Appendix R Consolidated Patent Rules - January 2021 Update

Title 37 - Code of Federal Regulations
Patents, Trademarks, and Copyrights

*[Editor Note: **Current as of January 20, 2021.** The Federal Register is the authoritative source and should be consulted if a need arises to verify the authenticity of the language reproduced below. This Consolidated Rules document incorporates the following final rule actions that became effective subsequent to the publication of MPEP Revision 10.2019 (which was updated as of October 2019):*
(1) Patent Term Adjustment Reductions in View of the Federal Circuit Decision in Supernus Pharm., Inc. v. Iancu, 85 FR 36335, June 16, 2020, effective July 16, 2020;
(2) Facilitating the Use of the World Intellectual Property Organization's ePCT System To Prepare International Applications for Filing With the United States Receiving Office, 85 FR 61604, September 30, 2020, effective September 30, 2020;
(3) Setting and Adjusting Patent Fees During Fiscal Year 2020, 85 FR 46932, August 3, 2020, effective October 2, 2020 and January 1, 2022;
(4) Setting and Adjusting Patent Fees During Fiscal Year 2020, correction, 85 FR 58282, September 18, 2020, effective October 2, 2020;
(5) PTAB Rules of Practice for Instituting on All Challenged Patent Claims and All Grounds and Eliminating the Presumption at Institution Favoring Petitioner as to Testimonial Evidence, 85 FR 79120, December 9, 2020, effective January 8, 2021;
(6) Small Entity Government Use License Exception, 85 FR 82917, December 21, 2020, effective January 20, 2021, corrected to effective January 21, 2021, 86 FR 2542, January 13, 2021 and correction withdrawn 86 FR 3815, January 15, 2021; and
(7) Rules of Practice To Allocate the Burden of Persuasion on Motions To Amend in Trial Proceedings Before the Patent Trial and Appeal Board, 85 FR 82923, December 21, 2020, effective January 20, 2021, corrected to effective January 21, 2021, 86 FR 2542, January 13, 2021 and correction withdrawn 86 FR 3815, January 15, 2021.]

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CHAPTER I — UNITED STATES PATENT AND TRADEMARK OFFICE, DEPARTMENT OF COMMERCE

SUBCHAPTER A — GENERAL

PATENTS

PART 1 — RULES OF PRACTICE IN PATENT CASES

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1.33 (pre-AIA) Correspondence respecting patent applications, reexamination proceedings, and other proceedings.
1.34 Acting in a representative capacity.
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1.36 (pre-AIA) Revocation of power of attorney; withdrawal of patent attorney or agent.

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1.45 Application for patent by joint inventors.
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1.421 (pre-AIA) Applicant for international application.
1.422 Legal representative as applicant in an international application.
1.422 (pre-AIA) When the inventor is dead.
1.423 [Reserved]
1.423 (pre-AIA) When the inventor is insane or legally incapacitated.
1.424 Assignee, obligated assignee, or person having sufficient proprietary interest as applicant in an international application.
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1.780 Certificate or order of extension of patent term.
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1.991 Merger of concurrent reissue application and inter partes reexamination proceeding.
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1.1011 Applicant for international design application.
1.1012 Applicant's Contracting Party.

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GENERAL INFORMATION AND CORRESPONDENCE

§ 1.1 Addresses for non-trademark correspondence with the United States Patent and Trademark Office.

(a) *In general.* Except as provided in paragraphs (a)(3)(i), (a)(3)(ii), and (d)(1) of this section, all correspondence intended for the United States Patent and Trademark Office must be addressed to either "Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450" or to specific areas within the Office as set out in paragraphs (a)(1), and (a)(3)(iii) of this section. When appropriate, correspondence should also be marked for the attention of a particular office or individual.

(1) *Patent correspondence.*

(i) *In general.* All correspondence concerning patent matters processed by

organizations reporting to the Commissioner for Patents should be addressed to: Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450.

(ii) *Patent Trial and Appeal Board.* See § 41.10 or § 42.6 of this title. Notices of appeal, appeal briefs, reply briefs, requests for oral hearing, as well as all other correspondence in an application or a patent involved in an appeal to the Board for which an address is not otherwise specified, should be addressed as set out in paragraph (a)(1)(i) of this section.

(2) [Reserved]

(3) *Office of General Counsel correspondence.—*

(i) *Litigation and service.* Correspondence relating to pending litigation or otherwise within the scope of part 104 of this title shall be addressed as provided in § 104.2.

(ii) *Disciplinary proceedings.* Correspondence to counsel for the Director of the Office of Enrollment and Discipline relating to disciplinary proceedings pending before a Hearing Officer or the Director shall be mailed to: Mail Stop 8, Office of the Solicitor, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450.

(iii) *Solicitor, in general.* Correspondence to the Office of the Solicitor not otherwise provided for shall be addressed to: Mail Stop 8, Office of the Solicitor, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450.

(iv) *General Counsel.* Correspondence to the Office of the General Counsel not otherwise provided for, including correspondence to the General Counsel relating to disciplinary proceedings, shall be addressed to: General Counsel, United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450.

(v) *Improper correspondence.* Correspondence improperly addressed to a Post Office Box specified in paragraphs (a)(3)(i) and (a)(3)(ii) of this section will not be filed elsewhere in the United States Patent and Trademark Office, and may be returned.

(4) *Office of Public Records correspondence.*

(i) *Assignments.* All patent-related documents submitted by mail to be recorded by Assignment Services Division, except for documents filed together with a new application, 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. *See* § 3.27.

(ii) *Documents.* All requests for certified or uncertified copies of patent documents should be addressed to: Mail Stop Document Services, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450.

(5) *Office of Enrollment and Discipline correspondence.* All correspondence directed to the Office of Enrollment and Discipline concerning enrollment, registration, and investigation matters should be addressed to Mail Stop OED, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450.

(b) *Patent Cooperation Treaty.* Letters and other communications relating to international applications during the international stage and prior to the assignment of a national serial number should be additionally marked “Mail Stop PCT.”

(c) *For reexamination or supplemental examination proceedings.*

(1) All correspondence concerning *ex parte* reexamination, other than correspondence to the Office of the General Counsel pursuant to § 1.1(a)(3) and § 102.4 of this chapter, should be additionally marked “Mail Stop *Ex Parte* Reexam.”

(2) All correspondence concerning *inter partes* reexamination, other than correspondence to the Office of the General Counsel pursuant to § 1.1(a)(3) and § 102.4 of this chapter, should be additionally marked "Mail Stop *Inter Partes* Reexam."

(3) Requests for supplemental examination (original and corrected request papers) and any other paper filed in a supplemental examination proceeding, should be additionally marked "Mail Stop Supplemental Examination."

(4) All correspondence concerning a reexamination proceeding ordered as a result of a supplemental reexamination proceeding, other than correspondence to the Office of the General Counsel

pursuant to § 1.1(a)(3) and § 102.4 of this chapter should be additionally marked "Mail Stop *Ex Parte* Reexam."

(d) Payments of maintenance fees in patents not submitted electronically over the Internet, and correspondence related to maintenance fees may be addressed to: Director of the United States Patent and Trademark Office, Attn: Maintenance Fee, 2051 Jamieson Avenue, Suite 300, Alexandria, Virginia 22314.

(e) *Patent term extension.* All applications for extension of patent term under 35 U.S.C. 156 and any communications relating thereto intended for the United States Patent and Trademark Office should be additionally marked "Mail Stop Hatch-Waxman PTE." When appropriate, the communication should also be marked to the attention of a particular individual, as where a decision has been rendered.

(f) [Reserved]

[46 FR 29181, May 29, 1981; para. (d) added, 49 FR 34724, Aug. 31, 1984, effective Nov. 1, 1984; para. (e), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (f) added, 52 FR 9394, Mar. 24, 1987; para. (g) added, 53 FR 16413, May 9,1988; para. (h) added, 54 FR 37588, Sept. 11, 1989, effective Nov. 16, 1989; para. (i) added, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; para. (a) revised and para. (g) removed and reserved, 61 FR 56439, Nov. 1, 1996, effective Dec. 2, 1996; para. (b) revised, 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; paras. (a) and (d) revised, 66 FR 39447, July 31, 2001, effective Oct. 1, 2001; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para (a)(2) corrected, 68 FR 19371, Apr. 21, 2003, effective May 1, 2003; section heading, para. (a) introductory text and para. (a)(4) revised, para. (a)(2) removed and reserved, and note following para. (f) removed, 68 FR 48286, Aug. 13, 2003, effective Sept. 12, 2003; para. (c) revised, 68 FR 70996, Dec. 22, 2003, effective Jan. 21, 2004; para. (a)(4)(i) revised and para. (f) removed and reserved, 69 FR 29865, May 26, 2004, effective June 25, 2004; para. (a) introductory text revised and para. (a)(5) added, 69 FR 35427, June 24, 2004, effective July 26, 2004; para. (a)(1)(ii) revised and para. (a)(1)(iii) removed, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (c)(1) revised, 72 FR 18892, Apr. 16, 2007, effective May 16, 2007; para. (d) revised, 73 FR 47534, Aug. 14, 2008, effective Oct. 2, 2008; paras. (a)(3)(ii) and (a)(3)(iii) revised, 75 FR 36294, June 25, 2010, effective June 25, 2010; para. (a)(1)(ii) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012; para. (e) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012; para. (c) revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013]

§ 1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

§ 1.3 Business to be conducted with decorum and courtesy.

Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided. Complaints against examiners and other employees must be made in correspondence separate from other papers.

[Amended, 61 FR 56439, Nov. 1, 1996, effective Dec. 2, 1996; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; revised, 68 FR 38611, June 30, 2003, effective July 30, 2003]

§ 1.4 Nature of correspondence and signature requirements.

(a) Correspondence with the Patent and Trademark Office comprises:

(1) Correspondence relating to services and facilities of the Office, such as general inquiries, requests for publications supplied by the Office, orders for printed copies of patents, orders for copies of records, transmission of assignments for recording, and the like, and

(2) *Correspondence in and relating to a particular application or other proceeding in the Office.* See particularly the rules relating to the filing, processing, or other proceedings of national applications in subpart B of this part; of international applications in subpart C of this part; of *ex parte*

reexaminations of patents in subpart D of this part; of supplemental examination of patents in subpart E of this part; of extension of patent term in subpart F of this part; of *inter partes* reexaminations of patents in subpart H of this part; of international design applications in subpart I of this part; and of the Patent Trial and Appeal Board in parts 41 and 42 of this chapter.

(b) Since each file must be complete in itself, a separate copy of every paper to be filed in a patent application, patent file, or other proceeding must be furnished for each file to which the paper pertains, even though the contents of the papers filed in two or more files may be identical. The filing of duplicate copies of correspondence in the file of an application, patent, or other proceeding should be avoided, except in situations in which the Office requires the filing of duplicate copies. The Office may dispose of duplicate copies of correspondence in the file of an application, patent, or other proceeding.

(c) Since different matters may be considered by different branches or sections of the Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects. Subjects provided for on a single Office or World Intellectual Property Organization form may be contained in a single paper.

(d)(1) *Handwritten signature.* Each piece of correspondence, except as provided in paragraphs (d)(2), (d)(3), (d)(4), (e), and (f) of this section, filed in an application, patent file, or other proceeding in the Office which requires a person's signature, must:

(i) Be an original, that is, have an original handwritten signature personally signed, in permanent dark ink or its equivalent, by that person; or

(ii) Be a direct or indirect copy, such as a photocopy or facsimile transmission (§ 1.6(d)), of an original. In the event that a copy of the original is filed, the original should be retained as evidence of authenticity. If a question of authenticity arises, the Office may require submission of the original.

(2) *S-signature.* An S-signature is a signature inserted between forward slash marks, but not a handwritten signature as defined by paragraph (d)(1) of this section. An S-signature includes any signature made by electronic or mechanical means, and any other mode of making or applying a signature other than a handwritten signature as provided for in paragraph (d)(1) of this section. Correspondence being filed in the Office in paper, by facsimile transmission as provided in § 1.6(d), or via the Office electronic filing system as an attachment as provided in § 1.6(a)(4), for a patent application, patent, or a reexamination or supplemental examination proceeding may be S-signature signed instead of being personally signed (*i.e.*, with a handwritten signature) as provided for in paragraph (d)(1) of this section. The requirements for an S-signature under this paragraph (d)(2) of this section are as follows.

(i) The S-signature must consist only of letters, or Arabic numerals, or both, with appropriate spaces and commas, periods, apostrophes, or hyphens for punctuation, and the person signing the correspondence must insert his or her own S-signature with a first single forward slash mark before, and a second single forward slash mark after, the S-signature (*e.g.*, /Dr. James T. Jones, Jr./); and

(ii) A patent practitioner (§ 1.32(a)(1)), signing pursuant to §§ 1.33(b)(1) or 1.33(b)(2), must supply his/her registration number either as part of the S-signature, or immediately below or adjacent to the S-signature. The number (#) character may be used only as part of the S-signature when appearing before a practitioner's registration number; otherwise the number character may not be used in an S-signature.

(iii) The signer's name must be:

(A) Presented in printed or typed form preferably immediately below or adjacent the S-signature, and

(B) Reasonably specific enough so that the identity of the signer can be readily recognized.

(3) *Electronically submitted correspondence.* Correspondence permitted via the Office electronic filing system may be signed by a graphic representation of a handwritten signature as provided for in paragraph (d)(1) of this section or a graphic representation of an S-signature as provided for in paragraph (d)(2) of this section when it is submitted via the Office electronic filing system.

(4) *Certifications—*

(i) *Certification as to the paper presented.* The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any paper by a party, whether a practitioner or non-practitioner, constitutes a certification under § 11.18(b) of this subchapter. Violations of § 11.18(b)(2) of this subchapter by a party, whether a practitioner or non-practitioner, may result in the imposition of sanctions under § 11.18(c) of this subchapter. Any practitioner violating § 11.18(b) of this subchapter may also be subject to disciplinary action. See § 11.18(d) of this subchapter.

(ii) *Certification as to the signature.* The person inserting a signature under paragraph (d)(2) or (d)(3) of this section in a document submitted to the Office certifies that the inserted signature appearing in the document is his or her own signature. A person submitting a document signed by another under paragraph (d)(2) or (d)(3) of this section is obligated to have a reasonable basis to believe that the person whose signature is present on the document was actually inserted by that person, and should retain evidence of authenticity of the signature. Violations of the certification as to the signature of another or a person's own signature as set forth in this paragraph may result in the imposition of sanctions under § 11.18(c) and (d) of this chapter.

(5) *Forms.* The Office provides forms for the public to use in certain situations to assist in the filing of correspondence for a certain purpose and to meet certain requirements for patent applications and proceedings. Use of the forms for purposes for which they were not designed is prohibited. No changes to certification statements on the Office forms (*e.g.,* oath or declaration forms, terminal disclaimer forms, petition forms, and nonpublication request forms) may be made. The existing text of a form, other than a certification statement, may be modified, deleted, or added to, if all text identifying the form as an Office form is removed. The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any Office form with text identifying the form as an Office form by a party, whether a practitioner or non-practitioner, constitutes a certification under § 11.18(b) of this chapter that the existing text and any certification statements on the form have not been altered other than permitted by EFS-Web customization.

(e) The following correspondence must be submitted with an original handwritten signature personally signed in permanent dark ink or its equivalent:

(1) Correspondence requiring a person's signature and relating to registration to practice before the Patent and Trademark Office in patent cases, enrollment and disciplinary investigations, or disciplinary proceedings; and

(2) Payments by credit cards where the payment is not being made via the Office's electronic filing systems.

(f) When a document that is required by statute to be certified must be filed, a copy, including a photocopy or facsimile transmission, of the certification is not acceptable.

(g) An applicant who has not made of record a registered attorney or agent may be required to state whether assistance was received in the preparation or prosecution of the patent application, for which any compensation or consideration was given or charged, and if so, to disclose the name or names of the person or persons providing such assistance. Assistance includes the preparation for the applicant of the specification and amendments or other papers to be filed in the Patent and Trademark Office, as well as other assistance in such matters, but does not include merely making drawings by draftsmen or stenographic services in typing papers.

(h) *Ratification/confirmation/evidence of authenticity:* The Office may require ratification, confirmation (which includes submission of a duplicate document but with a proper signature), or evidence of authenticity of a signature, such as when the Office has reasonable doubt as to the authenticity (veracity) of the signature, *e.g.,* where there are variations of a signature, or where the signature and the typed or printed name, do not clearly identify the person signing.

[24 FR 10332, Dec. 22, 1959; 43 FR 20461, May 11, 1978; para. (a), 48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (a)(2), 53 FR 47807, Nov. 28, 1988, effective Jan. 1, 1989; paras. (d)-(f) added, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; para. (d) revised & para. (g) added, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a)(2) and (d)(1) revised, 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; paras. (b) and (c) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a)(2) revised, 65 FR

76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (d)(1)(iii)(A) amended, 67 FR 79520, Dec. 30, 2002, effective Dec. 30, 2002; para. (d)(1)(iii)(B) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (d)(1)(iii) removed and reserved, paras. (a)(1), (a)(2), (b), (d)(1), introductory text, and (d)(1)(ii) revised, 68 FR 48286, Aug. 13, 2003, effective Sept. 12, 2003; para. (a)(2) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; paras. (d) and (e) revised and para. (h) added, 69 FR 56481, Sept. 21, 2004, effective Sept. 21, 2004; para. (d)(2) introductory text and paragraph (d)(2)(ii) revised, 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005; paras. (d)(2) introductory text, (d)(3), and (d)(4)(ii) revised, 72 FR 2770, Jan. 23, 2007, effective Jan. 23, 2007; paras. (d)(3) and (d)(4)(i) revised, para. (d)(4)(ii)(C) added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008; para. (a)(2) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012; para. (e) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012; para. (d)(4)(i) revised, 78 FR 20180, Apr. 3, 2013, effective May 3, 2013; paras. (a)(2), (c) and (d) revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013; para. (a)(2) revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.5 Identification of patent, patent application, or patent-related proceeding.

(a) No correspondence relating to an application should be filed prior to receipt of the assigned application number (*i.e.* , U.S. application number, international application number, or international registration number as appropriate). When correspondence directed to the Patent and Trademark Office concerns a previously filed application for a patent, it must identify on the top page in a conspicuous location, the application number (consisting of the series code and the serial number; *e.g.* , 07/123,456), or the serial number and filing date assigned to that application by the Patent and Trademark Office, or the international application number of the international application, or the international registration number of an international design application. Any correspondence not containing such identification will be returned to the sender where a return address is available. The returned correspondence will be accompanied with a cover letter, which will indicate to the sender that if the returned correspondence is resubmitted to the Patent and Trademark Office within two weeks of the mail date on the cover letter, the original date of receipt of the correspondence will be considered by the Patent and Trademark Office as the date of receipt of the correspondence. Applicants may use either the Certificate of Mailing or Transmission procedure under § 1.8 or the Priority Mail Express® procedure under § 1.10 for resubmissions of returned correspondence if they desire to have the benefit of the date of deposit in the United States Postal Service. If the returned correspondence is not resubmitted within the two-week period, the date of receipt of the resubmission will be considered to be the date of receipt of the correspondence. The two-week period to resubmit the returned correspondence will not be extended. In addition to the application number, all correspondence directed to the Patent and Trademark Office concerning applications for patent should also state the name of the first listed inventor, the title of the invention, the date of filing the same, and if known, the group art unit or other unit within the Patent and Trademark Office responsible for considering the correspondence and the name of the examiner or other person to which it has been assigned.

(b) When the letter concerns a patent other than for purposes of paying a maintenance fee, it should state the number and date of issue of the patent, the name of the patentee, and the title of the invention. For letters concerning payment of a maintenance fee in a patent, see the provisions of § 1.366(c).

(c) Correspondence relating to a trial proceeding before the Patent Trial and Appeal Board (part 42 of this title) are governed by § 42.6 of this title.

(d) A letter relating to a reexamination or supplemental examination proceeding should identify it as such by the number of the patent undergoing reexamination or supplemental examination, the request control number assigned to such proceeding, and, if known, the group art unit and name of the examiner to which it been assigned.

(e) [Reserved]

(f) When a paper concerns a provisional application, it should identify the application as such and include the application number.

[24 FR 10332, Dec. 22, 1959; 46 FR 29181, May 29, 1981; para. (a), 49 FR 552, Jan. 4, 1984, effective Apr. 1, 1984; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; paras. (a) & (b), 53 FR 47807, Nov. 28, 1988, effective Jan. 1, 1989; para. (a) revised, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; para. (f) added, 61 FR 42790, Aug. 19, 1996, effective

Sept. 23, 1996; para. (a) amended, 61 FR 56439, Nov. 1, 1996, effective Dec. 2, 1996; para. (c) revised, 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; section heading revised, para. (c) removed and reserved, 68 FR 48286, Aug. 13, 2003, effective Sept. 12, 2003; para. (e) removed and reserved, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (c) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012; para. (a) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012; para. (d) revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013; para. (a) revised, 79 FR 63036, Oct. 22, 2014, effective Oct. 22, 2014; para. (a) revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.6 Receipt of correspondence.

(a) *Date of receipt and Priority Mail Express® date of deposit.* Correspondence received in the Patent and Trademark Office is stamped with the date of receipt except as follows:

(1) The Patent and Trademark Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia. Except for correspondence transmitted by facsimile under paragraph (a)(3) of this section, or filed electronically under paragraph (a)(4) of this section, no correspondence is received in the Office on Saturdays, Sundays, or Federal holidays within the District of Columbia.

(2) Correspondence filed in accordance with § 1.10 will be stamped with the date of deposit as Priority Mail Express® with the United States Postal Service.

(3) Correspondence transmitted by facsimile to the Patent and Trademark Office will be stamped with the date on which the complete transmission is received in the Patent and Trademark Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the date stamped will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia.

(4) Correspondence may be submitted using the Office electronic filing system only in accordance with the Office electronic filing system requirements. Correspondence submitted to the Office by way of the Office electronic filing system will be accorded a receipt date, which is the date the correspondence is received at the correspondence address for the Office set forth in § 1.1 when it was officially submitted.

(b) [Reserved]

(c) *Correspondence delivered by hand.* In addition to being mailed, correspondence may be delivered by hand during hours the Office is open to receive correspondence.

(d) *Facsimile transmission.* Except in the cases enumerated below, correspondence, including authorizations to charge a deposit account, may be transmitted by facsimile. The receipt date accorded to the correspondence will be the date on which the complete transmission is received in the United States Patent and Trademark Office, unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. See paragraph (a)(3) of this section. To facilitate proper processing, each transmission session should be limited to correspondence to be filed in a single application or other proceeding before the United States Patent and Trademark Office. The application number of a patent application, the control number of a reexamination or supplemental examination proceeding, the interference number of an interference proceeding, the trial number of a trial proceeding before the Board, or the patent number of a patent should be entered as a part of the sender's identification on a facsimile cover sheet. Facsimile transmissions are not permitted and, if submitted, will not be accorded a date of receipt in the following situations:

(1) Correspondence as specified in § 1.4(e), requiring an original signature;

(2) Certified documents as specified in § 1.4(f);

(3) Correspondence that cannot receive the benefit of the certificate of mailing or transmission as specified in § 1.8(a)(2)(i)(A) through (D), (F), (I), and (K) and § 1.8(a)(2)(iii)(A), except that a continued prosecution application under § 1.53(d) may be transmitted to the Office by facsimile;

(4) Color drawings submitted under §§ 1.81, 1.83 through 1.85, 1.152, 1.165, 1.173, 1.437, or 1.1026;

(5) A request for reexamination under § 1.510 or § 1.913, or a request for supplemental examination under § 1.610;

(6) Correspondence to be filed in an application subject to a secrecy order under §§ 5.1 through 5.5 of this chapter and directly related to the secrecy order content of the application;

(7) In contested cases and trials before the Patent Trial and Appeal Board, except as the Board may expressly authorize.

(e) [Reserved]

(f) *Facsimile transmission of a patent application under § 1.53(d).* In the event that the Office has no evidence of receipt of an application under § 1.53(d) (a continued prosecution application) transmitted to the Office by facsimile transmission, the party who transmitted the application under § 1.53(d) may petition the Director to accord the application under § 1.53(d) a filing date as of the date the application under § 1.53(d) is shown to have been transmitted to and received in the Office,

(1) Provided that the party who transmitted such application under § 1.53(d):

(i) Informs the Office of the previous transmission of the application under § 1.53(d) promptly after becoming aware that the Office has no evidence of receipt of the application under § 1.53(d);

(ii) Supplies an additional copy of the previously transmitted application under § 1.53(d); and

(iii) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous transmission of the application under § 1.53(d) and is accompanied by a copy of the sending unit's report confirming transmission of the application under § 1.53(d) or evidence that came into being after the complete transmission and within one business day of the complete transmission of the application under § 1.53(d).

(2) The Office may require additional evidence to determine if the application under § 1.53(d) was transmitted to and received in the Office on the date in question.

(g) *Submission of the national stage correspondence required by § 1.495 via the Office electronic filing system.* In the event that the Office has no evidence of receipt of the national stage correspondence required by § 1.495, which was submitted to the Office by the Office electronic filing system, the party who submitted the correspondence may petition the Director to accord the national stage correspondence a receipt date as of the date the correspondence is shown to have been officially submitted to the Office.

(1) The petition of this paragraph (g) requires that the party who submitted such national stage correspondence:

(i) Informs the Office of the previous submission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence under § 1.495;

(ii) Supplies an additional copy of the previously submitted correspondence;

(iii) Includes a statement that attests on a personal knowledge basis, or to the satisfaction of the Director, that the correspondence was previously officially submitted; and

(iv) Supplies a copy of an acknowledgment receipt generated by the Office electronic filing system, or equivalent evidence, confirming the submission to support the statement of paragraph (g)(1)(iii) of this section.

(2) The Office may require additional evidence to determine if the national stage correspondence was submitted to the Office on the date in question.

[48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; 48 FR 4285, Jan. 31, 1983; para. (a), 49 FR 552, Jan. 4, 1984, effective Apr. 1, 1984; revised, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; para. (a) amended, 61 FR 56439, Nov. 1, 1996, effective Dec. 2, 1996; paras. (d)(3), (d)(6) & (e) amended, para. (f) added, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para (a)(1) revised and para. (a)(4) added, 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; para.(d)(9) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (d)(5) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (b) removed and reserved and paras. (e), (f) & (f)(1)(iii) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; paras. (a)(4), (d)(7) and (d)(8) removed and reserved, and paras. (d), introductory text, (d)(3), and (d)(4) revised, 68 FR 48286, Aug. 13, 2003, effective Sept. 12, 2003; para. (d)(9) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (d)(4) revised and para. (e) removed and reserved, 69 FR 56481, Sept. 21, 2004, effective Sept. 21, 2004; paras. (a)(4) & (g) added, 72 FR 2770, Jan. 23, 2007, effective Jan. 23, 2007; para. (d)(3) revised, 77 FR 42150, July 17,

2012, effective Sept. 16, 2012; ; paras. (d) introductory text and (d)(9) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012; para. (d) revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013; paras. (a) and (a)(2) revised, 79 FR 63036, Oct. 22, 2014, effective Oct. 22, 2014; paras. (d)(3)-(4) and (6) revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.7 Times for taking action; Expiration on Saturday, Sunday or Federal holiday.

(a) Whenever periods of time are specified in this part in days, calendar days are intended. When the day, or the last day fixed by statute or by or under this part for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or on a Federal holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding business day which is not a Saturday, Sunday, or a Federal holiday. See § 90.3 of this chapter for time for appeal or for commencing civil action.

(b) If the day that is twelve months after the filing date of a provisional application under 35 U.S.C. 111(b) and § 1.53(c) falls on Saturday, Sunday, or on a Federal holiday within the District of Columbia, the period of pendency shall be extended to the next succeeding secular or business day which is not a Saturday, Sunday, or a Federal holiday.

[48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; corrected 48 FR 4285, Jan. 31, 1983; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); para. (a) revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013]

§ 1.8 Certificate of mailing or transmission.

(a) Except in the situations enumerated in paragraph (a)(2) of this section or as otherwise expressly excluded in this chapter, correspondence required to be filed in the U.S. Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.

(1) Correspondence will be considered as being timely filed if:

(i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:

(A) Addressed as set out in § 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail;

(B) Transmitted by facsimile to the Patent and Trademark Office in accordance with § 1.6(d); or

(C) Transmitted via the Office electronic filing system in accordance with § 1.6(a)(4); and

(ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.

(2) The procedure described in paragraph (a)(1) of this section does not apply to, and no benefit will be given to a Certificate of Mailing or Transmission on, the following:

(i) *Relative to Patents and Patent Applications—*

(A) The filing of a national patent application specification and drawing or other correspondence for the purpose of obtaining an application filing date, including a request for a continued prosecution application under § 1.53(d);

(B) Papers filed in trials before the Patent Trial and Appeal Board, which are governed by § 42.6(b) of this title;

(C) Papers filed in contested cases before the Patent Trial and Appeal Board, which are governed by § 41.106(f) of this title;

(D) The filing of an international application for patent;

(E) The filing of correspondence in an international application before the U.S. Receiving Office, the U.S. International Searching Authority, or the U.S. International Preliminary Examining Authority;

(F) The filing of a copy of the international application and the basic national fee necessary to enter the national stage, as specified in § 1.495(b).

(G) The filing of a written declaration of abandonment under § 1.138;

(H) The filing of a submission under § 1.217 for publication of a redacted copy of an application;

(I) The filing of a third-party submission under § 1.290;

(J) The calculation of any period of adjustment, as specified in § 1.703(f); and

(K) The filing of an international design application.

(ii) *[Reserved]*

(iii) *Relative to Disciplinary Proceedings—*

(A) Correspondence filed in connection with a disciplinary proceeding under part 11 of this chapter.

(B) [Reserved]

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence, or after the application is held to be abandoned, or after the proceeding is dismissed or decided with prejudice, or the prosecution of a reexamination proceeding is terminated pursuant to § 1.550(d) or § 1.957(b) or limited pursuant to § 1.957(c), or a requester paper is refused consideration pursuant to § 1.957(a), the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;

(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and

(3) Includes a statement that attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing, transmission or submission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement. If the correspondence was transmitted via the Office electronic filing system, a copy of an acknowledgment receipt generated by the Office electronic filing system confirming submission may be used to support this statement.

(c) The Office may require additional evidence to determine if the correspondence was timely filed.

[41 FR 43721, Oct. 4, 1976; 43 FR 20461, May 11, 1978; para. (a). 47 FR 47381, Oct. 26, 1982, effective Oct. 26, 1982; para. (a),48 FR 2696, Jan. 20, 1983; para. (a) 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (a), 49 FR 5171, Feb. 6, 1985, effective Mar. 8, 1985; 52 FR 20046, May 28, 1987; subparas. (a)(2)(xiv)-(xvi), 54 FR 37588, Sept. 11, 1989, effective Nov. 16, 1989; revised, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; para. (a) revised, 61 FR 56439, Nov. 1, 1996, effective Dec. 2, 1996; paras. (a)(2)(i)(A) & (b) revised; 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (a)(2)(i)(F) revised, 67 FR 520, Jan. 4, 2002, effective Apr. 1, 2002; para. (b)(3) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (a)(2)(ii) removed and reserved, 68 FR 48286, Aug. 13, 2003, effective Sept. 12, 2003; para. (a)(2)(i)(B) removed and reserved and para. (a)(2)(i)(C) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; paras. (a) and (b) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004; paras. (a)(1)(i) & (b)(3) revised, 72 FR 2770, Jan. 23, 2007, effective Jan. 23, 2007; para. (b) introductory text revised, 72 FR 18892, Apr. 16, 2007, effective May 16, 2007; para. (a)(2)(iii)(A) revised, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008; paras. (a)(2)(i)(C) revised and paras. (a)(2)(i)(B) and (a)(2)(i)(G)-(J) added, 77 FR 42150, July 17, 2012, effective Sept. 16, 2012; paras. (a)(2)(i)(I)-(J) revised and para. (a)(2)(i)(K) added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.9 Definitions.

(a)(1) A national application as used in this chapter means either a U.S. application for patent which was filed in the Office under 35 U.S.C. 111, an international application filed under the Patent Cooperation Treaty in which the basic national fee under 35 U.S.C. 41(a)(1)(F) has been paid, or an international design application filed under the Hague Agreement in which the Office has received a copy of the international registration pursuant to Hague Agreement Article 10.

(2) A provisional application as used in this chapter means a U.S. national application for patent filed in the Office under 35 U.S.C. 111(b).

(3) A nonprovisional application as used in this chapter means either a U.S. national application for patent which was filed in the Office under 35 U.S.C. 111(a), an international application filed under the Patent Cooperation Treaty in which the basic national fee under 35 U.S.C. 41(a)(1)(F) has been paid, or an international design application filed under the Hague Agreement in which the Office has received a copy of the international registration pursuant to Hague Agreement Article 10.

(b) An international application as used in this chapter means an international application for patent filed under the Patent Cooperation Treaty prior to entering national processing at the Designated Office stage.

(c) A published application as used in this chapter means an application for patent which has been published under 35 U.S.C. 122(b).

(d)(1) The term inventor or inventorship as used in this chapter means the individual or, if a joint invention, the individuals collectively who invented or discovered the subject matter of the invention.

(2) The term joint inventor or coinventor as used in this chapter means any one of the individuals who invented or discovered the subject matter of a joint invention.

(e) The term joint research agreement as used in this chapter means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.

(f) The term claimed invention as used in this chapter means the subject matter defined by a claim in a patent or an application for a patent.

(g) For definitions in Patent Trial and Appeal Board proceedings, see parts 41 and 42 of this title.

(h) A Federal holiday within the District of Columbia as used in this chapter means any day, except Saturdays and Sundays, when the Patent and Trademark Office is officially closed for business for the entire day.

(i) National security classified as used in this chapter means specifically authorized under criteria established by an Act of Congress or Executive Order to be kept secret in the interest of national defense or foreign policy and, in fact, properly classified pursuant to such Act of Congress or Executive Order.

(j) Director as used in this chapter, except for part 11 of this chapter, means the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

(k) Paper as used in this chapter means a document that may exist in electronic form, or in physical form, and therefore does not necessarily imply physical sheets of paper.

(l) Hague Agreement as used in this chapter means the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs adopted at Geneva, Switzerland, on July 2, 1999, and Hague Agreement Article as used in this chapter means an Article under the Hague Agreement.

(m) Hague Agreement Regulations as used in this chapter means the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement, and Hague Agreement Rule as used in this chapter means one of the Hague Agreement Regulations.

(n) An international design application as used in this chapter means an application for international registration of a design filed under the Hague Agreement. Unless otherwise clear from the wording, reference to "design application" or "application for a design patent" in this chapter includes an international design application that designates the United States.

[43 FR 20461, May 11, 1978; 47 FR 40139, Sept. 10, 1982, effective Oct. 1, 1982; 47 FR 43275, Sept. 30, 1982, effective Oct. 1, 1982; para. (d), 49 FR 34724, Aug. 31, 1984, effective Nov. 1, 1984; para. (g), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (d) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; para. (a) amended, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; para. (h) added, 61 FR 56439, Nov. 1, 1996, effective Dec. 2, 1996; paras. (d) & (f) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; paras. (c)-(f) removed and reserved and para. (i) added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (c) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para. (j) added, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (k) added, 68 FR 38611, June 30, 2003, effective July 30, 2003; para. (g) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (j) revised, 73 FR 47650, Aug. 14, 2008, effective Sept. 15,

2008; para. (g) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012; paras. (a) and (b) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012; paras. (d)-(f) added, 78 FR 11024, Feb. 14, 2013, effective Mar. 16, 2013; paras. (a)(1) and (3) revised and paras. (l)-(n) added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.10 Filing of correspondence by Priority Mail Express®.

(a)(1) Any correspondence received by the U.S. Patent and Trademark Office (USPTO) that was delivered by the Priority Mail Express® Post Office to Addressee service of the United States Postal Service (USPS) will be considered filed with the USPTO on the date of deposit with the USPS.

(2) The date of deposit with USPS is shown by the "date accepted" on the Priority Mail Express® label or other official USPS notation. If the USPS deposit date cannot be determined, the correspondence will be accorded the USPTO receipt date as the filing date. See § 1.6(a).

(b) Correspondence should be deposited directly with an employee of the USPS to ensure that the person depositing the correspondence receives a legible copy of the Priority Mail Express® mailing label with the "date accepted" clearly marked. Persons dealing indirectly with the employees of the USPS (such as by deposit in a Priority Mail Express® drop box) do so at the risk of not receiving a copy of the Priority Mail Express® mailing label with the desired "date accepted" clearly marked. The paper(s) or fee(s) that constitute the correspondence should also include the Priority Mail Express® mailing label number thereon. See paragraphs (c), (d) and (e) of this section.

(c) Any person filing correspondence under this section that was received by the Office and delivered by the Priority Mail Express® Post Office to Addressee service of the USPS, who can show that there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the "date accepted" on the Priority Mail Express® mailing label or other official USPS notation, may petition the Director to accord the correspondence a filing date as of the "date accepted" on the Priority Mail Express® mailing label or other official USPS notation, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;

(2) The number of the Priority Mail Express® mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by Priority Mail Express®; and

(3) The petition includes a true copy of the Priority Mail Express® mailing label showing the "date accepted," and of any other official notation by the USPS relied upon to show the date of deposit.

(d) Any person filing correspondence under this section that was received by the Office and delivered by the Priority Mail Express® Post Office to Addressee service of the USPS, who can show that the "date accepted" on the Priority Mail Express® mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Director to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;

(2) The number of the Priority Mail Express® mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by Priority Mail Express®; and

(3) The petition includes a showing which establishes, to the satisfaction of the Director, that the requested filing date was the date the correspondence was deposited in the Priority Mail Express® Post Office to Addressee service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the Priority Mail

Express® Post Office to Addressee service of the USPS.

(e) Any person mailing correspondence addressed as set out in § 1.1(a) to the Office with sufficient postage utilizing the Priority Mail Express® Post Office to Addressee service of the USPS but not received by the Office, may petition the Director to consider such correspondence filed in the Office on the USPS deposit date, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence;

(2) The number of the Priority Mail Express® mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by Priority Mail Express®;

(3) The petition includes a copy of the originally deposited paper(s) or fee(s) that constitute the correspondence showing the number of the Priority Mail Express® mailing label thereon, a copy of any returned postcard receipt, a copy of the Priority Mail Express® mailing label showing the "date accepted," a copy of any other official notation by the USPS relied upon to show the date of deposit, and, if the requested filing date is a date other than the "date accepted" on the Priority Mail Express® mailing label or other official notation entered by the USPS, a showing pursuant to paragraph (d)(3) of this section that the requested filing date was the date the correspondence was deposited in the Priority Mail Express® Post Office to Addressee service prior to the last scheduled pickup for that day; and

(4) The petition includes a statement which establishes, to the satisfaction of the Director, the original deposit of the correspondence and that the copies of the correspondence, the copy of the Priority Mail Express® mailing label, the copy of any returned postcard receipt, and any official notation entered by the USPS are true copies of the originally mailed correspondence, original Priority Mail Express® mailing label, returned postcard receipt, and official notation entered by the USPS.

(f) The Office may require additional evidence to determine if the correspondence was deposited as Priority Mail Express® with the USPS on the date in question.

(g) Any person who mails correspondence addressed as set out in § 1.1(a) to the Office with sufficient postage utilizing the Priority Mail Express® Post Office to Addressee service of the USPS, but has the correspondence returned by the USPS due to an interruption or emergency in Priority Mail Express® service, may petition the Director to consider such correspondence as filed on a particular date in the Office, provided that:

(1) The petition is filed promptly after the person becomes aware of the return of the correspondence;

(2) The number of the Priority Mail Express® mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by Priority Mail Express®;

(3) The petition includes the original correspondence or a copy of the original correspondence showing the number of the Priority Mail Express® mailing label thereon and a copy of the Priority Mail Express® mailing label showing the "date accepted"; and

(4) The petition includes a statement which establishes, to the satisfaction of the Director, the original deposit of the correspondence and that the correspondence or copy of the correspondence is the original correspondence or a true copy of the correspondence originally deposited with the USPS on the requested filing date. The Office may require additional evidence to determine if the correspondence was returned by the USPS due to an interruption or emergency in Priority Mail Express® service.

(h) Any person who attempts to mail correspondence addressed as set out in § 1.1(a) to the Office with sufficient postage utilizing the Priority Mail Express® Post Office to Addressee service of the USPS, but has the correspondence refused by an employee of the USPS due to an interruption or emergency in Priority Mail Express® service, may petition the Director to consider such

correspondence as filed on a particular date in the Office, provided that:

(1) The petition is filed promptly after the person becomes aware of the refusal of the correspondence;

(2) The number of the Priority Mail Express® mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the attempted mailing by Priority Mail Express®;

(3) The petition includes the original correspondence or a copy of the original correspondence showing the number of the Priority Mail Express® mailing label thereon; and

(4) The petition includes a statement by the person who originally attempted to deposit the correspondence with the USPS which establishes, to the satisfaction of the Director, the original attempt to deposit the correspondence and that the correspondence or copy of the correspondence is the original correspondence or a true copy of the correspondence originally attempted to be deposited with the USPS on the requested filing date. The Office may require additional evidence to determine if the correspondence was refused by an employee of the USPS due to an interruption or emergency in Priority Mail Express® service.

(i) Any person attempting to file correspondence under this section that was unable to be deposited with the USPS due to an interruption or emergency in Priority Mail Express® service which has been so designated by the Director, may petition the Director to consider such correspondence as filed on a particular date in the Office, provided that:

(1) The petition is filed in a manner designated by the Director promptly after the person becomes aware of the designated interruption or emergency in Priority Mail Express® service;

(2) The petition includes the original correspondence or a copy of the original correspondence; and

(3) The petition includes a statement which establishes, to the satisfaction of the Director, that the correspondence would have been deposited with the USPS but for the designated interruption or emergency in Priority Mail Express® service, and that the correspondence or copy of the correspondence is the original correspondence or a true copy of the correspondence originally attempted to be deposited with the USPS on the requested filing date.

[48 FR 2696, Jan. 20, 1983, added effective Feb. 27, 1983; 48 FR 4285, Jan. 31, 1983, paras. (a) & (c), 49 FR 552, Jan. 4, 1984, effective Apr. 1, 1984; paras. (a)-(c) revised and paras. (d) - (f) added, 61 FR 56439, Nov. 1, 1996, effective Dec. 2, 1996; paras. (d) & (e) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 67 FR 36099, May 23, 2002, effective June 24, 2002; paras. (c), (d), (d)(3), (e) & (e)(4) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (a)(1) revised, 68 FR 48286, Aug. 13, 2003, effective Sept. 12, 2003; paras. (g) through (i) added, 69 FR 56481, Sept. 21, 2004, effective Sept. 21, 2004; revised, 79 FR 63036, Oct. 22, 2014, effective Oct. 22, 2014;]

RECORDS AND FILES OF THE PATENT AND TRADEMARK OFFICE

§ 1.11 Files open to the public.

(a) The specification, drawings, and all papers relating to the file of: A published application; a patent; or a statutory invention registration are open to inspection by the public, and copies may be obtained upon the payment of the fee set forth in § 1.19(b)(2). If an application was published in redacted form pursuant to § 1.217, the complete file wrapper and contents of the patent application will not be available if: The requirements of paragraphs (d)(1), (d)(2), and (d)(3) of § 1.217 have been met in the application; and the application is still pending. See § 2.27 of this title for trademark files.

(b) All reissue applications, all applications in which the Office has accepted a request to open the complete application to inspection by the public, and related papers in the application file, are open to inspection by the public, and copies may be furnished upon paying the fee therefor. The filing of reissue applications, other than continued prosecution applications under § 1.53(d) of reissue applications, will be announced in the *Official Gazette.* The announcement shall include at least the filing date, reissue application and original patent numbers, title, class and subclass, name of the inventor, name of the owner of record, name of the attorney or agent of record, and examining group to which the reissue application is assigned.

(c) All requests for reexamination for which all the requirements of § 1.510 or § 1.915 have been satisfied will be announced in the *Official Gazette.* Any reexaminations at the initiative of the Director pursuant to § 1.520 will also be announced in the *Official Gazette.* The announcement shall include at least the date of the request, if any, the reexamination request control number or the Director initiated order control number, patent number, title, class and subclass, name of the inventor, name of the patent owner of record, and the examining group to which the reexamination is assigned.

(d) All papers or copies thereof relating to a reexamination proceeding which have been entered of record in the patent or reexamination file are open to inspection by the general public, and copies may be furnished upon paying the fee therefor.

(e) Except as prohibited in § 41.6(b), § 42.14 or § 42.410(b), the file of any interference or trial before the Patent Trial and Appeal Board is open to public inspection and copies of the file may be obtained upon payment of the fee therefor.

[42 FR 5593, Jan. 28, 1977; 43 FR 28477, June 30, 1978; 46 FR 29181, May 29, 1981, para. (c), 47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; paras. (a), (b) and (e), 50 FR 9278, Mar. 7, 1985, effective May 8, 1985; para. (e) revised, 60 FR 14488, Mar. 17, 1995, effective Mar. 17, 1995; para. (b) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para. (c) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (e) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (a) revised, 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005; para. (c) revised, 71 FR 44219, Aug. 4, 2006, effective Aug. 4, 2006; para. (e) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

§ 1.12 Assignment records open to public inspection.

[Editor Note: Paras. (b) and (c)(2) below include changes applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

(a)(1) Separate assignment records are maintained in the United States Patent and Trademark Office for patents and trademarks. The assignment records, relating to original or reissue patents, including digests and indexes (for assignments recorded on or after May 1, 1957), and published patent applications are open to public inspection at the United States Patent and Trademark Office, and copies of patent assignment records may be obtained upon request and payment of the fee set forth in § 1.19 of this chapter. See § 2.200 of this chapter regarding trademark assignment records.

(2) All records of assignments of patents recorded before May 1, 1957, are maintained by the National Archives and Records Administration (NARA). The records are open to public inspection. Certified and uncertified copies of those assignment records are provided by NARA upon request and payment of the fees required by NARA.

(b) Assignment records, digests, and indexes relating to any pending or abandoned patent application, which is open to the public pursuant to § 1.11 or for which copies or access may be supplied pursuant to § 1.14, are available to the public. Copies of any assignment records, digests, and indexes that are not available to the public shall be obtainable only upon written authority of an inventor, the applicant, the assignee or an assignee of an undivided part interest, or a patent practitioner of record, or upon a showing that the person seeking such information is a bona fide prospective or actual purchaser, mortgagee, or licensee of such application, unless it shall be necessary to the proper conduct of business before the Office or as provided in this part.

(c) Any request by a member of the public seeking copies of any assignment records of any pending or abandoned patent application preserved in confidence under § 1.14, or any information with respect thereto, must:

(1) Be in the form of a petition including the fee set forth in § 1.17(g); or

(2) Include written authority granting access to the member of the public to the particular assignment records from an inventor, the applicant, the assignee or an assignee of an undivided part interest, or a patent practitioner of record.

(d) An order for a copy of an assignment or other document should identify the reel and frame number where the assignment or document is recorded. If a document is identified without specifying its correct reel and frame, an extra charge as set forth in § 1.21(j) will be made for the time consumed in making a search for such assignment.

[47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; paras. (a) and (c), 54 FR 6893, Feb. 15, 1989, effective Apr. 17, 1989; paras. (a) and (d), 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; paras. (a)(1) and (d), 57 FR 29641, July 6, 1992, effective Sept. 4, 1992; para. (a)(2) added, 57 FR 29641, July 6, 1992, effective Sept. 4, 1992; para. (c) amended, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; para. (c) amended, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; para. (c)(1) amended, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a)(1) and (b) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; paras. (a)(1) and (a)(2) revised, 68 FR 48286, Aug. 13, 2003, effective Sept. 12, 2003; para. (b) revised, 69 FR 29865, May 26, 2004, effective June 25, 2004; para. (c)(1) revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004; paras. (b) and (c)(2) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012]

[*The changes to paras. (b) and (c)(2) effective Sept. 16, 2012 are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012. See § 1.12 (pre-AIA) for paras. (b) and (c)(2) otherwise in effect.]

§ 1.12 (pre-AIA) Assignment records open to public inspection.

[Editor Note: Applicable to patent applications filed before September 16, 2012*]

(a)(1) Separate assignment records are maintained in the United States Patent and Trademark Office for patents and trademarks. The assignment records, relating to original or reissue patents, including digests and indexes (for assignments recorded on or after May 1, 1957), and published patent applications are open to public inspection at the United States Patent and Trademark Office, and copies of patent assignment records may be obtained upon request and payment of the fee set forth in § 1.19 of this chapter. See § 2.200 of this chapter regarding trademark assignment records.

(2) All records of assignments of patents recorded before May 1, 1957, are maintained by the National Archives and Records Administration (NARA). The records are open to public inspection. Certified and uncertified copies of those assignment records are provided by NARA upon request and payment of the fees required by NARA.

(b) Assignment records, digests, and indexes relating to any pending or abandoned patent application, which is open to the public pursuant to § 1.11 or for which copies or access may be supplied pursuant to § 1.14, are available to the public. Copies of any assignment records, digests, and indexes that are not available to the public shall be obtainable only upon written authority of the applicant or applicant's assignee or patent attorney or patent agent or upon a showing that the person seeking such information is a bona fide prospective or actual purchaser, mortgagee, or licensee of such application, unless it shall be necessary to the proper conduct of business before the Office or as provided in this part.

(c) Any request by a member of the public seeking copies of any assignment records of any pending or abandoned patent application preserved in confidence under § 1.14, or any information with respect thereto, must:

(1) Be in the form of a petition including the fee set forth in § 1.17(g); or

(2) Include written authority granting access to the member of the public to the particular assignment records from the applicant or applicant's assignee or attorney or agent of record.

(d) An order for a copy of an assignment or other document should identify the reel and frame number where the assignment or document is recorded. If a document is identified without specifying its correct reel and frame, an extra charge as set forth in § 1.21(j) will be made for the time consumed in making a search for such assignment.

[47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; paras. (a) and (c), 54 FR 6893, Feb. 15, 1989, effective Apr. 17, 1989; paras. (a) and (d), 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; paras. (a)(1) and (d), 57 FR 29641, July 6, 1992, effective Sept. 4, 1992; para. (a)(2) added, 57 FR 29641, July 6, 1992, effective Sept. 4, 1992; para. (c) amended, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; para. (c) amended, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; para. (c)(1) amended, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a)(1) and (b) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; paras. (a)(1) and (a)(2) revised, 68 FR 48286, Aug. 13, 2003, effective Sept. 12, 2003; para. (b) revised, 69 FR 29865, May 26, 2004, effective June 25, 2004; para. (c)(1) revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004]

[*See § 1.12 for more information and the current rule, including paras. (b) and (c)(2) applicable to applications filed on or after Sept. 16, 2012]

§ 1.13 Copies and certified copies.

(a) Non-certified copies of patents, and patent application publications and of any records, books, papers, or drawings within the jurisdiction of the United States Patent and Trademark Office and open to the public, will be furnished by the United States Patent and Trademark Office to any person, and copies of other records or papers will be furnished to persons entitled thereto, upon payment of the appropriate fee. See § 2.201 of this chapter regarding copies of trademark records.

(b) Certified copies of patents, patent application publications, and trademark registrations and of any records, books, papers, or drawings within the jurisdiction of the United States Patent and Trademark Office and open to the public or persons entitled thereto will be authenticated by the seal of the United States Patent and Trademark Office and certified by the Director, or in his or her name, upon payment of the fee for the certified copy.

[Revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para. (b) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; revised, 68 FR 48286, Aug. 13, 2003, effective Sept. 12, 2003; para. (b) revised, 68 FR 70996, Dec. 22, 2003, effective Jan. 21, 2004]

§ 1.14 Patent applications preserved in confidence.

[Editor Note: Applicable to patent applications filed on or after September 16, 2012*]

(a) *Confidentiality of patent application information.* Patent applications that have not been published under 35 U.S.C. 122(b) are generally preserved in confidence pursuant to 35 U.S.C. 122(a). Information concerning the filing, pendency, or subject matter of an application for patent, including status information, and access to the application, will only be given to the public as set forth in § 1.11 or in this section.

(1) Records associated with patent applications (see paragraph (g) of this section for international applications and paragraph (j) of this section for international design applications) may be available in the following situations:

(i) *Patented applications and statutory invention registrations.* The file of an application that has issued as a patent or published as a statutory invention registration is available to the public as set forth in § 1.11(a) . A copy of the patent application-as-filed, the file contents of the application, or a specific document in the file of such an application may be provided upon request and payment of the appropriate fee set forth in § 1.19(b).

(ii) *Published abandoned applications.* The file of an abandoned published application is available to the public as set forth in § 1.11(a) . A copy of the application-as-filed, the file contents of the published application, or a specific document in the file of the published application may be provided to any person upon request and payment of the appropriate fee set forth in § 1.19(b) .

(iii) *Published pending applications.* A copy of the application-as-filed, the file contents of the application, or a specific document in the file of a pending published application may be provided to any person upon request and payment of the appropriate fee set forth in § 1.19(b) . If a redacted copy of the application was used for the patent application publication, the copy of the specification, drawings, and papers may be limited to a redacted copy. The Office will not provide access to the paper file of a pending application that has been published, except as provided in paragraph (c) or (i) of this section.

(iv) *Unpublished abandoned applications (including provisional applications) that are identified or relied upon.* The file contents of an unpublished, abandoned application may be made available to the public if the application is identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, an international publication of an international application under PCT Article 21(2), or a publication of an international registration under Hague Agreement Article 10(3) of an international design application designating the United States. An application is considered to have been identified in a document, such as a patent, when the application number or serial number and filing date, first named inventor, title, and filing date or other application specific information are provided in the text of the patent, but not when the same identification is made in a paper in the file contents of the patent and is

not included in the printed patent. Also, the file contents may be made available to the public, upon a written request, if benefit of the abandoned application is claimed under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c) in an application that has issued as a U.S. patent, or has published as a statutory invention registration, a U.S. patent application publication, an international publication of an international application under PCT Article 21(2), or a publication of an international registration under Hague Agreement Article 10(3). A copy of the application-as-filed, the file contents of the application, or a specific document in the file of the application may be provided to any person upon written request and payment of the appropriate fee (§ 1.19(b)).

(v) *Unpublished pending applications (including provisional applications) whose benefit is claimed.* A copy of the file contents of an unpublished pending application may be provided to any person, upon written request and payment of the appropriate fee (§ 1.19(b)), if the benefit of the application is claimed under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c) in an application that has issued as a U.S. patent, or in an application that has published as a statutory invention registration, a U.S. patent application publication, an international publication of an international application under PCT Article 21(2), or a publication of an international registration under Hague Agreement Article 10(3). A copy of the application-as-filed or a specific document in the file of the pending application may also be provided to any person upon written request and payment of the appropriate fee (§ 1.19(b)). The Office will not provide access to the paper file of a pending application, except as provided in paragraph (c) or (i) of this section.

(vi) *Unpublished pending applications (including provisional applications) that are incorporated by reference or otherwise identified.* A copy of the application as originally filed of an unpublished pending application may be provided to any person, upon written request and payment of the appropriate fee (§ 1.19(b)), if the application is incorporated by reference or otherwise identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, an international publication of an international application under PCT Article 21(2), or a publication of an international registration under Hague Agreement Article 10(3) of an international design application designating the United States. The Office will not provide access to the paper file of a pending application, except as provided in paragraph (c) or (i) of this section.

(vii) *When a petition for access or a power to inspect is required.* Applications that were not published or patented, that are not the subject of a benefit claim under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c) in an application that has issued as a U.S. patent, an application that has published as a statutory invention registration, a U.S. patent application publication, an international publication of an international application under PCT Article 21(2), or a publication of an international registration under Hague Agreement Article 10(3), or are not identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, an international publication of an international application under PCT Article 21(2), or a publication of an international registration under Hague Agreement Article 10(3) of an international design application designating the United States, are not available to the public. If an application is identified in the file contents of another application, but not the published patent application or patent itself, a granted petition for access (see paragraph (i)) or a power to inspect (see paragraph (c) of this section) is necessary to obtain the application, or a copy of the application.

(2) Information concerning a patent application may be communicated to the public if the patent application is identified in a published patent document or in an application as set forth in paragraphs (a)(1)(i) through (a)(1)(vi) of this section. The information that may be communicated to the public (*i.e.*, status information) includes:

(i) Whether the application is pending, abandoned, or patented;

(ii) Whether the application has been published under 35 U.S.C. 122(b);

(iii) The application "numerical identifier" which may be:

(A) The eight-digit application number (the two-digit series code plus the six-digit serial number); or

(B) The six-digit serial number plus any one of the filing date of the national application,

the international filing date, or date of entry into the national stage; and

(iv) Whether another application claims the benefit of the application (*i.e.*, whether there are any applications that claim the benefit of the filing date under 35 U.S.C. 119(e), 120, 121, 365, or 386 of the application), and if there are any such applications, the numerical identifier of the application, the specified relationship between the applications (*e.g.*, continuation), whether the application is pending, abandoned or patented, and whether the application has been published under 35 U.S.C. 122(b).

(b) *Electronic access to an application.* Where a copy of the application file or access to the application may be made available pursuant to this section, the Office may at its discretion provide access to only an electronic copy of the specification, drawings, and file contents of the application.

(c) *Power to inspect a pending or abandoned application.* Access to an application may be provided to any person if the application file is available, and the application contains written authority (*e.g.*, a power to inspect) granting access to such person. The written authority must be signed by:

(1) The applicant;

(2) A patent practitioner of record;

(3) The assignee or an assignee of an undivided part interest;

(4) The inventor or a joint inventor; or

(5) A registered attorney or agent named in the papers accompanying the application papers filed under § 1.53 or the national stage documents filed under § 1.495, if a power of attorney has not been appointed under § 1.32.

(d) *Applications reported to Department of Energy.* Applications for patents which appear to disclose, purport to disclose or do disclose inventions or discoveries relating to atomic energy are reported to the Department of Energy, which Department will be given access to the applications. Such reporting does not constitute a determination that the subject matter of each application so reported is in fact useful or is an invention or discovery, or that such application in fact discloses subject matter in categories specified by 42 U.S.C. 2181(c) and (d).

(e) *Decisions by the Director.* Any decision by the Director that would not otherwise be open to public inspection may be published or made available for public inspection if:

(1) The Director believes the decision involves an interpretation of patent laws or regulations that would be of precedential value; and

(2) The applicant is given notice and an opportunity to object in writing within two months on the ground that the decision discloses a trade secret or other confidential information. Any objection must identify the deletions in the text of the decision considered necessary to protect the information, or explain why the entire decision must be withheld from the public to protect such information. An applicant or party will be given time, not less than twenty days, to request reconsideration and seek court review before any portions of a decision are made public under this paragraph over his or her objection.

(f) *Notice to inventor of the filing of an application.* The Office may publish notice in the *Official Gazette* as to the filing of an application on behalf of an inventor by a person who otherwise shows sufficient proprietary interest in the matter.

(g) *International applications.*

(1) Copies of international application files for international applications which designate the U.S. and which have been published in accordance with PCT Article 21(2), or copies of a document in such application files, will be furnished in accordance with PCT Articles 30 and 38 and PCT Rules 94.2 and 94.3, upon written request including a showing that the publication of the application has occurred and that the U.S. was designated, and upon payment of the appropriate fee (see § 1.19(b)), if:

(i) With respect to the Home Copy (the copy of the international application kept by the Office in its capacity as the Receiving Office, see PCT Article 12(1)), the international application was filed with the U.S. Receiving Office;

(ii) With respect to the Search Copy (the copy of an international application kept by the Office in its capacity as the International Searching Authority, see PCT Article 12(1)), the U.S. acted as the International Searching Authority, except for

the written opinion of the International Searching Authority which shall not be available until the expiration of thirty months from the priority date; or

(iii) With respect to the Examination Copy (the copy of an international application kept by the Office in its capacity as the International Preliminary Examining Authority), the United States acted as the International Preliminary Examining Authority, an International Preliminary Examination Report has issued, and the United States was elected.

(2) A copy of an English language translation of a publication of an international application which has been filed in the United States Patent and Trademark Office pursuant to 35 U.S.C. 154(d)(4) will be furnished upon written request including a showing that the publication of the application in accordance with PCT Article 21(2) has occurred and that the U.S. was designated, and upon payment of the appropriate fee (§ 1.19(b)(4)).

(3) Access to international application files for international applications which designate the U.S. and which have been published in accordance with PCT Article 21(2), or copies of a document in such application files, will be permitted in accordance with PCT Articles 30 and 38 and PCT Rules 44 *ter*.1, 94.2 and 94.3, upon written request including a showing that the publication of the application has occurred and that the U.S. was designated.

(4) In accordance with PCT Article 30, copies of an international application-as-filed under paragraph (a) of this section will not be provided prior to the international publication of the application pursuant to PCT Article 21(2).

(5) Access to international application files under paragraphs (a)(1)(i) through (a)(1)(vi) and (g)(3) of this section will not be permitted with respect to the Examination Copy in accordance with PCT Article 38.

(h) *Access by a Foreign Intellectual Property Office.*

(1) Access to an application-as-filed may be provided to any foreign intellectual property office participating with the Office in a bilateral or multilateral priority document exchange agreement (participating foreign intellectual property office), if the application contains written authority granting such access. Written authority provided under this paragraph (h)(1) will be treated as authorizing the Office to provide the following to all participating foreign intellectual property offices in accordance with their respective agreements with the Office:

(i) A copy of the application-as-filed and its related bibliographic data;

(ii) A copy of the application-as-filed of any application the filing date of which is claimed by the application in which written authority under this paragraph (h)(1) is filed and its related bibliographic data; and

(iii) The date of filing of the written authorization under this paragraph (h)(1).

(2) Access to the file contents of an application may be provided to a foreign intellectual property office that has imposed a requirement for information on a counterpart application filed with the foreign intellectual property office where the foreign intellectual property office is a party to a bilateral or multilateral agreement with the Office to provide the required information from the application filed with the Office and the application contains written authority granting such access. Written authority provided under this paragraph (h)(2) will be treated as authorizing the Office to provide the following to all foreign intellectual property offices in accordance with their respective agreements with the Office:

(i) Bibliographic data related to the application; and

(ii) Any content of the application file necessary to satisfy the foreign intellectual property office requirement for information imposed on the counterpart application as indicated in the respective agreement.

(3) Written authority provided under paragraphs (h)(1) and (h)(2) of this section must include the title of the invention (§ 1.72(a)), comply with the requirements of paragraph (c) of this section, and be submitted on an application data sheet (§ 1.76) or on a separate document (§ 1.4(c)). The written authority provided under these paragraphs should be submitted before filing any subsequent foreign application in which priority is claimed to the application.

(i) *Access or copies in other circumstances.* The Office, either *sua sponte* or on petition, may

also provide access or copies of all or part of an application if necessary to carry out an Act of Congress or if warranted by other special circumstances. Any petition by a member of the public seeking access to, or copies of, all or part of any pending or abandoned application preserved in confidence pursuant to paragraph (a) of this section, or any related papers, must include:

(1) The fee set forth in § 1.17(g); and

(2) A showing that access to the application is necessary to carry out an Act of Congress or that special circumstances exist which warrant petitioner being granted access to all or part of the application.

(j) *International design applications.*

(1) With respect to an international design application maintained by the Office in its capacity as a designated office (§ 1.1003) for national processing, the records associated with the international design application may be made available as provided under paragraphs (a) through (i) of this section.

(2) With respect to an international design application maintained by the Office in its capacity as an office of indirect filing (§ 1.1002), the records of the international design application may be made available under paragraph (j)(1) of this section where contained in the file of the international design application maintained by the Office for national processing. Also, if benefit of the international design application is claimed under 35 U.S.C. 386(c) in a U.S. patent or published application, the file contents of the application may be made available to the public, or the file contents of the application, a copy of the application-as-filed, or a specific document in the file of the application may be provided to any person upon written request and payment of the appropriate fee (§ 1.19(b)).

[42 FR 5593, Jan. 28, 1977; 43 FR 20462, May 11, 1978; para. (e) added, 47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; para. (b), 49 FR 552, Jan. 4, 1984, effective Apr. 1, 1984; para. (d), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (b), 50 FR 9378, Mar. 7, 1985, effective May 8, 1985; 53 FR 23733, June 23, 1988; para. (e), 54 FR 6893, Feb. 15, 1989, effective Apr. 17, 1989; para. (b) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; para. (e) amended, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; paras. (a), (b) and (e) amended, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; para. (a) revised & para. (f) added, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (g) added, 63 FR 29614, June 1, 1998, effective July 1, 1998, (adopted as final, 63 FR 66040, Dec. 1, 1998); revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a), (b), (c), (e), (i) and (j) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para (h) corrected, 65 FR 78958, Dec. 18, 2000; para.(i)(2) revised, 66 FR 67087, Dec. 28, 2001, effective Dec. 28, 2001; para. (d)(4) revised, 67 FR 520, Jan. 4, 2002, effective Apr. 1, 2002; paras. (g) & (g)(1) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; revised, 68 FR 38611, June 30, 2003, effective July 30, 2003; paras. (g)(1)(ii) & (g)(3) revised, 68 FR 59881, Oct. 20, 2003, effective Jan. 1, 2004; para. (g)(1)(ii) corrected, 68 FR 67805, Dec., 4, 2003; para. (g)(5) revised, 68 FR 67805, Dec. 4, 2003, effective Jan. 1, 2004; para. (g)(2) revised, 68 FR 70996, Dec. 22, 2003, effective Jan. 21, 2004; para. (e) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (h)(1) revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004; paras. (a)(1)(iii), (a)(1)(v), (a)(1)(vi), (a)(1)(vii), (a)(2) introductory text, & (b) revised, para. (h) redesignated as para. (i) and para. (h) added, 72 FR 1664, Jan. 16, 2007, effective Jan. 16, 2007; paras. (c) and (f) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012; para.(f) revised, 78 FR 11024, Feb. 14, 2013, effective Mar. 16, 2013; paras. (a)(1)(ii)-(vii) and (a)(2)(iv) revised and para. (j) added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015; para (h) revised, 80 FR 65649, Oct. 27, 2015, effective Nov. 30, 2015]

[*The changes to paras. (c) and (f) effective Sept. 16, 2012 are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012. See § 1.14 (pre-AIA) for paras. (c) and (f) otherwise in effect.]

§ 1.14 (pre-AIA) Patent applications preserved in confidence.

[Editor Note: Applicable to patent applications filed before September 16, 2012*]

* * * * *

(c) *Power to inspect a pending or abandoned application.* Access to an application may be provided to any person if the application file is available, and the application contains written authority (*e.g.*, a power to inspect) granting access to such person. The written authority must be signed by:

(1) An applicant;

(2) An attorney or agent of record;

(3) An authorized official of an assignee of record (made of record pursuant to § 3.71 of this chapter); or

(4) A registered attorney or agent named in the papers accompanying the application papers filed under § 1.53 or the national stage documents filed under § 1.495, if an executed oath or declaration pursuant to § 1.63 or § 1.497 has not been filed.

* * * * *

(f) *Publication pursuant to § 1.47.* Information as to the filing of an application will be published in the *Official Gazette* in accordance with § 1.47(c).

* * * * *

[*See § 1.14 for the current rule, including the portions of the rule not reproduced above and applicable irrespective of the filing date of the application]

§ 1.15 [Reserved]

[32 FR 13812, Oct. 4, 1967; 34 FR 18857, Nov. 26, 1969; amended 53 FR 47685, Nov. 25, 1988, effective Dec. 30, 1988; removed and reserved, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

FEES AND PAYMENT OF MONEY

§ 1.16 National application filing, search, and examination fees.

[Editor Note: The amendment adding paragraph (u) is effective on January 1, 2022]

(a) Basic fee for filing each application under 35 U.S.C. 111 for an original patent, except design, plant, or provisional applications:

TABLE 1 TO PARAGRAPH (a)

By a micro entity (§ 1.29).....$80.00

By a small entity (§ 1.27(a)).....160.00

By a small entity (§ 1.27(a)) if the application is submitted in compliance with the Office electronic filing system (§ 1.27(b)(2)).....80.00

By other than a small or micro entity.....320.00

(b) Basic fee for filing each application under 35 U.S.C. 111 for an original design patent:

TABLE 2 TO PARAGRAPH (b)

By a micro entity (§ 1.29).....$55.00

By a small entity (§ 1.27(a)).....110.00

By other than a small or micro entity.....220.00

(c) Basic fee for filing each application for an original plant patent:

TABLE 3 TO PARAGRAPH (c)

By a micro entity (§ 1.29).....$55.00

By a small entity (§ 1.27(a)).....110.00

By other than a small or micro entity.....220.00

(d) Basic fee for filing each provisional application:

TABLE 4 TO PARAGRAPH (d)

By a micro entity (§ 1.29).....$75.00

By a small entity (§ 1.27(a)).....150.00

By other than a small or micro entity.....300.00

(e) Basic fee for filing each application for the reissue of a patent:

TABLE 5 TO PARAGRAPH (e)

By a micro entity (§ 1.29).....$80.00

By a small entity (§ 1.27(a)).....160.00

By other than a small or micro entity.....320.00

(f) Surcharge for filing the basic filing fee, search fee, examination fee, or the inventor's oath or declaration on a date later than the filing date of the application, an application that does not contain at least one claim on the filing date of the application, or an application filed by reference to a previously filed application under § 1.57(a), except provisional applications:

TABLE 6 TO PARAGRAPH (f)

By a micro entity (§ 1.29).....$40.00

By a small entity (§ 1.27(a)).....80.00

By other than a small or micro entity.....160.00

(g) Surcharge for filing the basic filing fee or cover sheet (§ 1.51(c)(1)) on a date later than the filing date of the provisional application:

TABLE 7 TO PARAGRAPH (g)

By a micro entity (§ 1.29).....$15.00

By a small entity (§ 1.27(a)).....30.00

By other than a small or micro entity...60.00

(h) In addition to the basic filing fee in an application, other than a provisional application, for filing or later presentation at any other time of each claim in independent form in excess of 3:

TABLE 8 TO PARAGRAPH (h)

By a micro entity (§ 1.29).....$120.00

By a small entity (§ 1.27(a)).....240.00

By other than a small or micro entity.....480.00

(i) In addition to the basic filing fee in an application, other than a provisional application, for filing or later presentation at any other time of each claim (whether dependent or independent) in excess of 20 (note that § 1.75(c) indicates how multiple dependent claims are considered for fee calculation purposes):

TABLE 9 TO PARAGRAPH (i)

By a micro entity (§ 1.29).....$25.00

By a small entity (§ 1.27(a)).....50.00

By other than a small or micro entity.....100.00

(j) In addition to the basic filing fee in an application, other than a provisional application, that contains, or is amended to contain, a multiple dependent claim, per application:

TABLE 10 TO PARAGRAPH (j)

By a micro entity (§ 1.29).....$215.00

By a small entity (§ 1.27(a)).....430.00

By other than a small or micro entity.....860.00

(k) Search fee for each application filed under 35 U.S.C. 111 for an original patent, except design, plant, or provisional applications:

TABLE 11 TO PARAGRAPH (k)

By a micro entity (§ 1.29).....$175.00

By a small entity (§ 1.27(a)).....350.00

By other than a small or micro entity.....700.00

(l) Search fee for each application under 35 U.S.C. 111 for an original design patent:

TABLE 12 TO PARAGRAPH (l)

By a micro entity (§ 1.29).....$40.00

By a small entity (§ 1.27(a)).....80.00

By other than a small or micro entity.....160.00

(m) Search fee for each application for an original plant patent:

TABLE 13 TO PARAGRAPH (m)

By a micro entity (§ 1.29).....$110.00

By a small entity (§ 1.27(a)).....220.00

By other than a small or micro entity.....440.00

(n) Search fee for each application for the reissue of a patent:

TABLE 14 TO PARAGRAPH (n)

By a micro entity (§ 1.29).....$175.00

By a small entity (§ 1.27(a)).....350.00

By other than a small or micro entity.....700.00

(o) Examination fee for each application filed under 35 U.S.C. 111 for an original patent, except design, plant, or provisional applications:

TABLE 15 TO PARAGRAPH (o)

By a micro entity (§ 1.29).....$200.00

By a small entity (§ 1.27(a)).....400.00

By other than a small entity.....800.00

(p) Examination fee for each application under 35 U.S.C. 111 for an original design patent:

TABLE 16 TO PARAGRAPH (p)

By a micro entity (§ 1.29).....$160.00

By a small entity (§ 1.27(a)).....320.00

By other than a micro or small entity.....640.00

(q) Examination fee for each application for an original plant patent:

TABLE 17 TO PARAGRAPH (q)

By a micro entity (§ 1.29).....$165.00

By a small entity (§ 1.27(a)).....330.00

By other than a small or micro entity.....660.00

(r) Examination fee for each application for the reissue of a patent:

TABLE 18 TO PARAGRAPH (r)

By a micro entity (§ 1.29).....$580.00

By a small entity (§ 1.27(a)).....1,160.00

By other than a small or micro entity.....2,320.00

(s) Application size fee for any application filed under 35 U.S.C.111 for the specification and drawings which exceed 100 sheets of paper, for each additional 50 sheets or fraction thereof:

TABLE 19 TO PARAGRAPH (s)

By a micro entity (§ 1.29).....$105.00

By a small entity (§ 1.27(a)).....210.00

By other than a small or micro entity.....420.00

(t) Non-electronic filing fee for any application under 35 U.S.C. 111(a) that is filed on or after November 15, 2011, other than by the Office electronic filing system, except for a reissue, design, or plant application:

TABLE 20 TO PARAGRAPH (t)

By a small entity (§ 1.27(a)).....$200.00

By other than a small entity.....$400.00

(u) Additional fee for any application filed on or after January 1, 2022 under 35 U.S.C. 111 for an original patent, except design, plant, or provisional applications, where the specification, claims, and/or abstract does not conform to the USPTO requirements for submission in DOCX format:

TABLE 21 TO PARAGRAPH (u)

By a micro entity (§ 1.29).....$100.00

By a small entity (§ 1.27(a)).....200.00

By a small entity (§ 1.27(a)) if the application is submitted in compliance with the Office electronic filing system (§ 1.27(b)(2)).....200.00

By other than a small or micro entity.....400.00

[Added, 47 FR 41272, Sept. 17, 1982, effective date Oct. 1, 1982; 50 FR 31824, Aug. 6, 1985, effective date Oct. 5, 1985; paras. (a), (b), (d)-(i), 54 FR 6893, Feb. 15, 1989, effective Apr. 17, 1989; paras. (a)-(j), 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; paras. (a)-(d) and (f)-(j), 57 FR 38190, Aug. 21, 1992, effective Oct. 1, 1992; paras. (a), (b), (d) and (f)-(i), 59 FR 43736, Aug. 25, 1994, effective Oct. 1, 1994; paras. (a)-(g) amended and paras. (k) and (l) added, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; paras. (a), (b), (d), & (f)-(i) amended, 60 FR 41018, Aug. 11, 1995, effective Oct. 1, 1995; paras. (a), (b), (d), and (f)-(i) amended and para. (m) added, 61 FR 39585, July 30, 1996, effective Oct. 1, 1996; paras. (a), (b), (d), and (f)-(i) amended, 62 FR 40450, July 29, 1997, effective Oct. 1, 1997; paras. (d) & (l) amended, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a)-(d) and (f)-(j) revised, 63 FR 6758, Dec. 8, 1998, effective Nov. 10, 1998; paras. (a) and (b) revised, 64 FR 67774, Dec. 3, 1999, effective Dec. 29, 1999; paras. (a), (b), (d), and (f)-(i) revised, 65 FR 49193, Aug. 11, 2000, effective Oct. 1, 2000; paras. (a)-(l) revised, 65 FR 78958, Dec. 18, 2000; paras. (a), (b), (d), (f)-(i) and (k) revised, 66 FR 39447, July 31, 2001, effective Oct. 1, 2001; paras. (a), (g), and (h) revised, 67 FR 70847, Nov. 27, 2002, effective Jan. 1, 2003; paras. (a), (b), (d), and (f)-(i) revised, 68 FR 41532, July 14, 2003, effective Oct. 1, 2003; paras. (a), (b), (d), and (f)-(i) revised, 69 FR 52604, Aug. 27, 2004, effective Oct. 1, 2004; revised, 70 FR 3880, Jan. 27, 2005, effective Dec. 8, 2004; paras. (f) and (s) revised, 70 FR 30360, May 26, 2005, effective July 1, 2005; paras. (a)-(e) and (h)-(s) revised, 72 FR 46899, Aug. 22, 2007, effective Sept. 30, 2007; paras. (a)-(e), (h)-(k), and (m)-(s) revised, 73 FR 47534, Aug. 14, 2008, effective Oct. 2, 2008; para. (t) added, 76 FR 70651, Nov. 15, 2011, effective Nov. 15, 2011; para. (f) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012; paras. (a)-(e), (h)-(j), and (o)-(s) revised, 77 FR 54360, Sept. 5, 2012, effective Oct. 5, 2012; paras. (a)-(s) revised, 78 FR 4212, Jan. 18, 2013, effective Mar. 19, 2013; para. (f) revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013; introductory text of paras. (b), (l), and (p) revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015; paras. (a)-(f) and (h)-(r) revised, 82 FR 52780, Nov. 14, 2017, effective Jan. 16,

2018; paras. (a)-(e), (h), (j), (k), and (m)-(s) revised and table headings added to paras. (f), (g), (i), (l), and (t), 85 FR 46932, Aug. 3, 2020, effective Oct. 2, 2020; para. (u) added, 85 FR 46932, Aug. 3, 2020, effective Jan. 1, 2022]

§ 1.17 Patent application and reexamination processing fees.

(a) Extension fees pursuant to § 1.136(a):

(1) For reply within first month:

TABLE 1 TO PARAGRAPH (a)(1)

By a micro entity (§ 1.29).....$55.00

By a small entity (§ 1.27(a)).....110.00

By other than a small or micro entity.....220.00

(2) For reply within second month:

TABLE 2 TO PARAGRAPH (a)(2)

By a micro entity (§ 1.29).....$160.00

By a small entity (§ 1.27(a)).....320.00

By other than a small or micro entity.....$640.00

(3) For reply within third month:

TABLE 3 TO PARAGRAPH (a)(3)

By a micro entity (§ 1.29).....$370.00

By a small entity (§ 1.27(a)).....740.00

By other than a small or micro entity.....1,480.00

(4) For reply within fourth month:

TABLE 4 TO PARAGRAPH (a)(4)

By a micro entity (§ 1.29).....$580.00

By a small entity (§ 1.27(a)).....1,160.00

By other than a small or micro entity.....$2,320.00

(5) For reply within fifth month:

TABLE 5 TO PARAGRAPH (a)(5)

By a micro entity (§ 1.29).....$790.00

By a small entity (§ 1.27(a)).....1,580.00

By other than a small or micro entity.....3,160.00

(b) For fees in proceedings before the Patent Trial and Appeal Board, *see* § 41.20 and § 42.15 of this title.

(c) For filing a request for prioritized examination under § 1.102(e):

TABLE 6 TO PARAGRAPH (c)

By a micro entity (§ 1.29).....$1,050.00

By a small entity (§ 1.27(a)).....2,100.00

By other than a small or micro entity 4,200.00

(d) For correction of inventorship in an application after the first action on the merits:

TABLE 7 TO PARAGRAPH (d)

By a micro entity (§ 1.29).....$160.00

By a small entity (§ 1.27(a)).....320.00

By other than a small or micro entity.....640.00

(e) To request continued examination pursuant to § 1.114:

(1) For filing a first request for continued examination pursuant to § 1.114 in an application:

TABLE 8 TO PARAGRAPH (e)(1)

By a micro entity (§ 1.29).....$340.00

By a small entity (§ 1.27(a)) 680.00

By other than a small or micro entity.....1,360.00

(2) For filing a second or subsequent request for continued examination pursuant to § 1.114 in an application:

TABLE 9 TO PARAGRAPH (e)(2)

By a micro entity (§ 1.29).....$500.00

By a small entity (§ 1.27(a)).....1,000.00

By other than a small or micro entity.....2,000.00

(f) For filing a petition under one of the following sections which refers to this paragraph (f):

TABLE 10 TO PARAGRAPH (f)

By a micro entity (§ 1.29).....$105.00

By a small entity (§ 1.27(a)).....210.00

By other than a small or micro entity.....420.00

§ 1.36(a)—for revocation of a power of attorney by fewer than all of the applicants.

§ 1.53(e)—to accord a filing date.

§ 1.182—for a decision on a question not specifically provided for in an application for a patent.

§ 1.183—to suspend the rules in an application for a patent.

§ 1.741(b)—to accord a filing date to an application under § 1.740 for an extension of a patent term.

§ 1.1023 —to review the filing date of an international design application.

(g) For filing a petition under one of the following sections which refers to this paragraph (g):

TABLE 11 TO PARAGRAPH (g)

By a micro entity (§ 1.29).....$55.00

By a small entity (§ 1.27(a)).....110.00

By other than a small or micro entity.....220.00

§ 1.12—for access to an assignment record.

§ 1.14—for access to an application.

§ 1.46—for filing an application on behalf of an inventor by a person who otherwise shows sufficient proprietary interest in the matter.

§ 1.55(f)—for filing a belated certified copy of a foreign application.

§ 1.55(g)—for filing a belated certified copy of a foreign application.

§ 1.57(a)—for filing a belated certified copy of a foreign application.

§ 1.59—for expungement of information.

§ 1.103(a)—to suspend action in an application.

§ 1.136(b)—for review of a request for extension of time when the provisions of § 1.136(a) are not available.

§ 1.377—for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.

§ 1.550(c)—for patent owner requests for extension of time in *ex parte* reexamination proceedings.

§ 1.956—for patent owner requests for extension of time in *inter partes* reexamination proceedings.

§ 5.12 of this chapter—for expedited handling of a foreign filing license.

§ 5.15 of this chapter—for changing the scope of a license.

§ 5.25 of this chapter—for a retroactive license.

(h) For filing a petition under one of the following sections that refers to this paragraph (h):

TABLE 12 TO PARAGRAPH (h)

By a micro entity (§ 1.29).....$35.00

By a small entity (§ 1.27(a)).....70.00

By other than a small or micro entity.....140.00

§ 1.84—for accepting color drawings or photographs.

§ 1.91—for entry of a model or exhibit.

§ 1.102(d)—to make an application special.

§ 1.138(c)—to expressly abandon an application to avoid publication.

§ 1.313—to withdraw an application from issue.

§ 1.314—to defer issuance of a patent.

(i) *Processing fees.*

(1) For taking action under one of the following sections that refers to this paragraph (i)(1):

TABLE 13 TO PARAGRAPH (i)(1)

By a micro entity (§ 1.29).....$35.00

By a small entity (§ 1.27(a)).....70.00

By other than a small or micro entity.....140.00

§ 1.28(c)(3)—for processing a non-itemized fee deficiency based on an error in small entity status.

§ 1.29(k)(3)—for processing a non-itemized fee deficiency based on an error in micro entity status.

§ 1.41(b)—for supplying the name or names of the inventor or joint inventors in an application without either an application data sheet or the inventor's oath or declaration, except in provisional applications.

§ 1.48—for correcting inventorship, except in provisional applications.

§ 1.52(d)—for processing a nonprovisional application filed with a specification in a language other than English.

§ 1.53(c)(3)—t[*sic*] convert a provisional application filed under § 1.53(c) into a nonprovisional application under § 1.53(b).

§1.71(g)(2)—for processing a belated amendment under § 1.71(g).

§ 1.102(e)—for requesting prioritized examination of an application.

§ 1.103(b)—for requesting limited suspension of action, continued prosecution application for a design patent (§ 1.53(d)).

§ 1.103(c)—for requesting limited suspension of action, request for continued examination (§ 1.114).

§ 1.103(d)—for requesting deferred examination of an application.

§ 1.291(c)(5)—for processing a second or subsequent protest by the same real party in interest.

§ 3.81—for a patent to issue to assignee, assignment submitted after payment of the issue fee.

(2) For taking action under one of the following sections that refers to this paragraph (i)(2):

TABLE 14 TO PARAGRAPH (i)(2)

By a micro entity (§ 1.29.....$140.00

By a small entity (§ 1.27(a)).....140.00

By other than a small or micro entity.....140.00

§ 1.217—for processing a redacted copy of a paper submitted in the file of an application in which a redacted copy was submitted for the patent application publication.

§ 1.221—for requesting voluntary publication or republication of an application.

(j) [Reserved]

(k) For filing a request for expedited examination under § 1.155(a):

TABLE 15 TO PARAGRAPH (k)

By a micro entity (§ 1.29).....$400.00

By a small entity (§ 1.27(a)).....800.00

By other than a small or micro entity.....1,600.00

(l) [Reserved]

(m) For filing a petition for the revival of an abandoned application for a patent, for the delayed payment of the fee for issuing each patent, for the delayed response by the patent owner in any reexamination proceeding, for the delayed payment of the fee for maintaining a patent in force, for the delayed submission of a priority or benefit claim, for the extension of the 12-month (six-month for designs) period for filing a subsequent application (§§ 1.55(c) and (e), 1.78(b), (c), and (e); 1.137; 1.378; and 1.452), or for filing a petition to excuse applicant's failure to act within prescribed time limits in an international design application (§ 1.1051):

TABLE 16 TO PARAGRAPH (m)

By a micro entity (§ 1.29).....$525.00

By a small entity (§ 1.27(a)).....1,050.00

By other than a small or micro entity.....2,100.00

(n) [Reserved]

(o) For every ten items or fraction thereof in a third-party submission under § 1.290:

TABLE 17 TO PARAGRAPH (o)

By a small entity (§ 1.27(a)) or micro entity (§ 1.29).....$90.00

By other than a small entity.....$180.00

(p) For an information disclosure statement under § 1.97(c) or (d):

TABLE 18 TO PARAGRAPH (p)

By a micro entity (§ 1.29).....$65.00

By a small entity (§ 1.27(a)).....130.00

By other than a small or micro entity.....260.00

(q) Processing fee for taking action under one of the following sections that refers to this paragraph (q):.....$50.00.

§ 1.41—to supply the name or names of the inventor or inventors after the filing date without a cover sheet as prescribed by § 1.51(c)(1) in a provisional application.

§ 1.48—for correction of inventorship in a provisional application.

§ 1.53(c)(2) —to convert a nonprovisional application filed under § 1.53(b) to a provisional application under § 1.53(c).

(r) For entry of a submission after final rejection under § 1.129(a):

TABLE 19 TO PARAGRAPH (r)

By a micro entity (§ 1.29).....$220.00

By a small entity (§ 1.27(a)).....440.00

By other than a small or micro entity.....880.00

(s) For each additional invention requested to be examined under § 1.129(b):

TABLE 20 TO PARAGRAPH (s)

By a micro entity (§ 1.29).....$220.00

By a small entity (§ 1.27(a)).....440.00

By other than a small or micro entity.....880.00

(t) For filing a petition to convert an international design application to a design application under 35 U.S.C. chapter 16 (§ 1.1052):

TABLE 21 TO PARAGRAPH (t)

By a micro entity (§ 1.29).....$45.00

By a small entity (§ 1.27(a)).....90.00

By other than a small or micro entity.....180.00

[Added 47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; para. (h), 48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; para. (h), 49 FR 13461, Apr. 4, 1984, effective June 4, 1984; para. (h), 49 FR 34724, Aug. 31, 1984, effective Nov. 1, 1984; paras. (e), (g), (h) and (i), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; paras. (h), (n) and (c), 50 FR 9379, Mar. 7, 1985, effective May 8, 1985; 50 FR 31824, Aug. 6, 1985, effective Oct. 5, 1985; paras. (a)-(m), 54 FR 6893, Feb. 15, 1989, 54 FR 9431, March 7, 1989, effective Apr. 17, 1989; para. (i)(1), 54 FR 47518, Nov. 15, 1989, effective Jan. 16, 1990; paras. (a)-(o), 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; para. (i)(1), 57 FR 2021, Jan. 17, 1992, effective March 16, 1992; para. (p) added, 57 FR 2021, Jan. 17, 1992, effective March 16, 1992; para. (i)(1), 57 FR 29642, July 6, 1992, effective Sept. 4, 1992; corrected 57 FR 32439, July 22, 1992; paras. (b)-(g), (j), and (m)-(o), 57 FR 38190, Aug. 21, 1992, effective Oct. 1, 1992; para. (h), 58 FR 38719, July 20, 1993, effective Oct. 1, 1993; paras. (b)-(g), (j) and (m)-(p), 59 FR 43736, Aug. 25, 1994, effective Oct. 1, 1994; paras. (h) & (i) amended and paras. (q)-(s) added, 67 FR 20195, Apr. 25, 1995, effective June 8, 1995; paras. (b)-(g), (j), (m)-(p), (r) & (s) amended, 60 FR 41018, Aug. 11, 1995, effective Oct. 1, 1995; paras. (b)-(g), (j), (m)-(p), (r) and (s) amended, 61 FR 39585, July 30, 1996, effective Oct. 1, 1996; paras. (b)-(g), (j), (m)-(p), (r) & (s) amended, 62 FR 40450, July 29, 1997, effective Oct. 1, 1997; paras. (a) - (d), (h), (i) & (q) revised, paras. (e)-(g) reserved, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (q) corrected, 62 FR 61235, Nov. 17, 1997, effective Dec. 1, 1997; paras. (a)-(d), (l) and (m) revised, 63 FR 67578, Dec. 8, 1998, effective Nov. 10, 1998; paras. (r) and (s) revised, 63 FR 67578, Dec. 8, 1998, effective Dec. 8, 1998; paras. (r) and (s) revised, 64 FR 67774, Dec. 3, 1999, effective Jan. 10, 2000; para. (e) added and para. (i) revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); paras. (a)-(e), (m), (r) and (s) revised, 65 FR 49193, August 11, 2000, effective October 1, 2000; paras. (h), (i), (k), (l), (m), (p), and (q) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; heading and paras. (h), (i), (l), (m) and (p) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para. (t) added, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; paras. (a)-(e), (r) and (s) revised, 65 FR 78958, Dec. 18, 2000; heading and para. (h) revised, 66 FR 47387, Sept. 12, 2001, effective Sept. 12, 2001; paras. (a)(2)-(a)(5), (b)-(e), (m) and (r)-(t) revised, 66 FR 39447, July 31, 2001, effective Oct. 1, 2001; paras. (a)(2)-(a)(5), (e), (m), and (r) through (t) revised, 67 FR 70847, Nov. 27, 2002, effective Jan. 1, 2003; para. (h) revised, 68 FR 38611, June 30, 2003, effective July 30, 2003; paras. (a)(2)-(a)(5), (b)-(e), (m), and (r)-(t) revised, 68 FR 41532, July 14, 2003, effective Oct. 1, 2003; paras. (c) and (d) removed and reserved and paras. (b) and (h) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; paras. (a)(2)-(a)(5), (e), (m), and (r)-(t) revised, 69 FR 52604, Aug. 27, 2004, effective Oct. 1, 2004; paras. (f) and (g) added and paras. (h) and (i) revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004; paras. (a), (l) and (m) revised, 70 FR 3880, Jan. 27, 2005, effective Dec. 8, 2004; para. (i) revised, 70 FR 54259, Sept. 14, 2005, effective Sept. 14, 2005; para. (f) revised, 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005; paras. (l) & (m) revised, 72 FR 18892, Apr. 16, 2007, effective May 16, 2007; paras. (a)(2)-(a)(5), (e), (l), (m), and (r)-(t) revised, 72 FR 46899, Aug. 22, 2007, effective Sept. 30, 2007; paras. (a)(4) and (a)(5) corrected, 72 FR 55055, Sept. 28, 2007, effective Sept. 30, 2007; para. (f) revised, 72 FR 46716, Aug. 21, 2007 (implementation enjoined and never became effective); para. (t) revised, 72 FR 51559, Sept. 10, 2007, and corrected 72 FR 57864, Oct. 11, 2007, effective Nov. 9, 2007; paras. (a), (l), and (m) revised, 73 FR 47534, Aug. 14, 2008, effective Oct. 2, 2008; para. (f) revised, 74 FR 52686, Oct. 14, 2009, effective Oct.

14, 2009 (to remove changes made by the final rules in 72 FR 46716 from the CFR); para. (c) added and para. (i) revised, 76 FR 18399, Apr. 4, 2011, effective date delayed until further notice, 76 FR 23876, Apr. 29, 2011 and withdrawn effective Sept. 23, 2011, 76 FR 59050, Sept. 23, 2011; para. (c) added and para. (i) revised, 76 FR 59050, Sept. 23, 2011, effective Sept. 26, 2011; para. (j) removed and reserved and para. (p) revised, 77 FR 42150, July 17, 2012, effective Sept. 16, 2012; para. (b) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012; paras. (g) and (i) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012; paras. (a), (l), and (m) revised, 77 FR 54360, Sept. 5, 2012, effective Oct. 5, 2012; paras.(g) and (i) revised and paras. (n) and (o) removed and reserved, 78 FR 11024, Feb. 14, 2013, effective Mar. 16, 2013; paras. (a)-(i), (k)-(m), and (p)-(t) revised, 78 FR 4212, Jan. 18, 2013, effective Mar. 19, 2013; revised, 78 FR 17102, Mar. 20, 2013, effective Mar. 20, 2013; paras. (f), (g), (m), and (p) revised, para. (o) added and paras. (l) and (t) removed and reserved, 78 FR 62368, Oct. 21, 2013, corrected 78 FR 75251, Dec. 11, 2013, effective Dec. 18, 2013; paras. (f), (g), (i)(1) and (m) revised and para. (t) added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015; paras. (e), (h), (m), (p) and (t) revised, 82 FR 52780, Nov. 14, 2017, effective Jan. 16, 2018; paras. (a), (c)-(h), (i)(1), (i)(2), (k), (m), and (p)-(s) revised and table headings added to paras. (o) and (t), 85 FR 46932, Aug. 3, 2020, effective Oct. 2, 2020; paras. (a)(2), (f), (g), (i)(2), and (q) corrected, 85 FR 58282, Sept. 18, 2020, effective Oct. 2, 2020]

§ 1.18 Patent post allowance (including issue) fees.

(a) Issue fee for issuing each original patent, except a design or plant patent, or for issuing each reissue patent:

TABLE 1 TO PARAGRAPH (a)

By a micro entity (§ 1.29).....$300.00

By a small entity (§ 1.27(a)).....600.00

By other than a small or micro entity.....1,200.00

(b)(1) Issue fee for issuing an original design patent:

TABLE 2 TO PARAGRAPH (b)(1)

By a micro entity (§ 1.29).....$185.00

By a small entity (§ 1.27(a)).....370.00

By other than a small or micro entity.....740.00

(2) [Reserved]

(3) Issue fee for issuing an international design application designating the United States, where the issue fee is paid through the International Bureau (Hague Agreement Rule 12(3)(c)) as an alternative to paying the issue fee under paragraph (b)(1) of this section: The amount established in Swiss currency pursuant to Hague Agreement Rule 28 as of the date of mailing of the notice of allowance (§ 1.311).

(c) Issue fee for issuing an original plant patent:

TABLE 3 TO PARAGRAPH (c)

By a micro entity (§ 1.29).....$210.00

By a small entity (§ 1.27(a)).....420.00

By other than a small or micro entity.....840.00

(d)

(1) Publication fee on or after January 1, 2014.....$0.00

(2) Publication fee before January 1, 2014.....300.00

(3) Republication fee (§ 1.221(a)).....$320.00

(e) For filing an application for patent term adjustment under § 1.705.....210.00

(f) For filing a request for reinstatement of all or part of the term reduced pursuant to § 1.704(b) in an application for a patent term adjustment under § 1.705.....420.00

[Added, 47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; 50 FR 31824, Aug. 6, 1985, effective Oct. 5, 1985; revised, 54 FR 6893, Feb. 15, 1989, effective Apr. 17, 1989; revised, 56 FR 65142, Dec. 13. 1991, effective Dec. 16, 1991; paras. (a)-(c), 57 FR 38190, Aug. 21, 1992, effective Oct. 1, 1992; revised, 59 FR 43736, Aug. 25, 1994, effective Oct. 1, 1994; amended, 60 FR 41018, Aug. 11, 1995, effective Oct. 1, 1995; amended, 61 FR 39585, July 30, 1996, effective Oct. 1, 1996; amended, 62 FR 40450, July 29, 1997, effective Oct. 1, 1997; amended, 63 FR 67578, Dec. 8, 1998, effective Nov. 10, 1998; revised, 65 FR 49193, Aug. 11, 2000, effective Oct. 1, 2000; heading revised and paras. (d)-(f) added, 65 FR 56366, Sept. 18, 2000, effective Nov. 17, 2000; para. (d) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; paras. (a)-(c) revised, 65 FR 78958, Dec. 18, 2000; paras. (a)-(c) revised, 66 FR 39447, July 31, 2001, effective Oct. 1, 2001; paras. (a)-(c) revised, 67 FR 70847, Nov. 27, 2002, effective Jan. 1,

2003; paras. (a)-(c) revised, 68 FR 41532, July 14, 2003, effective Oct. 1, 2003; paras. (a)-(c) revised, 69 FR 52604, Aug. 27, 2004, effective Oct. 1, 2004; paras. (a)-(c) revised, 70 FR 3880, Jan. 27, 2005, effective Dec. 8, 2004; paras. (a)-(c) revised, 72 FR 46899, Aug. 22, 2007, effective Sept. 30, 2007; paras. (a)-(c) revised, 73 FR 47534, Aug. 14, 2008, effective Oct. 2, 2008; paras. (a)-(c) revised, 77 FR 54360, Sept. 5, 2012, effective Oct. 5, 2012; revised, 78 FR 4212, Jan. 18, 2013, effective Mar. 19, 2013; para. (b)(3) added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015; paras. (a)-(c) revised, 82 FR 52780, Nov. 14, 2017, effective Jan. 16, 2018; paras. (a), (b)(1), (c), (d)(3), (e), and (f) revised, 85 FR 46932, Aug. 3, 2020, effective Oct. 2, 2020; paras. (d)(3), (e), and (f) corrected, 85 FR 58282, Sept. 18, 2020, effective Oct. 2, 2020]

§ 1.19 Document supply fees.

The United States Patent and Trademark Office will supply copies of the following patent-related documents upon payment of the fees indicated. Paper copies will be in black and white unless the original document is in color, a color copy is requested and the fee for a color copy is paid.

(a) Uncertified copies of patent application publications and patents:

(1) Printed copy of the paper portion of a patent application publication or patent, including a design patent, statutory invention registration, or defensive publication document. Service includes preparation of copies by the Office within two to three business days and delivery by United States Postal Service; and preparation of copies by the Office within one business day of receipt and delivery to an Office Box or by electronic means (*e.g.,* facsimile, electronic mail):.....$3.00.

(2) Printed copy of a plant patent in color:.....$15.00.

(3) Color copy of a patent (other than a plant patent) or statutory invention registration containing a color drawing:..... $25.00.

(b) Copies of Office documents to be provided in paper, or in electronic form, as determined by the Director (for other patent-related materials *see* § 1.21(k)):

(1) Copy of a patent application as filed, or a patent-related file wrapper and contents, stored in paper in a paper file wrapper, in an image format in an image file wrapper, or if color documents, stored in paper in an Artifact Folder:

(i) If provided on paper:

(A) Application as filed: .....$35.00.

(B) Copy Patent File Wrapper, Any Number of Sheets:.....$290.00

(C) [Reserved]

(D) Individual application documents, other than application as filed, per document:.....$25.00.

(ii) If provided on compact disc or other physical electronic medium in single order or if provided electronically (*e.g.,* by electronic transmission) other than on a physical electronic medium:

(A) Application as filed:.....$35.00.

(B) Copy Patent File Wrapper, Electronic, Any Size:.....$60.00

(C) [Reserved]

(iii) [Reserved]

(iv) If provided to a foreign intellectual property office pursuant to a bilateral or multilateral agreement (*see* § 1.14(h)):.....$0.00.

(2) [Reserved]

(3) Copy of Office records, except copies available under paragraph (b)(1) or (2) of this section:.....$25.00.

(4) For assignment records, abstract of title and certification, per patent:.....$35.00.

(c) Library service (35 U.S.C. 13): For providing to libraries copies of all patents issued annually, per annum:..... $50.00.

(d) [Reserved]

(e) [Reserved]

(f) Uncertified copy of a non-United States patent document, per document:.....$25.00.

(g) [Reserved]

(h) Copy of Patent Grant Single-Page TIFF Images (52 week subscription):.....$10,400.00.

(i) Copy of Patent Grant Full-Text W/ Embedded Images, Patent Application Publication Single-Page TIFF Images, or Patent Application Publication

Full-Text W/Embedded Images (52 week subscription):.....$5,200.00.

[Added 47 FR 41272, Sept. 17, 1982, effective date Oct. 1, 1982; para. (b), 49 FR 552, Jan. 4, 1984, effective date Apr. 1, 1984; paras. (f) and (g) added, 49 FR 34724, Aug. 31, 1984, effective date Nov. 1, 1984; paras. (a) and (c), 50 FR 9379, Mar. 7, 1985, effective date May 8,1985; 50 FR 31825, Aug. 6, 1985, effective date Oct. 5, 1985; revised, 54 FR 6893, Feb. 15, 1989; 54 FR 9432, March 7, 1989, effective Apr. 17, 1989, revised 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; paras. (b)(4), (f) and (h), 57 FR 38190, Aug. 21, 1992, effective Oct.1, 1992; para. (a)(3), 58 FR 38719, July 20, 1993, effective Oct. 1, 1993; paras. (a)(1)(ii), (a)(1)(iii), (b)(1)(i), & (b)(1)(ii) amended, 60 FR 41018, Aug. 11, 1995, effective Oct. 1, 1995; paras. (a)(2) and (a)(3) amended, 62 FR 40450, July 29, 1997, effective Oct. 1, 1997; paras. (a)(1)(i) through (a)(1)(iii) revised, 64 FR 67486, Dec. 2, 1999, effective Dec. 2, 1999; introductory text and paras. (a) and (b) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (g) and (h) removed and reserved, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; paras. (a)(1) and (b)(1) revised, 67 FR 70847, Nov. 27, 2002, effective Jan. 1, 2003; introductory text and para. (b) revised and para. (g) added, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004; para. (b)(1)(iv) added, 72 FR 1664, Jan. 16, 2007, effective Jan. 16, 2007; revised, 78 FR 4212, Jan. 18, 2013, effective Mar. 19, 2013; para. (b)(1)(iv) revised, 80 FR 65649, Oct. 27, 2015, effective Nov. 30, 2015; para. (b) revised, paras. (d), (e) and (g) removed and reserved, and paras. (h)-(l) added, 82 FR 52780, Nov. 14, 2017, effective Jan. 16, 2018; paras. (b)(1)(i)(B) and (b)(1)(ii)(B) revised and paras. (j)-(l) removed, 85 FR 46932, Aug. 3, 2020, effective Oct. 2, 2020]

§ 1.20 Post-issuance fees.

(a) For providing a certificate of correction for applicant's mistake (§ 1.323):.....$160.00

(b) Processing fee for correcting inventorship in a patent (§ 1.324):.....$160.00

(c) In reexamination proceedings:

(1)(i) For filing a request for *ex parte* reexamination (§ 1.510(a)) having:

(A) 40 or fewer pages;

(B) Lines that are double-spaced or one-and-a-half spaced;

(C) Text written in a non-script type font such as Arial, Times New Roman, or Courier;

(D) A font size no smaller than 12 point;

(E) Margins that conform to the requirements of § 1.52(a)(1)(ii); and

(F) Sufficient clarity and contrast to permit direct reproduction and electronic capture by use of digital imaging and optical character recognition.

TABLE 1 TO PARAGRAPH (c)(1)(i)

By a micro entity (§ 1.29)..$1,575.00

By a small entity (§ 1.27(a)).....3,150.00

By other than a small or micro entity.....6,300.00

(ii) The following parts of an *ex parte* reexamination request are excluded from paragraphs (c)(1)(i)(A) through (F) of this section:

(A) The copies of every patent or printed publication relied upon in the request pursuant to § 1.510(b)(3);

(B) The copy of the entire patent for which reexamination is requested pursuant to § 1.510(b)(4); and

(C) The certifications required pursuant to § 1.510(b)(5) and (6).

(2) For filing a request for *ex parte* reexamination (§ 1.510(b)) that has sufficient clarity and contrast to permit direct reproduction and electronic capture by use of digital imaging and optical character recognition, and which otherwise does not comply with the provisions of paragraph (c)(1) of this section:

TABLE 2 TO PARAGRAPH (c)(2)

By a micro entity (§ 1.29).....$3,150.00

By a small entity (§ 1.27(a)).....6,300.00

By other than a small or micro entity.....12,600.00

(3) For filing with a request for reexamination or later presentation at any other time of each claim in independent form in excess of three

and also in excess of the number of claims in independent form in the patent under reexamination:

TABLE 3 TO PARAGRAPH (c)(3)

By a micro entity (§ 1.29).....$120.00

By a small entity (§ 1.27(a)).....240.00

By other than a small or micro entity 480.00

(4) For filing with a request for reexamination or later presentation at any other time of each claim (whether dependent or independent) in excess of 20 and also in excess of the number of claims in the patent under reexamination (note that § 1.75(c) indicates how multiple dependent claims are considered for fee calculation purposes):

TABLE 4 TO PARAGRAPH (c)(4)

By a micro entity (§ 1.29).....$25.00

By a small entity (§ 1.27(a)).....50.00

By other than a small or micro entity.....100.00

(5) If the excess claims fees required by paragraphs (c)(3) and (4) of this section are not paid with the request for reexamination or on later presentation of the claims for which the excess claims fees are due, the fees required by paragraphs (c)(3) and (4) must be paid or the claims canceled by amendment prior to the expiration of the time period set for reply by the Office in any notice of fee deficiency in order to avoid abandonment.

(6) For filing a petition in a reexamination proceeding, except for those specifically enumerated in §§ 1.550(i) and 1.937(d):

TABLE 5 TO PARAGRAPH (c)(6)

By a micro entity (§ 1.29).....$510.00

By a small entity (§ 1.27(a)).....1,020.00

By other than a small or micro entity.....2,040.00

(7) For a refused request for *ex parte* reexamination under § 1.510 (included in the request for *ex parte* reexamination fee at § 1.20(c)(1) or (2)):

TABLE 6 TO PARAGRAPH (c)(7)

By a micro entity (§ 1.29).....$945.00

By a small entity (§ 1.27(a)).....1,890.00

By other than a small or micro entity.....3,780.00

(d) For filing each statutory disclaimer (§ 1.321):.....$170.00

(e) For maintaining an original or any reissue patent, except a design or plant patent, based on an application filed on or after December 12, 1980, in force beyond four years, the fee being due by three years and six months after the original grant:

TABLE 7 TO PARAGRAPH (e)

By a micro entity (§ 1.29).....$500.00

By a small entity (§ 1.27(a)).....1,000.00

By other than a small or micro entity.....2,000.00

(f) For maintaining an original or any reissue patent, except a design or plant patent, based on an application filed on or after December 12, 1980, in force beyond eight years, the fee being due by seven years and six months after the original grant:

TABLE 8 TO PARAGRAPH (f)

By a micro entity (§ 1.29).....$940.00

By a small entity (§ 1.27(a)).....1,880.00

By other than a small or micro entity.....3,760.00

(g) For maintaining an original or any reissue patent, except a design or plant patent, based on an application filed on or after December 12, 1980, in force beyond twelve years, the fee being due by eleven years and six months after the original grant:

TABLE 9 TO PARAGRAPH (g)

By a micro entity (§ 1.29).....$1,925.00

By a small entity (§ 1.27(a)).....3,850.00

By other than a small or micro entity.....7,700.00

(h) Surcharge for paying a maintenance fee during the six-month grace period following the expiration of three years and six months, seven years and six months, and eleven years and six months after the date of the original grant of a patent based

on an application filed on or after December 12, 1980:

TABLE 10 TO PARAGRAPH (h)

By a micro entity (§ 1.29).....$125.00

By a small entity (§ 1.27(a)).....250.00

By other than a small or micro entity.....500.00

(i) [Reserved]

(j) For filing an application for extension of the term of a patent:

TABLE 11 TO PARAGRAPH (j)

(1) Application for extension under § 1.740.....$1,180.00

(2) Initial application for interim extension under § 1.790.....440.00

(3) Subsequent application for interim extension under § 1.790.....230.00

(k) In supplemental examination proceedings:

(1) For processing and treating a request for supplemental examination:

TABLE 12 TO PARAGRAPH (k)(1)

By a micro entity (§ 1.29).....$1,155.00

By a small entity (§ 1.27(a)).....2,310.00

By other than a small or micro entity.....4,620.00

(2) For *ex parte* reexamination ordered as a result of a supplemental examination proceeding:

TABLE 13 TO PARAGRAPH (k)(2)

By a micro entity (§ 1.29).....$3,175.00

By a small entity (§ 1.27(a)).....6,350.00

By other than a small or micro entity.....12,700.00

(3) For processing and treating, in a supplemental examination proceeding, a non-patent document over 20 sheets in length, per document:

(i) Between 21 and 50 sheets:

TABLE 14 TO PARAGRAPH (k)(3)(i)

By a micro entity (§ 1.29).....$45.00

By a small entity (§ 1.27(a)).....90.00

By other than a small or micro entity.....180.00

(ii) For each additional 50 sheets or a fraction thereof:

TABLE 15 TO PARAGRAPH (k)(3)(ii)

By a micro entity (§ 1.29).....$75.00

By a small entity (§ 1.27(a)).....150.00

By other than a small or micro entity.....300.00

[Added 47 FR 41272, Sept. 17, 1982, effective date Oct. 1, 1982; paras. (k), (l) and (m) added, 49 FR 34724, Aug. 31, 1984, effective date Nov. 1, 1984; paras. (c), (f), (g) and (m), 50 FR 9379, Mar. 7, 1985, effective date May 8, 1985; 50 FR 31825, Aug. 6, 1985, effective date Oct. 5, 1985; 51 FR 28057, Aug. 4, 1986; 52 FR 9394, Mar. 24, 1987; paras. (a)-(n), 54 FR 6893, Feb. 15, 1989, 54 FR 8053, Feb. 24, 1989, effective Apr. 17, 1989; revised 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; paras. (a), (c), (e)-(g) and (i), 57 FR 38190, Aug. 21, 1992, effective Oct. 1, 1992; para. (i), 58 FR 44277, Aug. 20, 1993, effective Sept. 20, 1993; paras. (c), (e)-(g), (i)(1) and (j), 59 FR 43736, Aug. 25, 1994, effective Oct. 1, 1994; para. (j) revised, 60 FR 25615, May 12, 1995, effective July 11, 1995; paras. (c), (e)-(g), (i)(2), & (j)(1) amended, 60 FR 41018, Aug. 11, 1995, effective Oct. 1, 1995; paras. (a), (e) -(g), (i)(1), (i)(2), and (j)(1)-(j)(3) amended, 61 FR 39585, July 30, 1996, effective Oct. 1, 1996; paras. (c), (e) - (g), (i)(1), (i)(2), and (j)(1)-(j)(3) amended, 62 FR 40450, July 29, 1997, effective Oct. 1, 1997; paras. (d)-(g) revised, 63 FR 67578, Dec. 8, 1998, effective Nov. 10, 1998; para. (e) revised, 64 FR 67774, Dec. 3, 1999, effective Dec. 29, 1999; paras. (e)-(g) revised, 65 FR 49193, Aug. 11, 2000, effective Oct. 1, 2000; paras. (b) and (d)-(h) revised, 65 FR 78958, Dec. 18, 2000; para. (b) corrected, 65 FR 80755, Dec. 22, 2000; para. (c) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; paras. (e)-(g) revised, 66 FR 39447, July 31, 2001, effective Oct. 1, 2001; paras. (e)-(g) revised, 67 FR 70847, Nov. 27, 2002, effective Jan. 1, 2003; para. (i) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; paras. (e)-(g) revised, 68 FR 41532, July 14, 2003, effective Oct. 1, 2003; paras. (e)-(g) revised, 69 FR 52604, Aug. 27, 2004, effective Oct. 1, 2004; paras. (c)-(g) revised, 70 FR 3880, Jan. 27, 2005, effective Dec. 8, 2004; paras. (c)(3), (c)(4), and (e)-(g) revised, 72 FR 46899, Aug. 22, 2007, effective Sept. 30, 2007; paras. (c)(3),(c)(4), and (d)-(g) revised, 73 FR 47534, Aug. 14, 2008, effective Oct. 2, 2008; para. (c)(1) revised and paras. (c)(6), (c)(7), and (k) added, 77 FR 48828, Aug. 14, 2012, effective Sept. 16, 2012; paras.

(c)(3), (c)(4), and (d)-(g) revised, 77 FR 54360, Sept. 5, 2012, effective Oct. 5, 2012; revised, 78 FR 4212, Jan. 18, 2013, effective Mar. 19, 2013; revised 78 FR 17102, Mar. 20, 2013, effective Mar. 20, 2013; para. (i) removed and reserved, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013; paras. (a)-(c) and (e)-(g) revised, 82 FR 52780, Nov. 14, 2017, effective Jan. 16, 2018; revised, 85 FR 46932, Aug. 3, 2020, effective Oct. 2, 2020; paras. (c)(1)(i)(A)-(F), (c)(1)(ii)(A)-(C), and (c)(7) corrected, 85 FR 58282, Sept. 18, 2020, effective Oct. 2, 2020]

§ 1.21 Miscellaneous fees and charges.

The Patent and Trademark Office has established the following fees for the services indicated:

(a) Registration of attorneys and agents:

(1) For admission to examination for registration to practice:

(i) Application Fee (non-refundable):.....$110.00

(ii) Registration examination fee

(A) For test administration by commercial entity:.....$210.00

(B) For test administration by the USPTO:.....$470.00

(iii) For USPTO-administered review of registration examination:.....$470.00

(2) On registration to practice or grant of limited recognition:

(i) On registration to practice under § 11.6 of this chapter:.....$210.00

(ii) On grant of limited recognition under § 11.9(b) of this chapter:.....$210.00

(iii) On change of registration from agent to attorney:.....$110.00

(3) [Reserved]

(4) For certificate of good standing as an attorney or agent:

(i) Standard:.....$40.00.

(ii) Suitable for framing:.....$50.00.

(5) For review of decision:

(i) By the Director of Enrollment and Discipline under § 11.2(c) of this chapter:..$420.00

(ii) Of the Director of Enrollment and Discipline under § 11.2(d) of this chapter:.$420.00

(6) Recovery/Retrieval of OED Information System Customer Interface account by USPTO:

(i) [Reserved]

(ii) For USPTO-assisted change of address:.....$70.00.

(7) [Reserved]

(8) [Reserved]

(9)

(i) Delinquency fee:.....$50.00.

(ii) Administrative reinstatement fee:.....$210.00

(10) On application by a person for recognition or registration after disbarment or suspension on ethical grounds, or resignation pending disciplinary proceedings in any other jurisdiction; on application by a person for recognition or registration who is asserting rehabilitation from prior conduct that resulted in an adverse decision in the Office regarding the person's moral character; and on application by a person for recognition or registration after being convicted of a felony or crime involving moral turpitude or breach of fiduciary duty; and on petition for reinstatement by a person excluded or suspended on ethical grounds, or excluded on consent from practice before the Office:.....$1,680.00

(b) Deposit accounts:

(1) [Reserved]

(2) Service charge for each month when the balance at the end of the month is below $1,000:.....$25.00.

(3) Service charge for each month when the balance at the end of the month is below $300 for restricted subscription deposit accounts used exclusively for subscription order of patent copies as issued:.....$25.00.

(c) [Reserved]

(d) [Reserved]

(e) International type search reports: For preparing an international type search report of an international type search made at the time of the first action on the merits in a national patent application:.....$40.00.

(f) [Reserved]

(g) [Reserved]

(h) For recording each assignment, agreement, or other paper relating to the property in a patent or application, per property:

(1) If submitted electronically, on or after January 1, 2014:.....$0.00.

(2) If not submitted electronically:....$50.00.

(i) Publication in Official Gazette: For publication in the Official Gazette of a notice of the availability of an application or a patent for licensing or sale:

Each application or patent:.....$25.00.

(j) [Reserved]

(k) For items and services that the director finds may be supplied, for which fees are not specified by statute or by this part, such charges as may be determined by the director with respect to each such item or service: Actual cost

(l) [Reserved]

(m) For processing each payment refused (including a check returned "unpaid") or charged back by a financial institution: $50.00.

(n) For handling an application in which proceedings are terminated pursuant to § 1.53(e):.....$140.00

(o) The receipt of a very lengthy sequence listing (mega-sequence listing) in an application under 35 U.S.C. 111 or 371 is subject to the following fee:

(1) First receipt by the Office of a sequence listing in electronic form ranging in size from 300MB to 800MB (without file compression):

TABLE 1 TO PARAGRAPH (o)(1)

By a micro entity (§ 1.29).....$265.00

By a small entity (§ 1.27(a)).....530.00

By other than a small or micro entity.....1,060.00

(2) First receipt by the Office of a sequence listing in electronic form exceeding 800MB in size (without file compression):

TABLE 2 TO PARAGRAPH (o)(2)

By a micro entity (§ 1.29).....$2,625.00

By a small entity (§ 1.27(a)).....5,250.00

By other than a small or micro entity.....10,500.00

(p) Additional Fee for Overnight Delivery: $40.00.

(q) Additional Fee for Expedited Service: $170.00.

[Added 47 FR 41272, Sept. 17, 1982, effective date Oct. 1, 1982; paras. (b) and (l), 49 FR 553, Jan. 4, 1984, effective date Apr. 1, 1984; paras. (a)(5) and (6) added, 50 FR 5171, Feb. 6, 1985, effective date Apr. 8, 1985; 50 FR 31825, Aug. 6, 1985, effective date Oct. 5, 1985; paras. (a), (b)(1), (d)-(j), (l)-(m), 54 FR 6893, Feb. 15, 1989; 54 FR 8053, Feb. 24, 1989; 54 FR 9432, March 7, 1989, effective Apr. 17, 1989; para. (n) added 54 FR 47518, Nov. 15, 1989, effective Jan. 16, 1990; paras. (o)-(q) added 54 FR 50942, Dec.11, 1989, effective Feb. 12, 1990; paras. (a)-(c), (e)-(h), (j)-(l) & (n) amended, 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; paras. (p) and (q) deleted, 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; paras. (a)(1), (a)(5), (a)(6), (b)(2), (b)(3), (e) and (i), 57 FR 38190, Aug. 21, 1992, effective Oct. 1, 1992; para. (p) added, 57 FR 38190, Aug. 21, 1992, effective Oct. 1, 1992; para. (p) deleted, 59 FR 43736, Aug.25, 1994, effective Oct. 1, 1994; para. (l) amended, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; para. (a)(1) amended, 60 FR 41018, Aug. 11, 1995, effective Oct. 1, 1995; paras. (a)(1), (a)(3) and (a)(6) revised, 61 FR 39585, July 30, 1996, effective Oct. 1, 1996; paras. (a)(1)(ii), (a)(6), and (j) amended, 62 FR 40450, July 29, 1997, effective Oct. 1, 1997; paras. (l) & (n) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (a)(6)(ii) revised, 63 FR 67578, Dec. 8, 1998, effective Dec. 8, 1998; para (m) revised, 65 FR 33452, May 24, 2000, effective July 24, 2000; para. (a)(6) revised, 65 FR 49193, Aug. 11, 2000, effective Oct. 1, 2000; para. (o) removed and reserved, 66 FR 39447, July 31, 2001, effective Oct. 1, 2001; para. (k) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (a) revised, 69 FR 35427, June 24, 2004, effective July 26, 2004; para. (l) removed and reserved, 70 FR 30360, May 26, 2005, effective July 1, 2005; para. (c) removed and reserved, 71 FR 64636, Nov. 3, 2006, effective Feb. 1, 2007; para. (a)(3) removed and reserved and paras. (a)(7), (a)(8) and (a)(9) added, 73 FR 67750, Nov. 17, 2008, effective Dec. 17, 2008; paras. (a), (e), (g)-(k) and (n) revised and para. (d) removed and reserved, 78 FR 4212, Jan. 18, 2013, effective Mar. 19, 2013; paras. (a)(7) and (a)(8) removed and reserved, 78 FR 20180, Apr. 3, 2013, effective May 3, 2013; revised, 82 FR 52780, Nov. 14, 2017, effective Jan. 16, 2018; paras. (a)(1), (2), and (5), (a)(9)(ii) and (a)(10), (n), (o), and (q) revised, para.

(a)(6)(i) removed and reserved, and para. (k) added, 85 FR 46932, Aug. 3, 2020, as corrected by 85 FR 58282, Sept. 18, 2020, effective Oct. 2, 2020]

§ 1.22 Fees payable in advance.

(a) Patent fees and charges payable to the United States Patent and Trademark Office are required to be paid in advance; that is, at the time of requesting any action by the Office for which a fee or charge is payable with the exception that under § 1.53 applications for patent may be assigned a filing date without payment of the basic filing fee.

(b) All fees paid to the United States Patent and Trademark Office must be itemized in each individual application, patent, or other proceeding in such a manner that it is clear for which purpose the fees are paid. The Office may return fees that are not itemized as required by this paragraph. The provisions of § 1.5(a) do not apply to the resubmission of fees returned pursuant to this paragraph.

[48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; para. (b) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; revised, 68 FR 48286, Aug. 13, 2003, effective Sept. 12, 2003]

§ 1.23 Methods of payment.

(a) All payments of money required for United States Patent and Trademark Office fees, including fees for the processing of international applications (§ 1.445), shall be made in U.S. dollars and in the form of a cashier's or certified check, Treasury note, national bank notes, or United States Postal Service money order. If sent in any other form, the Office may delay or cancel the credit until collection is made. Checks and money orders must be made payable to the Director of the United States Patent and Trademark Office. (Checks made payable to the Commissioner of Patents and Trademarks will continue to be accepted.) Payments from foreign countries must be payable and immediately negotiable in the United States for the full amount of the fee required. Money sent to the Office by mail will be at the risk of the sender, and letters containing money should be registered with the United States Postal Service.

(b) Payments of money required for United States Patent and Trademark Office fees may also be made by credit card, except for replenishing a deposit account. Payment of a fee by credit card must specify the amount to be charged to the credit card and such other information as is necessary to process the charge, and is subject to collection of the fee. The Office will not accept a general authorization to charge fees to a credit card. If credit card information is provided on a form or document other than a form provided by the Office for the payment of fees by credit card, the Office will not be liable if the credit card number becomes public knowledge.

(c) A fee transmittal letter may be signed by a juristic applicant or patent owner.

[43 FR 20462, May 11, 1978; revised, 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; revised, 65 FR 33452, May 24, 2000, effective June 5, 2000; para. (b) revised, 69 FR 43751, July 22, 2004, effective Aug. 23, 2004; para. (c) added, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013]

§ 1.24 [Reserved]

[47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; 48 FR 2696, Jan. 20, 1983, effective date Feb. 27, 1983; 50 FR 31825, Aug. 6, 1985, effective Oct. 5, 1985; 51 FR 28057, Aug. 4, 1986; 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; para. (b) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; removed and reserved, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 1.25 Deposit accounts.

(a) For the convenience of attorneys, and the general public in paying any fees due, in ordering services offered by the Office, copies of records, etc., deposit accounts may be established in the Patent and Trademark Office upon payment of the fee for establishing a deposit account (§ 1.21(b)(1)). A minimum deposit of $1,000 is required for paying any fee due or in ordering any services offered by the Office. However, a minimum deposit of $300 may be paid to establish a restricted subscription deposit account used exclusively for subscription order of patent copies as issued. At the end of each month, a deposit account statement will be rendered. A remittance must be made promptly upon receipt of the statement to cover the value of items or services charged to the account and thus restore the account to its established normal deposit. An amount sufficient to cover all fees, services, copies, etc., requested must always be on deposit. Charges to

accounts with insufficient funds will not be accepted. A service charge (§ 1.21(b)(2)) will be assessed for each month that the balance at the end of the month is below $1,000. For restricted subscription deposit accounts, a service charge (§ 1.21(b)(3)) will be assessed for each month that the balance at the end of the month is below $300.

(b) Filing, issue, appeal, international-type search report, international application processing, international design application fees, petition, and post-issuance fees may be charged against these accounts if sufficient funds are on deposit to cover such fees. A general authorization to charge all fees, or only certain fees, set forth in §§ 1.16 through 1.18 to a deposit account containing sufficient funds may be filed in an individual application, either for the entire pendency of the application or with a particular paper filed. A general authorization to charge fees in an international design application set forth in § 1.1031 will only be effective for the transmittal fee (§ 1.1031(a)). An authorization to charge fees under § 1.16 in an international application entering the national stage under 35 U.S.C. 371 will be treated as an authorization to charge fees under § 1.492. An authorization to charge fees set forth in § 1.18 to a deposit account is subject to the provisions of § 1.311(b). An authorization to charge to a deposit account the fee for a request for reexamination pursuant to § 1.510 or 1.913 and any other fees required in a reexamination proceeding in a patent may also be filed with the request for reexamination, and an authorization to charge to a deposit account the fee for a request for supplemental examination pursuant to § 1.610 and any other fees required in a supplemental examination proceeding in a patent may also be filed with the request for supplemental examination. An authorization to charge a fee to a deposit account will not be considered payment of the fee on the date the authorization to charge the fee is effective unless sufficient funds are present in the account to cover the fee.

(c) A deposit account holder may replenish the deposit account by submitting a payment to the United States Patent and Trademark Office. A payment to replenish a deposit account must be submitted by one of the methods set forth in paragraphs (c)(1), (c)(2), (c)(3), or (c)(4) of this section.

(1) A payment to replenish a deposit account may be submitted by electronic funds transfer through the Federal Reserve Fedwire System, which requires that the following information be provided to the deposit account holder's bank or financial institution:

(i) Name of the Bank, which is Treas NYC (Treasury New York City);

(ii) Bank Routing Code, which is 021030004;

(iii) United States Patent and Trademark Office account number with the Department of the Treasury, which is 13100001; and

(iv) The deposit account holder's company name and deposit account number.

(2) A payment to replenish a deposit account may be submitted by electronic funds transfer over the Office's Internet Web site *(www.uspto.gov).*

(3) A payment to replenish a deposit account may be addressed to: Director of the United States Patent and Trademark Office, Attn: Deposit Accounts, 2051 Jamieson Avenue, Suite 300, Alexandria, Virginia 22314.

[49 FR 553, Jan. 4, 1984, effective Apr. 1, 1984; 47 FR 41272, Sept. 17, 1982, effective Oct. 1,1982; 50 FR 31826, Aug. 6, 1985, effective Oct. 5, 1985; para. (b) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para (b) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (b) revised, 67 FR 520, Jan. 4, 2002, effective Apr. 1, 2002; para. (c) added, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (c)(2) revised, 69 FR 43751, July 22, 2004, effective Aug. 23, 2004; para. (c)(4) revised, 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005; para. (c)(3) revised, para. (c)(4) removed, 73 FR 47534, Aug. 14, 2008, effective Oct. 2, 2008; para. (b) revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013; para. (b) revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.26 Refunds.

(a) The Director may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee. The Office will not refund amounts of twenty-five dollars or less unless a refund is specifically requested, and will not notify

the payor of such amounts. If a party paying a fee or requesting a refund does not provide the banking information necessary for making refunds by electronic funds transfer (31 U.S.C. 3332 and 31 CFR part 208), or instruct the Office that refunds are to be credited to a deposit account, the Director may require such information, or use the banking information on the payment instrument to make a refund. Any refund of a fee paid by credit card will be by a credit to the credit card account to which the fee was charged.

(b) Any request for refund must be filed within two years from the date the fee was paid, except as otherwise provided in this paragraph or in § 1.28(a). If the Office charges a deposit account by an amount other than an amount specifically indicated in an authorization (§ 1.25(b)), any request for refund based upon such charge must be filed within two years from the date of the deposit account statement indicating such charge, and include a copy of that deposit account statement. The time periods set forth in this paragraph are not extendable.

(c) If the Director decides not to institute a reexamination proceeding in response to a request for reexamination or supplemental examination, fees paid with the request for reexamination or supplemental examination will be refunded or returned in accordance with paragraphs (c)(1) through (c)(3) of this section. The reexamination requester or the patent owner who requested a supplemental examination proceeding, as appropriate, should indicate the form in which any refund should be made (*e.g.*, by check, electronic funds transfer, credit to a deposit account). Generally, refunds will be issued in the form that the original payment was provided.

(1) For an *ex parte* reexamination request, the *ex parte* reexamination filing fee paid by the reexamination requester, less the fee set forth in § 1.20(c)(7), will be refunded to the requester if the Director decides not to institute an *ex parte* reexamination proceeding.

(2) For an *inter partes* reexamination request, a refund of $7,970 will be made to the reexamination requester if the Director decides not to institute an *inter partes* reexamination proceeding.

(3) For a supplemental examination request, the fee for reexamination ordered as a result of supplemental examination, as set forth in § 1.20(k)(2), will be returned to the patent owner who requested the supplemental examination proceeding if the Director decides not to institute a reexamination proceeding.

[47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; 50 FR 31826 Aug. 6, 1985, effective Oct. 5, 1985; para. (c), 54 FR 6893, Feb. 15, 1989, effective Apr. 17, 1989; para. (c), 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; paras. (a) and (c), 57 FR 38190, Aug. 21, 1992, effective Oct. 1,1992; para. (a) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised and para. (b) added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (c) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; paras. (a) & (c) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (a) revised, 68 FR 48286, Aug. 13, 2003, effective Sept. 12, 2003; paras. (a) and (b) revised, 72 FR 46716, Aug. 21, 2007 (implementation enjoined and never became effective); paras. (a) and (b) revised, 74 FR 52686, Oct. 14, 2009, effective Oct. 14, 2009 (to remove changes made by the final rules in 72 FR 46716 from the CFR); para. (c) revised, 77 FR 48828, Aug. 14, 2012, effective Sept. 16, 2012]

§ 1.27 Definition of small entities and establishing status as a small entity to permit payment of small entity fees; when a determination of entitlement to small entity status and notification of loss of entitlement to small entity status are required; fraud on the Office.

[Editor Note: Para. (c)(2) below include(s) changes applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

(a) *Definition of small entities.* A small entity as used in this chapter means any party (person, small business concern, or nonprofit organization) under paragraphs (a)(1) through (a)(3) of this section.

(1) *Person.* A person, as used in paragraph (c) of this section, means any inventor or other individual (*e.g.*, an individual to whom an inventor has transferred some rights in the invention) who has not assigned, granted, conveyed, or licensed, and is under no obligation under contract or law to assign, grant, convey, or license, any rights in the invention. An inventor or other individual who has transferred some rights in the invention to one or more parties, or is under an obligation to transfer

some rights in the invention to one or more parties, can also qualify for small entity status if all the parties who have had rights in the invention transferred to them also qualify for small entity status either as a person, small business concern, or nonprofit organization under this section.

(2) *Small business concern.* A small business concern, as used in paragraph (c) of this section, means any business concern that:

(i) Has not assigned, granted, conveyed, or licensed, and is under no obligation under contract or law to assign, grant, convey, or license, any rights in the invention to any person, concern, or organization which would not qualify for small entity status as a person, small business concern, or nonprofit organization; and

(ii) Meets the size standards set forth in 13 CFR 121.801 through 121.805 to be eligible for reduced patent fees. Questions related to standards for a small business concern may be directed to: Small Business Administration, Size Standards Staff, 409 Third Street, SW., Washington, DC 20416.

(3) *Nonprofit Organization.* A nonprofit organization, as used in paragraph (c) of this section, means any nonprofit organization that:

(i) Has not assigned, granted, conveyed, or licensed, and is under no obligation under contract or law to assign, grant, convey, or license, any rights in the invention to any person, concern, or organization which would not qualify as a person, small business concern, or a nonprofit organization; and

(ii) Is either:

(A) A university or other institution of higher education located in any country;

(B) An organization of the type described in section 501(c)(3) of the Internal Revenue Code of 1986 (26 U.S.C. 501(c)(3)) and exempt from taxation under section 501(a) of the Internal Revenue Code (26 U.S.C. 501(a));

(C) Any nonprofit scientific or educational organization qualified under a nonprofit organization statute of a state of this country (35 U.S.C. 201(i)); or

(D) Any nonprofit organization located in a foreign country which would qualify as a nonprofit organization under paragraphs (a)(3)(ii)(B) of this section or (a)(3)(ii)(C) of this section if it were located in this country.

(4) *Federal Government Use License Exceptions.* In a patent application filed, prosecuted, and if patented, maintained at no expense to the Government, with the exception of any expense taken to deliver the application and fees to the Office on behalf of the applicant:

(i) For persons under paragraph (a)(1) of this section, claiming small entity status is not prohibited by:

(A) A use license to the Government resulting from a rights determination under Executive Order 10096 made in accordance with § 501.6 of this title;

(B) A use license to the Government resulting from Federal agency action pursuant to 15 U.S.C. 3710d(a) allowing the Federal employee-inventor to obtain or retain title to the invention; or

(C) A use license to a Federal agency resulting from retention of rights under 35 U.S.C. 202(d) by an inventor employed by a small business concern or nonprofit organization contractor, provided the license is equivalent to the license under 35 U.S.C. 202(c)(4) the Federal agency would have received had the contractor elected to retain title, and all the conditions applicable under § 401.9 of this title to an employee/inventor are met.

(ii) For small business concerns and nonprofit organizations under paragraphs (a)(2) and (3) of this section, a use license to a Federal agency resulting from a funding agreement with that agency pursuant to 35 U.S.C. 202(c)(4) does not preclude claiming small entity status, provided that:

(A) The subject invention was made solely by employees of the small business concern or nonprofit organization; or

(B) In the case of a Federal employee co-inventor, the Federal agency employing such co-inventor took action pursuant to 35 U.S.C. 202(e)(1) to exclusively license or assign whatever rights currently held or that it may acquire in the subject invention to the small business concern or nonprofit organization, subject to the license under 35 U.S.C. 202(c)(4).

(iii) For small business concerns and nonprofit organizations under paragraphs (a)(2) and (3) of this section that have collaborated with a Federal agency laboratory pursuant to a cooperative research and development agreement (CRADA) under 15 U.S.C. 3710a(a)(1), claiming small entity status is not prohibited by a use license to the Government pursuant to:

(A) 15 U.S.C. 3710a(b)(2) that results from retaining title to an invention made solely by the employee of the small business concern or nonprofit organization; or

(B) 15 U.S.C. 3710a(b)(3)(D), provided the laboratory has waived in whole any right of ownership the Government may have to the subject invention made by the small business concern or nonprofit organization, or has exclusively licensed whatever ownership rights the Government may acquire in the subject invention to the small business concern or nonprofit organization.

(iv) Regardless of whether an exception under this paragraph (a)(4) applies, no refund under § 1.28(a) is available for any patent fee paid by the Government.

(5) *Security Interest.* A security interest does not involve an obligation to transfer rights in the invention for the purposes of paragraphs (a)(1) through (a)(3) of this section unless the security interest is defaulted upon.

(b) *Establishment of small entity status permits payment of reduced fees.*

(1) A small entity, as defined in paragraph (a) of this section, who has properly asserted entitlement to small entity status pursuant to paragraph (c) of this section will be accorded small entity status by the Office in the particular application or patent in which entitlement to small entity status was asserted. Establishment of small entity status allows the payment of certain reduced patent fees pursuant to 35 U.S.C. 41(h)(1).

(2) Submission of an original utility application in compliance with the Office electronic filing system by an applicant who has properly asserted entitlement to small entity status pursuant to paragraph (c) of this section in that application allows the payment of a reduced filing fee pursuant to 35 U.S.C. 41(h)(3).

(c) *Assertion of small entity status.* Any party (person, small business concern or nonprofit organization) should make a determination, pursuant to paragraph (f) of this section, of entitlement to be accorded small entity status based on the definitions set forth in paragraph (a) of this section, and must, in order to establish small entity status for the purpose of paying small entity fees, actually make an assertion of entitlement to small entity status, in the manner set forth in paragraphs (c)(1) or (c)(3) of this section, in the application or patent in which such small entity fees are to be paid.

(1) *Assertion by writing.* Small entity status may be established by a written assertion of entitlement to small entity status. A written assertion must:

(i) Be clearly identifiable;

(ii) Be signed (see paragraph (c)(2) of this section); and

(iii) Convey the concept of entitlement to small entity status, such as by stating that applicant is a small entity, or that small entity status is entitled to be asserted for the application or patent. While no specific words or wording are required to assert small entity status, the intent to assert small entity status must be clearly indicated in order to comply with the assertion requirement.

(2) *Parties who can sign the written assertion.* The written assertion can be signed by:

(i) The applicant (§ 1.42 or § 1.421);

(ii) A patent practitioner of record or a practitioner acting in a representative capacity under § 1.34;

(iii) The inventor or a joint inventor, if the inventor is the applicant; or

(iv) The assignee.

(3) *Assertion by payment of the small entity basic filing, basic transmittal, basic national fee, international search fee, or individual designation fee in an international design application.* The payment, by any party, of the exact amount of one of the small entity basic filing fees set forth in § 1.16(a), (b), (c), (d), or (e), the small entity transmittal fee set forth in § 1.445(a)(1) or § 1.1031(a), the small entity international search fee set forth in § 1.445(a)(2) to a Receiving Office other than the United States Receiving Office in the exact

amount established for that Receiving Office pursuant to PCT Rule 16, or the small entity basic national fee set forth in § 1.492(a), will be treated as a written assertion of entitlement to small entity status even if the type of basic filing, basic transmittal, or basic national fee is inadvertently selected in error. The payment, by any party, of the small entity first part of the individual designation fee for the United States to the International Bureau (§ 1.1031) will be treated as a written assertion of entitlement to small entity status.

(i) If the Office accords small entity status based on payment of a small entity basic filing or basic national fee under paragraph (c)(3) of this section that is not applicable to that application, any balance of the small entity fee that is applicable to that application will be due along with the appropriate surcharge set forth in § 1.16(f), or § 1.16(g).

(ii) The payment of any small entity fee other than those set forth in paragraph (c)(3) of this section (whether in the exact fee amount or not) will not be treated as a written assertion of entitlement to small entity status and will not be sufficient to establish small entity status in an application or a patent.

(4) *Assertion required in related, continuing, and reissue applications.* Status as a small entity must be specifically established by an assertion in each related, continuing and reissue application in which status is appropriate and desired. Status as a small entity in one application or patent does not affect the status of any other application or patent, regardless of the relationship of the applications or patents. The refiling of an application under § 1.53 as a continuation, divisional, or continuation-in-part application (including a continued prosecution application under § 1.53(d)), or the filing of a reissue application, requires a new assertion as to continued entitlement to small entity status for the continuing or reissue application.

(d) *When small entity fees can be paid.* Any fee, other than the small entity basic filing fees and the small entity national fees of paragraph (c)(3) of this section, can be paid in the small entity amount only if it is submitted with, or subsequent to, the submission of a written assertion of entitlement to small entity status, except when refunds are permitted by § 1.28(a).

(e) *Only one assertion required.*

(1) An assertion of small entity status need only be filed once in an application or patent. Small entity status, once established, remains in effect until changed pursuant to paragraph (g)(1) of this section. Where an assignment of rights or an obligation to assign rights to other parties who are small entities occurs subsequent to an assertion of small entity status, a second assertion is not required.

(2) Once small entity status is withdrawn pursuant to paragraph (g)(2) of this section, a new written assertion is required to again obtain small entity status.

(f) *Assertion requires a determination of entitlement to pay small entity fees.* Prior to submitting an assertion of entitlement to small entity status in an application, including a related, continuing, or reissue application, a determination of such entitlement should be made pursuant to the requirements of paragraph (a) of this section. It should be determined that all parties holding rights in the invention qualify for small entity status. The Office will generally not question any assertion of small entity status that is made in accordance with the requirements of this section, but note paragraph (h) of this section.

(g)(1) *New determination of entitlement to small entity status is needed when issue and maintenance fees are due.* Once status as a small entity has been established in an application or patent, fees as a small entity may thereafter be paid in that application or patent without regard to a change in status until the issue fee is due or any maintenance fee is due.

(2) *Notification of loss of entitlement to small entity status is required when issue and maintenance fees are due.* Notification of a loss of entitlement to small entity status must be filed in the application or patent prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity as defined in paragraph (a) of this section is no longer appropriate. The notification that small entity status is no longer appropriate must be signed by a party identified in § 1.33(b). Payment of a fee in other than the small entity amount is not sufficient notification that small entity status is no longer appropriate.

(h) *Fraud attempted or practiced on the Office.*

(1) Any attempt to fraudulently establish status as a small entity, or pay fees as a small entity, shall be considered as a fraud practiced or attempted on the Office.

(2) Improperly, and with intent to deceive, establishing status as a small entity, or paying fees as a small entity, shall be considered as a fraud practiced or attempted on the Office.

[47 FR 40139, Sept. 10, 1982, added effective Oct. 1, 1982; para. (c) added, 47 FR 43276, Sept. 30, 1982; paras. (b), (c), and (d), 49 FR 553, Jan. 4, 1984, effective Apr. 1, 1984; revised, 62 FR 53132, Oct. 10, 1997, effective Dec.1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000; para. (a) revised, 69 FR 56481, Sept. 21, 2004, effective Sept. 21, 2004; paras. (b) and (c)(3) revised, 70 FR 3880, Jan. 27, 2005, effective Dec. 8, 2004; para. (c)(2) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012; para. (c)(3) introductory text revised, 78 FR 4212, Jan. 18, 2013, effective Mar. 19, 2013; para. (c)(3) revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015; para. (c)(3) introductory text revised, 85 FR 46932, Aug. 3, 2020, effective Oct. 2, 2020; para. (a)(4) revised, 85 FR 82917, Dec. 21, 2020, effective Jan. 20, 2021, corrected to effective Jan. 21, 2021, 86 FR 2542, Jan. 13, 2021, correction withdrawn 86 FR 3815, Jan. 15, 2021]

[*The changes to para. (c)(2) effective Sept. 16, 2012 are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012. See § 1.27 (pre-AIA) for para. (c)(2) otherwise in effect.]

§ 1.27 (pre-AIA) Definition of small entities and establishing status as a small entity to permit payment of small entity fees; when a determination of entitlement to small entity status and notification of loss of entitlement to small entity status are required; fraud on the Office.

[Editor Note: Para. (c)(2) below is **not applicable** to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012*]

(a) *Definition of small entities.* A small entity as used in this chapter means any party (person, small business concern, or nonprofit organization) under paragraphs (a)(1) through (a)(3) of this section.

(1) *Person.* A person, as used in paragraph (c) of this section, means any inventor or other individual (*e.g.*, an individual to whom an inventor has transferred some rights in the invention) who has not assigned, granted, conveyed, or licensed, and is under no obligation under contract or law to assign, grant, convey, or license, any rights in the invention. An inventor or other individual who has transferred some rights in the invention to one or more parties, or is under an obligation to transfer some rights in the invention to one or more parties, can also qualify for small entity status if all the parties who have had rights in the invention transferred to them also qualify for small entity status either as a person, small business concern, or nonprofit organization under this section.

(2) *Small business concern.* A small business concern, as used in paragraph (c) of this section, means any business concern that:

(i) Has not assigned, granted, conveyed, or licensed, and is under no obligation under contract or law to assign, grant, convey, or license, any rights in the invention to any person, concern, or organization which would not qualify for small entity status as a person, small business concern, or nonprofit organization; and

(ii) Meets the size standards set forth in 13 CFR 121.801 through 121.805 to be eligible for reduced patent fees. Questions related to standards for a small business concern may be directed to: Small Business Administration, Size Standards Staff, 409 Third Street, SW., Washington, DC 20416.

(3) *Nonprofit Organization.* A nonprofit organization, as used in paragraph (c) of this section, means any nonprofit organization that:

(i) Has not assigned, granted, conveyed, or licensed, and is under no obligation under contract or law to assign, grant, convey, or license, any rights in the invention to any person, concern, or organization which would not qualify as a person, small business concern, or a nonprofit organization; and

(ii) Is either:

(A) A university or other institution of higher education located in any country;

(B) An organization of the type described in section 501(c)(3) of the Internal Revenue Code of 1986 (26 U.S.C. 501(c)(3)) and exempt from taxation under section 501(a) of the Internal Revenue Code (26 U.S.C. 501(a));

(C) Any nonprofit scientific or educational organization qualified under a nonprofit organization statute of a state of this country (35 U.S.C. 201(i)); or

(D) Any nonprofit organization located in a foreign country which would qualify as a nonprofit organization under paragraphs (a)(3)(ii)(B) of this section or (a)(3)(ii)(C) of this section if it were located in this country.

(4) *License to a Federal agency.*

(i) For persons under paragraph (a)(1) of this section, a license to the Government resulting from a rights determination under Executive Order 10096 does not constitute a license so as to prohibit claiming small entity status.

(ii) For small business concerns and nonprofit organizations under paragraphs (a)(2) and (a)(3) of this section, a license to a Federal agency resulting from a funding agreement with that agency pursuant to 35 U.S.C. 202(c)(4) does not constitute a license for the purposes of paragraphs (a)(2)(i) and (a)(3)(i) of this section.

(5) *Security Interest.* A security interest does not involve an obligation to transfer rights in the invention for the purposes of paragraphs (a)(1) through (a)(3) of this section unless the security interest is defaulted upon.

(b) *Establishment of small entity status permits payment of reduced fees.*

(1) A small entity, as defined in paragraph (a) of this section, who has properly asserted entitlement to small entity status pursuant to paragraph (c) of this section will be accorded small entity status by the Office in the particular application or patent in which entitlement to small entity status was asserted. Establishment of small entity status allows the payment of certain reduced patent fees pursuant to 35 U.S.C. 41(h)(1).

(2) Submission of an original utility application in compliance with the Office electronic filing system by an applicant who has properly asserted entitlement to small entity status pursuant to paragraph (c) of this section in that application allows the payment of a reduced filing fee pursuant to 35 U.S.C. 41(h)(3).

(c) *Assertion of small entity status.* Any party (person, small business concern or nonprofit organization) should make a determination, pursuant to paragraph (f) of this section, of entitlement to be accorded small entity status based on the definitions set forth in paragraph (a) of this section, and must, in order to establish small entity status for the purpose of paying small entity fees, actually make an assertion of entitlement to small entity status, in the manner set forth in paragraphs (c)(1) or (c)(3) of this section, in the application or patent in which such small entity fees are to be paid.

(1) *Assertion by writing.* Small entity status may be established by a written assertion of entitlement to small entity status. A written assertion must:

(i) Be clearly identifiable;

(ii) Be signed (see paragraph (c)(2) of this section); and

(iii) Convey the concept of entitlement to small entity status, such as by stating that applicant is a small entity, or that small entity status is entitled to be asserted for the application or patent. While no specific words or wording are required to assert small entity status, the intent to assert small entity status must be clearly indicated in order to comply with the assertion requirement.

(2) *Parties who can sign and file the written assertion.* The written assertion can be signed by:

(i) One of the parties identified in § 1.33(b) (*e.g.*, an attorney or agent registered with the Office), § 3.73(b) of this chapter notwithstanding, who can also file the written assertion;

(ii) At least one of the individuals identified as an inventor (even though a § 1.63 executed oath or declaration has not been submitted), notwithstanding § 1.33(b)(4), who can also file the written assertion pursuant to the exception under § 1.33(b) of this part; or

(iii) An assignee of an undivided part interest, notwithstanding §§ 1.33(b)(3) and 3.73(b) of this chapter, but the partial assignee cannot file the assertion without resort to a party identified under § 1.33(b) of this part.

(3) *Assertion by payment of the small entity basic filing or basic national fee.* The payment, by any party, of the exact amount of one of the small entity basic filing fees set forth in §§ 1.16(a), 1.16(b), 1.16(c), 1.16(d), 1.16(e), or the small entity basic national fee set forth in § 1.492(a), will be

treated as a written assertion of entitlement to small entity status even if the type of basic filing or basic national fee is inadvertently selected in error.

(i) If the Office accords small entity status based on payment of a small entity basic filing or basic national fee under paragraph (c)(3) of this section that is not applicable to that application, any balance of the small entity fee that is applicable to that application will be due along with the appropriate surcharge set forth in § 1.16(f), or § 1.16(g).

(ii) The payment of any small entity fee other than those set forth in paragraph (c)(3) of this section (whether in the exact fee amount or not) will not be treated as a written assertion of entitlement to small entity status and will not be sufficient to establish small entity status in an application or a patent.

(4) *Assertion required in related, continuing, and reissue applications.* Status as a small entity must be specifically established by an assertion in each related, continuing and reissue application in which status is appropriate and desired. Status as a small entity in one application or patent does not affect the status of any other application or patent, regardless of the relationship of the applications or patents. The refiling of an application under § 1.53 as a continuation, divisional, or continuation-in-part application (including a continued prosecution application under § 1.53(d)), or the filing of a reissue application, requires a new assertion as to continued entitlement to small entity status for the continuing or reissue application.

(d) *When small entity fees can be paid.* Any fee, other than the small entity basic filing fees and the small entity national fees of paragraph (c)(3) of this section, can be paid in the small entity amount only if it is submitted with, or subsequent to, the submission of a written assertion of entitlement to small entity status, except when refunds are permitted by § 1.28(a).

(e) *Only one assertion required.*

(1) An assertion of small entity status need only be filed once in an application or patent. Small entity status, once established, remains in effect until changed pursuant to paragraph (g)(1) of this section. Where an assignment of rights or an obligation to assign rights to other parties who are small entities occurs subsequent to an assertion of small entity status, a second assertion is not required.

(2) Once small entity status is withdrawn pursuant to paragraph (g)(2) of this section, a new written assertion is required to again obtain small entity status.

(f) *Assertion requires a determination of entitlement to pay small entity fees.* Prior to submitting an assertion of entitlement to small entity status in an application, including a related, continuing, or reissue application, a determination of such entitlement should be made pursuant to the requirements of paragraph (a) of this section. It should be determined that all parties holding rights in the invention qualify for small entity status. The Office will generally not question any assertion of small entity status that is made in accordance with the requirements of this section, but note paragraph (h) of this section.

(g)(1) *New determination of entitlement to small entity status is needed when issue and maintenance fees are due.* Once status as a small entity has been established in an application or patent, fees as a small entity may thereafter be paid in that application or patent without regard to a change in status until the issue fee is due or any maintenance fee is due.

(2) *Notification of loss of entitlement to small entity status is required when issue and maintenance fees are due.* Notification of a loss of entitlement to small entity status must be filed in the application or patent prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity as defined in paragraph (a) of this section is no longer appropriate. The notification that small entity status is no longer appropriate must be signed by a party identified in § 1.33(b). Payment of a fee in other than the small entity amount is not sufficient notification that small entity status is no longer appropriate.

(h) *Fraud attempted or practiced on the Office.*

(1) Any attempt to fraudulently establish status as a small entity, or pay fees as a small entity, shall be considered as a fraud practiced or attempted on the Office.

(2) Improperly, and with intent to deceive, establishing status as a small entity, or paying fees

as a small entity, shall be considered as a fraud practiced or attempted on the Office.

[47 FR 40139, Sept. 10, 1982, added effective Oct. 1, 1982; para. (c) added, 47 FR 43276, Sept. 30, 1982; paras. (b), (c), and (d), 49 FR 553, Jan. 4, 1984, effective Apr. 1, 1984; revised, 62 FR 53132, Oct. 10, 1997, effective Dec.1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000; para. (a) revised, 69 FR 56481, Sept. 21, 2004, effective Sept. 21, 2004; paras. (b) and (c)(3) revised, 70 FR 3880, Jan. 27, 2005, effective Dec. 8, 2004]

[*See § 1.27 for more information and for para. (c)(2) applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012]

§ 1.28 Refunds when small entity status is later established; how errors in small entity status are excused.

(a) *Refunds based on later establishment of small entity status.* A refund pursuant to § 1.26, based on establishment of small entity status, of a portion of fees timely paid in full prior to establishing status as a small entity may only be obtained if an assertion under § 1.27(c) and a request for a refund of the excess amount are filed within three months of the date of the timely payment of the full fee. The three-month time period is not extendable under § 1.136. Status as a small entity is waived for any fee by the failure to establish the status prior to paying, at the time of paying, or within three months of the date of payment of, the full fee.

(b) *Date of payment.*

(1) The three-month period for requesting a refund, pursuant to paragraph (a) of this section, starts on the date that a full fee has been paid;

(2) The date when a deficiency payment is paid in full determines the amount of deficiency that is due, pursuant to paragraph (c) of this section.

(c) *How errors in small entity status are excused.* If status as a small entity is established in good faith, and fees as a small entity are paid in good faith, in any application or patent, and it is later discovered that such status as a small entity was established in error, or that through error the Office was not notified of a loss of entitlement to small entity status as required by § 1.27(g)(2), the error will be excused upon: compliance with the separate submission and itemization requirements of paragraphs (c)(1) and (c)(2) of this section, and the deficiency payment requirement of paragraph (c)(2) of this section:

(1) *Separate submission required for each application or patent.* Any paper submitted under this paragraph must be limited to the deficiency payment (all fees paid in error), required by paragraph (c)(2) of this section, for one application or one patent. Where more than one application or patent is involved, separate submissions of deficiency payments (*e.g.,* checks) and itemizations are required for each application or patent. See § 1.4(b).

(2) *Payment of deficiency owed.* The deficiency owed, resulting from the previous erroneous payment of small entity fees, must be paid.

(i) *Calculation of the deficiency owed.* The deficiency owed for each previous fee erroneously paid as a small entity is the difference between the current fee amount (for other than a small entity) on the date the deficiency is paid in full and the amount of the previous erroneous (small entity) fee payment. The total deficiency payment owed is the sum of the individual deficiency owed amounts for each fee amount previously erroneously paid as a small entity. Where a fee paid in error as a small entity was subject to a fee decrease between the time the fee was paid in error and the time the deficiency is paid in full, the deficiency owed is equal to the amount (previously) paid in error;

(ii) *Itemization of the deficiency payment.* An itemization of the total deficiency payment is required. The itemization must include the following information:

(A) Each particular type of fee that was erroneously paid as a small entity, (*e.g.,* basic statutory filing fee, two-month extension of time fee) along with the current fee amount for a non-small entity;

(B) The small entity fee actually paid, and when. This will permit the Office to differentiate, for example, between two one-month extension of time fees erroneously paid as a small entity but on different dates;

(C) The deficiency owed amount (for each fee erroneously paid); and

(D) The total deficiency payment owed, which is the sum or total of the individual deficiency owed amounts set forth in paragraph (c)(2)(ii)(C) of this section.

(3) *Failure to comply with requirements.* If the requirements of paragraphs (c)(1) and (c)(2) of this section are not complied with, such failure will either: be treated as an authorization for the Office to process the deficiency payment and charge the processing fee set forth in § 1.17(i), or result in a requirement for compliance within a one-month non-extendable time period under § 1.136(a) to avoid the return of the fee deficiency paper, at the option of the Office.

(d) *Payment of deficiency operates as notification of loss of status.* Any deficiency payment (based on a previous erroneous payment of a small entity fee) submitted under paragraph (c) of this section will be treated under § 1.27(g)(2) as a notification of a loss of entitlement to small entity status.

[47 FR 40140, Sept. 10, 1982, added effective Oct. 1, 1982; para. (a), 49 FR 553, Jan. 4, 1984, effective Apr. 1, 1984; para. (d)(2), 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; para. (c) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; para. (a) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; paras. (a) & (c) revised, 62 FR 53132, Oct. 10 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.29 Micro entity status.

(a) To establish micro entity status under this paragraph, the applicant must certify that:

(1) The applicant qualifies as a small entity as defined in § 1.27 without relying on a government use license exception under § 1.27(a)(4);

(2) Neither the applicant nor the inventor nor a joint inventor has been named as the inventor or a joint inventor on more than four previously filed patent applications, other than applications filed in another country, provisional applications under 35 U.S.C. 111(b), or international applications for which the basic national fee under 35 U.S.C. 41(a) was not paid;

(3) Neither the applicant nor the inventor nor a joint inventor, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986 (26 U.S.C. 61(a)), exceeding three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census; and

(4) Neither the applicant nor the inventor nor a joint inventor has assigned, granted, or conveyed, nor is under an obligation by contract or law to assign, grant, or convey, a license or other ownership interest in the application concerned to an entity that, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986, exceeding three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census.

(b) An applicant, inventor, or joint inventor is not considered to be named on a previously filed application for purposes of paragraph (a)(2) of this section if the applicant, inventor, or joint inventor has assigned, or is under an obligation by contract or law to assign, all ownership rights in the application as the result of the applicant's, inventor's, or joint inventor's previous employment.

(c) If an applicant's, inventor's, joint inventor's, or entity's gross income in the preceding calendar year is not in United States dollars, the average currency exchange rate, as reported by the Internal Revenue Service, during that calendar year shall be used to determine whether the applicant's, inventor's, joint inventor's, or entity's gross income exceeds the threshold specified in paragraph (a)(3) or (4) of this section.

(d) To establish micro entity status under this paragraph, the applicant must certify that:

(1) The applicant qualifies as a small entity as defined in § 1.27 without relying on a government use license exception under § 1.27(a)(4); and

(2)(i) The applicant's employer, from which the applicant obtains the majority of the applicant's income, is an institution of higher education as defined in section 101(a) of the Higher Education Act of 1965 (20 U.S.C. 1001(a)); or

(ii) The applicant has assigned, granted, conveyed, or is under an obligation by contract or law, to assign, grant, or convey, a license or other ownership interest in the particular application to such an institution of higher education.

(e) Micro entity status is established in an application by filing a micro entity certification in writing complying with the requirements of either paragraph (a) or (d) of this section and signed either in compliance with § 1.33(b), in an international application filed in a Receiving Office other than the United States Receiving Office by a person authorized to represent the applicant under § 1.455 , or in an international design application by a person authorized to represent the applicant under § 1.1041 before the International Bureau where the micro entity certification is filed with the International Bureau. Status as a micro entity must be specifically established in each related, continuing and reissue application in which status is appropriate and desired. Status as a micro entity in one application or patent does not affect the status of any other application or patent, regardless of the relationship of the applications or patents. The refiling of an application under § 1.53 as a continuation, divisional, or continuation-in-part application (including a continued prosecution application under § 1.53(d)), or the filing of a reissue application, requires a new certification of entitlement to micro entity status for the continuing or reissue application.

(f) A fee may be paid in the micro entity amount only if it is submitted with, or subsequent to, the submission of a certification of entitlement to micro entity status.

(g) A certification of entitlement to micro entity status need only be filed once in an application or patent. Micro entity status, once established, remains in effect until changed pursuant to paragraph (i) of this section. However, a fee may be paid in the micro entity amount only if status as a micro entity as defined in paragraph (a) or (d) of this section is appropriate on the date the fee is being paid. Where an assignment of rights or an obligation to assign rights to other parties who are micro entities occurs subsequent to the filing of a certification of entitlement to micro entity status, a second certification of entitlement to micro entity status is not required.

(h) Prior to submitting a certification of entitlement to micro entity status in an application, including a related, continuing, or reissue application, a determination of such entitlement should be made pursuant to the requirements of this section. It should be determined that each applicant qualifies for micro entity status under paragraph (a) or (d) of this section, and that any other party holding rights in the invention qualifies for small entity status under § 1.27. The Office will generally not question certification of entitlement to micro entity status that is made in accordance with the requirements of this section.

(i) Notification of a loss of entitlement to micro entity status must be filed in the application or patent prior to paying, or at the time of paying, any fee after the date on which status as a micro entity as defined in paragraph (a) or (d) of this section is no longer appropriate. The notification that micro entity status is no longer appropriate must be signed by a party identified in § 1.33(b). Payment of a fee in other than the micro entity amount is not sufficient notification that micro entity status is no longer appropriate. A notification that micro entity status is no longer appropriate will not be treated as a notification that small entity status is also no longer appropriate unless it also contains a notification of loss of entitlement to small entity status under § 1.27(f)(2)[1.27(g)(2)]. Once a notification of a loss of entitlement to micro entity status is filed in the application or patent, a new certification of entitlement to micro entity status is required to again obtain micro entity status.

(j) Any attempt to fraudulently establish status as a micro entity, or pay fees as a micro entity, shall be considered as a fraud practiced or attempted on the Office. Improperly, and with intent to deceive, establishing status as a micro entity, or paying fees as a micro entity, shall be considered as a fraud practiced or attempted on the Office.

(k) If status as a micro entity is established in good faith in an application or patent, and fees as a micro entity are paid in good faith in the application or patent, and it is later discovered that such micro entity status either was established in error, or that the Office was not notified of a loss of entitlement to micro entity status as required by paragraph (i) of this section through error, the error will be excused upon compliance with the separate submission and itemization requirements of paragraph (k)(1) of this section and the deficiency payment requirement of paragraph (k)(2) of this section.

(1) Any paper submitted under this paragraph must be limited to the deficiency payment (all fees paid in error) required for a single

application or patent. Where more than one application or patent is involved, separate submissions of deficiency payments are required for each application or patent (see § 1.4(b)). The paper must contain an itemization of the total deficiency payment for the single application or patent and include the following information:

(i) Each particular type of fee that was erroneously paid as a micro entity, (*e.g.*, basic statutory filing fee, two-month extension of time fee) along with the current fee amount for a small or non-small entity, as applicable;

(ii) The micro entity fee actually paid, and the date on which it was paid;

(iii) The deficiency owed amount (for each fee erroneously paid); and

(iv) The total deficiency payment owed, which is the sum or total of the individual deficiency owed amounts as set forth in paragraph (k)(2) of this section.

(2) The deficiency owed, resulting from the previous erroneous payment of micro entity fees, must be paid. The deficiency owed for each previous fee erroneously paid as a micro entity is the difference between the current fee amount for a small entity or non-small entity, as applicable, on the date the deficiency is paid in full and the amount of the previous erroneous micro entity fee payment. The total deficiency payment owed is the sum of the individual deficiency owed amounts for each fee amount previously and erroneously paid as a micro entity.

(3) If the requirements of paragraphs (k)(1) and (2) of this section are not complied with, such failure will either be treated at the option of the Office as an authorization for the Office to process the deficiency payment and charge the processing fee set forth in § 1.17(i), or result in a requirement for compliance within a one-month time period that is not extendable under § 1.136(a) to avoid the return of the fee deficiency payment.

(4) Any deficiency payment (based on a previous erroneous payment of a micro entity fee) submitted under this paragraph will be treated as a notification of a loss of entitlement to micro entity status under paragraph (i) of this section.

[Added, 77 FR 75019, Dec. 19, 2012, effective Mar. 19, 2013; paras. (e) and (k)(4) revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013; para. (e) revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015; paras. (a)(1) and (d)(1) revised, 85 FR 82917, Dec. 21, 2020, effective Jan. 20, 2021, corrected to effective Jan. 21, 2021, 86 FR 2542, Jan. 13, 2021, correction withdrawn 86 FR 3815, Jan. 15, 2021]

Subpart B — National Processing Provisions

PROSECUTION OF APPLICATION AND APPOINTMENT OF ATTORNEY OR AGENT

§ 1.31 Applicant may be represented by one or more patent practitioners or joint inventors.

An applicant for patent may file and prosecute the applicant's own case, or the applicant may give power of attorney so as to be represented by one or more patent practitioners or joint inventors, except that a juristic entity (*e.g.*, organizational assignee) must be represented by a patent practitioner even if the juristic entity is the applicant. The Office cannot aid in the selection of a patent practitioner.

[50 FR 5171, Feb. 6, 1985, effective Mar. 8, 1985; revised, 69 FR 29865, May 26, 2004, effective June 25, 2004; revised 69 FR 35427, June 24, 2004, effective July 26, 2004; revised, 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005; revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012]

§ 1.32 Power of attorney.

[Editor Note: Certain* paragraphs below include changes applicable only to patent applications filed under 35 U.S.C. 111, 363, or 385 on or after September 16, 2012]

(a) *Definitions.*

(1) *Patent practitioner* means a registered patent attorney or registered patent agent under § 11.6.

(2) *Power of attorney* means a written document by which a principal authorizes one or more patent practitioners or joint inventors to act on the principal's behalf.

(3) *Principal* means the applicant (§ 1.42) for an application for patent and the patent owner for a patent, including a patent in a supplemental

examination or reexamination proceeding. The principal executes a power of attorney designating one or more patent practitioners or joint inventors to act on the principal's behalf.

(4) *Revocation* means the cancellation by the principal of the authority previously given to a patent practitioner or joint inventor to act on the principal's behalf.

(5) *Customer Number* means a number that may be used to:

(i) Designate the correspondence address of a patent application or patent such that the correspondence address for the patent application, patent or other patent proceeding would be the address associated with the Customer Number;

(ii) Designate the fee address (§ 1.363) of a patent such that the fee address for the patent would be the address associated with the Customer Number; and

(iii) Submit a list of patent practitioners such that those patent practitioners associated with the Customer Number would have power of attorney.

(6) *Patent practitioner of record* means a patent practitioner who has been granted a power of attorney in an application, patent, or other proceeding in compliance with paragraph (b) of this section. The phrases practitioner of record and attorney or agent of record also mean a patent practitioner who has been granted a power of attorney in an application, patent, or other proceeding in compliance with paragraph (b) of this section.

(b) A power of attorney must:

(1) Be in writing;

(2) Name one or more representatives in compliance with paragraph (c) of this section;

(3) Give the representative power to act on behalf of the principal; and

(4) Be signed by the applicant for patent (§ 1.42) or the patent owner. A patent owner who was not the applicant under § 1.46 must appoint any power of attorney in compliance with §§ 3.71 and 3.73 of this chapter.

(c) A power of attorney may only name as representative:

(1) One or more joint inventors (§ 1.45);

(2) Those registered patent practitioners associated with a Customer Number;

(3) Ten or fewer patent practitioners, stating the name and registration number of each patent practitioner. Except as provided in paragraph (c)(1) or (c)(2) of this section, the Office will not recognize more than ten patent practitioners as being of record in an application or patent. If a power of attorney names more than ten patent practitioners, such power of attorney must be accompanied by a separate paper indicating which ten patent practitioners named in the power of attorney are to be recognized by the Office as being of record in the application or patent to which the power of attorney is directed.

(d) A power of attorney from a prior national application for which benefit is claimed under 35 U.S.C. 120, 121, 365(c), or 386(c) in a continuing application may have effect in the continuing application if a copy of the power of attorney from the prior application is filed in the continuing application unless:

(1) The power of attorney was granted by the inventor; and

(2) The continuing application names an inventor who was not named as an inventor in the prior application.

(e) If the power of attorney was granted by the originally named inventive entity, and an added inventor pursuant to § 1.48 does not provide a power of attorney consistent with the power of attorney granted by the originally named inventive entity, the addition of the inventor results in the loss of that power of attorney upon grant of the § 1.48 request. This provision does not preclude a practitioner from acting pursuant to § 1.34, if applicable.

[Added, 69 FR 29865, May 26, 2004, effective June 25, 2004; paras. (a) and (c)(3) revised, 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005; para. (d) introductory text revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

[* Paras. (a)(2), (a)(3), (a)(4), (a)(6), (b), (d) and (e) above include provisions applicable only to patent applications filed on or after Sept. 16, 2012. See § 1.32 (pre-AIA) for the rule applicable to applications filed prior to Sept. 16, 2012.]

§ 1.32 (pre-AIA) Power of attorney.

[Editor Note: Certain* paragraphs below are **not applicable** to patent applications filed under 35 U.S.C. 111, 363, or 385 on or after Sept. 16, 2012]

(a) *Definitions.*

(1) *Patent practitioner* means a registered patent attorney or registered patent agent under § 11.6.

(2) *Power of attorney* means a written document by which a principal authorizes one or more patent practitioners or joint inventors to act on his or her behalf.

(3) *Principal* means either an applicant for patent (§ 1.41(b)) or an assignee of entire interest of the applicant for patent or in a reexamination proceeding, the assignee of the entirety of ownership of a patent. The principal executes a power of attorney designating one or more patent practitioners or joint inventors to act on his or her behalf.

(4) *Revocation* means the cancellation by the principal of the authority previously given to a patent practitioner or joint inventor to act on his or her behalf.

(5) *Customer Number* means a number that may be used to:

(i) Designate the correspondence address of a patent application or patent such that the correspondence address for the patent application, patent or other patent proceeding would be the address associated with the Customer Number;

(ii) Designate the fee address (§ 1.363) of a patent such that the fee address for the patent would be the address associated with the Customer Number; and

(iii) Submit a list of patent practitioners such that those patent practitioners associated with the Customer Number would have power of attorney.

(b) A power of attorney must:

(1) Be in writing;

(2) Name one or more representatives in compliance with paragraph (c) of this section;

(3) Give the representative power to act on behalf of the principal; and

(4) Be signed by the applicant for patent (§ 1.41(b)) or the assignee of the entire interest of the applicant.

(c) A power of attorney may only name as representative:

(1) One or more joint inventors (§ 1.45);

(2) Those registered patent practitioners associated with a Customer Number;

(3) Ten or fewer patent practitioners, stating the name and registration number of each patent practitioner. Except as provided in paragraph (c)(1) or (c)(2) of this section, the Office will not recognize more than ten patent practitioners as being of record in an application or patent. If a power of attorney names more than ten patent practitioners, such power of attorney must be accompanied by a separate paper indicating which ten patent practitioners named in the power of attorney are to be recognized by the Office as being of record in the application or patent to which the power of attorney is directed.

[Added, 69 FR 29865, May 26, 2004, effective June 25, 2004; paras. (a) and (c)(3) revised, 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005]

[*See § 1.32 for more information and for the rule applicable to patent applications filed on or after Sept. 16, 2012]

§ 1.33 Correspondence respecting patent applications, reexamination proceedings, and other proceedings.

[Editor Note: Certain* paragraphs below are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012]

(a) *Correspondence address and daytime telephone number.* When filing an application, a correspondence address must be set forth in either an application data sheet (§ 1.76), or elsewhere, in a clearly identifiable manner, in any paper submitted with an application filing. If no correspondence address is specified, the Office may treat the mailing address of the first named inventor (if provided, see §§ 1.76(b)(1) and 1.63(b)(2)) as the correspondence address. The Office will direct, or otherwise make available, all notices, official letters, and other communications relating to the application to the person associated with the correspondence address. For correspondence submitted via the Office's

electronic filing system, however, an electronic acknowledgment receipt will be sent to the submitter. The Office will generally not engage in double correspondence with an applicant and a patent practitioner, or with more than one patent practitioner except as deemed necessary by the Director. If more than one correspondence address is specified, the Office will select one of the specified addresses for use as the correspondence address and, if given, may select the address associated with a Customer Number over a typed correspondence address. For the party to whom correspondence is to be addressed, a daytime telephone number should be supplied in a clearly identifiable manner and may be changed by any party who may change the correspondence address. The correspondence address may be changed by the parties set forth in paragraph (b)(1) or (b)(3) of this section. Prior to the appointment of any power of attorney under § 1.32(b), the correspondence address may also be changed by any patent practitioner named in the application transmittal papers who acts in a representative capacity under the provisions of § 1.34.

(b) *Amendments and other papers.* Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(iii) or (c)(2)(iv), filed in the application must be signed by:

(1) A patent practitioner of record;

(2) A patent practitioner not of record who acts in a representative capacity under the provisions of § 1.34; or

(3) The applicant (§ 1.42). Unless otherwise specified, all papers submitted on behalf of a juristic entity must be signed by a patent practitioner.

(c) All notices, official letters, and other communications for the patent owner or owners in a reexamination or supplemental examination proceeding will be directed to the correspondence address in the patent file. Amendments filed in a reexamination proceeding, and other papers filed in a reexamination or supplemental examination proceeding, on behalf of the patent owner must be signed by the patent owner, or if there is more than one owner by all the owners, or by an attorney or agent of record in the patent file, or by a registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34. Double correspondence with the patent owner or owners and the patent owner's attorney or agent, or with more than one attorney or agent, will not be undertaken.

(d) A "correspondence address" or change thereto may be filed with the Patent and Trademark Office during the enforceable life of the patent. The "correspondence address" will be used in any correspondence relating to maintenance fees unless a separate "fee address" has been specified. See § 1.363 for "fee address" used solely for maintenance fee purposes.

(e) A change of address filed in a patent application or patent does not change the address for a patent practitioner in the roster of patent attorneys and agents. See § 11.11 of this title.

(f) Where application papers from a prior application are used in a continuing application and the correspondence address was changed during the prosecution of the prior application, an application data sheet or separate paper identifying the correspondence address to be used for the continuing application must be submitted. Otherwise, the Office may not recognize the change of correspondence address effected during the prosecution of the prior application.

(g) A patent practitioner acting in a representative capacity whose correspondence address is the correspondence address of record in an application may change the correspondence address after the patent has issued, provided that the change of correspondence address is accompanied by a statement that notice has been given to the patentee or owner.

[36 FR 12617, July 2, 1971; 46 FR 29181, May 29, 1981; para. (d) added, 49 FR 34724, Aug. 31, 1984, effective Nov. 1, 1984; para. (c), 50 FR 5171, Feb. 6, 1985, effective Mar. 8, 1985; paras. (a) & (b) revised, 62 FR 53132, Oct. 10 1997, effective Dec. 1, 1997; paras. (a) and (b) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; (a) introductory text, (b) introductory text, and paras. (b)(1), (b)(2) and (c) revised, 69 FR 29865, May 26, 2004, effective June 25, 2004; para. (c) revised, 69 FR 35427, June 24, 2004, effective July 26, 2004; para. (c) revised, 70 FR 3880, Jan. 27, 2005, effective Dec. 8, 2004; para. (a) introductory text revised, paras. (a)(1), (b)(1), and (b)(2) revised, and para. (e) added, 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005; para. (a) introductory text revised, 72 FR 2770, Jan. 23, 2007, effective Jan. 23, 2007; para. (c) revised, 72 FR 18892, Apr. 16, 2007, effective May 16, 2007;

paras. (a) and (b) revised and paras. (f) and (g) added, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012; para. (c) revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013]

[*The revisions to paras. (a) and (b) and new paragraphs (f) and (g) effective Sept. 16, 2012 are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012. See § 1.33 (pre-AIA) for the rule otherwise in effect.]

§ 1.33 (pre-AIA) Correspondence respecting patent applications, reexamination proceedings, and other proceedings.

[Editor Note: The paragraphs below are applicable only to patent applications filed under 35 U.S.C. 111 (pre-AIA) or 363 (pre-AIA) before Sept. 16, 2012]

(a) *Correspondence address and daytime telephone number.* When filing an application, a correspondence address must be set forth in either an application data sheet (§ 1.76), or elsewhere, in a clearly identifiable manner, in any paper submitted with an application filing. If no correspondence address is specified, the Office may treat the mailing address of the first named inventor (if provided, see §§ 1.76(b)(1) and 1.63(c)(2)) as the correspondence address. The Office will direct, or otherwise make available, all notices, official letters, and other communications relating to the application to the person associated with the correspondence address. For correspondence submitted via the Office's electronic filing system, however, an electronic acknowledgment receipt will be sent to the submitter. The Office will generally not engage in double correspondence with an applicant and a patent practitioner, or with more than one patent practitioner except as deemed necessary by the Director. If more than one correspondence address is specified in a single document, the Office will select one of the specified addresses for use as the correspondence address and, if given, will select the address associated with a Customer Number over a typed correspondence address. For the party to whom correspondence is to be addressed, a daytime telephone number should be supplied in a clearly identifiable manner and may be changed by any party who may change the correspondence address. The correspondence address may be changed as follows:

(1) *Prior to filing of § 1.63 oath or declaration by any of the inventors.* If a § 1.63 oath or declaration has not been filed by any of the inventors, the correspondence address may be changed by the party who filed the application. If the application was filed by a patent practitioner, any other patent practitioner named in the transmittal papers may also change the correspondence address. Thus, the inventor(s), any patent practitioner named in the transmittal papers accompanying the original application, or a party that will be the assignee who filed the application, may change the correspondence address in that application under this paragraph.

(2) *Where a § 1.63 oath or declaration has been filed by any of the inventors.* If a § 1.63 oath or declaration has been filed, or is filed concurrent with the filing of an application, by any of the inventors, the correspondence address may be changed by the parties set forth in paragraph (b) of this section, except for paragraph (b)(2).

(b) *Amendments and other papers.* Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by:

(1) A patent practitioner of record appointed in compliance with § 1.32(b);

(2) A patent practitioner not of record who acts in a representative capacity under the provisions of § 1.34;

(3) An assignee as provided for under § 3.71(b) of this chapter; or

(4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

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[*See § 1.33 for more information and for the rule applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012]

§ 1.34 Acting in a representative capacity.

When a patent practitioner acting in a representative capacity appears in person or signs a paper in practice before the United States Patent and Trademark Office in a patent case, his or her personal appearance or signature shall constitute a representation to the United States Patent and Trademark Office that under the provisions of this subchapter and the law, he or she is authorized to

represent the particular party on whose behalf he or she acts. In filing such a paper, the patent practitioner must set forth his or her registration number, his or her name and signature. Further proof of authority to act in a representative capacity may be required.

[46 FR 29181, May 29, 1981; para. (a), 50 FR 5171, Feb. 6, 1985, effective Mar. 6, 1985; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; revised, 69 FR 29865, May 26, 2004, effective June 25, 2004; revised, 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005]

§ 1.36 Revocation of power of attorney; withdrawal of patent attorney or agent.

[Editor Note: Para. (a) below includes changes applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

(a) A power of attorney, pursuant to § 1.32(b), may be revoked at any stage in the proceedings of a case by the applicant or patent owner. A power of attorney to the patent practitioners associated with a Customer Number will be treated as a request to revoke any powers of attorney previously given. Fewer than all of the applicants (or fewer than all patent owners in a supplemental examination or reexamination proceeding) may revoke the power of attorney only upon a showing of sufficient cause, and payment of the petition fee set forth in § 1.17(f). A patent practitioner will be notified of the revocation of the power of attorney. Where power of attorney is given to the patent practitioners associated with a Customer Number (§ 1.32(c)(2)), the practitioners so appointed will also be notified of the revocation of the power of attorney when the power of attorney to all of the practitioners associated with the Customer Number is revoked. The notice of revocation will be mailed to the correspondence address for the application (§ 1.33) in effect before the revocation. An assignment will not of itself operate as a revocation of a power previously given, but the assignee may become the applicant under § 1.46(c) and revoke any previous power of attorney and grant a power of attorney as provided in § 1.32(b).

(b) A registered patent attorney or patent agent who has been given a power of attorney pursuant to § 1.32(b) may withdraw as attorney or agent of record upon application to and approval by the Director. The applicant or patent owner will be notified of the withdrawal of the registered patent attorney or patent agent. Where power of attorney is given to the patent practitioners associated with a Customer Number, a request to delete all of the patent practitioners associated with the Customer Number may not be granted if an applicant has given power of attorney to the patent practitioners associated with the Customer Number in an application that has an Office action to which a reply is due, but insufficient time remains for the applicant to file a reply. See § 41.5 of this title for withdrawal during proceedings before the Patent Trial and Appeal Board.

[49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; 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; revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (a) revised, 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005; para. (b) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

[*The changes to para. (a) effective Sept. 16, 2012 are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012. See § 1.36 (pre-AIA) for the rule otherwise in effect.]

§ 1.36 (pre-AIA) Revocation of power of attorney; withdrawal of patent attorney or agent.

[Editor Note: Para. (a) below is **not applicable** to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

(a) A power of attorney, pursuant to § 1.32(b), may be revoked at any stage in the proceedings of a case by an applicant for patent (§ 1.41(b)) or an assignee of the entire interest of the applicant, or the owner of the entire interest of a patent. A power of attorney to the patent practitioners associated with a Customer Number will be treated as a request to revoke any powers of attorney previously given. Fewer than all of the applicants (or fewer than all of the assignees of the entire interest of the applicant or, in a reexamination proceeding, fewer than all the owners of the entire interest of a patent) may revoke the power of attorney only upon a showing of sufficient cause, and payment of the petition fee set forth in § 1.17(f). A patent practitioner will be notified of the revocation of the power of attorney.

Where power of attorney is given to the patent practitioners associated with a Customer Number (§ 1.32(c)(2)), the practitioners so appointed will also be notified of the revocation of the power of attorney when the power of attorney to all of the practitioners associated with the Customer Number is revoked. The notice of revocation will be mailed to the correspondence address for the application (§ 1.33) in effect before the revocation. An assignment will not of itself operate as a revocation of a power previously given, but the assignee of the entire interest of the applicant may revoke previous powers of attorney and give another power of attorney of the assignee's own selection as provided in § 1.32(b).

(b) A registered patent attorney or patent agent who has been given a power of attorney pursuant to § 1.32(b) may withdraw as attorney or agent of record upon application to and approval by the Director. The applicant or patent owner will be notified of the withdrawal of the registered patent attorney or patent agent. Where power of attorney is given to the patent practitioners associated with a Customer Number, a request to delete all of the patent practitioners associated with the Customer Number may not be granted if an applicant has given power of attorney to the patent practitioners associated with the Customer Number in an application that has an Office action to which a reply is due, but insufficient time remains for the applicant to file a reply. See § 41.5 of this title for withdrawal during proceedings before the Patent Trial and Appeal Board.

[49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; 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; revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (a) revised, 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005; para. (b) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

[*See § 1.36 for more information and for para. (a) applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012]

WHO MAY APPLY FOR A PATENT

§ 1.41 Inventorship.

[Editor Note: Applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

(a) An application must include, or be amended to include, the name of the inventor for any invention claimed in the application.

(b) The inventorship of a nonprovisional application under 35 U.S.C. 111(a) is the inventor or joint inventors set forth in the application data sheet in accordance with § 1.76 filed before or concurrently with the inventor's oath or declaration. If an application data sheet is not filed before or concurrently with the inventor's oath or declaration, the inventorship is the inventor or joint inventors set forth in the inventor's oath or declaration, except as provided for in §§ 1.53(d)(4) and 1.63(d). Once an application data sheet or the inventor's oath or declaration is filed in a nonprovisional application, any correction of inventorship must be pursuant to § 1.48. If neither an application data sheet nor the inventor's oath or declaration is filed during the pendency of a nonprovisional application, the inventorship is the inventor or joint inventors set forth in the application papers filed pursuant to § 1.53(b), unless the applicant files a paper, including the processing fee set forth in § 1.17(i), supplying the name or names of the inventor or joint inventors.

(c) The inventorship of a provisional application is the inventor or joint inventors set forth in the cover sheet as prescribed by § 1.51(c)(1). Once a cover sheet as prescribed by § 1.51(c)(1) is filed in a provisional application, any correction of inventorship must be pursuant to § 1.48. If a cover sheet as prescribed by § 1.51(c)(1) is not filed during the pendency of a provisional application, the inventorship is the inventor or joint inventors set forth in the application papers filed pursuant to § 1.53(c), unless applicant files a paper including the processing fee set forth in § 1.17(q), supplying the name or names of the inventor or joint inventors..

(d) In a nonprovisional application under 35 U.S.C. 111(a) filed without an application data sheet or the inventor's oath or declaration, or in a provisional application filed without a cover sheet as prescribed by § 1.51(c)(1), the name and

residence of each person believed to be an actual inventor should be provided when the application papers pursuant to § 1.53(b) or § 1.53(c) are filed.

(e) The inventorship of an international application entering the national stage under 35 U.S.C. 371 is the inventor or joint inventors set forth in the application data sheet in accordance with § 1.76 filed with the initial submission under 35 U.S.C. 371. Unless the initial submission under 35 U.S.C. 371 is accompanied by an application data sheet in accordance with § 1.76 setting forth the inventor or joint inventors, the inventorship is the inventor or joint inventors set forth in the international application, which includes any change effected under PCT Rule 92 *bis*.

(f) The inventorship of an international design application designating the United States is the creator or creators set forth in the publication of the international registration under Hague Agreement Article 10(3). Any correction of inventorship must be pursuant to § 1.48.

[48 FR 2696, Jan. 20, 1983; 48 FR 4285, Jan. 31, 1983; para. (a) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a) and (c) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a)(4) revised, 67 FR 520, Jan. 4, 2002, effective Apr. 1, 2002; revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012; para. (f) added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

[*****The changes effective Sept. 16, 2012 are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012. See § 1.41 (pre-AIA) for the rule otherwise in effect.]

§ 1.41 (pre-AIA) Applicant for patent.

[Editor Note: **Not applicable** to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*****]

(a) A patent is applied for in the name or names of the actual inventor or inventors.

(1) The inventorship of a nonprovisional application is that inventorship set forth in the oath or declaration as prescribed by § 1.63, except as provided for in §§ 1.53(d)(4) and 1.63(d). If an oath or declaration as prescribed by § 1.63 is not filed during the pendency of a nonprovisional application, the inventorship is that inventorship set forth in the application papers filed pursuant to § 1.53(b), unless applicant files a paper, including the processing fee set forth in § 1.17(i), supplying or changing the name or names of the inventor or inventors.

(2) The inventorship of a provisional application is that inventorship set forth in the cover sheet as prescribed by § 1.51(c)(1). If a cover sheet as prescribed by § 1.51(c)(1) is not filed during the pendency of a provisional application, the inventorship is that inventorship set forth in the application papers filed pursuant to § 1.53(c), unless applicant files a paper including the processing fee set forth in § 1.17(q), supplying or changing the name or names of the inventor or inventors.

(3) In a nonprovisional application filed without an oath or declaration as prescribed by § 1.63 or a provisional application filed without a cover sheet as prescribed by § 1.51(c)(1), the name, residence, and citizenship of each person believed to be an actual inventor should be provided when the application papers pursuant to § 1.53(b) or § 1.53(c) are filed.

(4) The inventorship of an international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in the international application, which includes any change effected under PCT Rule 92 *bis*. See § 1.497(d) and (f) for filing an oath or declaration naming an inventive entity different from the inventive entity named in the international application, or if a change to the inventive entity has been effected under PCT Rule 92 *bis* subsequent to the execution of any declaration filed under PCT Rule 4.17(iv) (§ 1.48(f)(1) does not apply to an international application entering the national stage under 35 U.S.C. 371).

(b) Unless the contrary is indicated the word "applicant" when used in these sections refers to the inventor or joint inventors who are applying for a patent, or to the person mentioned in §§ 1.42, 1.43 or 1.47 who is applying for a patent in place of the inventor.

(c) Any person authorized by the applicant may physically or electronically deliver an application for patent to the Office on behalf of the inventor or inventors, but an oath or declaration for the application (§ 1.63) can only be made in accordance with § 1.64.

(d) A showing may be required from the person filing the application that the filing was authorized where such authorization comes into question.

[48 FR 2696, Jan. 20, 1983; 48 FR 4285, Jan. 31, 1983; para. (a) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a) and (c) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a)(4) revised, 67 FR 520, Jan. 4, 2002, effective Apr. 1, 2002]

[*See § 1.41 for more information and for the rule applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012]

§ 1.42 Applicant for patent.

[Editor Note: Applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

(a) The word "applicant" when used in this title refers to the inventor or all of the joint inventors, or to the person applying for a patent as provided in §§ 1.43, 1.45, or 1.46.

(b) If a person is applying for a patent as provided in § 1.46, the word "applicant" refers to the assignee, the person to whom the inventor is under an obligation to assign the invention, or the person who otherwise shows sufficient proprietary interest in the matter, who is applying for a patent under § 1.46 and not the inventor.

(c) If fewer than all joint inventors are applying for a patent as provided in § 1.45, the phrase "the applicant" means the joint inventors who are applying for the patent without the omitted inventor(s).

(d) Any person having authority may deliver an application and fees to the Office on behalf of the applicant. However, an oath or declaration, or substitute statement in lieu of an oath or declaration, may be executed only in accordance with § 1.63 or 1.64, a correspondence address may be provided only in accordance with § 1.33(a), and amendments and other papers must be signed in accordance with § 1.33(b).

(e) The Office may require additional information where there is a question concerning ownership or interest in an application, and a showing may be required from the person filing the application that the filing was authorized where such authorization comes into question.

[48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012]

[*The changes effective Sept. 16, 2012 are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012. See § 1.42 (pre-AIA) for the rule otherwise in effect.]

§ 1.42 (pre-AIA) When the inventor is dead.

[Editor Note: **Not applicable** to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent. Where the inventor dies during the time intervening between the filing of the application and the granting of a patent thereon, the letters patent may be issued to the legal representative upon proper intervention.

[48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983]

[*See §1.42 for more information and for the rule applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012]

§ 1.43 Application for patent by a legal representative of a deceased or legally incapacitated inventor.

[Editor Note: Applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

If an inventor is deceased or under legal incapacity, the legal representative of the inventor may make an application for patent on behalf of the inventor. If an inventor dies during the time intervening between the filing of the application and the granting of a patent thereon, the letters patent may be issued to the legal representative upon proper intervention. See § 1.64 concerning the execution of a substitute statement by a legal representative in lieu of an oath or declaration.

[48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012]

[*The changes effective Sept. 16, 2012 are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012. See § 1.43 (pre-AIA) for the rule otherwise in effect.]

§ 1.43 (pre-AIA) When the inventor is insane or legally incapacitated.

[Editor Note: **Not applicable** to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

In case an inventor is insane or otherwise legally incapacitated, the legal representative (guardian, conservator, etc.) of such inventor may make the necessary oath or declaration, and apply for and obtain the patent.

[48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983]

[*See § 1.43 for more information and for the rule applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012]

§ 1.44 [Reserved]

[Removed and reserved, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000]

§ 1.45 Application for patent by joint inventors.

[Editor Note: Applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

(a) Joint inventors must apply for a patent jointly, and each must make an inventor's oath or declaration as required by § 1.63, except as provided for in § 1.64. If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the other joint inventor or inventors may make the application for patent on behalf of themselves and the omitted inventor. See § 1.64 concerning the execution of a substitute statement by the other joint inventor or inventors in lieu of an oath or declaration.

(b) Inventors may apply for a patent jointly even though:

(1) They did not physically work together or at the same time;

(2) Each inventor did not make the same type or amount of contribution; or

(3) Each inventor did not make a contribution to the subject matter of every claim of the application.

(c) If multiple inventors are named in a nonprovisional application, each named inventor must have made a contribution, individually or jointly, to the subject matter of at least one claim of the application and the application will be considered to be a joint application under 35 U.S.C. 116. If multiple inventors are named in a provisional application, each named inventor must have made a contribution, individually or jointly, to the subject matter disclosed in the provisional application and the provisional application will be considered to be a joint application under 35 U.S.C. 116.

[paras. (b) and (c), 47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; 48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; 50 FR 9379, Mar. 7, 1985, effective May 8, 1985; para. (c) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012]

[*The changes effective Sept. 16, 2012 are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012. See § 1.45 (pre-AIA) for the rule otherwise in effect.]

§ 1.45 (pre-AIA) Joint inventors.

[Editor Note: **Not applicable** to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

(a) Joint inventors must apply for a patent jointly and each must make the required oath or declaration: neither of them alone, nor less than the entire number, can apply for a patent for an invention invented by them jointly, except as provided in § 1.47.

(b) Inventors may apply for a patent jointly even though

(1) They did not physically work together or at the same time,

(2) Each inventor did not make the same type or amount of contribution, or

(3) Each inventor did not make a contribution to the subject matter of every claim of the application.

(c) If multiple inventors are named in a nonprovisional application, each named inventor must have made a contribution, individually or jointly, to the subject matter of at least one claim of the application and the application will be considered to be a joint application under 35 U.S.C.

116. If multiple inventors are named in a provisional application, each named inventor must have made a contribution, individually or jointly, to the subject matter disclosed in the provisional application and the provisional application will be considered to be a joint application under 35 U.S.C. 116.

[paras. (b) and (c), 47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; 48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; 50 FR 9379, Mar. 7, 1985, effective May 8, 1985; para. (c) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995]

[*See § 1.45 for more information and for the rule applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012]

§ 1.46 Application for patent by an assignee, obligated assignee, or a person who otherwise shows sufficient proprietary interest in the matter.

[Editor Note: Applicable only to patent applications filed under 35 U.S.C. 111(a), 363, or 385 on or after September 16, 2012*]

(a) A person to whom the inventor has assigned or is under an obligation to assign the invention may make an application for patent. A person who otherwise shows sufficient proprietary interest in the matter may make an application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is appropriate to preserve the rights of the parties.

(b) If an application under 35 U.S.C. 111 is made by a person other than the inventor under paragraph (a) of this section, the application must contain an application data sheet under § 1.76 specifying in the applicant information section (§ 1.76(b)(7)) the assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter. If an application entering the national stage under 35 U.S.C. 371, or a nonprovisional international design application, is applied for by a person other than the inventor under paragraph (a) of this section, the assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter must have been identified as the applicant for the United States in the international stage of the international application or as the applicant in the publication of the international registration under Hague Agreement Article 10(3).

(1) If the applicant is the assignee or a person to whom the inventor is under an obligation to assign the invention, documentary evidence of ownership (*e.g.*, assignment for an assignee, employment agreement for a person to whom the inventor is under an obligation to assign the invention) should be recorded as provided for in part 3 of this chapter no later than the date the issue fee is paid in the application.

(2) If the applicant is a person who otherwise shows sufficient proprietary interest in the matter, such applicant must submit a petition including:

(i) The fee set forth in § 1.17(g);

(ii) A showing that such person has sufficient proprietary interest in the matter; and

(iii) A statement that making the application for patent by a person who otherwise shows sufficient proprietary interest in the matter on behalf of and as agent for the inventor is appropriate to preserve the rights of the parties.

(c)(1) *Correction or update in the name of the applicant.* Any request to correct or update the name of the applicant under this section must include an application data sheet under § 1.76 specifying the correct or updated name of the applicant in the applicant information section (§ 1.76(b)(7)) in accordance with § 1.76(c)(2). A change in the name of the applicant recorded pursuant to Hague Agreement Article 16(1)(ii) will be effective to change the name of the applicant in a nonprovisional international design application.

(2) *Change in the applicant.* Any request to change the applicant under this section after an original applicant has been specified must include an application data sheet under § 1.76 specifying the applicant in the applicant information section (§ 1.76(b)(7)) in accordance with § 1.76(c)(2) and comply with §§ 3.71 and 3.73 of this title.

(d) Even if the whole or a part interest in the invention or in the patent to be issued is assigned or obligated to be assigned, an oath or declaration must be executed by the actual inventor or each actual joint inventor, except as provided for in § 1.64. *See* § 1.64 concerning the execution of a substitute statement by an assignee, person to whom the inventor is under an obligation to assign the

invention, or a person who otherwise shows sufficient proprietary interest in the matter.

(e) If a patent is granted on an application filed under this section by a person other than the inventor, the patent shall be granted to the real party in interest. Otherwise, the patent may be issued to the assignee or jointly to the inventor and the assignee as provided in § 3.81. Where a real party in interest has filed an application under § 1.46, the applicant shall notify the Office of any change in the real party in interest no later than payment of the issue fee. The Office will treat the absence of such a notice as an indication that there has been no change in the real party in interest.

(f) The Office may publish notice of the filing of the application by a person who otherwise shows sufficient proprietary interest in the *Official Gazette.*

[48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; 57 FR 29642, July 6, 1992, effective Sept. 4, 1992; revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012; para. (b) introductory text and para. (c) revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

[*****The changes effective Sept. 16, 2012 and May 13, 2015 are applicable only to patent applications filed on or after Sept. 16, 2012. See § 1.46 (pre-AIA) for the rule otherwise in effect.]

§ 1.46 (pre-AIA) Assigned inventions and patents.

[Editor Note: **Not applicable** to patent applications filed under 35 U.S.C. 111(a), 363, or 385 on or after September 16, 2012*****]

In case the whole or a part interest in the invention or in the patent to be issued is assigned, the application must still be made or authorized to be made, and an oath or declaration signed, by the inventor or one of the persons mentioned in §§ 1.42, 1.43, or 1.47. However, the patent may be issued to the assignee or jointly to the inventor and the assignee as provided in § 3.81.

[48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; 57 FR 29642, July 6, 1992, effective Sept. 4, 1992]

[*****See § 1.46 for more information and for the rule applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012]

§ 1.47 [Reserved]

[Removed and reserved with respect to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012. For § 1.47 otherwise in effect, see § 1.47 (pre-AIA)]

§ 1.47 (pre-AIA) Filing when an inventor refuses to sign or cannot be reached.

[Editor Note: **Not applicable** to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*****]

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(g), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

(b) Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in § 1.17(g), and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

(c) The Office will send notice of the filing of the application to all inventors who have not joined in the application at the address(es) provided in the petition under this section, and publish notice of the filing of the application in the *Official Gazette.* The Office may dispense with this notice provision in a continuation or divisional application, if notice

regarding the filing of the prior application was given to the nonsigning inventor(s).

[47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; 48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a) and (b) revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004]

[*Removed and reserved with respect to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012.]

§ 1.48 Correction of inventorship pursuant to 35 U.S.C. 116 or correction of the name or order of names in a patent application, other than a reissue application.

(a) *Nonprovisional application:* Any request to correct or change the inventorship once the inventorship has been established under § 1.41 must include:

(1) An application data sheet in accordance with § 1.76 that identifies each inventor by his or her legal name; and

(2) The processing fee set forth in § 1.17(i) .

(b) *Inventor's oath or declaration for added inventor:* An oath or declaration as required by § 1.63, or a substitute statement in compliance with § 1.64, will be required for any actual inventor who has not yet executed such an oath or declaration.

(c) Any request to correct or change the inventorship under paragraph (a) of this section filed after the Office action on the merits has been given or mailed in the application must also be accompanied by the fee set forth in § 1.17(d), unless the request is accompanied by a statement that the request to correct or change the inventorship is due solely to the cancelation of claims in the application.

(d) *Provisional application.* Once a cover sheet as prescribed by § 1.51(c)(1) is filed in a provisional application, any request to correct or change the inventorship must include:

(1) A request, signed by a party set forth in § 1.33(b), to correct the inventorship that identifies each inventor by his or her legal name; and

(2) The processing fee set forth in § 1.17(q) .

(e) *Additional information may be required.* The Office may require such other information as may be deemed appropriate under the particular circumstances surrounding the correction of inventorship.

(f) *Correcting or updating the name of an inventor:* Any request to correct or update the name of the inventor or a joint inventor, or the order of the names of joint inventors, in a nonprovisional application must include:

(1) An application data sheet in accordance with § 1.76 that identifies each inventor by his or her legal name in the desired order; and

(2) The processing fee set forth in § 1.17(i).

(g) *Reissue applications not covered.* The provisions of this section do not apply to reissue applications. See §§ 1.171 and 1.175 for correction of inventorship in a patent via a reissue application.

(h) *Correction of inventorship in patent.* See § 1.324 for correction of inventorship in a patent.

(i) *Correction of inventorship in an interference or contested case before the Patent Trial and Appeal Board.* In an interference under part 41, subpart D, of this title, a request for correction of inventorship in an application must be in the form of a motion under § 41.121(a)(2) of this title. In a contested case under part 42, subpart D, of this title, a request for correction of inventorship in an application must be in the form of a motion under § 42.22 of this title. The motion under § 41.121(a)(2) or 42.22 of this title must comply with the requirements of paragraph (a) of this section.

[48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; 50 FR 9379, Mar. 7, 1985, effective May 8, 1985; para. (a), 57 FR 56446, Nov. 30, 1992, effective Jan. 4, 1993; revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (f)(1) revised, 67 FR 520, Jan. 4, 2002, effective Apr. 1, 2002; paras. (a)-(c) and (i) revised and para. (j) added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012; para. (c) revised, 78 FR 4212, Jan. 18, 2013, effective Mar. 19, 2013]

THE APPLICATION

§ 1.51 General requisites of an application.

(a) Applications for patents must be made to the Director of the United States Patent and Trademark Office. An application transmittal letter limited to the transmittal of the documents and fees comprising a patent application under this section may be signed by a juristic applicant or patent owner.

(b) A complete application filed under § 1.53(b) or § 1.53(d) comprises:

(1) A specification as prescribed by 35 U.S.C. 112, including a claim or claims, see §§ 1.71 to 1.77;

(2) The inventor's oath or declaration, see §§ 1.63 and 1.64;

(3) Drawings, when necessary, see §§ 1.81 to 1.85; and

(4) The prescribed filing fee, search fee, examination fee, and application size fee, see § 1.16.

(c) A complete provisional application filed under § 1.53(c) comprises:

(1) A cover sheet identifying:

(i) The application as a provisional application,

(ii) The name or names of the inventor or inventors, (see § 1.41(a)(2)),

(iii) The residence of each named inventor,

(iv) The title of the invention,

(v) The name and registration number of the attorney or agent (if applicable),

(vi) The docket number used by the person filing the application to identify the application (if applicable),

(vii) The correspondence address, and

(viii) The name of the U.S. Government agency and Government contract number (if the invention was made by an agency of the U.S. Government or under a contract with an agency of the U.S. Government);

(2) A specification as prescribed by 35 U.S.C. 112(a), see § 1.71;

(3) Drawings, when necessary, see §§ 1.81 to 1.85; and

(4) The prescribed filing fee and application size fee, see § 1.16.

(d) Applicants are encouraged to file an information disclosure statement in nonprovisional applications. See § 1.97 and § 1.98. No information disclosure statement may be filed in a provisional application.

[42 FR 5593, Jan. 28, 1977; paras. (a) and (c), 47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; paras. (a) and (b), 48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; para. (b), 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; paras. (a) & (b) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (b) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; paras. (b)(4) and (c)(4) revised, 70 FR 3880, Jan. 27, 2005, effective Dec. 8, 2004; para. (c)(2) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012; para. (b)(2) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012; para. (a) revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013]

§ 1.52 Language, paper, writing, margins, compact disc specifications.

(a) *Papers that are to become a part of the permanent United States Patent and Trademark Office records in the file of a patent application, or a reexamination or supplemental examination proceeding.*

(1) All papers, other than drawings, that are submitted on paper or by facsimile transmission, and are to become a part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination or supplemental examination proceeding, must be on sheets of paper that are the same size, not permanently bound together, and:

(i) Flexible, strong, smooth, non-shiny, durable, and white;

(ii) Either 21.0 cm by 29.7 cm (DIN size A4) or 21.6 cm by 27.9 cm (8 1/2 by 11 inches), with each sheet including a top margin of at least 2.0 cm (3/4 inch), a left side margin of at least 2.5 cm (1 inch), a right side margin of at least 2.0 cm (3/4 inch), and a bottom margin of at least 2.0 cm (3/4 inch);

(iii) Written on only one side in portrait orientation;

(iv) Plainly and legibly written either by a typewriter or machine printer in permanent dark ink or its equivalent; and

(v) Presented in a form having sufficient clarity and contrast between the paper and the writing thereon to permit the direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by use of digital imaging and optical character recognition.

(2) All papers that are submitted on paper or by facsimile transmission and are to become a part of the permanent records of the United States Patent and Trademark Office should have no holes in the sheets as submitted.

(3) The provisions of this paragraph and paragraph (b) of this section do not apply to the pre-printed information on paper forms provided by the Office, or to the copy of the patent submitted on paper in double column format as the specification in a reissue application or request for reexamination.

(4) See § 1.58 for chemical and mathematical formulae and tables, and § 1.84 for drawings.

(5) Papers that are submitted electronically to the Office must be formatted and transmitted in compliance with the Office's electronic filing system requirements.

(b) *The application (specification, including the claims, drawings, and the inventor's oath or declaration) or reexamination or supplemental examination proceeding, any amendments to the application or reexamination proceeding, or any corrections to the application, or reexamination or supplemental examination proceeding.*

(1) The application or proceeding and any amendments or corrections to the application (including any translation submitted pursuant to paragraph (d) of this section) or proceeding, except as provided for in § 1.69 and paragraph (d) of this section, must:

(i) Comply with the requirements of paragraph (a) of this section; and

(ii) Be in the English language or be accompanied by a translation of the application and a translation of any corrections or amendments into the English language together with a statement that the translation is accurate.

(2) The specification (including the abstract and claims) for other than reissue applications and reexamination or supplemental examination proceedings, and any amendments for applications (including reissue applications) and reexamination proceedings to the specification, except as provided for in §§ 1.821 through 1.825, must have:

(i) Lines that are 1 1/2 or double spaced;

(ii) Text written in a nonscript type font (*e.g.*, Arial, Times Roman, or Courier, preferably a font size of 12) lettering style having capital letters which should be at least 0.3175 cm. (0.125 inch) high, but may be no smaller than 0.21 cm. (0.08 inch) high (*e.g.*, a font size of 6); and

(iii) Only a single column of text.

(3) The claim or claims must commence on a separate physical sheet or electronic page (§ 1.75(h)).

(4) The abstract must commence on a separate physical sheet or electronic page or be submitted as the first page of the patent in a reissue application or reexamination or supplemental examination proceeding (§ 1.72(b)).

(5) Other than in a reissue application or a reexamination or supplemental examination proceeding, the pages of the specification including claims and abstract must be numbered consecutively, starting with 1, the numbers being centrally located above or preferably, below, the text.

(6) Other than in a reissue application or reexamination or supplemental examination proceeding, the paragraphs of the specification, other than in the claims or abstract, may be numbered at the time the application is filed, and should be individually and consecutively numbered using Arabic numerals, so as to unambiguously identify each paragraph. The number should consist of at least four numerals enclosed in square brackets, including leading zeros (*e.g.*, [0001]). The numbers and enclosing brackets should appear to the right of the left margin as the first item in each paragraph, before the first word of the paragraph, and should be highlighted in bold. A gap, equivalent to

approximately four spaces, should follow the number. Nontext elements (*e.g.*, tables, mathematical or chemical formulae, chemical structures, and sequence data) are considered part of the numbered paragraph around or above the elements, and should not be independently numbered. If a nontext element extends to the left margin, it should not be numbered as a separate and independent paragraph. A list is also treated as part of the paragraph around or above the list, and should not be independently numbered. Paragraph or section headers (titles), whether abutting the left margin or centered on the page, are not considered paragraphs and should not be numbered.

(c) Interlineation, erasure, cancellation, or other alteration of the application papers may be made before or after the signing of the inventor's oath or declaration referring to those application papers, provided that the statements in the inventor's oath or declaration pursuant to § 1.63 remain applicable to those application papers. A substitute specification (§ 1.125) may be required if the application papers do not comply with paragraphs (a) and (b) of this section.

(d) A nonprovisional or provisional application under 35 U.S.C. 111 may be in a language other than English.

(1) *Nonprovisional application.* If a nonprovisional application under 35 U.S.C. 111(a) is filed in a language other than English, an English language translation of the non-English language application, a statement that the translation is accurate, and the processing fee set forth in § 1.17(i) are required. If these items are not filed with the application, the applicant will be notified and given a period of time within which they must be filed in order to avoid abandonment.

(2) *Provisional application.* If a provisional application under 35 U.S.C. 111(b) is filed in a language other than English, an English language translation of the non-English language provisional application will not be required in the provisional application. *See* § 1.78(a) for the requirements for claiming the benefit of such provisional application in a nonprovisional application.

(e) *Electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application, or reexamination or supplemental examination proceeding.*

(1) The following documents may be submitted to the Office on a compact disc in compliance with this paragraph:

(i) A computer program listing (see § 1.96);

(ii) A "Sequence Listing" (submitted under § 1.821(c)); or

(iii) Any individual table (see § 1.58) if the table is more than 50 pages in length, or if the total number of pages of all the tables in an application exceeds 100 pages in length, where a table page is a page printed on paper in conformance with paragraph (b) of this section and § 1.58(c).

(2) A compact disc as used in this part means a Compact Disc-Read Only Memory (CD-ROM) or a Compact Disc-Recordable (CD-R) in compliance with this paragraph. A CD-ROM is a "read-only" medium on which the data is pressed into the disc so that it cannot be changed or erased. A CD-R is a "write once" medium on which once the data is recorded, it is permanent and cannot be changed or erased.

(3)(i) Each compact disc must conform to the International Organization for Standardization (ISO) 9660 standard, and the contents of each compact disc must be in compliance with the American Standard Code for Information Interchange (ASCII).

(ii) Each compact disc must be enclosed in a hard compact disc case within an unsealed padded and protective mailing envelope and accompanied by a transmittal letter on paper in accordance with paragraph (a) of this section. The transmittal letter must list for each compact disc the machine format (*e.g.*, IBM-PC, Macintosh), the operating system compatibility (*e.g.*, MS-DOS, MS-Windows, Macintosh, Unix), a list of files contained on the compact disc including their names, sizes in bytes, and dates of creation, plus any other special information that is necessary to identify, maintain, and interpret (*e.g.*, tables in landscape orientation should be identified as landscape orientation or be identified when inquired about) the information on the compact disc. Compact discs submitted to the Office will not be returned to the applicant.

(4) Any compact disc must be submitted in duplicate unless it contains only the "Sequence Listing" in computer readable form required by § 1.821(e). The compact disc and duplicate copy must be labeled "Copy 1" and "Copy 2," respectively. The transmittal letter which accompanies the compact disc must include a statement that the two compact discs are identical. In the event that the two compact discs are not identical, the Office will use the compact disc labeled "Copy 1" for further processing. Any amendment to the information on a compact disc must be by way of a replacement compact disc in compliance with this paragraph containing the substitute information, and must be accompanied by a statement that the replacement compact disc contains no new matter. The compact disc and copy must be labeled "COPY 1 REPLACEMENT MM/DD/YYYY" (with the month, day and year of creation indicated), and "COPY 2 REPLACEMENT MM/DD/YYYY," respectively.

(5) The specification must contain an incorporation-by-reference of the material on the compact disc in a separate paragraph (§ 1.77(b)(5)), identifying each compact disc by the names of the files contained on each of the compact discs, their date of creation and their sizes in bytes. The Office may require applicant to amend the specification to include in the paper portion any part of the specification previously submitted on compact disc.

(6) A compact disc must also be labeled with the following information:

(i) The name of each inventor (if known);

(ii) Title of the invention;

(iii) The docket number, or application number if known, used by the person filing the application to identify the application;

(iv) A creation date of the compact disc;

(v) If multiple compact discs are submitted, the label shall indicate their order (*e.g.*, "1 of X"); and

(vi) An indication that the disc is "Copy 1" or "Copy 2" of the submission. See paragraph (b)(4) of this section.

(7) If a file is unreadable on both copies of the disc, the unreadable file will be treated as not having been submitted. A file is unreadable if, for example, it is of a format that does not comply with the requirements of paragraph (e)(3) of this section, it is corrupted by a computer virus, or it is written onto a defective compact disc.

(f)(1) Any sequence listing in an electronic medium in compliance with §§ 1.52(e) and 1.821(c) or (e), and any computer program listing filed in an electronic medium in compliance with §§ 1.52(e) and 1.96, will be excluded when determining the application size fee required by § 1.16(s) or § 1.492(j). For purposes of determining the application size fee required by § 1.16(s) or § 1.492(j), for an application the specification and drawings of which, excluding any sequence listing in compliance with § 1.821(c) or (e), and any computer program listing filed in an electronic medium in compliance with §§ 1.52(e) and 1.96, are submitted in whole or in part on an electronic medium other than the Office electronic filing system, each three kilobytes of content submitted on an electronic medium shall be counted as a sheet of paper.

(2) Except as otherwise provided in this paragraph, the paper size equivalent of the specification and drawings of an application submitted via the Office electronic filing system will be considered to be seventy-five percent of the number of sheets of paper present in the specification and drawings of the application when entered into the Office file wrapper after being rendered by the Office electronic filing system for purposes of determining the application size fee required by § 1.16(s). Any sequence listing in compliance with § 1.821(c) or (e), and any computer program listing in compliance with § 1.96, submitted via the Office electronic filing system will be excluded when determining the application size fee required by § 1.16(s) if the listing is submitted in ASCII text as part of an associated file.

[43 FR 20462, May 11, 1978; paras. (a) and (d), 47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; para. (c), 48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; para. (d), 49 FR 554, Jan. 4, 1984, effective Apr. 1, 1984; para. (c), 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; paras. (a) and (b) amended, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; paras. (a), (c) & (d) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (e) added, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000 (effective date corrected, 65 FR 78958, Dec. 18, 2000); paras. (a), (b), and (c) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (d) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; paras. (a) and (b) revised, 68 FR 38611, June

30, 2003, effective July 30, 2003; section heading and paras. (b)(2)(ii), (e)(1)(iii) and (e)(3)(i)-(ii) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004; section heading revised and para. (f) added; 70 FR 3880, Jan. 27, 2005, effective Dec. 8, 2004; para. (f) revised, 70 FR 30360, May 26, 2005, effective July 1, 2005; para. (e)(5) revised, 70 FR 54259, Sept. 14, 2005, effective Sept. 14, 2005; paras. (a)(5), (a)(7), and (b)(7) removed and para. (a)(6) redesignated as (a)(5), 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005; para. (d)(2) revised, 72 FR 46716, Aug. 21, 2007 (implementation enjoined and never became effective); para. (d)(2) revised, 74 FR 52686, Oct. 14, 2009, effective Oct. 14, 2009 (to remove changes made by the final rules in 72 FR 46716 from the CFR); para. (b) heading and paras. (c) and (d) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012; paras. (a), (b), and (e) revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013]

§ 1.53 Application number, filing date, and completion of application.

[Editor Note: Applicable to patent applications filed under 35 U.S.C. 111 on or after December 18, 2013.]

(a) *Application number.* Any papers received in the Patent and Trademark Office which purport to be an application for a patent will be assigned an application number for identification purposes.

(b) *Application filing requirements—Nonprovisional application.* The filing date of an application for patent filed under this section, other than an application for a design patent or a provisional application under paragraph (c) of this section, is the date on which a specification, with or without claims, is received in the Office. The filing date of an application for a design patent filed under this section, except for a continued prosecution application under paragraph (d) of this section, is the date on which the specification as prescribed by 35 U.S.C. 112, including at least one claim, and any required drawings are received in the Office. No new matter may be introduced into an application after its filing date. A continuing application, which may be a continuation, divisional, or continuation-in-part application, may be filed under the conditions specified in 35 U.S.C. 120, 121, 365(c), or 386(c) and § 1.78.

(1) A continuation or divisional application that names as inventors the same or fewer than all of the inventors named in the prior application may be filed under this paragraph or paragraph (d) of this section.

(2) A continuation-in-part application (which may disclose and claim subject matter not disclosed in the prior application) or a continuation or divisional application naming an inventor not named in the prior application must be filed under this paragraph.

(c) *Application filing requirements — Provisional application.* The filing date of a provisional application is the date on which a specification, with or without claims, is received in the Office. No amendment, other than to make the provisional application comply with the patent statute and all applicable regulations, may be made to the provisional application after the filing date of the provisional application.

(1) A provisional application must also include the cover sheet required by § 1.51(c)(1), which may be an application data sheet (§ 1.76), or a cover letter identifying the application as a provisional application. Otherwise, the application will be treated as an application filed under paragraph (b) of this section.

(2) An application for patent filed under paragraph (b) of this section may be converted to a provisional application and be accorded the original filing date of the application filed under paragraph (b) of this section. The grant of such a request for conversion will not entitle applicant to a refund of the fees that were properly paid in the application filed under paragraph (b) of this section. Such a request for conversion must be accompanied by the processing fee set forth in § 1.17(q) and be filed prior to the earliest of:

(i) Abandonment of the application filed under paragraph (b) of this section;

(ii) Payment of the issue fee on the application filed under paragraph (b) of this section; or

(iii) Expiration of twelve months after the filing date of the application filed under paragraph (b) of this section.

(3) A provisional application filed under paragraph (c) of this section may be converted to a nonprovisional application filed under paragraph (b) of this section and accorded the original filing date of the provisional application. The conversion of a provisional application to a nonprovisional application will not result in either the refund of any

fee properly paid in the provisional application or the application of any such fee to the filing fee, or any other fee, for the nonprovisional application. Conversion of a provisional application to a nonprovisional application under this paragraph will result in the term of any patent to issue from the application being measured from at least the filing date of the provisional application for which conversion is requested. Thus, applicants should consider avoiding this adverse patent term impact by filing a nonprovisional application claiming the benefit of the provisional application under 35 U.S.C. 119(e), rather than converting the provisional application into a nonprovisional application pursuant to this paragraph. A request to convert a provisional application to a nonprovisional application must be accompanied by the fee set forth in § 1.17(i) and an amendment including at least one claim as prescribed by 35 U.S.C. 112(b), unless the provisional application under paragraph (c) of this section otherwise contains at least one claim as prescribed by 35 U.S.C. 112(b). The nonprovisional application resulting from conversion of a provisional application must also include the filing fee, search fee, and examination fee for a nonprovisional application, and the surcharge required by § 1.16(f) if either the basic filing fee for a nonprovisional application or the inventor's oath or declaration was not present on the filing date accorded the resulting nonprovisional application (*i.e.*, the filing date of the original provisional application). A request to convert a provisional application to a nonprovisional application must also be filed prior to the earliest of:

(i) Abandonment of the provisional application filed under paragraph (c) of this section; or

(ii) Expiration of twelve months after the filing date of the provisional application filed under paragraph (c) of this section.

(4) A provisional application is not entitled to the right of priority under 35 U.S.C. 119, 365(a), or 386(a) or § 1.55, or to the benefit of an earlier filing date under 35 U.S.C. 120, 121, 365(c), or 386(c) or § 1.78 of any other application. No claim for priority under 35 U.S.C. 119(e) or § 1.78(a) may be made in a design application based on a provisional application. The requirements of §§ 1.821 through 1.825 regarding application disclosures containing nucleotide and/or amino acid sequences are not mandatory for provisional applications.

(d) *Application filing requirements — Continued prosecution (nonprovisional) application.*

(1) A continuation or divisional application (but not a continuation-in-part) of a prior nonprovisional application may be filed as a continued prosecution application under this paragraph, provided that:

(i) The application is for a design patent;

(ii) The prior nonprovisional application is a design application, but not an international design application, that is complete as defined by § 1.51(b), except for the inventor's oath or declaration if the application is filed on or after September 16, 2012, and the prior nonprovisional application contains an application data sheet meeting the conditions specified in § 1.53(f)(3)(i); and

(iii) The application under this paragraph is filed before the earliest of:

(A) Payment of the issue fee on the prior application, unless a petition under § 1.313(c) is granted in the prior application;

(B) Abandonment of the prior application; or

(C) Termination of proceedings on the prior application.

(2) The filing date of a continued prosecution application is the date on which a request on a separate paper for an application under this paragraph is filed. An application filed under this paragraph:

(i) Must identify the prior application;

(ii) Discloses and claims only subject matter disclosed in the prior application;

(iii) Names as inventors the same inventors named in the prior application on the date the application under this paragraph was filed, except as provided in paragraph (d)(4) of this section;

(iv) Includes the request for an application under this paragraph, will utilize the file jacket and contents of the prior application, including the specification, drawings and the inventor's oath or declaration from the prior application, to constitute the new application, and

will be assigned the application number of the prior application for identification purposes; and

(v) Is a request to expressly abandon the prior application as of the filing date of the request for an application under this paragraph.

(3) The filing fee, search fee, and examination fee for a continued prosecution application filed under this paragraph are the basic filing fee as set forth in § 1.16(b), the search fee as set forth in § 1.16(l), and the examination fee as set forth in § 1.16(p).

(4) An application filed under this paragraph may be filed by fewer than all the inventors named in the prior application, provided that the request for an application under this paragraph when filed is accompanied by a statement requesting deletion of the name or names of the person or persons who are not inventors of the invention being claimed in the new application. No person may be named as an inventor in an application filed under this paragraph who was not named as an inventor in the prior application on the date the application under this paragraph was filed, except by way of correction of inventorship under § 1.48.

(5) Any new change must be made in the form of an amendment to the prior application as it existed prior to the filing of an application under this paragraph. No amendment in an application under this paragraph (a continued prosecution application) may introduce new matter or matter that would have been new matter in the prior application. Any new specification filed with the request for an application under this paragraph will not be considered part of the original application papers, but will be treated as a substitute specification in accordance with § 1.125.

(6) The filing of a continued prosecution application under this paragraph will be construed to include a waiver of confidentiality by the applicant under 35 U.S.C. 122 to the extent that any member of the public, who is entitled under the provisions of § 1.14 to access to, copies of, or information concerning either the prior application or any continuing application filed under the provisions of this paragraph, may be given similar access to, copies of, or similar information concerning the other application or applications in the file jacket.

(7) A request for an application under this paragraph is the specific reference required by 35 U.S.C. 120 to every application assigned the application number identified in such request. No amendment in an application under this paragraph may delete this specific reference to any prior application.

(8) In addition to identifying the application number of the prior application, applicant should furnish in the request for an application under this paragraph the following information relating to the prior application to the best of his or her ability:

(i) Title of invention;

(ii) Name of applicant(s); and

(iii) Correspondence address.

(9) See § 1.103(b) for requesting a limited suspension of action in an application filed under this paragraph.

(e) *Failure to meet filing date requirements.*

(1) If an application deposited under paragraph (b), (c), or (d) of this section does not meet the requirements of such paragraph to be entitled to a filing date, applicant will be so notified, if a correspondence address has been provided, and given a period of time within which to correct the filing error. If, however, a request for an application under paragraph (d) of this section does not meet the requirements of that paragraph because the application in which the request was filed is not a design application, and if the application in which the request was filed was itself filed on or after June 8, 1995, the request for an application under paragraph (d) of this section will be treated as a request for continued examination under § 1.114.

(2) Any request for review of a notification pursuant to paragraph (e)(1) of this section, or a notification that the original application papers lack a portion of the specification or drawing(s), must be by way of a petition pursuant to this paragraph accompanied by the fee set forth in § 1.17(f). In the absence of a timely (§ 1.181(f)) petition pursuant to this paragraph, the filing date of an application in which the applicant was notified of a filing error pursuant to paragraph (e)(1) of this section will be the date the filing error is corrected.

(3) If an applicant is notified of a filing error pursuant to paragraph (e)(1) of this section, but fails to correct the filing error within the given time

period or otherwise timely (§ 1.181(f)) take action pursuant to this paragraph, proceedings in the application will be considered terminated. Where proceedings in an application are terminated pursuant to this paragraph, the application may be disposed of, and any filing fees, less the handling fee set forth in § 1.21(n), will be refunded.

(f) *Completion of application subsequent to filing — Nonprovisional (including continued prosecution or reissue) application.*

(1) If an application which has been accorded a filing date pursuant to paragraph (b) or (d) of this section does not include the basic filing fee, search fee, or examination fee, or if an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include at least one claim or the inventor's oath or declaration (§§ 1.63, 1.64, 1.162 or 1.175), and the applicant has provided a correspondence address (§ 1.33(a)), the applicant will be notified and given a period of time within which to file a claim or claims, pay the basic filing fee, search fee, and examination fee, and pay the surcharge if required by § 1.16(f), to avoid abandonment.

(2) If an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include the basic filing fee, search fee, examination fee, at least one claim, or the inventor's oath or declaration, and the applicant has not provided a correspondence address (§ 1.33(a)), the applicant has three months from the filing date of the application within which to file a claim or claims, pay the basic filing fee, search fee, and examination fee, and pay the surcharge required by § 1.16(f), to avoid abandonment.

(3) The inventor's oath or declaration in an application under § 1.53(b) must also be filed within the period specified in paragraph (f)(1) or (f)(2) of this section, except that the filing of the inventor's oath or declaration may be postponed until the application is otherwise in condition for allowance under the conditions specified in paragraphs (f)(3)(i) and (f)(3)(ii) of this section.

(i) The application must be an original (non-reissue) application that contains an application data sheet in accordance with § 1.76 identifying:

(A) Each inventor by his or her legal name;

(B) A mailing address where the inventor customarily receives mail, and residence, if an inventor lives at a location which is different from where the inventor customarily receives mail, for each inventor.

(ii) The applicant must file each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, no later than the date on which the issue fee for the patent is paid. If the applicant is notified in a notice of allowability that an oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, executed by or with respect to each named inventor has not been filed, the applicant must file each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, no later than the date on which the issue fee is paid to avoid abandonment. This time period is not extendable under § 1.136 (see § 1.136(c)). The Office may dispense with the notice provided for in paragraph (f)(1) of this section if each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, has been filed before the application is in condition for allowance.

(4) If the excess claims fees required by § 1.16(h) and (i) and multiple dependent claim fee required by § 1.16(j) are not paid on filing or on later presentation of the claims for which the excess claims or multiple dependent claim fees are due, the fees required by § 1.16(h), (i), and (j) must be paid or the claims canceled by amendment prior to the expiration of the time period set for reply by the Office in any notice of fee deficiency. If the application size fee required by § 1.16(s) (if any) is not paid on filing or on later presentation of the amendment necessitating a fee or additional fee under § 1.16(s), the fee required by § 1.16(s) must be paid prior to the expiration of the time period set for reply by the Office in any notice of fee deficiency in order to avoid abandonment.

(5) This paragraph applies to continuation or divisional applications under paragraphs (b) or (d) of this section and to continuation-in-part applications under paragraph (b) of this section. *See* § 1.63(d) concerning the submission of a copy of the inventor's oath or declaration from the prior application for a continuing application under paragraph (b) of this section.

(6) If applicant does not pay the basic filing fee during the pendency of the application, the Office may dispose of the application.

(g) *Completion of application subsequent to filing — Provisional application.*

(1) If a provisional application which has been accorded a filing date pursuant to paragraph (c) of this section does not include the cover sheet required by § 1.51(c)(1) or the basic filing fee (§ 1.16(d)), and applicant has provided a correspondence address (§ 1.33(a)), applicant will be notified and given a period of time within which to pay the basic filing fee, file a cover sheet (§ 1.51(c)(1)), and pay the surcharge required by § 1.16(g) to avoid abandonment.

(2) If a provisional application which has been accorded a filing date pursuant to paragraph (c) of this section does not include the cover sheet required by § 1.51(c)(1) or the basic filing fee (§ 1.16(d)), and applicant has not provided a correspondence address (§ 1.33(a)), applicant has two months from the filing date of the application within which to pay the basic filing fee, file a cover sheet (§ 1.51(c)(1)), and pay the surcharge required by § 1.16(g) to avoid abandonment.

(3) If the application size fee required by § 1.16(s) (if any) is not paid on filing, the fee required by § 1.16(s) must be paid prior to the expiration of the time period set for reply by the Office in any notice of fee deficiency in order to avoid abandonment.

(4) If applicant does not pay the basic filing fee during the pendency of the application, the Office may dispose of the application.

(h) *Subsequent treatment of application — Nonprovisional (including continued prosecution) application.* An application for a patent filed under paragraphs (b) or (d) of this section will not be placed on the files for examination until all its required parts, complying with the rules relating thereto, are received, except that the inventor's oath or declaration may be filed when the application is otherwise in condition for allowance pursuant to paragraph (f)(3) of this section and minor informalities may be waived subject to subsequent correction whenever required.

(i) *Subsequent treatment of application - Provisional application.* A provisional application for a patent filed under paragraph (c) of this section will not be placed on the files for examination and will become abandoned no later than twelve months after its filing date pursuant to 35 U.S.C. 111(b)(1).

[48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; paras. (b) and (d), 49 FR 554, Jan. 4, 1984, effective Apr. 1, 1984; para. (c), 50 FR 31826, Aug. 6, 1985, effective Oct. 5, 1985; paras. (c) and (d), 53 FR 47808, Nov. 28, 1988, effective Jan. 1, 1989; paras. (b) and (c), 54 FR 47518, Nov. 15, 1989, effective Jan. 16, 1990; paras. (a)-(e) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (d) revised, 63 FR 5734, Feb. 4, 1998, effective Feb. 4, 1998 (adopted as final, 63 FR 36184, Jul. 2, 1998); paras. (c)(3), (c)(4) and (d) revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (paras. (c)(4) and (d) adopted as final, 65 FR 50092, Aug. 16, 2000); para. (c)(3) revised, 65 FR 50092, Aug. 16, 2000, effective Aug. 16, 2000; paras. (c)(1), (c)(2), (d)(4), (e)(2), (f), and (g) revised and para. (d)(10) added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (c)(4) revised, 65 FR 78958, Dec. 18, 2000; para. (d)(9) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; paras. (d)(1), (d)(3) and (e)(1) revised, 68 FR 32376, May 30, 2003, effective July 14, 2003; para. (d)(9) deleted and para. (d)(10) redesignated as para. (d)(9), 69 FR 29865, May 26, 2004, effective June 25, 2004; para. (e)(2) revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004; paras (c)(3), (f) and (g) revised, 70 FR 3880, Jan. 27, 2005, effective Dec., 8, 2004; paras. (d)(3) and (f)(5) revised, 70 FR 30360, May 26, 2005, effective July 1, 2005; paras. (b) and (c)(4) revised, 72 FR 46716, Aug. 21, 2007 (implementation enjoined and never became effective); paras. (b) and (c)(4) revised, 74 FR 52686, Oct. 14, 2009, effective Oct. 14, 2009 (to remove changes made by the final rules in 72 FR 46716 from the CFR); introductory text of paras. (c) and (c)(3), and paras. (d)(2)(iv), (f), and (h) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012; para.(b) introductory text, paras. (c)(2)(ii)-(iii) and (c)(4) revised, and para.(j) removed, 78 FR 11024, Feb. 14, 2013, effective Mar. 16, 2013; paras. (b), (c) and (f) revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013; para. (d)(1)(ii) revised, 79 FR 12384, Mar. 5, 2014, effective Mar. 5, 2014(adopted as final, 79 FR 68121, Nov. 14, 2014); para. (b) introductory text and paras. (c)(4) and (d)(1)(ii) revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

[***** Paragraphs (b), (c), (f) and (h) above include changes having limited applicability as follows:

The changes to paras. (b) and (c) effective Dec. 18, 2013 and May 13, 2015 are applicable only to patent applications filed on or after Dec. 18, 2013. See § 1.53

(pre-PLT(AIA)) for paras. (b) and (c) otherwise in effect; and

The changes to para. (f) effective Dec. 18, 2013 and the changes to para. (h) effective Sept. 16, 2012 are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012. See § 1.53 (pre-AIA) for paras. (f) and (h) otherwise in effect.]

§ 1.53 (pre-PLT (AIA)) Application number, filing date, and completion of application.

[Editor Note: Applicable to patent applications filed under 35 U.S.C. 111 (pre-PLT (AIA)) before December 18, 2013.]

* * * * *

(b) *Application filing requirements — Nonprovisional application.* The filing date of an application for patent filed under this section, except for a provisional application under paragraph (c) of this section or a continued prosecution application under paragraph (d) of this section, is the date on which a specification as prescribed by 35 U.S.C. 112 containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office. No new matter may be introduced into an application after its filing date. A continuing application, which may be a continuation, divisional, or continuation-in-part application, may be filed under the conditions specified in 35 U.S.C. 120, 121 or 365(c) and § 1.78(c) and (d).

(1) A continuation or divisional application that names as inventors the same or fewer than all of the inventors named in the prior application may be filed under this paragraph or paragraph (d) of this section.

(2) A continuation-in-part application (which may disclose and claim subject matter not disclosed in the prior application) or a continuation or divisional application naming an inventor not named in the prior application must be filed under this paragraph.

(c) *Application filing requirements — Provisional application.* The filing date of a provisional application is the date on which a specification as prescribed by 35 U.S.C. 112(a), and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office. No amendment, other than to make the provisional application comply with the patent statute and all applicable regulations, may be made to the provisional application after the filing date of the provisional application.

(1) A provisional application must also include the cover sheet required by § 1.51(c)(1), which may be an application data sheet (§ 1.76), or a cover letter identifying the application as a provisional application. Otherwise, the application will be treated as an application filed under paragraph (b) of this section.

(2) An application for patent filed under paragraph (b) of this section may be converted to a provisional application and be accorded the original filing date of the application filed under paragraph (b) of this section. The grant of such a request for conversion will not entitle applicant to a refund of the fees that were properly paid in the application filed under paragraph (b) of this section. Such a request for conversion must be accompanied by the processing fee set forth in § 1.17(q) and be filed prior to the earliest of:

(i) Abandonment of the application filed under paragraph (b) of this section;

(ii) Payment of the issue fee on the application filed under paragraph (b) of this section; or

(iii) Expiration of twelve months after the filing date of the application filed under paragraph (b) of this section.

(3) A provisional application filed under paragraph (c) of this section may be converted to a nonprovisional application filed under paragraph (b) of this section and accorded the original filing date of the provisional application. The conversion of a provisional application to a nonprovisional application will not result in either the refund of any fee properly paid in the provisional application or the application of any such fee to the filing fee, or any other fee, for the nonprovisional application. Conversion of a provisional application to a nonprovisional application under this paragraph will result in the term of any patent to issue from the application being measured from at least the filing date of the provisional application for which conversion is requested. Thus, applicants should consider avoiding this adverse patent term impact by filing a nonprovisional application claiming the

benefit of the provisional application under 35 U.S.C. 119(e) (rather than converting the provisional application into a nonprovisional application pursuant to this paragraph). A request to convert a provisional application to a nonprovisional application must be accompanied by the fee set forth in § 1.17(i) and an amendment including at least one claim as prescribed by 35 U.S.C. 112(b), unless the provisional application under paragraph (c) of this section otherwise contains at least one claim as prescribed by 35 U.S.C. 112(b). The nonprovisional application resulting from conversion of a provisional application must also include the filing fee, search fee, and examination fee for a nonprovisional application, the inventor's oath or declaration, and the surcharge required by § 1.16(f) if either the basic filing fee for a nonprovisional application or the inventor's oath or declaration was not present on the filing date accorded the resulting nonprovisional application (*i.e.*, the filing date of the original provisional application). A request to convert a provisional application to a nonprovisional application must also be filed prior to the earliest of:

(i) Abandonment of the provisional application filed under paragraph (c) of this section; or

(ii) Expiration of twelve months after the filing date of the provisional application filed under paragraph (c) of this section.

(4) A provisional application is not entitled to the right of priority under 35 U.S.C. 119 or 365(a) or § 1.55, or to the benefit of an earlier filing date under 35 U.S.C. 120, 121 or 365(c) or § 1.78 of any other application. No claim for priority under 35 U.S.C. 119(e) or § 1.78(a) may be made in a design application based on a provisional application. The requirements of §§ 1.821 through 1.825 regarding application disclosures containing nucleotide and/or amino acid sequences are not mandatory for provisional applications.

* * * * *

[*See § 1.53 for the current rule, including paras. (b) and (c) containing changes applicable to patent applications filed on or after Dec. 18, 2013.]

§ 1.53 (pre-AIA) Application number, filing date, and completion of application.

[Editor Note: Applicable to patent applications filed before September 16, 2012*]

* * * * *

(f) *Completion of application subsequent to filing — Nonprovisional (including continued prosecution or reissue) application.*

(1) If an application which has been accorded a filing date pursuant to paragraph (b) or (d) of this section does not include the basic filing fee, the search fee, or the examination fee, or if an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include an oath or declaration by the applicant pursuant to §§ 1.63, 1.162 or § 1.175, and applicant has provided a correspondence address (§ 1.33(a)), applicant will be notified and given a period of time within which to pay the basic filing fee, search fee, and examination fee, file an oath or declaration in an application under paragraph (b) of this section, and pay the surcharge if required by § 1.16(f) to avoid abandonment.

(2) If an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include the basic filing fee, the search fee, the examination fee, or an oath or declaration by the applicant pursuant to §§ 1.63, 1.162 or § 1.175, and applicant has not provided a correspondence address (§ 1.33(a)), applicant has two months from the filing date of the application within which to pay the basic filing fee, search fee, and examination fee, file an oath or declaration, and pay the surcharge required by § 1.16(f) to avoid abandonment.

(3) If the excess claims fees required by §§ 1.16(h) and (i) and multiple dependent claim fee required by § 1.16(j) are not paid on filing or on later presentation of the claims for which the excess claims or multiple dependent claim fees are due, the fees required by §§ 1.16(h), (i), and (j), must be paid or the claims canceled by amendment prior to the expiration of the time period set for reply by the Office in any notice of fee deficiency. If the application size fee required by § 1.16(s) (if any) is not paid on filing or on later presentation of the amendment necessitating a fee or additional fee

under § 1.16(s), the fee required by § 1.16(s) must be paid prior to the expiration of the time period set for reply by the Office in any notice of fee deficiency in order to avoid abandonment.

(4) This paragraph applies to continuation or divisional applications under paragraphs (b) or (d) of this section and to continuation-in-part applications under paragraph (b) of this section. See § 1.63(d) concerning the submission of a copy of the oath or declaration from the prior application for a continuation or divisional application under paragraph (b) of this section.

(5) If applicant does not pay the basic filing fee during the pendency of the application, the Office may dispose of the application.

* * * * *

(h) *Subsequent treatment of application — Nonprovisional (including continued prosecution) application.* An application for a patent filed under paragraphs (b) or (d) of this section will not be placed on the files for examination until all its required parts, complying with the rules relating thereto, are received, except that certain minor informalities may be waived subject to subsequent correction whenever required.

[*See § 1.53 for the portions of the rule applicable irrespective of application filing date and for current paras. (f) and (h)]

§ 1.54 Parts of application to be filed together; filing receipt.

(a) It is desirable that all parts of the complete application be deposited in the Office together; otherwise, a letter must accompany each part, accurately and clearly connecting it with the other parts of the application. See § 1.53(f) and (g) with regard to completion of an application.

(b) Applicant will be informed of the application number and filing date by a filing receipt, unless the application is an application filed under § 1.53(d). A letter limited to a request for a filing receipt may be signed by a juristic applicant or patent owner.

[48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; para. (b) amended, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (b) revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013]

§ 1.55 Claim for foreign priority.

(a) *In general.* An applicant in a nonprovisional application may claim priority to one or more prior foreign applications under the conditions specified in 35 U.S.C. 119(a) through (d) and (f), 172, 365(a) and (b), and 386(a) and (b) and this section.

(b) *Time for filing subsequent application.* The nonprovisional application must be:

(1) Filed not later than twelve months (six months in the case of a design application) after the date on which the foreign application was filed, subject to paragraph (c) of this section (a subsequent application); or

(2) Entitled to claim the benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) of a subsequent application that was filed within the period set forth in paragraph (b)(1) of this section.

(c) *Delayed filing of subsequent application.* If the subsequent application has a filing date which is after the expiration of the period set forth in paragraph (b)(1) of this section, but within two months from the expiration of the period set forth in paragraph (b)(1) of this section, the right of priority in the subsequent application may be restored under PCT Rule 26 *bis*.3 for an international application, or upon petition pursuant to this paragraph, if the delay in filing the subsequent application within the period set forth in paragraph (b)(1) of this section was unintentional. A petition to restore the right of priority under this paragraph filed on or after May 13, 2015, must be filed in the subsequent application, or in the earliest nonprovisional application claiming benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) to the subsequent application, if such subsequent application is not a nonprovisional application. Any petition to restore the right of priority under this paragraph must include:

(1) The priority claim under 35 U.S.C. 119(a) through (d) or (f), 365(a) or (b), or 386(a) or (b) in an application data sheet (§ 1.76(b)(6)), identifying the foreign application to which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, unless previously submitted;

(2) The petition fee as set forth in § 1.17(m); and

(3) A statement that the delay in filing the subsequent application within the period set forth in paragraph (b)(1) of this section was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(d) *Time for filing priority claim—*

(1) *Application under 35 U.S.C. 111(a).* The claim for priority must be filed within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application in an original application filed under 35 U.S.C. 111(a), except as provided in paragraph (e) of this section. The claim for priority must be presented in an application data sheet (§ 1.76(b)(6)) and must identify the foreign application to which priority is claimed by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. The time periods in this paragraph do not apply if the later-filed application is:

(i) An application for a design patent; or

(ii) An application filed under 35 U.S.C. 111(a) before November 29, 2000.

(2) *Application under 35 U.S.C. 371.* The claim for priority must be made within the time limit set forth in the PCT and the Regulations under the PCT in an international application entering the national stage under 35 U.S.C. 371, except as provided in paragraph (e) of this section.

(e) *Delayed priority claim.* Unless such claim is accepted in accordance with the provisions of this paragraph, any claim for priority under 35 U.S.C. 119(a) through (d) or (f), 365(a) or (b), or 386(a) or 386(b) not presented in the manner required by paragraph (d) or (m) of this section during pendency and within the time period provided by paragraph (d) of this section (if applicable) is considered to have been waived. If a claim for priority is considered to have been waived under this section, the claim may be accepted if the priority claim was unintentionally delayed. A petition to accept a delayed claim for priority under 35 U.S.C. 119(a) through (d) or (f), 365(a) or (b), or 386(a) or 386(b) must be accompanied by:

(1) The priority claim under 35 U.S.C. 119(a) through (d) or (f), 365(a) or (b), or 386(a) or 386(b) in an application data sheet (§ 1.76(b)(6)), identifying the foreign application to which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, unless previously submitted;

(2) A certified copy of the foreign application, unless previously submitted or an exception in paragraph (h), (i), or (j) of this section applies;

(3) The petition fee as set forth in § 1.17(m); and

(4) A statement that the entire delay between the date the priority claim was due under this section and the date the priority claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(f) *Time for filing certified copy of foreign application—*

(1) *Application under 35 U.S.C. 111(a).* A certified copy of the foreign application must be filed within the later of four months from the actual filing date of the application, or sixteen months from the filing date of the prior foreign application, in an original application under 35 U.S.C. 111(a) filed on or after March 16, 2013, except as provided in paragraphs (h), (i), and (j) of this section. The time period in this paragraph does not apply in a design application.

(2) *Application under 35 U.S.C. 371.* A certified copy of the foreign application must be filed within the time limit set forth in the PCT and the Regulations under the PCT in an international application entering the national stage under 35 U.S.C. 371. If a certified copy of the foreign application is not filed during the international stage in an international application in which the national stage commenced on or after December 18, 2013, a certified copy of the foreign application must be filed within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) (§ 1.491(a)), four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or sixteen months from the filing date of the prior foreign application,

except as provided in paragraphs (h), (i), and (j) of this section.

(3) If a certified copy of the foreign application is not filed within the time period specified [in] paragraph (f)(1) of this section in an application under 35 U.S.C. 111(a) or within the period specified in paragraph (f)(2) of this section in an international application entering the national stage under 35 U.S.C. 371, and an exception in paragraph (h), (i), or (j) of this section is not applicable, the certified copy of the foreign application must be accompanied by a petition including a showing of good and sufficient cause for the delay and the petition fee set forth in § 1.17(g).

(g) *Requirement for filing priority claim, certified copy of foreign application, and translation in any application.*

(1) The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed within the pendency of the application, unless filed with a petition under paragraph (e) or (f) of this section, or with a petition accompanied by the fee set forth in § 1.17(g) which includes a showing of good and sufficient cause for the delay in filing the certified copy of the foreign application in a design application. If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323.

(2) The Office may require that the claim for priority and the certified copy of the foreign application be filed earlier than otherwise provided in this section:

(i) When the application is involved in an interference (see § 41.202 of this chapter) or derivation (see part 42 of this chapter) proceeding;

(ii) When necessary to overcome the date of a reference relied upon by the examiner; or

(iii) When deemed necessary by the examiner.

(3) An English language translation of a non-English language foreign application is not required except:

(i) When the application is involved in an interference (see § 41.202 of this chapter) or derivation (see part 42 of this chapter) proceeding;

(ii) When necessary to overcome the date of a reference relied upon by the examiner; or

(iii) When specifically required by the examiner.

(4) If an English language translation of a non-English language foreign application is required, it must be filed together with a statement that the translation of the certified copy is accurate.

(h) *Certified copy in another U.S. patent or application.* The requirement in paragraphs (f) and (g) of this section for a certified copy of the foreign application will be considered satisfied in a reissue application if the patent for which reissue is sought satisfies the requirement of this section for a certified copy of the foreign application and such patent is identified as containing a certified copy of the foreign application. The requirement in paragraphs (f) and (g) of this section for a certified copy of the foreign application will also be considered satisfied in an application if a prior-filed nonprovisional application for which a benefit is claimed under 35 U.S.C. 120, 121, 365(c), or 386(c) contains a certified copy of the foreign application and such prior-filed nonprovisional application is identified as containing a certified copy of the foreign application.

(i) *Foreign intellectual property office participating in a priority document exchange agreement.* The requirement in paragraphs (f) and (g) of this section for a certified copy of the foreign application to be filed within the time limit set forth therein will be considered satisfied if:

(1) The foreign application was filed in a foreign intellectual property office participating with the Office in a bilateral or multilateral priority document exchange agreement (participating foreign intellectual property office), or a copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office that permits the Office to obtain such a copy;

(2) The claim for priority is presented in an application data sheet (§ 1.76(b)(6)), identifying the foreign application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and

year of its filing, and the applicant provides the information necessary for the participating foreign intellectual property office to provide the Office with access to the foreign application;

(3) The copy of the foreign application is received by the Office from the participating foreign intellectual property office, or a certified copy of the foreign application is filed, within the period specified in paragraph (g)(1) of this section; and

(4) The applicant files in a separate document a request that the Office obtain a copy of the foreign application from a participating intellectual property office that permits the Office to obtain such a copy where, although the foreign application was not filed in a participating foreign intellectual property office, a copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office that permits the Office to obtain such a copy. The request must identify the participating intellectual property office and the subsequent application by the application number, day, month, and year of its filing in which a copy of the foreign application was filed. The request must be filed within the later of sixteen months from the filing date of the prior foreign application, four months from the actual filing date of an application under 35 U.S.C. 111(a), four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) (§ 1.491(a)), or four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or the request must be accompanied by a petition under paragraph (e) or (f) of this section.

(j) *Interim copy.* The requirement in paragraph (f) of this section for a certified copy of the foreign application to be filed within the time limit set forth therein will be considered satisfied if:

(1) A copy of the original foreign application clearly labeled as "Interim Copy," including the specification, and any drawings or claims upon which it is based, is filed in the Office together with a separate cover sheet identifying the foreign application by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, and stating that the copy filed in the Office is a true copy of the original application as filed in the foreign country (or intellectual property authority);

(2) The copy of the foreign application and separate cover sheet are filed within the later of sixteen months from the filing date of the prior foreign application, four months from the actual filing date of an application under 35 U.S.C. 111(a), four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) (§ 1.491(a)), four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or with a petition under paragraph (e) or (f) of this section; and

(3) A certified copy of the foreign application is filed within the period specified in paragraph (g)(1) of this section.

(k) *Requirements for certain applications filed on or after March 16, 2013.* If a nonprovisional application filed on or after March 16, 2013, other than a nonprovisional international design application, claims priority to a foreign application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date as defined in § 1.109 that is on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the nonprovisional application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, sixteen months from the filing date of the prior foreign application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the nonprovisional application. An applicant is not required to provide such a statement if the applicant reasonably believes on the basis of information already known to the individuals designated in § 1.56(c)) that the nonprovisional application does not, and did not at any time, contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

(l) *Inventor's certificates.* An applicant in a nonprovisional application may under certain circumstances claim priority on the basis of one or more applications for an inventor's certificate in a country granting both inventor's certificates and patents. To claim the right of priority on the basis of an application for an inventor's certificate in such a country under 35 U.S.C. 119(d), the applicant, when submitting a claim for such right as specified in this section, must include an affidavit or

declaration. The affidavit or declaration must include a specific statement that, upon an investigation, he or she is satisfied that to the best of his or her knowledge, the applicant, when filing the application for the inventor's certificate, had the option to file an application for either a patent or an inventor's certificate as to the subject matter of the identified claim or claims forming the basis for the claim of priority.

(m) *Time for filing priority claim and certified copy of foreign application in an international design application designating the United States.* In an international design application designating the United States, the claim for priority may be made in accordance with the Hague Agreement and the Hague Agreement Regulations. In a nonprovisional international design application, the priority claim, unless made in accordance with the Hague Agreement and the Hague Agreement Regulations, must be presented in an application data sheet (§ 1.76(b)(6)), identifying the foreign application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. In a nonprovisional international design application, the priority claim and certified copy must be furnished in accordance with the time period and other conditions set forth in paragraph (g) of this section.

(n) *Applications filed before September 16, 2012.* Notwithstanding the requirement in paragraphs (d)(1), (e)(1), and (i)(2) of this section that any priority claim be presented in an application data sheet (§ 1.76), this requirement in paragraphs (d)(1), (e)(1), and (i)(2) of this section will be satisfied by the presentation of such priority claim in the oath or declaration under § 1.63 in a nonprovisional application filed under 35 U.S.C. 111(a) before September 16, 2012, or resulting from an international application filed under 35 U.S.C. 363 before September 16, 2012. The provisions of this paragraph do not apply to any priority claim submitted for a petition under paragraph (c) of this section to restore the right of priority to a foreign application.

(o) *Priority under 35 U.S.C. 386(a) or (b).* The right of priority under 35 U.S.C. 386(a) or (b) with respect to an international design application is applicable only to nonprovisional applications, international applications, and international design applications filed on or after May 13, 2015, and patents issuing thereon.

(p) *Time periods in this section.* The time periods set forth in this section are not extendable, but are subject to 35 U.S.C. 21(b) (and § 1.7(a)), PCT Rule 80.5, and Hague Agreement Rule 4(4).

[para. (b), 47 FR 41272, Sept. 17, 1982, effective Oct. 1 1982; 48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; para. (b), 49 FR 554, Jan. 4, 1984, effective Apr. 1, 1984; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (a), 54 FR 6893, Feb. 15, 1989, effective Apr. 17, 1989; para. (a) revised, 54 FR 9432, March 7, 1989, effective Apr. 17, 1989; para. (a), 54 FR 47518, Nov. 15, 1989, effective Jan. 16, 1990; para. (a) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; revised, 60 FR 20195, Apr.25, 1995, effective June 8, 1995; para. (a) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a) revised and para. (c) added, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; paras. (a) and (c) corrected, 65 FR 66502, Nov. 6, 2000, effective Nov. 29, 2000; paras.(a)(1) and (c) revised, 66 FR 67087, Dec. 28, 2001, effective Dec. 28, 2001; para. (c)(3) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; paras. (a)(3) and (a)(4) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (d) added, 72 FR 1664, Jan. 16, 2007, effective Jan. 16, 2007; introductory text of paras. (a)(1)(i) and (c), and para. (d)(1)(ii) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012; revised, 78 FR 11024, Feb. 14, 2013, effective Mar. 16, 2013; corrected 78 FR 16182, Mar. 14, 2013, effective Mar. 16, 2013; paras. (b)-(f) and (h) revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013; revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.56 Duty to disclose information material to patentability.

[Editor Note: Para. (c)(3) below is applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as

defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

(1) Prior art cited in search reports of a foreign patent office in a counterpart application, and

(2) The closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

(1) It establishes, by itself or in combination with other information, a *prima facie* case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the applicant takes in:

(i) Opposing an argument of unpatentability relied on by the Office, or

(ii) Asserting an argument of patentability.

A *prima facie* case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

(c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

(1) Each inventor named in the application;

(2) Each attorney or agent who prepares or prosecutes the application; and

(3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, the applicant, an assignee, or anyone to whom there is an obligation to assign the application.

(d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent, or inventor.

(e) In any continuation-in-part application, the duty under this section includes the duty to disclose to the Office all information known to the person to be material to patentability, as defined in paragraph (b) of this section, which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

[42 FR 5593, Jan. 28, 1977; paras. (d) & (e) - (i), 47 FR 21751, May 19, 1982, effective July 1, 1982; para. (c), 48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; paras. (b) and (j), 49 FR 554, Jan. 4, 1984, effective Apr. 1, 1984; paras. (d) and (h), 50 FR 5171, Feb. 6, 1985, effective Mar. 8, 1985; para. (e), 53 FR 47808, Nov. 28, 1988, effective Jan. 1, 1989; 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; para. (e) added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (c)(3) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012]

[* The changes to para. (c)(3) effective Sept. 16, 2012 are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012. See § 1.56 (pre-AIA) for para. (c)(3) otherwise in effect.]

§ 1.56 (pre-AIA) Duty to disclose information material to patentability.

[Editor Note: Para. (c)(3) below is **not applicable** to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012*]

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(c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

(1) Each inventor named in the application;

(2) Each attorney or agent who prepares or prosecutes the application; and

(3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.

(d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent, or inventor.

(e) In any continuation-in-part application, the duty under this section includes the duty to disclose to the Office all information known to the person to be material to patentability, as defined in paragraph (b) of this section, which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

[42 FR 5593, Jan. 28, 1977; paras. (d) & (e) - (i), 47 FR 21751, May 19, 1982, effective July 1, 1982; para. (c), 48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; paras. (b) and (j), 49 FR 554, Jan. 4, 1984, effective Apr. 1, 1984; paras. (d) and (h), 50 FR 5171, Feb. 6, 1985, effective Mar. 8, 1985; para. (e), 53 FR 47808, Nov. 28, 1988, effective Jan. 1, 1989; 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; para. (e) added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

[*See § 1.56 for more information and for the rule applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012]

§ 1.57 Incorporation by reference.

[Editor Note: Para. (a) below is only applicable to patent applications filed under 35 U.S.C. 111(a) on or after December 18, 2013*]

(a) Subject to the conditions and requirements of this paragraph, a reference made in the English language in an application data sheet in accordance with § 1.76 upon the filing of an application under 35 U.S.C. 111(a) to a previously filed application, indicating that the specification and any drawings of the application under 35 U.S.C. 111(a) are replaced by the reference to the previously filed application, and specifying the previously filed application by application number, filing date, and the intellectual property authority or country in which the previously filed application was filed, shall constitute the specification and any drawings of the application under 35 U.S.C. 111(a) for purposes of a filing date under § 1.53(b).

(1) If the applicant has provided a correspondence address (§ 1.33(a)), the applicant will be notified and given a period of time within which to file a copy of the specification and drawings from the previously filed application, an English language translation of the previously filed application, and the fee required by § 1.17(i) if it is in a language other than English, and pay the surcharge required by § 1.16(f), to avoid abandonment. Such a notice may be combined with a notice under § 1.53(f).

(2) If the applicant has not provided a correspondence address (§ 1.33(a)), the applicant has three months from the filing date of the application to file a copy of the specification and drawings from the previously filed application, an English language translation of the previously filed application, and the fee required by § 1.17(i) if it is in a language other than English, and pay the surcharge required by § 1.16(f), to avoid abandonment.

(3) An application abandoned under paragraph (a)(1) or (a)(2) of this section shall be treated as having never been filed, unless:

(i) The application is revived under § 1.137; and

(ii) A copy of the specification and any drawings of the previously filed application are filed in the Office.

(4) A certified copy of the previously filed application must be filed in the Office, unless the previously filed application is an application filed under 35 U.S.C. 111 or 363, or the previously filed application is a foreign priority application and the

conditions set forth in § 1.55(i) are satisfied with respect to such foreign priority application. The certified copy of the previously filed application, if required by this paragraph, must be filed within the later of four months from the filing date of the application or sixteen months from the filing date of the previously filed application, or be accompanied by a petition including a showing of good and sufficient cause for the delay and the petition fee set forth in § 1.17(g).

(b) Subject to the conditions and requirements of this paragraph, if all or a portion of the specification or drawing(s) is inadvertently omitted from an application, but the application contains a claim under § 1.55 for priority of a prior-filed foreign application or a claim under § 1.78 for the benefit of a prior-filed provisional, nonprovisional, international application, or international design application, that was present on the filing date of the application, and the inadvertently omitted portion of the specification or drawing(s) is completely contained in the prior-filed application, the claim under § 1.55 or 1.78 shall also be considered an incorporation by reference of the prior-filed application as to the inadvertently omitted portion of the specification or drawing(s).

(1) The application must be amended to include the inadvertently omitted portion of the specification or drawing(s) within any time period set by the Office, but in no case later than the close of prosecution as defined by § 1.114(b), or abandonment of the application, whichever occurs earlier. The applicant is also required to:

(i) Supply a copy of the prior-filed application, except where the prior-filed application is an application filed under 35 U.S.C. 111;

(ii) Supply an English language translation of any prior-filed application that is in a language other than English; and

(iii) Identify where the inadvertently omitted portion of the specification or drawings can be found in the prior-filed application.

(2) Any amendment to an international application pursuant to paragraph (b)(1) of this section shall be effective only as to the United States, and shall have no effect on the international filing date of the application. In addition, no request under this section to add the inadvertently omitted portion of the specification or drawings in an international application designating the United States will be acted upon by the Office prior to the entry and commencement of the national stage (§ 1.491) or the filing of an application under 35 U.S.C. 111(a) which claims benefit of the international application. Any omitted portion of the international application which applicant desires to be effective as to all designated States, subject to PCT Rule 20.8(b), must be submitted in accordance with PCT Rule 20.

(3) If an application is not otherwise entitled to a filing date under § 1.53(b), the amendment must be by way of a petition pursuant to § 1.53(e) accompanied by the fee set forth in § 1.17(f).

(4) Any amendment to an international design application pursuant to paragraph (b)(1) of this section shall be effective only as to the United States and shall have no effect on the filing date of the application. In addition, no request under this section to add the inadvertently omitted portion of the specification or drawings in an international design application will be acted upon by the Office prior to the international design application becoming a nonprovisional application.

(c) Except as provided in paragraph (a) or (b) of this section, an incorporation by reference must be set forth in the specification and must:

(1) Express a clear intent to incorporate by reference by using the root words “incorporat(e)” and “reference” (*e.g.*, “incorporate by reference”); and

(2) Clearly identify the referenced patent, application, or publication.

(d) “Essential material” may be incorporated by reference, but only by way of an incorporation by reference to a U.S. patent or U.S. patent application publication, which patent or patent application publication does not itself incorporate such essential material by reference. “Essential material” is material that is necessary to:

(1) Provide a written description of the claimed invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and set forth the best mode contemplated by the inventor

of carrying out the invention as required by 35 U.S.C. 112(a);

(2) Describe the claimed invention in terms that particularly point out and distinctly claim the invention as required by 35 U.S.C. 112(b); or

(3) Describe the structure, material, or acts that correspond to a claimed means or step for performing a specified function as required by 35 U.S.C. 112(f).

(e) Other material ("Nonessential material") may be incorporated by reference to U.S. patents, U.S. patent application publications, foreign patents, foreign published applications, prior and concurrently filed commonly owned U.S. applications, or non-patent publications. An incorporation by reference by hyperlink or other form of browser executable code is not permitted.

(f) The examiner may require the applicant to supply a copy of the material incorporated by reference. If the Office requires the applicant to supply a copy of material incorporated by reference, the material must be accompanied by a statement that the copy supplied consists of the same material incorporated by reference in the referencing application.

(g) Any insertion of material incorporated by reference into the specification or drawings of an application must be by way of an amendment to the specification or drawings. Such an amendment must be accompanied by a statement that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter.

(h) An incorporation of material by reference that does not comply with paragraphs (c), (d) or (e) of this section is not effective to incorporate such material unless corrected within any time period set by the Office, but in no case later than the close of prosecution as defined by § 1.114(b), or abandonment of the application, whichever occurs earlier. In addition:

(1) A correction to comply with paragraph (c)(1) of this section is permitted only if the application as filed clearly conveys an intent to incorporate the material by reference. A mere reference to material does not convey an intent to incorporate the material by reference.

(2) A correction to comply with paragraph (c)(2) of this section is only permitted for material that was sufficiently described to uniquely identify the document.

(i) An application transmittal letter limited to the transmittal of a copy of the specification and drawings from a previously filed application submitted under paragraph (a) or (b) of this section may be signed by a juristic applicant or patent owner.

[Added, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004; para. (a)(3) added, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004; para. (a)(2) revised, 72 FR 51559, Sept. 10, 2007, effective Sept. 10, 2007; paras. (c)(1)-(3) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012; revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013; para. (a) revised, para. (b) introductory text revised and para. (b)(4) added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

[* The changes to para. (a) effective Dec. 18, 2013 and May 13, 2015 are applicable only to patent applications filed on or after Dec. 18, 2013. See § 1.57 (pre-PLT) for para. (a) applicable to applications filed before Dec. 18, 2013.]

§ 1.57 (pre-PLT) Incorporation by reference.

[Editor Note: Para. (a) below is applicable to applications filed before December 18, 2013.]

(a) Subject to the conditions and requirements of this paragraph, if all or a portion of the specification or drawing(s) is inadvertently omitted from an application, but the application contains a claim under § 1.55 for priority of a prior-filed foreign application, or a claim under § 1.78 for the benefit of a prior-filed provisional, nonprovisional, or international application, that was present on the filing date of the application, and the inadvertently omitted portion of the specification or drawing(s) is completely contained in the prior-filed application, the claim under § 1.55 or § 1.78 shall also be considered an incorporation by reference of the prior-filed application as to the inadvertently omitted portion of the specification or drawing(s).

(1) The application must be amended to include the inadvertently omitted portion of the specification or drawing(s) within any time period set by the Office, but in no case later than the close of prosecution as defined by § 1.114(b), or abandonment of the application, whichever occurs earlier. The applicant is also required to:

(i) Supply a copy of the prior-filed application, except where the prior-filed application is an application filed under 35 U.S.C. 111;

(ii) Supply an English language translation of any prior-filed application that is in a language other than English; and

(iii) Identify where the inadvertently omitted portion of the specification or drawings can be found in the prior-filed application.

(2) Any amendment to an international application pursuant to this paragraph shall be effective only as to the United States, and shall have no effect on the international filing date of the application. In addition, no request under this section to add the inadvertently omitted portion of the specification or drawings in an international application designating the United States will be acted upon by the Office prior to the entry and commencement of the national stage (§ 1.491) or the filing of an application under 35 U.S.C. 111(a) which claims benefit of the international application. Any omitted portion of the international application which applicant desires to be effective as to all designated States, subject to PCT Rule 20.8(b), must be submitted in accordance with PCT Rule 20.

(3) If an application is not otherwise entitled to a filing date under § 1.53(b), the amendment must be by way of a petition pursuant to this paragraph accompanied by the fee set forth in § 1.17(f)

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[Para. (a) above is applicable to patent applications filed under 35 U.S.C. 111 (pre-PLT (AIA)) before Dec. 18, 2013. See § 1.57 for the current rule, including para. (a) applicable to patent applications filed under 35 U.S.C. 111 on or after Dec. 18, 2013.]

§ 1.58 Chemical and mathematical formulae and tables.

(a) The specification, including the claims, may contain chemical and mathematical formulae, but shall not contain drawings or flow diagrams. The description portion of the specification may contain tables, but the same tables should not be included in both the drawings and description portion of the specification. Claims may contain tables either if necessary to conform to 35 U.S.C. 112 or if otherwise found to be desirable.

(b) Tables that are submitted in electronic form (§§ 1.96(c) and 1.821(c)) must maintain the spatial relationships (*e.g.*, alignment of columns and rows) of the table elements when displayed so as to visually preserve the relational information they convey. Chemical and mathematical formulae must be encoded to maintain the proper positioning of their characters when displayed in order to preserve their intended meaning.

(c) Chemical and mathematical formulae and tables must be presented in compliance with § 1.52(a) and (b), except that chemical and mathematical formulae or tables may be placed in a landscape orientation if they cannot be presented satisfactorily in a portrait orientation. Typewritten characters used in such formulae and tables must be chosen from a block (nonscript) type font or lettering style having capital letters which should be at least 0.422 cm. (0.166 inch) high (*e.g.*, preferably Arial, Times Roman, or Courier with a font size of 12), but may be no smaller than 0.21 cm. (0.08 inch) high (*e.g.*, a font size of 6). A space at least 0.64 cm. (1/4 inch) high should be provided between complex formulae and tables and the text. Tables should have the lines and columns of data closely spaced to conserve space, consistent with a high degree of legibility.

[43 FR 20463, May 11, 1978; para. (b) removed and reserved, para. (c) amended, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; para. (b) added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004; para. (a) revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013]

§ 1.59 Expungement of information or copy of papers in application file.

(a)(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section or § 41.7(a) or § 42.7(a) of this title.

(2) Information forming part of the original disclosure (*i.e.*, written specification including the claims, drawings, and any preliminary amendment present on the filing date of the application) will not be expunged from the application file.

(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to

expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

(c) Upon request by an applicant and payment of the fee specified in § 1.19(b), the Office will furnish copies of an application, unless the application has been disposed of (*see* §§ 1.53(e), (f), and (g)). The Office cannot provide or certify copies of an application that has been disposed of.

[48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; 49 FR 554, Jan. 4, 1984, effective Apr. 1, 1984; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; 50 FR 23123, May 31, 1985, effective Feb. 11, 1985; revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (b) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (b) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; revised, 68 FR 38611, June 30, 2003, effective July 30, 2003; para. (a)(1) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (b) revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004; para. (a)(1) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012; para. (a)(2) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012]

§ 1.60 [Reserved]

[48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; 49 FR 554, Jan. 4, 1984, effective Apr. 1, 1984; 50 FR 9379, Mar. 7, 1985, effective May 8, 1985; paras. (a), (b) and (c), 54 FR 47519, Nov. 15, 1989, effective Jan. 16, 1990; paras. (b) and (c) revised, para. (d) added, 57 FR 56446, Nov. 30, 1992, effective Jan. 4, 1993; para. (b) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; removed and reserved, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.61 [Reserved]

(Editor's note: Substance is now in § 1.495)

§ 1.62 [Reserved]

[47 FR 47244, Oct. 25, 1982, added effective Feb. 27, 1983; 48 FR 2696, Jan. 20, 1983, effective date Feb. 27, 1983; paras. (a) and (d), 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; paras. (a), (c), and (h), 50 FR 9380, Mar. 7, 1985, effective May 8, 1985; paras. (e) and (j), 54 FR 47519, Nov. 15, 1989, effective Jan. 16, 1990; paras. (a) and (e) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; para. (f) revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; removed and reserved, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

OATH OR DECLARATION

§ 1.63 Inventor's oath or declaration.

[Editor Note: Applicable only to patent applications filed under 35 U.S.C. 111, 363, or 385 on or after September 16, 2012*]

(a) The inventor, or each individual who is a joint inventor of a claimed invention, in an application for patent must execute an oath or declaration directed to the application, except as provided for in § 1.64. An oath or declaration under this section must:

(1) Identify the inventor or joint inventor executing the oath or declaration by his or her legal name;

(2) Identify the application to which it is directed;

(3) Include a statement that the person executing the oath or declaration believes the named inventor or joint inventor to be the original inventor or an original joint inventor of a claimed invention in the application for which the oath or declaration is being submitted; and

(4) State that the application was made or was authorized to be made by the person executing the oath or declaration.

(b) Unless the following information is supplied in an application data sheet in accordance with § 1.76, the oath or declaration must also identify:

(1) Each inventor by his or her legal name; and

(2) A mailing address where the inventor customarily receives mail, and residence, if an inventor lives at a location which is different from where the inventor customarily receives mail, for each inventor.

(c) A person may not execute an oath or declaration for an application unless that person has reviewed and understands the contents of the application, including the claims, and is aware of the duty to disclose to the Office all information

known to the person to be material to patentability as defined in § 1.56. There is no minimum age for a person to be qualified to execute an oath or declaration, but the person must be competent to execute, *i.e.*, understand, the document that the person is executing.

(d)(1) A newly executed oath or declaration under § 1.63, or substitute statement under § 1.64, is not required under §§ 1.51(b)(2) and 1.53(f), or under §§ 1.497 and 1.1021(d), for an inventor in a continuing application that claims the benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) in compliance with § 1.78 of an earlier-filed application, provided that an oath or declaration in compliance with this section, or substitute statement under § 1.64, was executed by or with respect to such inventor and was filed in the earlier-filed application, and a copy of such oath, declaration, or substitute statement showing the signature or an indication thereon that it was executed, is submitted in the continuing application.

(2) The inventorship of a continuing application filed under 35 U.S.C. 111(a) is the inventor or joint inventors specified in the application data sheet filed before or concurrently with the copy of the inventor's oath or declaration from the earlier-filed application. If an application data sheet is not filed before or concurrently with the copy of the inventor's oath or declaration from the earlier-filed application, the inventorship is the inventorship set forth in the copy of the inventor's oath or declaration from the earlier-filed application, unless it is accompanied by a statement signed pursuant to § 1.33(b) stating the name of each inventor in the continuing application.

(3) Any new joint inventor named in the continuing application must provide an oath or declaration in compliance with this section, except as provided for in § 1.64.

(e)(1) An assignment may also serve as an oath or declaration required by this section if the assignment as executed:

(i) Includes the information and statements required under paragraphs (a) and (b) of this section; and

(ii) A copy of the assignment is recorded as provided for in part 3 of this chapter.

(2) Any reference to an oath or declaration under this section includes an assignment as provided for in this paragraph.

(f) With respect to an application naming only one inventor, any reference to the inventor's oath or declaration in this chapter includes a substitute statement executed under § 1.64. With respect to an application naming more than one inventor, any reference to the inventor's oath or declaration in this chapter means the oaths, declarations, or substitute statements that have been collectively executed by or with respect to all of the joint inventors, unless otherwise clear from the context.

(g) An oath or declaration under this section, including the statement provided for in paragraph (e) of this section, must be executed (*i.e.*, signed) in accordance either with § 1.66 or with an acknowledgment that any willful false statement made in such declaration or statement is punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.

(h) An oath or declaration filed at any time pursuant to 35 U.S.C. 115(h)(1) will be placed in the file record of the application or patent, but may not necessarily be reviewed by the Office. Any request for correction of the named inventorship must comply with § 1.48 in an application and § 1.324 in a patent.

[48 FR 2696, Jan. 20, 1983, added effective Feb. 27, 1983; 48 FR 4285, Jan. 31, 1983; paras. (b)(3) and (d), 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; para. (a) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; paras. (a) & (d) revised, para. (e) added, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a), (b), (c), and (e) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (d)(4) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004; revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012; para. (d)(1) revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

[*****The changes effective Sept. 16, 2012 and May 13, 2015 are applicable only to patent applications filed on or after Sept. 16, 2012. See § 1.63 (pre-AIA) for the rule applicable to patent applications filed before Sept. 16, 2012.]

§ 1.63 (pre-AIA) Oath or declaration.

[Editor Note: **Not applicable** to patent applications filed under 35 U.S.C. 111, 363, or 385 on or after September 16, 2012*]

(a) An oath or declaration filed under § 1.51(b)(2) as a part of a nonprovisional application must:

(1) Be executed, *i.e.*, signed, in accordance with either § 1.66 or § 1.68. There is no minimum age for a person to be qualified to sign, but the person must be competent to sign, *i.e.*, understand the document that the person is signing;

(2) Identify each inventor by full name, including the family name, and at least one given name without abbreviation together with any other given name or initial;

(3) Identify the country of citizenship of each inventor; and

(4) State that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

(b) In addition to meeting the requirements of paragraph (a) of this section, the oath or declaration must also:

(1) Identify the application to which it is directed;

(2) State that the person making the oath or declaration has reviewed and understands the contents of the application, including the claims, as amended by any amendment specifically referred to in the oath or declaration; and

(3) State that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56.

(c) Unless such information is supplied on an application data sheet in accordance with § 1.76, the oath or declaration must also identify:

(1) The mailing address, and the residence if an inventor lives at a location which is different from where the inventor customarily receives mail, of each inventor; and

(2) Any foreign application for patent (or inventor's certificate) for which a claim for priority is made pursuant to § 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month, and year of its filing.

(d)(1) A newly executed oath or declaration is not required under § 1.51(b)(2) and § 1.53(f) in a continuation or divisional application, provided that:

(i) The prior nonprovisional application contained an oath or declaration as prescribed by paragraphs (a) through (c) of this section;

(ii) The continuation or divisional application was filed by all or by fewer than all of the inventors named in the prior application;

(iii) The specification and drawings filed in the continuation or divisional application contain no matter that would have been new matter in the prior application; and

(iv) A copy of the executed oath or declaration filed in the prior application, showing the signature or an indication thereon that it was signed, is submitted for the continuation or divisional application.

(2) The copy of the executed oath or declaration submitted under this paragraph for a continuation or divisional application must be accompanied by a statement requesting the deletion of the name or names of the person or persons who are not inventors in the continuation or divisional application.

(3) Where the executed oath or declaration of which a copy is submitted for a continuation or divisional application was originally filed in a prior application accorded status under § 1.47, the copy of the executed oath or declaration for such prior application must be accompanied by:

(i) A copy of the decision granting a petition to accord § 1.47 status to the prior application, unless all inventors or legal representatives have filed an oath or declaration to join in an application accorded status under § 1.47 of which the continuation or divisional application claims a benefit under 35 U.S.C. 120, 121, or 365(c); and

(ii) If one or more inventor(s) or legal representative(s) who refused to join in the prior application or could not be found or reached has subsequently joined in the prior application or another application of which the continuation or divisional application claims a benefit under 35 U.S.C. 120, 121, or 365(c), a copy of the subsequently executed oath(s) or declaration(s) filed by the inventor or legal representative to join in the application.

(4) Where the power of attorney or correspondence address was changed during the prosecution of the prior application, the change in power of attorney or correspondence address must be identified in the continuation or divisional application. Otherwise, the Office may not recognize in the continuation or divisional application the change of power of attorney or correspondence address during the prosecution of the prior application.

(5) A newly executed oath or declaration must be filed in a continuation or divisional application naming an inventor not named in the prior application.

(e) A newly executed oath or declaration must be filed in any continuation-in-part application, which application may name all, more, or fewer than all of the inventors named in the prior application.

[48 FR 2696, Jan. 20, 1983, added effective Feb. 27, 1983; 48 FR 4285, Jan. 31, 1983; paras. (b)(3) and (d), 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; para. (a) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; paras. (a) & (d) revised, para. (e) added, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a), (b), (c), and (e) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (d)(4) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

[*See § 1.63 for more information and for the rule applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012]

§ 1.64 Substitute statement in lieu of an oath or declaration.

[Editor Note: Applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

(a) An applicant under § 1.43, 1.45 or 1.46 may execute a substitute statement in lieu of an oath or declaration under § 1.63 if the inventor is deceased, is under a legal incapacity, has refused to execute the oath or declaration under § 1.63, or cannot be found or reached after diligent effort.

(b) A substitute statement under this section must:

(1) Comply with the requirements of § 1.63(a), identifying the inventor or joint inventor with respect to whom a substitute statement in lieu of an oath or declaration is executed, and stating upon information and belief the facts which such inventor is required to state;

(2) Identify the person executing the substitute statement and the relationship of such person to the inventor or joint inventor with respect to whom the substitute statement is executed, and unless such information is supplied in an application data sheet in accordance with § 1.76, the residence and mailing address of the person signing the substitute statement;

(3) Identify the circumstances permitting the person to execute the substitute statement in lieu of an oath or declaration under § 1.63, namely whether the inventor is deceased, is under a legal incapacity, cannot be found or reached after a diligent effort was made, or has refused to execute the oath or declaration under § 1.63; and

(4) Unless the following information is supplied in an application data sheet in accordance with § 1.76, also identify:

(i) Each inventor by his or her legal name; and

(ii) The last known mailing address where the inventor customarily receives mail, and last known residence, if an inventor lives at a location which is different from where the inventor customarily receives mail, for each inventor who is not deceased or under a legal incapacity.

(c) A person may not execute a substitute statement provided for in this section for an application unless that person has reviewed and understands the contents of the application, including the claims, and is aware of the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56.

(d) Any reference to an inventor's oath or declaration includes a substitute statement provided for in this section.

(e) A substitute statement under this section must contain an acknowledgment that any willful false statement made in such statement is punishable under section 1001 of title 18 by fine or imprisonment of not more than 5 years, or both.

(f) A nonsigning inventor or legal representative may subsequently join in the application by submitting an oath or declaration under § 1.63. The submission of an oath or declaration by a nonsigning inventor or legal representative in an application filed under § 1.43, 1.45 or 1.46 will not permit the nonsigning inventor or legal representative to revoke or grant a power of attorney.

[48 FR 2696, Jan. 20, 1983, added effective Feb. 27, 1983; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012]

[*The changes effective Sept. 16, 2012 are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012. See § 1.64 (pre-AIA) for the rule otherwise in effect.]

§ 1.64 (pre-AIA) Person making oath or declaration.

[Editor Note: **Not applicable** to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

(a) The oath or declaration (§ 1.63), including any supplemental oath or declaration (§ 1.67), must be made by all of the actual inventors except as provided for in §§ 1.42, 1.43, 1.47, or § 1.67.

(b) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, 1.47, or § 1.67), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor is required to state. If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

[48 FR 2696, Jan. 20, 1983, added effective Feb. 27, 1983; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

[*See § 1.64 for more information and for the rule applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012]

§ 1.66 Statements under oath.

[Editor Note: Applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

An oath or affirmation may be made before any person within the United States authorized by law to administer oaths. An oath made in a foreign country may be made before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by a certificate of a diplomatic or consular officer of the United States, or by an apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States. The oath shall be attested in all cases in this and other countries, by the proper official seal of the officer before whom the oath or affirmation is made. Such oath or affirmation shall be valid as to execution if it complies with the laws of the State or country where made. When the person before whom the oath or affirmation is made in this country is not provided with a seal, his official character shall be established by competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal.

[47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012]

[*The changes effective Sept. 16, 2012 are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012. See § 1.66 (pre-AIA) for the rule otherwise in effect.]

§ 1.66 (pre-AIA) Officers authorized to administer oaths.

[Editor Note: **Not applicable** to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

(a) The oath or affirmation may be made before any person within the United States authorized by

law to administer oaths. An oath made in a foreign country may be made before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by a certificate of a diplomatic or consular officer of the United States, or by an apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States. The oath shall be attested in all cases in this and other countries, by the proper official seal of the officer before whom the oath or affirmation is made. Such oath or affirmation shall be valid as to execution if it complies with the laws of the State or country where made. When the person before whom the oath or affirmation is made in this country is not provided with a seal, his official character shall be established by competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal.

(b) When the oath is taken before an officer in a country foreign to the United States, any accompanying application papers, except the drawings, must be attached together with the oath and a ribbon passed one or more times through all the sheets of the application, except the drawings, and the ends of said ribbon brought together under the seal before the latter is affixed and impressed, or each sheet must be impressed with the official seal of the officer before whom the oath is taken. If the papers as filed are not properly ribboned or each sheet impressed with the seal, the case will be accepted for examination, but before it is allowed, duplicate papers, prepared in compliance with the foregoing sentence, must be filed.

[47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982]

[*See § 1.66 for more information and for the rule applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012]

§ 1.67 Supplemental oath or declaration.

[Editor Note: Applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

(a) The applicant may submit an inventor's oath or declaration meeting the requirements of § 1.63, § 1.64, or § 1.162 to correct any deficiencies or inaccuracies present in an earlier-filed inventor's oath or declaration. Deficiencies or inaccuracies due to the failure to meet the requirements of § 1.63(b) in an oath or declaration may be corrected with an application data sheet in accordance with § 1.76, except that any correction of inventorship must be pursuant to § 1.48.

(b) A supplemental inventor's oath or declaration under this section must be executed by the person whose inventor's oath or declaration is being withdrawn, replaced, or otherwise corrected.

(c) The Office will not require a person who has executed an oath or declaration in compliance with 35 U.S.C. 115 and § 1.63 or 1.162 for an application to provide an additional inventor's oath or declaration for the application.

(d) No new matter may be introduced into a nonprovisional application after its filing date even if an inventor's oath or declaration is filed to correct deficiencies or inaccuracies present in the earlier-filed inventor's oath or declaration.

[48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; para. (c) added, 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; para. (b) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; para. (b) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised and para. (c) removed and reserved, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012]

[*The changes effective Sept. 16, 2012 are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012. See § 1.67 (pre-AIA) for the rule otherwise in effect.]

§ 1.67 (pre-AIA) Supplemental oath or declaration.

[Editor Note: **Not applicable** to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

(a) The Office may require, or inventors and applicants may submit, a supplemental oath or declaration meeting the requirements of § 1.63 or § 1.162 to correct any deficiencies or inaccuracies present in the earlier filed oath or declaration.

(1) Deficiencies or inaccuracies relating to all the inventors or applicants (§§ 1.42, 1.43, or §

1.47) may be corrected with a supplemental oath or declaration signed by all the inventors or applicants.

(2) Deficiencies or inaccuracies relating to fewer than all of the inventor(s) or applicant(s) (§§ 1.42, 1.43 or § 1.47) may be corrected with a supplemental oath or declaration identifying the entire inventive entity but signed only by the inventor(s) or applicant(s) to whom the error or deficiency relates.

(3) Deficiencies or inaccuracies due to the failure to meet the requirements of § 1.63(c) (*e.g.*, to correct the omission of a mailing address of an inventor) in an oath or declaration may be corrected with an application data sheet in accordance with § 1.76.

(4) Submission of a supplemental oath or declaration or an application data sheet (§ 1.76), as opposed to who must sign the supplemental oath or declaration or an application data sheet, is governed by § 1.33(a)(2) and paragraph (b) of this section.

(b) A supplemental oath or declaration meeting the requirements of § 1.63 must be filed when a claim is presented for matter originally shown or described but not substantially embraced in the statement of invention or claims originally presented or when an oath or declaration submitted in accordance with § 1.53(f) after the filing of the specification and any required drawings specifically and improperly refers to an amendment which includes new matter. No new matter may be introduced into a nonprovisional application after its filing date even if a supplemental oath or declaration is filed. In proper situations, the oath or declaration here required may be made on information and belief by an applicant other than the inventor.

(c) [Reserved]

[48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; para. (c) added, 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; para. (b) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; para. (b) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised and para. (c) removed and reserved, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

[*See § 1.67 for more information and for the rule applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012]

§ 1.68 Declaration in lieu of oath.

Any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be under oath may be subscribed to by a written declaration. Such declaration may be used in lieu of the oath otherwise required, if, and only if, the declarant is on the same document, warned that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon. The declarant must set forth in the body of the declaration that all statements made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true.

[49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985]

§ 1.69 Foreign language oaths and declarations.

(a) Whenever an individual making an oath or declaration cannot understand English, the oath or declaration must be in a language that such individual can understand and shall state that such individual understands the content of any documents to which the oath or declaration relates.

(b) Unless the text of any oath or declaration in a language other than English is in a form provided by the Patent and Trademark Office or in accordance with PCT Rule 4.17(iv), it must be accompanied by an English translation together with a statement that the translation is accurate, except that in the case of an oath or declaration filed under § 1.63, the translation may be filed in the Office no later than two months from the date applicant is notified to file the translation.

[42 FR 5594, Jan. 28, 1977; para. (b), 48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; para. (b) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (b) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004; para. (b) revised, 70 FR 3880, Jan. 27, 2005, effective Dec. 8, 2004]

§ 1.70 [Reserved]

[52 FR 20046, May 28, 1987, effective July 1, 1987]

SPECIFICATION

§ 1.71 Detailed description and specification of the invention.

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

(d) A copyright or mask work notice may be placed in a design or utility patent application adjacent to copyright and mask work material contained therein. The notice may appear at any appropriate portion of the patent application disclosure. For notices in drawings, see § 1.84(s). The content of the notice must be limited to only those elements provided for by law. For example, "©1983 John Doe"(17 U.S.C. 401) and "*M* John Doe" (17 U.S.C. 909) would be properly limited and, under current statutes, legally sufficient notices of copyright and mask work, respectively. Inclusion of a copyright or mask work notice will be permitted only if the authorization language set forth in paragraph (e) of this section is included at the beginning (preferably as the first paragraph) of the specification.

(e) The authorization shall read as follows:

> A portion of the disclosure of this patent document contains material which is subject to (copyright or mask work) protection. The (copyright or mask work) owner has no objection to the facsimile reproduction by anyone of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent file or records, but otherwise reserves all (copyright or mask work) rights whatsoever.

(f) The specification must commence on a separate sheet. Each sheet including part of the specification may not include other parts of the application or other information. The claim(s), abstract and sequence listing (if any) should not be included on a sheet including any other part of the application.

(g)(1) The specification may disclose or be amended to disclose the names of the parties to a joint research agreement as defined in § 1.9(e).

(2) An amendment under paragraph (g)(1) of this section must be accompanied by the processing fee set forth in § 1.17(i) if not filed within one of the following time periods:

(i) Within three months of the filing date of a national application;

(ii) Within three months of the date of entry of the national stage as set forth in § 1.491 in an international application;

(iii) Before the mailing of a first Office action on the merits; or

(iv) Before the mailing of a first Office action after the filing of a request for continued examination under § 1.114.

(3) If an amendment under paragraph (g)(1) of this section is filed after the date the issue fee is paid, the patent as issued may not necessarily include the names of the parties to the joint research agreement. If the patent as issued does not include the names of the parties to the joint research agreement, the patent must be corrected to include

the names of the parties to the joint research agreement by a certificate of correction under 35 U.S.C. 255 and § 1.323 for the amendment to be effective.

[paras. (d) and (e), 53 FR 47808, Nov. 28, 1988, effective Jan. 1, 1989; para. (d), 58 FR 38719, July 20, 1993, effective Oct. 1, 1993; para. (f) added, 68 FR 38611, June 30, 2003, effective July 30, 2003; para. (g) added, 70 FR 1818, Jan. 11, 2005, effective Dec. 10, 2004; para. (g) revised, 70 FR 54259, Sept. 14, 2005, effective Sept. 14, 2005; para. (g)(1) revised, 78 FR 11024, Feb. 14, 2013, effective Mar. 16, 2013]

§ 1.72 Title and abstract.

(a) The title of the invention may not exceed 500 characters in length and must be as short and specific as possible. Characters that cannot be captured and recorded in the Office's automated information systems may not be reflected in the Office's records in such systems or in documents created by the Office. Unless the title is supplied in an application data sheet (§ 1.76), the title of the invention should appear as a heading on the first page of the specification.

(b) A brief abstract of the technical disclosure in the specification must commence on a separate sheet, preferably following the claims, under the heading "Abstract" or "Abstract of the Disclosure." The sheet or sheets presenting the abstract may not include other parts of the application or other material. The abstract must be as concise as the disclosure permits, preferably not exceeding 150 words in length. The purpose of the abstract is to enable the Office and the public generally to determine quickly from a cursory inspection the nature and gist of the technical disclosure.

[31 FR 12922, Oct. 4, 1966; 43 FR 20464, May 11, 1978; para. (b) amended, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para. (b) revised, 68 FR 38611, June 30, 2003, effective July 30, 2003; para. (b) revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013]

§ 1.73 Summary of the invention.

A brief summary of the invention indicating its nature and substance, which may include a statement of the object of the invention, should precede the detailed description. Such summary should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed.

§ 1.74 Reference to drawings.

When there are drawings, there shall be a brief description of the several views of the drawings and the detailed description of the invention shall refer to the different views by specifying the numbers of the figures and to the different parts by use of reference letters or numerals (preferably the latter).

§ 1.75 Claim(s).

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

(b) More than one claim may be presented provided they differ substantially from each other and are not unduly multiplied.

(c) One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application. Any dependent claim which refers to more than one other claim ("multiple dependent claim") shall refer to such other claims in the alternative only. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. For fee calculation purposes under § 1.16, a multiple dependent claim will be considered to be that number of claims to which direct reference is made therein. For fee calculation purposes also, any claim depending from a multiple dependent claim will be considered to be that number of claims to which direct reference is made in that multiple dependent claim. In addition to the other filing fees, any original application which is filed with, or is amended to include, multiple dependent claims must have paid therein the fee set forth in § 1.16(j). Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of each of the particular claims in relation to which it is being considered.

(d)(1) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See § 1.58(a).)

(2) See §§ 1.141 to 1.146 as to claiming different inventions in one application.

(e) Where the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order:

(1) A preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known,

(2) A phrase such as “wherein the improvement comprises,” and

(3) Those elements, steps and/or relationships which constitute that portion of the claimed combination which the applicant considers as the new or improved portion.

(f) If there are several claims, they shall be numbered consecutively in Arabic numerals.

(g) The least restrictive claim should be presented as claim number 1, and all dependent claims should be grouped together with the claim or claims to which they refer to the extent practicable.

(h) The claim or claims must commence on a separate physical sheet or electronic page. Any sheet including a claim or portion of a claim may not contain any other parts of the application or other material.

(i) Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation.

[31 FR 12922, Oct. 4, 1966; 36 FR 12690, July 3, 1971; 37 FR 21995, Oct. 18, 1972; 43 FR 4015, Jan. 31, 1978; para. (c), 47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; para. (g) amended, paras. (h) and (i) added, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; para. (h) revised, 68 FR 38611, June 30, 2003, effective July 30, 2003; para. (h) revised, 68 FR 38611, June 30, 2003, effective July 30, 2003; para. (c) revised, 70 FR 3880, Jan. 27, 2005, effective Dec. 8, 2004; paras. (b) and (c) revised, 72 FR 46716, Aug. 21, 2007 (implementation enjoined and never became effective); paras. (b) and (c) revised, 74 FR 52686, Oct. 14, 2009, effective Oct. 14, 2009 (to remove changes made by the final rules in 72 FR 46716 from the CFR)]

§ 1.76 Application data sheet.

[Editor Note: Some paragraphs have limited applicability. See * below for details.]

(a) *Application data sheet.* An application data sheet is a sheet or sheets that may be submitted in a provisional application under 35 U.S.C. 111(b), a nonprovisional application under 35 U.S.C. 111(a), a nonprovisional international design application, or a national stage application under 35 U.S.C. 371 and must be submitted when required by § 1.55 or 1.78 to claim priority to or the benefit of a prior-filed application under 35 U.S.C. 119, 120, 121, 365, or 386. An application data sheet must be titled "Application Data Sheet." An application data sheet must contain all of the section headings listed in paragraph (b) of this section, except as provided in paragraph (c)(2) of this section, with any appropriate data for each section heading. If an application data sheet is provided, the application data sheet is part of the application for which it has been submitted.

(b) *Bibliographic data.* Bibliographic data as used in paragraph (a) of this section includes:

(1) *Inventor information.* This information includes the legal name, residence, and mailing address of the inventor or each joint inventor.

(2) *Correspondence information.* This information includes the correspondence address, which may be indicated by reference to a customer number, to which correspondence is to be directed (see § 1.33(a)).

(3) *Application information.* This information includes the title of the invention, the total number of drawing sheets, a suggested drawing figure for publication (in a nonprovisional application), any docket number assigned to the application, the type of application (*e.g.*, utility, plant, design, reissue, provisional), whether the application discloses any significant part of the subject matter of an application under a secrecy order pursuant to § 5.2 of this chapter (*see* § 5.2(c)), and, for plant applications, the Latin name of the genus and species of the plant claimed, as well as the variety denomination. When information concerning the previously filed application is required under § 1.57(a), application information

also includes the reference to the previously filed application, indicating that the specification and any drawings of the application are replaced by the reference to the previously filed application, and specifying the previously filed application by application number, filing date, and the intellectual property authority or country in which the previously filed application was filed.

(4) *Representative information.* This information includes the registration number of each practitioner having a power of attorney in the application (preferably by reference to a customer number). Providing this information in the application data sheet does not constitute a power of attorney in the application (see § 1.32).

(5) *Domestic benefit information.* This information includes the application number, the filing date, the status (including patent number if available), and relationship of each application for which a benefit is claimed under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c). Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120 and § 1.78.

(6) *Foreign priority information.* This information includes the application number, country (or intellectual property authority), and filing date of each foreign application for which priority is claimed. Providing this information in the application data sheet constitutes the claim for priority as required by 35 U.S.C. 119(b) and § 1.55.

(7) *Applicant information:* This information includes the name (either natural person or juristic entity) and address of the legal representative, assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter who is the applicant under § 1.43 or § 1.46. Providing assignment information in the application data sheet does not substitute for compliance with any requirement of part 3 of this chapter to have an assignment recorded by the Office.

(c) *Correcting and updating an application data sheet.*

(1) Information in a previously submitted application data sheet, inventor's oath or declaration under § 1.63, § 1.64 or § 1.67, or otherwise of record, may be corrected or updated until payment of the issue fee by a new application data sheet providing corrected or updated information, except that inventorship changes must comply with the requirements of § 1.48, foreign priority and domestic benefit information changes must comply with §§ 1.55 and 1.78, and correspondence address changes are governed by § 1.33(a).

(2) An application data sheet providing corrected or updated information may include all of the sections listed in paragraph (b) of this section or only those sections containing changed or updated information. The application data sheet must include the section headings listed in paragraph (b) of this section for each section included in the application data sheet, and must identify the information that is being changed, with underlining for insertions, and strike-through or brackets for text removed, except that identification of information being changed is not required for an application data sheet included with an initial submission under 35 U.S.C. 371.

(d) *Inconsistencies between application data sheet and other documents.* For inconsistencies between information that is supplied by both an application data sheet under this section and other documents:

(1) The most recent submission will govern with respect to inconsistencies as between the information provided in an application data sheet, a designation of a correspondence address, or by the inventor's oath or declaration, except that:

(i) The most recent application data sheet will govern with respect to foreign priority (§ 1.55) or domestic benefit (§ 1.78) claims; and

(ii) The naming of the inventorship is governed by § 1.41 and changes to inventorship or the names of the inventors is governed by § 1.48.

(2) The information in the application data sheet will govern when inconsistent with the information supplied at the same time by a designation of correspondence address or the inventor's oath or declaration. The information in the application data sheet will govern when inconsistent with the information supplied at any time in a Patent Cooperation Treaty Request Form, Patent Law Treaty Model International Request Form, Patent Law Treaty Model International Request for Recordation of Change in Name or Address Form, or Patent Law Treaty Model

International Request for Recordation of Change in Applicant or Owner Form.

(3) The Office will capture bibliographic information from the application data sheet. The Office will generally not review the inventor's oath or declaration to determine if the bibliographic information contained therein is consistent with the bibliographic information provided in an application data sheet. Incorrect bibliographic information contained in an application data sheet may be corrected as provided in paragraph (c)(1) of this section.

(e) *Signature requirement.* An application data sheet must be signed in compliance with § 1.33(b). An unsigned application data sheet will be treated only as a transmittal letter.

(f) *Patent Law Treaty Model International Forms.* The requirement in § 1.55 or § 1.78 for the presentation of a priority or benefit claim under 35 U.S.C. 119, 120, 121, or 365 in an application data sheet will be satisfied by the presentation of such priority or benefit claim in the Patent Law Treaty Model International Request Form, and the requirement in § 1.57(a) for a reference to the previously filed application in an application data sheet will be satisfied by the presentation of such reference to the previously filed application in the Patent Law Treaty Model International Request Form. The requirement in § 1.46 for the presentation of the name of the applicant under 35 U.S.C. 118 in an application data sheet will be satisfied by the presentation of the name of the applicant in the Patent Law Treaty Model International Request Form, Patent Law Treaty Model International Request for Recordation of Change in Name or Address Form, or Patent Law Treaty Model International Request for Recordation of Change in Applicant or Owner Form, as applicable.

(g) *Patent Cooperation Treaty Request Form.* The requirement in § 1.78 for the presentation of a benefit claim under 35 U.S.C. 119, 120, 121, or 365 in an application data sheet will be satisfied in a national stage application under 35 U.S.C. 371 by the presentation of such benefit claim in the Patent Cooperation Treaty Request Form contained in the international application or the presence of such benefit claim on the front page of the publication of the international application under PCT Article 21(2). The requirement in § 1.55 or § 1.78 for the presentation of a priority or benefit claim under 35 U.S.C. 119, 120, 121, or 365 in an application data sheet and the requirement in § 1.46 for the presentation of the name of the applicant under 35 U.S.C. 118 in an application data sheet will be satisfied in an application under 35 U.S.C. 111 by the presentation of such priority or benefit claim and presentation of the name of the applicant in a Patent Cooperation Treaty Request Form. If a Patent Cooperation Treaty Request Form is submitted in an application under 35 U.S.C. 111, the Patent Cooperation Treaty Request Form must be accompanied by a clear indication that treatment of the application as an application under 35 U.S.C. 111 is desired.

[Added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (b)(7) added, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; paras. (a), (b)(4), (c)(2) and (d) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004; para. (b)(5) revised, 70 FR 54259, Sept. 14, 2005, effective Sept. 14, 2005; para. (b)(5) revised, 72 FR 46716, Aug. 21, 2007 (implementation enjoined and never became effective); para. (b)(5) revised, 74 FR 52686, Oct. 14, 2009, effective Oct. 14, 2009 (to remove changes made by the final rules in 72 FR 46716 from the CFR); paras. (a), (b)(1), (b)(3), (b)(5), (b)(7), (c), and (d) revised and para. (e) added, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012; paras. (b)(5) and (b)(6) revised, 78 FR 11024, Feb. 14, 2013, effective Mar. 16, 2013; para. (b)(3) and (d)(2) revised, paras. (f) and (g) added, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013; paras. (a), (b)(5), and (b)(6) revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

[*Paragraphs (a), (b)(1), (b)(3), (b)(5), (b)(6), (b)(7), (c), (d) and (e) above include changes having limited applicability as follows:

The changes to para. 1.76(b)(3) effective Dec. 18, 2013 are applicable only to patent applications filed under 35 U.S.C. 111 on or after Dec. 18, 2013. For para. (b)(3) applicable to applications filed on or after Sept. 16, 2012 and before Dec. 18, 2013, see § 1.76 (2012-09-16 thru 2013-12-17). For para. (b)(3) applicable to applications filed before Sept. 16, 2012, see § 1.76 (pre-AIA). The changes to paras. (a), (b)(1), (b)(5), (b)(6), (b)(7), (c), (d), and (e) effective Sept. 16, 2012 and/or May 13, 2015 are applicable only to patent applications filed on or after Sept. 16, 2012. For paras. (a), (b)(1), (b)(5), (b)(6), (b)(7), (c), and (d) in effect for applications filed prior to Sept. 16, 2012, see § 1.76 (pre-AIA).]

§ 1.76 (2012-09-16 thru 2013-12-17) Application data sheet.

[Editor Note: Para. (b)(3) below is applicable to applications filed on or after September 16, 2012 and before December 18, 2013*]

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(b) *****

(3) *Application information.* This information includes the title of the invention, the total number of drawing sheets, a suggested drawing figure for publication (in a nonprovisional application), any docket number assigned to the application, the type of application (*e.g.*, utility, plant, design, reissue, provisional), whether the application discloses any significant part of the subject matter of an application under a secrecy order pursuant to § 5.2 of this chapter (*see* § 5.2(c)), and, for plant applications, the Latin name of the genus and species of the plant claimed, as well as the variety denomination.

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Para. (b)(3) above includes changes applicable to any application filed under 35 U.S.C. 111 or 363 on or after Sept. 16, 2012 and before Mar. 16, 2013. For para. (b)(3) applicable to applications filed on or after Mar. 16, 2013, see § 1.76. For para. (b)(3) applicable to applications filed before Sept. 16, 2012, see § 1.76 (pre-AIA).

§ 1.76 (pre-AIA) Application data sheet.

[Editor Note: Paras. (a), (b)(1), (b)(3), (b)(5), (b)(7), (c) and (d) below are applicable to patent applications filed under 35 U.S.C. 111(a) or 363 before September 16, 2012.]

(a) *Application data sheet.* An application data sheet is a sheet or sheets, that may be voluntarily submitted in either provisional or nonprovisional applications, which contains bibliographic data, arranged in a format specified by the Office. An application data sheet must be titled "Application Data Sheet" and must contain all of the section headings listed in paragraph (b) of this section, with any appropriate data for each section heading. If an application data sheet is provided, the application data sheet is part of the provisional or nonprovisional application for which it has been submitted.

(b) *Bibliographic data.* Bibliographic data as used in paragraph (a) of this section includes:

(1) *Applicant information.* This information includes the name, residence, mailing address, and citizenship of each applicant (§ 1.41(b)). The name of each applicant must include the family name, and at least one given name without abbreviation together with any other given name or initial. If the applicant is not an inventor, this information also includes the applicant's authority (§§ 1.42, 1.43, and 1.47) to apply for the patent on behalf of the inventor.

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(3) *Application information.* This information includes the title of the invention, a suggested classification, by class and subclass, the Technology Center to which the subject matter of the invention is assigned, the total number of drawing sheets, a suggested drawing figure for publication (in a nonprovisional application), any docket number assigned to the application, the type of application (e.g., utility, plant, design, reissue, provisional), whether the application discloses any significant part of the subject matter of an application under a secrecy order pursuant to § 5.2 of this chapter (see § 5.2(c)), and, for plant applications, the Latin name of the genus and species of the plant claimed, as well as the variety denomination. The suggested classification and Technology Center information should be supplied for provisional applications whether or not claims are present. If claims are not present in a provisional application, the suggested classification and Technology Center should be based upon the disclosure.

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(5) *Domestic priority information.* This information includes the application number, the filing date, the status (including patent number if available), and relationship of each application for which a benefit is claimed under 35 U.S.C. 119(e), 120, 121, or 365(c). Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and § 1.78(a)(2) or § 1.78(a)(5), and need not otherwise be made part of the specification.

(6) *Foreign priority information* . This information includes the application number, country, and filing date of each foreign application

for which priority is claimed. Providing this information in the application data sheet constitutes the claim for priority as required by 35 U.S.C. 119(b) and § 1.55.

(7) *Assignee information.* This information includes the name (either person or juristic entity) and address of the assignee of the entire right, title, and interest in an application. Providing this information in the application data sheet does not substitute for compliance with any requirement of part 3 of this chapter to have an assignment recorded by the Office.

(c) *Supplemental application data sheets.* Supplemental application data sheets:

(1) May be subsequently supplied prior to payment of the issue fee either to correct or update information in a previously submitted application data sheet, or an oath or declaration under § 1.63 or § 1.67, except that inventorship changes are governed by § 1.48, correspondence changes are governed by § 1.33(a), and citizenship changes are governed by § 1.63 or § 1.67; and

(2) Must be titled "Supplemental Application Data Sheet," include all of the section headings listed in paragraph (b) of this section, include all appropriate data for each section heading, and must identify the information that is being changed, preferably with underlining for insertions, and strike-through or brackets for text removed.

(d) *Inconsistencies between application data sheet and other documents.* For inconsistencies between information that is supplied by both an application data sheet under this section and other documents.

(1) The latest submitted information will govern notwithstanding whether supplied by an application data sheet, an amendment to the specification, a designation of a correspondence address, or by a § 1.63 or § 1.67 oath or declaration, except as provided by paragraph (d)(3) of this section;

(2) The information in the application data sheet will govern when inconsistent with the information supplied at the same time by a designation of correspondence address or the inventor's oath or declaration. The information in the application data sheet will govern when inconsistent with the information supplied at any time in a Patent Cooperation Treaty Request Form, Patent Law Treaty Model International Request Form, Patent Law Treaty Model International Request for Recordation of Change in Name or Address Form, or Patent Law Treaty Model International Request for Recordation of Change in Applicant or Owner Form.

(3) The oath or declaration under § 1.63 or § 1.67 governs inconsistencies with the application data sheet in the naming of inventors (§ 1.41(a)(1)) and setting forth their citizenship (35 U.S.C. 115);

(4) The Office will capture bibliographic information from the application data sheet (notwithstanding whether an oath or declaration governs the information). Thus, the Office shall generally, for example, not look to an oath or declaration under § 1.63 to see if the bibliographic information contained therein is consistent with the bibliographic information captured from an application data sheet (whether the oath or declaration is submitted prior to or subsequent to the application data sheet). Captured bibliographic information derived from an application data sheet containing errors may be corrected if applicant submits a request therefor and a supplemental application data sheet.

[* Paras. (a), (b)(1), (b)(5), (b)(6), (b)(7), (c), and (d) above are applicable to applications filed before Sept. 16, 2012. For the current rule, including paras. (a), (b)(1), (b)(5), (b)(6), (b)(7), (c), and (d) applicable to applications filed on or after Sept. 16, 2012, see § 1.76.]

§ 1.77 Arrangement of application elements.

(a) The elements of the application, if applicable, should appear in the following order:

(1) Utility application transmittal form.

(2) Fee transmittal form.

(3) Application data sheet (see § 1.76).

(4) Specification.

(5) Drawings.

(6) The inventor's oath or declaration.

(b) The specification should include the following sections in order:

(1) Title of the invention, which may be accompanied by an introductory portion stating the

name, citizenship, and residence of the applicant (unless included in the application data sheet).

(2) Cross-reference to related applications.

(3) Statement regarding federally sponsored research or development.

(4) The names of the parties to a joint research agreement.

(5) Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on a compact disc and an incorporation-by-reference of the material on the compact disc (see § 1.52(e)(5)). The total number of compact discs including duplicates and the files on each compact disc shall be specified.

(6) Statement regarding prior disclosures by the inventor or a joint inventor.

(7) Background of the invention.

(8) Brief summary of the invention.

(9) Brief description of the several views of the drawing.

(10) Detailed description of the invention.

(11) A claim or claims.

(12) Abstract of the disclosure.

(13) "Sequence Listing," if on paper (see §§ 1.821 through 1.825).

(c) The text of the specification sections defined in paragraphs (b)(1) through (b)(12) of this section, if applicable, should be preceded by a section heading in uppercase and without underlining or bold type.

[43 FR 20464, May 11, 1978; 46 FR 2612, Jan. 12, 1981; paras. (h) and (i), 48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (b) and (c) revised, 70 FR 1818, Jan. 11, 2005, effective Dec. 10, 2004; para. (a)(6) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012; para. (b)(2) revised, (b)(6)-(12) redesignated as (b)(7)-(13), and para. (b)(6) added, 78 FR 11024, Feb. 14, 2013, effective Mar. 16, 2013]

§ 1.78 Claiming benefit of earlier filing date and cross-references to other applications.

(a) *Claims under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application.* An applicant in a nonprovisional application, other than for a design patent, or an international application designating the United States may claim the benefit of one or more prior-filed provisional applications under the conditions set forth in 35 U.S.C. 119(e) and this section.

(1) The nonprovisional application or international application designating the United States must be:

(i) Filed not later than twelve months after the date on which the provisional application was filed, subject to paragraph (b) of this section (a subsequent application); or

(ii) Entitled to claim the benefit under 35 U.S.C. 120, 121, or 365(c) of a subsequent application that was filed within the period set forth in paragraph (a)(1)(i) of this section.

(2) Each prior-filed provisional application must name the inventor or a joint inventor named in the later-filed application as the inventor or a joint inventor. In addition, each prior-filed provisional application must be entitled to a filing date as set forth in § 1.53(c), and the basic filing fee set forth in § 1.16(d) must have been paid for such provisional application within the time period set forth in § 1.53(g).

(3) Any nonprovisional application or international application designating the United States that claims the benefit of one or more prior-filed provisional applications must contain, or be amended to contain, a reference to each such prior-filed provisional application, identifying it by the provisional application number (consisting of series code and serial number). If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76(b)(5)).

(4) The reference required by paragraph (a)(3) of this section must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed provisional application. If the later-filed application is a nonprovisional application entering the national stage from an international application under 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on

which the national stage commenced under 35 U.S.C. 371(b) or (f) (§ 1.491(a)), four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or sixteen months from the filing date of the prior-filed provisional application. Except as provided in paragraph (c) of this section, failure to timely submit the reference is considered a waiver of any benefit under 35 U.S.C. 119(e) of the prior-filed provisional application. The time periods in this paragraph do not apply if the later-filed application is:

(i) An application filed under 35 U.S.C. 111(a) before November 29, 2000; or

(ii) An international application filed under 35 U.S.C. 363 before November 29, 2000.

(5) If the prior-filed provisional application was filed in a language other than English and both an English-language translation of the prior-filed provisional application and a statement that the translation is accurate were not previously filed in the prior-filed provisional application, the applicant will be notified and given a period of time within which to file, in the prior-filed provisional application, the translation and the statement. If the notice is mailed in a pending nonprovisional application, a timely reply to such a notice must include the filing in the nonprovisional application of either a confirmation that the translation and statement were filed in the provisional application, or an application data sheet (§ 1.76(b)(5)) eliminating the reference under paragraph (a)(3) of this section to the prior-filed provisional application, or the nonprovisional application will be abandoned. The translation and statement may be filed in the provisional application, even if the provisional application has become abandoned.

(6) If a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a provisional application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date as defined in § 1.109 that is on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the nonprovisional application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, sixteen months from the filing date of the prior-filed provisional application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the nonprovisional application. An applicant is not required to provide such a statement if the applicant reasonably believes on the basis of information already known to the individuals designated in § 1.56(c) that the nonprovisional application does not, and did not at any time, contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

(b) *Delayed filing of the subsequent nonprovisional application or international application designating the United States.* If the subsequent nonprovisional application or international application designating the United States has a filing date which is after the expiration of the twelve-month period set forth in paragraph (a)(1)(i) of this section but within two months from the expiration of the period set forth in paragraph (a)(1)(i) of this section, the benefit of the provisional application may be restored under PCT Rule 26 *bis*.3 for an international application, or upon petition pursuant to this paragraph, if the delay in filing the subsequent nonprovisional application or international application designating the United States within the period set forth in paragraph (a)(1)(i) of this section was unintentional.

(1) A petition to restore the benefit of a provisional application under this paragraph filed on or after May 13, 2015, must be filed in the subsequent application, and any petition to restore the benefit of a provisional application under this paragraph must include:

(i) The reference required by 35 U.S.C. 119(e) to the prior-filed provisional application in an application data sheet (§ 1.76(b)(5)) identifying it by provisional application number (consisting of series code and serial number), unless previously submitted;

(ii) The petition fee as set forth in § 1.17(m); and

(iii) A statement that the delay in filing the subsequent nonprovisional application or international application designating the United States within the twelve-month period set forth in paragraph (a)(1)(i) of this section was unintentional. The Director may require additional information

where there is a question whether the delay was unintentional.

(2) The restoration of the right of priority under PCT Rule 26 *bis*.3 to a provisional application does not affect the requirement to include the reference required by paragraph (a)(3) of this section to the provisional application in a national stage application under 35 U.S.C. 371 within the time period provided by paragraph (a)(4) of this section to avoid the benefit claim being considered waived.

(c) *Delayed claims under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application.* If the reference required by 35 U.S.C. 119(e) and paragraph (a)(3) of this section is presented in an application after the time period provided by paragraph (a)(4) of this section, the claim under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application may be accepted if the reference identifying the prior-filed application by provisional application number was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application must be accompanied by:

(1) The reference required by 35 U.S.C. 119(e) and paragraph (a)(3) of this section to the prior-filed provisional application, unless previously submitted;

(2) The petition fee as set forth in § 1.17(m); and

(3) A statement that the entire delay between the date the benefit claim was due under paragraph (a)(4) of this section and the date the benefit claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(d) *Claims under 35 U.S.C. 120, 121, 365(c), or 386(c) for the benefit of a prior-filed nonprovisional application, international application, or international design application.* An applicant in a nonprovisional application (including a nonprovisional application resulting from an international application or international design application), an international application designating the United States, or an international design application designating the United States may claim the benefit of one or more prior-filed copending nonprovisional applications, international applications designating the United States, or international design applications designating the United States under the conditions set forth in 35 U.S.C. 120, 121, 365(c), or 386(c) and this section.

(1) Each prior-filed application must name the inventor or a joint inventor named in the later-filed application as the inventor or a joint inventor. In addition, each prior-filed application must either be:

(i) An international application entitled to a filing date in accordance with PCT Article 11 and designating the United States;

(ii) An international design application entitled to a filing date in accordance with § 1.1023 and designating the United States; or

(iii) A nonprovisional application under 35 U.S.C. 111(a) that is entitled to a filing date as set forth in § 1.53(b) or (d) for which the basic filing fee set forth in § 1.16 has been paid within the pendency of the application.

(2) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application, international application designating the United States, or international design application designating the United States that claims the benefit of one or more prior-filed nonprovisional applications, international applications designating the United States, or international design applications designating the United States must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number), international application number and international filing date, or international registration number and filing date under § 1.1023. If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76(b)(5)). The reference also must identify the relationship of the applications, namely, whether the later-filed application is a continuation, divisional, or continuation-in-part of the prior-filed nonprovisional application, international application, or international design application.

(3)

(i) The reference required by 35 U.S.C. 120 and paragraph (d)(2) of this section must be submitted during the pendency of the later-filed application.

(ii) If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. If the later-filed application is a nonprovisional application entering the national stage from an international application under 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) (§ 1.491(a)), four months from the date of the initial submission under35 U.S.C. 371 to enter the national stage, or sixteen months from the filing date of the prior-filed application. The time periods in this paragraph do not apply if the later-filed application is:

(A) An application for a design patent;

(B) An application filed under 35 U.S.C. 111(a) before November 29, 2000; or

(C) An international application filed under 35 U.S.C. 363 before November 29, 2000.

(iii) Except as provided in paragraph (e) of this section, failure to timely submit the reference required by 35 U.S.C. 120 and paragraph (d)(2) of this section is considered a waiver of any benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) to the prior-filed application.

(4) The request for a continued prosecution application under § 1.53(d) is the specific reference required by 35 U.S.C. 120 to the prior-filed application. The identification of an application by application number under this section is the identification of every application assigned that application number necessary for a specific reference required by 35 U.S.C. 120 to every such application assigned that application number.

(5) Cross-references to other related applications may be made when appropriate (see § 1.14), but cross-references to applications for which a benefit is not claimed under title 35, United States Code, must not be included in an application data sheet (§ 1.76(b)(5)).

(6) If a nonprovisional application filed on or after March 16, 2013, other than a nonprovisional international design application, claims the benefit of the filing date of a nonprovisional application or an international application designating the United States filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date as defined in § 1.109 that is on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the later-filed application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, sixteen months from the filing date of the prior-filed application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the later-filed application. An applicant is not required to provide such a statement if either:

(i) The application claims the benefit of a nonprovisional application in which a statement under § 1.55(k), paragraph (a)(6) of this section, or this paragraph that the application contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013 has been filed; or

(ii) The applicant reasonably believes on the basis of information already known to the individuals designated in § 1.56(c) that the later filed application does not, and did not at any time, contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

(7) Where benefit is claimed under 35 U.S.C. 120, 121, 365(c), or 386(c) to an international application or an international design application which designates but did not originate in the United States, the Office may require a certified copy of such application together with an English translation thereof if filed in another language.

(e) *Delayed claims under 35 U.S.C. 120, 121, 365(c), or 386(c) for the benefit of a prior-filed nonprovisional application, international application, or international design application.* If the reference required by 35 U.S.C. 120 and paragraph (d)(2) of this section is presented after the time period provided by paragraph (d)(3) of this section, the claim under 35 U.S.C. 120, 121, 365(c), or 386(c) for the benefit of a prior-filed copending nonprovisional application, international application designating the United States, or international design application designating the United States may be

accepted if the reference required by paragraph (d)(2) of this section was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121 , 365(c), or 386(c) for the benefit of a prior-filed application must be accompanied by:

(1) The reference required by 35 U.S.C. 120 and paragraph (d)(2) of this section to the prior-filed application, unless previously submitted;

(2) The petition fee as set forth in § 1.17(m); and

(3) A statement that the entire delay between the date the benefit claim was due under paragraph (d)(3) of this section and the date the benefit claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(f) *Applications containing patentably indistinct claims.* Where two or more applications filed by the same applicant or assignee contain patentably indistinct claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

(g) *Applications or patents under reexamination naming different inventors and containing patentably indistinct claims.* If an application or a patent under reexamination and at least one other application naming different inventors are owned by the same person and contain patentably indistinct claims, and there is no statement of record indicating that the claimed inventions were commonly owned or subject to an obligation of assignment to the same person on the effective filing date (as defined in § 1.109), or on the date of the invention, as applicable, of the later claimed invention, the Office may require the applicant or assignee to state whether the claimed inventions were commonly owned or subject to an obligation of assignment to the same person on such date, and if not, indicate which named inventor is the prior inventor, as applicable. Even if the claimed inventions were commonly owned, or subject to an obligation of assignment to the same person on the effective filing date (as defined in § 1.109), or on the date of the invention, as applicable, of the later claimed invention, the patentably indistinct claims may be rejected under the doctrine of double patenting in view of such commonly owned or assigned applications or patents under reexamination.

(h) *Applications filed before September 16, 2012.* Notwithstanding the requirement in paragraphs (a)(3) and (d)(2) of this section that any specific reference to a prior-filed application be presented in an application data sheet (§ 1.76), this requirement in paragraph (a)(3) and (d)(2) of this section will be satisfied by the presentation of such specific reference in the first sentence(s) of the specification following the title in a nonprovisional application filed under 35 U.S.C. 111(a) before September 16, 2012, or resulting from an international application filed under 35 U.S.C. 363 before September 16, 2012. The provisions of this paragraph do not apply to any specific reference submitted for a petition under paragraph (b) of this section to restore the benefit of a provisional application.

(i) *Petitions required in international applications.* If a petition under paragraph (b), (c), or (e) of this section is required in an international application that was not filed with the United States Receiving Office and is not a nonprovisional application, then such petition may be filed in the earliest nonprovisional application that claims benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) to the international application and will be treated as having been filed in the international application.

(j) *Benefit under 35 U.S.C. 386(c).* Benefit under 35 U.S.C. 386(c) with respect to an international design application is applicable only to nonprovisional applications, international applications, and international design applications filed on or after May 13, 2015, and patents issuing thereon.

(k) *Time periods in this section.* The time periods set forth in this section are not extendable, but are subject to 35 U.S.C. 21(b) (and § 1.7(a)), PCT Rule 80.5, and Hague Agreement Rule 4(4).

[36 FR 7312, Apr. 17, 1971; 49 FR 555, Jan. 4, 1984; paras. (a), (c) & (d), 50 FR 9380, Mar. 7, 1985, effective May 8, 1985; 50 FR 11366, Mar. 21, 1985; para. (a) revised 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; paras. (a)(1) and (a)(2) revised and paras. (a)(3) and (a)(4) added, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; para. (c) revised and para. (d) deleted, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; para. (a) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (a)(3) revised, 65 FR 14865, Mar. 20, 2000,

effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); paras. (a)(2), (a)(4), and (c) revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000; paras. (a)(2), (a)(3), and (a)(4) revised and paras. (a)(5) and (a)(6) added, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para. (a) revised, 66 FR 67087, Dec. 28, 2001, effective Dec. 28, 2001; paras. (a)(3)(iii) & (a)(6)(iii) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para (a)(3) revised, 68 FR 70996, Dec. 22, 2003, effective Jan. 21, 2004; paras. (a)(1), (a)(2)(iii), (a)(5)(iii) and (c) revised, 69 FR 56481, Sept. 21, 2004, effective Sept. 21, 2004; para. (a)(4) revised, 70 FR 3880, Jan. 27, 2005, effective Dec. 8, 2004; para.(a)(1)(iii) removed and para. (a)(1)(ii) revised, 70 FR 30360, May 26, 2005, effective July 1, 2005; para. (a)(5)(iv) revised, 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005; revised, 72 FR 46716, Aug. 21, 2007 (implementation enjoined and never became effective); revised, 74 FR 52686, Oct. 14, 2009, effective Oct. 14, 2009 (to remove changes made by the final rules in 72 FR 46716 from the CFR); paras. (a)(1) introductory text and (a)(4) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012; paras. (a)(2)(iii), (a)(5)(iii), (a)(5)(iv), and (c) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012; revised, 78 FR 11024, Feb. 14, 2013, effective Mar. 16, 2013; revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013; revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.79 [Reserved]

[Removed and reserved, 84 FR 51977, Oct. 1, 2019, effective Oct. 31, 2019]

THE DRAWINGS

§ 1.81 Drawings required in patent application.

[Editor Note: Para. (a) below is applicable only to patent applications filed under 35 U.S.C. 111 on or after December 18, 2013*]

(a) The applicant for a patent is required to furnish a drawing of the invention where necessary for the understanding of the subject matter sought to be patented. Since corrections are the responsibility of the applicant, the original drawing(s) should be retained by the applicant for any necessary future correction.

(b) Drawings may include illustrations which facilitate an understanding of the invention (for example, flow sheets in cases of processes, and diagrammatic views).

(c) Whenever the nature of the subject matter sought to be patented admits of illustration by a drawing without its being necessary for the understanding of the subject matter and the applicant has not furnished such a drawing, the examiner will require its submission within a time period of not less than two months from the date of the sending of a notice thereof.

(d) Drawings submitted after the filing date of the application may not be used to overcome any insufficiency of the specification due to lack of an enabling disclosure or otherwise inadequate disclosure therein, or to supplement the original disclosure thereof for the purpose of interpretation of the scope of any claim.

[43 FR 4015, Jan. 31, 1978; para. (a), 53 FR 47809, Nov. 28, 1988, effective Jan. 1, 1989; para. (a) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012; para. (a) revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013]

[* Para. (a) above is only applicable to applications filed under 35 U.S.C. 111 on or after Dec. 18, 2013. See § 1.81 (2012-09-16 thru 2013-12-17) for para. (a) applicable to applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012 and before Dec. 18, 2013. See § 1.81 (pre-AIA) for para. (a) applicable to applications filed before Sept. 16, 2012.]

§ 1.81 (2012-09-16 thru 2013-12-17) Drawings required in patent application.

[Editor Note: Para. (a) below is applicable to patent applications filed on or after September 16, 2012 and before December 18, 2013.]

(a) The applicant for a patent is required to furnish a drawing of the invention where necessary for the understanding of the subject matter sought to be patented; this drawing, or a high quality copy thereof, must be filed with the application. Since corrections are the responsibility of the applicant, the original drawing(s) should be retained by the applicant for any necessary future correction.

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[* Para. (a) above is applicable to applications filed under 35 U.S.C. 111 or 363 on or after Sept. 16, 2012 and before Dec. 18, 2013. See § 1.81 for the current rule, including para. (a) applicable to applications filed under 35 U.S.C. 111 on or after Dec. 18, 2013. See § 1.81 (pre-AIA) for para. (a) applicable to applications filed before Sept. 16, 2012.]

§ 1.81 (pre-AIA) Drawings required in patent application.

[Editor Note: Para. (a) below is applicable to patent applications filed before September 16, 2012*]

(a) The applicant for a patent is required to furnish a drawing of his or her invention where necessary for the understanding of the subject matter sought to be patented; this drawing, or a high quality copy thereof, must be filed with the application. Since corrections are the responsibility of the applicant, the original drawing(s) should be retained by the applicant for any necessary future correction.

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[* Para. (a) above is applicable to applications filed before Sept. 16, 2012. See § 1.81 for the current rule including para. (a) applicable to applications filed under 35 U.S.C. 111 on or after Dec. 18, 2013. See § 1.81 (2012-09-16 thru 2013-12-17) for para. (a) applicable to applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012 and before Dec. 18, 2013.]

§ 1.83 Content of drawing.

(a) The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (*e.g.*, a labeled rectangular box). In addition, tables that are included in the specification and sequences that are included in sequence listings should not be duplicated in the drawings.

(b) When the invention consists of an improvement on an old machine the drawing must when possible exhibit, in one or more views, the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

(c) Where the drawings in a nonprovisional application do not comply with the requirements of paragraphs (a) and (b) of this section, the examiner shall require such additional illustration within a time period of not less than two months from the date of the sending of a notice thereof. Such corrections are subject to the requirements of § 1.81(d).

[31 FR 12923, Oct. 4, 1966; 43 FR 4015, Jan. 31, 1978; paras. (a) and (c) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; para. (a) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004; para. (a) revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013]

§ 1.84 Standards for drawings.

(a) *Drawings.* There are two acceptable categories for presenting drawings in utility and design patent applications.

(1) *Black ink.* Black and white drawings are normally required. India ink, or its equivalent that secures solid black lines, must be used for drawings; or

(2) *Color.* Color drawings are permitted in design applications. Where a design application contains color drawings, the application must include the number of sets of color drawings required by paragraph (a)(2)(ii) of this section and the specification must contain the reference required by paragraph (a)(2)(iii) of this section. On rare occasions, color drawings may be necessary as the only practical medium by which to disclose the subject matter sought to be patented in a utility patent application. The color drawings must be of sufficient quality such that all details in the drawings are reproducible in black and white in the printed patent. Color drawings are not permitted in international applications (see PCT Rule 11.13). The Office will accept color drawings in utility patent applications only after granting a petition filed under this paragraph explaining why the color drawings are necessary. Any such petition must include the following:

(i) The fee set forth in § 1.17(h);

(ii) One (1) set of color drawings if submitted via the Office electronic filing system or three (3) sets of color drawings if not submitted via the Office electronic filing system; and

(iii) An amendment to the specification to insert (unless the specification contains or has been previously amended to contain) the following language as the first paragraph of the brief description of the drawings:

The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee.

(b) *Photographs.*—

(1) *Black and white.* Photographs, including photocopies of photographs, are not ordinarily permitted in utility and design patent applications. The Office will accept photographs in utility and design patent applications, however, if photographs are the only practicable medium for illustrating the claimed invention. For example, photographs or photomicrographs of: electrophoresis gels, blots (*e.g.*, immunological, western, Southern, and northern), autoradiographs, cell cultures (stained and unstained), histological tissue cross sections (stained and unstained), animals, plants, in vivo imaging, thin layer chromatography plates, crystalline structures, and, in a design patent application, ornamental effects, are acceptable. If the subject matter of the application admits of illustration by a drawing, the examiner may require a drawing in place of the photograph. The photographs must be of sufficient quality so that all details in the photographs are reproducible in the printed patent.

(2) *Color photographs.* Color photographs will be accepted in utility and design patent applications if the conditions for accepting color drawings and black and white photographs have been satisfied. See paragraphs (a)(2) and (b)(1) of this section.

(c) *Identification of drawings.* Identifying indicia should be provided, and if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet within the top margin. Each drawing sheet submitted after the filing date of an application must be identified as either "Replacement Sheet" or "New Sheet" pursuant to § 1.121(d). If a marked-up copy of any amended drawing figure including annotations indicating the changes made is filed, such marked-up copy must be clearly labeled as "Annotated Sheet" pursuant to § 1.121(d)(1).

(d) *Graphic forms in drawings.* Chemical or mathematical formulae, tables, and waveforms may be submitted as drawings, and are subject to the same requirements as drawings. Each chemical or mathematical formula must be labeled as a separate figure, using brackets when necessary, to show that information is properly integrated. Each group of waveforms must be presented as a single figure, using a common vertical axis with time extending along the horizontal axis. Each individual waveform discussed in the specification must be identified with a separate letter designation adjacent to the vertical axis.

(e) *Type of paper.* Drawings submitted to the Office must be made on paper which is flexible, strong, white, smooth, non-shiny, and durable. All sheets must be reasonably free from cracks, creases, and folds. Only one side of the sheet may be used for the drawing. Each sheet must be reasonably free from erasures and must be free from alterations, overwritings, and interlineations. Photographs must be developed on paper meeting the sheet-size requirements of paragraph (f) of this section and the margin requirements of paragraph (g) of this section. See paragraph (b) of this section for other requirements for photographs.

(f) *Size of paper.* All drawing sheets in an application must be the same size. One of the shorter sides of the sheet is regarded as its top. The size of the sheets on which drawings are made must be:

(1) 21.0 cm. by 29.7 cm. (DIN size A4), or

(2) 21.6 cm. by 27.9 cm. (8 1/2 by 11 inches).

(g) *Margins.* The sheets must not contain frames around the sight (*i.e.*, the usable surface), but should have scan target points (*i.e.*, cross-hairs) printed on two catercorner margin corners. Each sheet must include a top margin of at least 2.5 cm. (1 inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 1.5 cm. (5/8 inch), and a bottom margin of at least 1.0 cm. (3/8 inch), thereby leaving a sight no greater than 17.0 cm. by 26.2 cm. on 21.0 cm. by 29.7 cm. (DIN size A4) drawing sheets, and a sight no greater than 17.6 cm. by 24.4 cm. (6 15/16 by 9 5/8 inches) on 21.6 cm. by 27.9 cm. (8 1/2 by 11 inch) drawing sheets.

(h) *Views.* The drawing must contain as many views as necessary to show the invention. The views may be plan, elevation, section, or perspective

views. Detail views of portions of elements, on a larger scale if necessary, may also be used. All views of the drawing must be grouped together and arranged on the sheet(s) without wasting space, preferably in an upright position, clearly separated from one another, and must not be included in the sheets containing the specifications, claims, or abstract. Views must not be connected by projection lines and must not contain center lines. Waveforms of electrical signals may be connected by dashed lines to show the relative timing of the waveforms.

(1) *Exploded views.* Exploded views, with the separated parts embraced by a bracket, to show the relationship or order of assembly of various parts are permissible. When an exploded view is shown in a figure which is on the same sheet as another figure, the exploded view should be placed in brackets.

(2) *Partial views.* When necessary, a view of a large machine or device in its entirety may be broken into partial views on a single sheet, or extended over several sheets if there is no loss in facility of understanding the view. Partial views drawn on separate sheets must always be capable of being linked edge to edge so that no partial view contains parts of another partial view. A smaller scale view should be included showing the whole formed by the partial views and indicating the positions of the parts shown. When a portion of a view is enlarged for magnification purposes, the view and the enlarged view must each be labeled as separate views.

(i) Where views on two or more sheets form, in effect, a single complete view, the views on the several sheets must be so arranged that the complete figure can be assembled without concealing any part of any of the views appearing on the various sheets.

(ii) A very long view may be divided into several parts placed one above the other on a single sheet. However, the relationship between the different parts must be clear and unambiguous.

(3) *Sectional views.* The plane upon which a sectional view is taken should be indicated on the view from which the section is cut by a broken line. The ends of the broken line should be designated by Arabic or Roman numerals corresponding to the view number of the sectional view, and should have arrows to indicate the direction of sight. Hatching must be used to indicate section portions of an object, and must be made by regularly spaced oblique parallel lines spaced sufficiently apart to enable the lines to be distinguished without difficulty. Hatching should not impede the clear reading of the reference characters and lead lines. If it is not possible to place reference characters outside the hatched area, the hatching may be broken off wherever reference characters are inserted. Hatching must be at a substantial angle to the surrounding axes or principal lines, preferably 45°. A cross section must be set out and drawn to show all of the materials as they are shown in the view from which the cross section was taken. The parts in cross section must show proper material(s) by hatching with regularly spaced parallel oblique strokes, the space between strokes being chosen on the basis of the total area to be hatched. The various parts of a cross section of the same item should be hatched in the same manner and should accurately and graphically indicate the nature of the material(s) that is illustrated in cross section. The hatching of juxtaposed different elements must be angled in a different way. In the case of large areas, hatching may be confined to an edging drawn around the entire inside of the outline of the area to be hatched. Different types of hatching should have different conventional meanings as regards the nature of a material seen in cross section.

(4) *Alternate position.* A moved position may be shown by a broken line superimposed upon a suitable view if this can be done without crowding; otherwise, a separate view must be used for this purpose.

(5) *Modified forms.* Modified forms of construction must be shown in separate views.

(i) *Arrangement of views***.** One view must not be placed upon another or within the outline of another. All views on the same sheet should stand in the same direction and, if possible, stand so that they can be read with the sheet held in an upright position. If views wider than the width of the sheet are necessary for the clearest illustration of the invention, the sheet may be turned on its side so that the top of the sheet, with the appropriate top margin to be used as the heading space, is on the right-hand side. Words must appear in a horizontal, left-to-right fashion when the page is either upright or turned so that the top becomes the right side, except for graphs utilizing standard scientific convention to denote

the axis of abscissas (of X) and the axis of ordinates (of Y).

(j) *Front page view.* The drawing must contain as many views as necessary to show the invention. One of the views should be suitable for inclusion on the front page of the patent application publication and patent as the illustration of the invention. Views must not be connected by projection lines and must not contain center lines. Applicant may suggest a single view (by figure number) for inclusion on the front page of the patent application publication and patent.

(k) *Scale.* The scale to which a drawing is made must be large enough to show the mechanism without crowding when the drawing is reduced in size to two-thirds in reproduction. Indications such as "actual size" or "scale 1/2" on the drawings are not permitted since these lose their meaning with reproduction in a different format.

(l) *Character of lines, numbers, and letters.* All drawings must be made by a process which will give them satisfactory reproduction characteristics. Every line, number, and letter must be durable, clean, black (except for color drawings), sufficiently dense and dark, and uniformly thick and well-defined. The weight of all lines and letters must be heavy enough to permit adequate reproduction. This requirement applies to all lines however fine, to shading, and to lines representing cut surfaces in sectional views. Lines and strokes of different thicknesses may be used in the same drawing where different thicknesses have a different meaning.

(m) *Shading.* The use of shading in views is encouraged if it aids in understanding the invention and if it does not reduce legibility. Shading is used to indicate the surface or shape of spherical, cylindrical, and conical elements of an object. Flat parts may also be lightly shaded. Such shading is preferred in the case of parts shown in perspective, but not for cross sections. See paragraph (h)(3) of this section. Spaced lines for shading are preferred. These lines must be thin, as few in number as practicable, and they must contrast with the rest of the drawings. As a substitute for shading, heavy lines on the shade side of objects can be used except where they superimpose on each other or obscure reference characters. Light should come from the upper left corner at an angle of 45°. Surface delineations should preferably be shown by proper shading. Solid black shading areas are not permitted, except when used to represent bar graphs or color.

(n) *Symbols.* Graphical drawing symbols may be used for conventional elements when appropriate. The elements for which such symbols and labeled representations are used must be adequately identified in the specification. Known devices should be illustrated by symbols which have a universally recognized conventional meaning and are generally accepted in the art. Other symbols which are not universally recognized may be used, subject to approval by the Office, if they are not likely to be confused with existing conventional symbols, and if they are readily identifiable.

(o) *Legends.* Suitable descriptive legends may be used subject to approval by the Office, or may be required by the examiner where necessary for understanding of the drawing. They should contain as few words as possible.

(p) *Numbers, letters, and reference characters.*

(1) Reference characters (numerals are preferred), sheet numbers, and view numbers must be plain and legible, and must not be used in association with brackets or inverted commas, or enclosed within outlines, *e.g.*, encircled. They must be oriented in the same direction as the view so as to avoid having to rotate the sheet. Reference characters should be arranged to follow the profile of the object depicted.

(2) The English alphabet must be used for letters, except where another alphabet is customarily used, such as the Greek alphabet to indicate angles, wavelengths, and mathematical formulas.

(3) Numbers, letters, and reference characters must measure at least .32 cm. (1/8 inch) in height. They should not be placed in the drawing so as to interfere with its comprehension. Therefore, they should not cross or mingle with the lines. They should not be placed upon hatched or shaded surfaces. When necessary, such as indicating a surface or cross section, a reference character may be underlined and a blank space may be left in the hatching or shading where the character occurs so that it appears distinct.

(4) The same part of an invention appearing in more than one view of the drawing must always be designated by the same reference character, and

the same reference character must never be used to designate different parts.

(5) Reference characters not mentioned in the description shall not appear in the drawings. Reference characters mentioned in the description must appear in the drawings.

(q) *Lead lines.* Lead lines are those lines between the reference characters and the details referred to. Such lines may be straight or curved and should be as short as possible. They must originate in the immediate proximity of the reference character and extend to the feature indicated. Lead lines must not cross each other. Lead lines are required for each reference character except for those which indicate the surface or cross section on which they are placed. Such a reference character must be underlined to make it clear that a lead line has not been left out by mistake. Lead lines must be executed in the same way as lines in the drawing. See paragraph (l) of this section.

(r) *Arrows.* Arrows may be used at the ends of the lines, provided that their meaning is clear, as follows:

(1) On a lead line, a freestanding arrow to indicate the entire section towards which it points;

(2) On a lead line, an arrow touching a line to indicate the surface shown by the line looking along the direction of the arrow; or

(3) To show the direction of movement.

(s) *Copyright or Mask Work Notice.* A copyright or mask work notice may appear in the drawing, but must be placed within the sight of the drawing immediately below the figure representing the copyright or mask work material and be limited to letters having a print size of .32 cm. to .64 cm. (1/8 to 1/4 inches) high. The content of the notice must be limited to only those elements provided for by law. For example, "©1983 John Doe" (17 U.S.C. 401) and "*M* John Doe" (17 U.S.C. 909) would be properly limited and, under current statutes, legally sufficient notices of copyright and mask work, respectively. Inclusion of a copyright or mask work notice will be permitted only if the authorization language set forth in § 1.71(e) is included at the beginning (preferably as the first paragraph) of the specification.

(t) *Numbering of sheets of drawings.* The sheets of drawings should be numbered in consecutive Arabic numerals, starting with 1, within the sight as defined in paragraph (g) of this section. These numbers, if present, must be placed in the middle of the top of the sheet, but not in the margin. The numbers can be placed on the right-hand side if the drawing extends too close to the middle of the top edge of the usable surface. The drawing sheet numbering must be clear and larger than the numbers used as reference characters to avoid confusion. The number of each sheet should be shown by two Arabic numerals placed on either side of an oblique line, with the first being the sheet number and the second being the total number of sheets of drawings, with no other marking.

(u) *Numbering of views.*

(1) The different views must be numbered in consecutive Arabic numerals, starting with 1, independent of the numbering of the sheets and, if possible, in the order in which they appear on the drawing sheet(s). Partial views intended to form one complete view, on one or several sheets, must be identified by the same number followed by a capital letter. View numbers must be preceded by the abbreviation "FIG." Where only a single view is used in an application to illustrate the claimed invention, it must not be numbered and the abbreviation "FIG." must not appear.

(2) Numbers and letters identifying the views must be simple and clear and must not be used in association with brackets, circles, or inverted commas. The view numbers must be larger than the numbers used for reference characters.

(v) *Security markings***.** Authorized security markings may be placed on the drawings provided they are outside the sight, preferably centered in the top margin.

(w) *Corrections.* Any corrections on drawings submitted to the Office must be durable and permanent.

(x) *Holes.* No holes should be made by applicant in the drawing sheets.

(y) *Types of drawings.* See § 1.152 for design drawings, § 1.1026 for international design reproductions, § 1.165 for plant drawings, and § 1.173(a)(2) for reissue drawings.

[24 FR 10332, Dec. 22, 1959; 31 FR 12923, Oct. 4, 1966; 36 FR 9775, May 28, 1971; 43 FR 20464, May 11, 1978; 45 FR 73657, Nov. 6,1980; paras. (a), (b), (i),

(j), and (l) amended, paras. (n), (o), and (p) added, 53 FR 47809, Nov. 28, 1988, effective Jan. 1, 1989; revised, 58 FR 38719, July 20, 1993, effective Oct. 1, 1993; paras. (c), (f), (g), and (x) revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; paras. (a)(2)(i), (b), (c) & (g) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a), (b), (c), (j), (k), (o), and (x) revised, and para. (y) added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a)(2), (e), and (j) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para. (c) revised, 69 FR 56481, Sept. 21, 2004, effective Sept. 21, 2004; para. (a)(2) revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004; para. (y) revised, 70 FR 3880, Jan. 27, 2005, effective Dec. 8, 2004; para.(a)(2) introductory text revised, 78 FR 11024, Feb. 14, 2013, effective Mar. 16, 2013; paras. (a)(2) and (y) revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.85 Corrections to drawings.

(a) A utility or plant application will not be placed on the files for examination until objections to the drawings have been corrected. Except as provided in § 1.215(c), any patent application publication will not include drawings filed after the application has been placed on the files for examination. Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a *bona fide* attempt to advance the application to final action (§ 1.135(c)). If a drawing in a design application meets the requirements of § 1.84(e), (f), and (g) and is suitable for reproduction, but is not otherwise in compliance with § 1.84, the drawing may be admitted for examination.

(b) The Office will not release drawings for purposes of correction. If corrections are necessary, new corrected drawings must be submitted within the time set by the Office.

(c) If a corrected drawing is required or if a drawing does not comply with § 1.84 or an amended drawing submitted under § 1.121(d) in a nonprovisional international design application does not comply with § 1.1026 at the time an application is allowed, the Office may notify the applicant in a notice of allowability and set a three-month period of time from the mail date of the notice of allowability within which the applicant must file a corrected drawing in compliance with § 1.84 or 1.1026, as applicable, to avoid abandonment. This time period is not extendable under § 1.136 (see § 1.136(c)).

[47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; 53 FR 47810, Nov. 28, 1988, effective Jan. 1, 1989; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para. (c) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004; para. (c) revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013; para. (c) revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.88 [Reserved]

[Deleted, 58 FR 38719, July 20, 1993, effective Oct. 1, 1993]

MODELS, EXHIBITS, SPECIMENS

§ 1.91 Models or exhibits not generally admitted as part of application or patent.

(a) A model or exhibit will not be admitted as part of the record of an application unless it:

(1) Substantially conforms to the requirements of § 1.52 or § 1.84;

(2) Is specifically required by the Office; or

(3) Is filed with a petition under this section including:

(i) The fee set forth in § 1.17(h); and

(ii) An explanation of why entry of the model or exhibit in the file record is necessary to demonstrate patentability.

(b) Notwithstanding the provisions of paragraph (a) of this section, a model, working model, or other physical exhibit may be required by the Office if deemed necessary for any purpose in examination of the application.

(c) Unless the model or exhibit substantially conforms to the requirements of § 1.52 or § 1.84 under paragraph (a)(1) of this section, it must be accompanied by photographs that show multiple views of the material features of the model or exhibit and that substantially conform to the requirements of § 1.84.

[Revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (a)(3)(i) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (c) added, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

§ 1.92 [Reserved]

[Removed and reserved, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.93 Specimens.

When the invention relates to a composition of matter, the applicant may be required to furnish specimens of the composition, or of its ingredients or intermediates, for the purpose of inspection or experiment.

§ 1.94 Return of models, exhibits or specimens.

(a) Models, exhibits, or specimens may be returned to the applicant if no longer necessary for the conduct of business before the Office. When applicant is notified that a model, exhibit, or specimen is no longer necessary for the conduct of business before the Office and will be returned, applicant must arrange for the return of the model, exhibit, or specimen at the applicant's expense. The Office will dispose of perishables without notice to applicant unless applicant notifies the Office upon submission of the model, exhibit or specimen that a return is desired and makes arrangements for its return promptly upon notification by the Office that the model, exhibit or specimen is no longer necessary for the conduct of business before the Office.

(b) Applicant is responsible for retaining the actual model, exhibit, or specimen for the enforceable life of any patent resulting from the application. The provisions of this paragraph do not apply to a model or exhibit that substantially conforms to the requirements of § 1.52 or § 1.84, where the model or exhibit has been described by photographs that substantially conform to § 1.84, or where the model, exhibit or specimen is perishable.

(c) Where applicant is notified, pursuant to paragraph (a) of this section, of the need to arrange for return of a model, exhibit or specimen, applicant must arrange for the return within the period set in such notice, to avoid disposal of the model, exhibit or specimen by the Office. Extensions of time are available under § 1.136, except in the case of perishables. Failure to establish that the return of the item has been arranged for within the period set or failure to have the item removed from Office storage within a reasonable amount of time notwithstanding any arrangement for return, will permit the Office to dispose of the model, exhibit or specimen.

[Revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

§ 1.95 Copies of exhibits.

Copies of models or other physical exhibits will not ordinarily be furnished by the Office, and any model or exhibit in an application or patent shall not be taken from the Office except in the custody of an employee of the Office specially authorized by the Director.

[Revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

§ 1.96 Submission of computer program listings.

(a) *General.* Descriptions of the operation and general content of computer program listings should appear in the description portion of the specification. A computer program listing for the purpose of this section is defined as a printout that lists in appropriate sequence the instructions, routines, and other contents of a program for a computer. The program listing may be either in machine or machine-independent (object or source) language which will cause a computer to perform a desired procedure or task such as solve a problem, regulate the flow of work in a computer, or control or monitor events. Computer program listings may be submitted in patent applications as set forth in paragraphs (b) and (c) of this section.

(b) *Material which will be printed in the patent:* If the computer program listing is contained in 300 lines or fewer, with each line of 72 characters or fewer, it may be submitted either as drawings or as part of the specification.

(1) *Drawings.* If the listing is submitted as drawings, it must be submitted in the manner and complying with the requirements for drawings as

provided in § 1.84. At least one figure numeral is required on each sheet of drawing.

(2) *Specification.*

(i) If the listing is submitted as part of the specification, it must be submitted in accordance with the provisions of § 1.52.

(ii) Any listing having more than 60 lines of code that is submitted as part of the specification must be positioned at the end of the description but before the claims. Any amendment must be made by way of submission of a substitute sheet.

(c) *As an appendix which will not be printed:* Any computer program listing may, and any computer program listing having over 300 lines (up to 72 characters per line) must, be submitted on a compact disc in compliance with § 1.52(e). A compact disc containing such a computer program listing is to be referred to as a "computer program listing appendix." The "computer program listing appendix" will not be part of the printed patent. The specification must include a reference to the "computer program listing appendix" at the location indicated in § 1.77(b)(5).

(1) Multiple computer program listings for a single application may be placed on a single compact disc. Multiple compact discs may be submitted for a single application if necessary. A separate compact disc is required for each application containing a computer program listing that must be submitted on a "computer program listing appendix."

(2) The "computer program listing appendix" must be submitted on a compact disc that complies with § 1.52(e) and the following specifications (no other format shall be allowed):

(i) Computer Compatibility: IBM PC/XT/AT, or compatibles, or Apple Macintosh;

(ii) Operating System Compatibility: MS-DOS, MS-Windows, Unix, or Macintosh;

(iii) Line Terminator: ASCII Carriage Return plus ASCII Line Feed;

(iv) Control Codes: the data must not be dependent on control characters or codes which are not defined in the ASCII character set; and

(v) Compression: uncompressed data.

[46 FR 2612, Jan. 12, 1981; para. (b)(1), 54 FR 47519, Nov. 15, 1989, effective Jan. 16, 1990; revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; paras. (b) and (c) revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000 (effective date corrected, 65 FR 78958, Dec. 18, 2000; para. (c) introductory text revised, 70 FR 54259, Sept. 14, 2005, effective Sept. 14, 2005]

INFORMATION DISCLOSURE STATEMENT

§ 1.97 Filing of information disclosure statement.

(a) In order for an applicant for a patent or for a reissue of a patent to have an information disclosure statement in compliance with § 1.98 considered by the Office during the pendency of the application, the information disclosure statement must satisfy one of paragraphs (b), (c), or (d) of this section.

(b) An information disclosure statement shall be considered by the Office if filed by the applicant within any one of the following time periods:

(1) Within three months of the filing date of a national application other than a continued prosecution application under § 1.53(d);

(2) Within three months of the date of entry of the national stage as set forth in § 1.491 in an international application;

(3) Before the mailing of a first Office action on the merits;

(4) Before the mailing of a first Office action after the filing of a request for continued examination under § 1.114; or

(5) Within three months of the date of publication of the international registration under Hague Agreement Article 10(3) in an international design application.

(c) An information disclosure statement shall be considered by the Office if filed after the period specified in paragraph (b) of this section, provided that the information disclosure statement is filed before the mailing date of any of a final action under § 1.113, a notice of allowance under § 1.311, or an action that otherwise closes prosecution in the application, and it is accompanied by one of:

(1) The statement specified in paragraph (e) of this section; or

(2) The fee set forth in § 1.17(p).

(d) An information disclosure statement shall be considered by the Office if filed by the applicant after the period specified in paragraph (c) of this section, provided that the information disclosure statement is filed on or before payment of the issue fee and is accompanied by:

(1) The statement specified in paragraph (e) of this section; and

(2) The fee set forth in § 1.17(p).

(e) A statement under this section must state either:

(1) That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement; or

(2) That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in § 1.56(c) more than three months prior to the filing of the information disclosure statement.

(f) No extensions of time for filing an information disclosure statement are permitted under § 1.136. If a *bona fide* attempt is made to comply with § 1.98, but part of the required content is inadvertently omitted, additional time may be given to enable full compliance.

(g) An information disclosure statement filed in accordance with this section shall not be construed as a representation that a search has been made.

(h) The filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in § 1.56(b).

(i) If an information disclosure statement does not comply with either this section or § 1.98, it will be placed in the file but will not be considered by the Office.

[48 FR 2696, Jan. 20, 1983, effective date Feb. 27, 1983; 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; para. (d) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; paras. (a)- (d) revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; paras. (c)-(e) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (b) revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); paras. (a) through (e) and (i) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (b)(3)-(4) revised and para. (b)(5) added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.98 Content of information disclosure statement.

(a) Any information disclosure statement filed under § 1.97 shall include the items listed in paragraphs (a)(1), (a)(2) and (a)(3) of this section.

(1) A list of all patents, publications, applications, or other information submitted for consideration by the Office. U.S. patents and U.S. patent application publications must be listed in a section separately from citations of other documents. Each page of the list must include:

(i) The application number of the application in which the information disclosure statement is being submitted;

(ii) A column that provides a space, next to each document to be considered, for the examiner's initials; and

(iii) A heading that clearly indicates that the list is an information disclosure statement.

(2) A legible copy of:

(i) Each foreign patent;

(ii) Each publication or that portion which caused it to be listed, other than U.S. patents and U.S. patent application publications unless required by the Office;

(iii) For each cited pending unpublished U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion [but see 1287 OG 163 (October 19, 2004) discussed in MPEP § 609.04(a), subsection II]; and

(iv) All other information or that portion which caused it to be listed.

(3)(i) A concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from applicant's specification or incorporated therein.

(ii) A copy of the translation if a written English-language translation of a non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c).

(b)(1) Each U.S. patent listed in an information disclosure statement must be identified by inventor, patent number, and issue date.

(2) Each U.S. patent application publication listed in an information disclosure statement shall be identified by applicant, patent application publication number, and publication date.

(3) Each U.S. application listed in an information disclosure statement must be identified by the inventor, application number, and filing date.

(4) Each foreign patent or published foreign patent application listed in an information disclosure statement must be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application.

(5) Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.

(c) When the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications as specified in paragraph (a) of this section may be submitted without copies of the other patents or publications, provided that it is stated that these other patents or publications are cumulative.

(d) A copy of any patent, publication, pending U.S. application or other information, as specified in paragraph (a) of this section, listed in an information disclosure statement is required to be provided, even if the patent, publication, pending U.S. application or other information was previously submitted to, or cited by, the Office in an earlier application, unless:

(1) The earlier application is properly identified in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. 120; and

(2) The information disclosure statement submitted in the earlier application complies with paragraphs (a) through (c) of this section.

[42 FR 5594, Jan. 28, 1977; para. (a) 48 FR 2696, Jan. 20, 1983, effective date Feb. 27, 1983; 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a)(2) and (b) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para. (e) added, 68 FR 38611, June 30, 2003, effective July 30, 2003; paras. (a) and (c) revised and para. (e) removed, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

§ 1.99 [Reserved]

[Removed and reserved, 77 FR 42150, July 17, 2012, effective Sept. 16, 2012]

EXAMINATION OF APPLICATIONS

§ 1.101 [Reserved]

[29 FR 13470, Sept. 30, 1964; para. (a), 48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; para. (a), 50 FR 9381, Mar. 7, 1985, effective May 8, 1985; 52 FR 20046, May 28, 1987, effective July 1, 1987; para. (a) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; removed and reserved, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.102 Advancement of examination.

(a) Applications will not be advanced out of turn for examination or for further action except as provided by this part, or upon order of the Director to expedite the business of the Office, or upon filing of a request under paragraph (b) or (e) of this section or upon filing a petition or request under paragraph (c) or (d) of this section with a showing which, in the opinion of the Director, will justify so advancing it.

(b) Applications wherein the inventions are deemed of peculiar importance to some branch of the public service and the head of some department

of the Government requests immediate action for that reason, may be advanced for examination.

(c) A petition to make an application special may be filed without a fee if the basis for the petition is:

(1) The applicant's age or health; or

(2) That the invention will materially:

(i) Enhance the quality of the environment;

(ii) Contribute to the development or conservation of energy resources; or

(iii) Contribute to countering terrorism.

(d) A petition to make an application special on grounds other than those referred to in paragraph (c) of this section must be accompanied by the fee set forth in § 1.17(h).

(e) A request for prioritized examination under this paragraph (e) must comply with the requirements of this paragraph (e) and be accompanied by the prioritized examination fee set forth in § 1.17(c), the processing fee set forth in § 1.17(i), and if not already paid, the publication fee set forth in § 1.18(d). An application for which prioritized examination has been requested may not contain or be amended to contain more than four independent claims, more than thirty total claims, or any multiple dependent claim. Prioritized examination under this paragraph (e) will not be accorded to international applications that have not entered the national stage under 35 U.S.C. 371, design applications, reissue applications, provisional applications, or reexamination proceedings. A request for prioritized examination must also comply with the requirements of paragraph (e)(1) or (2) of this section. No more than 12,000 requests for such prioritized examination will be accepted in any fiscal year.

(1) A request for prioritized examination may be filed with an original utility or plant nonprovisional application under 35 U.S.C. 111(a). The application must include a specification as prescribed by 35 U.S.C. 112 including at least one claim, a drawing when necessary, and the inventor's oath or declaration on filing, except that the filing of an inventor's oath or declaration may be postponed in accordance with § 1.53(f)(3) if an application data sheet meeting the conditions specified in § 1.53(f)(3)(i) is present upon filing. If the application is a utility application, it must be filed via the Office's electronic filing system and include the filing fee under § 1.16(a), search fee under § 1.16(k), and examination fee under § 1.16(o) upon filing. If the application is a plant application, it must include the filing fee under § 1.16(c), search fee under § 1.16(m), and examination fee under § 1.16(q) upon filing. The request for prioritized examination in compliance with this paragraph must be present upon filing of the application, except that the applicant may file an amendment to cancel any independent claims in excess of four, any total claims in excess of thirty, and any multiple dependent claim not later than one month from a first decision on the request for prioritized examination. This one-month time period is not extendable.

(2) A request for prioritized examination may be filed with or after a request for continued examination in compliance with § 1.114. If the application is a utility application, the request must be filed via the Office's electronic filing system. The request must be filed before the mailing of the first Office action after the filing of the request for continued examination under § 1.114. Only a single such request for prioritized examination under this paragraph may be granted in an application.

[24 FR 10332, Dec. 22, 1959; paras. (a), (c), and (d), 47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; para. (d), 54 FR 6893, Feb. 15, 1989, effective Apr. 17, 1989; para. (d) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; para. (a) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (d) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (c) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004; para. (a) revised and para. (e) added, 76 FR 18399, Apr. 4, 2011, effective date delayed until further notice, 76 FR 23876, Apr. 29, 2011 and withdrawn effective Sept. 23, 2011, 76 FR 59050, Sept. 23, 2011; para. (a) revised and para. (e) added, 76 FR 59050, Sept. 23, 2011, effective Sept. 26, 2011; para. (e) revised, 76 FR 78566, Dec. 19, 2011, effective Dec. 19, 2011; para. (e)(1) revised, 79 FR 12386, Mar. 5, 2014, effective Mar. 5, 2014 (adopted as final, 79 FR 68124, Nov. 14, 2014); para. (e) introductory text revised, 84 FR 45907, Sept. 3, 2019, effective Sept. 3, 2019]

§ 1.103 Suspension of action by the Office.

(a) *Suspension for cause.* On request of the applicant, the Office may grant a suspension of

action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months. Any petition for suspension of action under this paragraph must also include:

(1) A showing of good and sufficient cause for suspension of action; and

(2) The fee set forth in § 1.17(g), unless such cause is the fault of the Office.

(b) *Limited suspension of action in a continued prosecution application (CPA) filed under § 1.53(d).* On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph in a continued prosecution application filed under § 1.53(d) for a period not exceeding three months. Any request for suspension of action under this paragraph must be filed with the request for an application filed under § 1.53(d), specify the period of suspension, and include the processing fee set forth in § 1.17(i).

(c) *Limited suspension of action after a request for continued examination (RCE) under § 1.114.* On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph after the filing of a request for continued examination in compliance with § 1.114 for a period not exceeding three months. Any request for suspension of action under this paragraph must be filed with the request for continued examination under § 1.114, specify the period of suspension, and include the processing fee set forth in § 1.17(i).

(d) *Deferral of examination.* On request of the applicant, the Office may grant a deferral of examination under the conditions specified in this paragraph for a period not extending beyond three years from the earliest filing date for which a benefit is claimed under title 35, United States Code. A request for deferral of examination under this paragraph must include the publication fee set forth in § 1.18(d) and the processing fee set forth in § 1.17(i). A request for deferral of examination under this paragraph will not be granted unless:

(1) The application is an original utility or plant application filed under § 1.53(b) or resulting from entry of an international application into the national stage after compliance with § 1.495;

(2) The applicant has not filed a nonpublication request under § 1.213(a), or has filed a request under § 1.213(b) to rescind a previously filed nonpublication request;

(3) The application is in condition for publication as provided in § 1.211(c); and

(4) The Office has not issued either an Office action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151.

(e) *Notice of suspension on initiative of the Office.* The Office will notify applicant if the Office suspends action by the Office on an application on its own initiative.

(f) *Suspension of action for public safety or defense.* The Office may suspend action by the Office by order of the Director if the following conditions are met:

(1) The application is owned by the United States;

(2) Publication of the invention may be detrimental to the public safety or defense; and

(3) The appropriate department or agency requests such suspension.

[24 FR 10332, Dec. 22, 1959; 33 FR 5624, Apr. 11, 1968; paras. (a) and (b), 47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; para. (d), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (d), 50 FR 9381, Mar. 7, 1985, effective May 8, 1985; para. (a), 54 FR 6893, Feb. 15, 1989, effective Apr. 17, 1989; para. (a) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; para. (a) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 50092, Aug. 16, 2000, effective Aug. 16, 2000; paras. (d) through (f) redesignated as (e) through (g) and para. (d) added, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para. (d)(1) revised, 67 FR 520, Jan. 4, 2002, effective Apr. 1, 2002; para. (f) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (g) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (a)(2) revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004; para. (g) removed, 78 FR 11024, Feb. 14, 2013, effective Mar. 16, 2013]

§ 1.104 Nature of examination.

(a) *Examiner's action.*

(1) On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough

study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.

(2) The applicant, or in the case of a reexamination proceeding, both the patent owner and the requester, will be notified of the examiner's action. The reasons for any adverse action or any objection or requirement will be stated in an Office action and such information or references will be given as may be useful in aiding the applicant, or in the case of a reexamination proceeding the patent owner, to judge the propriety of continuing the prosecution.

(3) An international-type search will be made in all national applications filed on and after June 1, 1978.

(4) Any national application may also have an international-type search report prepared thereon at the time of the national examination on the merits, upon specific written request therefor and payment of the international-type search report fee set forth in § 1.21(e). The Patent and Trademark Office does not require that a formal report of an international-type search be prepared in order to obtain a search fee refund in a later filed international application.

(b) *Completeness of examiner's action.* The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.

(c) *Rejection of claims.*

(1) If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable will be rejected.

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

(3) In rejecting claims the examiner may rely upon admissions by the applicant, or the patent owner in a reexamination proceeding, as to any matter affecting patentability and, insofar as rejections in applications are concerned, may also rely upon facts within his or her knowledge pursuant to paragraph (d)(2) of this section.

(4)(i) Subject matter which would otherwise qualify as prior art under 35 U.S.C. 102(a)(2) and a claimed invention will be treated as commonly owned for purposes of 35 U.S.C. 102(b)(2)(C) if the applicant or patent owner provides a statement to the effect that the subject matter and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

(ii) Subject matter which would otherwise qualify as prior art under 35 U.S.C. 102(a)(2) and a claimed invention will be treated as commonly owned for purposes of 35 U.S.C. 102(b)(2)(C) on the basis of a joint research agreement under 35 U.S.C. 102(c) if:

(A) The applicant or patent owner provides a statement to the effect that the subject matter was developed and the claimed invention was made by or on behalf of one or more parties to a joint research agreement, within the meaning of 35 U.S.C. 100(h) and § 1.9(e), that was in effect on or before the effective filing date of the claimed invention, and the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(B) The application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(5)(i) Subject matter which qualifies as prior art under 35 U.S.C. 102(e), (f), or (g) in effect prior to March 16, 2013, and a claimed invention in an application filed on or after November 29, 1999, or any patent issuing thereon, in an application

filed before November 29, 1999, but pending on December 10, 2004, or any patent issuing thereon, or in any patent granted on or after December 10, 2004, will be treated as commonly owned for purposes of 35 U.S.C. 103(c) in effect prior to March 16, 2013, if the applicant or patent owner provides a statement to the effect that the subject matter and the claimed invention, at the time the claimed invention was made, were owned by the same person or subject to an obligation of assignment to the same person.

(ii) Subject matter which qualifies as prior art under 35 U.S.C. 102(e), (f), or (g) in effect prior to March 16, 2013, and a claimed invention in an application pending on or after December 10, 2004, or in any patent granted on or after December 10, 2004, will be treated as commonly owned for purposes of 35 U.S.C. 103(c) in effect prior to March 16, 2013, on the basis of a joint research agreement under 35 U.S.C. 103(c)(2) in effect prior to March 16, 2013, if:

(A) The applicant or patent owner provides a statement to the effect that the subject matter and the claimed invention were made by or on behalf of the parties to a joint research agreement, within the meaning of 35 U.S.C. 100(h) and § 1.9(e), which was in effect on or before the date the claimed invention was made, and that the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(B) The application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(6) Patents issued prior to December 10, 2004, from applications filed prior to November 29, 1999, are subject to 35 U.S.C. 103(c) in effect on November 28, 1999.

(d) *Citation of references.*

(1) If domestic patents are cited by the examiner, their numbers and dates, and the names of the patentees will be stated. If domestic patent application publications are cited by the examiner, their publication number, publication date, and the names of the applicants will be stated. If foreign published applications or patents are cited, their nationality or country, numbers and dates, and the names of the patentees will be stated, and such other data will be furnished as may be necessary to enable the applicant, or in the case of a reexamination proceeding, the patent owner, to identify the published applications or patents cited. In citing foreign published applications or patents, in case only a part of the document is involved, the particular pages and sheets containing the parts relied upon will be identified. If printed publications are cited, the author (if any), title, date, pages or plates, and place of publication, or place where a copy can be found, will be given.

(2) When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

(e) *Reasons for allowance.* If the examiner believes that the record of the prosecution as a whole does not make clear his or her reasons for allowing a claim or claims, the examiner may set forth such reasoning. The reasons shall be incorporated into an Office action rejecting other claims of the application or patent under reexamination or be the subject of a separate communication to the applicant or patent owner. The applicant or patent owner may file a statement commenting on the reasons for allowance within such time as may be specified by the examiner. Failure by the examiner to respond to any statement commenting on reasons for allowance does not give rise to any implication.

[43 FR 20465, May 11, 1978; 46 FR 29182, May 29, 1981; para. (d), 47 FR 41272, Sept. 17, 1982, effective date Oct. 1, 1982; para. (e), 50 FR 9381, Mar. 7, 1985, effective May 8, 1985; para. (e), 57 FR 29642, July 6, 1992, effective Sept. 4, 1992; revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (c)(4) revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); paras. (a)(2) and (e) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a)(5) removed and para. (d)(1) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para. (c)(4) revised, 70 FR 1818, Jan. 11, 2005, effective Dec. 10, 2004; para. (c)(4) revised, 70 FR 54259, Sept. 14, 2005, effective Sept. 14, 2005; paras. (a)(1) and (b) revised, 72 FR 46716, Aug. 21, 2007 (implementation enjoined and never became effective); paras. (a)(1) and (b) revised, 74 FR 52686, Oct. 14, 2009, effective Oct. 14, 2009 (to remove changes made by the final rules in 72 FR 46716 from the CFR); paras.(c)(4)

and (c)(5) revised and (c)(6) added, 78 FR 11024, Feb. 14, 2013, effective Mar. 16, 2013]

§ 1.105 Requirements for information.

[Editor Note: Some* paragraphs below are not applicable to patent applications filed before Sept. 16, 2012]

(a)(1) In the course of examining or treating a matter in a pending or abandoned application, in a patent, or in a reexamination proceeding, including a reexamination proceeding ordered as a result of a supplemental examination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

(i) *Commercial databases:* The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.

(ii) *Search:* Whether a search of the prior art was made, and if so, what was searched.

(iii) *Related information:* A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

(iv) *Information used to draft application:* A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

(v) *Information used in invention process:* A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) *Improvements:* Where the claimed invention is an improvement, identification of what is being improved.

(vii) *In Use:* Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(viii) *Technical information known to applicant.* Technical information known to applicant concerning the related art, the disclosure, the claimed subject matter, other factual information pertinent to patentability, or concerning the accuracy of the examiner's stated interpretation of such items.

(2) Requirements for factual information known to applicant may be presented in any appropriate manner, for example:

(i) A requirement for factual information;

(ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or

(iii) Stipulations as to facts with which the applicant may agree or disagree.

(3) Any reply to a requirement for information pursuant to this section that states either that the information required to be submitted is unknown to or is not readily available to the party or parties from which it was requested may be accepted as a complete reply.

(b) The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section will be governed by §§ 1.135 and 1.136.

[Removed and reserved, 62 FR 53132, Oct. 10, 1997, effective Dec.1, 1997; added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a)(3) revised and paras. (a)(1)(viii) and (a)(4) added, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004; para. (a)(1)(ix) added, 72 FR 46716, Aug. 21, 2007 (implementation enjoined and never became effective); para. (a)(1)(ix) removed, 74 FR 52686, Oct. 14, 2009, effective Oct. 14, 2009 (to remove changes made by the final rules in 72 FR 46716 from the CFR); para. (a)(2) removed and paras. (a)(3) and (a)(4) redesignated as (a)(2) and (a)(3), 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012; para. (a)(1) introductory text revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

[*The changes effective Sept. 16, 2012 are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012. See § 1.105 (pre-AIA) for the rule otherwise in effect.]

§ 1.105 (pre-AIA) Requirements for information.

[Editor Note: Some* paragraphs below are **not applicable** to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012]

(a)(1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

(i) *Commercial databases:* The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.

(ii) *Search:* Whether a search of the prior art was made, and if so, what was searched.

(iii) *Related information:* A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

(iv) *Information used to draft application:* A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

(v) *Information used in invention process:* A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) *Improvements :* Where the claimed invention is an improvement, identification of what is being improved.

(vii) *In Use:* Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(viii) *Technical information known to applicant.* Technical information known to applicant concerning the related art, the disclosure, the claimed subject matter, other factual information pertinent to patentability, or concerning the accuracy of the examiner's stated interpretation of such items.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(i), (iii), and (vii) of this section may also be applied to such assignee.

(3) Requirements for factual information known to applicant may be presented in any appropriate manner, for example:

(i) A requirement for factual information;

(ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or

(iii) Stipulations as to facts with which the applicant may agree or disagree.

(4) Any reply to a requirement for information pursuant to this section that states either that the information required to be submitted is unknown to or is not readily available to the party or parties from which it was requested may be accepted as a complete reply.

(b) The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section will be governed by §§ 1.135 and 1.136.

[Removed and reserved, 62 FR 53132, Oct. 10, 1997, effective Dec.1, 1997; added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a)(3) revised and paras. (a)(1)(viii) and (a)(4) added, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004; para. (a)(1)(ix) added, 72 FR 46716, Aug. 21, 2007 (implementation enjoined and never became effective); para. (a)(1)(ix) removed, 74 FR 52686, Oct. 14, 2009, effective Oct. 14, 2009 (to remove changes made by the final rules in 72 FR 46716 from the CFR)]

[*See § 1.105 for more information and for the rule applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012]

§ 1.106 [Reserved]

[24 FR 10332, Dec. 22, 1959; 34 FR 18857, Nov. 26, 1969; para. (c) added, 47 FR 21752, May 19, 1982, effective July 1, 1982; paras. (d) and (e), 50 FR 9381, Mar. 7, 1985, effective May 8, 1985; removed and reserved, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.107 [Reserved]

[46 FR 29182, May 29, 1981; para. (a) revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; removed and reserved, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.108 [Reserved]

[50 FR 9381, Mar. 7, 1985, effective May 8, 1985; removed and reserved, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.109 Effective filing date of a claimed invention under the Leahy-Smith America Invents Act.

(a) The effective filing date for a claimed invention in a patent or application for patent, other than in a reissue application or reissued patent, is the earliest of:

(1) The actual filing date of the patent or the application for the patent containing a claim to the invention; or

(2) The filing date of the earliest application for which the patent or application is entitled, as to such invention, to a right of priority or the benefit of an earlier filing date under 35 U.S.C. 119, 120, 121, 365, or 386.

(b) The effective filing date for a claimed invention in a reissue application or a reissued patent is determined by deeming the claim to the invention to have been contained in the patent for which reissue was sought.

[Added 78 FR 11024, Feb. 14, 2013, effective Mar. 16, 2013; revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.110 Inventorship and ownership of the subject matter of individual claims.

When one or more joint inventors are named in an application or patent, the Office may require an applicant or patentee to identify the inventorship and ownership or obligation to assign ownership, of each claimed invention on its effective filing date (as defined in § 1.109) or on its date of invention, as applicable, when necessary for purposes of an Office proceeding. The Office may also require an applicant or patentee to identify the invention dates of the subject matter of each claim when necessary for purposes of an Office proceeding.

[50 FR 9381, Mar. 7, 1985, effective date May 8, 1985; revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; revised, 72 FR 46716, Aug. 21, 2007 (implementation enjoined and never became effective); revised, 74 FR 52686, Oct. 14, 2009, effective Oct. 14, 2009 (to remove changes made by the final rules in 72 FR 46716 from the CFR); revised, 78 FR 11024, Feb. 14, 2013, effective Mar. 16, 2013]

ACTION BY APPLICANT AND FURTHER CONSIDERATION

§ 1.111 Reply by applicant or patent owner to a non-final Office action.

(a)(1) If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment. See §§ 1.135 and 1.136 for time for reply to avoid abandonment.

(2) *Supplemental replies.*

(i) A reply that is supplemental to a reply that is in compliance with § 1.111(b) will not be entered as a matter of right except as provided in paragraph (a)(2)(ii) of this section. The Office may enter a supplemental reply if the supplemental reply is clearly limited to:

(A) Cancellation of a claim(s);

(B) Adoption of the examiner suggestion(s);

(C) Placement of the application in condition for allowance;

(D) Reply to an Office requirement made after the first reply was filed;

(E) Correction of informalities (*e.g.*, typographical errors); or

(F) Simplification of issues for appeal.

(ii) A supplemental reply will be entered if the supplemental reply is filed within the period during which action by the Office is suspended under § 1.103(a) or (c).

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and

must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a *bona fide* attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

(c) In amending in reply to a rejection of claims in an application or patent under reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The applicant or patent owner must also show how the amendments avoid such references or objections.

[46 FR 29182, May 29, 1981; para. (b) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a) and (c) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a)(2) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (a)(2) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004; para. (a)(2)(i) revised, 70 FR 3880, Jan. 27, 2005, effective Dec. 8. 2004]

§ 1.112 Reconsideration before final action.

After reply by applicant or patent owner (§ 1.111 or § 1.945) to a non-final action and any comments by an inter partes reexamination requester (§ 1.947), the application or the patent under reexamination will be reconsidered and again examined. The applicant, or in the case of a reexamination proceeding the patent owner and any third party requester, will be notified if claims are rejected, objections or requirements made, or decisions favorable to patentability are made, in the same manner as after the first examination (§ 1.104). Applicant or patent owner may reply to such Office action in the same manner provided in § 1.111 or § 1.945, with or without amendment, unless such Office action indicates that it is made final (§ 1.113) or an appeal (§ 41.31 of this title) has been taken (§ 1.116), or in an inter partes reexamination, that it is an action closing prosecution (§ 1.949) or a right of appeal notice (§ 1.953).

[46 FR 29182, May 29, 1981; revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 1.113 Final rejection or action.

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

[24 FR 10332, Dec. 22, 1959; 46 FR 29182, May 29, 1981; revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); para. (a) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (a) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 1.114 Request for continued examination.

(a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of:

(1) Payment of the issue fee, unless a petition under § 1.313 is granted;

(2) Abandonment of the application; or

(3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.

(b) Prosecution in an application is closed as used in this section means that the application is under appeal, or that the last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application.

(c) A submission as used in this section includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. If reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.111.

(d) If an applicant timely files a submission and fee set forth in § 1.17(e), the Office will withdraw the finality of any Office action and the submission will be entered and considered. If an applicant files a request for continued examination under this section after appeal, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner. An appeal brief (§ 41.37 of this title) or a reply brief (§ 41.41 of this title), or related papers, will not be considered a submission under this section.

(e) The provisions of this section do not apply to:

(1) A provisional application;

(2) An application for a utility or plant patent filed under 35 U.S.C. 111(a) before June 8, 1995;

(3) An international application filed under 35 U.S.C. 363 before June 8, 1995, or an international application that does not comply with 35 U.S.C. 371;

(4) An application for a design patent;

(5) An international design application; or

(6) A patent under reexamination.

[Added 65 FR 14865, Mar. 20, 2000, effective May 29, 2000; revised 65 FR 50092, Aug. 16, 2000; para. (d) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; paras. (a) and (d) revised and (f), (g), and (h) added, 72 FR 46716, Aug. 21, 2007 (implementation enjoined and never became effective); paras. (a) and (d) revised and (f), (g), and (h) removed, 74 FR 52686, Oct. 14, 2009, effective Oct. 14, 2009 (to remove changes made by the final rules in 72 FR 46716 from the CFR); paras. (e)(3)-(5) revised and para. (e)(6) added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

AMENDMENTS

§ 1.115 Preliminary amendments.

(a) A preliminary amendment is an amendment that is received in the Office (§ 1.6) on or before the mail date of the first Office action under § 1.104. The patent application publication may include preliminary amendments (§ 1.215(a)).

(1) A preliminary amendment that is present on the filing date of an application is part of the original disclosure of the application.

(2) A preliminary amendment filed after the filing date of the application is not part of the original disclosure of the application.

(b) A preliminary amendment in compliance with § 1.121 will be entered unless disapproved by the Director.

(1) A preliminary amendment seeking cancellation of all the claims without presenting any new or substitute claims will be disapproved.

(2) A preliminary amendment may be disapproved if the preliminary amendment unduly interferes with the preparation of a first Office action in an application. Factors that will be considered in disapproving a preliminary amendment include:

(i) The state of preparation of a first Office action as of the date of receipt (§ 1.6) of the preliminary amendment by the Office; and

(ii) The nature of any changes to the specification or claims that would result from entry of the preliminary amendment.

(3) A preliminary amendment will not be disapproved under (b)(2) of this section if it is filed no later than:

(i) Three months from the filing date of an application under § 1.53(b);

(ii) The filing date of a continued prosecution application under § 1.53(d); or

(iii) Three months from the date the national stage is entered as set forth in § 1.491 in an international application.

(4) The time periods specified in paragraph (b)(3) of this section are not extendable.

[46 FR 29183, May 29, 1981; removed and reserved, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (b)(1) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; revised, 69 FR 56481, Sept. 21, 2004, effective Sept. 21, 2004]

§ 1.116 Amendments and affidavits or other evidence after final action and prior to appeal.

(a) An amendment after final action must comply with § 1.114 or this section.

(b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;

(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or

(3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

(c) The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or reexamination proceeding from its condition as subject to appeal or to save the application from abandonment under § 1.135, or the reexamination prosecution from termination under § 1.550(d) or § 1.957(b) or limitation of further prosecution under § 1.957(c).

(d)(1) Notwithstanding the provisions of paragraph (b) of this section, no amendment other than canceling claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.

(2) Notwithstanding the provisions of paragraph (b) of this section, an amendment made after a final rejection or other final action (§ 1.113) in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913 may not cancel claims where such cancellation affects the scope of any other pending claim in the reexamination proceeding except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.

(e) An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913 but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

(f) Notwithstanding the provisions of paragraph (e) of this section, no affidavit or other evidence can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.

(g) After decision on appeal, amendments, affidavits and other evidence can only be made as provided in §§ 1.198 and 1.981, or to carry into effect a recommendation under § 41.50(c) of this title.

[24 FR 10332, Dec. 22, 1959; 46 FR 29183, May 29, 1981; para. (a) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); paras. (b) and (d) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 1.117 [Reserved]

[Removed and reserved, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; added, 72 FR 46716, Aug. 21, 2007 (implementation enjoined and never became effective); removed, 74 FR 52686, Oct. 14, 2009, effective Oct. 14, 2009 (to remove changes made by the final rules in 72 FR 46716 from the CFR)]

§ 1.118 [Reserved]

[48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; removed and reserved, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.119 [Reserved]

[32 FR 13583, Sept. 28, 1967; removed and reserved, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.121 Manner of making amendments in applications.

(a) *Amendments in applications, other than reissue applications.* Amendments in applications, other than reissue applications, are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made.

(b) *Specification.* Amendments to the specification, other than the claims, computer listings (§ 1.96) and sequence listings (§ 1.825), must be made by adding, deleting or replacing a paragraph, by replacing a section, or by a substitute specification, in the manner specified in this section.

(1) *Amendment to delete, replace, or add a paragraph.* Amendments to the specification, including amendment to a section heading or the title of the invention which are considered for amendment purposes to be an amendment of a paragraph, must be made by submitting:

(i) An instruction, which unambiguously identifies the location, to delete one or more paragraphs of the specification, replace a paragraph with one or more replacement paragraphs, or add one or more paragraphs;

(ii) The full text of any replacement paragraph with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived;

(iii) The full text of any added paragraphs without any underlining; and

(iv) The text of a paragraph to be deleted must not be presented with strike-through or placed within double brackets. The instruction to delete may identify a paragraph by its paragraph number or include a few words from the beginning, and end, of the paragraph, if needed for paragraph identification purposes.

(2) *Amendment by replacement section.* If the sections of the specification contain section headings as provided in § 1.77(b), § 1.154(b), or § 1.163(c), amendments to the specification, other than the claims, may be made by submitting:

(i) A reference to the section heading along with an instruction, which unambiguously identifies the location, to delete that section of the specification and to replace such deleted section with a replacement section; and

(ii) A replacement section with markings to show all changes relative to the previous version of the section. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived.

(3) *Amendment by substitute specification.* The specification, other than the claims, may also be amended by submitting:

(i) An instruction to replace the specification; and

(ii) A substitute specification in compliance with §§ 1.125(b) and (c).

(4) *Reinstatement of previously deleted paragraph or section.* A previously deleted paragraph or section may be reinstated only by a subsequent amendment adding the previously deleted paragraph or section.

(5) *Presentation in subsequent amendment document.* Once a paragraph or section is amended in a first amendment document, the paragraph or section shall not be represented in a subsequent amendment document unless it is amended again or a substitute specification is provided.

(c) *Claims.* Amendments to a claim must be made by rewriting the entire claim with all changes (*e.g.*, additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) *Claim listing.* All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of "canceled" or "not entered" may be aggregated into one statement (*e.g.*, Claims 1–5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) *When claim text with markings is required.* All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of "currently amended," and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of "currently amended," or "withdrawn" if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as "withdrawn— currently amended."

(3) *When claim text in clean version is required.* The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, *i.e.*, without any markings in the presentation of text. The presentation of a clean version of any claim having the status of "original," "withdrawn" or "previously presented" will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of "withdrawn" or "previously presented." Any claim added by amendment must be indicated with the status of "new" and presented in clean version, *i.e.*, without any underlining.

(4) *When claim text shall not be presented; canceling a claim.*

(i) No claim text shall be presented for any claim in the claim listing with the status of "canceled" or "not entered."

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as "canceled" will constitute an instruction to cancel the claim.

(5) *Reinstatement of previously canceled claim.* A claim which was previously canceled may be reinstated only by adding the claim as a "new" claim with a new claim number.

(d) *Drawings.* One or more application drawings shall be amended in the following manner: Any changes to an application drawing must be in compliance with § 1.84 or, for a nonprovisional international design application, in compliance with §§ 1.84(c) and 1.1026 and must be submitted on a

replacement sheet of drawings which shall be an attachment to the amendment document and, in the top margin, labeled "Replacement Sheet." Any replacement sheet of drawings shall include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is amended. Any new sheet of drawings containing an additional figure must be labeled in the top margin as "New Sheet." All changes to the drawings shall be explained, in detail, in either the drawing amendment or remarks section of the amendment paper.

(1) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be included. The marked-up copy must be clearly labeled as “Annotated Sheet” and must be presented in the amendment or remarks section that explains the change to the drawings.

(2) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.

(e) *Disclosure consistency.* The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(f) *No new matter.* No amendment may introduce new matter into the disclosure of an application.

(g) *Exception for examiner’s amendments.* Changes to the specification, including the claims, of an application made by the Office in an examiner’s amendment may be made by specific instructions to insert or delete subject matter set forth in the examiner’s amendment by identifying the precise point in the specification or the claim(s) where the insertion or deletion is to be made. Compliance with paragraphs (b)(1), (b)(2), or (c) of this section is not required.

(h) *Amendment sections.* Each section of an amendment document (*e.g.*, amendment to the claims, amendment to the specification, replacement drawings, and remarks) must begin on a separate sheet.

(i) *Amendments in reissue applications.* Any amendment to the description and claims in reissue applications must be made in accordance with § 1.173.

(j) *Amendments in reexamination proceedings.* Any proposed amendment to the description and claims in patents involved in reexamination proceedings must be made in accordance with § 1.530.

(k) *Amendments in provisional applications.* Amendments in provisional applications are not usually made. If an amendment is made to a provisional application, however, it must comply with the provisions of this section. Any amendments to a provisional application shall be placed in the provisional application file but may not be entered.

[32 FR 13583, Sept. 28, 1967; 46 FR 29183, May 29, 1981; para. (e), 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (i) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; revised, 68 FR 38611, June 30, 2003, effective July 30, 2003; para. (d) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004; para. (d) introductory text revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.122 [Reserved]

[24 FR 10332, Dec. 22, 1959; para. (b), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; removed and reserved, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.123 [Reserved]

[48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; amended, 58 FR 38719, July 20, 1993, effective Oct. 1, 1993; removed and reserved, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.124 [Reserved]

[Removed and reserved, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.125 Substitute specification.

(a) If the number or nature of the amendments or the legibility of the application papers renders it difficult to consider the application, or to arrange the papers for printing or copying, the Office may

require the entire specification, including the claims, or any part thereof, be rewritten.

(b) Subject to § 1.312, a substitute specification, excluding the claims, may be filed at any point up to payment of the issue fee if it is accompanied by a statement that the substitute specification includes no new matter.

(c) A substitute specification submitted under this section must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown pursuant to this paragraph.

(d) A substitute specification under this section is not permitted in a reissue application or in a reexamination proceeding.

[48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; paras. (b)(2) and (c) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (b) and (c) revised, 68 FR 38611, June 30, 2003, effective July 30, 2003]

§ 1.126 Numbering of claims.

The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled the remaining claims must not be renumbered. When claims are added, they must be numbered by the applicant consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not). When the application is ready for allowance, the examiner, if necessary, will renumber the claims consecutively in the order in which they appear or in such order as may have been requested by applicant.

[32 FR 13583, Sept. 28, 1967; revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.127 [Reserved]

[Revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; removed and reserved, 84 FR 51977, Oct. 1, 2019, effective Oct. 31, 2019]

TRANSITIONAL PROVISIONS

§ 1.129 Transitional procedures for limited examination after final rejection and restriction practice.

(a) An applicant in an application, other than for reissue or a design patent, that has been pending for at least two years as of June 8, 1995, taking into account any reference made in such application to any earlier filed application under 35 U.S.C. 120, 121 and 365(c), is entitled to have a first submission entered and considered on the merits after final rejection under the following circumstances: The Office will consider such a submission, if the first submission and the fee set forth in § 1.17(r) are filed prior to the filing of an appeal brief and prior to abandonment of the application. The finality of the final rejection is automatically withdrawn upon the timely filing of the submission and payment of the fee set forth in § 1.17(r). If a subsequent final rejection is made in the application, applicant is entitled to have a second submission entered and considered on the merits after the subsequent final rejection under the following circumstances: The Office will consider such a submission, if the second submission and a second fee set forth in § 1.17(r) are filed prior to the filing of an appeal brief and prior to abandonment of the application. The finality of the subsequent final rejection is automatically withdrawn upon the timely filing of the submission and payment of the second fee set forth in § 1.17(r). Any submission filed after a final rejection made in an application subsequent to the fee set forth in § 1.17(r) having been twice paid will be treated as set forth in § 1.116. A submission as used in this paragraph includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims or drawings and a new substantive argument or new evidence in support of patentability.

(b)(1) In an application, other than for reissue or a design patent, that has been pending for at least three years as of June 8, 1995; taking into

account any reference made in the application to any earlier filed application under 35 U.S.C. 120, 121 and 365(c), no requirement for restriction or for the filing of divisional applications shall be made or maintained in the application after June 8, 1995, except where:

(i) The requirement was first made in the application or any earlier filed application under 35 U.S.C. 120, 121, and 365(c) prior to April 8, 1995;

(ii) The examiner has not made a requirement for restriction in the present or parent application prior to April 8, 1995, due to actions by the applicant; or

(iii) The required fee for examination of each additional invention was not paid.

(2) If the application contains more than one independent and distinct invention and a requirement for restriction or for the filing of divisional applications cannot be made or maintained pursuant to this paragraph, applicant will be so notified and given a time period to:

(i) Elect the invention or inventions to be searched and examined, if no election has been made prior to the notice, and pay the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects;

(ii) Confirm an election made prior to the notice and pay the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in addition to the one invention which applicant previously elected; or

(iii) File a petition under this section traversing the requirement. If the required petition is filed in a timely manner, the original time period for electing and paying the fee set forth in § 1.17(s) will be deferred and any decision on the petition affirming or modifying the requirement will set a new time period to elect the invention or inventions to be searched and examined and to pay the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects.

(3) The additional inventions for which the required fee has not been paid will be withdrawn from consideration under § 1.142(b). An applicant who desires examination of an invention so withdrawn from consideration can file a divisional application under 35 U.S.C. 121.

(c) The provisions of this section shall not be applicable to any application filed after June 8, 1995.

[Added, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995]

AFFIDAVITS OVERCOMING REJECTIONS

§ 1.130 Affidavit or declaration of attribution or prior public disclosure under the Leahy-Smith America Invents Act.

(a) *Affidavit or declaration of attribution.* When any claim of an application or a patent under reexamination is rejected, the applicant or patent owner may submit an appropriate affidavit or declaration to disqualify a disclosure as prior art by establishing that the disclosure was made by the inventor or a joint inventor, or the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor.

(b) *Affidavit or declaration of prior public disclosure.* When any claim of an application or a patent under reexamination is rejected, the applicant or patent owner may submit an appropriate affidavit or declaration to disqualify a disclosure as prior art by establishing that the subject matter disclosed had, before such disclosure was made or before such subject matter was effectively filed, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor. An affidavit or declaration under this paragraph must identify the subject matter publicly disclosed and provide the date such subject matter was publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

(1) If the subject matter publicly disclosed on that date was in a printed publication, the affidavit or declaration must be accompanied by a copy of the printed publication.

(2) If the subject matter publicly disclosed on that date was not in a printed publication, the affidavit or declaration must describe the subject matter with sufficient detail and particularity to

determine what subject matter had been publicly disclosed on that date by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

(c) *When this section is not available.* The provisions of this section are not available if the rejection is based upon a disclosure made more than one year before the effective filing date of the claimed invention. The provisions of this section may not be available if the rejection is based upon a U.S. patent or U.S. patent application publication of a patented or pending application naming another inventor, the patent or pending application claims an invention that is the same or substantially the same as the applicant's or patent owner's claimed invention, and the affidavit or declaration contends that an inventor named in the U.S. patent or U.S. patent application publication derived the claimed invention from the inventor or a joint inventor named in the application or patent, in which case an applicant or a patent owner may file a petition for a derivation proceeding pursuant to § 42.401 et seq. of this title.

(d) *Applications and patents to which this section is applicable.* The provisions of this section apply to any application for patent, and to any patent issuing thereon, that contains, or contained at any time:

(1) A claim to a claimed invention that has an effective filing date as defined in § 1.109 that is on or after March 16, 2013; or

(2) A specific reference under 35 U.S.C. 120, 121, 365(c), or 386(c) to any patent or application that contains, or contained at any time, a claim to a claimed invention that has an effective filing date as defined in § 1.109 that is on or after March 16, 2013.

[Added, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; heading and para. (a) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para. (b) removed and reserved, 70 FR 1818, Jan. 11, 2005, effective Dec. 10, 2004; revised, 78 FR 11024, Feb. 14, 2013, effective Mar. 16, 2013; para. (d) revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.131 Affidavit or declaration of prior invention or to disqualify commonly owned patent or published application as prior art.

(a) When any claim of an application or a patent under reexamination is rejected, the applicant or patent owner may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. The effective date of a U.S. patent, U.S. patent application publication, or international application publication under PCT Article 21(2) is the earlier of its publication date or the date that it is effective as a reference under 35 U.S.C. 102(e) as in effect on March 15, 2013. Prior invention may not be established under this section in any country other than the United States, a NAFTA country, or a WTO member country. Prior invention may not be established under this section before December 8, 1993, in a NAFTA country other than the United States, or before January 1, 1996, in a WTO member country other than a NAFTA country. Prior invention may not be established under this section if either:

(1) The rejection is based upon a U.S. patent or U.S. patent application publication of a pending or patented application naming another inventor which claims interfering subject matter as defined in § 41.203(a) of this chapter, in which case an applicant may suggest an interference pursuant to § 41.202(a) of this chapter; or

(2) The rejection is based upon a statutory bar.

(b) The showing of facts for an oath or declaration under paragraph (a) of this section shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

(c) When any claim of an application or a patent under reexamination is rejected under 35 U.S.C. 103 as in effect on March 15, 2013, on a U.S. patent

or U.S. patent application publication which is not prior art under 35 U.S.C. 102(b) as in effect on March 15, 2013, and the inventions defined by the claims in the application or patent under reexamination and by the claims in the patent or published application are not identical but are not patentably distinct, and the inventions are owned by the same party, the applicant or owner of the patent under reexamination may disqualify the patent or patent application publication as prior art. The patent or patent application publication can be disqualified as prior art by submission of:

(1) A terminal disclaimer in accordance with § 1.321(c); and

(2) An oath or declaration stating that the application or patent under reexamination and patent or published application are currently owned by the same party, and that the inventor named in the application or patent under reexamination is the prior inventor under 35 U.S.C. 104 as in effect on March 15, 2013.

(d) The provisions of this section apply to any application for patent and to any patent issuing thereon, that contains, or contained at any time:

(1) A claim to an invention that has an effective filing date as defined in § 1.109 that is before March 16, 2013; or

(2) A specific reference under 35 U.S.C. 120, 121, 365(c), or 386(c) to any patent or application that contains, or contained at any time, a claim to an invention that has an effective filing date as defined in § 1.109 that is before March 16, 2013.

(e) In an application for patent to which the provisions of § 1.130 apply, and to any patent issuing thereon, the provisions of this section are applicable only with respect to a rejection under 35 U.S.C. 102(g) as in effect on March 15, 2013.

[24 FR 10332, Dec. 22, 1959; 34 FR 18857, Nov. 26, 1969; para. (a), 48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; para. (a), 50 FR 9381, Mar. 7, 1985, effective May 8, 1985; 50 FR 11366, Mar. 21, 1985; 53 FR 23733, June 23, 1988, effective Sept. 12, 1988; para. (a)(1) revised and para. (a)(2) added, 60 FR 21043, May 1, 1995, effective May 31, 1995; para. (a) revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; heading and para. (a) revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000; para. (a) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para. (a)(1) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (b) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004; para. (a) introductory text revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012; revised, 78 FR 11024, Feb. 14, 2013, effective Mar. 16, 2013; para. (a) revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013; para. (d) revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.132 Affidavits or declarations traversing rejections or objections.

When any claim of an application or a patent under reexamination is rejected or objected to, any evidence submitted to traverse the rejection or objection on a basis not otherwise provided for must be by way of an oath or declaration under this section.

[48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000; revised 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

INTERVIEWS

§ 1.133 Interviews.

(a)(1) Interviews with examiners concerning applications and other matters pending before the Office must be conducted on Office premises and within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director.

(2) An interview for the discussion of the patentability of a pending application will not occur before the first Office action, unless the application is a continuing or substitute application or the examiner determines that such an interview would advance prosecution of the application.

(3) The examiner may require that an interview be scheduled in advance.

(b) In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office actions as specified in §§ 1.111 and 1.135.

[Para. (b) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a)(1) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (a)(2) revised, 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005]

TIME FOR REPLY BY APPLICANT; ABANDONMENT OF APPLICATION

§ 1.134 Time period for reply to an Office action.

An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.

[47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.135 Abandonment for failure to reply within time period.

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

(c) When reply by the applicant is a *bona fide* attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

[Paras. (a), (b), and (c), 47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; para. (d) deleted, 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.136 Extensions of time.

(a)(1) If an applicant is required to reply within a nonstatutory or shortened statutory time period, applicant may extend the time period for reply up to the earlier of the expiration of any maximum period set by statute or five months after the time period set for reply, if a petition for an extension of time and the fee set in § 1.17(a) are filed, unless:

(i) Applicant is notified otherwise in an Office action;

(ii) The reply is a reply brief submitted pursuant to § 41.41 of this title;

(iii) The reply is a request for an oral hearing submitted pursuant to § 41.47(a) of this title;

(iv) The reply is to a decision by the Patent Trial and Appeal Board pursuant to § 41.50 or § 41.52 of this chapter or to § 90.3 of this chapter; or

(v) The application is involved in a contested case (§ 41.101(a) of this title) or a derivation proceeding (§ 42.4(b) of this title).

(2) The date on which the petition and the fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The expiration of the time period is determined by the amount of the fee paid. A reply must be filed prior to the expiration of the period of extension to avoid abandonment of the application (§ 1.135), but in no situation may an applicant reply later than the maximum time period set by statute, or be granted an extension of time under paragraph (b) of this section when the provisions of paragraph (a) of this section are available.

(3) A written request may be submitted in an application that is an authorization to treat any concurrent or future reply, requiring a petition for an extension of time under this paragraph for its timely submission, as incorporating a petition for extension of time for the appropriate length of time. An authorization to charge all required fees, fees under § 1.17, or all required extension of time fees

will be treated as a constructive petition for an extension of time in any concurrent or future reply requiring a petition for an extension of time under this paragraph for its timely submission. Submission of the fee set forth in § 1.17(a) will also be treated as a constructive petition for an extension of time in any concurrent reply requiring a petition for an extension of time under this paragraph for its timely submission.

(b) When a reply cannot be filed within the time period set for such reply and the provisions of paragraph (a) of this section are not available, the period for reply will be extended only for sufficient cause and for a reasonable time specified. Any request for an extension of time under this paragraph must be filed on or before the day on which such reply is due, but the mere filing of such a request will not effect any extension under this paragraph. In no situation can any extension carry the date on which reply is due beyond the maximum time period set by statute. Any request under this paragraph must be accompanied by the petition fee set forth in § 1.17(g).

(c) If an applicant is notified in a "Notice of Allowability" that an application is otherwise in condition for allowance, the following time periods are not extendable if set in the "Notice of Allowability" or in an Office action having a mail date on or after the mail date of the "Notice of Allowability":

(1) The period for submitting the inventor's oath or declaration;

(2) The period for submitting formal drawings set under § 1.85(c); and

(3) The period for making a deposit set under § 1.809(c).

(d) See § 1.550(c) for extensions of time in *ex parte* reexamination proceedings, § 1.956 for extensions of time in *inter partes* reexamination proceedings; §§ 41.4(a) and 41.121(a)(3) of this chapter for extensions of time in contested cases before the Patent Trial and Appeal Board; § 42.5(c) of this chapter for extensions of time in trials before the Patent Trial and Appeal Board; and § 90.3 of this chapter for extensions of time to appeal to the U.S. Court of Appeals for the Federal Circuit or to commence a civil action.

[47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; 54 FR 29551, July 13, 1989, effective Aug. 20, 1989; para. (a) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (c) added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a)(2) and (b) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (c) revised, 66 FR 21090, Apr. 27, 2001, effective May 29, 2001; paras. (a)(1), (a)(2), and (b) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (b) revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004; para. (b) revised, 70 FR 3880, Jan. 27, 2005, effective Dec. 8, 2004; para. (a)(1) revised, 72 FR 46716, Aug. 21, 2007 (implementation enjoined and never became effective); para. (a)(1) revised, 74 FR 52686, Oct. 14, 2009, effective Oct. 14, 2009 (to remove changes made by the final rules in 72 FR 46716 from the CFR); paras. (a)(1)(iv), (a)(1)(v), (a)(2), and (b) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012; para. (c)(1) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012; paras. (a)(1)(iv), (a)(2) and (b) revised, para. (d) added, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013]

§ 1.137 Revival of abandoned application, or terminated or limited reexamination prosecution.

(a) *Revival on the basis of unintentional delay.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this section to revive an abandoned application or a reexamination prosecution terminated under § 1.550(d) or § 1.957(b) or limited under § 1.957(c).

(b) *Petition requirements.* A grantable petition pursuant to this section must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;

(2) The petition fee as set forth in § 1.17(m);

(3) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section; and

(4) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this section was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(c) *Reply.* In an application abandoned under § 1.57(a), the reply must include a copy of the specification and any drawings of the previously filed application. In an application or patent abandoned for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance. In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, abandoned after the close of prosecution as defined in § 1.114(b), the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114.

(d) *Terminal disclaimer.*

(1) Any petition to revive pursuant to this section in a design application must be accompanied by a terminal disclaimer and fee as set forth in § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application. Any petition to revive pursuant to this section in either a utility or plant application filed before June 8, 1995, must be accompanied by a terminal disclaimer and fee as set forth in § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the lesser of:

(i) The period of abandonment of the application; or

(ii) The period extending beyond twenty years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application(s) under 35 U.S.C. 120, 121, 365(c), or 386(c) from the date on which the earliest such application was filed.

(2) Any terminal disclaimer pursuant to paragraph (d)(1) of this section must also apply to any patent granted on a continuing utility or plant application filed before June 8, 1995, or a continuing design application, that contains a specific reference under 35 U.S.C. 120, 121, 365(c), or 386(c) to the application for which revival is sought.

(3) The provisions of paragraph (d)(1) of this section do not apply to applications for which revival is sought solely for purposes of copendency with a utility or plant application filed on or after June 8, 1995, to reissue applications, or to reexamination proceedings.

(e) *Request for reconsideration.* Any request for reconsideration or review of a decision refusing to revive an abandoned application, or a terminated or limited reexamination prosecution, upon petition filed pursuant to this section, to be considered timely, must be filed within two months of the decision refusing to revive or within such time as set in the decision. Unless a decision indicates otherwise, this time period may be extended under:

(1) The provisions of § 1.136 for an abandoned application;

(2) The provisions of § 1.550(c) for a terminated *ex parte* reexamination prosecution, where the *ex parte* reexamination was filed under § 1.510; or

(3) The provisions of § 1.956 for a terminated *inter partes* reexamination prosecution or an *inter partes* reexamination limited as to further prosecution, where the *inter partes* reexamination was filed under § 1.913.

(f) *Abandonment for failure to notify the Office of a foreign filing.* A nonprovisional application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to timely notify the Office of the filing of an application in a foreign country or under a multinational treaty that requires publication of applications eighteen months after filing, may be revived pursuant to this section. The reply requirement of paragraph (c) of this section is met by the notification of such filing in a foreign country or under a multinational treaty, but the filing of a petition under this section will not operate to stay any period for reply that may be running against the application.

(g) *Provisional applications.* A provisional application, abandoned for failure to timely respond to an Office requirement, may be revived pursuant to this section. Subject to the provisions of 35 U.S.C. 119(e)(3) and § 1.7(b), a provisional application will not be regarded as pending after twelve months from its filing date under any circumstances.

[47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; para. (b) 48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; paras. (a) - (c), paras. (d) & (e) added, 58 FR 44277, Aug. 20,1993, effective Sept. 20, 1993; para. (c)

revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (c) revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000; revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para. (d)(3) revised, 69 FR 56481, Sept. 21, 2004, effective Sept. 21, 2004; heading, paras. (a) introductory text, (b) introductory text, and (e) revised, 72 FR 18892, Apr. 16, 2007, effective May 16, 2007; revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013; paras. (d)(1)(ii) and (d)(2) revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.138 Express abandonment.

(a) An application may be expressly abandoned by filing a written declaration of abandonment identifying the application in the United States Patent and Trademark Office. Express abandonment of the application may not be recognized by the Office before the date of issue or publication unless it is actually received by appropriate officials in time to act.

(b) A written declaration of abandonment must be signed by a party authorized under § 1.33(b)(1) or (b)(3) to sign a paper in the application, except as otherwise provided in this paragraph. A registered attorney or agent, not of record, who acts in a representative capacity under the provisions of § 1.34 when filing a continuing application, may expressly abandon the prior application as of the filing date granted to the continuing application.

(c) An applicant seeking to abandon an application to avoid publication of the application (see § 1.211(a)(1)) must submit a declaration of express abandonment by way of a petition under this paragraph including the fee set forth in § 1.17(h) in sufficient time to permit the appropriate officials to recognize the abandonment and remove the application from the publication process. Applicants should expect that the petition will not be granted and the application will be published in regular course unless such declaration of express abandonment and petition are received by the appropriate officials more than four weeks prior to the projected date of publication.

(d) An applicant seeking to abandon an application filed under 35 U.S.C. 111(a) and § 1.53(b) on or after December 8, 2004, to obtain a refund of the search fee and excess claims fee paid in the application, must submit a declaration of express abandonment by way of a petition under this paragraph before an examination has been made of the application. The date indicated on any certificate of mailing or transmission under § 1.8 will not be taken into account in determining whether a petition under § 1.138(d) was filed before an examination has been made of the application. If a request for refund of the search fee and excess claims fee paid in the application is not filed with the declaration of express abandonment under this paragraph or within two months from the date on which the declaration of express abandonment under this paragraph was filed, the Office may retain the entire search fee and excess claims fee paid in the application. This two-month period is not extendable. If a petition and declaration of express abandonment under this paragraph are not filed before an examination has been made of the application, the Office will not refund any part of the search fee and excess claims fee paid in the application except as provided in § 1.26.

[47 FR 47244, Oct. 25, 1982, effective Feb. 27, 1983; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a) revised and para. (c) added, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para. (c) revised and para. (d) added, 71 FR 12284, Mar. 10, 2006, effective Mar. 10, 2006; para. (b) revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013]

§ 1.139 [Reserved]

[Added, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; removed and reserved, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

JOINDER OF INVENTIONS IN ONE APPLICATION; RESTRICTION

§ 1.141 Different inventions in one national application.

(a) Two or more independent and distinct inventions may not be claimed in one national application, except that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (§ 1.75)

or otherwise include all the limitations of the generic claim.

(b) Where claims to all three categories, product, process of making, and process of use, are included in a national application, a three way requirement for restriction can only be made where the process of making is distinct from the product. If the process of making and the product are not distinct, the process of using may be joined with the claims directed to the product and the process of making the product even though a showing of distinctness between the product and process of using the product can be made.

[52 FR 20046, May 28, 1987, effective July 1, 1987]

§ 1.142 Requirement for restriction.

(a) If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division). Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action.

(b) Claims to the invention or inventions not elected, if not canceled, are nevertheless withdrawn from further consideration by the examiner by the election, subject however to reinstatement in the event the requirement for restriction is withdrawn or overruled.

[Para (a) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised and (c) added, 72 FR 46716, Aug. 21, 2007 (implementation enjoined and never became effective); para. (a) revised and (c) removed, 74 FR 52686, Oct. 14, 2009, effective Oct. 14, 2009 (to remove changes made by the final rules in 72 FR 46716 from the CFR)]

§ 1.143 Reconsideration of requirement.

If the applicant disagrees with the requirement for restriction, he may request reconsideration and withdrawal or modification of the requirement, giving the reasons therefor. (See § 1.111.) In requesting reconsideration the applicant must indicate a provisional election of one invention for prosecution, which invention shall be the one elected in the event the requirement becomes final. The requirement for restriction will be reconsidered on such a request. If the requirement is repeated and made final, the examiner will at the same time act on the claims to the invention elected.

§ 1.144 Petition from requirement for restriction.

After a final requirement for restriction, the applicant, in addition to making any reply due on the remainder of the action, may petition the Director to review the requirement. Petition may be deferred until after final action on or allowance of claims to the invention elected, but must be filed not later than appeal. A petition will not be considered if reconsideration of the requirement was not requested (see § 1.181).

[Revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

§ 1.145 Subsequent presentation of claims for different invention.

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144.

[Revised, 72 FR 46716, Aug. 21, 2007 (implementation enjoined and never became effective); revised, 74 FR 52686, Oct. 14, 2009, effective Oct. 14, 2009 (to remove changes made by the final rules in 72 FR 46716 from the CFR)]

§ 1.146 Election of species.

In the first action on an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will

be restricted if no claim to the genus is found to be allowable. However, if such application contains claims directed to more than a reasonable number of species, the examiner may require restriction of the claims to not more than a reasonable number of species before taking further action in the application.

[43 FR 20465, May 11, 1978; revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

DESIGN PATENTS

§ 1.151 Rules applicable.

The rules relating to applications for patents for other inventions or discoveries are also applicable to applications for patents for designs except as otherwise provided.

§ 1.152 Design drawings.

The design must be represented by a drawing that complies with the requirements of § 1.84 and must contain a sufficient number of views to constitute a complete disclosure of the appearance of the design. Appropriate and adequate surface shading should be used to show the character or contour of the surfaces represented. Solid black surface shading is not permitted except when used to represent the color black as well as color contrast. Broken lines may be used to show visible environmental structure, but may not be used to show hidden planes and surfaces that cannot be seen through opaque materials. Alternate positions of a design component, illustrated by full and broken lines in the same view are not permitted in a design drawing. Photographs and ink drawings are not permitted to be combined as formal drawings in one application. Photographs submitted in lieu of ink drawings in design patent applications must not disclose environmental structure but must be limited to the design claimed for the article.

[53 FR 47810, Nov. 28, 1988, effective Jan. 1, 1989; amended, 58 FR 38719, July 20, 1993, effective Oct. 1, 1993; revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000]

§ 1.153 Title, description and claim, oath or declaration.

[Editor Note: Para. (b) below is applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

(a) The title of the design must designate the particular article. No description, other than a reference to the drawing, is ordinarily required. The claim shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described. More than one claim is neither required nor permitted.

(b) The inventor's oath or declaration must comply with the requirements of § 1.63, or comply with the requirements of § 1.64 for a substitute statement.

[24 FR 10332, Dec. 22, 1959; 29 FR 18503, Dec. 29, 1964; para. (b), 48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; para. (b) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012]

[*The changes to para. (b) effective Sept. 16, 2012 are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012. See § 1.153 (pre-AIA) for para. (b) otherwise in effect.]

§ 1.153 (pre-AIA) Title, description and claim, oath or declaration.

[Editor Note: Para. (b) below is **not applicable** to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012*]

(a) The title of the design must designate the particular article. No description, other than a reference to the drawing, is ordinarily required. The claim shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described. More than one claim is neither required nor permitted.

(b) The oath or declaration required of the applicant must comply with § 1.63.

[24 FR 10332, Dec. 22, 1959; 29 FR 18503, Dec. 29, 1964; para. (b), 48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983]

[*See § 1.153 for more information and for para. (b) applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012]

§ 1.154 Arrangement of application elements in a design application.

(a) The elements of the design application, if applicable, should appear in the following order:

(1) Design application transmittal form.

(2) Fee transmittal form.

(3) Application data sheet (see § 1.76).

(4) Specification.

(5) Drawings or photographs.

(6) The inventor's oath or declaration (*see* § 1.153(b)).

(b) The specification should include the following sections in order:

(1) Preamble, stating the name of the applicant, title of the design, and a brief description of the nature and intended use of the article in which the design is embodied.

(2) Cross-reference to related applications (unless included in the application data sheet).

(3) Statement regarding federally sponsored research or development.

(4) Description of the figure or figures of the drawing.

(5) Feature description.

(6) A single claim.

(c) The text of the specification sections defined in paragraph (b) of this section, if applicable, should be preceded by a section heading in uppercase letters without underlining or bold type.

[24 FR 10332, Dec. 22, 1959, para. (e), 48 FR 2696, Jan. 20, 1983, effective date Feb. 27, 1983; revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; para. (a)(3) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a)(6) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012]

§ 1.155 Expedited examination of design applications.

(a) The applicant may request that the Office expedite the examination of a design application. To qualify for expedited examination:

(1) The application must include drawings in compliance with § 1.84, or for an international design application that designates the United States, must have been published pursuant to Hague Agreement Article 10(3);

(2) The applicant must have conducted a preexamination search; and

(3) The applicant must file a request for expedited examination including:

(i) The fee set forth in § 1.17(k); and

(ii) A statement that a preexamination search was conducted. The statement must also indicate the field of search and include an information disclosure statement in compliance with § 1.98.

(b) The Office will not examine an application that is not in condition for examination (*e.g.*, missing basic filing fee) even if the applicant files a request for expedited examination under this section.

[47 FR 41272, Sept. 17, 1982, effective date Oct. 1, 1982; paras. (b)-(d) amended, paras. (e) and (f) added, 58 FR 44277, Aug. 20, 1993, effective Sept. 20, 1993; revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000; para. (a)(1) revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

PLANT PATENTS

§ 1.161 Rules applicable.

The rules relating to applications for patent for other inventions or discoveries are also applicable to applications for patents for plants except as otherwise provided.

§ 1.162 Applicant, oath or declaration.

[Editor Note: Applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

The inventor named for a plant patent application must be the person who has invented or discovered and asexually reproduced the new and distinct variety of plant for which a patent is sought. The inventor's oath or declaration, in addition to the averments required by § 1.63 or § 1.64, must state that the inventor has asexually reproduced the plant.

Where the plant is a newly found plant, the inventor's oath or declaration must also state that it was found in a cultivated area.

[48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012]

[*The changes effective Sept. 16, 2012 are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012. See § 1.162 (pre-AIA) for the rule otherwise in effect.]

§ 1.162 (pre-AIA) Applicant, oath or declaration.

[Editor Note: **Not applicable** to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

The applicant for a plant patent must be the person who has invented or discovered and asexually reproduced the new and distinct variety of plant for which a patent is sought (or as provided in §§ 1.42, 1.43, and 1.47). The oath or declaration required of the applicant, in addition to the averments required by § 1.63, must state that he or she has asexually reproduced the plant. Where the plant is a newly found plant the oath or declaration must also state that it was found in a cultivated area.

[48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983]

[*See § 1.162 for more information and for the rule applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012]

§ 1.163 Specification and arrangement of application elements in a plant application.

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. For a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

(b) The elements of the plant application, if applicable, should appear in the following order:

(1) Plant application transmittal form.

(2) Fee transmittal form.

(3) Application data sheet (see § 1.76).

(4) Specification.

(5) Drawings (in duplicate).

(6) The inventor's oath or declaration (§ 1.162).

(c) The specification should include the following sections in order:

(1) Title of the invention, which may include an introductory portion stating the name, citizenship, and residence of the applicant.

(2) Cross-reference to related applications (unless included in the application data sheet).

(3) Statement regarding federally sponsored research or development.

(4) Latin name of the genus and species of the plant claimed.

(5) Variety denomination.

(6) Background of the invention.

(7) Brief summary of the invention.

(8) Brief description of the drawing.

(9) Detailed botanical description.

(10) A single claim.

(11) Abstract of the disclosure.

(d) The text of the specification or sections defined in paragraph (c) of this section, if applicable, should be preceded by a section heading in upper case, without underlining or bold type.

[24 FR 10332, Dec. 22, 1959; para. (b), 48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; paras. (c) and (d) added, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; para. (b) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (b)(6) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012]

§ 1.164 Claim.

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

§ 1.165 Plant Drawings.

(a) Plant patent drawings should be artistically and competently executed and must comply with the requirements of § 1.84. View numbers and reference characters need not be employed unless required by the examiner. The drawing must disclose all the distinctive characteristics of the plant capable of visual representation.

(b) The drawings may be in color. The drawing must be in color if color is a distinguishing characteristic of the new variety. Two copies of color drawings or photographs must be submitted.

[24 FR 10332, Dec. 22, 1959; para. (b), 47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; paras. (a) and (b) amended, 58 FR 38719, July 20, 1993, effective Oct. 1, 1993; para. (b) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para. (b) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

§ 1.166 Specimens.

The applicant may be required to furnish specimens of the plant, or its flower or fruit, in a quantity and at a time in its stage of growth as may be designated, for study and inspection. Such specimens, properly packed, must be forwarded in conformity with instructions furnished to the applicant. When it is not possible to forward such specimens, plants must be made available for official inspection where grown.

§ 1.167 Examination.

Applications may be submitted by the Patent and Trademark Office to the Department of Agriculture for study and report.

[24 FR 10332, Dec. 22, 1959; 34 FR 18857, Nov. 26, 1969; revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

REISSUES

§ 1.171 Application for reissue.

An application for reissue must contain the same parts required for an application for an original patent, complying with all the rules relating thereto except as otherwise provided, and in addition, must comply with the requirements of the rules relating to reissue applications.

[47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; revised, 54 FR 6893, Feb. 17, 1989, 54 FR 9432, March 7, 1989, effective Apr. 17, 1989; 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.172 Reissue applicant.

[Editor Note: Applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

(a) The reissue applicant is the original patentee, or the current patent owner if there has been an assignment. A reissue application must be accompanied by the written consent of all assignees, if any, currently owning an undivided interest in the patent. All assignees consenting to the reissue must establish their ownership in the patent by filing in the reissue application a submission in accordance with the provisions of § 3.73(c) of this chapter.

(b) A reissue will be granted to the original patentee, his legal representatives or assigns as the interest may appear.

[24 FR 10332, Dec. 22, 1959; para. (a), 48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; para. (a) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012]

[*The changes effective Sept. 16, 2012 are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012. See § 1.172 (pre-AIA) for the rule otherwise in effect.]

§ 1.172 (pre-AIA) Applicants, assignees.

[Editor Note: **Not applicable** to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012*]

(a) A reissue oath must be signed and sworn to or declaration made by the inventor or inventors except as otherwise provided (see §§ 1.42, 1.43, 1.47), and must be accompanied by the written consent of all assignees, if any, owning an undivided interest in the patent, but a reissue oath may be made and sworn to or declaration made by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original

patent. All assignees consenting to the reissue must establish their ownership interest in the patent by filing in the reissue application a submission in accordance with the provisions of § 3.73(b) of this chapter.

(b) A reissue will be granted to the original patentee, his legal representatives or assigns as the interest may appear.

[24 FR 10332, Dec. 22, 1959; para. (a), 48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; para. (a) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

[*See § 1.172 for more information and for the rule applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012]

§ 1.173 Reissue specification, drawings, and amendments.

(a) *Contents of a reissue application.* An application for reissue must contain the entire specification, including the claims, and the drawings of the patent. No new matter shall be introduced into the application. No reissue patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent, pursuant to 35 U.S.C. 251.

(1) *Specification, including claims.* The entire specification, including the claims, of the patent for which reissue is requested must be furnished in the form of a copy of the printed patent, in double column format, each page on only one side of a single sheet of paper. If an amendment of the reissue application is to be included, it must be made pursuant to paragraph (b) of this section. The formal requirements for papers making up the reissue application other than those set forth in this section are set out in § 1.52. Additionally, a copy of any disclaimer (§ 1.321), certificate of correction (§§ 1.322 through 1.324), or reexamination certificate (§ 1.570) issued in the patent must be included. (See also § 1.178).

(2) *Drawings.* Applicant must submit a clean copy of each drawing sheet of the printed patent at the time the reissue application is filed. If such copy complies with § 1.84, no further drawings will be required. Where a drawing of the reissue application is to include any changes relative to the patent being reissued, the changes to the drawing must be made in accordance with paragraph (b)(3) of this section. The Office will not transfer the drawings from the patent file to the reissue application.

(b) *Making amendments in a reissue application.* An amendment in a reissue application is made either by physically incorporating the changes into the specification when the application is filed, or by a separate amendment paper. If amendment is made by incorporation, markings pursuant to paragraph (d) of this section must be used. If amendment is made by an amendment paper, the paper must direct that specified changes be made, as follows:

(1) *Specification other than the claims.* Changes to the specification, other than to the claims, must be made by submission of the entire text of an added or rewritten paragraph, including markings pursuant to paragraph (d) of this section, except that an entire paragraph may be deleted by a statement deleting the paragraph without presentation of the text of the paragraph. The precise point in the specification must be identified where any added or rewritten paragraph is located. This paragraph applies whether the amendment is submitted on paper or compact disc (see §§ 1.52(e)(1) and 1.821(c), but not for discs submitted under § 1.821(e)).

(2) *Claims.* An amendment paper must include the entire text of each claim being changed by such amendment paper and of each claim being added by such amendment paper. For any claim changed by the amendment paper, a parenthetical expression “amended,” “twice amended,” *etc.*, should follow the claim number. Each changed patent claim and each added claim must include markings pursuant to paragraph (d) of this section, except that a patent claim or added claim should be canceled by a statement canceling the claim without presentation of the text of the claim.

(3) *Drawings.* One or more patent drawings shall be amended in the following manner: Any changes to a patent drawing must be submitted as a replacement sheet of drawings which shall be an attachment to the amendment document. Any replacement sheet of drawings must be in compliance with § 1.84 and shall include all of the figures appearing on the original version of the sheet, even if only one figure is amended. Amended

figures must be identified as "Amended," and any added figure must be identified as "New." In the event that a figure is canceled, the figure must be surrounded by brackets and identified as "Canceled." All changes to the drawing(s) shall be explained, in detail, beginning on a separate sheet accompanying the papers including the amendment to the drawings.

(i) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be included. The marked-up copy must be clearly labeled as "Annotated Marked-up Drawings" and must be presented in the amendment or remarks section that explains the change to the drawings.

(ii) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.

(c) *Status of claims and support for claim changes*. Whenever there is an amendment to the claims pursuant to paragraph (b) of this section, there must also be supplied, on pages separate from the pages containing the changes, the status (*i.e.*, pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes made to the claims.

(d) *Changes shown by markings.* Any changes relative to the patent being reissued which are made to the specification, including the claims, upon filing, or by an amendment paper in the reissue application, must include the following markings:

(1) The matter to be omitted by reissue must be enclosed in brackets; and

(2) The matter to be added by reissue must be underlined, except for amendments submitted on compact discs (§§ 1.96 and 1.821(c)). Matter added by reissue on compact discs must be preceded with "<U>" and end with "</U>" to properly identify the material being added.

(e) *Numbering of patent claims preserved.* Patent claims may not be renumbered. The numbering of any claim added in the reissue application must follow the number of the highest numbered patent claim.

(f) *Amendment of disclosure may be required.* The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(g) *Amendments made relative to the patent.* All amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing of the reissue application.

[Revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (b)(3) revised, 68 FR 38611, June 30, 2003, effective July 30, 2003; para. (b) introductory text revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

§ 1.174 [Reserved]

[24 FR 10332, Dec. 22, 1959; para. (a), 48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; removed and reserved, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.175 Inventor's oath or declaration for a reissue application.

[Editor Note: Applicable only to patent applications filed under 35 U.S.C. 111, 363, or 385 on or after September 16, 2012*]

(a) The inventor's oath or declaration for a reissue application, in addition to complying with the requirements of § 1.63, § 1.64, or § 1.67, must also specifically identify at least one error pursuant to 35 U.S.C. 251 being relied upon as the basis for reissue and state that the applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent.

(b) If the reissue application seeks to enlarge the scope of the claims of the patent (a basis for the reissue is the patentee claiming less than the patentee had the right to claim in the patent), the inventor's oath or declaration for a reissue application must identify a claim that the application seeks to broaden. A claim is a broadened claim if the claim is broadened in any respect.

(c) The inventor, or each individual who is a joint inventor of a claimed invention, in a reissue application must execute an oath or declaration for

the reissue application, except as provided for in § 1.64, and except that the inventor's oath or declaration for a reissue application may be signed by the assignee of the entire interest if:

(1) The application does not seek to enlarge the scope of the claims of the original patent; or

(2) The application for the original patent was filed under § 1.46 by the assignee of the entire interest.

(d) If errors previously identified in the inventor's oath or declaration for a reissue application pursuant to paragraph (a) of this section are no longer being relied upon as the basis for reissue, the applicant must identify an error being relied upon as the basis for reissue.

(e) The inventor's oath or declaration for a reissue application required by paragraph (a) of this section may be submitted under the provisions of § 1.53(f), except that the provisions of § 1.53(f)(3) do not apply to a reissue application.

(f)(1) The requirement for the inventor's oath or declaration for a continuing reissue application that claims the benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) in compliance with § 1.78 of an earlier-filed reissue application may be satisfied by a copy of the inventor's oath or declaration from the earlier-filed reissue application, provided that:

(i) The inventor, or each individual who is a joint inventor of a claimed invention, in the reissue application executed an inventor's oath or declaration for the earlier-filed reissue application, except as provided for in § 1.64;

(ii) The continuing reissue application does not seek to enlarge the scope of the claims of the original patent; or

(iii) The application for the original patent was filed under § 1.46 by the assignee of the entire interest.

(2) If all errors identified in the inventor's oath or declaration from the earlier-filed reissue application are no longer being relied upon as the basis for reissue, the applicant must identify an error being relied upon as the basis for reissue.

(g) An oath or declaration filed at any time pursuant to 35 U.S.C. 115(h)(1), will be placed in the file record of the reissue application, but may not necessarily be reviewed by the Office.

[24 FR 10332, Dec. 22, 1959; 29 FR 18503, Dec. 29, 1964; 34 FR 18857, Nov. 26, 1969; para. (a), 47 FR 21752, May 19, 1982, effective July 1,1982; para. (a), 48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; para. (a)(7), 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (e) added, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004; revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012; para. (f)(1) introductory text revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

[*****The changes effective Sept. 16, 2012 and May 13, 2015 are applicable only to patent applications filed under 35 U.S.C. 111, 363, or 385 on or after September 16, 2012. See § 1.175 (pre-AIA) for the rule otherwise in effect.]

§ 1.175 (pre-AIA) Reissue oath or declaration.

[Editor Note: **Not applicable** to patent applications filed under 35 U.S.C. 111, 363, or 385 on or after Sept. 16, 2012*****]

(a) The reissue oath or declaration in addition to complying with the requirements of § 1.63, must also state that:

(1) The applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, stating at least one error being relied upon as the basis for reissue; and

(2) All errors being corrected in the reissue application up to the time of filing of the oath or declaration under this paragraph arose without any deceptive intention on the part of the applicant.

(b)(1) For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant. Any supplemental oath or declaration required by this paragraph must be submitted before allowance and may be submitted:

(i) With any amendment prior to allowance; or

(ii) In order to overcome a rejection under 35 U.S.C. 251 made by the examiner where it is indicated that the submission of a supplemental oath or declaration as required by this paragraph will overcome the rejection.

(2) For any error sought to be corrected after allowance, a supplemental oath or declaration must accompany the requested correction stating that the error(s) to be corrected arose without any deceptive intention on the part of the applicant.

(c) Having once stated an error upon which the reissue is based, as set forth in paragraph (a)(1), unless all errors previously stated in the oath or declaration are no longer being corrected, a subsequent oath or declaration under paragraph (b) of this section need not specifically identify any other error or errors being corrected.

(d) The oath or declaration required by paragraph (a) of this section may be submitted under the provisions of § 1.53(f).

(e) The filing of any continuing reissue application which does not replace its parent reissue application must include an oath or declaration which, pursuant to paragraph (a)(1) of this section, identifies at least one error in the original patent which has not been corrected by the parent reissue application or an earlier reissue application. All other requirements relating to oaths or declarations must also be met.

[24 FR 10332, Dec. 22, 1959; 29 FR 18503, Dec. 29, 1964; 34 FR 18857, Nov. 26, 1969; para. (a), 47 FR 21752, May 19, 1982, effective July 1,1982; para. (a), 48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; para. (a)(7), 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (e) added, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

[*See § 1.175 for more information and for the rule applicable to patent applications filed under 35 U.S.C. 111, 363, or 385 on or after September 16, 2012]

§ 1.176 Examination of reissue.

(a) A reissue application will be examined in the same manner as a non-reissue, non-provisional application, and will be subject to all the requirements of the rules related to non-reissue applications. Applications for reissue will be acted on by the examiner in advance of other applications.

(b) Restriction between subject matter of the original patent claims and previously unclaimed subject matter may be required (restriction involving only subject matter of the original patent claims will not be required). If restriction is required, the subject matter of the original patent claims will be held to be constructively elected unless a disclaimer of all the patent claims is filed in the reissue application, which disclaimer cannot be withdrawn by applicant.

[42 FR 5595, Jan. 28, 1977; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.177 Issuance of multiple reissue patents.

(a) The Office may reissue a patent as multiple reissue patents. If applicant files more than one application for the reissue of a single patent, each such application must contain or be amended to contain in the first sentence of the specification a notice stating that more than one reissue application has been filed and identifying each of the reissue applications by relationship, application number and filing date. The Office may correct by certificate of correction under § 1.322 any reissue patent resulting from an application to which this paragraph applies that does not contain the required notice.

(b) If applicant files more than one application for the reissue of a single patent, each claim of the patent being reissued must be presented in each of the reissue applications as an amended, unamended, or canceled (shown in brackets) claim, with each such claim bearing the same number as in the patent being reissued. The same claim of the patent being reissued may not be presented in its original unamended form for examination in more than one of such multiple reissue applications. The numbering of any added claims in any of the multiple reissue applications must follow the number of the highest numbered original patent claim.

(c) If any one of the several reissue applications by itself fails to correct an error in the original patent as required by 35 U.S.C. 251 but is otherwise in condition for allowance, the Office may suspend action in the allowable application until all issues are resolved as to at least one of the remaining reissue applications. The Office may also merge two or more of the multiple reissue applications into a single reissue application. No reissue application containing only unamended patent claims and not

correcting an error in the original patent will be passed to issue by itself.

[47 FR 41272, Sept. 17, 1982, effective date Oct. 1, 1982; revised, 54 FR 6893, Feb. 15, 1989, 54 FR 9432, March 7, 1989, effective Apr. 17, 1989; revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.178 Original patent; continuing duty of applicant.

(a) The application for reissue of a patent shall constitute an offer to surrender that patent, and the surrender shall take effect upon reissue of the patent. Until a reissue application is granted, the original patent shall remain in effect.

(b) In any reissue application before the Office, the applicant must call to the attention of the Office any prior or concurrent proceedings in which the patent (for which reissue is requested) is or was involved, such as interferences or trials before the Patent Trial and Appeal Board, reissues, reexaminations, or litigations and the results of such proceedings (see also § 1.173(a)(1)).

[24 FR 10332, Dec. 22, 1959; 34 FR 18857, Nov. 26, 1969; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a) revised, 69 FR 56481, Sept. 21, 2004, effective Sept. 21, 2004; para. (b) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

§ 1.179 [Reserved]

[Removed and reserved, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

PETITIONS AND ACTION BY THE DIRECTOR

§ 1.181 Petition to the Director.

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Patent Trial and Appeal Board or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Patent Trial and Appeal Board, see § 41.3 of this title.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

(d) Where a fee is required for a petition to the Director the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

(e) Oral hearing will not be granted except when considered necessary by the Director.

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

[24 FR 10332, Dec. 22, 1959; 34 FR 18857, Nov. 26, 1969; paras. (d) and (g), 47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (f) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a) and (c) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; paras. (a), (a)(2)-(3), (c)-(e) & (g) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para.

(a)(3) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; paras. (a)(1) and (a)(3) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

§ 1.182 Questions not specifically provided for.

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

[47 FR 41272, Sept. 17, 1982, effective date Oct. 1, 1982; revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004]

§ 1.183 Suspension of rules.

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

[47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004]

§ 1.184 [Reserved]

[Removed and reserved, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

APPEAL TO THE PATENT TRIAL AND APPEAL BOARD

§ 1.191 Appeal to Patent Trial and Appeal Board.

Appeals to the Patent Trial and Appeal Board under 35 U.S.C. 134(a) and (b) are conducted according to part 41 of this title.

[46 FR 29183, May 29, 1981; para. (a), 47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; para. (d), 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; paras. (b) and (d) amended, para. (e) added, 54 FR 29553, July 13, 1989, effective Aug. 20, 1989; para. (d) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; paras. (a) and (b) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (e) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (a) revised, 68 FR 70996, Dec. 22, 2003, effective Jan. 21, 2004; revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

§ 1.192 [Reserved]

[36 FR 5850, Mar. 30, 1971; para. (a), 47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; para. (a), 49 FR 556, Jan. 4, 1984, effective Apr. 1, 1984; 53 FR 23734, June 23, 1988, effective Sept. 12, 1988; para. (a), (c), and (d) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; paras. (a)-(c) revised, 60 FR 14488, Mar 17, 1995, effective Apr. 21, 1995; para. (a) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; removed and reserved, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 1.193 [Reserved]

[24 FR 10332, Dec. 22, 1959; 34 FR 18858, Nov.26, 1969; para. (c), 47 FR 21752, May 19, 1982, added effective July 1, 1982; para. (b), 50 FR 9382, Mar. 7, 1985, effective May 8, 1985; 53 FR 23735, June 23, 1988, effective Sept. 12, 1988; para. (c) deleted, 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; para. (b) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (b)(1) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a)(1) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; removed and reserved, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 1.194 [Reserved]

[42 FR 5595, Jan. 28, 1977; paras. (b) & (c), 47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (b) revised 53 FR 23735, June 23, 1988, effective Sept. 12, 1988; para. (b) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; removed and reserved, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 1.195 [Reserved]

[34 FR 18858, Nov. 26, 1969; removed and reserved, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 1.196 [Reserved]

[24 FR 10332, Dec. 12, 1959; 49 FR 29183, May 29, 1981; 49 FR 48416, Dec. 12, 1984, effective Feb. 12, 1985; para. (b) revised, 53 FR 23735, June 23, 1988, effective Sept. 12, 1988; paras. (a), (b) & (d) amended, paras. (e) & (f) added, 54 FR 29552, July 13, 1989, effective Aug. 20, 1989; para. (f) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; paras. (b) & (d) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; removed and reserved, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 1.197 Termination of proceedings.

(a) Proceedings on an application are considered terminated by the dismissal of an appeal or the failure to timely file an appeal to the court or a civil action except:

(1) Where claims stand allowed in an application; or

(2) Where the nature of the decision requires further action by the examiner.

(b) The date of termination of proceedings on an application is the date on which the appeal is dismissed or the date on which the time for appeal to the U.S. Court of Appeals for the Federal Circuit or review by civil action (§ 90.3 of this chapter) expires in the absence of further appeal or review. If an appeal to the U.S. Court of Appeals for the Federal Circuit or a civil action has been filed, proceedings on an application are considered terminated when the appeal or civil action is terminated. A civil action is terminated when the time to appeal the judgment expires. An appeal to the U.S. Court of Appeals for the Federal Circuit, whether from a decision of the Board or a judgment in a civil action, is terminated when the mandate is issued by the Court.

[46 FR 29184, May 29, 1981; para. (a), 47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; 49 FR 556, Jan. 4, 1984, effective Apr. 1, 1984; paras. (a) and (b), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; paras. (b) and (c), 54 FR 29552, July 13, 1989, effective Aug. 20, 1989; para. (b) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; paras. (a) & (b) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (c) revised, 68 FR 70996, Dec. 22, 2003, effective Jan. 21, 2004; revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; section heading revised and para. (a) removed and reserved, 76 FR 72270, Nov. 22, 2011, effective Jan. 23, 2012; revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013 and corrected 78 FR 75251, Dec. 11, 2013, effective Dec. 18, 2013]

§ 1.198 Reopening after a final decision of the Patent Trial and Appeal Board.

When a decision by the Patent Trial and Appeal Board on appeal has become final for judicial review, prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 41.50 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.

[49 FR 48416, Dec. 12, 1984, effective date Feb. 11, 1985; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

PUBLICATION OF APPLICATIONS

§ 1.211 Publication of applications.

[Editor Note: Para. (c) below is applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

(a) Each U.S. national application for patent filed in the Office under 35 U.S.C. 111(a) and each international application in compliance with 35

U.S.C. 371 will be published promptly after the expiration of a period of eighteen months from the earliest filing date for which a benefit is sought under title 35, United States Code, unless:

(1) The application is recognized by the Office as no longer pending;

(2) The application is national security classified (see § 5.2(c)), subject to a secrecy order under 35 U.S.C. 181, or under national security review;

(3) The application has issued as a patent in sufficient time to be removed from the publication process; or

(4) The application was filed with a nonpublication request in compliance with § 1.213(a).

(b) Provisional applications under 35 U.S.C. 111(b) shall not be published, and design applications under 35 U.S.C. chapter 16, international design applications under 35 U.S.C. chapter 38, and reissue applications under 35 U.S.C. chapter 25 shall not be published under this section.

(c) An application filed under 35 U.S.C. 111(a) will not be published until it includes the basic filing fee (§ 1.16(a) or § 1.16(c)) and any English translation required by § 1.52(d). The Office may delay publishing any application until it includes any application size fee required by the Office under § 1.16(s) or § 1.492(j), a specification having papers in compliance with § 1.52 and an abstract (§ 1.72(b)), drawings in compliance with § 1.84, a sequence listing in compliance with §§ 1.821 through 1.825 (if applicable), and the inventor's oath or declaration or application data sheet containing the information specified in § 1.63(b).

(d) The Office may refuse to publish an application, or to include a portion of an application in the patent application publication (§ 1.215), if publication of the application or portion thereof would violate Federal or state law, or if the application or portion thereof contains offensive or disparaging material.

(e) The publication fee set forth in § 1.18(d) must be paid in each application published under this section before the patent will be granted. If an application is subject to publication under this section, the sum specified in the notice of allowance under § 1.311 will also include the publication fee which must be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. This three-month period is not extendable. If the application is not published under this section, the publication fee (if paid) will be refunded.

[Added, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para. (c) revised, 70 FR 3880, Jan. 27, 2005, effective Dec. 8, 2004; para. (c) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012; para. (b) revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

[*****The revisions to para. (c) effective Sept. 16, 2012 are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012. See § 1.211 (pre-AIA) for para. (c) otherwise in effect.]

§ 1.211 (pre-AIA) Publication of applications.

[Editor Note: Para. (c) below is **not applicable** to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*****]

(a) Each U.S. national application for patent filed in the Office under 35 U.S.C.111(a) and each international application in compliance with 35 U.S.C. 371 will be published promptly after the expiration of a period of eighteen months from the earliest filing date for which a benefit is sought under title 35, United States Code, unless:

(1) The application is recognized by the Office as no longer pending;

(2) The application is national security classified (see § 5.2(c)), subject to a secrecy order under 35 U.S.C. 181, or under national security review;

(3) The application has issued as a patent in sufficient time to be removed from the publication process; or

(4) The application was filed with a nonpublication request in compliance with § 1.213(a).

(b) Provisional applications under 35 U.S.C. 111(b) shall not be published, and design applications under 35 U.S.C. chapter 16 and reissue applications under 35 U.S.C. chapter 25 shall not be published under this section.

(c) An application filed under 35 U.S.C. 111(a) will not be published until it includes the basic filing

fee (§ 1.16(a) or 1.16(c)), any English translation required by § 1.52(d), and an executed oath or declaration under § 1.63. The Office may delay publishing any application until it includes any application size fee required by the Office under § 1.16(s) or § 1.492(j), a specification having papers in compliance with § 1.52 and an abstract (§ 1.72(b)), drawings in compliance with § 1.84, and a sequence listing in compliance with §§ 1.821 through 1.825 (if applicable), and until any petition under § 1.47 is granted.

(d) The Office may refuse to publish an application, or to include a portion of an application in the patent application publication (§ 1.215), if publication of the application or portion thereof would violate Federal or state law, or if the application or portion thereof contains offensive or disparaging material.

(e) The publication fee set forth in § 1.18(d) must be paid in each application published under this section before the patent will be granted. If an application is subject to publication under this section, the sum specified in the notice of allowance under § 1.311 will also include the publication fee which must be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. This three-month period is not extendable. If the application is not published under this section, the publication fee (if paid) will be refunded.

[Added, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para. (c) revised, 70 FR 3880, Jan. 27, 2005, effective Dec. 8, 2004]

[*See § 1.211 for more information and for the rule applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012]

§ 1.213 Nonpublication request.

(a) If the invention disclosed in an application has not been and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing, the application will not be published under 35 U.S.C. 122(b) and § 1.211 provided:

(1) A request (nonpublication request) is submitted with the application upon filing;

(2) The request states in a conspicuous manner that the application is not to be published under 35 U.S.C. 122(b);

(3) The request contains a certification that the invention disclosed in the application has not been and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication at eighteen months after filing; and

(4) The request is signed in compliance with § 1.33(b).

(b) The applicant may rescind a nonpublication request at any time. A request to rescind a nonpublication request under paragraph (a) of this section must:

(1) Identify the application to which it is directed;

(2) State in a conspicuous manner that the request that the application is not to be published under 35 U.S.C. 122(b) is rescinded; and

(3) Be signed in compliance with § 1.33(b).

(c) If an applicant who has submitted a nonpublication request under paragraph (a) of this section subsequently files an application directed to the invention disclosed in the application in which the nonpublication request was submitted in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing, the applicant must notify the Office of such filing within forty-five days after the date of the filing of such foreign or international application. The failure to timely notify the Office of the filing of such foreign or international application shall result in abandonment of the application in which the nonpublication request was submitted (35 U.S.C. 122(b)(2)(B)(iii)).

[Added, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 1.215 Patent application publication.

[Editor Note: Paragraphs (a) - (c) below are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

(a) The publication of an application under 35 U.S.C. 122(b) shall include a patent application publication. The date of publication shall be indicated on the patent application publication. The

patent application publication will be based upon the specification and drawings deposited on the filing date of the application, as well as the application data sheet and/or the inventor's oath or declaration. The patent application publication may also be based upon amendments to the specification (other than the abstract or the claims) that are reflected in a substitute specification under § 1.125(b), amendments to the abstract under § 1.121(b), amendments to the claims that are reflected in a complete claim listing under § 1.121(c), and amendments to the drawings under § 1.121(d), provided that such substitute specification or amendment is submitted in sufficient time to be entered into the Office file wrapper of the application before technical preparations for publication of the application have begun. Technical preparations for publication of an application generally begin four months prior to the projected date of publication. The patent application publication of an application that has entered the national stage under 35 U.S.C. 371 may also include amendments made during the international stage. *See* paragraph (c) of this section for publication of an application based upon a copy of the application submitted via the Office electronic filing system.

(b) The patent application publication will include the name of the assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter if that information is provided in the application data sheet in an application filed under § 1.46. Assignee information may be included on the patent application publication in other applications if the assignee information is provided in an application data sheet submitted in sufficient time to be entered into the Office file wrapper of the application before technical preparations for publication of the application have begun. Providing assignee information in the application data sheet does not substitute for compliance with any requirement of part 3 of this chapter to have an assignment recorded by the Office.

(c) At applicant's option, the patent application publication will be based upon the copy of the application (specification, drawings, and the application data sheet and/or the inventor's oath or declaration) as amended, provided that applicant supplies such a copy in compliance with the Office electronic filing system requirements within one month of the mailing date of the first Office communication that includes a confirmation number for the application, or fourteen months of the earliest filing date for which a benefit is sought under title 35, United States Code, whichever is later.

(d) If the copy of the application submitted pursuant to paragraph (c) of this section does not comply with the Office electronic filing system requirements, the Office will publish the application as provided in paragraph (a) of this section. If, however, the Office has not started the publication process, the Office may use an untimely filed copy of the application supplied by the applicant under paragraph (c) of this section in creating the patent application publication.

[Added, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; paras. (a) and (c) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004; paras. (a)-(c) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012]

[*The revisions to paras. (a)-(c) effective Sept. 16, 2012 are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012. See § 1.215 (pre-AIA) for the rule otherwise in effect.]

§ 1.215 (pre-AIA) Patent application publication.

[Editor Paragraphs (a) - (c) below are **not applicable** to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012]

(a) The publication of an application under 35 U.S.C. 122(b) shall include a patent application publication. The date of publication shall be indicated on the patent application publication. The patent application publication will be based upon the specification and drawings deposited on the filing date of the application, as well as the executed oath or declaration submitted to complete the application. The patent application publication may also be based upon amendments to the specification (other than the abstract or the claims) that are reflected in a substitute specification under § 1.125(b), amendments to the abstract under § 1.121(b), amendments to the claims that are reflected in a complete claim listing under § 1.121(c), and amendments to the drawings under § 1.121(d), provided that such substitute specification or amendment is submitted in sufficient time to be

entered into the Office file wrapper of the application before technical preparations for publication of the application have begun. Technical preparations for publication of an application generally begin four months prior to the projected date of publication. The patent application publication of an application that has entered the national stage under 35 U.S.C. 371 may also include amendments made during the international stage. See paragraph (c) of this section for publication of an application based upon a copy of the application submitted via the Office electronic filing system.

(b) If applicant wants the patent application publication to include assignee information, the applicant must include the assignee information on the application transmittal sheet or the application data sheet (§ 1.76). Assignee information may not be included on the patent application publication unless this information is provided on the application transmittal sheet or application data sheet included with the application on filing. Providing this information on the application transmittal sheet or the application data sheet does not substitute for compliance with any requirement of part 3 of this chapter to have an assignment recorded by the Office.

(c) At applicant's option, the patent application publication will be based upon the copy of the application (specification, drawings, and oath or declaration) as amended, provided that applicant supplies such a copy in compliance with the Office electronic filing system requirements within one month of the mailing date of the first Office communication that includes a confirmation number for the application, or fourteen months of the earliest filing date for which a benefit is sought under title 35, United States Code, whichever is later.

(d) If the copy of the application submitted pursuant to paragraph (c) of this section does not comply with the Office electronic filing system requirements, the Office will publish the application as provided in paragraph (a) of this section. If, however, the Office has not started the publication process, the Office may use an untimely filed copy of the application supplied by the applicant under paragraph (c) of this section in creating the patent application publication.

[Added, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; paras. (a) and (c) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

[*See § 1.215 for more information and for the rule applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012]

§ 1.217 Publication of a redacted copy of an application.

(a) If an applicant has filed applications in one or more foreign countries, directly or through a multilateral international agreement, and such foreign-filed applications or the description of the invention in such foreign-filed applications is less extensive than the application or description of the invention in the application filed in the Office, the applicant may submit a redacted copy of the application filed in the Office for publication, eliminating any part or description of the invention that is not also contained in any of the corresponding applications filed in a foreign country. The Office will publish the application as provided in § 1.215(a) unless the applicant files a redacted copy of the application in compliance with this section within sixteen months after the earliest filing date for which a benefit is sought under title 35, United States Code.

(b) The redacted copy of the application must be submitted in compliance with the Office electronic filing system requirements. The title of the invention in the redacted copy of the application must correspond to the title of the application at the time the redacted copy of the application is submitted to the Office. If the redacted copy of the application does not comply with the Office electronic filing system requirements, the Office will publish the application as provided in § 1.215(a).

(c) The applicant must also concurrently submit in paper (§ 1.52(a)) to be filed in the application:

(1) A certified copy of each foreign-filed application that corresponds to the application for which a redacted copy is submitted;

(2) A translation of each such foreign-filed application that is in a language other than English, and a statement that the translation is accurate;

(3) A marked-up copy of the application showing the redactions in brackets; and

(4) A certification that the redacted copy of the application eliminates only the part or description of the invention that is not contained in

any application filed in a foreign country, directly or through a multilateral international agreement, that corresponds to the application filed in the Office.

(d) The Office will provide a copy of the complete file wrapper and contents of an application for which a redacted copy was submitted under this section to any person upon written request pursuant to § 1.14(c)(2), unless applicant complies with the requirements of paragraphs (d)(1), (d)(2), and (d)(3) of this section.

(1) Applicant must accompany the submission required by paragraph (c) of this section with the following:

(i) A copy of any Office correspondence previously received by applicant including any desired redactions, and a second copy of all Office correspondence previously received by applicant showing the redacted material in brackets; and

(ii) A copy of each submission previously filed by the applicant including any desired redactions, and a second copy of each submission previously filed by the applicant showing the redacted material in brackets.

(2) In addition to providing the submission required by paragraphs (c) and (d)(1) of this section, applicant must:

(i) Within one month of the date of mailing of any correspondence from the Office, file a copy of such Office correspondence including any desired redactions, and a second copy of such Office correspondence showing the redacted material in brackets; and

(ii) With each submission by the applicant, include a copy of such submission including any desired redactions, and a second copy of such submission showing the redacted material in brackets.

(3) Each submission under paragraph (d)(1) or (d)(2) of this paragraph must also be accompanied by the processing fee set forth in § 1.17(i) and a certification that the redactions are limited to the elimination of material that is relevant only to the part or description of the invention that was not contained in the redacted copy of the application submitted for publication.

(e) The provisions of § 1.8 do not apply to the time periods set forth in this section.

[Added, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 1.219 Early publication.

Applications that will be published under § 1.211 may be published earlier than as set forth in § 1.211(a) at the request of the applicant. Any request for early publication must be accompanied by the publication fee set forth in § 1.18(d). If the applicant does not submit a copy of the application in compliance with the Office electronic filing system requirements pursuant to § 1.215(c), the Office will publish the application as provided in § 1.215(a). No consideration will be given to requests for publication on a certain date, and such requests will be treated as a request for publication as soon as possible.

[Added, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 1.221 Voluntary publication or republication of patent application publication.

(a) Any request for publication of an application filed before, but pending on, November 29, 2000, and any request for republication of an application previously published under § 1.211, must include a copy of the application in compliance with the Office electronic filing system requirements and be accompanied by the publication fee set forth in § 1.18(d) and the processing fee set forth in § 1.17(i). If the request does not comply with the requirements of this paragraph or the copy of the application does not comply with the Office electronic filing system requirements, the Office will not publish the application and will refund the publication fee.

(b) The Office will grant a request for a corrected or revised patent application publication other than as provided in paragraph (a) of this section only when the Office makes a material mistake which is apparent from Office records. Any request for a corrected or revised patent application publication other than as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable.

[Added, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

MISCELLANEOUS PROVISIONS

§ 1.248 Service of papers; manner of service; proof of service in cases other than interferences and trials.

(a) Service of papers must be on the attorney or agent of the party if there be such or on the party if there is no attorney or agent, and may be made in any of the following ways:

(1) By delivering a copy of the paper to the person served;

(2) By leaving a copy at the usual place of business of the person served with someone in his employment;

(3) When the person served has no usual place of business, by leaving a copy at the person's residence, with some person of suitable age and discretion who resides there;

(4) Transmission by first class mail. When service is by mail the date of mailing will be regarded as the date of service;

(5) Whenever it shall be satisfactorily shown to the Director that none of the above modes of obtaining or serving the paper is practicable, service may be by notice published in the *Official Gazette.*

(b) Papers filed in the Patent and Trademark Office which are required to be served shall contain proof of service. Proof of service may appear on or be affixed to papers filed. Proof of service shall include the date and manner of service. In the case of personal service, proof of service shall also include the name of any person served, certified by the person who made service. Proof of service may be made by:

(1) An acknowledgement of service by or on behalf of the person served or

(2) A statement signed by the attorney or agent containing the information required by this section.

(c) *See* § 41.106(e) or § 42.6(e) of this title for service of papers in contested cases or trials before the Patent Trial and Appeal Board.

[46 FR 29184, May 29, 1981; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (a)(5) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (c) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (c) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (c) revised, 69 FR 5 8260, Sept. 30, 2004, effective Sept. 30, 2004; section heading and para. (c) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

§ 1.251 Unlocatable file.

(a) In the event that the Office cannot locate the file of an application, patent, or other patent-related proceeding after a reasonable search, the Office will notify the applicant or patentee and set a time period within which the applicant or patentee must comply with the notice in accordance with one of paragraphs (a)(1), (a)(2), or (a)(3) of this section.

(1) Applicant or patentee may comply with a notice under this section by providing:

(i) A copy of the applicant's or patentee's record (if any) of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding (except for U.S. patent documents);

(ii) A list of such correspondence; and

(iii) A statement that the copy is a complete and accurate copy of the applicant's or patentee's record of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding (except for U.S. patent documents), and whether applicant or patentee is aware of any correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding that is not among applicant's or patentee's records.

(2) Applicant or patentee may comply with a notice under this section by:

(i) Producing the applicant's or patentee's record (if any) of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding for the Office to copy (except for U.S. patent documents); and

(ii) Providing a statement that the papers produced by applicant or patentee are applicant's or patentee's complete record of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding (except for U.S. patent documents), and whether applicant or patentee is aware of any correspondence between the Office and the applicant

or patentee for such application, patent, or other proceeding that is not among applicant's or patentee's records.

(3) If applicant or patentee does not possess any record of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding, applicant or patentee must comply with a notice under this section by providing a statement that applicant or patentee does not possess any record of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding.

(b) With regard to a pending application, failure to comply with one of paragraphs (a)(1), (a)(2), or (a)(3) of this section within the time period set in the notice will result in abandonment of the application.

[Added, 65 FR 69446, Nov. 17, 2000, effective Nov. 17, 2000]

PREISSUANCE SUBMISSIONS AND PROTESTS BY THIRD PARTIES

§ 1.290 Submissions by third parties in applications.

(a) A third party may submit, for consideration and entry in the record of a patent application, any patents, published patent applications, or other printed publications of potential relevance to the examination of the application if the submission is made in accordance with 35 U.S.C. 122(e) and this section. A third-party submission may not be entered or considered by the Office if any part of the submission is not in compliance with 35 U.S.C. 122(e) and this section.

(b) Any third-party submission under this section must be filed prior to the earlier of:

(1) The date a notice of allowance under § 1.311 is given or mailed in the application; or

(2) The later of:

(i) Six months after the date on which the application is first published by the Office under 35 U.S.C. 122(b) and § 1.211, or

(ii) The date the first rejection under § 1.104 of any claim by the examiner is given or mailed during the examination of the application.

(c) Any third-party submission under this section must be made in writing.

(d) Any third-party submission under this section must include:

(1) A document list identifying the documents, or portions of documents, being submitted in accordance with paragraph (e) of this section;

(2) A concise description of the asserted relevance of each item identified in the document list;

(3) A legible copy of each item identified in the document list, other than U.S. patents and U.S. patent application publications;

(4) An English language translation of any non-English language item identified in the document list; and

(5) A statement by the party making the submission that:

(i) The party is not an individual who has a duty to disclose information with respect to the application under § 1.56; and

(ii) The submission complies with the requirements of 35 U.S.C. 122(e) and this section.

(e) The document list required by paragraph (d)(1) of this section must include a heading that identifies the list as a third-party submission under § 1.290, identify on each page of the list the application number of the application in which the submission is being filed, list U.S. patents and U.S. patent application publications in a separate section from other items, and identify each:

(1) U.S. patent by patent number, first named inventor, and issue date;

(2) U.S. patent application publication by patent application publication number, first named inventor, and publication date;

(3) Foreign patent or published foreign patent application by the country or patent office that issued the patent or published the application; the applicant, patentee, or first named inventor; an appropriate document number; and the publication date indicated on the patent or published application; and

(4) Non-patent publication by author (if any), title, pages being submitted, publication date, and,

where available, publisher and place of publication. If no publication date is known, the third party must provide evidence of publication.

(f) Any third-party submission under this section must be accompanied by the fee set forth in § 1.17(o) for every ten items or fraction thereof identified in the document list.

(g) The fee otherwise required by paragraph (f) of this section is not required for a submission listing three or fewer total items that is accompanied by a statement by the party making the submission that, to the knowledge of the person signing the statement after making reasonable inquiry, the submission is the first and only submission under 35 U.S.C. 122(e) filed in the application by the party or a party in privity with the party.

(h) In the absence of a request by the Office, an applicant need not reply to a submission under this section.

(i) The provisions of § 1.8 do not apply to the time periods set forth in this section.

[Added, 77 FR 42150, July 17, 2012, effective Sept. 16, 2012; para. (f) revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013]

§ 1.291 Protests by the public against pending applications.

(a) A protest may be filed by a member of the public against a pending application, and it will be matched with the application file if it adequately identifies the patent application. A protest submitted within the time frame of paragraph (b) of this section, which is not matched, or not matched in a timely manner to permit review by the examiner during prosecution, due to inadequate identification, may not be entered and may be returned to the protestor where practical, or, if return is not practical, discarded.

(b) The protest will be entered into the record of the application if, in addition to complying with paragraph (c) of this section, the protest has been served upon the applicant in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible; and, except for paragraph (b)(1) of this section, the protest was filed prior to the date the application was published under § 1.211, or the date a notice of allowance under § 1.311 was given or mailed, whichever occurs first:

(1) If a protest is accompanied by the written consent of the applicant, the protest will be considered if the protest is filed prior to the date a notice of allowance under § 1.311 is given or mailed in the application.

(2) A statement must accompany a protest that it is the first protest submitted in the application by the real party in interest who is submitting the protest; or the protest must comply with paragraph (c)(5) of this section. This section does not apply to the first protest filed in an application.

(c) In addition to compliance with paragraphs (a) and (b) of this section, a protest must include:

(1) An information list of the documents, portions of documents, or other information being submitted, where each:

(i) U.S. patent is identified by patent number, first named inventor, and issue date;

(ii) U.S. patent application publication is identified by patent application publication number, first named inventor, and publication date;

(iii) Foreign patent or published foreign patent application is identified by the country or patent office that issued the patent or published the application; an appropriate document number; the applicant, patentee, or first named inventor; and the publication date indicated on the patent or published application;

(iv) Non-patent publication is identified by author (if any), title, pages being submitted, publication date, and, where available, publisher and place of publication; and

(v) Item of other information is identified by date, if known.

(2) A concise explanation of the relevance of each item identified in the information list pursuant to paragraph (c)(1) of this section;

(3) A legible copy of each item identified in the information list, other than U.S. patents and U.S. patent application publications;

(4) An English language translation of any non-English language item identified in the information list; and

(5) If it is a second or subsequent protest by the same real party in interest, an explanation as to why the issue(s) raised in the second or subsequent

protest are significantly different than those raised earlier and why the significantly different issue(s) were not presented earlier, and a processing fee under § 1.17(i) must be submitted.

(d) A member of the public filing a protest in an application under this section will not receive any communication from the Office relating to the protest, other than the return of a self-addressed postcard which the member of the public may include with the protest in order to receive an acknowledgment by the Office that the protest has been received. The limited involvement of the member of the public filing a protest pursuant to this section ends with the filing of the protest, and no further submission on behalf of the protestor will be considered, unless the submission is made pursuant to paragraph (c)(5) of this section.

(e) Where a protest raising inequitable conduct issues satisfies the provisions of this section for entry, it will be entered into the application file, generally without comment on the inequitable conduct issues raised in it.

(f) In the absence of a request by the Office, an applicant need not reply to a protest.

(g) Protests that fail to comply with paragraphs (b) or (c) of this section may not be entered, and if not entered, will be returned to the protestor, or discarded, at the option of the Office.

[47 FR 21752, May 19, 1982, effective July 1, 1982; paras. (a) and (c), 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; paras. (a) and (b) revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; para. (c) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (a)(1) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004; para. (b) introductory text and paras. (b)(1), (c)(1)-(4), and (f) revised, 77 FR 42150, July 17, 2012, effective Sept. 16, 2012]

§ 1.292 [Reserved]

[Removed and reserved, 77 FR 42150, July 17, 2012, effective Sept. 16, 2012]

§ 1.293 [Reserved]

[Removed and reserved, 78 FR 11024, Feb. 14, 2013, effective Mar. 16, 2013. See § 1.293 (pre-2013-03-16) for the rule applicable to any request for a statutory invention registration filed prior to March 16, 2013.]

§ 1.293 (pre-2013-03-16) Statutory invention registration.

[Editor Note: Applies to any request for a statutory invention registration filed prior to March 16, 2013]

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

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

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

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

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

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

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

unless a reissue application is filed seeking to enlarge the scope of the claims of the patent. See also § 1.104(c)(5).

[50 FR 9382, Mar. 7, 1985, effective date May 8, 1985; para. (c) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; removed and reserved, 78 FR 11024, Feb. 14, 2013, effective Mar. 16, 2013]

§ 1.294 [Reserved]

[Removed and reserved, 78 FR 11024, Feb. 14, 2013, effective Mar. 16, 2013. See § 1.294 (pre-2013-03-16) for the rule applicable to any request for a statutory invention registration filed prior to March 16, 2013.]

§ 1.294 (pre-2013-03-16) Examination of request for publication of a statutory invention registration and patent application to which the request is directed.

[Editor Note: Applies to any request for a statutory invention registration filed prior to March 16, 2013]

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

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

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

[50 FR 9382, Mar. 7, 1985, effective date May 8, 1985; para. (b) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; removed and reserved, 78 FR 11024, Feb. 14, 2013, effective Mar. 16, 2013]

§ 1.295 [Reserved]

[Removed and reserved, 78 FR 11024, Feb. 14, 2013, effective Mar. 16, 2013. See § 1.295 (pre-2013-03-16) for the rule applicable to any request for a statutory invention registration filed prior to March 16, 2013.]

§ 1.295 (pre-2013-03-16) Review of decision finally refusing to publish a statutory invention registration.

[Editor Note: Applies to any request for a statutory invention registration filed prior to March 16, 2013]

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

(b) Any requester who is dissatisfied with a decision finally rejecting claims pursuant to 35 U.S.C. 112 may obtain review of the decision by filing an appeal to the Board of Patent Appeals and Interferences pursuant to § 41.31 of this title. If the decision rejecting claims pursuant to 35 U.S.C. 112 is reversed, the request for a statutory invention registration will be approved and the registration

published if all of the other provisions of § 1.293 and this section are met.

[50 FR 9382, Mar. 7, 1985, effective May 8, 1985; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (b) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (a) revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004; removed and reserved, 78 FR 11024, Feb. 14, 2013, effective Mar. 16, 2013]

§ 1.296 [Reserved]

[Removed and reserved, 78 FR 11024, Feb. 14, 2013, effective Mar. 16, 2013. See § 1.296 (pre-2013-03-16) for the rule applicable to any request for a statutory invention registration filed prior to March 16, 2013.]

§ 1.296 (pre-2013-03-16) Withdrawal of request for publication of statutory invention registration.

[Editor Note: Applies to any request for a statutory invention registration filed prior to March 16, 2013]

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

[50 FR 9382, Mar. 7, 1985, effective date May 8, 1985; revised, 54 FR 6893, Feb. 15, 1989, effective Apr. 17, 1989; 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004; removed and reserved, 78 FR 11024, Feb. 14, 2013, effective Mar. 16, 2013]

§ 1.297 [Reserved]

[Removed and reserved, 78 FR 11024, Feb. 14, 2013, effective Mar. 16, 2013. See § 1.297 (pre-2013-03-16) for the rule applicable to any request for a statutory invention registration filed prior to March 16, 2013.]

§ 1.297 (pre-2013-03-16) Publication of statutory invention registration.

[Editor Note: Applies to any request for a statutory invention registration filed prior to March 16, 2013]

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

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

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

[50 FR 9382, Mar. 7, 1985, effective May 8, 1985; 50 FR 31826, Aug. 6, 1985, effective Oct. 5, 1985; removed and reserved, 78 FR 11024, Feb. 14, 2013, effective Mar. 16, 2013]

REVIEW OF PATENT AND TRADEMARK OFFICE DECISIONS BY COURT

§ 1.301 [Reserved]

[Removed and reserved, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

§ 1.302 [Reserved]

[Removed and reserved, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

§ 1.303 [Reserved]

[Removed and reserved, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

§ 1.304 [Reserved]

[Removed and reserved, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

ALLOWANCE AND ISSUE OF PATENT

§ 1.311 Notice of Allowance.

(a) If, on examination, it appears that the applicant is entitled to a patent under the law, a notice of allowance will be sent to the applicant at the correspondence address indicated in § 1.33. The notice of allowance shall specify a sum constituting the issue fee and any required publication fee (§ 1.211(e)), which issue fee and any required publication fee must both be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. This three-month period is not extendable.

(b) An authorization to charge the issue fee or other post-allowance fees set forth in § 1.18 to a deposit account may be filed in an individual application only after mailing of the notice of allowance. The submission of either of the following after the mailing of a notice of allowance will operate as a request to charge the correct issue fee or any publication fee due to any deposit account identified in a previously filed authorization to charge such fees:

(1) An incorrect issue fee or publication fee; or

(2) A fee transmittal form (or letter) for payment of issue fee or publication fee.

[47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; para. (b) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para. (a) revised, 66 FR 67087, Dec. 28, 2001, effective Dec. 28, 2001; para. (b) revised, 69 FR 56481, Sept. 21, 2004, effective Sept. 21, 2004; para. (a) revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013]

§ 1.312 Amendments after allowance.

No amendment may be made as a matter of right in an application after the mailing of the notice of allowance. Any amendment filed pursuant to this section must be filed before or with the payment of the issue fee, and may be entered on the recommendation of the primary examiner, approved by the Director, without withdrawing the application from issue.

[Para. (b) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; para. (b) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; para. (b) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

§ 1.313 Withdrawal from issue.

(a) Applications may be withdrawn from issue for further action at the initiative of the Office or upon petition by the applicant. To request that the Office withdraw an application from issue, applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why withdrawal of the application from issue is necessary. A petition under this section is not required if a request for continued examination under § 1.114 is filed prior to payment of the issue fee. If the Office withdraws the application from issue, the Office will issue a new notice of allowance if the Office again allows the application.

(b) Once the issue fee has been paid, the Office will not withdraw the application from issue at its own initiative for any reason except:

(1) A mistake on the part of the Office;

(2) A violation of § 1.56 or illegality in the application;

(3) Unpatentability of one or more claims; or

(4) For an interference or derivation proceeding.

(c) Once the issue fee has been paid, the application will not be withdrawn from issue upon petition by the applicant for any reason except:

(1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;

(2) Consideration of a request for continued examination in compliance with § 1.114; or

(3) Express abandonment of the application. Such express abandonment may be in favor of a continuing application.

(d) A petition under this section will not be effective to withdraw the application from issue unless it is actually received and granted by the appropriate officials before the date of issue. Withdrawal of an application from issue after payment of the issue fee may not be effective to avoid publication of application information.

[47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; para. (a), 54 FR 6893, Feb. 15, 1989, 54 FR 9432, Mar. 7, 1989, effective Apr. 17, 1989; para. (b), 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; para. (a) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (paras. (b), (c)(1), (c)(3) and (d) adopted as final, 65 FR 50092, Aug. 16, 2000); paras. (a) and (c)(2) revised, 65 FR 50092, Aug. 16, 2000, effective Aug. 16, 2000; para. (b)(4) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

§ 1.314 Issuance of patent.

If applicant timely pays the issue fee, the Office will issue the patent in regular course unless the application is withdrawn from issue (§ 1.313) or the Office defers issuance of the patent. To request that the Office defer issuance of a patent, applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why it is necessary to defer issuance of the patent.

[47 FR 41272, Sept. 17, 1982, effective date Oct. 1, 1982; revised, 54 FR 6893, Feb. 15, 1989, effective Apr. 17, 1989; revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.315 Delivery of patent.

The patent will be delivered or mailed upon issuance to the correspondence address of record. See § 1.33(a).

[Revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996]

§ 1.316 Application abandoned for failure to pay issue fee.

If the issue fee is not paid within three months from the date of the notice of allowance, the application will be regarded as abandoned. Such an abandoned application will not be considered as pending before the Patent and Trademark Office.

[47 FR 41272, Sept. 17, 1982, effective date Oct. 1, 1982; paras. (b)-(d) amended, paras. (e) and (f) added, 58 FR 44277, Aug. 20, 1993, effective Sept. 20, 1993; para. (d) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.317 [Reserved]

[47 FR 41272, Sept. 17, 1982, effective date Oct. 1, 1982; paras. (a)-(d) amended, paras. (e) & (f) added, 58 FR 44277, Aug. 20, 1993, effective Sept. 20, 1993; para. (d) amended, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; removed and reserved, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013]

§ 1.318 [Reserved]

[43 FR 20465, May 11, 1978; removed and reserved, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

DISCLAIMER

§ 1.321 Statutory disclaimers, including terminal disclaimers.

[Editor Note: Para. (b) below is applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

(a) A patentee owning the whole or any sectional interest in a patent may disclaim any

complete claim or claims in a patent. In like manner any patentee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted. Such disclaimer is binding upon the grantee and its successors or assigns. A notice of the disclaimer is published in the *Official Gazette* and attached to the printed copies of the specification. The disclaimer, to be recorded in the Patent and Trademark Office, must:

(1) Be signed by the patentee, or an attorney or agent of record;

(2) Identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term will be refused recordation;

(3) State the present extent of patentee's ownership interest in the patent; and

(4) Be accompanied by the fee set forth in § 1.20(d).

(b) An applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of a patent to be granted. Such terminal disclaimer is binding upon the grantee and its successors or assigns. The terminal disclaimer, to be recorded in the Patent and Trademark Office, must:

(1) Be signed by the applicant or an attorney or agent of record;

(2) Specify the portion of the term of the patent being disclaimed;

(3) State the present extent of applicant's ownership interest in the patent to be granted; and

(4) Be accompanied by the fee set forth in § 1.20(d).

(c) A terminal disclaimer, when filed to obviate judicially created double patenting in a patent application or in a reexamination proceeding except as provided for in paragraph (d) of this section, must:

(1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;

(2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding; and

(3) Include a provision that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the judicially created double patenting.

(d) A terminal disclaimer, when filed in a patent application or in a reexamination proceeding to obviate double patenting based upon a patent or application that is not commonly owned but was disqualified as prior art as set forth in either § 1.104(c)(4)(ii) or (c)(5)(ii) as the result of activities undertaken within the scope of a joint research agreement, must:

(1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;

(2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or be signed in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding; and

(3) Include a provision waiving the right to separately enforce any patent granted on that application or any patent subject to the reexamination proceeding and the patent or any patent granted on the application which formed the basis for the double patenting, and that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent and the patent, or any patent granted on the application, which formed the basis for the double patenting are not separately enforced.

[47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; para. (c) revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; para (d) added, 70 FR 1818, Jan. 11, 2005, effective Dec. 10, 2004; paras. (c) and (d) revised, 70 FR 54259, Sept. 14, 2005, effective Sept. 14, 2005; para. (b) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012; para.(d) introductory text revised, 78 FR 11024, Feb. 14, 2013, effective Mar. 16, 2013]

[*The revisions to para. (b) effective Sept. 16, 2012 were applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012. See § 1.321 (pre-AIA) for the rule otherwise in effect.]

§ 1.321 (pre-AIA) Statutory disclaimers, including terminal disclaimers.

[Editor Note: Para. (b) below is **not applicable** to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012*]

(a) A patentee owning the whole or any sectional interest in a patent may disclaim any complete claim or claims in a patent. In like manner any patentee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted. Such disclaimer is binding upon the grantee and its successors or assigns. A notice of the disclaimer is published in the *Official Gazette* and attached to the printed copies of the specification. The disclaimer, to be recorded in the Patent and Trademark Office, must:

(1) Be signed by the patentee, or an attorney or agent of record;

(2) Identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term will be refused recordation;

(3) State the present extent of patentee's ownership interest in the patent; and

(4) Be accompanied by the fee set forth in § 1.20(d).

(b) An applicant or assignee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of a patent to be granted. Such terminal disclaimer is binding upon the grantee and its successors or assigns. The terminal disclaimer, to be recorded in the Patent and Trademark Office, must:

(1) Be signed:

(i) By the applicant, or

(ii) If there is an assignee of record of an undivided part interest, by the applicant and such assignee, or

(iii) If there is an assignee of record of the entire interest, by such assignee, or

(iv) By an attorney or agent of record;

(2) Specify the portion of the term of the patent being disclaimed;

(3) State the present extent of applicant's or assignee's ownership interest in the patent to be granted; and

(4) Be accompanied by the fee set forth in § 1.20(d).

(c) A terminal disclaimer, when filed to obviate judicially created double patenting in a patent application or in a reexamination proceeding except as provided for in paragraph (d) of this section, must:

(1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;

(2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding; and

(3) Include a provision that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the judicially created double patenting.

(d) A terminal disclaimer, when filed in a patent application or in a reexamination proceeding to obviate double patenting based upon a patent or application that is not commonly owned but was disqualified as prior art as set forth in either § 1.104(c)(4)(ii) or (c)(5)(ii) as the result of activities undertaken within the scope of a joint research agreement, must:

(1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;

(2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or be signed in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding;

(3) Include a provision waiving the right to separately enforce any patent granted on that application or any patent subject to the reexamination proceeding and the patent or any patent granted on the application which formed the basis for the double patenting, and that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent and the patent, or any patent granted on the application,

which formed the basis for the double patenting are not separately enforced.

[47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; para. (c) revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; para (d) added, 70 FR 1818, Jan. 11, 2005, effective Dec. 10, 2004; paras. (c) and (d) revised, 70 FR 54259, Sept. 14, 2005, effective Sept. 14, 2005; para.(d) introductory text revised, 78 FR 11024, Feb. 14, 2013, effective Mar. 16, 2013]

[*See § 1.321 for more information and for para. (b) applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012]

CORRECTION OF ERRORS IN PATENT

§ 1.322 Certificate of correction of Office mistake.

(a)(1) The Director may issue a certificate of correction pursuant to 35 U.S.C. 254 to correct a mistake in a patent, incurred through the fault of the Office, which mistake is clearly disclosed in the records of the Office:

(i) At the request of the patentee or the patentee's assignee;

(ii) Acting *sua sponte* for mistakes that the Office discovers; or

(iii) Acting on information about a mistake supplied by a third party.

(2)(i) There is no obligation on the Office to act on or respond to a submission of information or request to issue a certificate of correction by a third party under paragraph (a)(1)(iii) of this section.

(ii) Papers submitted by a third party under this section will not be made of record in the file that they relate to nor be retained by the Office.

(3) If the request relates to a patent involved in an interference or trial before the Patent Trial and Appeal Board, the request must comply with the requirements of this section and be accompanied by a motion under § 41.121(a)(2), § 41.121(a)(3), or § 42.20 of this title.

(4) The Office will not issue a certificate of correction under this section without first notifying the patentee (including any assignee of record) at the correspondence address of record as specified in § 1.33(a) and affording the patentee or an assignee an opportunity to be heard.

(b) If the nature of the mistake on the part of the Office is such that a certificate of correction is deemed inappropriate in form, the Director may issue a corrected patent in lieu thereof as a more appropriate form for certificate of correction, without expense to the patentee.

[24 FR 10332, Dec. 22, 1959; 34 FR 5550, Mar. 22, 1969; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (a) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a)(1) & (b) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (a)(3) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (a)(3) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

§ 1.323 Certificate of correction of applicant's mistake.

The Office may issue a certificate of correction under the conditions specified in 35 U.S.C. 255 at the request of the patentee or the patentee's assignee, upon payment of the fee set forth in § 1.20(a). If the request relates to a patent involved in an interference or trial before the Patent Trial and Appeal Board, the request must comply with the requirements of this section and be accompanied by a motion under § 41.121(a)(2), § 41.121(a)(3) or § 42.20 of this title.

[34 FR 5550, Mar. 22, 1969; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

§ 1.324 Correction of inventorship in patent, pursuant to 35 U.S.C. 256.

(a) Whenever through error a person is named in an issued patent as the inventor, or an inventor is not named in an issued patent, the Director, pursuant to 35 U.S.C. 256, may, on application of all the parties and assignees, or on order of a court before which such matter is called in question, issue a certificate naming only the actual inventor or inventors.

(b) Any request to correct inventorship of a patent pursuant to paragraph (a) of this section must be accompanied by:

(1) A statement from each person who is being added as an inventor and each person who is currently named as an inventor either agreeing to the change of inventorship or stating that he or she has no disagreement in regard to the requested change;

(2) A statement from all assignees of the parties submitting a statement under paragraph (b)(1) of this section agreeing to the change of inventorship in the patent, which statement must comply with the requirements of § 3.73(c) of this chapter; and

(3) The fee set forth in § 1.20(b).

(c) For correction of inventorship in an application, *see* § 1.48.

(d) In an interference under part 41, subpart D, of this title, a request for correction of inventorship in a patent must be in the form of a motion under § 41.121(a)(2) of this title. In a contested case under part 42, subpart D, of this title, a request for correction of inventorship in a patent must be in the form of a motion under § 42.22 of this title. The motion under § 41.121(a)(2) or § 42.22 of this title must comply with the requirements of this section.

[47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; 48 FR 2696, Jan. 20, 1983, effective Feb. 27, 1983; 49 FR 48416, Dec. 12, 1984, 50 FR 23123, May 31, 1985, effective Feb. 11, 1985; revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; heading and para. (b)(1) revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000; para. (c) added, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; paras. (a) and (c) revised and para. (d) added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (a) and para. (b) introductory text revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004; para. (a) revised, 70 FR 3880, Jan. 27, 2005, effective Dec. 8, 2004; revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012]

§ 1.325 Other mistakes not corrected.

Mistakes other than those provided for in §§ 1.322, 1.323, 1.324, and not affording legal grounds for reissue or for reexamination, will not be corrected after the date of the patent.

[48 FR 2696, Jan. 20, 1983, effective date Feb. 27, 1983]

ARBITRATION AWARDS

§ 1.331 [Reserved]

[24 FR 10332, Dec. 22, 1959; 43 FR 20465, May 11, 1978; 47 FR 41272, Sept. 17, 1982; deleted, 57 FR 29642, July 6, 1992, effective Sept. 4, 1992]

§ 1.332 [Reserved]

[47 FR 41272, Sept. 17, 1982; deleted, 57 FR 29642, July 6, 1992, effective Sept. 4, 1992]

§ 1.333 [Reserved]

[Deleted, 57 FR 29642, July 6, 1992, effective Sept. 4, 1992]

§ 1.334 [Reserved]

[47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; para. (c), 54 FR 6893, Feb. 15, 1989, effective Apr. 17, 1989; deleted, 57 FR 29642, July 6, 1992, effective Sept. 4, 1992]

§ 1.335 Filing of notice of arbitration awards.

(a) Written notice of any award by an arbitrator pursuant to 35 U.S.C. 294 must be filed in the Patent and Trademark Office by the patentee or the patentee's assignee or licensee. If the award involves more than one patent a separate notice must be filed for placement in the file of each patent. The notice must set forth the patent number, the names of the inventor and patent owner, and the names and addresses of the parties to the arbitration. The notice must also include a copy of the award.

(b) If an award by an arbitrator pursuant to 35 U.S.C. 294 is modified by a court, the party requesting the modification must file in the Patent and Trademark Office, a notice of the modification for placement in the file of each patent to which the modification applies. The notice must set forth the patent number, the names of the inventor and patent owner, and the names and addresses of the parties to the arbitration. The notice must also include a copy of the court's order modifying the award.

(c) Any award by an arbitrator pursuant to 35 U.S.C. 294 shall be unenforceable until any notices required by paragraph (a) or (b) of this section are

filed in the Patent and Trademark Office. If any required notice is not filed by the party designated in paragraph (a) or (b) of this section, any party to the arbitration proceeding may file such a notice.

[48 FR 2696, Jan. 20, 1983, effective Feb. 8, 1983]

§ 1.351 [Reserved]

[Removed and reserved, 84 FR 51977, Oct. 1, 2019, effective Oct. 31, 2019]

§ 1.352 [Reserved]

[Para. (a) amended, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; removed and reserved, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

MAINTENANCE FEES

§ 1.362 Time for payment of maintenance fees.

(a) Maintenance fees as set forth in §§ 1.20(e) through (g) are required to be paid in all patents based on applications filed on or after December 12, 1980, except as noted in paragraph (b) of this section, to maintain a patent in force beyond 4, 8 and 12 years after the date of grant.

(b) Maintenance fees are not required for any plant patents or for any design patents.

(c) The application filing dates for purposes of payment of maintenance fees are as follows:

(1) For an application not claiming benefit of an earlier application, the actual United States filing date of the application.

(2) For an application claiming benefit of an earlier foreign application under 35 U.S.C. 119, the United States filing date of the application.

(3) For a continuing (continuation, division, continuation-in-part) application claiming the benefit of a prior patent application under 35 U.S.C. 120, the actual United States filing date of the continuing application.

(4) For a reissue application, including a continuing reissue application claiming the benefit of a reissue application under 35 U.S.C. 120, [the] United States filing date of the original non-reissue application on which the patent reissued is based.

(5) For an international application which has entered the United States as a Designated Office under 35 U.S.C. 371, the international filing date granted under Article 11(1) of the Patent Cooperation Treaty which is considered to be the United States filing date under 35 U.S.C. 363.

(d) Maintenance fees may be paid in patents without surcharge during the periods extending respectively from:

(1) 3 years through 3 years and 6 months after grant for the first maintenance fee,

(2) 7 years through 7 years and 6 months after grant for the second maintenance fee, and

(3) 11 years through 11 years and 6 months after grant for the third maintenance fee.

(e) Maintenance fees may be paid with the surcharge set forth in § 1.20(h) during the respective grace periods after:

(1) 3 years and 6 months and through the day of the 4th anniversary of the grant for the first maintenance fee.

(2) 7 years and 6 months and through the day of the 8th anniversary of the grant for the second maintenance fee, and

(3) 11 years and 6 months and through the day of the 12th anniversary of the grant for the third maintenance fee.

(f) If the last day for paying a maintenance fee without surcharge set forth in paragraph (d) of this section, or the last day for paying a maintenance fee with surcharge set forth in paragraph (e) of this section, falls on a Saturday, Sunday, or a federal holiday within the District of Columbia, the maintenance fee and any necessary surcharge may be paid under paragraph (d) or paragraph (e) respectively on the next succeeding day which is not a Saturday, Sunday, or Federal holiday.

(g) Unless the maintenance fee and any applicable surcharge is paid within the time periods set forth in paragraphs (d), (e) or (f) of this section, the patent will expire as of the end of the grace period set forth in paragraph (e) of this section. A patent which expires for the failure to pay the maintenance fee will expire at the end of the same date (anniversary date) the patent was granted in the 4th, 8th, or 12th year after grant.

(h) The periods specified in §§ 1.362(d) and (e) with respect to a reissue application, including a continuing reissue application thereof, are counted from the date of grant of the original non-reissue application on which the reissued patent is based.

[49 FR 34724, Aug. 31, 1984, added effective Nov. 1, 1984; paras. (a) and (e), 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; paras. (c)(4) and (e) revised and para. (h) added, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; para. (b) revised, 82 FR 52780, Nov. 14, 2017, effective Jan. 16, 2018]

§ 1.363 Fee address for maintenance fee purposes.

(a) All notices, receipts, refunds, and other communications relating to payment or refund of maintenance fees will be directed to the correspondence address used during prosecution of the application as indicated in § 1.33(a) unless:

(1) A fee address for purposes of payment of maintenance fees is set forth when submitting the issue fee, or

(2) A change in the correspondence address for all purposes is filed after payment of the issue fee, or

(3) A fee address or a change in the "fee address" is filed for purposes of receiving notices, receipts and other correspondence relating to the payment of maintenance fees after the payment of the issue fee, in which instance, the latest such address will be used.

(b) An assignment of a patent application or patent does not result in a change of the "correspondence address" or "fee address" for maintenance fee purposes.

(c) A fee address must be an address associated with a Customer Number.

[49 FR 34725, Aug. 31, 1984, added effective Nov. 1, 1984; para. (c) added, 69 FR 29865, May 26, 2004, effective June 25, 2004]

§ 1.366 Submission of maintenance fees.

(a) The patentee may pay maintenance fees and any necessary surcharges, or any person or organization may pay maintenance fees and any necessary surcharges on behalf of a patentee. A maintenance fee transmittal letter may be signed by a juristic applicant or patent owner. A patentee need not file authorization to enable any person or organization to pay maintenance fees and any necessary surcharges on behalf of the patentee.

(b) A maintenance fee and any necessary surcharge submitted for a patent must be submitted in the amount due on the date the maintenance fee and any necessary surcharge are paid. A maintenance fee or surcharge may be paid in the manner set forth in § 1.23 or by an authorization to charge a deposit account established pursuant to § 1.25. Payment of a maintenance fee and any necessary surcharge or the authorization to charge a deposit account must be submitted within the periods set forth in § 1.362(d), (e), or (f). Any payment or authorization of maintenance fees and surcharges filed at any other time will not be accepted and will not serve as a payment of the maintenance fee except insofar as a delayed payment of the maintenance fee is accepted by the Director in an expired patent pursuant to a petition filed under § 1.378. Any authorization to charge a deposit account must authorize the immediate charging of the maintenance fee and any necessary surcharge to the deposit account. Payment of less than the required amount, payment in a manner other than that set forth in § 1.23, or in the filing of an authorization to charge a deposit account having insufficient funds will not constitute payment of a maintenance fee or surcharge on a patent. The procedures set forth in § 1.8 or § 1.10 may be utilized in paying maintenance fees and any necessary surcharges.

(c) In submitting maintenance fees and any necessary surcharges, identification of the patents for which maintenance fees are being paid must include the patent number, and the application number of the United States application for the patent on which the maintenance fee is being paid. If the payment includes identification of only the patent number (*i.e.*, does not identify the application number of the United States application for the patent on which the maintenance fee is being paid), the Office may apply the payment to the patent identified by patent number in the payment or may return the payment.

(d) Payment of maintenance fees and any surcharges should identify the fee being paid for each patent as to whether it is the 3 1/2-, 7 1/2-, or 11 1/2-year fee, whether small entity status is being

changed or claimed, the amount of the maintenance fee and any surcharge being paid, and any assigned customer number. If the maintenance fee and any necessary surcharge is being paid on a reissue patent, the payment must identify the reissue patent by reissue patent number and reissue application number as required by paragraph (c) of this section and should also include the original patent number.

(e) Maintenance fee payments and surcharge payments relating thereto must be submitted separate from any other payments for fees or charges, whether submitted in the manner set forth in § 1.23 or by an authorization to charge a deposit account. If maintenance fee and surcharge payments for more than one patent are submitted together, they should be submitted on as few sheets as possible with the patent numbers listed in increasing patent number order. If the payment submitted is insufficient to cover the maintenance fees and surcharges for all the listed patents, the payment will be applied in the order the patents are listed, beginning at the top of the listing.

(f) Notification of any change in status resulting in loss of entitlement to small entity status must be filed in a patent prior to paying, or at the time of paying, the earliest maintenance fee due after the date on which status as a small entity is no longer appropriate. See § 1.27(g).

(g) Maintenance fees and surcharges relating thereto will not be refunded except in accordance with §§ 1.26 and 1.28(a).

[49 FR 34725, Aug. 31, 1984, added effective Nov. 1, 1984; para. (b) amended, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; paras. (b) - (d) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (c) revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000; para. (f) revised, 65 FR 78958, Dec. 18, 2000; para. (b) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; paras. (a) and (b) revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013]

§ 1.377 Review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of patent.

(a) Any patentee who is dissatisfied with the refusal of the Patent and Trademark Office to accept and record a maintenance fee which was filed prior to the expiration of the patent may petition the Director to accept and record the maintenance fee.

(b) Any petition under this section must be filed within two months of the action complained of, or within such other time as may be set in the action complained of, and must be accompanied by the fee set forth in § 1.17(g). The petition may include a request that the petition fee be refunded if the refusal to accept and record the maintenance fee is determined to result from an error by the Patent and Trademark Office.

(c) Any petition filed under this section must comply with the requirements of § 1.181(b) and must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest.

[49 FR 34725, Aug. 31, 1984, added effective Nov. 1, 1984; para. (c) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (b) revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004]

§ 1.378 Acceptance of delayed payment of maintenance fee in expired patent to reinstate patent.

(a) The Director may accept the payment of any maintenance fee due on a patent after expiration of the patent if, upon petition, the delay in payment of the maintenance fee is shown to the satisfaction of the Director to have been unintentional. If the Director accepts payment of the maintenance fee upon petition, the patent shall be considered as not having expired, but will be subject to the conditions set forth in 35 U.S.C. 41(c)(2).

(b) Any petition to accept an unintentionally delayed payment of a maintenance fee must include:

(1) The required maintenance fee set forth in § 1.20(e) through (g);

(2) The petition fee as set forth in § 1.17(m); and

(3) A statement that the delay in payment of the maintenance fee was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(c) Any petition under this section must be signed in compliance with § 1.33(b).

(d) Reconsideration of a decision refusing to accept a delayed maintenance fee may be obtained

by filing a petition for reconsideration within two months of the decision, or such other time as set in the decision refusing to accept the delayed payment of the maintenance fee.

(e) If the delayed payment of the maintenance fee is not accepted, the maintenance fee will be refunded following the decision on the petition for reconsideration, or after the expiration of the time for filing such a petition for reconsideration, if none is filed.

[49 FR 34726, Aug. 31, 1984, added effective Nov. 1, 1984; para. (a), 50 FR 9383, Mar.7, 1985, effective May 8, 1985; paras. (b) and (c), 53 FR 47810, Nov. 28, 1988, effective Jan. 1, 1989; paras. (a) - (c) and (e), 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; paras. (a) - (c) and (e), 58 FR 44277, Aug. 20, 1993, effective Sept. 20, 1993; para. (d) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a) & (e) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (e) revised, 69 FR 56536, Sept. 21, 2004, effective Nov. 22, 2004; revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013]

Subpart C — International Processing Provisions

GENERAL INFORMATION

§ 1.401 Definitions of terms under the Patent Cooperation Treaty.

(a) The abbreviation *PCT* and the term *Treaty* mean the Patent Cooperation Treaty.

(b) *International Bureau* means the World Intellectual Property Organization located in Geneva, Switzerland.

(c) *Administrative Instructions* means that body of instructions for operating under the Patent Cooperation Treaty referred to in PCT Rule 89.

(d) *Request*, when capitalized, means that element of the international application described in PCT Rules 3 and 4.

(e) *International application*, as used in this subchapter is defined in § 1.9(b).

(f) *Priority date* for the purpose of computing time limits under the Patent Cooperation Treaty is defined in PCT Art. 2(xi). Note also § 1.465.

(g) *Demand*, when capitalized, means that document filed with the International Preliminary Examining Authority which requests an international preliminary examination.

(h) *Annexes* means amendments made to the claims, description or the drawings before the International Preliminary Examining Authority.

(i) Other terms and expressions in this subpart C not defined in this section are to be taken in the sense indicated in PCT Art. 2 and 35 U.S.C. 351.

[43 FR 20458, May 11, 1978; 52 FR 20047, May 28, 1987]

§ 1.412 The United States Receiving Office.

(a) The United States Patent and Trademark Office is a Receiving Office only for applicants who are residents or nationals of the United States of America.

(b) The Patent and Trademark Office, when acting as a Receiving Office, will be identified by the full title “United States Receiving Office” or by the abbreviation “RO/US.”

(c) The major functions of the Receiving Office include:

(1) According of international filing dates to international applications meeting the requirements of PCT Art. 11(1) and PCT Rule 20;

(2) Assuring that international applications meet the standards for format and content of PCT Art. 14(1), PCT Rule 9, 26, 29.1, 37, 38, 91, and portions of PCT Rules 3 through 11;

(3) Collecting and, when required, transmitting fees due for processing international applications (PCT Rule 14, 15, 16);

(4) Transmitting the record and search copies to the International Bureau and International Searching Authority, respectively (PCT Rules 22 and 23); and

(5) Determining compliance with applicable requirements of part 5 of this chapter.

(6) Reviewing and, unless prescriptions concerning national security prevent the application from being so transmitted (PCT Rule 19.4), transmitting the international application to the International Bureau for processing in its capacity as a Receiving Office:

(i) Where the United States Receiving Office is not the competent Receiving Office under PCT Rule 19.1 or 19.2 and § 1.421(a); or

(ii) Where the international application is not in English but is in a language accepted under PCT Rule 12.1(a) by the International Bureau as a Receiving Office; or

(iii) Where there is agreement and authorization in accordance with PCT Rule 19.4(a)(iii).

[Para. (c)(6) added, 60 FR 21438, May 2, 1995, effective June 1, 1995; para. (c)(6) revised, 63 FR 29614, June 1, 1998, effective July 1, 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998)]

§ 1.413 The United States International Searching Authority.

(a) Pursuant to appointment by the Assembly, the United States Patent and Trademark Office will act as an International Searching Authority for international applications filed in the United States Receiving Office and in other Receiving Offices as may be agreed upon by the Director, in accordance with the agreement between the Patent and Trademark Office and the International Bureau (PCT Art. 16(3)(b)).

(b) The Patent and Trademark Office, when acting as an International Searching Authority, will be identified by the full title "United States International Searching Authority" or by the abbreviation "ISA/US."

(c) The major functions of the International Searching Authority include:

(1) Approving or establishing the title and abstract;

(2) Considering the matter of unity of invention;

(3) Conducting international and international-type searches and preparing international and international-type search reports (PCT Art. 15, 17 and 18, and PCT Rules 25, 33 to 45 and 47), and issuing declarations that no international search report will be established (PCT Article 17(2)(a));

(4) Preparing written opinions of the International Searching Authority in accordance with PCT Rule 43 *bis* (when necessary); and

(5) Transmitting the international search report and the written opinion of the International Searching Authority to the applicant and the International Bureau.

[Para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; paras. (a) & (c) revised, 68 FR 58991, Oct. 20, 2003, effective Jan. 1, 2004]

§ 1.414 The United States Patent and Trademark Office as a Designated Office or Elected Office.

(a) The United States Patent and Trademark Office will act as a Designated Office or Elected Office for international applications in which the United States of America has been designated or elected as a State in which patent protection is desired.

(b) The United States Patent and Trademark Office, when acting as a Designated Office or Elected Office during international processing will be identified by the full title "United States Designated Office" or by the abbreviation "DO/US" or by the full title "United States Elected Office" or by the abbreviation "EO/US."

(c) The major functions of the United States Designated Office or Elected Office in respect to international applications in which the United States of America has been designated or elected, include:

(1) Receiving various notifications throughout the international stage and

(2) National stage processing for international applications entering the national stage under 35 U.S.C. 371.

[52 FR 20047, May 28, 1987, effective July 1, 1987; para. (c)(2) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012]

§ 1.415 The International Bureau.

(a) The International Bureau is the World Intellectual Property Organization located at Geneva, Switzerland. It is the international intergovernmental organization which acts as the coordinating body under the Treaty and the Regulations (PCT Art. 2(xix) and 35 U.S.C. 351(h)).

(b) The major functions of the International Bureau include:

(1) Publishing of international applications and the International Gazette;

(2) Transmitting copies of international applications to Designated Offices;

(3) Storing and maintaining record copies; and

(4) Transmitting information to authorities pertinent to the processing of specific international applications.

§ 1.416 The United States International Preliminary Examining Authority.

(a) Pursuant to appointment by the Assembly, the United States Patent and Trademark Office will act as an International Preliminary Examining Authority for international applications filed in the United States Receiving Office and in other Receiving Offices as may be agreed upon by the Director, in accordance with agreement between the Patent and Trademark Office and the International Bureau.

(b) The United States Patent and Trademark Office, when acting as an International Preliminary Examining Authority, will be identified by the full title "United States International Preliminary Examining Authority" or by the abbreviation "IPEA/US."

(c) The major functions of the International Preliminary Examining Authority include:

(1) Receiving and checking for defects in the Demand;

(2) Forwarding Demands in accordance with PCT Rule 59.3;

(3) Collecting the handling fee for the International Bureau and the preliminary examination fee for the United States International Preliminary Examining Authority;

(4) Informing applicant of receipt of the Demand;

(5) Considering the matter of unity of invention;

(6) Providing an international preliminary examination report which is a non-binding opinion on the questions of whether the claimed invention appears: to be novel, to involve an inventive step (to be nonobvious), and to be industrially applicable; and

(7) Transmitting the international preliminary examination report to applicant and the International Bureau.

[Added 52 FR 20047, May 28, 1987; para. (c) revised, 63 FR 29614, June 1, 1998, effective July 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998); para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

§ 1.417 Submission of translation of international publication.

The submission of an English language translation of the publication of an international application pursuant to 35 U.S.C. 154(d)(4) must clearly identify the international application to which it pertains (§ 1.5(a)) and be clearly identified as a submission pursuant to 35 U.S.C. 154(d)(4). Otherwise, the submission will be treated as a filing under 35 U.S.C. 111(a). Such submissions should be marked "Mail Stop PCT."

[Added 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; revised 67 FR 520, Jan. 4, 2002, effective Apr. 1, 2002; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; revised, 68 FR 70996, Dec. 22, 2003, effective Jan. 21, 2004]

§ 1.419 Display of currently valid control number under the Paperwork Reduction Act.

(a) Pursuant to the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*), the collection of information in this subpart has been reviewed and approved by the Office of Management and Budget under control number 0651-0021.

(b) Notwithstanding any other provision of law, no person is required to respond to nor shall a person be subject to a penalty for failure to comply with a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid Office of Management and Budget control number. This section constitutes the display required by 44 U.S.C. 3512(a) and 5 CFR 1320.5(b)(2)(i) for the collection of information under Office of Management and Budget control number 0651-0021 (see 5 CFR 1320.5(b)(2)(ii)(D)).

[Added, 63 FR 29614, June 1, 1998, effective July 1, 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998)]

WHO MAY FILE AN INTERNATIONAL APPLICATION

§ 1.421 Applicant for international application.

[Editor Note: Applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

(a) Only residents or nationals of the United States of America may file international applications in the United States Receiving Office. If an international application does not include an applicant who is indicated as being a resident or national of the United States of America, and at least one applicant:

(1) Has indicated a residence or nationality in a PCT Contracting State, or

(2) Has no residence or nationality indicated, applicant will be so notified and, if the international application includes a fee amount equivalent to that required by § 1.445(a)(4), the international application will be forwarded for processing to the International Bureau acting as a Receiving Office (*see* also § 1.412(c)(6)).

(b) Although the United States Receiving Office will accept international applications filed by any applicant who is a resident or national of the United States of America for international processing, for the purposes of the designation of the United States, an international application will be accepted by the Patent and Trademark Office for the national stage only if the applicant is the inventor or other person as provided in § 1.422 or § 1.424. Joint inventors must jointly apply for an international application.

(c) A registered attorney or agent of the applicant may sign the international application Request and file the international application for the applicant. A separate power of attorney from each applicant may be required.

(d) Any indication of different applicants for the purpose of different Designated Offices must be shown on the Request portion of the international application.

(e) Requests for changes in the indications concerning the applicant, agent, or common representative of an international application shall be made in accordance with PCT Rule 92 *bis* and may be required to be signed by all applicants.

(f) Requests for withdrawals of the international application, designations, priority claims, the Demand, or elections shall be made in accordance with PCT Rule 90 *bis* and must be signed by all applicants. A separate power of attorney from the applicants will be required for the purposes of any request for a withdrawal in accordance with PCT Rule 90 *bis* which is not signed by all applicants.

[Paras. (f) and (g), 53 FR 47810, Nov. 28, 1988, effective Jan. 1, 1989; para. (a) amended, 60 FR 21438, May 2, 1995, effective June 1, 1995; paras. (b)-(g) revised, 68 FR 58991, Oct. 20, 2003, effective Jan. 1, 2004; para. (a)(2) revised, 68 FR 67805, Dec. 4, 2003, effective Jan. 1, 2004; revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012]

[*The changes effective Sept. 16, 2012 are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012. See § 1.421 (pre-AIA) for the rule otherwise in effect.]

§ 1.421 (pre-AIA) Applicant for international application.

[Editor Note: **Not applicable** to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012*]

(a) Only residents or nationals of the United States of America may file international applications in the United States Receiving Office. If an international application does not include an applicant who is indicated as being a resident or national of the United States of America, and at least one applicant:

(1) Has indicated a residence or nationality in a PCT Contracting State, or

(2) Has no residence or nationality indicated, applicant will be so notified and, if the international application includes a fee amount equivalent to that required by § 1.445(a)(4), the international application will be forwarded for processing to the International Bureau acting as a Receiving Office (see also § 1.412(c)(6)).

(b) Although the United States Receiving Office will accept international applications filed by any resident or national of the United States of America

for international processing, for the purposes of the designation of the United States, an international application must be filed, and will be accepted by the Patent and Trademark Office for the national stage only if filed, by the inventor or as provided in §§ 1.422 or 1.423. Joint inventors must jointly apply for an international application.

(c) For the purposes of designations other than the United States, international applications may be filed by the assignee or owner.

(d) A registered attorney or agent of the applicant may sign the international application Request and file the international application for the applicant. A separate power of attorney from each applicant may be required.

(e) Any indication of different applicants for the purpose of different Designated Offices must be shown on the Request portion of the international application.

(f) Requests for changes in the indications concerning the applicant, agent, or common representative of an international application shall be made in accordance with PCT Rule 92 *bis* and may be required to be signed by all applicants.

(g) Requests for withdrawals of the international application, designations, priority claims, the Demand, or elections shall be made in accordance with PCT Rule 90 *bis* and must be signed by all applicants. A separate power of attorney from the applicants will be required for the purposes of any request for a withdrawal in accordance with PCT Rule 90 *bis* which is not signed by all applicants. The submission of a separate power of attorney may be excused upon the request of another applicant where one or more inventors cannot be found or reached after diligent effort. Such a request must be accompanied by a statement explaining to the satisfaction of the Director the lack of the signature concerned.

[Paras. (f) and (g), 53 FR 47810, Nov. 28, 1988, effective Jan. 1, 1989; para. (a) amended, 60 FR 21438, May 2, 1995, effective June 1, 1995; paras. (b)-(g) revised, 68 FR 58991, Oct. 20, 2003, effective Jan. 1, 2004; para. (a)(2) revised, 68 FR 67805, Dec. 4, 2003, effective Jan. 1, 2004]

[*See § 1.421 for more information and for the rule applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012]

§ 1.422 Legal representative as applicant in an international application.

[Editor Note: Applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

If an inventor is deceased or under legal incapacity, the legal representative of the inventor may be an applicant in an international application which designates the United States of America.

[Revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012]

[*The changes effective Sept. 16, 2012 are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012. See § 1.422 (pre-AIA) for the rule otherwise in effect.]

§ 1.422 (pre-AIA) When the inventor is dead.

[Editor Note: **Not applicable** to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may file an international application which designates the United States of America.

[*See § 1.422 for more information and for the rule applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012.]

§ 1.423 [Reserved]

[Effective Sept. 16, 2012, § 1.423 was removed and reserved with respect to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012. See 77 FR 48776, Aug. 14, 2012. Editor assumes "1.423" was intended instead of "1.432" in the first column of page 48776. For the rule otherwise in effect, see § 1.423 (pre-AIA).]

§ 1.423 (pre-AIA) When the inventor is insane or legally incapacitated.

[Editor Note: **Not applicable** to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

In case an inventor is insane or otherwise legally incapacitated, the legal representative (guardian, conservator, etc.) of such inventor may file an international application which designates the United States of America.

[*Removed and reserved with respect to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012]

§ 1.424 Assignee, obligated assignee, or person having sufficient proprietary interest as applicant in an international application.

[Editor Note: Applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

(a)) A person to whom the inventor has assigned or is under an obligation to assign the invention may be an applicant in an international application which designates the United States of America. A person who otherwise shows sufficient proprietary interest in the matter may be an applicant in an international application which designates the United States of America on proof of the pertinent facts and a showing that such action is appropriate to preserve the rights of the parties.

(b) Neither any showing required under paragraph (a) of this section nor documentary evidence of ownership or proprietary interest will be required or considered by the Office in the international stage, but will be required in the national stage in accordance with the conditions and requirements of § 1.46.

[Added, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012]

[*The changes effective Sept. 16, 2012 are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012.]

§ 1.425 [Reserved]

[Removed and reserved, 68 FR 58991, Oct. 20, 2003, effective Jan. 1, 2004]

THE INTERNATIONAL APPLICATION

§ 1.431 International application requirements.

[Editor Note: Para. (b)(3)(iii) below is applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

(a) An international application shall contain, as specified in the Treaty and the Regulations, a Request, a description, one or more claims, an abstract, and one or more drawings (where required). (PCT Art. 3(2) and Section 207 of the Administrative Instructions.)

(b) An international filing date will be accorded by the United States Receiving Office, at the time of receipt of the international application, provided that:

(1) At least one applicant (§ 1.421) is a United States resident or national and the papers filed at the time of receipt of the international application so indicate (35 U.S.C. 361(a), PCT Art. 11(1)(i)).

(2) The international application is in the English language (35 U.S.C. 361(c), PCT Art. 11(1)(ii)).

(3) The international application contains at least the following elements (PCT Art. 11(1)(iii)):

(i) An indication that it is intended as an international application (PCT Rule 4.2);

(ii) The designation of at least one Contracting State of the International Patent Cooperation Union (§ 1.432);

(iii) The name of the applicant, as prescribed (note §§ 1.421, 1.422, and 1.424);

(iv) A part which on the face of it appears to be a description; and

(v) A part which on the face of it appears to be a claim.

(c) Payment of the international filing fee (PCT Rule 15.2) and the transmittal and search fees (§ 1.445) may be made in full at the time the international application papers required by paragraph (b) of this section are deposited or within one month thereafter. The international filing, transmittal, and search fee payable is the

international filing, transmittal, and search fee in effect on the receipt date of the international application. If the international filing, transmittal and search fees are not paid within one month from the date of receipt of the international application and prior to the sending of a notice of deficiency, which imposes a late payment fee (§ 1.445(a)(6)), the applicant will be notified and given a one month non-extendable time limit within which to pay the deficient fees plus the late payment fee.

(d) If the payment needed to cover the transmittal fee, the international filing fee, the search fee, and the late payment fee pursuant to paragraph (c) of this section is not timely made in accordance with PCT Rule 16 *bis*.1(e), the Receiving Office will declare the international application withdrawn under PCT Article 14(3)(a).

[43 FR 20458, May 11, 1978; paras. (b), (c), (d) and (e), 50 FR 9383, Mar. 7, 1985, effective May 8, 1985; para. (d) amended, 52 FR 20047, May 28, 1987; paras. (b)(1), (b)(3)(ii), (c) and (d) amended, para. (e) deleted, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; paras. (c) and (d) revised, 63 FR 29614, June 1, 1998, effective July 1, 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998); paras. (b)(3), (c) & (d) revised, 68 FR 58991, Oct. 20, 2003, effective Jan. 1, 2004; para. (c)(2) corrected, 68 FR 67805, Dec. 4, 2003; para. (b)(3)(iii) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012; para. (c) revised, 85 FR 46932, Aug. 3, 2020, effective Oct. 2, 2020]

[*****The revisions to para. (b)(3)(iii) effective Sept. 16, 2012 are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012. See § 1.431(pre-AIA) for para. (b)(3)(iii) otherwise in effect.]

§ 1.431 (pre-AIA) International application requirements.

[Editor Note: Para. (b)(3)(iii) below is **not applicable** to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012*****]

(a) An international application shall contain, as specified in the Treaty and the Regulations, a Request, a description, one or more claims, an abstract, and one or more drawings (where required). (PCT Art. 3(2) and Section 207 of the Administrative Instructions.)

(b) An international filing date will be accorded by the United States Receiving Office, at the time of receipt of the international application, provided that:

(1) At least one applicant is a United States resident or national and the papers filed at the time of receipt of the international application so indicate (35 U.S.C. 361(a), PCT Art. 11(1)(i)).

(2) The international application is in the English language (35 U.S.C. 361(c), PCT Art. 11(1)(ii)).

(3) The international application contains at least the following elements (PCT Art. 11(1)(iii)):

(i) An indication that it is intended as an international application (PCT Rule 4.2);

(ii) The designation of at least one Contracting State of the International Patent Cooperation Union (§ 1.432);

(iii) The name of the applicant, as prescribed (note §§ 1.421-1.423);

(iv) A part which on the face of it appears to be a description; and

(v) A part which on the face of it appears to be a claim.

(c) Payment of the international filing fee (PCT Rule 15.2) and the transmittal and search fees (§ 1.445) may be made in full at the time the international application papers required by paragraph (b) of this section are deposited or within one month thereafter. The international filing, transmittal, and search fee payable is the international filing, transmittal, and search fee in effect on the receipt date of the international application.

(1) If the international filing, transmittal and search fees are not paid within one month from the date of receipt of the international application and prior to the sending of a notice of deficiency which imposes a late payment fee, applicant will be notified and given one month within which to pay the deficient fees plus the late payment fee. Subject to paragraph (c)(2) of this section, the late payment fee will be equal to the greater of:

(i) Fifty percent of the amount of the deficient fees; or

(ii) An amount equal to the transmittal fee.

(2) The late payment fee shall not exceed an amount equal to fifty percent of the international filing fee not taking into account any fee for each sheet of the international application in excess of thirty sheets (PCT Rule 16 *bis*).

(3) The one-month time limit set pursuant to paragraph (c) of this section to pay deficient fees may not be extended.

(d) If the payment needed to cover the transmittal fee, the international filing fee, the search fee, and the late payment fee pursuant to paragraph (c) of this section is not timely made in accordance with PCT Rule 16 *bis*.1(e), the Receiving Office will declare the international application withdrawn under PCT Article 14(3)(a).

[43 FR 20458, May 11, 1978; paras. (b), (c), (d) and (e), 50 FR 9383, Mar. 7, 1985, effective May 8, 1985; para. (d) amended, 52 FR 20047, May 28, 1987; paras. (b)(1), (b)(3)(ii), (c) and (d) amended, para. (e) deleted, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; paras. (c) and (d) revised, 63 FR 29614, June 1, 1998, effective July 1, 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998); paras. (b)(3), (c) & (d) revised, 68 FR 58991, Oct. 20, 2003, effective Jan. 1, 2004; para. (c)(2) corrected, 68 FR 67805, Dec. 4, 2003]

[*See § 1.431 for more information and for para. (b)(3)(iii) applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012]

§ 1.432 Designation of States by filing an international application.

The filing of an international application request shall constitute:

(a) The designation of all Contracting States that are bound by the Treaty on the international filing date;

(b) An indication that the international application is, in respect of each designated State to which PCT Article 43 or 44 applies, for the grant of every kind of protection which is available by way of the designation of that State; and

(c) An indication that the international application is, in respect of each designated State to which PCT Article 45(1) applies, for the grant of a regional patent and also, unless PCT Article 45(2) applies, a national patent.

[43 FR 20458, May 11, 1978; para. (b) amended 52 FR 20047, May 28, 1987; paras. (a), (b) amended and para. (c) added, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; paras. (b) and (c) revised, para. (d) added, 63 FR 29614, June 1, 1998, effective July 1, 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998); revised, 68 FR 58991, Oct. 20, 2003, effective Jan. 1, 2004]

§ 1.433 Physical requirements of international application.

(a) The international application and each of the documents that may be referred to in the check list of the Request (PCT Rule 3.3(a)(ii)) shall be filed in one copy only.

(b) All sheets of the international application must be on A4 size paper (21.0 x 29.7 cm.).

(c) Other physical requirements for international applications are set forth in PCT Rule 11 and sections 201-207 of the Administrative Instructions.

§ 1.434 The request.

(a) The request shall be made on a standardized form (PCT Rules 3 and 4). Copies of printed Request forms are available from the United States Patent and Trademark Office. Letters requesting printed forms should be marked “Mail Stop PCT.”

(b) The Check List portion of the Request form should indicate each document accompanying the international application on filing.

(c) All information, for example, addresses, names of States and dates, shall be indicated in the Request as required by PCT Rule 4 and Administrative Instructions 110 and 201.

(d) For the purposes of the designation of the United States of America, an international application shall include:

(1) The name of the inventor; and

(2) A reference to any prior-filed national application or international application designating the United States of America, if the benefit of the filing date for the prior-filed application is to be claimed.

(e) An international application may also include in the Request a declaration of the inventors as provided for in PCT Rule 4.17(iv).

[Para. (a) amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; para. (d) revised, 66 FR 16004, Mar. 22, 2001, effective Mar. 1, 2001; para. (d)(2)

revised, 66 FR 67087, Dec. 28, 2001, effective Dec. 28, 2001; paras. (a) & (d)(2) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (d) revised, para (e) added, 68 FR 58991, Oct. 20, 2003, effective Jan. 1, 2004]

§ 1.435 The description.

(a) The application must meet the requirements as to the content and form of the description set forth in PCT Rules 5, 9, 10, and 11 and sections 204 and 208 of the Administrative Instructions.

(b) In international applications designating the United States the description must contain upon filing an indication of the best mode contemplated by the inventor for carrying out the claimed invention.

[Para. (a) revised, 63 FR 29614, June 1, 1998, effective July 1, 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998)]

§ 1.436 The claims.

The requirements as to the content and format of claims are set forth in PCT Art. 6 and PCT Rules 6, 9, 10 and 11 and shall be adhered to. The number of the claims shall be reasonable, considering the nature of the invention claimed.

§ 1.437 The drawings.

(a) Drawings are required when they are necessary for the understanding of the invention (PCT Art. 7).

(b) The physical requirements for drawings are set forth in PCT Rule 11 and shall be adhered to.

[Revised, 72 FR 51559, Sept. 10, 2007, effective Sept. 10, 2007]

§ 1.438 The abstract.

(a) Requirements as to the content and form of the abstract are set forth in PCT Rule 8, and shall be adhered to.

(b) Lack of an abstract upon filing of an international application will not affect the granting of a filing date. However, failure to furnish an abstract within one month from the date of the notification by the Receiving Office will result in the international application being declared withdrawn.

FEES

§ 1.445 International application filing, processing and search fees.

(a) The following fees and charges for international applications are established by law or by the director under the authority of 35 U.S.C. 376:

(1) A transmittal fee (*see* 35 U.S.C. 361(d) and PCT Rule 14) consisting of:

(i) A basic portion:

(A) For an international application having a receipt date that is on or after October 2, 2020:

TABLE 1 TO PARAGRAPH (a)(1)(i)(A)

By a micro entity (§ 1.29)..$65.00

By a small entity (§ 1.27(a))....130.00

By other than a small or micro entity....260.00

(B) For an international application having a receipt date that is on or after January 1, 2014, and before October 2, 2020:

TABLE 2 TO PARAGRAPH (a)(1)(i)(B)

By a micro entity (§ 1.29)..$60.00

By a small entity (§ 1.27(a))....$120.00

By other than a small or micro entity....$240.00

(C) For an international application having a receipt date that is before January 1, 2014....$240.00.

(ii) A non-electronic filing fee portion for any international application designating the United States of America that is filed on or after November 15, 2011, other than by the Office electronic filing system, except for a plant application:

TABLE 3 TO PARAGRAPH (a)(1)(ii)

By a small entity (§ 1.27(a))....$200.00

By other than a small entity....400.00

(2) A search fee (*see* 35 U.S.C. 361(d) and PCT Rule 16):

(i) For an international application having a receipt date that is on or after October 2, 2020:

TABLE 4 TO PARAGRAPH (a)(2)(i)

By a micro entity (§ 1.29)....$545.00

By a small entity (§ 1.27(a))....1,090.00

By other than a small entity....2,180.00

(ii) For an international application having a receipt date that is on or after January 1, 2014, and before October 2, 2020:

TABLE 5 TO PARAGRAPH (a)(2)(ii)

By a micro entity (§ 1.29)....$520.00

By a small entity (§ 1.27(a))....1,040.00

By other than a small or micro entity....2,080.00

(iii) For an international application having a receipt date that is before January 1, 2014....$2,080.00.

(3) A supplemental search fee when required, per additional invention:

(i) For an international application having a receipt date that is on or after October 2, 2020:

TABLE 6 TO PARAGRAPH (a)(3)(i)

By a micro entity (§ 1.29)....$545.00

By a small entity (§ 1.27(a))....1,090.00

By other than a small or micro entity....2,180.00

(ii) For an international application having a receipt date that is on or after January 1, 2014, and before October 2, 2020:

TABLE 7 TO PARAGRAPH (a)(3)(ii)

By a micro entity (§ 1.29)....$520.00

By a small entity (§ 1.27(a))....$1,040.00

By other than a small or micro entity....$2,080.00

(iii) For an international application having a receipt date that is before January 1, 2014:....$2,080.00.

(4) A fee equivalent to the transmittal fee in paragraph (a)(1) of this section that would apply if the USPTO was the Receiving Office for transmittal of an international application to the International Bureau for processing in its capacity as a Receiving Office (PCT Rule 19.4).

(5) Late furnishing fee for providing a sequence listing in response to an invitation under PCT Rule 13 *ter*:

TABLE 8 TO PARAGRAPH (a)(5)

By a micro entity (§ 1.29)....$80.00

By a small entity (§ 1.27(a))....160.00

By other than a small or micro entity....320.00

(6) Late payment fee pursuant to PCT Rule 16 *bis*.2.

(b) The international filing fee shall be as prescribed in PCT Rule 15.

[43 FR 20458, May 11, 1978; para. (a), 47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; para. (a)(4) - (6), 50 FR 9384, Mar. 7, 1985, effective May 8, 1985; 50 FR 31826, Aug. 6, 1985, effective Oct. 5, 1985; para. (a) amended 52 FR 20047, May 28, 1987; paras. (a)(2) and (3), 54 FR 6893, Feb. 15, 1989, 54 FR 9432, Mar. 7, 1989, effective Apr. 17, 1989; para. (a), 56 FR 65142, Dec. 13, 1991, effective Dec. 27, 1991; para. (a), 57 FR 38190, Aug. 21, 1992, effective Oct. 1, 1992; para. (a)(4) added, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; paras. (a)(1)-(3), 59 FR 43736, Aug. 25, 1994, effective Oct. 1, 1994; para. (a)(5) added, 60 FR 21438, May 2, 1995, effective June 1, 1995; para. (a) amended, 60 FR 41018, Aug. 11, 1995, effective Oct. 1, 1995; para. (a) amended, 61 FR 39585, July 30, 1996, effective Oct. 1, 1996; para. (a) amended, 62 FR 40450, July 29, 1997, effective Oct. 1, 1997; para. (a) revised, 63 FR 29614, June 1, 1998, effective July 1,1998 (adopted as final, 63 FR 66040, Dec. 1, 1998); para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; revised, 68 FR 58991, Oct. 20, 2003, effective Jan. 1, 2004; para. (a)(2) revised, 70 FR 3880, Jan. 27, 2005, effective Dec. 8, 2004; paras. (a)(2) and (a)(3) revised, 72 FR 51559, Sept.

10, 2007, effective Nov. 9, 2007; paras. (a)(1) through (a)(3) revised, 73 FR 67754, Nov. 12, 2008, effective Jan. 12, 2009; para. (a) introductory text and (a)(1) revised, 76 FR 70651, Nov. 15, 2011, effective Nov. 15, 2011; para. (a) introductory text and paras. (a)(1)(i), (a)(2)-(4) and (b) revised, 78 FR 4212, Jan. 18, 2013, effective Mar. 19, 2013; revised 78 FR 17102, Mar. 20, 2013, effective Mar. 20, 2013; para. (a)(5) added, 82 FR 52780, Nov. 14, 2017, effective Jan. 16, 2018; para. (a) revised, 85 FR 46932, Aug. 3, 2020, effective Oct. 2, 2020; para. (a)(6) corrected, 85 FR 58282, Sept. 18, 2020, effective Oct. 2, 2020]

§ 1.446 Refund of international application filing and processing fees.

(a) Money paid for international application fees, where paid by actual mistake or in excess, such as a payment not required by law or treaty and its regulations, may be refunded. A mere change of purpose after the payment of a fee will not entitle a party to a refund of such fee. The Office will not refund amounts of twenty-five dollars or less unless a refund is specifically requested and will not notify the payor of such amounts. If the payor or party requesting a refund does not provide the banking information necessary for making refunds by electronic funds transfer, the Office may use the banking information provided on the payment instrument to make any refund by electronic funds transfer.

(b) Any request for refund under paragraph (a) of this section must be filed within two years from the date the fee was paid. If the Office charges a deposit account by an amount other than an amount specifically indicated in an authorization under § 1.25(b), any request for refund based upon such charge must be filed within two years from the date of the deposit account statement indicating such charge and include a copy of that deposit account statement. The time periods set forth in this paragraph are not extendable.

(c) Refund of the supplemental search fees will be made if such refund is determined to be warranted by the Director or the Director's designee acting under PCT Rule 40.2(c).

(d) The international and search fees will be refunded if no international filing date is accorded or if the application is withdrawn before transmittal of the record copy to the International Bureau (PCT Rules 15.6 and 16.2). The search fee will be refunded if the application is withdrawn before transmittal of the search copy to the International Searching Authority. The transmittal fee will not be refunded.

(e) The handling fee (§ 1.482(b)) will be refunded (PCT Rule 57.6) only if:

(1) The Demand is withdrawn before the Demand has been sent by the International Preliminary Examining Authority to the International Bureau, or

(2) The Demand is considered not to have been submitted (PCT Rule 54.4(a)).

[43 FR 20458, May 11, 1978; para. (b), 47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; para.(b), 50 FR 9384, Mar. 7, 1985, effective May 8, 1985; 50 FR 31826, Aug. 6, 1985, effective Oct. 5, 1985; para. (d) amended and para. (e) added, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; para (a) revised and para. (b) added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (c) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

PRIORITY

§ 1.451 The priority claim and priority document in an international application.

(a) The claim for priority must, subject to paragraph (d) of this section, be made on the Request (PCT Rule 4.10) in a manner complying with sections 110 and 115 of the Administrative Instructions.

(b) Whenever the priority of an earlier United States national application or international application filed with the United States Receiving Office is claimed in an international application, the applicant may request in the Request or in a letter of transmittal accompanying the international application upon filing with the United States Receiving Office or in a separate letter filed in the United States Receiving Office not later than 16 months after the priority date, that the United States Patent and Trademark Office prepare a certified copy of the prior application for transmittal to the International Bureau (PCT Article 8 and PCT Rule 17). The fee for preparing a certified copy is set forth in § 1.19(b)(1).

(c) If a certified copy of the priority document is not submitted together with the international

application on filing, or, if the priority application was filed in the United States and a request and appropriate payment for preparation of such a certified copy do not accompany the international application on filing or are not filed within 16 months of the priority date, the certified copy of the priority document must be furnished by the applicant to the International Bureau or to the United States Receiving Office within the time limit specified in PCT Rule 17.1(a).

(d) The applicant may correct or add a priority claim in accordance with PCT Rule 26 *bis*.1.

[43 FR 20458, May 11, 1978; 47 FR 40140, Sept. 10, 1982, effective Oct. 1, 1982; para. (b), 47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; paras. (b) & (c), 50 FR 9384, Mar. 7, 1985, effective May 8, 1985; para. (b), 54 FR 6893, Feb. 15, 1989, effective Apr. 17, 1989; para. (a) amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; para. (a) revised, para. (d) added, 63 FR 29614, June 1, 1998, effective July 1, 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998); para. (b) revised, 66 FR 16004, Mar. 22, 2001, effective Mar. 1, 2001]

§ 1.452 Restoration of right of priority.

(a) If the international application has an international filing date which is later than the expiration of the priority period as defined by PCT Rule 2.4 but within two months from the expiration of the priority period, the right of priority in the international application may be restored upon request if the delay in filing the international application within the priority period was unintentional.

(b) A request to restore the right of priority in an international application under paragraph (a) of this section must be filed not later than two months from the expiration of the priority period and must include:

(1) A notice under PCT Rule 26 *bis*.1(a) adding the priority claim, if the priority claim in respect of the earlier application is not contained in the international application;

(2) The petition fee as set forth in § 1.17(m); and

(3) A statement that the delay in filing the international application within the priority period was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(c) If the applicant makes a request for early publication under PCT Article 21(2)(b), any requirement under paragraph (b) of this section filed after the technical preparations for international publication have been completed by the International Bureau shall be considered as not having been submitted in time.

[Added, 72 FR 51559 Sept. 10, 2007, effective Nov. 9, 2007; para. (b)(2) revised and para. (d) removed, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013]

§ 1.453 Transmittal of documents relating to earlier search or classification.

(a) Subject to paragraph (c) of this section, where an applicant has requested in an international application filed with the United States Receiving Office pursuant to PCT Rule 4.12 that an International Searching Authority take into account the results of an earlier search, the United States Receiving Office shall prepare and transmit to the International Searching Authority, as applicable, a copy of the results of the earlier search and any earlier classification as provided under PCT Rule 23 *bis*.1.

(b) Subject to paragraph (c) of this section, where an international application filed with the United States Receiving Office claims the priority of an earlier application filed with the USPTO in which the USPTO has carried out an earlier search or has classified such earlier application, the United States Receiving Office shall prepare and transmit to the International Searching Authority a copy of the results of any such earlier search and earlier classification as provided under PCT Rule 23 *bis*.2.

(c) The United States Receiving Office will not prepare a copy of the results of an earlier search or earlier classification referred to in paragraphs (a) and (b) of this section for transmittal to an International Searching Authority from an application preserved in confidence (§ 1.14) unless the international application contains written authority granting the International Searching Authority access to such results. Written authority provided under this paragraph must be signed by:

(1) An applicant in the international application who is also an applicant in the application preserved in confidence; or

(2) A person set forth in § 1.14(c) permitted to grant access to the application preserved in confidence.

[Added 82 FR 24249, May 26, 2017, effective July 1, 2017]

REPRESENTATION

§ 1.455 Representation in international applications.

(a) Applicants of international applications may be represented by attorneys or agents registered to practice before the United States Patent and Trademark Office or by an applicant appointed as a common representative (PCT Art. 49, Rules 4.8 and 90 and § 11.9). If applicants have not appointed an attorney or agent or one of the applicants to represent them, and there is more than one applicant, the applicant first named in the request and who is entitled to file in the U.S. Receiving Office shall be considered to be the common representative of all the applicants. An attorney or agent having the right to practice before a national office with which an international application is filed and for which the United States is an International Searching Authority or International Preliminary Examining Authority may be appointed to represent the applicants in the international application before that authority. An attorney or agent may appoint an associate attorney or agent who shall also then be of record (PCT Rule 90.1(d)). The appointment of an attorney or agent, or of a common representative, revokes any earlier appointment unless otherwise indicated (PCT Rule 90.6(b) and (c)).

(b) Appointment of an agent, attorney or common representative (PCT Rule 4.8) must be effected either in the Request form, signed by applicant, in the Demand form, signed by applicant, or in a separate power of attorney submitted either to the United States Receiving Office or to the International Bureau.

(c) Powers of attorney and revocations thereof should be submitted to the United States Receiving Office until the issuance of the international search report.

(d) The addressee for correspondence will be as indicated in section 108 of the Administrative Instructions.

[43 FR 20458, May 11, 1978; 50 FR 5171, Feb. 6, 1985, effective Mar. 8, 1985; para. (a) amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; para. (b) revised, 68 FR 58991, Oct. 20, 2003, effective Jan. 1, 2004; para. (a) revised, 69 FR 35427, June 24, 2004, effective July 26, 2004]

TRANSMITTAL OF RECORD COPY

§ 1.461 Procedures for transmittal of record copy to the International Bureau.

(a) Transmittal of the record copy of the international application to the International Bureau shall be made by the United States Receiving Office or as provided by PCT Rule 19.4.

(b) [Reserved]

(c) No copy of an international application may be transmitted to the International Bureau, a foreign Designated Office, or other foreign authority by the United States Receiving Office or the applicant, unless the applicable requirements of part 5 of this chapter have been satisfied.

[43 FR 20458, May 11, 1978; paras. (a) and (b), 50 FR 9384, Mar. 7, 1985, effective May 8, 1985; para. (a) revised, 63 FR 29614, June 1, 1998, effective July 1, 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998)]

TIMING

§ 1.465 Timing of application processing based on the priority date.

(a) For the purpose of computing time limits under the Treaty, the priority date shall be defined as in PCT Art. 2(xi).

(b) When a claimed priority date is corrected under PCT Rule 26 *bis*.1(a), or a priority claim is added under PCT Rule 26 *bis*.1(a), withdrawn under PCT Rule 90 *bis*.3, or considered not to have been made under PCT Rule 26 *bis*.2, the priority date for the purposes of computing any non-expired time limits will be the filing date of the earliest remaining priority claim under PCT Article 8 of the international application, or if none, the international filing date.

(c) When corrections under PCT Art. 11(2), Art. 14(2) or PCT Rule 20.2(a) (i) or (iii) are timely submitted, and the date of receipt of such corrections falls later than one year from the claimed priority

date or dates, the Receiving Office shall proceed under PCT Rule 26 *bis*.2.

[Paras. (b) and (c) revised, 63 FR 29614, June 1, 1998, effective July 1, 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998); para. (b) revised, 72 FR 51559, Sept. 10, 2007, effective Sept. 10, 2007]

§ 1.468 Delays in meeting time limits.

Delays in meeting time limits during international processing of international applications may only be excused as provided in PCT Rule 82. For delays in meeting time limits in a national application, see § 1.137.

AMENDMENTS

§ 1.471 Corrections and amendments during international processing.

(a) Except as otherwise provided in this paragraph, all corrections submitted to the United States Receiving Office or United States International Searching Authority must be in English, in the form of replacement sheets in compliance with PCT Rules 10 and 11, and accompanied by a letter that draws attention to the differences between the replaced sheets and the replacement sheets. Replacement sheets are not required for the deletion of lines of text, the correction of simple typographical errors, and one addition or change of not more than five words per sheet. These changes may be stated in a letter and, if appropriate, the United States Receiving Office will make the deletion or transfer the correction to the international application, provided that such corrections do not adversely affect the clarity and direct reproducibility of the application (PCT Rule 26.4). Amendments that do not comply with PCT Rules 10 and 11.1 to 11.13 may not be entered.

(b) Amendments of claims submitted to the International Bureau shall be as prescribed by PCT Rule 46.

(c) Corrections or additions to the Request of any declarations under PCT Rule 4.17 should be submitted to the International Bureau as prescribed by PCT Rule 26 *ter*.

[Para. (a) revised, 63 FR 29614, June 1, 1998, effective July 1, 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998); para. (c) added, 66 FR 16004, Mar. 22, 2001, effective Mar. 1, 2001]

§ 1.472 Changes in person, name, or address of applicants and inventors.

All requests for a change in person, name or address of applicants and inventor [should] be sent to the United States Receiving Office until the time of issuance of the international search report. Thereafter requests for such changes should be submitted to the International Bureau.

[43 FR 20458, May 11, 1978; redesignated at 52 FR 20047, May 28, 1987]

UNITY OF INVENTION

§ 1.475 Unity of invention before the International Searching Authority, the International Preliminary Examining Authority and during the national stage.

(a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

(1) A product and a process specially adapted for the manufacture of said product; or

(2) A product and a process of use of said product; or

(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or

(4) A process and an apparatus or means specifically designed for carrying out the said process; or

(5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

(c) If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.

(d) If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and § 1.476(c).

(e) The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

[Added 52 FR 20047, May 28, 1987, effective July 1, 1987; paras. (a) - (e) amended and para. (f) deleted, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993]

§ 1.476 Determination of unity of invention before the International Searching Authority.

(a) Before establishing the international search report, the International Searching Authority will determine whether the international application complies with the requirement of unity of invention as set forth in § 1.475.

(b) If the International Searching Authority considers that the international application does not comply with the requirement of unity of invention, it shall inform the applicant accordingly and invite the payment of additional fees (note § 1.445 and PCT Art. 17(3)(a) and PCT Rule 40). The applicant will be given a time period in accordance with PCT Rule 40.3 to pay the additional fees due.

(c) In the case of non-compliance with unity of invention and where no additional fees are paid, the international search will be performed on the invention first mentioned ("main invention") in the claims.

(d) Lack of unity of invention may be directly evident before considering the claims in relation to any prior art, or after taking the prior art into consideration, as where a document discovered during the search shows the invention claimed in a generic or linking claim lacks novelty or is clearly obvious, leaving two or more claims joined thereby without a common inventive concept. In such a case the International Searching Authority may raise the objection of lack of unity of invention.

[43 FR 20458, May 11, 1978; redesignated and amended at 52 FR 20047, May 28, 1987; para. (a) amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993]

§ 1.477 Protest to lack of unity of invention before the International Searching Authority.

(a) If the applicant disagrees with the holding of lack of unity of invention by the International Searching Authority, additional fees may be paid under protest, accompanied by a request for refund and a statement setting forth reasons for disagreement or why the required additional fees are considered excessive, or both (PCT Rule 40.2(c)).

(b) Protest under paragraph (a) of this section will be examined by the Director or the Director's designee. In the event that the applicant's protest is determined to be justified, the additional fees or a portion thereof will be refunded.

(c) An applicant who desires that a copy of the protest and the decision thereon accompany the international search report when forwarded to the Designated Offices, may notify the International Searching Authority to that effect any time prior to the issuance of the international search report. Thereafter, such notification should be directed to the International Bureau (PCT Rule 40.2(c)).

[43 FR 20458, May 11, 1978; redesignated and amended at 52 FR 20047, May 28, 1987; para. (b) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

INTERNATIONAL PRELIMINARY EXAMINATION

§ 1.480 Demand for international preliminary examination.

(a) On the filing of a proper Demand in an application for which the United States International Preliminary Examining Authority is competent and for which the fees have been paid, the international application shall be the subject of an international preliminary examination. The preliminary examination fee (§ 1.482(a)(1)) and the handling fee (§ 1.482(b)) shall be due within the applicable time limit set forth in PCT Rule 57.3.

(b) The Demand shall be made on a standardized form (PCT Rule 53). Copies of the printed Demand forms are available from the United States Patent and Trademark Office. Letters requesting printed Demand forms should be marked "Mail Stop PCT."

(c) Withdrawal of a proper Demand prior to the start of the international preliminary examination will entitle applicant to a refund of the preliminary examination fee minus the amount of the transmittal fee set forth in § 1.445(a)(1).

(d) The filing of a Demand shall constitute the election of all Contracting States which are designated and are bound by Chapter II of the Treaty on the international filing date (PCT Rule 53.7).

(e) Any Demand filed after the expiration of the applicable time limit set forth in PCT Rule 54 *bis*.1(a) shall be considered as if it had not been submitted (PCT Rule 54 *bis*.1(b)).

[52 FR 20048, May 28, 1987; para. (d), 53 FR 47810, Nov. 28, 1988, effective Jan. 1, 1989; para. (b) amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; para. (a) revised, 63 FR 29614, June 1, 1998, effective July 1, 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998); para. (c) removed and para. (d) redesignated as para. (c), 67 FR 520, Jan. 4, 2002, effective Apr. 1, 2002; para. (b) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (a) revised, paras. (d) & (e) added, 68 FR 58991, Oct. 20, 2003, effective Jan. 1, 2004]

§ 1.481 Payment of international preliminary examination fees.

(a) The handling and preliminary examination fees shall be paid within the time period set in PCT Rule 57.3. The handling fee or preliminary examination fee payable is the handling fee or preliminary examination fee in effect on the date of payment.

(1) If the handling and preliminary examination fees are not paid within the time period set in PCT Rule 57.3, applicant will be notified and given one month within which to pay the deficient fees plus a late payment fee equal to the greater of:

(i) Fifty percent of the amount of the deficient fees, but not exceeding an amount equal to double the handling fee; or

(ii) An amount equal to the handling fee (PCT Rule 58 *bis*.2).

(2) The one-month time limit set in this paragraph to pay deficient fees may not be extended.

(b) If the payment needed to cover the handling and preliminary examination fees, pursuant to paragraph (a) of this section, is not timely made in accordance with PCT Rule 58 *bis*.1(d), the United States International Preliminary Examination Authority will declare the Demand to be considered as if it had not been submitted.

[63 FR 29614, June 1, 1998, effective July 1, 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998); para. (a) revised, 68 FR 58991, Oct. 20, 2003, effective Jan. 1, 2004]

§ 1.482 International preliminary examination and processing fees.

(a) The following fees and charges for international preliminary examination are established by the director under the authority of 35 U.S.C. 376:

(1) The following preliminary examination fee is due on filing the demand:

(i) If an international search fee as set forth in § 1.445(a)(2) has been paid on the international application to the United States Patent and Trademark Office as an International Searching Authority:

TABLE 1 TO PARAGRAPH (a)(1)(i)

By a micro entity (§ 1.29)....$160.00

By a small entity (§ 1.27(a))....320.00

By other than a small or micro entity.....640.00

(ii) If the International Searching Authority for the international application was an authority other than the United States Patent and Trademark Office:

TABLE 2 TO PARAGRAPH (a)(1)(ii)

By a micro entity (§ 1.29)....$200.00

By a small entity (§ 1.27(a))....400.00

By other than a small or micro entity.....800.00

(2) An additional preliminary examination fee when required, per additional invention:

TABLE 3 TO PARAGRAPH (a)(2)

By a micro entity (§ 1.29).....$160.00

By a small entity (§ 1.27(a)).....320.00

By other than a small or micro entity.....640.00

(b) The handling fee is due on filing the demand and shall be as prescribed in PCT Rule 57.

(c) Late furnishing fee for providing a sequence listing in response to an invitation under PCT Rule 13 *ter*:

TABLE 4 TO PARAGRAPH (c)

By a micro entity (§ 1.29).....$80.00

By a small entity (§ 1.27(a)).....160.00

By other than a small or micro entity.....320.00

[52 FR 20048, May 28, 1987; para. (a), 54 FR 6893, Feb. 15, 1989, effective Apr. 17, 1989; para. (a), 56 FR 65142, Dec. 13, 1991, effective Dec. 27, 1991; paras. (a)(1) and (a)(2)(ii), 57 FR 38190, Aug. 21, 1992, effective Oct. 1, 1992; paras. (a)(2)(i) and (b) amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; paras. (a)(1) and (a)(2)(ii), 59 FR 43736, Aug. 25, 1994, effective Oct. 1, 1994; paras. (a)(1)(i), (a)(1)(ii), & (a)(2)(ii) amended, 60 FR 41018, Aug. 11, 1995, effective Oct. 1, 1995; paras. (a)(1)(i), (a)(1)(ii), and (a)(2)(ii) amended, 61 FR 39585, July 30, 1996, effective Oct. 1, 1996; paras. (a)(1)(i), (a)(1)(ii), and (a)(2)(ii) amended, 62 FR 40450, July 29, 1997, effective Oct. 1, 1997; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; revised, 68 FR 58991, Oct. 20, 2003, effective Jan. 1, 2004; revised, 78 FR 4212, Jan. 18, 2013, effective Mar. 19, 2013; revised 78 FR 17102, Mar. 20, 2013, effective Mar. 20, 2013; section heading revised and para. (c) added, 82 FR 52780, Nov. 14, 2017, effective Jan. 16, 2018; revised, 85 FR 46932, Aug. 3, 2020, effective Oct. 2, 2020]

§ 1.484 Conduct of international preliminary examination.

(a) An international preliminary examination will be conducted to formulate a non-binding opinion as to whether the claimed invention has novelty, involves an inventive step (is non-obvious) and is industrially applicable.

(b) International preliminary examination will begin in accordance with PCT Rule 69.1.

(c) No international preliminary examination will be conducted on inventions not previously searched by an International Searching Authority.

(d) The International Preliminary Examining Authority will establish a written opinion if any defect exists or if the claimed invention lacks novelty, inventive step or industrial applicability and will set a non-extendable time limit in the written opinion for the applicant to reply.

(e) The written opinion established by the International Searching Authority under PCT Rule 43 *bis*.1 shall be considered to be a written opinion of the United States International Preliminary Examining Authority for the purposes of paragraph (d) of this section.

(f) The International Preliminary Examining Authority may establish further written opinions under paragraph (d) of this section.

(g) If no written opinion under paragraph (d) of this section is necessary, or if no further written opinion under paragraph (f) of this section is to be established, or after any written opinion and the reply thereto or the expiration of the time limit for reply to such written opinion, an international preliminary examination report will be established by the International Preliminary Examining Authority. One copy will be submitted to the International Bureau and one copy will be submitted to the applicant.

(h) An applicant will be permitted a personal or telephone interview with the examiner, which may be requested after the filing of a Demand, and must be conducted during the period between the establishment of the written opinion and the establishment of the international preliminary examination report. Additional interviews may be conducted where the examiner determines that such additional interviews may be helpful to advancing the international preliminary examination procedure. A summary of any such personal or telephone interview must be filed by the applicant or, if not filed by applicant be made of record in the file by the examiner.

(i) If the application whose priority is claimed in the international application is in a language other than English, the United States International Preliminary Examining Authority may, where the validity of the priority claim is relevant for the formulation of the opinion referred to in Article 33(1), invite the applicant to furnish an English translation of the priority document within two months from the date of the invitation. If the translation is not furnished within that time limit, the international preliminary report may be established as if the priority had not been claimed.

[52 FR 20049, May 28, 1987; para. (b) amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; paras. (d)-(f) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (b) revised, 63 FR 29614, June 1, 1998, effective July 1, 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998); para. (g) added, 66 FR 16004, Mar. 22, 2001, effective Mar. 1, 2001; para. (b) & (e)-(g) revised, paras. (h) & (i) added, 68 FR 58991, Oct. 20, 2003, effective Jan. 1, 2004]

§ 1.485 Amendments by applicant during international preliminary examination.

The applicant may make amendments at the time of filing the Demand. The applicant may also make amendments within the time limit set by the International Preliminary Examining Authority for reply to any notification under § 1.484(b) or to any written opinion. Any such amendments must be made in accordance with PCT Rule 66.8.

[Added 52 FR 20049, May 28, 1987; amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; para. (a) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 63 FR 29614, June 1, 1998, effective July 1, 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998); amended, 74 FR 31372, July 1, 2009, effective July 1, 2009]

§ 1.488 Determination of unity of invention before the International Preliminary Examining Authority.

(a) Before establishing any written opinion or the international preliminary examination report, the International Preliminary Examining Authority will determine whether the international application complies with the requirement of unity of invention as set forth in § 1.475.

(b) If the International Preliminary Examining Authority considers that the international application does not comply with the requirement of unity of invention, it may:

(1) Issue a written opinion and/or an international preliminary examination report, in respect of the entire international application and indicate that unity of invention is lacking and specify the reasons therefor without extending an invitation to restrict or pay additional fees. No international preliminary examination will be conducted on inventions not previously searched by an International Searching Authority.

(2) Invite the applicant to restrict the claims or pay additional fees, pointing out the categories of invention found, within a set time limit which will not be extended. No international preliminary examination will be conducted on inventions not previously searched by an International Searching Authority, or

(3) If applicant fails to restrict the claims or pay additional fees within the time limit set for reply, the International Preliminary Examining Authority will issue a written opinion and/or establish an international preliminary examination report on the main invention and shall indicate the relevant facts in the said report. In case of any doubt as to which invention is the main invention, the invention first mentioned in the claims and previously searched by an International Searching Authority shall be considered the main invention.

(c) Lack of unity of invention may be directly evident before considering the claims in relation to any prior art, or after taking the prior art into consideration, as where a document discovered

during the search shows the invention claimed in a generic or linking claim lacks novelty or is clearly obvious, leaving two or more claims joined thereby without a common inventive concept. In such a case the International Preliminary Examining Authority may raise the objection of lack of unity of invention.

[52 FR 20049, May 28, 1987; para. (a) amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; para. (b)(3) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.489 Protest to lack of unity of invention before the International Preliminary Examining Authority.

(a) If the applicant disagrees with the holding of lack of unity of invention by the International Preliminary Examining Authority, additional fees may be paid under protest, accompanied by a request for refund and a statement setting forth reasons for disagreement or why the required additional fees are considered excessive, or both.

(b) Protest under paragraph (a) of this section will be examined by the Director or the Director's designee. In the event that the applicant's protest is determined to be justified, the additional fees or a portion thereof will be refunded.

(c) An applicant who desires that a copy of the protest and the decision thereon accompany the international preliminary examination report when forwarded to the Elected Offices, may notify the International Preliminary Examining Authority to that effect any time prior to the issuance of the international preliminary examination report. Thereafter, such notification should be directed to the International Bureau.

[Added 52 FR 20050, May 28, 1987, effective July 1, 1987; para. (b) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

NATIONAL STAGE

§ 1.491 National stage commencement, entry, and fulfillment.

[Editor Note: Certain paragraphs below are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

(a) Subject to 35 U.S.C. 371(f), the national stage shall commence with the expiration of the applicable time limit under PCT Article 22(1) or (2), or under PCT Article 39(1)(a).

(b) An international application enters the national stage when the applicant has filed the documents and fees required by 35 U.S.C. 371(c)(1) and (c)(2) within the period set in § 1.495.

(c) An international application fulfills the requirements of 35 U.S.C. 371 when the national stage has commenced under 35 U.S.C. 371(b) or (f) and all applicable requirements of 35 U.S.C. 371 have been satisfied.

[Added, 52 FR 20050, May 28, 1987; revised, 66 FR 45775, Aug. 30, 2001; revised, 67 FR 520, Jan. 4, 2002, effective Apr. 1, 2002; heading and para. (b) revised and para. (c) added, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012]

[*The changes effective Sept. 16, 2012 are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012. See § 1.491 (pre-AIA) for the rule otherwise in effect.]

§ 1.491 (pre-AIA) National stage commencement and entry.

[Editor Note: **Not applicable** to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

(a) Subject to 35 U.S.C. 371(f), the national stage shall commence with the expiration of the applicable time limit under PCT Article 22(1) or (2), or under PCT Article 39(1)(a).

(b) An international application enters the national stage when the applicant has filed the documents and fees required by 35 U.S.C. 371(c) within the period set in § 1.495.

[Added, 52 FR 20050, May 28, 1987; revised, 66 FR 45775, Aug. 30, 2001; revised, 67 FR 520, Jan. 4, 2002, effective Apr. 1, 2002]

[*See § 1.491 for more information and for the rule applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012]

§ 1.492 National stage fees.

The following fees and charges are established for international applications entering the national stage under 35 U.S.C. 371:

(a) The basic national fee for an international application entering the national stage under 35 U.S.C. 371:

TABLE 1 TO PARAGRAPH (a)

By a micro entity (§ 1.29).....$80.00

By a small entity (§ 1.27(a)).....160.00

By other than a small or micro entity.....320.00

(b) Search fee for an international application entering the national stage under 35 U.S.C. 371:

(1) If an international preliminary examination report on the international application prepared by the United States International Preliminary Examining Authority or a written opinion on the international application prepared by the United States International Searching Authority states that the criteria of novelty, inventive step (non-obviousness), and industrial applicability, as defined in PCT Article 33(1) to (4) have been satisfied for all of the claims presented in the application entering the national stage:

TABLE 2 TO PARAGRAPH (b)(1)

By a micro entity (§ 1.29).....$0.00

By a small entity (§ 1.27(a)).....0.00

By other than a small or micro entity.....0.00

(2) If the search fee as set forth in § 1.445(a)(2) has been paid on the international application to the United States Patent and Trademark Office as an International Searching Authority:

TABLE 3 TO PARAGRAPH (b)(2)

By a micro entity (§ 1.29).....$35.00

By a small entity (§ 1.27(a)).....70.00

By other than a small or micro entity.....140.00

(3) If an international search report on the international application has been prepared by an International Searching Authority other than the United States International Searching Authority and is provided, or has been previously communicated by the International Bureau, to the Office:

TABLE 4 TO PARAGRAPH (b)(3)

By a micro entity (§ 1.29).....$135.00

By a small entity (§ 1.27(a)).....270.00

By other than a small entity.....540.00

(4) In all situations not provided for in paragraph (b)(1), (2), or (3) of this section:

TABLE 5 TO PARAGRAPH (b)(4)

By a micro entity (§ 1.29).....$175.00

By a small entity (§ 1.27(a)).....350.00

By other than a small or micro entity.....700.00

(c) The examination fee for an international application entering the national stage under 35 U.S.C. 371:

(1) If an international preliminary examination report on the international application prepared by the United States International Preliminary Examining Authority or a written opinion on the international application prepared by the United States International Searching Authority states that the criteria of novelty, inventive step (non-obviousness), and industrial applicability, as defined in PCT Article 33(1) to (4) have been satisfied for all of the claims presented in the application entering the national stage:

TABLE 6 TO PARAGRAPH (c)(1)

By a micro entity (§ 1.29).....$0.00

By a small entity (§ 1.27(a)).....0.00

By other than a small or micro entity.....0.00

(2) In all situations not provided for in paragraph (c)(1) of this section:

TABLE 7 TO PARAGRAPH (c)(2)

By a micro entity (§ 1.29).....$200.00

By a small entity (§ 1.27(a)).....400.00

By other than a small or micro entity.....800.00

(d) In addition to the basic national fee, for filing or on later presentation at any other time of each claim in independent form in excess of three:

TABLE 8 TO PARAGRAPH (d)

By a micro entity (§ 1.29).....$120.00

By a small entity (§ 1.27(a)).....240.00

By other than a small or micro entity.....480.00

(e) In addition to the basic national fee, for filing or on later presentation at any other time of each claim (whether dependent or independent) in excess of 20 (note that § 1.75(c) indicates how multiple dependent claims are considered for fee calculation purposes):

TABLE 9 TO PARAGRAPH (e)

By a micro entity (§ 1.29).....$25.00

By a small entity (§ 1.27(a)).....50.00

By other than a small or micro entity.....100.00

(f) In addition to the basic national fee, if the application contains, or is amended to contain, a multiple dependent claim, per application:

TABLE 10 TO PARAGRAPH (f)

By a micro entity (§ 1.29).....$215.00

By a small entity (§ 1.27(a)).....430.00

By other than a small or micro entity.....860.00

(g) If the excess claims fees required by paragraphs (d) and (e) of this section and multiple dependent claim fee required by paragraph (f) of this section are not paid with the basic national fee or on later presentation of the claims for which excess claims or multiple dependent claim fees are due, the fees required by paragraphs (d), (e), and (f) of this section must be paid or the claims canceled by amendment prior to the expiration of the time period set for reply by the Office in any notice of fee deficiency in order to avoid abandonment.

(h) Surcharge for filing any of the search fee, the examination fee, or the oath or declaration after the date of the commencement of the national stage (§ 1.491(a)) pursuant to § 1.495(c):

TABLE 11 TO PARAGRAPH (h)

By a micro entity (§ 1.29).....$40.00

By a small entity (§ 1.27(a)).....80.00

By other than a small entity.....160.00

(i) For filing an English translation of an international application or any annexes to an international preliminary examination report later than thirty months after the priority date (§ 1.495(c) and (e)):

TABLE 12 TO PARAGRAPH (i)

By a micro entity (§ 1.29).....$35.00

By a small entity (§ 1.27(a)).....70.00

By other than a small or micro entity.....140.00

(j) Application size fee for any international application, the specification and drawings of which exceed 100 sheets of paper, for each additional 50 sheets or fraction thereof:

TABLE 13 TO PARAGRAPH (j)

By a micro entity (§ 1.29).....$105.00

By a small entity (§ 1.27(a)).....210.00

By other than a small or micro entity.....420.00

[52 FR 20050, May 28, 1987, effective July 1, 1987; paras. (a)(1) - (3), (b), (d)- (f), 54 FR 6893, Feb. 15, 1989, effective Apr. 17, 1989; para. (a)(5) added, 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; revised, 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; paras. (a)(1)-(a)(3), (a)(5) and (b)-(d), 57 FR 38190, Aug. 21, 1992, effective Oct. 1, 1992; para. (e) amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; paras. (a), (b) and (d), 59 FR 43736, Aug. 25, 1994, effective Oct. 1, 1994; paras. (a), (b), & (d) amended, 60 FR 41018, Aug. 11, 1995, effective, Oct. 1, 1995; paras. (a), (b), & (d) amended, 61 FR 39585, July 30, 1996, effective Oct. 1, 1996; paras. (a), (b), & (d) amended, 62 FR 40450, July 29, 1997, effective Oct. 1, 1997; para. (g) added, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a)-(d) revised, 63 FR 67578, Dec. 8, 1998, effective Nov. 10, 1998; para. (a)(2) revised, 64 FR 67774, Dec. 3, 1999, effective Dec. 29, 1999; paras. (a), (b) and (d) revised, 65 FR 49193, Aug. 11, 2000, effective Oct. 1, 2000; paras. (a)-(e) revised, 65 FR 78958, Dec. 18, 2000; paras. (a)(1)-(a)(3), (a)(5), (b) and (d) revised, 66 FR 39447, July 31, 2001, effective Oct. 1, 2001; paras. (e) and (f) revised, 67 FR 520, Jan. 4, 2002, effective Apr. 1, 2002; paras. (a)(1) through (a)(3), and (a)(5) revised, 67 FR 70847, Nov. 27, 2002, effective Jan. 1, 2003; paras. (a)(1) through (a)(3), (a)(5), (b), and (d) revised, 68 FR 41532,

July 14, 2003, effective Oct. 1, 2003; paras. (a)(1) through (a)(3), (a)(5), (b) and (d) revised, 69 F R 52604, Aug. 27, 2004, effective Oct. 1, 2004; revised, 70 FR 3880, Jan. 27, 2005, effective Dec. 8, 2004; paras. (b) and (c) revised, 70 FR 5053, Feb. 1, 2005, effective Feb. 1, 2005; paras. (h) and (j) revised, 70 FR 30360, May 26, 2005, effective July 1, 2005; paras. (b) and (c) revised, 70 FR 35375, June 20, 2005, effective July 1, 2005; paras. (a), (b)(2) through (b)(4), (c)(2), (d) through (f), and (j) revised, 72 FR 46899, Aug. 22, 2007, effective Sept. 30, 2007; paras. (b)(2) through (b)(4) corrected, 72 FR 55055, Sept. 28, 2007, effective Sept. 30, 2007; paras. (a), (b)(3), (b)(4), (c)(2), (d) through (f) and (j) revised, 73 FR 47534, Aug. 14, 2008, effective Oct. 2, 2008; para. (h) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012; paras. (a), (b)(3), (b)(4), (c)(2), (d)-(f) and (j) revised, 77 FR 54360, Sept. 5, 2012, effective Oct. 5, 2012; revised, 78 FR 4212, Jan. 18, 2013, effective Mar. 19, 2013; paras. (a), (b)(2)-(4), (c)(2), and (d)-(f) revised, 82 FR 52780, Nov. 14, 2017, effective Jan. 16, 2018; paras. (a), (b)(3), (b)(4), (c)(2), (d), (f), (h), and (j) revised and table headings added to paras. (b)(1), (b)(2), (c)(1), (e), and (i), 85 FR 46932, Aug. 3, 2020, effective Oct. 2, 2020]

§ 1.494 [Reserved]

[Added 52 FR 20050, May 28, 1987; paras. (a) - (d) and (g) amended and para. (h) deleted, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; para. (c) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para (c) revised, 63 FR 29614, June 1, 1998, effective, July 1, 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998); para (f) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para. (c)(2) revised, 66 FR 16004, Mar. 22, 2001, effective Mar. 1, 2000; para. (c)(2) corrected, 66 FR 28053, May 22, 2001, effective Mar. 22, 2001; removed and reserved, 67 FR 520, Jan. 4, 2002, effective Apr. 1, 2002]

§ 1.495 Entering the national stage in the United States of America.

[Editor Note: Paragraphs (a), (c), and (h) below are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

(a) The applicant in an international application must fulfill the requirements of 35 U.S.C. 371 within the time periods set forth in paragraphs (b) and (c) of this section in order to prevent the abandonment of the international application as to the United States of America. The thirty-month time period set forth in paragraphs (b), (c), (d), (e) and (h) of this section may not be extended.

(b) To avoid abandonment of the application, the applicant shall furnish to the United States Patent and Trademark Office not later than the expiration of thirty months from the priority date:

(1) A copy of the international application, unless it has been previously communicated by the International Bureau or unless it was originally filed in the United States Patent and Trademark Office; and

(2) The basic national fee (see § 1.492(a)).

(c)(1) If applicant complies with paragraph (b) of this section before expiration of thirty months from the priority date, the Office will notify the applicant if he or she has omitted any of:

(i) A translation of the international application, as filed, into the English language, if it was originally filed in another language and if any English language translation of the publication of the international application previously submitted under 35 U.S.C. 154(d) (§ 1.417) is not also a translation of the international application as filed (35 U.S.C. 371(c)(2));

(ii) The inventor's oath or declaration (35 U.S.C. 371(c)(4) and § 1.497), if a declaration of inventorship in compliance with § 1.63 has not been previously submitted in the international application under PCT Rule 4.17(iv) within the time limits provided for in PCT Rule 26 *ter*.1;

(iii) The search fee set forth in § 1.492(b);

(iv) The examination fee set forth in § 1.492(c); and

(v) Any application size fee required by § 1.492(j);

(2) A notice under paragraph (c)(1) of this section will set a time period within which applicant must provide any omitted translation, search fee set forth in § 1.492(b), examination fee set forth in § 1.492(c), and any application size fee required by § 1.492(j) in order to avoid abandonment of the application.

(3) The inventor's oath or declaration must also be filed within the period specified in paragraph (c)(2) of this section, except that the filing of the inventor's oath or declaration may be postponed until the application is otherwise in condition for allowance under the conditions specified in

paragraphs (c)(3)(i) through (c)(3)(iii) of this section.

(i) The application contains an application data sheet in accordance with § 1.76 filed prior to the expiration of the time period set in any notice under paragraph (c)(1) identifying:

(A) Each inventor by his or her legal name;

(B) A mailing address where the inventor customarily receives mail, and residence, if an inventor lives at a location which is different from where the inventor customarily receives mail, for each inventor.

(ii) The applicant must file each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, no later than the date on which the issue fee for the patent is paid. If the applicant is notified in a notice of allowability that an oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64 , executed by or with respect to each named inventor has not been filed, the applicant must file each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, no later than the date on which the issue fee is paid to avoid abandonment. This time period is not extendable under § 1.136 (*see* § 1.136(c)). The Office may dispense with the notice provided for in paragraph (c)(1) of this section if each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, has been filed before the application is in condition for allowance.

(iii) An international application in which the basic national fee under 35 U.S.C. 41(a)(1)(F) has been paid and for which an application data sheet in accordance with § 1.76 has been filed may be treated as complying with 35 U.S.C. 371 for purposes of eighteen-month publication under 35 U.S.C. 122(b) and § 1.211 *et seq.*

(4) The payment of the processing fee set forth in § 1.492(i) is required for acceptance of an English translation later than the expiration of thirty months after the priority date. The payment of the surcharge set forth in § 1.492(h) is required for acceptance of any of the search fee, the examination fee, or the inventor's oath or declaration after the date of the commencement of the national stage (§ 1.491(a)).

(5) A "Sequence Listing" need not be translated if the "Sequence Listing" complies with PCT Rule 12.1(d) and the description complies with PCT Rule 5.2(b).

(d) A copy of any amendments to the claims made under PCT Article 19, and a translation of those amendments into English, if they were made in another language, must be furnished not later than the expiration of thirty months from the priority date. Amendments under PCT Article 19 which are not received by the expiration of thirty months from the priority date will be considered to be canceled.

(e) A translation into English of any annexes to an international preliminary examination report (if applicable), if the annexes were made in another language, must be furnished not later than the expiration of thirty months from the priority date. Translations of the annexes which are not received by the expiration of thirty months from the priority date may be submitted within any period set pursuant to paragraph (c) of this section accompanied by the processing fee set forth in § 1.492(f). Annexes for which translations are not timely received will be considered canceled.

(f) Verification of the translation of the international application or any other document pertaining to an international application may be required where it is considered necessary, if the international application or other document was filed in a language other than English.

(g) The documents and fees submitted under paragraphs (b) and (c) of this section must be identified as a submission to enter the national stage under 35 U.S.C. 371. If the documents and fees contain conflicting indications as between an application under 35 U.S.C. 111 and a submission to enter the national stage under 35 U.S.C. 371, the documents and fees will be treated as a submission to enter the national stage under 35 U.S.C. 371.

(h) An international application becomes abandoned as to the United States thirty months from the priority date if the requirements of paragraph (b) of this section have not been complied with within thirty months from the priority date.

[Added 52 FR 20051, May 28, 1987, effective July 1, 1987; paras. (a) -(e) & (h) amended and para. (i) deleted, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; para. (c) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; para (c) revised, 63 FR 29614,

June 1, 1998, effective July 1, 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998), para. (g) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para. (c)(2) revised, 66 FR 16004, Mar. 22, 2001, effective Mar. 1, 2001 para. (c)(2) corrected, 66 FR 28053, May 22, 2001, effective Mar. 22, 2001; heading and paras. (a)-(e) and (h) revised, 67 FR 520, Jan. 4, 2002, effective Apr. 1, 2002; paras. (c) & (g) revised, 68 FR 70996, Dec. 22, 2003, effective Jan. 21, 2004; para. (c) revised, 70 FR 3880, Jan. 27, 2005, effective Dec. 8, 2004; paras. (c)(1)(i) and (c)(3) revised, 70 FR 30360, May 26, 2005, effective July 1, 2005; para. (g) revised, 72 FR 46716, Aug. 21, 2007 (implementation enjoined and never became effective); para. (g) revised, 74 FR 52686, Oct. 14, 2009, effective Oct. 14, 2009 (to remove changes made by the final rules in 72 FR 46716 from the CFR); paras. (a), (c), (g), and (h) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012; para. (c)(3)(ii) revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013]

[*The changes to paras. (a), (c), and (h) effective Sept. 16, 2012 are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012. See § 1.495 (pre-AIA) for paras. (a), (c), and (h) otherwise in effect.]

§ 1.495 (pre-AIA) Entering the national stage in the United States of America.

[Editor Note: Paragraphs (a), (c), and (h) below are **not applicable** to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012*]

(a) The applicant in an international application must fulfill the requirements of 35 U.S.C. 371 within the time periods set forth in paragraphs (b) and (c) of this section in order to prevent the abandonment of the international application as to the United States of America. The thirty-month time period set forth in paragraphs (b), (c), (d), (e) and (h) of this section may not be extended. International applications for which those requirements are timely fulfilled will enter the national stage and obtain an examination as to the patentability of the invention in the United States of America.

* * * * *

(c)(1) If applicant complies with paragraph (b) of this section before expiration of thirty months from the priority date, the Office will notify the applicant if he or she has omitted any of:

(i) A translation of the international application, as filed, into the English language, if it was originally filed in another language and if any English language translation of the publication of the international application previously submitted under 35 U.S.C. 154(d) (§ 1.417) is not also a translation of the international application as filed (35 U.S.C. 371(c)(2));

(ii) The oath or declaration of the inventor (35 U.S.C. 371(c)(4) and § 1.497), if a declaration of inventorship in compliance with § 1.497 has not been previously submitted in the international application under PCT Rule 4.17(iv) within the time limits provided for in PCT Rule 26 *ter*.1;

(iii) The search fee set forth in § 1.492(b);

(iv) The examination fee set forth in § 1.492(c); and

(v) Any application size fee required by § 1.492(j);

(2) A notice under paragraph (c)(1) of this section will set a time period within which applicant must provide any omitted translation, oath or declaration of the inventor, search fee set forth in § 1.492(b), examination fee set forth in § 1.492(c), and any application size fee required by § 1.492(j) in order to avoid abandonment of the application.

(3) The payment of the processing fee set forth in § 1.492(i) is required for acceptance of an English translation later than the expiration of thirty months after the priority date. The payment of the surcharge set forth in § 1.492(h) is required for acceptance of any of the search fee, the examination fee, or the oath or declaration of the inventor after the date of the commencement of the national stage (§ 1.491(a)).

(4) A “Sequence Listing” need not be translated if the “Sequence Listing” complies with PCT Rule 12.1(d) and the description complies with PCT Rule 5.2(b).

* * * * *

(h) An international application becomes abandoned as to the United States thirty months from the priority date if the requirements of paragraph (b) of this section have not been complied with within thirty months from the priority date. If the requirements of paragraph (b) of this section are complied with within thirty months from the priority date but either of any required translation of the international application as filed or the oath or

declaration are not timely filed, an international application will become abandoned as to the United States upon expiration of the time period set pursuant to paragraph (c) of this section.

[*See § 1.495 for more information and for the current rule, including the portions of the rule not reproduced above and applicable irrespective of application filing date and paras. (a), (c), and (h) applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012]

§ 1.496 Examination of international applications in the national stage.

National stage applications having paid therein the search fee as set forth in § 1.492(b)(1) and examination fee as set forth in § 1.492(c)(1) may be amended subsequent to the date of commencement of national stage processing only to the extent necessary to eliminate objections as to form or to cancel rejected claims. Such national stage applications will be advanced out of turn for examination.

[Added 52 FR 20051, May 28, 1987, effective July 1, 1987; para. (b) revised, 70 FR 5053, Feb. 1, 2005, effective Feb. 1, 2005; para. (b) revised, 70 FR 35375, June 20, 2005, effective July 1, 2005; revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012]

§ 1.497 Inventor's oath or declaration under 35 U.S.C. 371(c)(4).

[Editor Note: Applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

(a) When an applicant of an international application desires to enter the national stage under 35 U.S.C. 371 pursuant to § 1.495, and a declaration in compliance with § 1.63 has not been previously submitted in the international application under PCT Rule 4.17(iv) within the time limits provided for in PCT Rule 26 *ter*.1, the applicant must file the inventor's oath or declaration. The inventor, or each individual who is a joint inventor of a claimed invention, in an application for patent must execute an oath or declaration in accordance with the conditions and requirements of § 1.63, except as provided for in § 1.64.

(b) An oath or declaration under § 1.63 will be accepted as complying with 35 U.S.C. 371(c)(4) if it complies with the requirements of §§ 1.63(a), (c) and (g). A substitute statement under § 1.64 will be accepted as complying with 35 U.S.C. 371(c)(4) if it complies with the requirements of §§ 1.64(b)(1), (c) and (e) and identifies the person executing the substitute statement. If a newly executed inventor's oath or declaration under § 1.63 or substitute statement under § 1.64 is not required pursuant to § 1.63(d), submission of the copy of the previously executed oath, declaration, or substitute statement under § 1.63(d)(1) is required to comply with 35 U.S.C. 371(c)(4).

(c) If an oath or declaration under § 1.63, or substitute statement under § 1.64, meeting the requirements of § 1.497(b) does not also meet the requirements of § 1.63 or § 1.64, an oath, declaration, substitute statement, or application data sheet in accordance with § 1.76 to comply with § 1.63 or § 1.64 will be required.

[Added 52 FR 20052, May 28, 1987, effective July 1, 1987; paras. (a) and (b) revised and para. (c) added, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; para. (b)(2) revised and paras. (d) and (e) added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a), (c), and (d) revised and paras. (f) and (g) added, 66 FR 16004, Mar. 22, 2001, effective Mar. 1, 2001; para. (a)(1) corrected, 66 FR 28053, May 22, 2001, effective Mar. 22, 2001; paras. (a), (c), (d), and (f) revised, 67 FR 520, Jan. 4, 2002, effective Apr. 1, 2002; para. (c) corrected, 67 FR 6075, Feb. 8, 2002; para. (f)(1), revised 72 FR 51559, Sept. 10, 2007, effective Sept. 10, 2007; revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012]

[*The changes effective Sept. 16, 2012 are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012. See § 1.497 (pre-AIA) for the rule otherwise in effect.]

§ 1.497 (pre-AIA) Oath or declaration under 35 U.S.C. 371(c)(4).

[Editor Note: **Not applicable** to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

(a) When an applicant of an international application desires to enter the national stage under 35 U.S.C. 371 pursuant to § 1.495, and a declaration in compliance with this section has not been previously submitted in the international application under PCT Rule 4.17(iv) within the time limits provided for in PCT Rule 26 *ter*.1, he or she must file an oath or declaration that:

(1) Is executed in accordance with either §§ 1.66 or 1.68;

(2) Identifies the specification to which it is directed;

(3) Identifies each inventor and the country of citizenship of each inventor; and

(4) States that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

(b)(1) The oath or declaration must be made by all of the actual inventors except as provided for in§§ 1.42, 1.43 or 1.47.

(2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative.

(c) Subject to paragraph (f) of this section, if the oath or declaration meets the requirements of paragraphs (a) and (b) of this section, the oath or declaration will be accepted as complying with 35 U.S.C. 371(c)(4) and § 1.495(c). However, if the oath or declaration does not also meet the requirements of § 1.63, a supplemental oath or declaration in compliance with § 1.63 or an application data sheet will be required in accordance with § 1.67.

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, or if a change to the inventive entity has been effected under PCT Rule 92 *bis* subsequent to the execution of any oath or declaration which was filed in the application under PCT Rule 4.17(iv) or this section and the inventive entity thus changed is different from the inventive entity identified in any such oath or declaration, applicant must submit:

(1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;

(2) The processing fee set forth in § 1.17(i); and

(3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter); and

(4) Any new oath or declaration required by paragraph (f) of this section.

(e) The Office may require such other information as may be deemed appropriate under the particular circumstances surrounding the correction of inventorship.

(f) A new oath or declaration in accordance with this section must be filed to satisfy 35 U.S.C. 371(c)(4) if the declaration was filed under PCT Rule 4.17(iv), and:

(1) There was a change in the international filing date pursuant to PCT Rule 20.5(c) after the declaration was executed; or

(2) A change in the inventive entity was effected under PCT Rule 92 *bis* after the declaration was executed and no declaration which sets forth and is executed by the inventive entity as so changed has been filed in the application.

(g) If a priority claim has been corrected or added pursuant to PCT Rule 26 *bis* during the international stage after the declaration of inventorship was executed in the international application under PCT Rule 4.17(iv), applicant will be required to submit either a new oath or declaration or an application data sheet as set forth in § 1.76 correctly identifying the application upon which priority is claimed.

[Added 52 FR 20052, May 28, 1987, effective July 1, 1987; paras. (a) and (b) revised and para. (c) added, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; para. (b)(2) revised and paras. (d) and (e) added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a), (c), and (d) revised and paras. (f) and (g) added, 66 FR 16004, Mar. 22, 2001, effective Mar. 1, 2001; para. (a)(1) corrected, 66 FR 28053, May 22, 2001, effective Mar. 22, 2001; paras. (a), (c), (d), and (f) revised, 67 FR 520, Jan. 4, 2002, effective Apr. 1, 2002; para. (c) corrected,

67 FR 6075, Feb. 8, 2002; para. (f)(1), revised 72 FR 51559, Sept. 10, 2007, effective Sept. 10, 2007]

[*See § 1.497 for more information and for the rule applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012]

§ 1.499 Unity of invention during the national stage.

If the examiner finds that a national stage application lacks unity of invention under § 1.475, the examiner may in an Office action require the applicant in the response to that action to elect the invention to which the claims shall be restricted. Such requirement may be made before any action on the merits but may be made at any time before the final action at the discretion of the examiner. Review of any such requirement is provided under §§ 1.143 and 1.144.

[Added 52 FR 20052, May 28, 1987, effective July 1, 1987; amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993]

Subpart D — Ex Parte Reexamination of Patents

CITATION OF PRIOR ART AND WRITTEN STATEMENTS

§ 1.501 Citation of prior art and written statements in patent files.

(a) *Information content of submission:* At any time during the period of enforceability of a patent, any person may file a written submission with the Office under this section, which is directed to the following information:

(1) Prior art consisting of patents or printed publications which the person making the submission believes to have a bearing on the patentability of any claim of the patent; or

(2) Statements of the patent owner filed by the patent owner in a proceeding before a Federal court or the Office in which the patent owner took a position on the scope of any claim of the patent. Any statement submitted under this paragraph must be accompanied by any other documents, pleadings, or evidence from the proceeding in which the statement was filed that address the written statement, and such statement and accompanying information under this paragraph must be submitted in redacted form to exclude information subject to an applicable protective order.

(3) Submissions under paragraph (a)(2) of this section must identify:

(i) The forum and proceeding in which patent owner filed each statement;

(ii) The specific papers and portions of the papers submitted that contain the statements; and

(iii) How each statement submitted is a statement in which patent owner took a position on the scope of any claim in the patent.

(b) *Explanation:* A submission pursuant to paragraph (a) of this section:

(1) Must include an explanation in writing of the pertinence and manner of applying any prior art submitted under paragraph (a)(1) of this section and any written statement and accompanying information submitted under paragraph (a)(2) of this section to at least one claim of the patent, in order for the submission to become a part of the official file of the patent; and

(2) May, if the submission is made by the patent owner, include an explanation of how the claims differ from any prior art submitted under paragraph (a)(1) of this section or any written statements and accompanying information submitted under paragraph (a)(2) of this section.

(c) *Reexamination pending:* If a reexamination proceeding has been requested and is pending for the patent in which the submission is filed, entry of the submission into the official file of the patent is subject to the provisions of §§ 1.502 and 1.902.

(d) *Identity:* If the person making the submission wishes his or her identity to be excluded from the patent file and kept confidential, the submission papers must be submitted anonymously without any identification of the person making the submission.

(e) *Certificate of Service:* A submission under this section by a person other than the patent owner must include a certification that a copy of the submission was served in its entirety upon patent owner at the address as provided for in § 1.33(c). A submission by a person other than the patent owner

that fails to include proper proof of service as required by § 1.248(b) will not be entered into the patent file.

[46 FR 29185, May 29, 1981, effective July 1, 1981; para. (a) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

§ 1.502 Processing of prior art citations during an *ex parte* reexamination proceeding.

Citations by the patent owner under § 1.555 and by an *ex parte* reexamination requester under either § 1.510 or § 1.535 will be entered in the reexamination file during a reexamination proceeding. The entry in the patent file of citations submitted after the date of an order to reexamine pursuant to § 1.525 by persons other than the patent owner, or an *ex parte* reexamination requester under either § 1.510 or § 1.535, will be delayed until the reexamination proceeding has been concluded by the issuance and publication of a reexamination certificate. See § 1.902 for processing of prior art citations in patent and reexamination files during an *inter partes* reexamination proceeding filed under § 1.913.

[Added 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; revised, 72 FR 18892, Apr. 16, 2007, effective May 16, 2007]

REQUEST FOR *EX PARTE* REEXAMINATION

§ 1.510 Request for *ex parte* reexamination.

(a) Any person may, at any time during the period of enforceability of a patent, file a request for an *ex parte* reexamination by the Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501, unless prohibited by 35 U.S.C. 315(e)(1) or 35 U.S.C. 325(e)(1). The request must be accompanied by the fee for requesting reexamination set in § 1.20(c)(1).

(b) Any request for reexamination must include the following parts:

(1) A statement pointing out each substantial new question of patentability based on prior patents and printed publications.

(2) An identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested. For each statement of the patent owner and accompanying information submitted pursuant to § 1.501(a)(2) which is relied upon in the detailed explanation, the request must explain how that statement is being used to determine the proper meaning of a patent claim in connection with the prior art applied to that claim and how each relevant claim is being interpreted. If appropriate, the party requesting reexamination may also point out how claims distinguish over cited prior art.

(3) A copy of every patent or printed publication relied upon or referred to in paragraph (b)(1) and (2) of this section accompanied by an English language translation of all the necessary and pertinent parts of any non-English language patent or printed publication.

(4) A copy of the entire patent including the front face, drawings, and specification/claims (in double column format) for which reexamination is requested, and a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent. All copies must have each page plainly written on only one side of a sheet of paper.

(5) A certification that a copy of the request filed by a person other than the patent owner has been served in its entirety on the patent owner at the address as provided for in § 1.33(c). The name and address of the party served must be indicated. If service was not possible, a duplicate copy must be supplied to the Office.

(6) A certification by the third party requester that the statutory estoppel provisions of 35 U.S.C. 315(e)(1) or 35 U.S.C. 325(e)(1) do not prohibit the requester from filing the *ex parte* reexamination request.

(c) If the request does not include the fee for requesting *ex parte* reexamination required by paragraph (a) of this section and meet all the requirements by paragraph (b) of this section, then the person identified as requesting reexamination will be so notified and will generally be given an opportunity to complete the request within a specified time. Failure to comply with the notice will result in the *ex parte* reexamination request not

being granted a filing date, and will result in placement of the request in the patent file as a citation if it complies with the requirements of § 1.501.

(d) The filing date of the request for *ex parte* reexamination is the date on which the request satisfies all the requirements of this section.

(e) A request filed by the patent owner may include a proposed amendment in accordance with § 1.530.

(f) If a request is filed by an attorney or agent identifying another party on whose behalf the request is being filed, the attorney or agent must have a power of attorney from that party or be acting in a representative capacity pursuant to § 1.34.

[46 FR 29185, May 29, 1981, effective July 1, 1981; para. (a), 47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; para. (e) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; paras. (b)(4) and (e) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; heading and para. (a) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; paras. (c) and (d) revised, 71 FR 9260, Feb. 23, 2006, effective Mar. 27, 2006; paras. (c) and (d) revised, 71 FR 44219, Aug. 4, 2006, effective Aug. 4, 2006; para. (f) revised, 72 FR 18892, Apr. 16, 2007, effective May 16, 2007; paras. (a) and (b)(2) revised and para. (b)(6) added, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

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

(a) Within three months following the filing date of a request for an *ex parte* reexamination, an examiner will consider the request and determine whether or not a substantial new question of patentability affecting any claim of the patent is raised by the request and the prior art cited therein, with or without consideration of other patents or printed publications. A statement and any accompanying information submitted pursuant to § 1.501(a)(2) will not be considered by the examiner when making a determination on the request. The examiner's determination will be based on the claims in effect at the time of the determination, will become a part of the official file of the patent, and will be given or mailed to the patent owner at the address provided for in § 1.33(c) and to the person requesting reexamination.

(b) Where no substantial new question of patentability has been found, a refund of a portion of the fee for requesting *ex parte* reexamination will be made to the requester in accordance with § 1.26(c).

(c) The requester may seek review by a petition to the Director under § 1.181 within one month of the mailing date of the examiner's determination refusing *ex parte* reexamination. Any such petition must comply with § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable.

[46 FR 29185, May 29, 1981, effective July 1, 1981; revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (c) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (a) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

§ 1.520 *Ex parte* reexamination at the initiative of the Director.

The Director, at any time during the period of enforceability of a patent, may determine whether or not a substantial new question of patentability is raised by patents or printed publications which have been discovered by the Director or which have been brought to the Director's attention, even though no request for reexamination has been filed in accordance with § 1.510 or § 1.913. The Director may initiate *ex parte* reexamination without a request for reexamination pursuant to § 1.510 or § 1.913. Normally requests from outside the Office that the Director undertake reexamination on his own initiative will not be considered. Any determination to initiate *ex parte* reexamination under this section will become a part of the official file of the patent and will be mailed to the patent owner at the address as provided for in § 1.33(c).

[46 FR 29186, May 29, 1981, effective July 1, 1981; revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

EX PARTE REEXAMINATION

§ 1.525 Order for *ex parte* reexamination.

(a) If a substantial new question of patentability is found pursuant to § 1.515 or § 1.520, the determination will include an order for *ex parte* reexamination of the patent for resolution of the question. If the order for *ex parte* reexamination resulted from a petition pursuant to § 1.515(c), the *ex parte* reexamination will ordinarily be conducted by an examiner other than the examiner responsible for the initial determination under § 1.515(a).

(b) The notice published in the *Official Gazette* under § 1.11(c) will be considered to be constructive notice and *ex parte* reexamination will proceed.

[46 FR 29186, May 29, 1981, effective July 1, 1981; heading and paras. (a) and (b) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.530 Statement by patent owner in *ex parte* reexamination; amendment by patent owner in *ex parte* or *inter partes* reexamination; inventorship change in *ex parte* or *inter partes* reexamination.

(a) Except as provided in § 1.510(e), no statement or other response by the patent owner in an *ex parte* reexamination proceeding shall be filed prior to the determinations made in accordance with § 1.515 or § 1.520. If a premature statement or other response is filed by the patent owner, it will not be acknowledged or considered in making the determination, and it will be returned or discarded (at the Office's option).

(b) The order for *ex parte* reexamination will set a period of not less than two months from the date of the order within which the patent owner may file a statement on the new question of patentability, including any proposed amendments the patent owner wishes to make.

(c) Any statement filed by the patent owner shall clearly point out why the subject matter as claimed is not anticipated or rendered obvious by the prior art patents or printed publications, either alone or in any reasonable combinations. Where the reexamination request was filed by a third party requester, any statement filed by the patent owner must be served upon the *ex parte* reexamination requester in accordance with § 1.248.

(d) *Making amendments in a reexamination proceeding.* A proposed amendment in an *ex parte* or an *inter partes* reexamination proceeding is made by filing a paper directing that proposed specified changes be made to the patent specification, including the claims, or to the drawings. An amendment paper directing that proposed specified changes be made in a reexamination proceeding may be submitted as an accompaniment to a request filed by the patent owner in accordance with § 1.510(e), as part of a patent owner statement in accordance with paragraph (b) of this section, or, where permitted, during the prosecution of the reexamination proceeding pursuant to § 1.550(a) or § 1.937.

(1) *Specification other than the claims.* Changes to the specification, other than to the claims, must be made by submission of the entire text of an added or rewritten paragraph including markings pursuant to paragraph (f) of this section, except that an entire paragraph may be deleted by a statement deleting the paragraph, without presentation of the text of the paragraph. The precise point in the specification must be identified where any added or rewritten paragraph is located. This paragraph applies whether the amendment is submitted on paper or compact disc (*see* §§ 1.96 and 1.825).

(2) *Claims.* An amendment paper must include the entire text of each patent claim which is being proposed to be changed by such amendment paper and of each new claim being proposed to be added by such amendment paper. For any claim changed by the amendment paper, a parenthetical expression "amended," "twice amended," *etc.*, should follow the claim number. Each patent claim proposed to be changed and each proposed added claim must include markings pursuant to paragraph (f) of this section, except that a patent claim or proposed added claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

(3) *Drawings.* Any change to the patent drawings must be submitted as a sketch on a separate paper showing the proposed changes in red for approval by the examiner. Upon approval of the changes by the examiner, only new sheets of

drawings including the changes and in compliance with § 1.84 must be filed. Amended figures must be identified as "Amended," and any added figure must be identified as "New." In the event a figure is canceled, the figure must be surrounded by brackets and identified as "Canceled."

(4) The formal requirements for papers making up the reexamination proceeding other than those set forth in this section are set out in § 1.52.

(e) *Status of claims and support for claim changes.* Whenever there is an amendment to the claims pursuant to paragraph (d) of this section, there must also be supplied, on pages separate from the pages containing the changes, the status (*i.e.*, pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes to the claims made by the amendment paper.

(f) *Changes shown by markings.* Any changes relative to the patent being reexamined which are made to the specification, including the claims, must include the following markings:

(1) The matter to be omitted by the reexamination proceeding must be enclosed in brackets; and

(2) The matter to be added by the reexamination proceeding must be underlined.

(g) *Numbering of patent claims preserved.* Patent claims may not be renumbered. The numbering of any claims added in the reexamination proceeding must follow the number of the highest numbered patent claim.

(h) *Amendment of disclosure may be required.* The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(i) *Amendments made relative to patent.* All amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination.

(j) *No enlargement of claim scope.* No amendment may enlarge the scope of the claims of the patent or introduce new matter. No amendment may be proposed for entry in an expired patent. Moreover, no amendment, other than the cancellation of claims, will be incorporated into the patent by a certificate issued after the expiration of the patent.

(k) *Amendments not effective until certificate.* Although the Office actions will treat proposed amendments as though they have been entered, the proposed amendments will not be effective until the reexamination certificate is issued and published.

(l) *Correction of inventorship in an ex parte or inter partes reexamination proceeding.*

(1) When it appears in a patent being reexamined that the correct inventor or inventors were not named, the Director may, on petition of all the parties set forth in § 1.324(b)(1) and (b)(2), including the assignees, and satisfactory proof of the facts and payment of the fee set forth in § 1.20(b), or on order of a court before which such matter is called in question, include in the reexamination certificate to be issued under § 1.570 or § 1.997 an amendment naming only the actual inventor or inventors. The petition must be submitted as part of the reexamination proceeding and must satisfy the requirements of § 1.324.

(2) Notwithstanding paragraph (l)(1) of this section, if a petition to correct inventorship satisfying the requirements of § 1.324 is filed in a reexamination proceeding, and the reexamination proceeding is concluded other than by a reexamination certificate under § 1.570 or § 1.997, a certificate of correction indicating the change of inventorship stated in the petition will be issued upon request by the patentee.

[46 FR 29186, May 29, 1981, effective July 1, 1981; para. (d) revised, para. (e) removed, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; heading and para. (d) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (e) through (l) added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; heading, paras. (a)-(c), para. (d) introductory text and para. (l) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (l)(1) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; paras. (a), (k), and (l) revised, 72 FR 18892, Apr. 16, 2007, effective May 16, 2007; para. (l)(1) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012]

§ 1.535 Reply by third party requester in *ex parte* reexamination.

A reply to the patent owner's statement under § 1.530 may be filed by the *ex parte* reexamination requester within two months from the date of service of the patent owner's statement. Any reply by the *ex parte* requester must be served upon the patent owner in accordance with § 1.248. If the patent owner does not file a statement under § 1.530, no reply or other submission from the *ex parte* reexamination requester will be considered.

[46 FR 29186, May 29, 1981, effective July 1, 1981; revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.540 Consideration of responses in *ex parte* reexamination.

The failure to timely file or serve the documents set forth in § 1.530 or in § 1.535 may result in their being refused consideration. No submissions other than the statement pursuant to § 1.530 and the reply by the *ex parte* reexamination requester pursuant to § 1.535 will be considered prior to examination.

[46 FR 29186, May 29, 1981, effective July 1, 1981; revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.550 Conduct of *ex parte* reexamination proceedings.

(a) All *ex parte* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office. After issuance of the *ex parte* reexamination order and expiration of the time for submitting any responses, the examination will be conducted in accordance with §§ 1.104 through 1.116 and will result in the issuance of an *ex parte* reexamination certificate under § 1.570.

(b) The patent owner in an *ex parte* reexamination proceeding will be given at least thirty days to respond to any Office action. In response to any rejection, such response may include further statements and/or proposed amendments or new claims to place the patent in a condition where all claims, if amended as proposed, would be patentable.

(c) The time for taking any action by a patent owner in an *ex parte* reexamination proceeding may be extended as provided in this paragraph.

(1) Any request for such an extension must specify the requested period of extension and be accompanied by the petition fee set forth in § 1.17(g).

(2) Any request for an extension in a third party requested *ex parte* reexamination must be filed on or before the day on which action by the patent owner is due, and the mere filing of such a request for extension will not effect the extension. A request for an extension in a third party requested *ex parte* reexamination will not be granted in the absence of sufficient cause or for more than a reasonable time.

(3) Any request for an extension in a patent owner requested or Director ordered *ex parte* reexamination for up to two months from the time period set in the Office action must be filed no later than two months from the expiration of the time period set in the Office action. A request for an extension in a patent owner requested or Director ordered *ex parte* reexamination for more than two months from the time period set in the Office action must be filed on or before the day on which action by the patent owner is due, and the mere filing of a request for an extension for more than two months from the time period set in the Office action will not effect the extension. The time for taking action in a patent owner requested or Director ordered *ex parte* reexamination will not be extended for more than two months from the time period set in the Office action in the absence of sufficient cause or for more than a reasonable time.

(4) The reply or other action must in any event be filed prior to the expiration of the period of extension, but in no situation may a reply or other action be filed later than the maximum time period set by statute.

(5) See § 90.3(c) of this title for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.

(d) If the patent owner fails to file a timely and appropriate response to any Office action or any

written statement of an interview required under § 1.560(b), the prosecution in the *ex parte* reexamination proceeding will be a terminated prosecution, and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.570 in accordance with the last action of the Office.

(e) If a response by the patent owner is not timely filed in the Office, a petition may be filed pursuant to § 1.137 to revive a reexamination prosecution terminated under paragraph (d) of this section if the delay in response was unintentional.

(f) The reexamination requester will be sent copies of Office actions issued during the *ex parte* reexamination proceeding. After filing of a request for *ex parte* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party in the reexamination proceeding in the manner provided by § 1.248. The document must reflect service or the document may be refused consideration by the Office.

(g) The active participation of the *ex parte* reexamination requester ends with the reply pursuant to § 1.535, and no further submissions on behalf of the reexamination requester will be acknowledged or considered. Further, no submissions on behalf of any third parties will be acknowledged or considered unless such submissions are:

(1) in accordance with § 1.510 or § 1.535; or

(2) entered in the patent file prior to the date of the order for *ex parte* reexamination pursuant to § 1.525.

(h) Submissions by third parties, filed after the date of the order for *ex parte* reexamination pursuant to § 1.525, must meet the requirements of and will be treated in accordance with § 1.501(a).

(i) A petition in an *ex parte* reexamination proceeding must be accompanied by the fee set forth in § 1.20(c)(6), except for petitions under paragraph (c) of this section to extend the period for response by a patent owner, petitions under paragraph (e) of this section to accept a delayed response by a patent owner, petitions under § 1.78 to accept an unintentionally delayed benefit claim, and petitions under § 1.530(l) for correction of inventorship in a reexamination proceeding.

[46 FR 29186, May 29, 1981, effective July 1, 1981; para. (c), 49 FR 556, Jan. 4, 1984, effective Apr. 1, 1984; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (c), 54 FR 29553, July 13, 1989, effective Aug. 20, 1989; paras. (a), (b), & (e) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a) and (b) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; paras. (d) & (e)(1) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (c) revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004; para. (d) revised, 72 FR 18892, Apr. 16, 2007, effective May 16, 2007; para. (i) added, 77 FR 48828, Aug. 14, 2012, effective Sept. 16, 2012; paras. (c) and (e) revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013]

§ 1.552 Scope of reexamination in *ex parte* reexamination proceedings.

(a) Claims in an *ex parte* reexamination proceeding will be examined on the basis of patents or printed publications and, with respect to subject matter added or deleted in the reexamination proceeding, on the basis of the requirements of 35 U.S.C. 112.

(b) Claims in an *ex parte* reexamination proceeding will not be permitted to enlarge the scope of the claims of the patent.

(c) Issues other than those indicated in paragraphs (a) and (b) of this section will not be resolved in a reexamination proceeding. If such issues are raised by the patent owner or third party requester during a reexamination proceeding, the existence of such issues will be noted by the examiner in the next Office action, in which case the patent owner may consider the advisability of filing a reissue application to have such issues considered and resolved.

(d) Any statement of the patent owner and any accompanying information submitted pursuant to § 1.501(a)(2) which is of record in the patent being reexamined (which includes any reexamination files for the patent) may be used after a reexamination proceeding has been ordered to determine the proper meaning of a patent claim when applying patents or printed publications.

[46 FR 29186, May 29, 1981, effective July 1, 1981; revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (d) added, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

§ 1.555 Information material to patentability in *ex parte* reexamination and *inter partes* reexamination proceedings.

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective reexamination occurs when, at the time a reexamination proceeding is being conducted, the Office is aware of and evaluates the teachings of all information material to patentability in a reexamination proceeding. Each individual associated with the patent owner in a reexamination proceeding has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability in a reexamination proceeding. The individuals who have a duty to disclose to the Office all information known to them to be material to patentability in a reexamination proceeding are the patent owner, each attorney or agent who represents the patent owner, and every other individual who is substantively involved on behalf of the patent owner in a reexamination proceeding. The duty to disclose the information exists with respect to each claim pending in the reexamination proceeding until the claim is cancelled. Information material to the patentability of a cancelled claim need not be submitted if the information is not material to patentability of any claim remaining under consideration in the reexamination proceeding. The duty to disclose all information known to be material to patentability in a reexamination proceeding is deemed to be satisfied if all information known to be material to patentability of any claim in the patent after issuance of the reexamination certificate was cited by the Office or submitted to the Office in an information disclosure statement. However, the duties of candor, good faith, and disclosure have not been complied with if any fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct by, or on behalf of, the patent owner in the reexamination proceeding. Any information disclosure statement must be filed with the items listed in § 1.98(a) as applied to individuals associated with the patent owner in a reexamination proceeding, and should be filed within two months of the date of the order for reexamination, or as soon thereafter as possible.

(b) Under this section, information is material to patentability in a reexamination proceeding when it is not cumulative to information of record or being made of record in the reexamination proceeding, and

(1) It is a patent or printed publication that establishes, by itself or in combination with other patents or printed publications, a *prima facie* case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the patent owner takes in:

(i) Opposing an argument of unpatentability relied on by the Office, or

(ii) Asserting an argument of patentability.

A *prima facie* case of unpatentability of a claim pending in a reexamination proceeding is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

(c) The responsibility for compliance with this section rests upon the individuals designated in paragraph (a) of this section and no evaluation will be made by the Office in the reexamination proceeding as to compliance with this section. If questions of compliance with this section are raised by the patent owner or the third party requester during a reexamination proceeding, they will be noted as unresolved questions in accordance with § 1.552(c).

[46 FR 29187, May 29, 1981, effective July 1, 1981; 47 FR 21752, May 19, 1982, effective July 1, 1982; paras. (a) and (b), 49 FR 556, Jan. 4, 1984, effective Apr. 1, 1984; revised 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; heading and para. (c) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.560 Interviews in *ex parte* reexamination proceedings.

(a) Interviews in *ex parte* reexamination proceedings pending before the Office between examiners and the owners of such patents or their

attorneys or agents of record must be conducted in the Office at such times, within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director. Interviews for the discussion of the patentability of claims in patents involved in *ex parte* reexamination proceedings will not be conducted prior to the first official action. Interviews should be arranged in advance. Requests that reexamination requesters participate in interviews with examiners will not be granted.

(b) In every instance of an interview with an examiner in an *ex parte* reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner. An interview does not remove the necessity for response to Office actions as specified in § 1.111. Patent owner's response to an outstanding Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.

[46 FR 29187, May 29, 1981, effective July 1, 1981; revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

§ 1.565 Concurrent office proceedings which include an *ex parte* reexamination proceeding.

(a) In an *ex parte* reexamination proceeding before the Office, the patent owner must inform the Office of any prior or concurrent proceedings in which the patent is or was involved such as interferences, reissues, *ex parte* reexaminations, *inter partes* reexaminations, or litigation and the results of such proceedings. See § 1.985 for notification of prior or concurrent proceedings in an *inter partes* reexamination proceeding.

(b) If a patent in the process of *ex parte* reexamination is or becomes involved in litigation, the Director shall determine whether or not to suspend the reexamination. See § 1.987 for *inter partes* reexamination proceedings.

(c) If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination proceeding has not been terminated, the *ex parte* reexamination proceedings will usually be merged and result in the issuance and publication of a single certificate under § 1.570. For merger of *inter partes* reexamination proceedings, see § 1.989(a). For merger of *ex parte* reexamination and *inter partes* reexamination proceedings, see § 1.989(b).

(d) If a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will usually be made to merge the two proceedings or to suspend one of the two proceedings. Where merger of a reissue application and an *ex parte* reexamination proceeding is ordered, the merged examination 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 *ex parte* reexamination proceeding during the pendency of the merged proceeding. The examiner's actions and responses by the patent owner in a merged proceeding will apply to both the reissue application and the *ex parte* reexamination proceeding and will be physically entered into both files. Any *ex parte* reexamination proceeding merged with a reissue application shall be concluded by the grant of the reissued patent. For merger of a reissue application and an *inter partes* reexamination, see § 1.991.

(e) If a patent in the process of *ex parte* reexamination is or becomes involved in an interference, the Director may suspend the reexamination or the interference. The Director will not consider a request to suspend an interference unless a motion (§ 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. For concurrent *inter partes* reexamination and interference of a patent, see § 1.993.

[46 FR 29187, May 29, 1981, effective July 1, 1981; paras. (b) and (d), 47 FR 21753, May 19, 1982, effective July 1, 1982; paras. (b) & (e), 49 FR 48416,

Dec. 12, 1984, 50 FR 23123, May 31, 1985, effective Feb. 11, 1985; para (a) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; paras. (b) & (e) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (e) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; paras. (c) and (d) revised, 72 FR 18892, Apr. 16, 2007, effective May 16, 2007]

CERTIFICATE

§ 1.570 Issuance and publication of *ex parte* reexamination certificate concludes *ex parte* reexamination proceeding.

(a) To conclude an *ex parte* reexamination proceeding, the Director will issue and publish an *ex parte* reexamination certificate in accordance with 35 U.S.C. 307 setting forth the results of the *ex parte* reexamination proceeding and the content of the patent following the *ex parte* reexamination proceeding.

(b) An *ex parte* reexamination certificate will be issued and published in each patent in which an *ex parte* reexamination proceeding has been ordered under § 1.525 and has not been merged with any *inter partes* reexamination proceeding pursuant to § 1.989(a). Any statutory disclaimer filed by the patent owner will be made part of the *ex parte* reexamination certificate.

(c) The *ex parte* reexamination certificate will be mailed on the day of its date to the patent owner at the address as provided for in § 1.33(c). A copy of the *ex parte* reexamination certificate will also be mailed to the requester of the *ex parte* reexamination proceeding.

(d) If an *ex parte* reexamination certificate has been issued and published 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 *ex parte* reexamination proceeding is terminated by the grant of a reissued patent as provided in § 1.565(d), the reissued patent will constitute the *ex parte* reexamination certificate required by this section and 35 U.S.C. 307.

(f) A notice of the issuance of each *ex parte* reexamination certificate under this section will be published in the *Official Gazette* on its date of issuance.

[46 FR 29187, May 29, 1981, effective July 1, 1981; para. (e), 47 FR 21753, May 19, 1982, effective July 1, 1982; revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; heading and paras. (a), (b), and (d) revised, 72 FR 18892, Apr. 16, 2007, effective May 16, 2007]

Subpart E — Supplemental Examination of Patents

§ 1.601 Filing of papers in supplemental examination.

(a) A request for supplemental examination of a patent must be filed by the owner(s) of the entire right, title, and interest in the patent.

(b) Any party other than the patent owner (*i.e.*, any third party) is prohibited from filing papers or otherwise participating in any manner in a supplemental examination proceeding.

(c) A request for supplemental examination of a patent may be filed at any time during the period of enforceability of the patent.

[Added, 77 FR 48828, Aug. 14, 2012, effective Sept. 16, 2012]

§ 1.605 Items of information.

(a) Each request for supplemental examination may include no more than twelve items of information believed to be relevant to the patent. More than one request for supplemental examination of the same patent may be filed at any time during the period of enforceability of the patent.

(b) An item of information includes a document submitted as part of the request that contains information, believed to be relevant to the patent, that the patent owner requests the Office to consider, reconsider, or correct. If the information to be considered, reconsidered, or corrected is not, at least in part, contained within or based on any document submitted as part of the request, the discussion within the body of the request relative to the information will be considered as an item of information.

(c) An item of information must be in writing in accordance with § 1.2. To be considered, any audio or video recording must be submitted in the form of a written transcript.

(d) If one item of information is combined in the request with one or more additional items of information, each item of information of the combination may be separately counted. Exceptions include the combination of a non-English language document and its translation, and the combination of a document that is over 50 pages in length and its summary pursuant to § 1.610(b)(8).

[Added, 77 FR 48828, Aug. 14, 2012, effective Sept. 16, 2012]

§ 1.610 Content of request for supplemental examination.

(a) A request for supplemental examination must be accompanied by the fee for filing a request for supplemental examination as set forth in § 1.20(k)(1), the fee for reexamination ordered as a result of a supplemental examination proceeding as set forth in § 1.20(k)(2), and any applicable document size fees as set forth in § 1.20(k)(3).

(b) A request for supplemental examination must include:

(1) An identification of the number of the patent for which supplemental examination is requested.

(2) A list of the items of information that are requested to be considered, reconsidered, or corrected. Where appropriate, the list must meet the requirements of § 1.98(b).

(3) A list identifying any other prior or concurrent post-patent Office proceedings involving the patent for which supplemental examination is being requested, including an identification of the type of proceeding, the identifying number of any such proceeding (*e.g.*, a control number or reissue application number), and the filing date of any such proceeding.

(4) An identification of each claim of the patent for which supplemental examination is requested.

(5) A separate, detailed explanation of the relevance and manner of applying each item of information to each claim of the patent for which supplemental examination is requested.

(6) A copy of the patent for which supplemental examination is requested and a copy of any disclaimer or certificate issued for the patent.

(7) A copy of each item of information listed in paragraph (b)(2) of this section, accompanied by a written English translation of all of the necessary and pertinent parts of any non-English language item of information. The patent owner is not required to submit copies of items of information that form part of the discussion within the body of the request as specified in § 1.605(b), or copies of U.S. patents and U.S. patent application publications.

(8) A summary of the relevant portions of any submitted document, other than the request, that is over 50 pages in length. The summary must include citations to the particular pages containing the relevant portions.

(9) An identification of the owner(s) of the entire right, title, and interest in the patent requested to be examined, and a submission by the patent owner in compliance with § 3.73(c) of this chapter establishing the entirety of the ownership in the patent requested to be examined.

(c) The request may also include:

(1) A cover sheet itemizing each component submitted as part of the request;

(2) A table of contents for the request;

(3) An explanation of how the claims patentably distinguish over the items of information; and

(4) An explanation of why each item of information submitted with the request does or does not raise a substantial new question of patentability.

(d) The filing date of a request for supplemental examination will not be granted if the request is not in compliance with §§ 1.605, 1.615, and this section, subject to the discretion of the Office. If the Office determines that the request, as originally submitted, is not entitled to a filing date, the patent owner will be so notified and will be given an opportunity to complete the request within a specified time. If the patent owner does not timely comply with the notice, the request for supplemental examination will not be granted a filing date and the fee for reexamination

as set forth in § 1.20(k)(2) will be refunded. If the patent owner timely files a corrected request in response to the notice that properly addresses all of the defects set forth in the notice and that otherwise complies with all of the requirements of §§ 1.605, 1.615, and this section, the filing date of the supplemental examination request will be the receipt date of the corrected request.

[Added, 77 FR 48828, Aug. 14, 2012, effective Sept. 16, 2012]

§ 1.615 Format of papers filed in a supplemental examination proceeding.

(a) All papers submitted in a supplemental examination proceeding must be formatted in accordance with § 1.52.

(b) Court documents and non-patent literature may be redacted, but must otherwise be identical both in content and in format to the original documents, and, if a court document, to the document submitted in court, and must not otherwise be reduced in size or modified, particularly in terms of font type, font size, line spacing, and margins. Patents, patent application publications, and third-party-generated affidavits or declarations must not be reduced in size or otherwise modified in the manner described in this paragraph.

[Added, 77 FR 48828, Aug. 14, 2012, effective Sept. 16, 2012]

§ 1.620 Conduct of supplemental examination proceeding.

(a) Within three months after the filing date of a request for supplemental examination, the Office will determine whether a substantial new question of patentability affecting any claim of the patent is raised by any of the items of information presented in the request. The determination will generally be limited to a review of the item(s) of information identified in the request as applied to the identified claim(s) of the patent. The determination will be based on the claims in effect at the time of the determination and will become a part of the official record of the patent.

(b) The Office may hold in abeyance action on any petition or other paper filed in a supplemental examination proceeding until after the proceeding is concluded by the electronic issuance of the supplemental examination certificate as set forth in § 1.625.

(c) If an unauthorized or otherwise improper paper is filed in a supplemental examination proceeding, it will not be entered into the official file or considered, or if inadvertently entered, it will be expunged.

(d) The patent owner must, as soon as possible upon the discovery of any other prior or concurrent post-patent Office proceeding involving the patent for which the current supplemental examination is requested, file a paper limited to notifying the Office of the post-patent Office proceeding, if such notice has not been previously provided with the request. The notice shall be limited to an identification of the post-patent Office proceeding, including the type of proceeding, the identifying number of any such proceeding (*e.g.*, a control number or reissue application number), and the filing date of any such proceeding, without any discussion of the issues of the current supplemental examination proceeding or of the identified post-patent Office proceeding(s).

(e) Interviews are prohibited in a supplemental examination proceeding.

(f) No amendment may be filed in a supplemental examination proceeding.

(g) If the Office becomes aware, during the course of supplemental examination or of any reexamination ordered under 35 U.S.C. 257 as a result of the supplemental examination proceeding, that a material fraud on the Office may have been committed in connection with the patent requested to be examined, the supplemental examination proceeding or any reexamination proceeding ordered under 35 U.S.C. 257 will continue, and the matter will be referred to the U.S. Attorney General in accordance with 35 U.S.C. 257(e).

[Added, 77 FR 48828, Aug. 14, 2012, effective Sept. 16, 2012]

§ 1.625 Conclusion of supplemental examination; publication of supplemental examination certificate; procedure after conclusion.

(a) A supplemental examination proceeding will conclude with the electronic issuance of a supplemental examination certificate. The supplemental examination certificate will indicate

the result of the determination whether any of the items of information presented in the request raised a substantial new question of patentability.

(b) If the supplemental examination certificate states that a substantial new question of patentability is raised by one or more items of information in the request, *ex parte* reexamination of the patent will be ordered under 35 U.S.C. 257. Upon the conclusion of the *ex parte* reexamination proceeding, an *ex parte* reexamination certificate, which will include a statement specifying that *ex parte* reexamination was ordered under 35 U.S.C. 257, will be published. The electronically issued supplemental examination certificate will remain as part of the public record of the patent.

(c) If the supplemental examination certificate indicates that no substantial new question of patentability is raised by any of the items of information in the request, and *ex parte* reexamination is not ordered under 35 U.S.C. 257, the electronically issued supplemental examination certificate will be published in due course. The fee for reexamination ordered as a result of supplemental examination, as set forth in § 1.20(k)(2), will be refunded in accordance with § 1.26(c).

(d) Any *ex parte* reexamination ordered under 35 U.S.C. 257 will be conducted in accordance with §§ 1.530 through 1.570, which govern *ex parte* reexamination, except that:

(1) The patent owner will not have the right to file a statement pursuant to § 1.530, and the order will not set a time period within which to file such a statement;

(2) Reexamination of any claim of the patent may be conducted on the basis of any item of information as set forth in § 1.605, and is not limited to patents and printed publications or to subject matter that has been added or deleted during the reexamination proceeding, notwithstanding § 1.552(a);

(3) Issues in addition to those raised by patents and printed publications, and by subject matter added or deleted during a reexamination proceeding, may be considered and resolved, notwithstanding § 1.552(c); and

(4) Information material to patentability will be defined by § 1.56(b), notwithstanding § 1.555(b).

[Added, 77 FR 48828, Aug. 14, 2012, effective Sept. 16, 2012]

Subpart F — Adjustment and Extension of Patent Term

ADJUSTMENT OF PATENT TERM DUE TO EXAMINATION DELAY

§ 1.701 Extension of patent term due to examination delay under the Uruguay Round Agreements Act (original applications, other than designs, filed on or after June 8, 1995, and before May 29, 2000).

(a) A patent, other than for designs, issued on an application filed on or after June 8, 1995, is entitled to extension of the patent term if the issuance of the patent was delayed due to:

(1) Interference or derivation proceedings under 35 U.S.C. 135(a); and/or

(2) The application being placed under a secrecy order under 35 U.S.C. 181; and/or

(3) Appellate review by the Patent Trial and Appeal Board or by a Federal court under 35 U.S.C. 141 or 145, if the patent was issued pursuant to a decision in the review reversing an adverse determination of patentability and if the patent is not subject to a terminal disclaimer due to the issuance of another patent claiming subject matter that is not patentably distinct from that under appellate review. If an application is remanded by a panel of the Patent Trial and Appeal Board and the remand is the last action by a panel of the Patent Trial and Appeal Board prior to the mailing of a notice of allowance under 35 U.S.C. 151 in the application, the remand shall be considered a decision in the review reversing an adverse determination of patentability as that phrase is used in 35 U.S.C. 154(b)(2) as amended by section 532(a) of the Uruguay Round Agreements Act, Public Law 103–465, 108 Stat. 4809, 4983–85 (1994), and a final decision in favor of the applicant under paragraph (c)(3) of this section. A remand by a panel of the Patent Trial and Appeal Board shall not be considered a decision in the review reversing an adverse determination of patentability as provided in this paragraph if there is filed a request for continued examination under 35 U.S.C. 132(b) that

was not first preceded by the mailing, after such remand, of at least one of an action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151.

(b) The term of a patent entitled to extension under paragraph (a) of this section shall be extended for the sum of the periods of delay calculated under paragraphs (c)(1), (c)(2), (c)(3) and (d) of this section, to the extent that these periods are not overlapping, up to a maximum of five years. The extension will run from the expiration date of the patent.

(c)(1) The period of delay under paragraph (a)(1) of this section for an application is the sum of the following periods, to the extent that the periods are not overlapping:

(i) With respect to each interference or derivation proceeding in which the application was involved, the number of days, if any, in the period beginning on the date the interference or derivation proceeding was instituted to involve the application in the interference or derivation proceeding and ending on the date that the interference or derivation proceeding was terminated with respect to the application; and

(ii) The number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Patent and Trademark Office due to interference or derivation proceedings under 35 U.S.C. 135(a) not involving the application and ending on the date of the termination of the suspension.

(2) The period of delay under paragraph (a)(2) of this section for an application is the sum of the following periods, to the extent that the periods are not overlapping:

(i) The number of days, if any, the application was maintained in a sealed condition under 35 U.S.C. 181;

(ii) The number of days, if any, in the period beginning on the date of mailing of an examiner's answer under § 41.39 of this title in the application under secrecy order and ending on the date the secrecy order and any renewal thereof was removed;

(iii) The number of days, if any, in the period beginning on the date applicant was notified that an interference or derivation proceeding would be instituted but for the secrecy order and ending on the date the secrecy order and any renewal thereof was removed; and

(iv) The number of days, if any, in the period beginning on the date of notification under § 5.3(c) and ending on the date of mailing of the notice of allowance under § 1.311.

(3) The period of delay under paragraph (a)(3) of this section is the sum of the number of days, if any, in the period beginning on the date on which an appeal to the Patent Trial and Appeal Board was filed under 35 U.S.C. 134 and ending on the date of a final decision in favor of the applicant by the Patent Trial and Appeal Board or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145.

(d) The period of delay set forth in paragraph (c)(3) shall be reduced by:

(1) Any time during the period of appellate review that occurred before three years from the filing date of the first national application for patent presented for examination; and

(2) Any time during the period of appellate review, as determined by the Director, during which the applicant for patent did not act with due diligence. In determining the due diligence of an applicant, the Director may examine the facts and circumstances of the applicant's actions during the period of appellate review to determine whether the applicant exhibited that degree of timeliness as may reasonably be expected from, and which is ordinarily exercised by, a person during a period of appellate review.

(e) The provisions of this section apply only to original patents, except for design patents, issued on applications filed on or after June 8, 1995, and before May 29, 2000.

[Added, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; para. (e) added, 65 FR 56366, Sept. 18, 2000, effective Oct. 18, 2000; para. (d)(2) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (a)(3) revised, 69 FR 21704, Apr. 22, 2004, effective May 24, 2004; para. (c)(2)(ii) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; paras. (a)(1), (a)(3), (c)(1)(i)-(ii), (c)(2)(iii), and (c)(3) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

§ 1.702 Grounds for adjustment of patent term due to examination delay under the

Patent Term Guarantee Act of 1999 (original applications, other than designs, filed on or after May 29, 2000).

[Editor Note: Applies to any patent granted on or after January 14, 2013*]

(a) *Failure to take certain actions within specified time frames.* Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or the date the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application;

(2) Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken;

(3) Act on an application not later than four months after the date of a decision by the Patent Trial and Appeal Board under 35 U.S.C. 134 or 135 or a decision by a Federal court under 35 U.S.C. 141, 145, or 146 where at least one allowable claim remains in the application; or

(4) Issue a patent not later than four months after the date on which the issue fee was paid under 35 U.S.C. 151 and all outstanding requirements were satisfied.

(b) *Three-year pendency.* Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, but not including:

(1) Any time consumed by continued examination of the application under 35 U.S.C. 132(b);

(2) Any time consumed by an interference or derivation proceeding under 35 U.S.C. 135(a);

(3) Any time consumed by the imposition of a secrecy order under 35 U.S.C. 181;

(4) Any time consumed by review by the Patent Trial and Appeal Board or a Federal court; or

(5) Any delay in the processing of the application by the Office that was requested by the applicant.

(c) *Delays caused by interference and derivation proceedings.* Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to interference or derivation proceedings under 35 U.S.C. 135(a).

(d) *Delays caused by secrecy order.* Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the application being placed under a secrecy order under 35 U.S.C. 181.

(e) *Delays caused by successful appellate review.* Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to review by the Patent Trial and Appeal Board under 35 U.S.C. 134 or by a Federal court under 35 U.S.C. 141 or 145, if the patent was issued under a decision in the review reversing an adverse determination of patentability. If an application is remanded by a panel of the Patent Trial and Appeal Board and the remand is the last action by a panel of the Patent Trial and Appeal Board prior to the mailing of a notice of allowance under 35 U.S.C. 151 in the application, the remand shall be considered a decision by the Patent Trial and Appeal Board as that phrase is used in 35 U.S.C. 154(b)(1)(A)(iii), a decision in the review reversing an adverse determination of patentability as that phrase is used in 35 U.S.C. 154(b)(1)(C)(iii), and a final decision in favor of the applicant under § 1.703(e). A remand by a panel of the Patent Trial and Appeal Board shall not be considered a decision in the review reversing an adverse determination of patentability as provided in this paragraph if there is filed a request for continued examination under 35 U.S.C. 132(b) that was not first preceded by the mailing, after such remand, of at least one of an action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151.

(f) The provisions of this section and §§ 1.703 through 1.705 apply only to original applications, except applications for a design patent, filed on or after May 29, 2000, and patents issued on such applications.

[Added, 65 FR 56366, Sept. 18, 2000, effective Oct. 18, 2000; para. (e) revised, 69 FR 21704, Apr. 22, 2004, effective May 24, 2004; paras. (a)(3), (b)(2), (b)(4), (c), and (e) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012; para. (a)(1) and para. (b) heading revised, 78 FR 19416, Apr. 1, 2013, effective Apr. 1, 2013 (adopted as final, 79 FR 27755, May 15, 2014)]

[*The changes to para. (a)(1) and the heading of para. (b) effective Apr. 1, 2013 apply to any patent granted on or after Jan. 14, 2013]

§ 1.702 (pre-2013-04-01) Grounds for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999 (original applications, other than designs, filed on or after May 29, 2000).

[Editor Note: Not applicable to patents granted on or after January 14, 2013*]

(a) *Failure to take certain actions within specified time frames.* Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application;

(2) Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken;

(3) Act on an application not later than four months after the date of a decision by the Patent Trial and Appeal Board under 35 U.S.C. 134 or 135 or a decision by a Federal court under 35 U.S.C. 141, 145, or 146 where at least one allowable claim remains in the application; or

(4) Issue a patent not later than four months after the date on which the issue fee was paid under 35 U.S.C. 151 and all outstanding requirements were satisfied.

(b) *Failure to issue a patent within three years of the actual filing date of the application.* Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, but not including:

(1) Any time consumed by continued examination of the application under 35 U.S.C. 132(b);

(2) Any time consumed by an interference or derivation proceeding under 35 U.S.C. 135(a);

(3) Any time consumed by the imposition of a secrecy order under 35 U.S.C. 181;

(4) Any time consumed by review by the Patent Trial and Appeal Board or a Federal court; or

(5) Any delay in the processing of the application by the Office that was requested by the applicant.

(c) *Delays caused by interference and derivation proceedings.* Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to interference or derivation proceedings under 35 U.S.C. 135(a).

(d) *Delays caused by secrecy order.* Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the application being placed under a secrecy order under 35 U.S.C. 181.

(e) *Delays caused by successful appellate review.* Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to review by the Patent Trial and Appeal Board under 35 U.S.C. 134 or by a Federal court under 35 U.S.C. 141 or 145, if the patent was issued under a decision in the review reversing an adverse determination of patentability. If an application is remanded by a panel of the Patent

Trial and Appeal Board and the remand is the last action by a panel of the Patent Trial and Appeal Board prior to the mailing of a notice of allowance under 35 U.S.C. 151 in the application, the remand shall be considered a decision by the Patent Trial and Appeal Board as that phrase is used in 35 U.S.C. 154(b)(1)(A)(iii), a decision in the review reversing an adverse determination of patentability as that phrase is used in 35 U.S.C. 154(b)(1)(C)(iii), and a final decision in favor of the applicant under § 1.703(e). A remand by a panel of the Patent Trial and Appeal Board shall not be considered a decision in the review reversing an adverse determination of patentability as provided in this paragraph if there is filed a request for continued examination under 35 U.S.C. 132(b) that was not first preceded by the mailing, after such remand, of at least one of an action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151.

(f) The provisions of this section and §§ 1.703 through 1.705 apply only to original applications, except applications for a design patent, filed on or after May 29, 2000, and patents issued on such applications.

[Added, 65 FR 56366, Sept. 18, 2000, effective Oct. 18, 2000; para. (e) revised, 69 FR 21704, Apr. 22, 2004, effective May 24, 2004; paras. (a)(3), (b)(2), (b)(4), (c), and (e) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

[*See § 1.702 for more recent history and the rule applicable to patents granted on or after January 14, 2013]

§ 1.703 Period of adjustment of patent term due to examination delay.

[Editor Note: Para. (a)(1) below includes amendments applicable only to patents granted on or after January 14, 2013 and paras. (b)(4) and (e) below include amendments applicable only to applications and patents in which a notice of allowance issued on or after September 17, 2012*]

(a) The period of adjustment under § 1.702(a) is the sum of the following periods:

(1) The number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or the date the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

(2) The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was filed and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

(3) The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply in compliance with § 1.113(c) was filed and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

(4) The number of days, if any, in the period beginning on the day after the date that is four months after the date an appeal brief in compliance with § 41.37 of this title was filed and ending on the date of mailing of any of an examiner's answer under § 41.39 of this title, an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

(5) The number of days, if any, in the period beginning on the day after the date that is four months after the date of a final decision by the Patent Trial and Appeal Board or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145 or 146 where at least one allowable claim remains in the application and ending on the date of mailing of either an action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151, whichever occurs first; and

(6) The number of days, if any, in the period beginning on the day after the date that is four months after the date the issue fee was paid and all outstanding requirements were satisfied and ending on the date a patent was issued.

(b) The period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the sum of the following periods:

(1) The number of days, if any, in the period beginning on the date on which any request for continued examination of the application under 35 U.S.C. 132(b) was filed and ending on the date of mailing of the notice of allowance under 35 U.S.C. 151;

(2)(i) The number of days, if any, in the period beginning on the date an interference or derivation proceeding was instituted to involve the application in the interference or derivation proceeding under 35 U.S.C. 135(a) and ending on the date that the interference or derivation proceeding was terminated with respect to the application; and

(ii) The number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Office due to interference or derivation proceedings under 35 U.S.C. 135(a) not involving the application and ending on the date of the termination of the suspension;

(3)(i) The number of days, if any, the application was maintained in a sealed condition under 35 U.S.C. 181;

(ii) The number of days, if any, in the period beginning on the date of mailing of an examiner's answer under § 41.39 of this title in the application under secrecy order and ending on the date the secrecy order was removed;

(iii) The number of days, if any, in the period beginning on the date applicant was notified that an interference or derivation proceeding under 35 U.S.C. 135(a) would be instituted but for the secrecy order and ending on the date the secrecy order was removed; and

(iv) The number of days, if any, in the period beginning on the date of notification under § 5.3(c) of this chapter and ending on the date of mailing of the notice of allowance under 35 U.S.C. 151; and,

(4) The number of days, if any, in the period beginning on the date on which jurisdiction over the application passes to the Patent Trial and Appeal Board under § 41.35(a) of this chapter and ending on the date that jurisdiction by the Patent Trial and Appeal Board ends under § 41.35(b) of this chapter or the date of the last decision by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145, whichever is later.

(c) The period of adjustment under § 1.702(c) is the sum of the following periods, to the extent that the periods are not overlapping:

(1) The number of days, if any, in the period beginning on the date an interference or derivation proceeding was instituted to involve the application in the interference or derivation proceeding under 35 U.S.C. 135(a) and ending on the date that the interference or derivation proceeding was terminated with respect to the application; and

(2) The number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Office due to interference or derivation proceedings under 35 U.S.C. 135(a) not involving the application and ending on the date of the termination of the suspension.

(d) The period of adjustment under § 1.702(d) is the sum of the following periods, to the extent that the periods are not overlapping:

(1) The number of days, if any, the application was maintained in a sealed condition under 35 U.S.C. 181;

(2) The number of days, if any, in the period beginning on the date of mailing of an examiner's answer under § 41.39 of this title in the application under secrecy order and ending on the date the secrecy order was removed;

(3) The number of days, if any, in the period beginning on the date applicant was notified that an interference or derivation proceeding under 35 U.S.C. 135(a) would be instituted but for the secrecy order and ending on the date the secrecy order was removed; and

(4) The number of days, if any, in the period beginning on the date of notification under § 5.3(c) of this chapter and ending on the date of mailing of the notice of allowance under 35 U.S.C. 151.

(e) The period of adjustment under § 1.702(e) is the sum of the number of days, if any, in the period beginning on the date on which jurisdiction over the application passes to the Patent Trial and Appeal Board under § 41.35(a) of this chapter and ending on the date of a final decision in favor of the applicant by the Patent Trial and Appeal Board or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145.

(f) The adjustment will run from the expiration date of the patent as set forth in 35 U.S.C. 154(a)(2). To the extent that periods of delay attributable to the grounds specified in § 1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed. The term of a patent entitled to adjustment under § 1.702 and this section shall be adjusted for the sum of the periods calculated under paragraphs (a) through (e) of this section, to the extent that such periods are not overlapping, less the sum of the periods calculated under § 1.704. The date indicated on any certificate of mailing or transmission under § 1.8 shall not be taken into account in this calculation.

(g) No patent, the term of which has been disclaimed beyond a specified date, shall be adjusted under § 1.702 and this section beyond the expiration date specified in the disclaimer.

[Added, 65 FR 56366, Sept. 18, 2000, effective Oct. 18, 2000; para. (f) revised, 69 FR 21704, Apr. 22, 2004, effective May 24, 2004; paras. (a)(4), (b)(3)(ii), (b)(4), (d)(2), and (e) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; paras. (a)(5), (b)(2), (b)(3)(iii), (c)(1)-(2) and (d)(3) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012; paras. (b)(4) and (e) revised, 77 FR 49354, Aug. 16, 2012, effective Sept. 17, 2012; para. (a)(1) revised, 78 FR 19416, Apr. 1, 2013, effective Apr. 1, 2013 (adopted as final, 79 FR 27755, May 15, 2014); para. (b)(1) revised, 80 FR 1346, Jan. 9, 2015, effective Jan. 9, 2015]

[*The changes to para. (a)(1) effective Apr. 1, 2013 are applicable to any patent granted on or after Jan. 14, 2013. See § 1.703 (2012-09-17 thru 2013-03-31) for para. (a)(1) applicable to patents granted before Jan. 14, 2013. The changes to paras. (b)(4) and (e) effective Sept. 17, 2012 are applicable to any application in which a notice of allowance was issued on or after Sept. 17, 2012, and any patent issuing thereon. See § 1.703 (pre-2012-09-17) for paras. (b)(4) and (e) that apply if the notice of allowance was issued before Sept. 17, 2012.]

§ 1.703 (2012-09-17 thru 2013-03-31) Period of adjustment of patent term due to examination delay.

[Editor Note: The paragraphs below include amendments applicable only to applications and patents in which a notice of allowance issued on or after September 17, 2012*]

(a) The period of adjustment under § 1.702(a) is the sum of the following periods:

(1) The number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

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(b) The period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the sum of the following periods:

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(4) The number of days, if any, in the period beginning on the date on which jurisdiction over the application passes to the Patent Trial and Appeal Board under § 41.35(a) of this chapter and ending on the date that jurisdiction by the Patent Trial and Appeal Board ends under § 41.35(b) of this chapter or the date of the last decision by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145, whichever is later.

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[Added, 65 FR 56366, Sept. 18, 2000, effective Oct. 18, 2000; para. (f) revised, 69 FR 21704, Apr. 22, 2004, effective May 24, 2004; paras. (a)(4), (b)(3)(ii), (b)(4), (d)(2), and (e) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; paras. (a)(5), (b)(2), (b)(3)(iii), (c)(1)-(2) and (d)(3) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012; paras. (b)(4) and (e) revised, 77 FR 49354, Aug. 16, 2012, effective Sept. 17, 2012]

[*The changes to paras. (b)(4) and (e) effective Sept. 17, 2012 are applicable to any application in which a notice of allowance was issued on or after Sept. 17, 2012, and any patent issuing thereon. See § 1.703 (pre-2012-09-17) for paras. (b)(4) and (e) otherwise in effect.]

§ 1.703 (pre-2012-09-17) Period of adjustment of patent term due to examination delay.

[Editor Note: The paragraphs below are not applicable to applications and patents in which a notice of allowance was issued on or after September 17, 2012 or a patent was granted on or after January 14, 2013*]

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(b) The period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the sum of the following periods:

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(4) The number of days, if any, in the period beginning on the date on which a notice of appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and § 41.31 of this title and ending on the date of the last decision by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145, or on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first, if the appeal did not result in a decision by the Board of Patent Appeals and Interferences.

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[Added, 65 FR 56366, Sept. 18, 2000, effective Oct. 18, 2000; para. (f) revised, 69 FR 21704, Apr. 22, 2004, effective May 24, 2004; paras. (a)(4), (b)(3)(ii), (b)(4), (d)(2), and (e) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; paras. (a)(5), (b)(2), (b)(3)(iii), (c)(1)-(2) and (d)(3) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

[*See § 1.703 for para. (a)(1) applicable to patents granted on or after Jan. 14, 2013 and paras. (b)(4) and (e) applicable if a notice of allowance was issued on or after Sept. 17, 2012]

§ 1.704 Reduction of period of adjustment of patent term.

[Editor Note: Some paragraphs have limited applicability. See * below for details.]

(a) The period of adjustment of the term of a patent under §§ 1.703(a) through (e) shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution (processing or examination) of the application.

(b) With respect to the grounds for adjustment set forth in §§ 1.702(a) through (e), and in particular the ground of adjustment set forth in § 1.702(b), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

(c) Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

(1) Suspension of action under § 1.103 at the applicant's request, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the date a request for suspension of action under § 1.103 was filed and ending on the date of the termination of the suspension;

(2) Deferral of issuance of a patent under § 1.314, in which case the period of adjustment set

forth in § 1.703 shall be reduced by the number of days, if any, beginning on the date a request for deferral of issuance of a patent under § 1.314 was filed and ending on the earlier of the date a request to terminate the deferral was filed or the date the patent was issued;

(3) Abandonment of the application or late payment of the issue fee, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the date of abandonment or the day after the date the issue fee was due and ending on the date the grantable petition to revive the application or accept late payment of the issue fee was filed;

(4) Failure to file a petition to withdraw the holding of abandonment or to revive an application within two months from the date of mailing of a notice of abandonment, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date two months from the date of mailing of a notice of abandonment and ending on the date a petition to withdraw the holding of abandonment or to revive the application was filed;

(5) Conversion of a provisional application under 35 U.S.C. 111(b) to a nonprovisional application under 35 U.S.C. 111(a) pursuant to 35 U.S.C. 111(b)(5), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the date the application was filed under 35 U.S.C. 111(b) and ending on the date a request in compliance with § 1.53(c)(3) to convert the provisional application into a nonprovisional application was filed;

(6) Submission of a preliminary amendment or other preliminary paper less than one month before the mailing of an Office action under 35 U.S.C. 132 or notice of allowance under 35 U.S.C. 151 that requires the mailing of a supplemental Office action or notice of allowance, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is eight months from either the date on which the application was filed under 35 U.S.C. 111(a) or the date of commencement of the national stage under 35 U.S.C. 371(b) or (f) in an international application and ending on the date the preliminary amendment or other preliminary paper was filed;

(7) Submission of a reply having an omission (§ 1.135(c)), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed;

(8) Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed;

(9) Submission of an amendment or other paper after a decision by the Patent Trial and Appeal Board, other than a decision designated as containing a new ground of rejection under § 41.50(b) of this title or statement under § 41.50(c) of this title, or a decision by a Federal court, less than one month before the mailing of an Office action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 that requires the mailing of a supplemental Office action or supplemental notice of allowance, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date of the decision by the Patent Trial and Appeal Board or by a Federal court and ending on date the amendment or other paper was filed;

(10) Submission of an amendment under § 1.312 or other paper, other than an amendment under § 1.312 or other paper expressly requested by the Office or a request for continued examination in compliance with § 1.114, after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date of mailing of the notice of allowance under 35 U.S.C. 151 and ending on the date the amendment under § 1.312 or other paper was filed;

(11) Failure to file an appeal brief in compliance with § 41.37 of this chapter within three months from the date on which a notice of appeal to the Patent Trial and Appeal Board was filed under 35 U.S.C. 134 and § 41.31 of this chapter, in which case the period of adjustment set forth in § 1.703

shall be reduced by the number of days, if any, beginning on the day after the date three months from the date on which a notice of appeal to the Patent Trial and Appeal Board was filed under 35 U.S.C. 134 and § 41.31 of this chapter, and ending on the date an appeal brief in compliance with § 41.37 of this chapter or a request for continued examination in compliance with § 1.114 was filed;

(12) Submission of a request for continued examination under 35 U.S.C. 132(b) after any notice of allowance under 35 U.S.C. 151 has been mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date of mailing of the notice of allowance under 35 U.S.C. 151 and ending on the date the request for continued examination under 35 U.S.C. 132(b) was filed;

(13) Failure to provide an application in condition for examination as defined in paragraph (f) of this section within eight months from either the date on which the application was filed under 35 U.S.C. 111(a) or the date of commencement of the national stage under 35 U.S.C. 371(b) or (f) in an international application, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is eight months from either the date on which the application was filed under 35 U.S.C. 111(a) or the date of commencement of the national stage under 35 U.S.C. 371(b) or (f) in an international application and ending on the date the application is in condition for examination as defined in paragraph (f) of this section; and

(14) Further prosecution via a continuing application, in which case the period of adjustment set forth in § 1.703 shall not include any period that is prior to the actual filing date of the application that resulted in the patent.

(d)(1) A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section, and a request for continued examination in compliance with § 1.114 with no submission other than an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraph (c)(12) of this section, if the paper or request for continued examination is accompanied by a statement that each item of information contained in the information disclosure statement:

(i) Was first cited in any communication from a patent office in a counterpart foreign or international application or from the Office, and this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement; or

(ii) Is a communication that was issued by a patent office in a counterpart foreign or international application or by the Office, and this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement.

(2) The thirty-day period set forth in paragraph (d)(1) of this section is not extendable.

(e) The submission of a request under § 1.705(c) for reinstatement of reduced patent term adjustment will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraph (c)(10) of this section.

(f) An application filed under 35 U.S.C. 111(a) is in condition for examination when the application includes a specification, including at least one claim and an abstract (§ 1.72(b)), and has papers in compliance with § 1.52, drawings (if any) in compliance with § 1.84, any English translation required by § 1.52(d) or § 1.57(a), a sequence listing in compliance with § 1.821 through § 1.825 (if applicable), the inventor's oath or declaration or an application data sheet containing the information specified in § 1.63(b), the basic filing fee (§ 1.16(a) or § 1.16(c)), the search fee (§ 1.16(k) or § 1.16(m)), the examination fee (§ 1.16(o) or § 1.16(q)), any certified copy of the previously filed application required by § 1.57(a), and any application size fee required by the Office under § 1.16(s). An international application is in condition for examination when the application has entered the national stage as defined in § 1.491(b), and includes a specification, including at least one claim and an abstract (§ 1.72(b)), and has papers in compliance with § 1.52, drawings (if any) in compliance with

§ 1.84, a sequence listing in compliance with § 1.821 through § 1.825 (if applicable), the inventor's oath or declaration or an application data sheet containing the information specified in § 1.63(b), the search fee (§ 1.492(b)), the examination fee (§ 1.492(c)), and any application size fee required by the Office under § 1.492(j). An application shall be considered as having papers in compliance with § 1.52, drawings (if any) in compliance with § 1.84, and a sequence listing in compliance with § 1.821 through § 1.825 (if applicable) for purposes of this paragraph on the filing date of the latest reply (if any) correcting the papers, drawings, or sequence listing that is prior to the date of mailing of either an action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151, whichever occurs first.

[Added, 65 FR 56366, Sept. 18, 2000, effective Oct. 18, 2000; para. (d) revised, 69 FR 21704, Apr. 22, 2004, effective May 24, 2004; para. (c)(9) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (c)(11) redesignated as (c)(12) and (c)(11) added, 72 FR 46716, Aug. 21, 2007 (implementation enjoined and never became effective); para. (c)(11) removed and (c)(12) redesignated as (c)(11), 74 FR 52686, Oct. 14, 2009, effective Oct. 14, 2009 (to remove changes made by the final rules in 72 FR 46716 from the CFR); para. (d) revised, 76 FR 74700, Dec. 1, 2011, effective Dec. 1, 2011; para. (c)(9) introductory text revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012; paras. (c)(10)(ii) and (c)(11) revised and para. (c)(12) added, 77 FR 49354, Aug. 16, 2012, effective Sept. 17, 2012; para. (e) revised, 78 FR 19416, Apr. 1, 2013, effective Apr. 1, 2013 (adopted as final, 79 FR 27755, May 15, 2014); paras. (c)(11) and (c)(12) revised, paras. (c)(13) and (f) added, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013; paras. (c)(10), (c)(12), (c)(13) and (d)(1) revised, para. (c)(14) added, 80 FR 1346, Jan. 9, 2015, effective Mar. 10, 2015; para. (c) revised, 85 FR 36335, June 16, 2020, effective July 16, 2020]

[* Paragraphs (c)(2)-(4), (c)(6), and (c)(9)-(10) above include changes applicable only to original utility and plant patents issuing from applications filed on or after May 29, 2000, in which a notice of allowance was mailed on or after July 16, 2020 or in which a notice of allowance was mailed prior to July 16, 2020 and patentee has requested applicability in a timely filed request for reconsideration under § 1.705. For paras. (c)(2)-(4), (c)(6), and (c)(9)-(10) in effect for applications filed on or after May 29, 2000, in which there was no notice of allowance mailed on or after July 16, 2020, see § 1.704 (2015-03-10 thru 2020-07-15).]

[* Paragraphs (c)(11)-(14), (e), and (f) above include changes having limited applicability as follows: Para. (c)(12) above includes changes applicable only to applications in which a request for continued examination under 35 U.S.C. 132(b) and 37 CFR 1.114 was filed on or after Mar. 10, 2015. For para. (c)(12) in effect for applications in which all requests for continued examination were filed prior to March 10, 2015, see § 1.704 (2013-12-18 thru 2015-03-09) below. Paras. (c)(11), (c)(13), (c)(14) and (f) above include changes applicable only to patent applications filed under 35 U.S.C. 111 on or after December 18, 2013, and to international patent applications in which the national stage commenced under 35 U.S.C. 371 on or after December 18, 2013. For paras. (c)(11) and (c)(13) in effect for applications filed before (and international applications in which the national stage commenced before) December 18, 2013, and in which a notice of appeal was filed on or after Sept. 17, 2012, see § 1.704 (2012-09-17 thru 2013-12-17). For para. (c)(11) in effect for applications in which there was no notice of appeal filed on or after Sept. 17, 2012, see § 1.704 (pre-2012-09-17). Para. (e) above includes changes applicable only to applications in which a notice of allowance was mailed on or after April 1, 2013. For para. (e) in effect for applications in which there was no notice of allowance mailed on or after April 1, 2013, see § 1.704 (pre 2013-03-31).]

§ 1.704 (2015-03-10 thru 2020-07-15) Reduction of period of adjustment of patent term.

[The following paragraphs have limited applicability, see * below.]

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(c) Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

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(2) Deferral of issuance of a patent under § 1.314, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the date a request for deferral of issuance of a patent under § 1.314 was filed and ending on the date the patent was issued;

(3) Abandonment of the application or late payment of the issue fee, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the date

of abandonment or the date after the date the issue fee was due and ending on the earlier of:

(i) The date of mailing of the decision reviving the application or accepting late payment of the issue fee; or

(ii) The date that is four months after the date the grantable petition to revive the application or accept late payment of the issue fee was filed;

(4) Failure to file a petition to withdraw the holding of abandonment or to revive an application within two months from the mailing date of a notice of abandonment, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date two months from the mailing date of a notice of abandonment and ending on the date a petition to withdraw the holding of abandonment or to revive the application was filed;

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(6) Submission of a preliminary amendment or other preliminary paper less than one month before the mailing of an Office action under 35 U.S.C. 132 or notice of allowance under 35 U.S.C. 151 that requires the mailing of a supplemental Office action or notice of allowance, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the day after the mailing date of the original Office action or notice of allowance and ending on the date of mailing of the supplemental Office action or notice of allowance; or

(ii) Four months;

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(9) Submission of an amendment or other paper after a decision by the Patent Trial and Appeal Board, other than a decision designated as containing a new ground of rejection under § 41.50(b) of this title or statement under § 41.50(c) of this title, or a decision by a Federal court, less than one month before the mailing of an Office action under 35 U.S.C. 132 or notice of allowance under 35 U.S.C. 151 that requires the mailing of a supplemental Office action or supplemental notice of allowance, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the day after the mailing date of the original Office action or notice of allowance and ending on the mailing date of the supplemental Office action or notice of allowance; or

(ii) Four months;

(10) Submission of an amendment under § 1.312 or other paper, other than a request for continued examination in compliance with § 1.114, after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or

(ii) Four months;

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[* Paras. (c)(2)-(4), (c)(6), and (c)(9)-(10) above remain applicable to original utility and plant applications filed on or after May 29, 2000, in which no notice of allowance was mailed on or after July 16, 2020. Where a notice of allowance was mailed on or after July 16, 2020 or patentee has requested applicability of the current rule in a timely filed request for reconsideration under § 1.705, see § 1.704 for the current rule. Older versions of paras. (c)(2)-(4), (c)(6), and (c)(9)-(10) are available from prior publications of Appendix R of the MPEP in the archives available from **www.uspto.gov/web/offices/pac/mpep/old/index.htm**.]

§ 1.704 (2013-12-18 thru 2015-03-09) Reduction of period of adjustment of patent term.

[The following paragraphs have limited applicability, see * below.]

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(c) Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

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(12) Failure to provide an application in condition for examination as defined in paragraph (f) of this section within eight months from either the date on which the application was filed under 35 U.S.C. 111(a) or the date of commencement of the national stage under 35 U.S.C. 371(b) or (f) in an international application, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is eight months from either the date on which the application was filed under 35 U.S.C. 111(a) or the date of commencement of the national stage under 35 U.S.C. 371(b) or (f) in an international application and ending on the date the application is in condition for examination as defined in paragraph (f) of this section; and

(13) Further prosecution via a continuing application, in which case the period of adjustment set forth in § 1.703 shall not include any period that is prior to the actual filing date of the application that resulted in the patent.

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[*para. (c)(12) above is applicable to those applications in which all requests for continued examination under 35 U.S.C. 132(b) and 37 CFR 1.114 were filed prior to Mar. 10, 2015. See § 1.704 above, for para. (c)(12) applicable to applications in which a request for continued examination was filed on or after Mar. 10, 2015.

§ 1.704 (2012-09-17 thru 2013-12-17) Reduction of period of adjustment of patent term.

[Editor Note: Paras. (c)(11)-(12) below are applicable to applications filed before (and international applications in which the national stage commenced before) December 18, 2013 in which a notice of appeal was filed on or after Sept. 17, 2012.]

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(c) *****

(11) Failure to file an appeal brief in compliance with § 41.37 of this chapter within three months from the date on which a notice of appeal to the Patent Trial and Appeal Board was filed under 35 U.S.C. 134 and § 41.31 of this chapter, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date three months from the date on which a notice of appeal to the Patent Trial and Appeal Board was filed under 35 U.S.C. 134 and § 41.31 of this chapter, and ending on the date an appeal brief in compliance with § 41.37 of this chapter or a request for continued examination in compliance with § 1.114 was filed; and

(12) Further prosecution via a continuing application, in which case the period of adjustment set forth in § 1.703 shall not include any period that is prior to the actual filing date of the application that resulted in the patent.

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[* Paras. (c)(11) and (c)(12) above apply to applications filed under 35 U.S.C. 111 before Dec. 18, 2013, and international applications in which the national stage commenced under 35 U.S.C. 371 before Dec. 18, 2013, and in which a notice of appeal was filed on or after Sept. 17, 2012. For the current rule, see § 1.704. For para. (c)(11) in effect for applications in which there was no notice of appeal filed on or after Sept. 17, 2012, see § 1.704 (pre-2012-09-17).]

§ 1.704 (pre-2013-03-31) Reduction of period of adjustment of patent term.

[Editor Note: Para. (e) below applies to applications in which no notice of allowance was mailed on or after April 1, 2013.]

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(e) Submission of an application for patent term adjustment under § 1.705(b) (with or without request under § 1.705(c) for reinstatement of reduced patent term adjustment) will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraph (c)(10) of this section.

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[*See § 1.704 for current para. (e).]

§ 1.704 (pre-2012-09-17) Reduction of period of adjustment of patent term.

[Editor Note: Applicable to applications in which a notice of appeal under 37 CFR 41.31 was filed before September 17, 2012*]

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(c) *****

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(ii) Four months; and

(11) Further prosecution via a continuing application, in which case the period of adjustment set forth in § 1.703 shall not include any period that is prior to the actual filing date of the application that resulted in the patent.

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[*See § 1.704 for the current rule.]

§ 1.705 Patent term adjustment determination.

[Editor Note: Paras. (a)-(d) below include amendments applicable only to patents granted on or after January 14, 2013*]

(a) The patent will include notification of any patent term adjustment under 35 U.S.C. 154(b).

(b) Any request for reconsideration of the patent term adjustment indicated on the patent must be by way of an application for patent term adjustment filed no later than two months from the date the patent was granted. This two-month time period may be extended under the provisions of § 1.136(a). An application for patent term adjustment under this section must be accompanied by:

(1) The fee set forth in § 1.18(e); and

(2) A statement of the facts involved, specifying:

(i) The correct patent term adjustment and the basis or bases under § 1.702 for the adjustment;

(ii) The relevant dates as specified in §§ 1.703(a) through (e) for which an adjustment is sought and the adjustment as specified in § 1.703(f) to which the patent is entitled;

(iii) Whether the patent is subject to a terminal disclaimer and any expiration date specified in the terminal disclaimer; and

(iv)(A) Any circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704; or

(B) That there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(c) Any request for reinstatement of all or part of the period of adjustment reduced pursuant to § 1.704(b) for failing to reply to a rejection, objection, argument, or other request within three months of the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request must be filed prior to the issuance of the patent. This time period is not extendable. Any request for reinstatement of all or part of the period of adjustment reduced pursuant to § 1.704(b) under this paragraph must also be accompanied by:

(1) The fee set forth in § 1.18(f); and

(2) A showing to the satisfaction of the Director that, in spite of all due care, the applicant was unable to reply to the rejection, objection, argument, or other request within three months of the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request. The Office shall not grant any request for reinstatement for more than three additional months for each reply beyond three months from the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request.

(d) No submission or petition on behalf of a third party concerning patent term adjustment under 35 U.S.C. 154(b) will be considered by the Office. Any such submission or petition will be returned to the third party, or otherwise disposed of, at the convenience of the Office.

[Added, 65 FR 56366, Sept. 18, 2000, effective Oct. 18, 2000; para. (c)(2) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (d) revised, 69 FR 21704, Apr. 22, 2004, effective May 24, 2004; paras. (d) and (e) removed, para. (f) redesignated as para. (d), and paras. (a), (b) introductory text, and (c) introductory text revised, 78 FR 19416, Apr. 1, 2013, effective Apr. 1, 2013 (adopted as final, 79 FR 27755, May 15, 2014)]

[*The changes to paras. (a)-(f) effective Apr. 1, 2013 are applicable to any patent granted on or after Jan. 14, 2013. See § 1.705 (pre-2013-04-01) for paras. (a)-(f) in effect with respect to applications granted prior to Jan. 14, 2013.]

§ 1.705 (pre-2013-04-01) Patent term adjustment determination.

[Editor Note: Applicable to patents granted before January 14, 2013*]

(a) The notice of allowance will include notification of any patent term adjustment under 35 U.S.C. 154(b).

(b) Any request for reconsideration of the patent term adjustment indicated in the notice of allowance, except as provided in paragraph (d) of this section, and any request for reinstatement of all or part of the term reduced pursuant to § 1.704(b) must be by way of an application for patent term adjustment. An application for patent term adjustment under this section must be filed no later than the payment of the issue fee but may not be filed earlier than the date of mailing of the notice of allowance. An application for patent term adjustment under this section must be accompanied by:

(1) The fee set forth in § 1.18(e); and

(2) A statement of the facts involved, specifying:

(i) The correct patent term adjustment and the basis or bases under § 1.702 for the adjustment;

(ii) The relevant dates as specified in §§ 1.703(a) through (e) for which an adjustment is sought and the adjustment as specified in § 1.703(f) to which the patent is entitled;

(iii) Whether the patent is subject to a terminal disclaimer and any expiration date specified in the terminal disclaimer; and

(iv)(A) Any circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704; or

(B) That there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(c) Any application for patent term adjustment under this section that requests reinstatement of all or part of the period of adjustment reduced pursuant to § 1.704(b) for failing to reply to a rejection, objection, argument, or other request within three months of the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request must also be accompanied by:

(1) The fee set forth in § 1.18(f); and

(2) A showing to the satisfaction of the Director that, in spite of all due care, the applicant was unable to reply to the rejection, objection, argument, or other request within three months of the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request. The Office shall not grant any request for reinstatement for more than three additional months for each reply beyond three months from the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request.

(d) If there is a revision to the patent term adjustment indicated in the notice of allowance, the patent will indicate the revised patent term adjustment. If the patent indicates or should have indicated a revised patent term adjustment, any request for reconsideration of the patent term adjustment indicated in the patent must be filed within two months of the date the patent issued and must comply with the requirements of paragraphs (b)(1) and (b)(2) of this section. Any request for reconsideration under this section that raises issues that were raised, or could have been raised, in an application for patent term adjustment under paragraph (b) of this section shall be dismissed as untimely as to those issues.

(e) The periods set forth in this section are not extendable.

(f) No submission or petition on behalf of a third party concerning patent term adjustment under 35 U.S.C. 154(b) will be considered by the Office. Any such submission or petition will be returned to the third party, or otherwise disposed of, at the convenience of the Office.

[Added, 65 FR 56366, Sept. 18, 2000, effective Oct. 18, 2000; para. (c)(2) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (d) revised, 69 FR 21704, Apr. 22, 2004, effective May 24, 2004]

[*See § 1.705 for the rule applicable to patents granted on or after Jan. 14, 2013.]

EXTENSION OF PATENT TERM DUE TO REGULATORY REVIEW

§ 1.710 Patents subject to extension of the patent term.

(a) A patent is eligible for extension of the patent term if the patent claims a product as defined in paragraph (b) of this section, either alone or in combination with other ingredients that read on a composition that received permission for commercial marketing or use, or a method of using such a product, or a method of manufacturing such a product, and meets all other conditions and requirements of this subpart.

(b) The term *product* referred to in paragraph (a) of this section means —

(1) The active ingredient of a new human drug, antibiotic drug, or human biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Public Health Service Act) including any salt or ester of the active ingredient, as a single entity or in combination with another active ingredient; or

(2) The active ingredient of a new animal drug or veterinary biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Virus-Serum-Toxin Act) that is not primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes including site specific genetic manipulation techniques, including any salt or ester of the active ingredient, as a single entity or in combination with another active ingredient; or

(3) Any medical device, food additive, or color additive subject to regulation under the Federal Food, Drug, and Cosmetic Act.

[Added 52 FR 9394, Mar. 24, 1987, effective May 26, 1987; amended, 54 FR 30375, July 20, 1989, effective Aug. 22, 1989]

§ 1.720 Conditions for extension of patent term.

The term of a patent may be extended if:

(a) The patent claims a product or a method of using or manufacturing a product as defined in § 1.710;

(b) The term of the patent has never been previously extended, except for extensions issued pursuant to §§ 1.701, 1.760, or § 1.790;

(c) An application for extension is submitted in compliance with § 1.740;

(d) The product has been subject to a regulatory review period as defined in 35 U.S.C. 156(g) before its commercial marketing or use;

(e) The product has received permission for commercial marketing or use and —

(1) The permission for the commercial marketing or use of the product is the first received permission for commercial marketing or use under the provision of law under which the applicable regulatory review occurred, or

(2) In the case of a patent other than one directed to subject matter within § 1.710(b)(2) claiming a method of manufacturing the product that primarily uses recombinant DNA technology in the manufacture of the product, the permission for the commercial marketing or use is the first received permission for the commercial marketing or use of a product manufactured under the process claimed in the patent, or

(3) In the case of a patent claiming a new animal drug or a veterinary biological product that is not covered by the claims in any other patent that has been extended, and has received permission for the commercial marketing or use in non-food-producing animals and in food-producing animals, and was not extended on the basis of the regulatory review period for use in non-food-producing animals, the permission for the commercial marketing or use of the drug or product after the regulatory review period for use in food-producing animals is the first permitted commercial marketing or use of the drug or product for administration to a food-producing animal.

(f) The application is submitted within the sixty-day period beginning on the date the product first received permission for commercial marketing or use under the provisions of law under which the applicable regulatory review period occurred; or in the case of a patent claiming a method of manufacturing the product which primarily uses

recombinant DNA technology in the manufacture of the product, the application for extension is submitted within the sixty-day period beginning on the date of the first permitted commercial marketing or use of a product manufactured under the process claimed in the patent; or in the case of a patent that claims a new animal drug or a veterinary biological product that is not covered by the claims in any other patent that has been extended, and said drug or product has received permission for the commercial marketing or use in non-food-producing animals, the application for extension is submitted within the sixty-day period beginning on the date of the first permitted commercial marketing or use of the drug or product for administration to a food-producing animal;

(g) The term of the patent, including any interim extension issued pursuant to § 1.790, has not expired before the submission of an application in compliance with § 1.741; and

(h) No other patent term has been extended for the same regulatory review period for the product.

[Added 52 FR 9395, Mar. 24, 1987, effective May 26, 1987; paras. (e) & (f) amended, 54 FR 30375, July 20, 1989, effective Aug. 22, 1989; paras. (b) and (g) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.730 Applicant for extension of patent term; signature requirements.

(a) Any application for extension of a patent term must be submitted by the owner of record of the patent or its agent and must comply with the requirements of § 1.740.

(b) If the application is submitted by the patent owner, the application must be signed either by:

(1) The patent owner in compliance with § 3.73(c) of this chapter; or

(2) A registered practitioner on behalf of the patent owner.

(c) If the application is submitted on behalf of the patent owner by an agent of the patent owner (*e.g.*, a licensee of the patent owner), the application must be signed by a registered practitioner on behalf of the agent. The Office may require proof that the agent is authorized to act on behalf of the patent owner.

(d) If the application is signed by a registered practitioner, the Office may require proof that the practitioner is authorized to act on behalf of the patent owner or agent of the patent owner.

[Added 52 FR 9395, Mar. 24, 1987, effective May 26, 1987; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (b)(1) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012]

§ 1.740 Formal requirements for application for extension of patent term; correction of informalities.

(a) An application for extension of patent term must be made in writing to the Director. A formal application for the extension of patent term must include:

(1) A complete identification of the approved product as by appropriate chemical and generic name, physical structure or characteristics;

(2) A complete identification of the Federal statute including the applicable provision of law under which the regulatory review occurred;

(3) An identification of the date on which the product received permission for commercial marketing or use under the provision of law under which the applicable regulatory review period occurred;

(4) In the case of a drug product, an identification of each active ingredient in the product and as to each active ingredient, a statement that it has not been previously approved for commercial marketing or use under the Federal Food, Drug, and Cosmetic Act, the Public Health Service Act, or the Virus-Serum-Toxin Act, or a statement of when the active ingredient was approved for commercial marketing or use (either alone or in combination with other active ingredients), the use for which it was approved, and the provision of law under which it was approved.

(5) A statement that the application is being submitted within the sixty day period permitted for submission pursuant to § 1.720(f) and an identification of the date of the last day on which the application could be submitted;

(6) A complete identification of the patent for which an extension is being sought by the name of the inventor, the patent number, the date of issue, and the date of expiration;

(7) A copy of the patent for which an extension is being sought, including the entire specification (including claims) and drawings;

(8) A copy of any disclaimer, certificate of correction, receipt of maintenance fee payment, or reexamination certificate issued in the patent;

(9) A statement that the patent claims the approved product, or a method of using or manufacturing the approved product, and a showing which lists each applicable patent claim and demonstrates the manner in which at least one such patent claim reads on:

(i) The approved product, if the listed claims include any claim to the approved product;

(ii) The method of using the approved product, if the listed claims include any claim to the method of using the approved product; and

(iii) The method of manufacturing the approved product, if the listed claims include any claim to the method of manufacturing the approved product;

(10) A statement beginning on a new page of the relevant dates and information pursuant to 35 U.S.C.156(g) in order to enable the Secretary of Health and Human Services or the Secretary of Agriculture, as appropriate, to determine the applicable regulatory review period as follows:

(i) For a patent claiming a human drug, antibiotic, or human biological product:

(A) The effective date of the investigational new drug (IND) application and the IND number;

(B) The date on which a new drug application (NDA) or a Product License Application (PLA) was initially submitted and the NDA or PLA number; and

(C) The date on which the NDA was approved or the Product License issued;

(ii) For a patent claiming a new animal drug:

(A) The date a major health or environmental effects test on the drug was initiated, and any available substantiation of that date, or the date of an exemption under subsection (j) of Section 512 of the Federal Food, Drug, and Cosmetic Act became effective for such animal drug;

(B) The date on which a new animal drug application (NADA) was initially submitted and the NADA number; and

(C) The date on which the NADA was approved;

(iii) For a patent claiming a veterinary biological product:

(A) The date the authority to prepare an experimental biological product under the Virus-Serum-Toxin Act became effective;

(B) The date an application for a license was submitted under the Virus-Serum-Toxin Act; and

(C) The date the license issued;

(iv) For a patent claiming a food or color additive:

(A) The date a major health or environmental effects test on the additive was initiated and any available substantiation of that date;

(B) The date on which a petition for product approval under the Federal Food, Drug and Cosmetic Act was initially submitted and the petition number; and

(C) The date on which the FDA published a *Federal Register* notice listing the additive for use;

(v) For a patent claiming a medical device:

(A) The effective date of the investigational device exemption (IDE) and the IDE number, if applicable, or the date on which the applicant began the first clinical investigation involving the device, if no IDE was submitted, and any available substantiation of that date;

(B) The date on which the application for product approval or notice of completion of a product development protocol under Section 515 of the Federal Food, Drug and Cosmetic Act was initially submitted and the number of the application; and

(C) The date on which the application was approved or the protocol declared to be completed;

(11) A brief description beginning on a new page of the significant activities undertaken by the

marketing applicant during the applicable regulatory review period with respect to the approved product and the significant dates applicable to such activities;

(12) A statement beginning on a new page that in the opinion of the applicant the patent is eligible for the extension and a statement as to the length of extension claimed, including how the length of extension was determined;

(13) A statement that applicant acknowledges a duty to disclose to the Director of the United States Patent and Trademark Office and the Secretary of Health and Human Services or the Secretary of Agriculture any information which is material to the determination of entitlement to the extension sought (*see* § 1.765);

(14) The prescribed fee for receiving and acting upon the application for extension (see § 1.20(j)); and

(15) The name, address, and telephone number of the person to whom inquiries and correspondence relating to the application for patent term extension are to be directed.

(b) The application under this section must be accompanied by two additional copies of such application (for a total of three copies).

(c) If an application for extension of patent term is informal under this section, the Office will so notify the applicant. The applicant has two months from the mail date of the notice, or such time as is set in the notice, within which to correct the informality. Unless the notice indicates otherwise, this time period may be extended under the provisions of § 1.136.

[Added 52 FR 9395, Mar. 24, 1987, effective May 26, 1987; para. (a) amended, 54 FR 30375, July 20, 1989, effective Aug. 22, 1989; para. (a)(14), 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; heading, introductory text of paragraph (a), and paras. (a)(9), (a)(10), (a)(14), (a)(15), (b) and (c) revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000; paras. (a)(16) and (a)(17) removed, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000; paras. (a) & (a)(13) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

§ 1.741 Complete application given a filing date; petition procedure.

(a) The filing date of an application for extension of a patent term is the date on which a complete application is received in the Office or filed pursuant to the procedures set forth in § 1.8 or § 1.10. A complete application must include:

(1) An identification of the approved product;

(2) An identification of each Federal statute under which regulatory review occurred;

(3) An identification of the patent for which an extension is being sought;

(4) An identification of each claim of the patent which claims the approved product or a method of using or manufacturing the approved product;

(5) Sufficient information to enable the Director to determine under subsections (a) and (b) of 35 U.S.C. 156 the eligibility of a patent for extension, and the rights that will be derived from the extension, and information to enable the Director and the Secretary of Health and Human Services or the Secretary of Agriculture to determine the length of the regulatory review period; and

(6) A brief description of the activities undertaken by the marketing applicant during the applicable regulatory review period with respect to the approved product and the significant dates applicable to such activities.

(b) If an application for extension of patent term is incomplete under this section, the Office will so notify the applicant. If applicant requests review of a notice that an application is incomplete, or review of the filing date accorded an application under this section, applicant must file a petition pursuant to this paragraph accompanied by the fee set forth in § 1.17(f) within two months of the mail date of the notice that the application is incomplete, or the notice according the filing date complained of. Unless the notice indicates otherwise, this time period may be extended under the provisions of § 1.136.

[Added 52 FR 9396, Mar. 24, 1987, effective May 26, 1987; para. (a) amended, 54 FR 30375, July 20, 1989, effective Aug. 22, 1989; para. (a) amended, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; para. (a) correcting amendment, 61 FR 64027, Dec. 3, 1996; heading, introductory text of paragraph (a), and paras. (a)(5) and (b) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a)(5) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (b) revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004]

§ 1.750 Determination of eligibility for extension of patent term.

A determination as to whether a patent is eligible for extension may be made by the Director solely on the basis of the representations contained in the application for extension filed in compliance with § 1.740 or § 1.790. This determination may be delegated to appropriate Patent and Trademark Office officials and may be made at any time before the certificate of extension is issued. The Director or other appropriate officials may require from applicant further information or make such independent inquiries as desired before a final determination is made on whether a patent is eligible for extension. In an application for extension filed in compliance with § 1.740, a notice will be mailed to applicant containing the determination as to the eligibility of the patent for extension and the period of time of the extension, if any. This notice shall constitute the final determination as to the eligibility and any period of extension of the patent. A single request for reconsideration of a final determination may be made if filed by the applicant within such time as may be set in the notice of final determination or, if no time is set, within one month from the date of the final determination. The time periods set forth herein are subject to the provisions of § 1.136.

[Added 52 FR 9396, Mar. 24, 1987, effective May 26, 1987; revised, 60 FR 25615, May 12, 1995, effective July 11, 1995; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

§ 1.760 Interim extension of patent term under 35 U.S.C. 156(e)(2).

An applicant who has filed a formal application for extension in compliance with § 1.740 may request one or more interim extensions for periods of up to one year each pending a final determination on the application pursuant to § 1.750. Any such request should be filed at least three months prior to the expiration date of the patent. The Director may issue interim extensions, without a request by the applicant, for periods of up to one year each until a final determination is made. The patent owner or agent will be notified when an interim extension is granted and notice of the extension will be published in the *Official Gazette of the United States Patent and Trademark Office.* The notice will be recorded in the official file of the patent and will be considered as part of the original patent. In no event will the interim extensions granted under this section be longer than the maximum period for extension to which the applicant would be eligible.

[Added, 52 FR 9396, Mar. 24, 1987, effective May 26, 1987; heading revised, 60 FR 25615, May 12, 1995, effective July 11, 1995; revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

§ 1.765 Duty of disclosure in patent term extension proceedings.

(a) A duty of candor and good faith toward the Patent and Trademark Office and the Secretary of Health and Human Services or the Secretary of Agriculture rests on the patent owner or its agent, on each attorney or agent who represents the patent owner and on every other individual who is substantively involved on behalf of the patent owner in a patent term extension proceeding. All such individuals who are aware, or become aware, of material information adverse to a determination of entitlement to the extension sought, which has not been previously made of record in the patent term extension proceeding must bring such information to the attention of the Office or the Secretary, as appropriate, in accordance with paragraph (b) of this section, as soon as it is practical to do so after the individual becomes aware of the information. Information is material where there is a substantial likelihood that the Office or the Secretary would consider it important in determinations to be made in the patent term extension proceeding.

(b) Disclosures pursuant to this section must be accompanied by a copy of each written document which is being disclosed. The disclosure must be made to the Office or the Secretary, as appropriate, unless the disclosure is material to determinations to be made by both the Office and the Secretary, in which case duplicate copies, certified as such, must be filed in the Office and with the Secretary. Disclosures pursuant to this section may be made to the Office or the Secretary, as appropriate, through an attorney or agent having responsibility on behalf of the patent owner or its agent for the patent term extension proceeding or through a patent

owner acting on his or her own behalf. Disclosure to such an attorney, agent or patent owner shall satisfy the duty of any other individual. Such an attorney, agent or patent owner has no duty to transmit information which is not material to the determination of entitlement to the extension sought.

(c) No patent will be determined eligible for extension and no extension will be issued if it is determined that fraud on the Office or the Secretary was practiced or attempted or the duty of disclosure was violated through bad faith or gross negligence in connection with the patent term extension proceeding. If it is established by clear and convincing evidence that any fraud was practiced or attempted on the Office or the Secretary in connection with the patent term extension proceeding or that there was any violation of the duty of disclosure through bad faith or gross negligence in connection with the patent term extension proceeding, a final determination will be made pursuant to § 1.750 that the patent is not eligible for extension.

(d) The duty of disclosure pursuant to this section rests on the individuals identified in paragraph (a) of this section and no submission on behalf of third parties, in the form of protests or otherwise, will be considered by the Office. Any such submissions by third parties to the Office will be returned to the party making the submission, or otherwise disposed of, without consideration by the Office.

[Added, 52 FR 9396, Mar. 24 1987, effective May 26, 1987, para. (a) amended, 54 FR 30375, July 20, 1989, effective Aug. 22, 1989; para. (a) revised, 60 FR 25615, May 12, 1995, effective July 11, 1995]

§ 1.770 Express withdrawal of application for extension of patent term.

An application for extension of patent term may be expressly withdrawn before a determination is made pursuant to § 1.750 by filing in the Office, in duplicate, a written declaration of withdrawal signed by the owner of record of the patent or its agent. An application may not be expressly withdrawn after the date permitted for reply to the final determination on the application. An express withdrawal pursuant to this section is effective when acknowledged in writing by the Office. The filing of an express withdrawal pursuant to this section and its acceptance by the Office does not entitle applicant to a refund of the filing fee (§ 1.20(j)) or any portion thereof.

[Added 52 FR 9397, Mar. 24 1987, effective May 26, 1987; 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.775 Calculation of patent term extension for a human drug, antibiotic drug, or human biological product.

(a) If a determination is made pursuant to § 1.750 that a patent for a human drug, antibiotic drug or human biological product is eligible for extension, the term shall be extended by the time as calculated in days in the manner indicated by this section. The patent term extension will run from the original expiration date of the patent or any earlier date set by terminal disclaimer (§ 1.321).

(b) The term of the patent for a human drug, antibiotic drug or human biological product will be extended by the length of the regulatory review period for the product as determined by the Secretary of Health and Human Services, reduced as appropriate pursuant to paragraphs (d)(1) through (d)(6) of this section.

(c) The length of the regulatory review period for a human drug, antibiotic drug or human biological product will be determined by the Secretary of Health and Human Services. Under 35 U.S.C. 156(g)(1)(B), it is the sum of —

(1) The number of days in the period beginning on the date an exemption under subsection (i) of section 505 or subsection (d) of section 507 of the Federal Food, Drug, and Cosmetic Act became effective for the approved product and ending on the date the application was initially submitted for such product under those sections or under section 351 of the Public Health Service Act; and

(2) The number of days in the period beginning on the date the application was initially submitted for the approved product under section 351 of the Public Health Service Act, subsection (b) of section 505 or section 507 of the Federal Food, Drug, and Cosmetic Act and ending on the date such application was approved under such section.

(d) The term of the patent as extended for a human drug, antibiotic drug or human biological product will be determined by—

(1) Subtracting from the number of days determined by the Secretary of Health and Human Services to be in the regulatory review period:

(i) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section which were on and before the date on which the patent issued;

(ii) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section during which it is determined under 35 U.S.C. 156(d)(2)(B) by the Secretary of Health and Human Services that applicant did not act with due diligence;

(iii) One-half the number of days remaining in the period defined by paragraph (c)(1) of this section after that period is reduced in accordance with paragraphs (d)(1)(i) and (ii) of this section; half days will be ignored for purposes of subtraction;

(2) By adding the number of days determined in paragraph (d)(1) of this section to the original term of the patent as shortened by any terminal disclaimer;

(3) By adding 14 years to the date of approval of the application under section 351 of the Public Health Service Act, or subsection (b) of section 505 or section 507 of the Federal Food, Drug, and Cosmetic Act;

(4) By comparing the dates for the ends of the periods obtained pursuant to paragraphs (d)(2) and (d)(3) of this section with each other and selecting the earlier date;

(5) If the original patent was issued after September 24, 1984,

(i) By adding 5 years to the original expiration date of the patent or any earlier date set by terminal disclaimer; and

(ii) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(5)(i) of this section with each other and selecting the earlier date;

(6) If the original patent was issued before September 24, 1984, and

(i) If no request was submitted for an exemption under subsection (i) of section 505 or subsection (d) of section 507 of the Federal Food, Drug, and Cosmetic Act before September 24, 1984, by—

(A) Adding 5 years to the original expiration date of the patent or earlier date set by terminal disclaimer; and

(B) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(i)(A) of this section with each other and selecting the earlier date; or

(ii) If a request was submitted for an exemption under subsection (i) of section 505 or subsection (d) of section 507 of the Federal Food, Drug, or Cosmetic Act before September 24, 1984 and the commercial marketing or use of the product was not approved before September 24, 1984, by -

(A) Adding 2 years to the original expiration date of the patent or earlier date set by terminal disclaimer, and

(B) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(ii)(A) of this section with each other and selecting the earlier date.

[Added, 52 FR 9397, Mar. 24 1987, effective May 26, 1987]

§ 1.776 Calculation of patent term extension for a food additive or color additive.

(a) If a determination is made pursuant to § 1.750 that a patent for a food additive or color additive is eligible for extension, the term shall be extended by the time as calculated in days in the manner indicated by this section. The patent term extension will run from the original expiration date of the patent or earlier date set by terminal disclaimer (§ 1.321).

(b) The term of the patent for a food additive or color additive will be extended by the length of the regulatory review period for the product as determined by the Secretary of Health and Human Services, reduced as appropriate pursuant to paragraphs (d)(1) through (d)(6) of this section.

(c) The length of the regulatory review period for a food additive or color additive will be determined by the Secretary of Health and Human Services. Under 35 U.S.C. 156(g)(2)(B), it is the sum of -

(1) The number of days in the period beginning on the date a major health or environmental effects test on the additive was initiated and ending on the date a petition was initially submitted with respect to the approved product under the Federal Food, Drug, and Cosmetic Act requesting the issuance of a regulation for use of the product; and

(2) The number of days in the period beginning on the date a petition was initially submitted with respect to the approved product under the Federal Food, Drug, and Cosmetic Act requesting the issuance of a regulation for use of the product, and ending on the date such regulation became effective or, if objections were filed to such regulation, ending on the date such objections were resolved and commercial marketing was permitted or, if commercial marketing was permitted and later revoked pending further proceedings as a result of such objections, ending on the date such proceedings were finally resolved and commercial marketing was permitted.

(d) The term of the patent as extended for a food additive or color additive will be determined by

(1) Subtracting from the number of days determined by the Secretary of Health and Human Services to be in the regulatory review period:

(i) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section which were on and before the date on which the patent issued;

(ii) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section during which it is determined under 35 U.S.C. 156(d)(2)(B) by the Secretary of Health and Human Services that applicant did not act with due diligence;

(iii) The number of days equal to one-half the number of days remaining in the period defined by paragraph (c)(1) of this section after that period is reduced in accordance with paragraphs (d)(1) (i) and (ii) of this section; half days will be ignored for purposes of subtraction;

(2) By adding the number of days determined in paragraph (d)(1) of this section to the original term of the patent as shortened by any terminal disclaimer;

(3) By adding 14 years to the date a regulation for use of the product became effective or, if objections were filed to such regulation, to the date such objections were resolved and commercial marketing was permitted or, if commercial marketing was permitted and later revoked pending further proceedings as a result of such objections, to the date such proceedings were finally resolved and commercial marketing was permitted;

(4) By comparing the dates for the ends of the periods obtained pursuant to paragraphs (d)(2) and (d)(3) of this section with each other and selecting the earlier date;

(5) If the original patent was issued after September 24, 1984,

(i) By adding 5 years to the original expiration date of the patent or earlier date set by terminal disclaimer; and

(ii) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(5)(i) of this section with each other and selecting the earlier date;

(6) If the original patent was issued before September 24, 1984, and

(i) If no major health or environmental effects test was initiated and no petition for a regulation or application for registration was submitted before September 24, 1984, by

(A) Adding 5 years to the original expiration date of the patent or earlier date set by terminal disclaimer, and

(B) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(i)(A) of this section with each other and selecting the earlier date; or

(ii) If a major health or environmental effects test was initiated or a petition for a regulation or application for registration was submitted by September 24, 1984, and the commercial marketing or use of the product was not approved before September 24, 1984, by —

(A) Adding 2 years to the original expiration date of the patent or earlier date set by terminal disclaimer, and

(B) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(ii)(A) of this section with each other and selecting the earlier date.

[Added, 52 FR 9397, Mar. 24, 1987, effective May 26, 1987]

§ 1.777 Calculation of patent term extension for a medical device.

(a) If a determination is made pursuant to § 1.750 that a patent for a medical device is eligible for extension, the term shall be extended by the time as calculated in days in the manner indicated by this section. The patent term extension will run from the original expiration date of the patent or earlier date as set by terminal disclaimer (§ 1.321).

(b) The term of the patent for a medical device will be extended by the length of the regulatory review period for the product as determined by the Secretary of Health and Human Services, reduced as appropriate pursuant to paragraphs (d)(1) through (d)(6) of this section.

(c) The length of the regulatory review period for a medical device will be determined by the Secretary of Health and Human Services. Under 35 U.S.C. 156(g)(3)(B), it is the sum of

(1) The number of days in the period beginning on the date a clinical investigation on humans involving the device was begun and ending on the date an application was initially submitted with respect to the device under section 515 of the Federal Food, Drug, and Cosmetic Act; and

(2) The number of days in the period beginning on the date the application was initially submitted with respect to the device under section 515 of the Federal Food, Drug, and Cosmetic Act, and ending on the date such application was approved under such Act or the period beginning on the date a notice of completion of a product development protocol was initially submitted under section 515(f)(5) of the Act and ending on the date the protocol was declared completed under section 515(f)(6) of the Act.

(d) The term of the patent as extended for a medical device will be determined by —

(1) Subtracting from the number of days determined by the Secretary of Health and Human Services to be in the regulatory review period pursuant to paragraph (c) of this section:

(i) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section which were on and before the date on which the patent issued;

(ii) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section during which it is determined under 35 U.S.C. 156(d)(2)(B) by the Secretary of Health and Human Services that applicant did not act with due diligence;

(iii) One-half the number of days remaining in the period defined by paragraph (c)(1) of this section after that period is reduced in accordance with paragraphs (d)(1) (i) and (ii) of this section; half days will be ignored for purposes of subtraction;

(2) By adding the number of days determined in paragraph (d)(1) of this section to the original term of the patent as shortened by any terminal disclaimer;

(3) By adding 14 years to the date of approval of the application under section 515 of the Federal Food, Drug, and Cosmetic Act or the date a product development protocol was declared completed under section 515(f)(6) of the Act;

(4) By comparing the dates for the ends of the periods obtained pursuant to paragraphs (d)(2) and (d)(3) of this section with each other and selecting the earlier date;

(5) If the original patent was issued after September 24, 1984,

(i) By adding 5 years to the original expiration date of the patent or earlier date set by terminal disclaimer; and

(ii) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(5)(i) of this section with each other and selecting the earlier date;

(6) If the original patent was issued before September 24, 1984, and

(i) If no clinical investigation on humans involving the device was begun or no product development protocol was submitted under section 515(f)(5) of the Federal Food, Drug, and Cosmetic Act before September 24, 1984, by —

(A) Adding 5 years to the original expiration date of the patent or earlier date set by terminal disclaimer and

(B) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(i)(A) of this section with each other and selecting the earlier date; or

(ii) If a clinical investigation on humans involving the device was begun or a product development protocol was submitted under section 515(f)(5) of the Federal Food, Drug, and Cosmetic Act before September 24, 1984 and the commercial marketing or use of the product was not approved before September 24, 1984, by

(A) Adding 2 years to the original expiration date of the patent or earlier date set by terminal disclaimer, and

(B) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(ii)(A) of this section with each other and selecting the earlier date.

[Added, 52 FR 9398, Mar. 24 1987, effective May 26, 1987]

§ 1.778 Calculation of patent term extension for an animal drug product.

(a) If a determination is made pursuant to § 1.750 that a patent for an animal drug is eligible for extension, the term shall be extended by the time as calculated in days in the manner indicated by this section. The patent term extension will run from the original expiration date of the patent or any earlier date set by terminal disclaimer (§ 1.321).

(b) The term of the patent for an animal drug will be extended by the length of the regulatory review period for the drug as determined by the Secretary of Health and Human Services, reduced as appropriate pursuant to paragraphs (d)(1) through (d)(6) of this section.

(c) The length of the regulatory review period for an animal drug will be determined by the Secretary of Health and Human Services. Under 35 U.S.C. 156(g)(4)(B), it is the sum of —

(1) The number of days in the period beginning on the earlier of the date a major health or environmental effects test on the drug was initiated or the date an exemption under subsection (j) of section 512 of the Federal Food, Drug, and Cosmetic Act became effective for the approved animal drug and ending on the date an application was initially submitted for such animal drug under section 512 of the Federal Food, Drug, and Cosmetic Act; and

(2) The number of days in the period beginning on the date the application was initially submitted for the approved animal drug under subsection (b) of section 512 of the Federal Food, Drug, and Cosmetic Act and ending on the date such application was approved under such section.

(d) The term of the patent as extended for an animal drug will be determined by —

(1) Subtracting from the number of days determined by the Secretary of Health and Human Services to be in the regulatory review period:

(i) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section that were on and before the date on which the patent issued;

(ii) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section during which it is determined under 35 U.S.C. 156(d)(2)(B) by the Secretary of Health and Human Services that applicant did not act with due diligence;

(iii) One-half the number of days remaining in the period defined by paragraph (c)(1) of this section after that period is reduced in accordance with paragraphs (d)(1)(i) and (ii) of this section; half days will be ignored for purposes of subtraction;

(2) By adding the number of days determined in paragraph (d)(1) of this section to the original term of the patent as shortened by any terminal disclaimer;

(3) By adding 14 years to the date of approval of the application under section 512 of the Federal Food, Drug, and Cosmetic Act;

(4) By comparing the dates for the ends of the periods obtained pursuant to paragraphs (d)(2) and (d)(3) of this section with each other and selecting the earlier date;

(5) If the original patent was issued after November 16, 1988, by —

(i) Adding 5 years to the original expiration date of the patent or any earlier date set by terminal disclaimer; and

(ii) Comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(5)(i) of this section with each other and selecting the earlier date;

(6) If the original patent was issued before November 16, 1988, and

(i) If no major health or environmental effects test on the drug was initiated and no request was submitted for an exemption under subsection (j) of section 512 of the Federal Food, Drug, and Cosmetic Act before November 16, 1988, by —

(A) Adding 5 years to the original expiration date of the patent or earlier date set by terminal disclaimer; and

(B) Comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(i)(A) of this section with each other and selecting the earlier date; or

(ii) If a major health or environmental effects test was initiated or a request for an exemption under subsection (j) of section 512 of the Federal Food, Drug, and Cosmetic Act was submitted before November 16, 1988, and the application for commercial marketing or use of the animal drug was not approved before November 16, 1988, by —

(A) Adding 3 years to the original expiration date of the patent or earlier date set by terminal disclaimer, and

(B) Comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(ii)(A) of this section with each other and selecting the earlier date.

[Added, 54 FR 30375, July 20, 1989, effective Aug. 22, 1989]

§ 1.779 Calculation of patent term extension for a veterinary biological product.

(a) If a determination is made pursuant to § 1.750 that a patent for a veterinary biological product is eligible for extension, the term shall be extended by the time as calculated in days in the manner indicated by this section. The patent term extension will run from the original expiration date of the patent or any earlier date set by terminal disclaimer (§ 1.321).

(b) The term of the patent for a veterinary biological product will be extended by the length of the regulatory review period for the product as determined by the Secretary of Agriculture, reduced as appropriate pursuant to paragraphs (d)(1) through (d)(6) of this section.

(c) The length of the regulatory review period for a veterinary biological product will be determined by the Secretary of Agriculture. Under 35 U.S.C. 156(g)(5)(B), it is the sum of —

(1) The number of days in the period beginning on the date the authority to prepare an experimental biological product under the Virus-Serum-Toxin Act became effective and ending on the date an application for a license was submitted under the Virus-Serum-Toxin Act; and

(2) The number of days in the period beginning on the date an application for a license was initially submitted for approval under the Virus-Serum-Toxin Act and ending on the date such license was issued.

(d) The term of the patent as extended for a veterinary biological product will be determined by —

(1) Subtracting from the number of days determined by the Secretary of Agriculture to be in the regulatory review period:

(i) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section that were on and before the date on which the patent issued;

(ii) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section during which it is determined under 35 U.S.C. 156(d)(2)(B) by the Secretary of Agriculture that applicant did not act with due diligence;

(iii) One-half the number of days remaining in the period defined by paragraph (c)(1) of this section after that period is reduced in accordance with paragraphs (d)(1)(i) and (ii) of this section; half days will be ignored for purposes of subtraction;

(2) By adding the number of days determined in paragraph (d)(1) of this section to the original term of the patent as shortened by any terminal disclaimer;

(3) By adding 14 years to the date of the issuance of a license under the Virus-Serum-Toxin Act;

(4) By comparing the dates for the ends of the periods obtained pursuant to paragraphs (d)(2) and (d)(3) of this section with each other and selecting the earlier date;

(5) If the original patent was issued after November 16, 1988, by —

(i) Adding 5 years to the original expiration date of the patent or any earlier date set by terminal disclaimer; and

(ii) Comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(5)(i) of this section with each other and selecting the earlier date;

(6) If the original patent was issued before November 16, 1988, and

(i) If no request for the authority to prepare an experimental biological product under the Virus-Serum-Toxin Act was submitted before November 16, 1988, by —

(A) Adding 5 years to the original expiration date of the patent or earlier date set by terminal disclaimer; and

(B) Comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(i)(A) of this section with each other and selecting the earlier date; or

(ii) If a request for the authority to prepare an experimental biological product under the Virus-Serum-Toxin Act was submitted before November 16, 1988, and the commercial marketing or use of the product was not approved before November 16, 1988, by —

(A) Adding 3 years to the original expiration date of the patent or earlier date set by terminal disclaimer; and

(B) Comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(ii)(A) of this section with each other and selecting the earlier date.

[Added, 54 FR 30375, July 20, 1989, effective Aug. 22, 1989]

§ 1.780 Certificate or order of extension of patent term.

If a determination is made pursuant to § 1.750 that a patent is eligible for extension and that the term of the patent is to be extended, a certificate of extension, under seal, or an order granting interim extension under 35 U.S.C. 156(d)(5), will be issued to the applicant for the extension of the patent term. Such certificate or order will be recorded in the official file of the patent and will be considered as part of the original patent. Notification of the issuance of the certificate or order of extension will be published in the *Official Gazette of the United States Patent and Trademark Office.* Notification of the issuance of the order granting an interim extension under 35 U.S.C. 156(d)(5), including the identity of the product currently under regulatory review, will be published in the *Official Gazette of the United States Patent and Trademark* Office and in the *Federal Register.* No certificate of, or order granting, an extension will be issued if the term of the patent cannot be extended, even though the patent is otherwise determined to be eligible for extension. In such situations, the final determination made pursuant to § 1.750 will indicate that no certificate or order will issue.

[Added, 52 FR 9399, Mar. 24 1987, effective May 26, 1987; para. (a) revised, 60 FR 25615, May 12, 1995, effective July 11, 1995; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.785 Multiple applications for extension of term of the same patent or of different patents for the same regulatory review period for a product.

(a) Only one patent may be extended for a regulatory review period for any product (§ 1.720(h)). If more than one application for extension of the same patent is filed, the certificate of extension of patent term, if appropriate, will be issued based upon the first filed application for extension.

(b) If more than one application for extension is filed by a single applicant which seeks the extension of the term of two or more patents based upon the same regulatory review period, and the patents are otherwise eligible for extension pursuant to the requirements of this subpart, in the absence of an election by the applicant, the certificate of extension of patent term, if appropriate, will be issued upon the application for extension of the patent term having the earliest date of issuance of those patents for which extension is sought.

(c) If an application for extension is filed which seeks the extension of the term of a patent based upon the same regulatory review period as that relied upon in one or more applications for extension

pursuant to the requirements of this subpart, the certificate of extension of patent term will be issued on the application only if the patent owner or its agent is the holder of the regulatory approval granted with respect to the regulatory review period.

(d) An application for extension shall be considered complete and formal regardless of whether it contains the identification of the holder of the regulatory approval granted with respect to the regulatory review period. When an application contains such information, or is amended to contain such information, it will be considered in determining whether an application is eligible for an extension under this section. A request may be made of any applicant to supply such information within a non-extendable period of not less than one month whenever multiple applications for extension of more than one patent are received and rely upon the same regulatory review period. Failure to provide such information within the period for reply set shall be regarded as conclusively establishing that the applicant is not the holder of the regulatory approval.

(e) Determinations made under this section shall be included in the notice of final determination of eligibility for extension of the patent term pursuant to § 1.750 and shall be regarded as part of that determination.

[Added, 52 FR 9399, Mar. 24 1987, effective May 26, 1987; para. (b) amended, 54 FR 30375, July 20, 1989, effective Aug. 22, 1989; revised, 60 FR 25615, May 12, 1995, effective July 11, 1995; para. (d) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.790 Interim extension of patent term under 35 U.S.C. 156(d)(5).

(a) An owner of record of a patent or its agent who reasonably expects that the applicable regulatory review period described in paragraph (1)(B)(ii), (2)(B)(ii), (3)(B)(ii), (4)(B)(ii), or (5)(B)(ii) of subsection (g) that began for a product that is the subject of such patent may extend beyond the expiration of the patent term in effect may submit one or more applications for interim extensions for periods of up to one year each. The initial application for interim extension must be filed during the period beginning 6 months and ending 15 days before the patent term is due to expire. Each subsequent application for interim extension must be filed during the period beginning 60 days before and ending 30 days before the expiration of the preceding interim extension. In no event will the interim extensions granted under this section be longer than the maximum period of extension to which the applicant would be entitled under 35 U.S.C. 156(c).

(b) A complete application for interim extension under this section shall include all of the information required for a formal application under § 1.740 and a complete application under § 1.741. Sections (a)(1), (a)(2), (a)(4), and (a)(6) - (a)(17) of § 1.740 and § 1.741 shall be read in the context of a product currently undergoing regulatory review. Sections (a)(3) and (a)(5) of § 1.740 are not applicable to an application for interim extension under this section.

(c) The content of each subsequent interim extension application may be limited to a request for a subsequent interim extension along with a statement that the regulatory review period has not been completed along with any materials or information required under §§ 1.740 and 1.741 that are not present in the preceding interim extension application.

[Added, 60 FR 25615, May 12, 1995, effective July 11, 1995]

§ 1.791 Termination of interim extension granted prior to regulatory approval of a product for commercial marketing or use.

Any interim extension granted under 35 U.S.C. 156(d)(5) terminates at the end of the 60-day period beginning on the date on which the product involved receives permission for commercial marketing or use. If within that 60-day period the patent owner or its agent files an application for extension under §§ 1.740 and 1.741 including any additional information required under 35 U.S.C. 156(d)(1) not contained in the application for interim extension, the patent shall be further extended in accordance with the provisions of 35 U.S.C. 156.

[Added, 60 FR 25615, May 12, 1995, effective July 11, 1995]

Subpart G — Biotechnology Invention Disclosures

DEPOSIT OF BIOLOGICAL MATERIAL

§ 1.801 Biological material.

For the purposes of these regulations pertaining to the deposit of biological material for purposes of patents for inventions under 35 U.S.C. 101, the term biological material shall include material that is capable of self-replication either directly or indirectly. Representative examples include bacteria, fungi including yeast, algae, protozoa, eukaryotic cells, cell lines, hybridomas, plasmids, viruses, plant tissue cells, lichens and seeds. Viruses, vectors, cell organelles and other non-living material existing in and reproducible from a living cell may be deposited by deposit of the host cell capable of reproducing the non-living material.

[Added, 54 FR 34880, Aug. 22, 1989, effective Jan. 1, 1990]

§ 1.802 Need or opportunity to make a deposit.

(a) Where an invention is, or relies on, a biological material, the disclosure may include reference to a deposit of such biological material.

(b) Biological material need not be deposited unless access to such material is necessary for the satisfaction of the statutory requirements for patentability under 35 U.S.C. 112. If a deposit is necessary, it shall be acceptable if made in accordance with these regulations. Biological material need not be deposited, *inter alia*, if it is known and readily avaliable [sic] to the public or can be made or isolated without undue experimentation. Once deposited in a depository complying with these regulations, a biological material will be considered to be readily available even though some requirement of law or regulation of the United States or of the country in which the depository institution is located permits access to the material only under conditions imposed for safety, public health or similar reasons.

(c) The reference to a biological material in a specification disclosure or the actual deposit of such material by an applicant or patent owner does not create any presumption that such material is necessary to satisfy 35 U.S.C. 112 or that deposit in accordance with these regulations is or was required.

[Added, 54 FR 34880, Aug. 22, 1989, effective Jan. 1, 1990]

§ 1.803 Acceptable depository.

(a) A deposit shall be recognized for the purposes of these regulations if made in

(1) Any International Depositary Authority (IDA) as established under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure, or

(2) Any other depository recognized to be suitable by the Office. Suitability will be determined by the Director on the basis of the administrative and technical competence, and agreement of the depository to comply with the terms and conditions applicable to deposits for patent purposes. The Director may seek the advice of impartial consultants on the suitability of a depository. The depository must:

(i) Have a continuous existence;

(ii) Exist independent of the control of the depositor;

(iii) Possess the staff and facilities sufficient to examine the viability of a deposit and store the deposit in a manner which ensures that it is kept viable and uncontaminated;

(iv) Provide for sufficient safety measures to minimize the risk of losing biological material deposited with it;

(v) Be impartial and objective;

(vi) Furnish samples of the deposited material in an expeditious and proper manner; and

(vii) Promptly notify depositors of its inability to furnish samples, and the reasons why.

(b) A depository seeking status under paragraph (a)(2) of this section must direct a communication to the Director which shall:

(1) Indicate the name and address of the depository to which the communication relates;

(2) Contain detailed information as to the capacity of the depository to comply with the requirements of paragraph (a)(2) of this section, including information on its legal status, scientific standing, staff and facilities;

(3) Indicate that the depository intends to be available, for the purposes of deposit, to any depositor under these same conditions;

(4) Where the depository intends to accept for deposit only certain kinds of biological material, specify such kinds;

(5) Indicate the amount of any fees that the depository will, upon acquiring the status of suitable depository under paragraph (a)(2) of this section, charge for storage, viability statements and furnishings of samples of the deposit.

(c) A depository having status under paragraph (a)(2) of this section limited to certain kinds of biological material may extend such status to additional kinds of biological material by directing a communication to the Director in accordance with paragraph (b) of this section. If a previous communication under paragraph (b) of this section is of record, items in common with the previous communication may be incorporated by reference.

(d) Once a depository is recognized to be suitable by the Director or has defaulted or discontinued its performance under this section, notice thereof will be published in the Office Gazette of the Patent and Trademark Office.

[Added, 54 FR 34881, Aug. 22, 1989, effective Jan. 1, 199; paras. (a)(2) & (b)-(d) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

§ 1.804 Time of making an original deposit.

(a) Whenever a biological material is specifically identified in an application for patent as filed, an original deposit thereof may be made at any time before filing the application for patent or, subject to § 1.809, during pendency of the application for patent.

(b) When the original deposit is made after the effective filing date of an application for patent, the applicant must promptly submit a statement from a person in a position to corroborate the fact, stating that the biological material which is deposited is a biological material specifically identified in the application as filed.

[Added, 54 FR 34881, Aug. 22, 1989, effective Jan. 1, 1990; para. (b) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.805 Replacement or supplement of deposit.

(a) A depositor, after receiving notice during the pendency of an application for patent, application for reissue patent or reexamination proceeding, that the depository possessing a deposit either cannot furnish samples thereof or can furnish samples thereof but the deposit has become contaminated or has lost its capability to function as described in the specification, shall notify the Office in writing, in each application for patent or patent affected. In such a case, or where the Office otherwise learns, during the pendency of an application for patent, application for reissue patent or reexamination proceeding, that the depository possessing a deposit either cannot furnish samples thereof or can furnish samples thereof but the deposit has become contaminated or has lost its capability to function as described in the specification, the need for making a replacement or supplemental deposit will be governed by the same considerations governing the need for making an original deposit under the provisions set forth in § 1.802(b). A replacement or supplemental deposit made during the pendency of an application for patent shall not be accepted unless it meets the requirements for making an original deposit under these regulations, including the requirement set forth under § 1.804(b). A replacement or supplemental deposit made in connection with a patent, whether or not made during the pendency of an application for reissue patent or a reexamination proceeding or both, shall not be accepted unless a certificate of correction under § 1.323 is requested by the patent owner which meets the terms of paragraphs (b) and (c) of this section.

(b) A request for certificate of correction under this section shall not be granted unless the certificate identifies:

(1) The accession number for the replacement or supplemental deposit;

(2) The date of the deposit; and

(3) The name and address of the depository.

(c) A request for a certificate of correction under this section shall not be granted unless the request is made promptly after the replacement or supplemental deposit has been made and the request:

(1) Includes a statement of the reason for making the replacement or supplemental deposit;

(2) Includes a statement from a person in a position to corroborate the fact, and stating that the replacement or supplemental deposit is of a biological material which is identical to that originally deposited;

(3) Includes a showing that the patent owner acted diligently —

(i) In the case of a replacement deposit, in making the deposit after receiving notice that samples could no longer be furnished from an earlier deposit; or

(ii) In the case of a supplemental deposit, in making the deposit after receiving notice that the earlier deposit had become contaminated or had lost its capability to function as described in the specification;

(4) Includes a statement that the term of the replacement or supplemental deposit expires no earlier than the term of the deposit being replaced or supplemented; and

(5) Otherwise establishes compliance with these regulations.

(d) A depositor's failure to replace a deposit, or in the case of a patent, to diligently replace a deposit and promptly thereafter request a certificate of correction which meets the terms of paragraphs (b) and (c) of this section, after being notified that the depository possessing the deposit cannot furnish samples thereof, shall cause the application or patent involved to be treated in any Office proceeding as if no deposit were made.

(e) In the event a deposit is replaced according to these regulations, the Office will apply a rebuttable presumption of identity between the original and the replacement deposit where a patent making reference to the deposit is relied upon during any Office proceeeding [sic].

(f) A replacement or supplemental deposit made during the pendency of an application for patent may be made for any reason.

(g) In no case is a replacement or supplement [sic] deposit of a biological material necessary where the biological material, in accordance with § 1.802(b), need not be deposited.

(h) No replacement deposit of a biological material is necessary where a depository can furnish samples thereof but the depository for national security, health or environmental safety reasons is unable to provide samples to requesters outside of the jurisdiction where the depository is located.

(i) The Office will not recognize in any Office proceeding a replacement deposit of a biological material made by a patent owner where the depository could furnish samples of the deposit being replaced.

[Added, 54 FR 34881, Aug. 22, 1989, effective Jan. 1, 1990; para. (c) revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.806 Term of deposit.

A deposit made before or during pendency of an application for patent shall be made for a term of at least thirty (30) years and at least five (5) years after the most recent request for the furnishing of a sample of the deposit was received by the depository. In any case, samples must be stored under agreements that would make them available beyond the enforceable life of the patent for which the deposit was made.

[Added, 54 FR 34882, Aug. 22, 1989, effective Jan. 1, 1990]

§ 1.807 Viability of deposit.

(a) A deposit of biological material that is capable of self-replication either directly or indirectly must be viable at the time of deposit and during the term of deposit. Viability may be tested by the depository. The test must conclude only that the deposited material is capable of reproduction. No evidence is necessarily required regarding the ability of the deposited material to perform any function described in the patent application.

(b) A viability statement for each deposit of a biological material defined in paragraph (a) of this section not made under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent

Procedure must be filed in the application and must contain:

(1) The name and address of the depository;

(2) The name and address of the depositor;

(3) The date of deposit;

(4) The identity of the deposit and the accession number given by the depository;

(5) The date of the viability test;

(6) The procedures used to obtain a sample if the test is not done by the depository; and

(7) A statement that the deposit is capable of reproduction.

(c) If a viability test indicates that the deposit is not viable upon receipt, or the examiner cannot, for scientific or other valid reasons, accept the statement of viability received from the applicant, the examiner shall proceed as if no deposit has been made. The examiner will accept the conclusion set forth in a viability statement issued by a depository recognized under § 1.803(a).

[Added, 54 FR 34882, Aug. 22, 1989, effective Jan. 1, 1990]

§ 1.808 Furnishing of samples.

(a) A deposit must be made under conditions that assure that:

(1) Access to the deposit will be available during pendency of the patent application making reference to the deposit to one determined by the Director to be entitled thereto under § 1.14 and 35 U.S.C. 122, and

(2) Subject to paragraph (b) of this section, all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon the granting of the patent.

(b) The depositor may contract with the depository to require that samples of a deposited biological material shall be furnished only if a request for a sample, during the term of the patent:

(1) Is in writing or other tangible form and dated;

(2) Contains the name and address of the requesting party and the accession number of the deposit; and

(3) Is communicated in writing by the depository to the depositor along with the date on which the sample was furnished and the name and address of the party to whom the sample was furnished.

(c) Upon request made to the Office, the Office will certify whether a deposit has been stated to have been made under conditions which make it available to the public as of the issue date of the patent grant provided the request contains:

(1) The name and address of the depository;

(2) The accession number given to the deposit;

(3) The patent number and issue date of the patent referring to the deposit; and

(4) The name and address of the requesting party.

[Added, 54 FR 34882, Aug. 22, 1989, effective Jan. 1, 199; para. (a)(1) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

§ 1.809 Examination procedures.

(a) The examiner shall determine pursuant to § 1.104 in each application for patent, application for reissue patent or reexamination proceeding if a deposit is needed, and if needed, if a deposit actually made is acceptable for patent purposes. If a deposit is needed and has not been made or replaced or supplemented in accordance with these regulations, the examiner, where appropriate, shall reject the affected claims under the appropriate provision of 35 U.S.C. 112, explaining why a deposit is needed and/or why a deposit actually made cannot be accepted.

(b) The applicant for patent or patent owner shall reply to a rejection under paragraph (a) of this section by—

(1) In the case of an applicant for patent, either making an acceptable original, replacement, or supplemental deposit, or assuring the Office in writing that an acceptable deposit will be made; or, in the case of a patent owner, requesting a certificate of correction of the patent which meets the terms of paragraphs (b) and (c) of § 1.805, or

(2) Arguing why a deposit is not needed under the circumstances of the application or patent considered and/or why a deposit actually made

should be accepted. Other replies to the examiner's action shall be considered nonresponsive. The rejection will be repeated until either paragraph (b)(1) of this section is satisfied or the examiner is convinced that a deposit is not needed.

(c) If an application for patent is otherwise in condition for allowance except for a needed deposit and the Office has received a written assurance that an acceptable deposit will be made, the Office may notify the applicant in a notice of allowability and set a three-month period of time from the mailing date of the notice of allowability within which the deposit must be made in order to avoid abandonment. This time period is not extendable under § 1.136 (*see* § 1.136(c)).

(d) For each deposit made pursuant to these regulations, the specification shall contain:

(1) The accession number for the deposit;

(2) The date of the deposit;

(3) A description of the deposited biological material sufficient to specifically identify it and to permit examination; and

(4) The name and address of the depository.

(e) Any amendment required by paragraphs (d)(1), (d)(2) or (d)(4) of this section must be filed before or with the payment of the issue fee (see § 1.312).

[Added, 54 FR 34882, Aug. 22, 1989, effective Jan. 1, 1990; paras. (b) and (c) revised and para. (e) added, 66 FR 21092, Apr. 27, 2001, effective May 29, 2001; para. (c) revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013]

APPLICATION DISCLOSURES CONTAINING NUCLEOTIDE AND/OR AMINO ACID SEQUENCES

§ 1.821 Nucleotide and/or amino acid sequence disclosures in patent applications.

(a) Nucleotide and/or amino acid sequences as used in §§ 1.821 through 1.825 are interpreted to mean an unbranched sequence of four or more amino acids or an unbranched sequence of ten or more nucleotides. Branched sequences are specifically excluded from this definition. Sequences with fewer than four specifically defined nucleotides or amino acids are specifically excluded from this section. "Specifically defined" means those amino acids other than "Xaa" and those nucleotide bases other than "n" defined in accordance with the World Intellectual Property Organization (WIPO) Handbook on Industrial Property Information and Documentation, Standard ST.25: Standard for the Presentation of Nucleotide and Amino Acid Sequence Listings in Patent Applications (1998), including Tables 1 through 6 in Appendix 2, herein incorporated by reference. (Hereinafter "WIPO Standard ST.25 (1998)"). This incorporation by reference was approved by the Director of the Federal Register in accordance with 5 U.S.C. 552(a) and 1 CFR part 51. Copies of WIPO Standard ST.25 (1998) may be obtained from the World Intellectual Property Organization; 34 chemin des Colombettes; 1211 Geneva 20 Switzerland. Copies may also be inspected at the National Archives and Records Administration (NARA). For information on the availability of this material at NARA, call 202-741-6030, or go to: ***http://www.archives.gov/federal_register/code_of_federal_regulations/ ibr_locations.html***. Nucleotides and amino acids are further defined as follows:

(1) *Nucleotides:* Nucleotides are intended to embrace only those nucleotides that can be represented using the symbols set forth in WIPO Standard ST.25 (1998), Appendix 2, Table 1. Modifications, *e.g.*, methylated bases, may be described as set forth in WIPO Standard ST.25 (1998), Appendix 2, Table 2, but shall not be shown explicitly in the nucleotide sequence.

(2) *Amino acids:* Amino acids are those L-amino acids commonly found in naturally occurring proteins and are listed in WIPO Standard ST.25 (1998), Appendix 2, Table 3. Those amino acid sequences containing D-amino acids are not intended to be embraced by this definition. Any amino acid sequence that contains post-translationally modified amino acids may be described as the amino acid sequence that is initially translated using the symbols shown in WIPO Standard ST.25 (1998), Appendix 2, Table 3 with the modified positions; *e.g.*, hydroxylations or glycosylations, being described as set forth in WIPO Standard ST.25 (1998), Appendix 2, Table 4, but these modifications shall not be shown explicitly in the amino acid sequence. Any peptide or protein that can be expressed as a sequence using the

symbols in WIPO Standard ST.25 (1998), Appendix 2, Table 3 in conjunction with a description in the Feature section to describe, for example, modified linkages, cross links and end caps, non-peptidyl bonds, etc., is embraced by this definition.

(b) Patent applications which contain disclosures of nucleotide and/or amino acid sequences, in accordance with the definition in paragraph (a) of this section, shall, with regard to the manner in which the nucleotide and/or amino acid sequences are presented and described, conform exclusively to the requirements of §§ 1.821 through 1.825.

(c) Patent applications which contain disclosures of nucleotide and/or amino acid sequences must contain, as a separate part of the disclosure, a paper or compact disc copy (*see* § 1.52(e)) disclosing the nucleotide and/or amino acid sequences and associated information using the symbols and format in accordance with the requirements of §§ 1.822 and 1.823. This paper or compact disc copy is referred to elsewhere in this subpart as the "Sequence Listing." Each sequence disclosed must appear separately in the "Sequence Listing." Each sequence set forth in the "Sequence Listing" must be assigned a separate sequence identifier. The sequence identifiers must begin with 1 and increase sequentially by integers. If no sequence is present for a sequence identifier, the code "000" must be used in place of the sequence. The response for the numeric identifier <160> must include the total number of SEQ ID NOs, whether followed by a sequence or by the code "000."

(d) Where the description or claims of a patent application discuss a sequence that is set forth in the "Sequence Listing" in accordance with paragraph (c) of this section, reference must be made to the sequence by use of the sequence identifier, preceded by "SEQ ID NO:" in the text of the description or claims, even if the sequence is also embedded in the text of the description or claims of the patent application.

(e) A copy of the "Sequence Listing" referred to in paragraph (c) of this section must also be submitted in computer readable form (CRF) in accordance with the requirements of § 1.824. The computer readable form must be a copy of the "Sequence Listing" and may not be retained as a part of the patent application file. If the computer readable form of a new application is to be identical with the computer readable form of another application of the applicant on file in the Office, reference may be made to the other application and computer readable form in lieu of filing a duplicate computer readable form in the new application if the computer readable form in the other application was compliant with all of the requirements of this subpart. The new application must be accompanied by a letter making such reference to the other application and computer readable form, both of which shall be completely identified. In the new application, applicant must also request the use of the compliant computer readable "Sequence Listing" that is already on file for the other application and must state that the paper or compact disc copy of the "Sequence Listing" in the new application is identical to the computer readable copy filed for the other application.

(f) In addition to the paper or compact disc copy required by paragraph (c) of this section and the computer readable form required by paragraph (e) of this section, a statement that the "Sequence Listing" content of the paper or compact disc copy and the computer readable copy are the same must be submitted with the computer readable form, *e.g.*, a statement that "the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing."

(g) If any of the requirements of paragraphs (b) through (f) of this section are not satisfied at the time of filing under 35 U.S.C. 111(a) or at the time of entering the national stage under 35 U.S.C. 371, applicant will be notified and given a period of time within which to comply with such requirements in order to prevent abandonment of the application. Any submission in reply to a requirement under this paragraph must be accompanied by a statement that the submission includes no new matter.

(h) If any of the requirements of paragraphs (b) through (f) of this section are not satisfied at the time of filing an international application under the Patent Cooperation Treaty (PCT), which application is to be searched by the United States International Searching Authority or examined by the United States International Preliminary Examining Authority, applicant will be sent a notice necessitating compliance with the requirements within a prescribed time period. Any submission in reply to a requirement under this paragraph must be

accompanied by a statement that the submission does not include matter which goes beyond the disclosure in the international application as filed. If applicant fails to timely provide the required computer readable form, the United States International Searching Authority shall search only to the extent that a meaningful search can be performed without the computer readable form and the United States International Preliminary Examining Authority shall examine only to the extent that a meaningful examination can be performed without the computer readable form.

[Added, 55 FR 18230, May 1, 1990, effective Oct. 1, 1990; para. (h) amended, 58 FR 9335, Jan. 14, 1993, effective May 1, 1993; revised, 63 FR 29620, June 1, 1998, effective July 1, 1998; paras. (c), (e), and (f) revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000 (effective date corrected, 65 FR 78958, Dec. 18, 2000); para. (a) revised, 70 FR 10488, Mar. 4, 2005, effective Mar. 4, 2005]

§ 1.822 Symbols and format to be used for nucleotide and/or amino acid sequence data.

(a) The symbols and format to be used for nucleotide and/or amino acid sequence data shall conform to the requirements of paragraphs (b) through (e) of this section.

(b) The code for representing the nucleotide and/or amino acid sequence characters shall conform to the code set forth in the tables in WIPO Standard ST.25 (1998), Appendix 2, Tables 1 and 3. This incorporation by reference was approved by the Director of the Federal Register in accordance with 5 U.S.C. 552(a) and 1 CFR part 51. Copies of ST.25 may be obtained from the World Intellectual Property Organization; 34 chemin des Colombettes; 1211 Geneva 20 Switzerland. Copies may also be inspected at the National Archives and Records Administration (NARA). For information on the availability of this material at NARA, call 202-741-6030, or go to: ***http://www.archives.gov/federal_register/code_of_federal_regulations/ ibr_locations.html***. No code other than that specified in these sections shall be used in nucleotide and amino acid sequences. A modified base or modified or unusual amino acid may be presented in a given sequence as the corresponding unmodified base or amino acid if the modified base or modified or unusual amino acid is one of those listed in WIPO Standard ST.25 (1998), Appendix 2, Tables 2 and 4, and the modification is also set forth in the Feature section. Otherwise, each occurrence of a base or amino acid not appearing in WIPO Standard ST.25 (1998), Appendix 2, Tables 1 and 3, shall be listed in a given sequence as “n” or “Xaa,” respectively, with further information, as appropriate, given in the Feature section, preferably by including one or more feature keys listed in WIPO Standard ST.25 (1998), Appendix 2, Tables 5 and 6.

(c) *Format representation of nucleotides.*

(1) A nucleotide sequence shall be listed using the lower-case letter for representing the one-letter code for the nucleotide bases set forth in WIPO Standard ST.25 (1998), Appendix 2, Table 1.

(2) The bases in a nucleotide sequence (including introns) shall be listed in groups of 10 bases except in the coding parts of the sequence. Leftover bases, fewer than 10 in number, at the end of noncoding parts of a sequence shall be grouped together and separated from adjacent groups of 10 or 3 bases by a space.

(3) The bases in the coding parts of a nucleotide sequence shall be listed as triplets (codons). The amino acids corresponding to the codons in the coding parts of a nucleotide sequence shall be typed immediately below the corresponding codons. Where a codon spans an intron, the amino acid symbol shall be typed below the portion of the codon containing two nucleotides.

(4) A nucleotide sequence shall be listed with a maximum of 16 codons or 60 bases per line, with a space provided between each codon or group of 10 bases.

(5) A nucleotide sequence shall be presented, only by a single strand, in the 5 to 3 direction, from left to right.

(6) The enumeration of nucleotide bases shall start at the first base of the sequence with number 1. The enumeration shall be continuous through the whole sequence in the direction 5 to 3. The enumeration shall be marked in the right margin, next to the line containing the one-letter codes for the bases, and giving the number of the last base of that line.

(7) For those nucleotide sequences that are circular in configuration, the enumeration method

set forth in paragraph (c)(6) of this section remains applicable with the exception that the designation of the first base of the nucleotide sequence may be made at the option of the applicant.

(d) *Representation of amino acids.*

(1) The amino acids in a protein or peptide sequence shall be listed using the three-letter abbreviation with the first letter as an upper case character, as in WIPO Standard ST.25 (1998), Appendix 2, Table 3.

(2) A protein or peptide sequence shall be listed with a maximum of 16 amino acids per line, with a space provided between each amino acid.

(3) An amino acid sequence shall be presented in the amino to carboxy direction, from left to right, and the amino and carboxy groups shall not be presented in the sequence.

(4) The enumeration of amino acids may start at the first amino acid of the first mature protein, with the number 1. When presented, the amino acids preceding the mature protein, *e.g.*, pre-sequences, pro-sequences, pre-pro-sequences and signal sequences, shall have negative numbers, counting backwards starting with the amino acid next to number 1. Otherwise, the enumeration of amino acids shall start at the first amino acid at the amino terminal as number 1. It shall be marked below the sequence every 5 amino acids. The enumeration method for amino acid sequences that is set forth in this section remains applicable for amino acid sequences that are circular in configuration, with the exception that the designation of the first amino acid of the sequence may be made at the option of the applicant.

(5) An amino acid sequence that contains internal terminator symbols (*e.g.*, "Ter", "*", or ".", etc.) may not be represented as a single amino acid sequence, but shall be presented as separate amino acid sequences.

(e) A sequence with a gap or gaps shall be presented as a plurality of separate sequences, with separate sequence identifiers, with the number of separate sequences being equal in number to the number of continuous strings of sequence data. A sequence that is made up of one or more noncontiguous segments of a larger sequence or segments from different sequences shall be presented as a separate sequence.

[Added, 55 FR 18230, May 1, 1990, effective Oct. 1, 1990; revised, 63 FR 29620, June 1, 1998, effective, July 1, 1998; para. (b) revised, 70 FR 10488, Mar. 4, 2005, effective Mar. 4, 2005]

§ 1.823 Requirements for nucleotide and/or amino acid sequences as part of the application.

(a)(1) If the "Sequence Listing" required by § 1.821(c) is submitted on paper: The "Sequence Listing," setting forth the nucleotide and/or amino acid sequence and associated information in accordance with paragraph (b) of this section, must begin on a new page and must be titled "Sequence Listing." The pages of the "Sequence Listing" preferably should be numbered independently of the numbering of the remainder of the application. Each page of the "Sequence Listing" shall contain no more than 66 lines and each line shall contain no more than 72 characters. The sheet or sheets presenting a sequence listing may not include material other than part of the sequence listing. A fixed-width font should be used exclusively throughout the "Sequence Listing."

(2) If the "Sequence Listing" required by § 1.821(c) is submitted on compact disc: The "Sequence Listing" must be submitted on a compact disc in compliance with § 1.52(e). The compact disc may also contain table information if the application contains table information that may be submitted on a compact disc (§ 1.52(e)(1)(iii)). The specification must contain an incorporation-by-reference of the Sequence Listing as required by § 1.52(e)(5). The presentation of the "Sequence Listing" and other materials on compact disc under § 1.821(c) does not substitute for the Computer Readable Form that must be submitted on disk, compact disc, or tape in accordance with § 1.824.

(b) The "Sequence Listing" shall, except as otherwise indicated, include the actual nucleotide and/or amino acid sequence, the numeric identifiers and their accompanying information as shown in the following table. The numeric identifier shall be used only in the "Sequence Listing." The order and presentation of the items of information in the "Sequence Listing" shall conform to the arrangement given below. Each item of information shall begin on a new line and shall begin with the

numeric identifier enclosed in angle brackets as shown. The submission of those items of information designated with an “M” is mandatory. The submission of those items of information designated with an “O” is optional. Numeric identifiers <110> through <170> shall only be set forth at the beginning of the “Sequence Listing.” The following table illustrates the numeric identifiers.

Numeric Identifier	Definition	Comments and format	Mandatory (M) or Optional (O)
<110>	Applicant.....	Preferably max. of 10 names; one name per line; preferable format: Surname, Other Names and/or Initials.	M.
<120>	Title of Invention.....	.....	M.
<130>	File Reference.....	Personal file reference.....	M when filed prior to assignment or appl. number
<140>	Current Application Number.	Specify as: US 07/999,999 or PCT/US96/99999.	M, if available.
<141>	Current Filing Date.....	Specify as: yyyy-mm-dd.....	M, if available.
<150>	Prior Application Number.	Specify as: US 07/999,999 or PCT/US96/99999.	M, if applicable include priority documents under 35 U.S.C. 119 and 120
<151>	Prior Application Filing Date.	Specify as: yyyy-mm-dd	M, if applicable
<160>	Number of SEQ ID NOs.	Count includes total number of SEQ ID NOs.....	M.
<170>	Software.....	Name of software used to create the Sequence Listing.	O.
<210>	SEQ ID NO:#:.....	Response shall be an integer representing the SEQ ID NO shown.	M.
<211>	Length.....	Respond with an integer expressing the number of bases or amino acid residues.	M.
<212>	Type.....	Whether presented sequence molecule is DNA, RNA, or PRT (protein). If a nucleotide sequence contains both DNA and RNA fragments, the type shall be “DNA.” In addition, the combined DNA/ RNA molecule shall be further described in the <220> to <223> feature section.	M.
<213>	Organism.....	Scientific name, i.e. Genus/ species, Unknown or Artificial Sequence. In addition, the “Unknown” or “Artificial Sequence” organisms shall be further described in the <220> to <223> feature section.	M.
<220>	Feature.....	Leave blank after <220>. <221-223> provide for a description of points of	M, under the following conditions: if “n,” “Xaa,” or a modified or unusual L-amino acid or modified base was

Numeric Identifier	Definition	Comments and format	Mandatory (M) or Optional (O)
		biological significance in the sequence.	used in a sequence; if ORGANISM is “Artificial Sequence” or “Unknown”; if molecule is combined DNA/RNA.
<221>	Name/Key.....	Provide appropriate identifier for feature, preferably from WIPO Standard ST.25 (1998), Appendix 2, Tables 5 and 6.	M, under the following conditions: if “n,” “Xaa,” or a modified or unusual L-amino acid or modified base was used in a sequence.
Numeric Identifier	Definition	Comments and format	Mandatory (M) or Optional (O)
<222>	Location.....	Specify location within sequence; where appropriate state number of first and last bases/amino acids in feature.	M, under the following conditions: if “n,” “Xaa,” or a modified or unusual L-amino acid or modified base was used in a sequence.
<223>	Other Information.....	Other relevant information; four lines maximum.....	M, under the following conditions: if “n,” “Xaa,” or a modified or unusual L-amino acid or modified base was used in a sequence; if ORGANISM is “Artificial Sequence” or “Unknown”; if molecule is combined DNA/RNA.
<300>	Publication Information	Leave blank after <300>	O.
<301>	Authors.....	Preferably max. of ten named authors of publication; specify one name per line; preferable format: Surname, Other Names and/or Initials.	O.
<302>	Title.....	.....	O.
<303>	Journal.....	.....	O.
<304>	Volume	.....	O.
<305>	Issue	.....	O.
<306>	Pages	.....	O.
<307>	Date.....	Journal date on which data published; specify as yyyy- mm-dd, MMM-yyyy or Season- yyyy.	O.
<308>	Database Accession Number.	Accession number assigned by database including database name.	O.
<309>	Database Entry Date.....	Date of entry in database; specify as yyyy-mm-dd or MMM-yyyy.	O.
<310>	Patent Document Number.	Document number; for patent-type citations only. Specify as, for example, US 07/ 999,999.	O.
<311>	Patent Filing Date.....	Document filing date, for patent-type citations only; specify as yyyy-mm-dd.	O.
<312>	Publication Date.....	Document publication date, for patent-type citations only; specify as yyyy-mm-dd.	O.

Numeric Identifier	Definition	Comments and format	Mandatory (M) or Optional (O)
<313>	Relevant Residues.....	FROM (position) TO (position).....	O.
<400>	Sequence.....	SEQ ID NO should follow the numeric identifier and should appear on the line preceding the actual sequence.	M.

[Added, 55 FR 18230, May 1, 1990, effective Oct. 1, 1990; revised, 63 FR 29620, June 1, 1998, effective July 1, 1998; heading and para. (a) revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000 (effective date corrected, 65 FR 78958, Dec. 18, 2000); para. (a)(1) revised, 68 FR 38611, June 30, 2003, effective July 30, 2003]

§ 1.824 Form and format for nucleotide and/or amino acid sequence submissions in computer readable form.

(a) The computer readable form required by § 1.821(e) shall meet the following requirements:

(1) The computer readable form shall contain a single "Sequence Listing" as either a diskette, series of diskettes, or other permissible media outlined in paragraph (c) of this section.

(2) The "Sequence Listing" in paragraph (a)(l) of this section shall be submitted in American Standard Code for Information Interchange (ASCII) text. No other formats shall be allowed.

(3) The computer readable form may be created by any means, such as word processors, nucleotide/amino acid sequence editors' or other custom computer programs; however, it shall conform to all requirements detailed in this section.

(4) File compression is acceptable when using diskette media, so long as the compressed file is in a self-extracting format that will decompress on one of the systems described in paragraph (b) of this section.

(5) Page numbering must not appear within the computer readable form version of the "Sequence Listing" file.

(6) All computer readable forms must have a label permanently affixed thereto on which has been hand-printed or typed: the name of the applicant, the title of the invention, the date on which the data were recorded on the computer readable form, the operating system used, a reference number, and an application number and filing date, if known. If multiple diskettes are submitted, the diskette labels must indicate their order (*e.g.*, "1 of X").

(b) Computer readable form submissions must meet these format requirements:

(1) Computer Compatibility: IBM PC/XT/AT or Apple Macintosh;

(2) Operating System Compatibility: MS-DOS, MS-Windows, Unix or Macintosh;

(3) Line Terminator: ASCII Carriage Return plus ASCII Line Feed; and

(4) Pagination: Continuous file (no "hard page break" codes permitted).

(c) Computer readable form files submitted may be in any of the following media:

(1) Diskette: 3.50 inch, 1.44 Mb storage; 3.50 inch, 720 Kb storage; 5.25 inch, 1.2 Mb storage; 5.25 inch, 360 Kb storage.

(2) Magnetic tape: 0.5 inch, up to 24000 feet; Density: 1600 or 6250 bits per inch, 9 track; Format: Unix tar command; specify blocking factor (not "block size"); Line Terminator: ASCII Carriage Return plus ASCII Line Feed.

(3) 8mm Data Cartridge: Format: Unix tar command; specify blocking factor (not "block size"); Line Terminator: ASCII Carriage Return plus ASCII Line Feed.

(4) Compact disc: Format: ISO 9660 or High Sierra Format.

(5) Magneto Optical Disk: Size/Storage Specifications: 5.25 inch, 640 Mb.

(d) Computer readable forms that are submitted to the Office will not be returned to the applicant.

[Added, 55 FR 18230, May 1, 1990, effective Oct. 1, 1990; revised, 63 FR 29620, June 1, 1998, effective

July 1, 1998; revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000 (effective date corrected, 65 FR 78958, Dec. 18, 2000)]

§ 1.825 Amendments to or replacement of sequence listing and computer readable copy thereof.

(a) Any amendment to a paper copy of the "Sequence Listing" (§ 1.821(c)) must be made by the submission of substitute sheets and include a statement that the substitute sheets include no new matter. Any amendment to a compact disc copy of the "Sequence Listing" (§ 1.821(c)) must be made by the submission of a replacement compact disc (2 copies) in compliance with § 1.52(e). Amendments must also be accompanied by a statement that indicates support for the amendment in the application, as filed, and a statement that the replacement compact disc includes no new matter.

(b) Any amendment to the paper or compact disc copy of the "Sequence Listing," in accordance with paragraph (a) of this section, must be accompanied by a substitute copy of the computer readable form (§ 1.821(e)) including all previously submitted data with the amendment incorporated therein, accompanied by a statement that the copy in computer readable form is the same as the substitute copy of the "Sequence Listing."

(c) Any appropriate amendments to the "Sequence Listing" in a patent; *e.g.*, by reason of reissue or certificate of correction, must comply with the requirements of paragraphs (a) and (b) of this section.

(d) If, upon receipt, the computer readable form is found to be damaged or unreadable, applicant must provide, within such time as set by the Director, a substitute copy of the data in computer readable form accompanied by a statement that the substitute data is identical to that originally filed.

[Added 55 FR 18230, May 1, 1990, effective Oct. 1, 1990; revised, 63 FR 29620, June 1, 1998, effective July 1, 1998; paras. (a) and (b) revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000 (effective date corrected, 65 FR 78958, Dec. 18, 2000); para. (d) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

APPENDIX A TO SUBPART G TO PART 1 — SAMPLE SEQUENCE LISTING

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<110> Smith, John
      Smith, Jane

<120> Example of a Sequence Listing

<130> 01-00001

<140> US 08/999,999

<141> 1998-02-28

<150> EP 91000000
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<160> 2

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<213> Paramecium aurelia

<220>
<221> CDS
<222> 341..394

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<301> Doe, Richard
<302> Isolation and Characterization of a Gene Encoding a
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<303> Journal of Fictional Genes
<304> 1
<305> 4
<306> 1 - 7
<307> 1988-06-20

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ctgactgact ctgagatagt cgagcccgta cgagacccgt cgagggtgac agagagtggg      180

cgcgtgcgcg cagagcgccg cgccggtgcg cgcgcgagtg cgcggtgggc cgcgcgaggg      240

ctttcgcggc agcggcggcg ctttccggcg cgcgcccgtc cgcccctaga cctgagaggt      300

cttctcttcc ctcctcttca ctagagaggt ctatatatac atg gtt tca atg ttc        355

                                             Met Val Ser Met Phe
                                             1               5
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                 10                  15

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<400> 2

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Phe Val
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Subpart H — *Inter Partes* Reexamination of Patents That Issued From an Original Application Filed in the United States on or After November 29, 1999

PRIOR ART CITATIONS

§ 1.902 Processing of prior art citations during an *inter partes* reexamination proceeding.

Citations by the patent owner in accordance with § 1.933 and by an *inter partes* reexamination third party requester under § 1.915 or § 1.948 will be entered in the *inter partes* reexamination file. The entry in the patent file of other citations submitted after the date of an order for reexamination pursuant to § 1.931 by persons other than the patent owner, or the third party requester under either § 1.913 or § 1.948, will be delayed until the *inter partes* reexamination proceeding has been concluded by the issuance and publication of a reexamination certificate. See § 1.502 for processing of prior art citations in patent and reexamination files during an *ex parte* reexamination proceeding filed under § 1.510.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; revised, 72 FR 18892, Apr. 16, 2007, effective May 16, 2007]

REQUIREMENTS FOR *INTER PARTES* REEXAMINATION PROCEEDINGS

§ 1.903 Service of papers on parties in *inter partes* reexamination.

The patent owner and the third party requester will be sent copies of Office actions issued during the *inter partes* reexamination proceeding. After filing of a request for *inter partes* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on every other party in the reexamination proceeding in the manner provided in § 1.248. Any document must reflect service or the document may be refused consideration by the Office. The failure of the patent owner or the third party requester to serve documents may result in their being refused consideration.

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

§ 1.904 Notice of *inter partes* reexamination in Official Gazette.

A notice of the filing of an *inter partes* reexamination request will be published in the *Official Gazette.* The notice published in the *Official Gazette* under § 1.11(c) will be considered to be constructive notice of the *inter partes* reexamination

proceeding and *inter partes* reexamination will proceed.

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

§ 1.905 Submission of papers by the public in *inter partes* reexamination.

Unless specifically provided for, no submissions on behalf of any third parties other than third party requesters as defined in 35 U.S.C. 100(e) will be considered unless such submissions are in accordance with § 1.915 or entered in the patent file prior to the date of the order for reexamination pursuant to § 1.931. Submissions by third parties, other than third party requesters, filed after the date of the order for reexamination pursuant to § 1.931, must meet the requirements of § 1.501 and will be treated in accordance with § 1.902. Submissions which do not meet the requirements of § 1.501 will be returned.

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

§ 1.906 Scope of reexamination in *inter partes* reexamination proceeding.

(a) Claims in an *inter partes* reexamination proceeding will be examined on the basis of patents or printed publications and, with respect to subject matter added or deleted in the reexamination proceeding, on the basis of the requirements of 35 U.S.C. 112.

(b) Claims in an *inter partes* reexamination proceeding will not be permitted to enlarge the scope of the claims of the patent.

(c) Issues other than those indicated in paragraphs (a) and (b) of this section will not be resolved in an *inter partes* reexamination proceeding. If such issues are raised by the patent owner or the third party requester during a reexamination proceeding, the existence of such issues will be noted by the examiner in the next Office action, in which case the patent owner may desire to consider the advisability of filing a reissue application to have such issues considered and resolved.

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

§ 1.907 *Inter partes* reexamination prohibited.

(a) Once an order to reexamine has been issued under § 1.931, neither the third party requester, nor its privies, may file a subsequent request for *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued under § 1.997, unless authorized by the Director.

(b) Once a final decision has been entered against a party in a civil action arising in whole or in part under 28 U.S.C. 1338 that the party has not sustained its burden of proving invalidity of any patent claim-in-suit, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such civil action, and an *inter partes* reexamination requested by that party, or its privies, on the basis of such issues may not thereafter be maintained by the Office.

(c) If a final decision in an *inter partes* reexamination proceeding instituted by a third party requester is favorable to patentability of any original, proposed amended, or new claims of the patent, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claims on the basis of issues which that party, or its privies, raised or could have raised in such *inter partes* reexamination proceeding.

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

§ 1.913 Persons eligible to file, and time for filing, a request for *inter partes* reexamination.

(a) Except as provided for in § 1.907 and in paragraph (b) of this section, any person other than the patent owner or its privies may, at any time during the period of enforceability of a patent which issued from an original application filed in the United States on or after November 29, 1999, file a request for *inter partes* reexamination by the Office of any claim of the patent on the basis of

prior art patents or printed publications cited under § 1.501.

(b) Any request for an *inter partes* reexamination submitted on or after September 16, 2012, will not be accorded a filing date, and any such request will not be granted.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; revised, 68 FR 70996, Dec. 22, 2003, effective Jan. 21, 2004; revised, 76 FR 59055, Sept. 23, 2011, effective Sept. 23, 2011]

§ 1.915 Content of request for *inter partes* reexamination.

(a) The request must be accompanied by the fee for requesting *inter partes* reexamination set forth in § 1.20(c)(2).

(b) A request for *inter partes* reexamination must include the following parts:

(1) An identification of the patent by patent number and every claim for which reexamination is requested.

(2) A citation of the patents and printed publications which are presented to provide a showing that there is a reasonable likelihood that the requester will prevail with respect to at least one of the claims challenged in the request.

(3) A statement pointing out, based on the cited patents and printed publications, each showing of a reasonable likelihood that the requester will prevail with respect to at least one of the claims challenged in the request, and a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested.

(4) A copy of every patent or printed publication relied upon or referred to in paragraphs (b)(1) through (3) of this section, accompanied by an English language translation of all the necessary and pertinent parts of any non-English language document.

(5) A copy of the entire patent including the front face, drawings, and specification/claims (in double column format) for which reexamination is requested, and a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent. All copies must have each page plainly written on only one side of a sheet of paper.

(6) A certification by the third party requester that a copy of the request has been served in its entirety on the patent owner at the address provided for in § 1.33(c). The name and address of the party served must be indicated. If service was not possible, a duplicate copy of the request must be supplied to the Office.

(7) A certification by the third party requester that the estoppel provisions of § 1.907 do not prohibit the *inter partes* reexamination.

(8) A statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy.

(c) If an *inter partes* request is filed by an attorney or agent identifying another party on whose behalf the request is being filed, the attorney or agent must have a power of attorney from that party or be acting in a representative capacity pursuant to § 1.34.

(d) If the *inter partes* request does not include the fee for requesting *inter partes* reexamination required by paragraph (a) of this section and meet all the requirements of paragraph (b) of this section, then the person identified as requesting *inter partes* reexamination will be so notified and will generally be given an opportunity to complete the request within a specified time. Failure to comply with the notice will result in the *inter partes* reexamination request not being granted a filing date, and will result in placement of the request in the patent file as a citation if it complies with the requirements of § 1.501.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (d) revised, 71 FR 9260, Feb. 23, 2006, effective Mar. 27, 2006; para. (d) revised, 71 FR 44219, Aug. 4, 2006, effective Aug. 4, 2006; para. (c) revised, 72 FR 18892, Apr. 16, 2007, effective May 16, 2007; paras. (b)(2) and (b)(3) revised, 76 FR 59055, Sept. 23, 2011, effective Sept. 23, 2011]

§ 1.919 Filing date of request for *inter partes* reexamination.

(a) The filing date of a request for *inter partes* reexamination is the date on which the request satisfies all the requirements for the request set forth in § 1.915.

(b) If the request is not granted a filing date, the request will be placed in the patent file as a citation of prior art if it complies with the requirements of § 1.501.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (a) revised, 71 FR 9260, Feb. 23, 2006, effective Mar. 27, 2006]

§ 1.923 Examiner's determination on the request for *inter partes* reexamination.

Within three months following the filing date of a request for *inter partes* reexamination under § 1.915, the examiner will consider the request and determine whether or not the request and the prior art establish a reasonable likelihood that the requester will prevail with respect to at least one of the claims challenged in the request. The examiner's determination will be based on the claims in effect at the time of the determination, will become a part of the official file of the patent, and will be mailed to the patent owner at the address as provided for in § 1.33(c) and to the third party requester. If the examiner determines that the request has not established a reasonable likelihood that the requester will prevail with respect to at least one of the challenged claims, the examiner shall refuse the request and shall not order *inter partes* reexamination.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; revised, 72 FR 18892, Apr. 16, 2007, effective May 16, 2007; revised, 76 FR 59055, Sept. 23, 2011, effective Sept. 23, 2011]

§ 1.925 Partial refund if request for *inter partes* reexamination is not ordered.

Where *inter partes* reexamination is not ordered, a refund of a portion of the fee for requesting *inter partes* reexamination will be made to the requester in accordance with § 1.26(c).

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

§ 1.927 Petition to review refusal to order *inter partes* reexamination.

The third party requester may seek review by a petition to the Director under § 1.181 within one month of the mailing date of the examiner's determination refusing to order *inter partes* reexamination. Any such petition must comply with § 1.181(b). If no petition is timely filed or if the decision on petition affirms that a reasonable likelihood that the requester will prevail with respect to at least one of the claims challenged in the request has not been established, the determination shall be final and nonappealable.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; revised, 76 FR 59055, Sept. 23, 2011, effective Sept. 23, 2011]

INTER PARTES REEXAMINATION OF PATENTS

§ 1.931 Order for *inter partes* reexamination.

(a) If it is found that there is a reasonable likelihood that the requester will prevail with respect to at least one of the claims challenged in the request, the determination will include an order for *inter partes* reexamination of the patent for resolution of the question of whether the requester will prevail.

(b) If the order for *inter partes* reexamination resulted from a petition pursuant to § 1.927, the *inter partes* reexamination will ordinarily be conducted by an examiner other than the examiner responsible for the initial determination under § 1.923.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (a) revised, 76 FR 59055, Sept. 23, 2011, effective Sept. 23, 2011]

INFORMATION DISCLOSURE IN *INTER PARTES* REEXAMINATION

§ 1.933 Patent owner duty of disclosure in *inter partes* reexamination proceedings.

(a) Each individual associated with the patent owner in an *inter partes* reexamination proceeding has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability in a reexamination proceeding as set forth in § 1.555(a) and (b). The duty to disclose all information known to be material to patentability in an *inter partes* reexamination proceeding is deemed to be satisfied by filing a paper in compliance with the requirements set forth in § 1.555(a) and (b).

(b) The responsibility for compliance with this section rests upon the individuals designated in paragraph (a) of this section, and no evaluation will be made by the Office in the reexamination proceeding as to compliance with this section. If questions of compliance with this section are raised by the patent owner or the third party requester during a reexamination proceeding, they will be noted as unresolved questions in accordance with § 1.906(c).

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

OFFICE ACTIONS AND RESPONSES (BEFORE THE EXAMINER) IN *INTER PARTES* REEXAMINATION

§ 1.935 Initial Office action usually accompanies order for *inter partes* reexamination.

The order for *inter partes* reexamination will usually be accompanied by the initial Office action on the merits of the reexamination.

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

§ 1.937 Conduct of *inter partes* reexamination.

(a) All *inter partes* reexamination proceedings, including any appeals to the Patent Trial and Appeal Board, will be conducted with special dispatch within the Office, unless the Director makes a determination that there is good cause for suspending the reexamination proceeding.

(b) The *inter partes* reexamination proceeding will be conducted in accordance with §§ 1.104 through 1.116, the sections governing the application examination process, and will result in the issuance of an *inter partes* reexamination certificate under § 1.997, except as otherwise provided.

(c) All communications between the Office and the parties to the *inter partes* reexamination which are directed to the merits of the proceeding must be in writing and filed with the Office for entry into the record of the proceeding.

(d) A petition in an *inter partes* reexamination proceeding must be accompanied by the fee set forth in § 1.20(c)(6), except for petitions under § 1.956 to extend the period for response by a patent owner, petitions under § 1.958 to accept a delayed response by a patent owner, petitions under § 1.78 to accept an unintentionally delayed benefit claim, and petitions under § 1.530(l) for correction of inventorship in a reexamination proceeding.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (a) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012; para. (d) added, 77 FR 48828, Aug. 14, 2012, effective Sept. 16, 2012]

§ 1.939 Unauthorized papers in *inter partes* reexamination

(a) If an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned.

(b) Unless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the *inter partes* reexamination.

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

§ 1.941 Amendments by patent owner in *inter partes* reexamination.

Amendments by patent owner in *inter partes* reexamination proceedings are made by filing a paper in compliance with §§ 1.530(d)-(k) and 1.943.

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

§ 1.943 Requirements of responses, written comments, and briefs in *inter partes* reexamination.

(a) The form of responses, written comments, briefs, appendices, and other papers must be in accordance with the requirements of § 1.52.

(b) Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

(c) Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

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

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

(a) 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.

(b) Any supplemental response to the Office action will be entered only where the supplemental response is accompanied by a showing of sufficient cause why the supplemental response should be entered. The showing of sufficient cause must include:

(1) An explanation of how the requirements of § 1.111(a)(2)(i) are satisfied;

(2) An explanation of why the supplemental response was not presented together with the original response to the Office action; and

(3) A compelling reason to enter the supplemental response.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; revised, 72 FR 18892, Apr. 16, 2007, effective May 16, 2007]

§ 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.

(b) When the patent owner does file comments, a third party requester may once file comments responsive to the patent owner's comments within 30 days from the date of service of patent owner's comments on the third party requester.

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

§ 1.953 Examiner's Right of Appeal Notice in *inter partes* reexamination.

(a) Upon considering the comments of the patent owner and the third party requester subsequent to the Office action closing prosecution in an *inter partes* reexamination, or upon expiration of the time for submitting such comments, the examiner shall issue a Right of Appeal Notice, unless the examiner reopens prosecution and issues another Office action on the merits.

(b) Expedited Right of Appeal Notice: At any time after the patent owner's response to the initial Office action on the merits in an *inter partes* reexamination, the patent owner and all third party requesters may stipulate that the issues are appropriate for a final action, which would include a final rejection and/or a final determination favorable to patentability, and may request the issuance of a Right of Appeal Notice. The request must have the concurrence of the patent owner and all third party requesters present in the proceeding and must identify all of the appealable issues and the positions of the patent owner and all third party requesters on those issues. If the examiner determines that no other issues are present or should be raised, a Right of Appeal Notice limited to the identified issues shall be issued.

(c) The Right of Appeal Notice shall be a final action, which comprises a final rejection setting forth each ground of rejection and/or final decision favorable to patentability including each determination not to make a proposed rejection, an identification of the status of each claim, and the reasons for decisions favorable to patentability and/or the grounds of rejection for each claim. No amendment can be made in response to the Right of Appeal Notice. The Right of Appeal Notice shall set a one-month time period for either party to appeal. If no notice of appeal is filed, prosecution in the *inter partes* reexamination proceeding will be terminated, and the Director will proceed to issue and publish a certificate under § 1.997 in accordance with the Right of Appeal Notice.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (c) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; paras. (b) and (c) revised, 72 FR 18892, Apr. 16, 2007, effective May 16, 2007]

INTERVIEWS PROHIBITED IN *INTER PARTES* REEXAMINATION

§ 1.955 Interviews prohibited in *inter partes* reexamination proceedings.

There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

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

EXTENSIONS OF TIME, TERMINATING OF REEXAMINATION PROSECUTION, AND PETITIONS TO REVIVE IN *INTER PARTES* REEXAMINATION

§ 1.956 Patent owner extensions of time in *inter partes* reexamination.

The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition fee set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004]

§ 1.957 Failure to file a timely, appropriate or complete response or comment in *inter partes* reexamination.

(a) If the third party requester files an untimely or inappropriate comment, notice of appeal or brief in an *inter partes* reexamination, the paper will be refused consideration.

(b) If no claims are found patentable, and the patent owner fails to file a timely and appropriate response in an *inter partes* reexamination proceeding, the prosecution in the reexamination proceeding will be a terminated prosecution and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.997 in accordance with the last action of the Office.

(c) If claims are found patentable and the patent owner fails to file a timely and appropriate response to any Office action in an *inter partes* reexamination proceeding, further prosecution will be limited to the claims found patentable at the time of the failure to respond, and to any claims added thereafter which do not expand the scope of the claims which were found patentable at that time.

(d) When action by the patent owner is a *bona fide* attempt to respond and to advance the prosecution and is substantially a complete response to the Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, an opportunity to explain and supply the omission may be given.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (b) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (b) revised, 72 FR 18892, Apr. 16, 2007, effective May 16, 2007]

§ 1.958 Petition to revive *inter partes* reexamination prosecution terminated for lack of patent owner response.

If a response by the patent owner is not timely filed in the Office, a petition may be filed pursuant to § 1.137 to revive a reexamination prosecution terminated under § 1.957(b) or limited under § 1.957(c) if the delay in response was unintentional.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; heading revised, 72 FR 18892, Apr. 16, 2007, effective May 16, 2007; revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013]

APPEAL TO THE PATENT TRIAL AND APPEAL BOARD IN *INTER PARTES* REEXAMINATION

§ 1.959 Appeal in *inter partes* reexamination.

Appeals to the Patent Trial and Appeal Board under 35 U.S.C. 134(c) are conducted according to part 41 of this title.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para (f) added, 68 FR 70996, Dec. 22, 2003, effective Jan. 21, 2004; revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

§ 1.961 - 1.977 [Reserved]

§ 1.979 Return of Jurisdiction from the Patent Trial and Appeal Board; termination of appeal proceedings.

(a) Jurisdiction over an *inter partes* reexamination proceeding passes to the examiner after a decision by the Patent Trial and Appeal Board upon transmittal of the file to the examiner, subject to each appellant's right of appeal or other review, for such further action as the condition of the *inter partes* reexamination proceeding may require, to carry into effect the decision of the Patent Trial and Appeal Board.

(b) Upon judgment in the appeal before the Patent Trial and Appeal Board, if no further appeal has been taken (§ 1.983), the prosecution in the *inter partes* reexamination proceeding will be terminated and the Director will issue and publish a certificate under § 1.997 concluding the proceeding. If an appeal to the U.S. Court of Appeals for the Federal Circuit has been filed, that appeal is considered terminated when the mandate is issued by the Court.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (f) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; paras. (e) & (f) revised, 68 FR 70996, Dec. 22, 2003, effective Jan. 21, 2004; revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; heading and para. (b) revised, 72 FR 18892, Apr. 16, 2007, effective May 16, 2007; revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

§ 1.981 Reopening after a final decision of the Patent Trial and Appeal Board.

When a decision by the Patent Trial and Appeal Board 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; revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

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 Patent Trial and Appeal Board and who is dissatisfied with the decision of the Patent Trial and Appeal Board may, subject to § 41.81, 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 Patent Trial and Appeal Board.

(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 Patent Trial and Appeal Board.

(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 Patent Trial and Appeal Board.

(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 Patent Trial and Appeal Board 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; para. (a) revised, 72 FR 18892, Apr. 16, 2007, effective May 16, 2007; paras. (a), (c), (d), and (f) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

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 or trial before the Patent Trial and Appeal Board, 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 proceeding in which the same patent is or was involved, including but not limited to interference or trial before the Patent Trial and Appeal Board, 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.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

§ 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; revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

§ 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 and publication 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; para. (a) revised, 72 FR 18892, Apr. 16, 2007, effective May 16, 2007]

§ 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 and 41.60 through 41.81, 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 concluded by the grant of the reissued patent.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; revised, 72 FR 18892, Apr. 16, 2007, effective May 16, 2007]

§ 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 or trial before the Patent Trial and Appeal Board, the Director may suspend the *inter partes* reexamination, interference, or trial. The Director will not consider a request to suspend an interference or trial unless a motion under § 41.121(a)(3) of this title to suspend the interference or trial 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; revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

§ 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 and publication of *inter partes* reexamination certificate concludes *inter partes* reexamination proceeding.

(a) To conclude an *inter partes* reexamination proceeding, the Director will issue and publish an *inter partes* reexamination 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 and published 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 and published 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; heading and paras. (a), (b), and (d) revised, 72 FR 18892, Apr. 16, 2007, effective May 16, 2007]

Subpart I — International Design Application

General Information

§ 1.1001 Definitions related to international design applications.

(a) *Article* as used in this subpart means an article of the Hague Agreement;

(b) *Regulations* as used in this subpart, when capitalized, means the "Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement";

(c) *Rule* as used in this subpart, when capitalized, means one of the Regulations;

(d) *Administrative Instructions* as used in this subpart means the Administrative Instructions referred to in Rule 34;

(e) *1960 Act* as used in this subpart means the Act signed at the Hague on November 28, 1960, of the Hague Agreement;

(f) Other terms and expressions in subpart I not defined in this section are as defined in Article 1, Rule 1, and 35 U.S.C. 381.

[Added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.1002 The United States Patent and Trademark Office as an office of indirect filing.

(a) The United States Patent and Trademark Office, as an office of indirect filing, shall accept international design applications where the applicant's Contracting Party is the United States.

(b) The major functions of the United States Patent and Trademark Office as an office of indirect filing include:

(1) Receiving and according a receipt date to international design applications;

(2) Collecting and, when required, transmitting fees due for processing international design applications;

(3) Determining compliance with applicable requirements of part 5 of this chapter; and

(4) Transmitting an international design application to the International Bureau, unless prescriptions concerning national security prevent the application from being transmitted.

[Added,80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.1003 The United States Patent and Trademark Office as a designated office.

(a) The United States Patent and Trademark Office will act as a designated office ("United States Designated Office") for international design applications in which the United States has been designated as a Contracting Party in which protection is sought.

(b) The major functions of the United States Designated Office include:

(1) Accepting for national examination international design applications which satisfy the requirements of the Hague Agreement, the Regulations, and the regulations;

(2) Performing an examination of the international design application in accordance with 35 U.S.C. chapter 16; and

(3) Communicating the results of examination to the International Bureau.

[Added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.1004 The International Bureau.

(a) The International Bureau is the World Intellectual Property Organization located at Geneva, Switzerland. It is the international intergovernmental organization which acts as the coordinating body under the Hague Agreement and the Regulations.

(b) The major functions of the International Bureau include:

(1) Receiving international design applications directly from applicants and indirectly from an office of indirect filing;

(2) Collecting required fees and crediting designation fees to the accounts of the Contracting Parties concerned;

(3) Reviewing international design applications for compliance with prescribed formal requirements;

(4) Translating international design applications into the required languages for recordation and publication;

(5) Registering international designs in the International Register where the international design application complies with the applicable requirements;

(6) Publishing international registrations in the International Designs Bulletin; and

(7) Sending copies of the publication of the international registration to each designated office.

[Added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.1005 Display of currently valid control number under the Paperwork Reduction Act.

(a) Pursuant to the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*), the collection of information in this subpart has been reviewed and approved by the Office of Management and Budget under control number 0651-0075.

(b) Notwithstanding any other provision of law, no person is required to respond to nor shall a person be subject to a penalty for failure to comply with a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid Office of Management and Budget control number. This section constitutes the display required by 44 U.S.C. 3512(a) and 5 CFR 1320.5(b)(2)(i) for the collection of information under Office of Management and Budget control number 0651-0075 (*see* 5 CFR 1320.5(b)(2)(ii)(D)).

[Added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

WHO MAY FILE AN INTERNATIONAL DESIGN APPLICATION

§ 1.1011 Applicant for international design application.

(a) Only persons who are nationals of the United States or who have a domicile, a habitual residence,

or a real and effective industrial or commercial establishment in the territory of the United States may file international design applications through the United States Patent and Trademark Office.

(b) Although the United States Patent and Trademark Office will accept international design applications filed by any person referred to in paragraph (a) of this section, an international design application designating the United States may be refused by the Office as a designated office if the applicant is not a person qualified under 35 U.S.C. chapter 11 to be an applicant.

[Added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.1012 Applicant's Contracting Party.

In order to file an international design application through the United States Patent and Trademark Office as an office of indirect filing, the United States must be applicant's Contracting Party (Articles 4 and 1(xiv)).

[Added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

THE INTERNATIONAL DESIGN APPLICATION

§ 1.1021 Contents of the international design application.

(a) *Mandatory contents.* The international design application shall be in English, French, or Spanish (Rule 6(1)) and shall contain or be accompanied by:

(1) A request for international registration under the Hague Agreement (Article 5(1)(i));

(2) The prescribed data concerning the applicant (Article 5(1)(ii) and Rule 7(3)(i) and (ii));

(3) The prescribed number of copies of a reproduction or, at the choice of the applicant, of several different reproductions of the industrial design that is the subject of the international design application, presented in the prescribed manner; however, where the industrial design is two-dimensional and a request for deferment of publication is made in accordance with Article 5(5), the international design application may, instead of containing reproductions, be accompanied by the prescribed number of specimens of the industrial design (Article 5(1)(iii));

(4) An indication of the product or products that constitute the industrial design or in relation to which the industrial design is to be used, as prescribed (Article 5(1)(iv) and Rule 7(3)(iv));

(5) An indication of the designated Contracting Parties (Article 5(1)(v));

(6) The prescribed fees (Article 5(1)(vi) and Rule 12(1));

(7) The Contracting Party or Parties in respect of which the applicant fulfills the conditions to be the holder of an international registration (Rule 7(3)(iii));

(8) The number of industrial designs included in the international design application, which may not exceed 100, and the number of reproductions or specimens of the industrial designs accompanying the international design application (Rule 7(3)(v));

(9) The amount of the fees being paid and the method of payment, or instructions to debit the required amount of fees to an account opened with the International Bureau, and the identification of the party effecting the payment or giving the instructions (Rule 7(3)(vii)); and

(10) An indication of applicant's Contracting Party as required under Rule 7(4)(a).

(b) *Additional mandatory contents required by certain Contracting Parties.*

(1) Where the international design application contains the designation of a Contracting Party that requires, pursuant to Article 5(2), any of the following elements, then the international design application shall contain such required element(s):

(i) Indications concerning the identity of the creator of the industrial design that is the subject of that application (Rule 11(1));

(ii) A brief description of the reproduction or of the characteristic features of the industrial design that is the subject of that application (Rule 11(2));

(iii) A claim (Rule 11(3)).

(2) Where the international design application contains the designation of a Contracting

Party that has made a declaration under Rule 8(1), then the international application shall contain the statement, document, oath or declaration specified in that declaration (Rule 7(4)(c)).

(c) *Optional contents.* The international design application may contain:

(1) Two or more industrial designs, subject to the prescribed conditions (Article 5(4) and Rule 7(7));

(2) A request for deferment of publication (Article 5(5) and Rule 7(5)(e)) or a request for immediate publication (Rule 17);

(3) An element referred to in item (i) or (ii) of Article 5(2)(b) of the Hague Agreement or in Article 8(4)(a) of the 1960 Act even where that element is not required in consequence of a notification in accordance with Article 5(2)(a) of the Hague Agreement or in consequence of a requirement under Article 8(4)(a) of the 1960 Act (Rule 7(5)(a));

(4) The name and address of applicant's representative, as prescribed (Rule 7(5)(b));

(5) A claim of priority of one or more earlier filed applications in accordance with Article 6 and Rule 7(5)(c);

(6) A declaration, for purposes of Article 11 of the Paris Convention, that the product or products which constitute the industrial design or in which the industrial design is incorporated have been shown at an official or officially recognized international exhibition, together with the place where the exhibition was held and the date on which the product or products were first exhibited there and, where less than all the industrial designs contained in the international design application are concerned, the indication of those industrial designs to which the declaration relates or does not relate (Rule 7(5)(d));

(7) Any declaration, statement or other relevant indication as may be specified in the Administrative Instructions (Rule 7(5)(f));

(8) A statement that identifies information known by the applicant to be material to the eligibility for protection of the industrial design concerned (Rule 7(5)(g));

(9) A proposed translation of any text matter contained in the international design application for purposes of recording and publication (Rule 6(4)).

(d) *Required contents where the United States is designated.* In addition to the mandatory requirements set forth in paragraph (a) of this section, an international design application that designates the United States shall contain or be accompanied by:

(1) A claim (§§ 1.1021(b)(1)(iii) and 1.1025);

(2) Indications concerning the identity of the creator (i.e., the inventor, see § 1.9(d)) in accordance with Rule 11(1); and

(3) The inventor's oath or declaration (§§ 1.63 and 1.64). The requirements in §§ 1.63(b) and 1.64(b)(4) to identify each inventor by his or her legal name, mailing address, and residence, if an inventor lives at a location which is different from the mailing address, and the requirement in § 1.64(b)(2) to identify the residence and mailing address of the person signing the substitute statement will be considered satisfied by the presentation of such information in the international design application prior to international registration.

[Added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.1022 Form and signature.

(a) The international design application shall be presented on the official form (Rules 7(1) and 1(vi)).

(b) The international design application shall be signed by the applicant.

[Added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.1023 Filing date of an international design application in the United States.

(a) Subject to paragraph (b) of this section, the filing date of an international design application in the United States is the date of international registration determined by the International Bureau under the Hague Agreement (35 U.S.C. 384 and 381(a)(5)).

(b) Where the applicant believes the international design application is entitled under the

Hague Agreement to a filing date in the United States other than the date of international registration, the applicant may petition the Director under this paragraph to accord the international design application a filing date in the United States other than the date of international registration. Such petition must be accompanied by the fee set forth in § 1.17(f) and include a showing to the satisfaction of the Director that the international design application is entitled to such filing date.

[Added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.1024 The description.

An international design application designating the United States must include a specification as prescribed by 35 U.S.C. 112 and preferably include a brief description of the reproduction pursuant to Rule 7(5)(a) describing the view or views of the reproductions.

[Added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.1025 The claim.

The specific wording of the claim in an international design application designating the United States shall be in formal terms to the ornamental design for the article (specifying name of article) as shown, or as shown and described. More than one claim is neither required nor permitted for purposes of the United States.

[Added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.1026 Reproductions.

Reproductions shall comply with the requirements of Rule 9 and Part Four of the Administrative Instructions.

[Added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.1027 Specimens.

Where a request for deferment of publication has been filed in respect of a two dimensional industrial design, the international design application may include specimens of the design in accordance with Rule 10 and Part Four of the Administrative Instructions. Specimens are not permitted in an international design application that designates the United States or any other Contracting Party which does not permit deferment of publication.

[Added,80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.1028 Deferment of publication.

The international design application may contain a request for deferment of publication, provided the application does not designate the United States or any other Contracting Party which does not permit deferment of publication.

[Added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

FEES

§ 1.1031 International design application fees.

(a) International design applications filed through the Office as an office of indirect filing are subject to payment of a transmittal fee (35 U.S.C. 382(b) and Article 4(2)) in the amount of :

By a micro entity (§ 1.29).....$30.00

By a small entity (§ 1.27(a)) 60.00

By other than a small or micro entity.....120.00

(b) The Schedule of Fees annexed to the Regulations (Rule 27(1)), a list of individual designation fee amounts, and a fee calculator may be viewed on the Web site of the World Intellectual Property Organization, currently available at **http://www.wipo.int/hague**.

(c) The following fees required by the International Bureau may be paid either directly to the International Bureau or through the Office as an office of indirect filing in the amounts specified on the World Intellectual Property Organization Web site described in paragraph (b) of this section:

(1) International application fees (Rule 12(1)); and

(2) Fee for descriptions exceeding 100 words (Rule 11(2)).

(d) The fees referred to in paragraph (c) of this section may be paid as follows:

(1) Directly to the International Bureau in Swiss currency (see Administrative Instruction 801); or

(2) Through the Office as an office of indirect filing, provided such fees are paid no later than the date of payment of the transmittal fee required under paragraph (a) of this section. Any payment through the Office must be in U.S. dollars. Applicants paying the fees in paragraph (c) of this section through the Office may be subject to a requirement by the International Bureau to pay additional amounts where the conversion from U.S. dollars to Swiss currency results in the International Bureau receiving less than the prescribed amounts.

(e) Payment of the fees referred to in Article 17 and Rule 24 for renewing an international registration ("renewal fees") is not required to maintain a U.S. patent issuing on an international design application in force. Renewal fees, if required, must be submitted directly to the International Bureau. Any renewal fee submitted to the Office will not be transmitted to the International Bureau.

(f) The designation fee for the United States shall consist of:

(1) A first part established in Swiss currency pursuant to Hague Rule 28 based on the combined amounts of the basic filing fee (§ 1.16(b)), search fee (§ 1.16(l)), and examination fee (§ 1.16(p)) for a design application. The first part is payable at the time of filing the international design application; and

(2) A second part (issue fee) as provided in § 1.18(b). The second part is payable within the period specified in a notice of allowance (§ 1.311).

[Added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015; para. (a) revised and para. (f) added, 82 FR 52780, Nov. 14, 2017, effective Jan. 16, 2018]

REPRESENTATION

§ 1.1041 Representation in an international design application.

(a) The applicant may appoint a representative before the International Bureau in accordance with Rule 3.

(b) Applicants of international design applications may be represented before the Office as an office of indirect filing by a practitioner registered (§ 11.6) or granted limited recognition (§ 11.9(a) or (b)) to practice before the Office in patent matters. Such practitioner may act pursuant to § 1.34 or pursuant to appointment by the applicant. The appointment must be in writing signed by the applicant, must give the practitioner power to act on behalf of the applicant, and must specify the name and registration number or limited recognition number of each practitioner. An appointment of a representative made in the international design application pursuant to Rule 3(2) that complies with the requirements of this paragraph will be effective as an appointment before the Office as an office of indirect filing.

[Added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.1042 Correspondence respecting international design applications filed with the Office as an office of indirect filing.

The applicant may specify a correspondence address for correspondence sent by the Office as an office of indirect filing. Where no such address has been specified, the Office will use as the correspondence address the address of applicant's appointed representative (§ 1.1041) or, where no representative is appointed, the address as specified in Administrative Instruction 302.

[Added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

TRANSMITTAL OF INTERNATIONAL DESIGN APPLICATION TO THE INTERNATIONAL BUREAU

§ 1.1045 Procedures for transmittal of international design application to the International Bureau.

(a) Subject to paragraph (b) of this section and payment of the transmittal fee set forth in § 1.1031(a), transmittal of the international design application to the International Bureau shall be made by the Office as provided by Rule 13(1). At the same time as it transmits the international design application to the International Bureau, the Office shall notify the International Bureau of the date on which it received the application. The Office shall also notify the applicant of the date on which it received the application and of the transmittal of the international design application to the International Bureau.

(b) No copy of an international design application may be transmitted to the International Bureau, a foreign designated office, or other foreign authority by the Office or the applicant, unless the applicable requirements of part 5 of this chapter have been satisfied.

(c) Once transmittal of the international design application has been effected under paragraph (a) of this section, except for matters properly before the United States Patent and Trademark Office as an office of indirect filing or as a designated office, all further correspondence concerning the application should be sent directly to the International Bureau. The United States Patent and Trademark Office will generally not forward communications to the International Bureau received after transmittal of the application to the International Bureau. Any reply to an invitation sent to the applicant by the International Bureau must be filed directly with the International Bureau, and not with the Office, to avoid abandonment or other loss of rights under Article 8.

[Added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

RELIEF FROM PRESCRIBED TIME LIMITS; CONVERSION TO A DESIGN APPLICATION UNDER 35 U.S.C. CHAPTER 16

§ 1.1051 Relief from prescribed time limits.

(a) If the delay in an applicant's failure to act within prescribed time limits under the Hague Agreement in connection with requirements pertaining to an international design application was unintentional, a petition may be filed pursuant to this section to excuse the failure to act as to the United States. A grantable petition pursuant to this section must be accompanied by:

(1) A copy of any invitation sent from the International Bureau setting a prescribed time limit for which applicant failed to timely act;

(2) The reply required under paragraph (c) of this section, unless previously filed;

(3) The fee as set forth in § 1.17(m);

(4) A certified copy of the originally filed international design application, unless a copy of the international design application was previously communicated to the Office from the International Bureau or the international design application was filed with the Office as an office of indirect filing, and a translation thereof into the English language if it was filed in another language;

(5) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and

(6) A terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

(b) Any request for reconsideration or review of a decision refusing to excuse the applicant's failure to act within prescribed time limits in connection with requirements pertaining to an international design application upon petition filed pursuant to this section, to be considered timely, must be filed within two months of the decision refusing to excuse or within such time as set in the decision. Unless a decision indicates otherwise, this time period may be extended under the provisions of § 1.136.

(c) *Reply.* The reply required may be:

(1) The filing of a continuing application. If the international design application has not been subject to international registration, the reply must also include a grantable petition under § 1.1023(b) to accord the international design application a filing date; or

(2) A grantable petition under § 1.1052, where the international design application was filed with the Office as an office of indirect filing.

(d) *Terminal disclaimer.* Any petition pursuant to this section must be accompanied by a terminal disclaimer and fee as set forth in § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period beginning on the due date for the reply for which applicant failed to timely act and ending on the date of filing of the reply required under paragraph (c) of this section and must also apply to any patent granted on a continuing design application that contains a specific reference under 35 U.S.C. 120, 121, 365(c) or 386(c) to the application for which relief under this section is sought.

[Added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.1052 Conversion to a design application under 35 U.S.C. chapter 16.

(a) An international design application designating the United States filed with the Office as an office of indirect filing and meeting the requirements under § 1.53(b) for a filing date for an application for a design patent may, on petition under this section, be converted to an application for a design patent under § 1.53(b) and accorded a filing date as provided therein. A petition under this section must be accompanied by the fee set forth in § 1.17(t) and be filed prior to publication of the international registration under Article 10(3). The conversion of an international design application to an application for a design patent under § 1.53(b) will not entitle applicant to a refund of the transmittal fee or any fee forwarded to the International Bureau, or the application of any such fee toward the filing fee, or any other fee, for the application for a design patent under § 1.53(b). The application for a design patent resulting from conversion of an international design application must also include the basic filing fee (§ 1.16(b)), the search fee (§ 1.16(l)), the examination fee (§ 1.16(p)), the inventor's oath or declaration (§ 1.63 or 1.64), and a surcharge if required by § 1.16(f).

(b) An international design application will be converted to an application for a design patent under § 1.53(b) if a decision on petition under this section is granted prior to transmittal of the international design application to the International Bureau pursuant to § 1.1045. Otherwise, a decision granting a petition under this section will be effective to convert the international design application to an application for a design patent under § 1.53(b) only for purposes of the designation of the United States.

(c) A petition under this section will not be granted in an abandoned international design application absent a grantable petition under § 1.1051.

(d) An international design application converted under this section is subject to the regulations applicable to a design application filed under 35 U.S.C. chapter 16.

[Added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

NATIONAL PROCESSING OF INTERNATIONAL DESIGN APPLICATIONS

§ 1.1061 Rules applicable.

(a) The rules relating to applications for patents for other inventions or discoveries are also applicable to international design applications designating the United States, except as otherwise provided in this chapter or required by the Articles or Regulations.

(b) The provisions of § 1.74, § 1.84, except for § 1.84(c), and §§ 1.152 through 1.154 shall not apply to international design applications.

[Added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.1062 Examination.

(a) *Examination.* The Office shall make an examination pursuant to title 35, United States Code, of an international design application designating the United States.

(b) *Timing.* For each international design application to be examined under paragraph (a) of this section, the Office shall, subject to Rule 18(1)(c)(ii), send to the International Bureau within 12 months from the publication of the international registration under Rule 26(3) a notification of refusal (§ 1.1063) where it appears that the applicant is not entitled to a patent under the law with respect to any industrial design that is the subject of the international registration.

[Added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.1063 Notification of Refusal.

(a) A notification of refusal shall contain or indicate:

(1) The number of the international registration;

(2) The grounds on which the refusal is based;

(3) A copy of a reproduction of the earlier industrial design and information concerning the earlier industrial design, where the grounds of refusal refer to similarity with an industrial design that is the subject of an earlier application or registration;

(4) Where the refusal does not relate to all the industrial designs that are the subject of the international registration, those to which it relates or does not relate; and

(5) A time period for reply under §§ 1.134 and 1.136, where a reply to the notification of refusal is required.

(b) Any reply to the notification of refusal must be filed directly with the Office and not through the International Bureau. The requirements of § 1.111 shall apply to a reply to a notification of refusal.

[Added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.1064 One independent and distinct design.

(a) Only one independent and distinct design may be claimed in a nonprovisional international design application.

(b) If the requirements under paragraph (a) of this section are not satisfied, the examiner shall in the notification of refusal or other Office action require the applicant in the reply to that action to elect one independent and distinct design for which prosecution on the merits shall be restricted. Such requirement will normally be made before any action on the merits but may be made at any time before the final action. Review of any such requirement is provided under §§ 1.143 and 1.144.

[Added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.1065 Corrections and other changes in the International Register.

(a) The effects of any correction in the International Register by the International Bureau pursuant to Rule 22 in a pending nonprovisional international design application shall be decided by the Office in accordance with the merits of each situation, subject to such other requirements as may be imposed. A patent issuing from an international design application may only be corrected in accordance with the provisions of title 35, United States Code, for correcting patents. Any correction under Rule 22 recorded by the International Bureau with respect to an abandoned nonprovisional international design application will generally not be acted upon by the Office and shall not be given effect unless otherwise indicated by the Office.

(b) A recording of a partial change in ownership in the International Register pursuant to Rule 21(7) concerning a transfer of less than all designs shall not have effect in the United States.

[Added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.1066 Correspondence address for a nonprovisional international design application.

(a) Unless the correspondence address is changed in accordance with § 1.33(a), the Office will use as the correspondence address in a nonprovisional international design application the address according to the following order:

(1) The correspondence address under § 1.1042;

(2) The address of applicant's representative identified in the publication of the international registration; and

(3) The address of the applicant identified in the publication of the international registration.

(b) Reference in the rules to the correspondence address set forth in § 1.33(a) shall be construed to include a reference to this section for a nonprovisional international design application.

[Added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.1067 Title, description, and inventor's oath or declaration.

(a) The title of the design must designate the particular article. Where a nonprovisional international design application does not contain a title of the design, the Office may establish a title. No description, other than a reference to the drawing, is ordinarily required in a nonprovisional international design application.

(b) An international design application designating the United States must include the inventor's oath or declaration. *See* § 1.1021(d). If the applicant is notified in a notice of allowability that an oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, executed by or with respect to each named inventor has not been filed, the applicant must file each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, no later than the date on which the issue fee is paid to avoid abandonment. This time period is not extendable under § 1.136 (*see* § 1.136(c)).

[Added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.1068 Statement of grant of protection.

Upon issuance of a patent on an international design application designating the United States, the Office may send to the International Bureau a statement to the effect that protection is granted in the United States to those industrial design or designs that are the subject of the international registration and covered by the patent.

[Added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.1070 Notification of Invalidation.

(a) Where a design patent that was granted from an international design application is invalidated in the United States, and the invalidation is no longer subject to any review or appeal, the patentee shall inform the Office.

(b) After receiving a notification of invalidation under paragraph (a) of this section or through other means, the Office will notify the International Bureau in accordance with Hague Rule 20.

[Added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 1.1071 Grant of protection for an industrial design only upon issuance of a patent.

A grant of protection for an industrial design that is the subject of an international registration shall only arise in the United States through the issuance of a patent pursuant to 35 U.S.C. 389(d) or 171, and in accordance with 35 U.S.C. 153.

[Added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

PART 2 — RULES OF PRACTICE IN TRADEMARK CASES [See the Trademark Federal Statutes and Rules (TFSR)]

The rules in Part 2 of Title 37 of the CFR are available from the Trademark Federal Statutes and Rules (TFSR) **[Electronic Version][PDF]**

PART 3 — ASSIGNMENT, RECORDING AND RIGHTS OF ASSIGNEE

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§ 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, an international design 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; definition of "Application" revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

DOCUMENTS ELIGIBLE FOR RECORDING

§ 3.11 Documents which will be recorded.

(a) Assignments of applications, patents, and registrations, and other documents relating to interests in patent applications and patents, 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 53132, 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; para. (a) revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013]

§ 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/US2012/012345. An assignment relating to an international design application which designates the United States of America must identify the international design application by the international registration number or by the U.S. application number assigned to the international design application. If an assignment of a patent application filed under § 1.53(b) of this chapter 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) of this chapter 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 53132, Oct. 10, 1997, effective Dec. 1, 1997; revised, 69 FR 29865, May 26, 2004, effective June 25, 2004; revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 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 53132, 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 53132, 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 a single 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 interests in, or transactions involving, both patents and trademarks, then separate patent and trademark cover sheets, each accompanied by a copy of the document to be recorded, must be submitted. 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, in which case 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; revised, 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005]

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 (*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.

(8) For trademark assignments, the entity and citizenship of the party receiving the interest. In addition, if the party receiving the interest is a domestic partnership or domestic joint venture, the cover sheet must 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.

(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.

(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.

(h) The assignment cover sheet required by § 3.28 for a patent application or patent will be satisfied by the Patent Law Treaty Model International Request for Recordation of Change in Applicant or Owner Form, Patent Law Treaty Model International Request for Recordation of a License/ Cancellation of the Recordation of a License Form, Patent Law Treaty Model Certificate of Transfer Form or Patent Law Treaty Model International Request for Recordation of a Security Interest/ Cancellation of the Recordation of a Security Interest Form, as applicable, except where the assignment is also an oath or declaration under § 1.63 of this chapter. An assignment cover sheet required by § 3.28 must contain a conspicuous indication of an intent to utilize the assignment as an oath or declaration under § 1.63 of this chapter.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; para. (c) added, 62 FR 53132, 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; para. (a)(7)(i) revised, 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005; para. (a)(8) added and para. (f) revised, 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009; para. (h) added, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012; para. (h) revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013]

§ 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 53132, 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 53132, 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 53132, 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.

[Editor Note: Paras. (a) - (c) below are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012*]

(a) *Patents—conducting of prosecution.* One or more assignees as defined in paragraph (b) of this section may conduct prosecution of a national patent application as the applicant under § 1.46 of this title, or conduct prosecution of a supplemental examination or reexamination proceeding, to the exclusion of the inventor or previous applicant or patent owner. Conflicts between purported assignees are handled in accordance with § 3.73(c)(3).

(b) *Patents—assignee(s) who can prosecute.* The assignee(s) who may conduct either the prosecution of a national application for patent as the applicant under § 1.46 of this title or a supplemental examination or reexamination proceeding are:

(1) *A single assignee.* An assignee of the entire right, title and interest in the application or patent, 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, who together own the entire right, title and interest in the application or patent. A partial assignee is any assignee of record having less than the entire right, title and interest in the application or patent. The word "assignee" as used in this chapter means with respect to patent matters the single assignee of the entire right, title and interest in the application or patent if there is such a single assignee, or all of the partial assignees, or all of the partial assignee and inventors who have not assigned their interest in the application or patent, who together own the entire right, title and interest in the application or patent.

(c) *Patents—Becoming of record.* An assignee becomes of record as the applicant in a national patent application under § 1.46 of this title, and in a supplemental examination or reexamination proceeding, by filing a statement in compliance with § 3.73(c) 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; paras. (a)-(c) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012]

[*The changes to paras. (a)-(c) effective Sept. 16, 2012 are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012. See § 3.71 (pre-AIA) for the rule otherwise in effect.]

§ 3.71 (pre-AIA) Prosecution by assignee.

[Editor Note: Paras. (a) - (c) below are **not applicable** to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012*]

(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 prosecution 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]

[*See § 3.71 for more information and for paras. (a)-(c) applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012]

§ 3.73 Establishing right of assignee to take action.

[Editor Note: Applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

(a) The original applicant is presumed to be the owner of an application for an original patent, 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) In order to request or take action in a trademark matter, the assignee must establish its ownership of the 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:

(1) 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

(2) 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).

(c)(1) In order to request or take action in a patent matter, an assignee who is not the original applicant must establish its ownership of the patent 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 submission of the documentary evidence must be accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; 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) If the submission is by an assignee of less than the entire right, title and interest (*e.g.*, more than one assignee exists) the Office may refuse to accept the submission as an establishment of ownership unless:

(i) Each assignee establishes the extent (by percentage) of its ownership interest, so as to account for the entire right, title and interest in the application or patent by all parties including inventors; or

(ii) Each assignee submits a statement identifying the parties including inventors who together own the entire right, title and interest and stating that all the identified parties own the entire right, title and interest.

(3) If two or more purported assignees file conflicting statements under paragraph (c)(1) of this section, the Director will determine which, if any, purported assignee will be permitted to control prosecution of the application.

(d) The submission establishing ownership under paragraph (b) or (c) of this section must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

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

(2) Being signed by a person having apparent authority to sign on behalf of the assignee; or

(3) For patent matters only, being signed by a practitioner of record.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; para. (b) revised, 62 FR 53132, 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; para. (b)(1)(i) revised, 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005; revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012]

[*The changes to § 3.73 effective Sept. 16, 2012 are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012. See § 3.73 (pre-AIA) for the rule otherwise in effect.]

§ 3.73 (pre-AIA) Establishing right of assignee to take action.

[Editor Note: **Not applicable** to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012*]

(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). For trademark matters only, 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. For patent matters only, the submission of the documentary evidence must be accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; 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 53132, 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; para.

(b)(1)(i) revised, 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005.]

[*See § 3.73 for more information and for the rule applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012]

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, or exporting to, a foreign country an application on an invention made in the United States or technical data relating thereto.
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]

SECRECY

§ 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) *Definitions.*

(1) Application as used in this part includes provisional applications (§ 1.9(a)(2) of this chapter), nonprovisional applications (§ 1.9(a)(3)), international applications (§ 1.9(b)), or international design applications (§ 1.9(n)).

(2) Foreign application as used in this part includes, for filing in a foreign country or in a foreign or international intellectual property authority (other than the United States Patent and Trademark Office acting as a Receiving Office for international applications (35 U.S.C. 361, 37 CFR 1.412) or as an office of indirect filing for international design applications (35 U.S.C. 382, 37 CFR 1.1002)) any of the following: An application for patent; international application; international design application; or application for the registration of a utility model, industrial design, or model.

(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 53132, 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; para. (b) revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015; para. (b)(2) revised, 85 FR 61604, Sept. 30, 2020, effective Sept. 30, 2020]

§ 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 53132, 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 Commissioner for Patents will not be set for hearing until the secrecy order is removed.

(b) An interference or derivation will not be instituted 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 and international design 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 53132, 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; para. (b) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012; para. (d) revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 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 53132, 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 disclose 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 53132, Oct. 10, 1997, effective Dec. 1, 1997]

§ 5.6 [Reserved]

[Removed and reserved, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

§ 5.7 [Reserved]

[Removed and reserved, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

§ 5.8 [Reserved]

[Removed and reserved, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

LICENSES FOR FOREIGN EXPORTING AND FILING

§ 5.11 License for filing in, or exporting to, a foreign country an application on an invention made in the United States or technical data relating thereto.

(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 country or in a foreign or international intellectual property authority (other than the United States Patent and Trademark Office acting as a Receiving Office for international applications (35 U.S.C. 361, 37 CFR 1.412) or as an office of indirect filing for international design applications (35 U.S.C. 382, 37 CFR 1.1002)), 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) of this section would also authorize the export of technical data abroad for purposes related to:

(1) The preparation, filing or possible filing and prosecution of a foreign application; and

(2) The use of a World Intellectual Property Organization online service for preparing an international application for filing with the United States Patent and Trademark Office acting as a Receiving Office (35 U.S.C. 361, 37 CFR 1.412) without separately complying with the regulations contained in 22 CFR parts 120 through 130 (International Traffic in Arms Regulations of the Department of State), 15 CFR parts 730 through 774 (Export Administration Regulations of the Bureau of Industry and Security, Department of Commerce), and 10 CFR part 810 (Assistance to Foreign Atomic Energy Activities Regulations of the Department of Energy).

(c) Where technical data in the form of a patent application, or in any form, are being exported for purposes related to the preparation, filing or possible filing and prosecution of a foreign 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 730 through 774 (Export Administration Regulations of the Bureau of Industry and Security, 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 734, 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 application if:

(i) A license is not, or was not, required under paragraph (e)(2) of this section for the foreign 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 United States Patent and Trademark Office. An authorization to file a foreign 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 53132, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a)-(c) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; paras. (b) and (c) revised, 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005; paras. (a) through (c), (e)(3)(i) and (f) revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015; paras. (a), (b), and (e)(3) introductory text revised, 85 FR 61604, Sept. 30, 2020, effective Sept. 30, 2020]

§ 5.12 Petition for license.

(a) Filing of an application in the United States Patent and Trademark Office on an invention 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 or other official notice 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 2696, Jan. 20, 1983; amended 49 FR 13462, Apr. 4, 1984; para. (b) revised, 62 FR 53132, 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; para. (a) revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015; para. (a) revised, 85 FR 61604, Sept. 30, 2020, effective Sept. 30, 2020]

§ 5.13 Petition for license; no corresponding application.

If no corresponding national, international design, 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 53132, Oct. 10, 1997, effective Dec. 1, 1997; revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 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 or exported abroad, must be furnished with the petition. If, however, all new matter in the application to be filed or exported 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 53132, Oct. 10, 1997, effective Dec. 1, 1997; para. (c) revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 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 (a). This license permits subsequent modifications, amendments, and supplements containing additional subject matter to, or divisions of, a foreign application, if such changes to the application do not alter the general nature of the invention in a manner that would require the United States application to have been made available for inspection under 35 U.S.C. 181. Grant of this license authorizes the export of technical data pursuant to § 5.11(b) and the filing of an application in a foreign country or with any foreign or international intellectual property authority when the technical data and the subject matter of the foreign application correspond to that of the application or other materials reviewed pursuant to §§ 5.12 through 5.14, upon which the license was granted. This license includes the authority:

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

(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 application provided that the adding of subject matter or taking of any action under paragraph (a)(1) or (2) of this section does not change the general nature of the invention disclosed in the application in a manner that 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 120 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 Assistance to Foreign Atomic Energy Activities, 10 CFR part 810, in effect at the time of foreign filing.

(b) Applications or other materials that 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 (b). Grant of this license authorizes the export of technical data pursuant to § 5.11(b) and the filing of an application in a foreign country or with any foreign or international intellectual property authority. Further, this license includes the authority to export and file all duplicate and formal papers in foreign countries or with foreign or international intellectual property authorities and to make amendments, modifications, and supplements to; file divisions of; and take any action in the prosecution of the foreign 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 or export the foreign application, no license is required to file papers in connection with the prosecution of the foreign application not involving the disclosure of additional subject matter.

(e) Any paper filed abroad or transmitted to a foreign or international intellectual property authority following the filing of a foreign application that changes the general nature of the subject matter disclosed at the time of filing in a manner that would require such application to have been made available for inspection under 35 U.S.C. 181 or that involves the disclosure of subject matter listed in paragraph (a)(3)(i) or (ii) of this section must be separately licensed in the same manner as a foreign application. Further, if no license has been granted under § 5.12(a) after filing the corresponding United States application, any paper filed abroad or with a foreign or international intellectual property authority that involves the disclosure of additional subject matter must be licensed in the same manner as a foreign 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 53132, Oct.

10, 1997, effective Dec. 1, 1997; para. (c) revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004; para. (a) introductory text and paras. (a)(3), (b), (d), and (e) revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015; para. (a) introductory text and paras. (a)(1), (b) and (e) revised, 85 FR 61604, Sept. 30, 2020, effective Sept. 30, 2020]

§ 5.16 [Reserved]

[Removed and reserved, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997]

§ 5.17 [Reserved]

[49 FR 13463, Apr. 4, 1984; removed and reserved, 62 FR 53132, 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 53132, 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 734.3(b)(1)(v)) 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 U.S. 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 734.10(a)).

[45 FR 72654, Nov. 3, 1980; para. (a) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; revised, 62 FR 53132, Oct. 10, 1997, effective Dec. 1, 1997; revised, 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005]

§ 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 53132, 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 aboard[*sic*], 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 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. 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 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 53132, 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; paras. (a)(3)(iii) and (b) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012]

GENERAL

§ 5.31 [Reserved]

[24 FR 10381, Dec. 22, 1959; Redesignated at 49 FR 13463, Apr. 4, 1984; removed and reserved, 62 FR 53132, 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 53132, 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 53132, Oct. 10, 1997, effective Dec. 1, 1997]

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Subpart A — General Provisions

GENERAL INFORMATION

§ 11.1 Definitions.

This part governs solely the practice of patent, trademark, and other law before the United States 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 United States Patent and Trademark Office to accomplish its Federal objectives. Unless otherwise clear from the context, the following definitions apply to this part:

Attorney or *lawyer* means an individual who is an active member in good standing of the bar of the highest court of any State. A *non-lawyer* means a person who is not an attorney or lawyer.

Belief or *believes* means that the person involved actually supposed the fact in question to be true. A person's belief may be inferred from circumstances.

Confirmed in writing, when used in reference to the informed consent of a person, means informed consent that is given in writing by the person or a writing that a practitioner promptly transmits to the person confirming an oral informed consent. If it is not feasible to obtain or transmit the writing at the time the person gives informed consent, then the practitioner must obtain or transmit it within a reasonable time thereafter.

Conviction or *convicted* means any confession to a crime; a verdict or judgment finding a person guilty of a crime; any entered plea, including *nolo contendre* or Alford plea, to a crime; or receipt of deferred adjudication (whether judgment or sentence has been entered or not) for an accused or pled crime.

Crime means any offense declared to be a felony or misdemeanor by Federal or State law in the jurisdiction where the act occurs.

Data sheet means a form used to collect the name, address, and telephone information from individuals recognized to practice before the Office in patent matters.

Disqualified means any action that prohibits a practitioner from participating in or appearing before the program or agency, regardless of how long the prohibition lasts or the specific terminology used.

Federal agency means any authority of the executive branch of the Government of the United States.

Federal program means any program established by an Act of Congress or administered by a Federal agency.

Firm or law firm means a practitioner or practitioners in a law partnership, professional corporation, sole proprietorship or other association authorized to practice law; or practitioners employed in a legal services organization or the legal department of a corporation or other organization.

Fiscal year means the time period from October 1st through the ensuing September 30th.

Fraud or *fraudulent* means conduct that involves a misrepresentation of material fact made with intent to deceive or a state of mind so reckless respecting consequences as to be the equivalent of intent, where there is justifiable reliance on the misrepresentation by the party deceived, inducing the party to act thereon, and where there is injury to the party deceived resulting from reliance on the misrepresentation. Fraud also may be established by a purposeful omission or failure to state a material fact, which omission or failure to state makes other statements misleading, and where the

other elements of justifiable reliance and injury are established.

Good moral character and reputation means the possession of honesty and truthfulness, trustworthiness and reliability, and a professional commitment to the legal process and the administration of justice, as well as the condition of being regarded as possessing such qualities.

Grievance means a written submission from any source received by the OED Director that presents possible grounds for discipline of a specified practitioner.

Informed consent means the agreement by a person to a proposed course of conduct after the practitioner has communicated adequate information and explanation about the material risks of and reasonably available alternatives to the proposed course of conduct.

Knowingly, known, or *knows* means actual knowledge of the fact in question. A person's knowledge may be inferred from circumstances.

Law-related services means services that might reasonably be performed in conjunction with and in substance are related to the provision of legal services, and that are not prohibited as unauthorized practice of law when provided by a non-lawyer.

OED means the Office of Enrollment and Discipline.

OED Director means the Director of the Office of Enrollment and Discipline.

OED Director's representatives means attorneys within the USPTO Office of General Counsel who act as representatives of the OED Director.

Office means the United States Patent and Trademark Office.

Partner means a member of a partnership, a shareholder in a law firm organized as a professional corporation, or a member of an association authorized to practice law.

Person means an individual, a corporation, an association, a trust, a partnership, and any other organization or legal entity.

Practitioner means:

(1) An attorney or agent registered to practice before the Office in patent matters;

(2) An individual authorized under 5 U.S.C. 500(b), or otherwise as provided by § 11.14(a), (b), and (c), to practice before the Office in trademark matters or other non-patent matters;

(3) An individual authorized to practice before the Office in a patent case or matters under § 11.9(a) or (b); or

(4) An individual authorized to practice before the Office under § 11.16(d).

Proceeding before the Office means an application for patent, an application for reissue, a reexamination, a protest, a public use matter, an *inter partes* patent matter, correction of a patent, correction of inventorship, an application to register a trademark, an *inter partes* trademark matter, an appeal, a petition, and any other matter that is pending before the Office.

Reasonable or *reasonably* when used in relation to conduct by a practitioner means the conduct of a reasonably prudent and competent practitioner.

Reasonable belief or reasonably believes when used in reference to a practitioner means that the practitioner believes the matter in question and that the circumstances are such that the belief is reasonable.

Reasonably should know when used in reference to a practitioner means that a practitioner of reasonable prudence and competence would ascertain the matter in question.

Registration means registration to practice before the Office in patent proceedings.

Roster means a list of individuals who have been registered as either a patent attorney or patent agent.

Screened means the isolation of a practitioner from any participation in a matter through the timely imposition of procedures within a firm that are reasonably adequate under the circumstances to protect information that the isolated practitioner is obligated to protect under these USPTO Rules of Professional Conduct or other law.

Serious crime means:

(1) Any criminal offense classified as a felony under the laws of the United States, any state or any foreign country where the crime occurred; or

(2) Any crime a necessary element of which, as determined by the statutory or common law definition of such crime in the jurisdiction where the crime occurred, includes interference with the administration of justice, false swearing, misrepresentation, fraud, willful failure to file income tax returns, deceit, bribery, extortion, misappropriation, theft, or an attempt or a conspiracy or solicitation of another to commit a “serious crime.”

Significant evidence of rehabilitation means satisfactory evidence that is significantly more probable than not that there will be no recurrence in the foreseeable future of the practitioner’s prior disability or addiction.

State means any of the 50 states of the United States of America, the District of Columbia, and any Commonwealth or territory of the United States of America.

Substantial when used in reference to degree or extent means a material matter of clear and weighty importance.

Suspend or *suspension* means a temporary debarring from practice before the Office or other jurisdiction.

Tribunal means the Office, a court, an arbitrator in a binding arbitration proceeding or a legislative body, administrative agency or other body acting in an adjudicative capacity. A legislative body, administrative agency or other body acts in an adjudicative capacity when a neutral official, after the presentation of evidence or legal argument by a party or parties, will render a binding legal judgment directly affecting a party’s interests in a particular matter.

United States means the United States of America, and the territories and possessions the United States of America.

USPTO Director means the Director of the United States Patent and Trademark Office, or an employee of the Office delegated authority to act for the Director of the United States Patent and Trademark Office in matters arising under this part.

Writing or written means a tangible or electronic record of a communication or representation, including handwriting, typewriting, printing, photostating, photography, audio or video recording and electronic communications. A "signed" writing includes an electronic sound, symbol or process attached to or logically associated with a writing and executed or adopted by a person with the intent to sign the writing.

[Added, 69 FR 35427, June 24, 2004, effective July 26, 2004; revised, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008; definition of “grievance” added, 77 FR 45247, July 31, 2012, effective August 30, 2012; definitions of "mandatory disciplinary rule" and "matter" removed, definitions of "fraud or fraudulent" and "practitioner" revised, and definitions of "confirmed in writing," "firm or law firm," "informed consent," "law-related services," "partner," "person," "reasonable belief or reasonably believes," "reasonably should know," "screened," "tribunal," and "writing or written" added, 78 FR 20180, Apr. 3, 2013, effective May 3, 2013; definitions of "attorney or lawyer" and “practitioner" revised, 81 FR 33591, May 27, 2016, effective June 27, 2016]

§ 11.2 Director of the Office of Enrollment and Discipline.

(a) *Appointment.* The USPTO Director shall appoint a Director of the Office of Enrollment and Discipline (OED Director). In the event of a vacancy in the office of the OED Director, the USPTO Director may designate an employee of the Office to serve as acting OED Director. The OED Director shall be an active member in good standing of the bar of the highest court of a State.

(b) *Duties.* The OED Director shall:

(1) Supervise staff as may be necessary for the performance of the OED Director's duties.

(2) Receive and act upon applications for registration, prepare and grade the examination provided for in § 11.7(b), maintain the register provided for in § 11.5, and perform such other duties in connection with enrollment and recognition of attorneys and agents as may be necessary.

(3) Conduct investigations into the moral character and reputation of any individual seeking to be registered as an attorney or agent, or of any individual seeking limited recognition, deny registration or recognition of individuals failing to demonstrate possession of good moral character and reputation, and perform such other duties in connection with enrollment matters and investigations as may be necessary.

(4) Conduct investigations of matters involving possible grounds for discipline of practitioners coming to the attention of the OED Director. Except in matters meriting summary dismissal, no disposition under § 11.22(h) shall be recommended or undertaken by the OED Director until the accused practitioner shall have been afforded an opportunity to respond to a reasonable inquiry by the OED Director.

(5) With the consent of a panel of three members of the Committee on Discipline, initiate disciplinary proceedings under § 11.32 and perform such other duties in connection with investigations and disciplinary proceedings as may be necessary.

(6) Oversee the preliminary screening of information and close investigations as provided for in § 11.22.

(7) [Reserved]

(c) *Petition to OED Director regarding enrollment or recognition.* Any petition from any action or requirement of the staff of OED reporting to the OED Director shall be taken to the OED Director accompanied by payment of the fee set forth in § 1.21(a)(5)(i) of this chapter. Any such petition not filed within sixty days from the mailing date of the action or notice from which relief is requested will be dismissed as untimely. The filing of a petition will neither stay the period for taking other action which may be running, nor stay other proceedings. The petitioner may file a single request for reconsideration of a decision within thirty days of the date of the decision. Filing a request for reconsideration stays the period for seeking review of the OED Director's decision until a final decision on the request for reconsideration is issued.

(d) *Review of OED Director's decision regarding enrollment or recognition.* A party dissatisfied with a final decision of the OED Director regarding enrollment or recognition shall seek review of the decision upon petition to the USPTO Director accompanied by payment of the fee set forth in § 1.21(a)(5)(ii) of this chapter. By filing such petition to the USPTO Director, the party waives any right to seek reconsideration from the OED Director. Any petition not filed within thirty days after the final decision of the OED Director may be dismissed as untimely. Briefs or memoranda, if any, in support of the petition shall accompany the petition. The petition will be decided on the basis of the record made before the OED Director. The USPTO Director in deciding the petition will consider no new evidence. Copies of documents already of record before the OED Director shall not be submitted with the petition. An oral hearing will not be granted except when considered necessary by the USPTO Director. Any request for reconsideration of the decision of the USPTO Director may be dismissed as untimely if not filed within thirty days after the date of said decision. Only a decision of the USPTO Director regarding denial of a petition constitutes a final decision for the purpose of judicial review.

(e) *Petition to USPTO Director in disciplinary matters.* A party dissatisfied with any action or notice of any employee of the Office of Enrollment and Discipline during or at the conclusion of a disciplinary investigation shall seek review of the action or notice upon petition to the OED Director. A petition from any action or notice of the staff reporting to the OED Director shall be taken to the OED Director. A party dissatisfied with the OED Director's final decision shall seek review of the final decision upon petition to the USPTO Director to invoke the supervisory authority of the USPTO Director in appropriate circumstances in disciplinary matters. Any petition under this paragraph must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support of the petition must accompany the petition. Where facts are to be proven, the proof in the form of

affidavits or declarations (and exhibits, if any) must accompany the petition. The OED Director may be directed by the USPTO Director to file a reply to the petition to the USPTO Director, supplying a copy to the petitioner. An oral hearing on petition taken to the USPTO Director will not be granted except when considered necessary by the USPTO Director. The filing of a petition under this paragraph will not stay an investigation, disciplinary proceeding, or other proceedings. Any petition under this part not filed within thirty days of the mailing date of the action or notice from which relief is requested may be dismissed as untimely. Any request for reconsideration of the decision of the OED Director or the USPTO Director may be dismissed as untimely if not filed within thirty days after the date of said decision. Only a decision of the USPTO Director regarding denial of a petition constitutes a final decision for the purpose of judicial review.

[Added, 69 FR 35427, June 24, 2004, effective July 26, 2004; paras. (a), (b)(4), (c) and (d) revised, paras. (b)(5), (b)(6) and (e) added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008; paras. (c), (d) and (e) revised, 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.3 Suspension of rules.

(a) In an extraordinary situation, when justice requires, any requirement of the regulations of this Part which is not a requirement of statute may be suspended or waived by the USPTO Director or the designee of the USPTO Director, *sua sponte*, or on petition by any party, including the OED Director or the OED Director's representative, subject to such other requirements as may be imposed.

(b) No petition under this section shall stay a disciplinary proceeding unless ordered by the USPTO Director or a hearing officer.

[Added, 69 FR 35427, June 24, 2004, effective July 26, 2004; revised, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008]

Subpart B — Recognition To Practice Before the USPTO

PATENTS, TRADEMARKS, AND OTHER NON-PATENT LAW

§ 11.4 [Reserved]

[Reserved, 69 FR 35427, June 24, 2004, effective July 26, 2004]

§ 11.5 Register of attorneys and agents in patent matters; practice before the Office.

(a) A register of attorneys and agents is kept in the Office on which are entered the names of all individuals recognized as entitled to represent applicants having prospective or immediate business before the Office in the preparation and prosecution of patent applications. Registration in the Office under the provisions of this part shall entitle the individuals so registered to practice before the Office only in patent matters.

(b) *Practice before the Office.* Practice before the Office includes, but is not limited to, law-related service that comprehends any matter connected with the presentation to the Office or any of its officers or employees relating to a client's rights, privileges, duties, or responsibilities under the laws or regulations administered by the Office for the grant of a patent or registration of a trademark, or for enrollment or disciplinary matters. Such presentations include preparing necessary documents in contemplation of filing the documents with the Office, corresponding and communicating with the Office, and representing a client through documents or at interviews, hearings, and meetings, as well as communicating with and advising a client concerning matters pending or contemplated to be presented before the Office. Nothing in this section proscribes a practitioner from employing or retaining non-practitioner assistants under the supervision of the practitioner to assist the practitioner in matters pending or contemplated to be presented before the Office.

(1) *Practice before the Office in patent matters.* Practice before the Office in patent matters includes, but is not limited to, preparing and prosecuting any patent application, consulting with

or giving advice to a client in contemplation of filing a patent application or other document with the Office, drafting the specification or claims of a patent application; drafting an amendment or reply to a communication from the Office that may require written argument to establish the patentability of a claimed invention; drafting a reply to a communication from the Office regarding a patent application; and drafting a communication for a public use, interference, reexamination proceeding, petition, appeal to or any other proceeding before the Patent Trial and Appeal Board, or other proceeding. Registration to practice before the Office in patent cases sanctions the performance of those services which are reasonably necessary and incident to the preparation and prosecution of patent applications or other proceeding before the Office involving a patent application or patent in which the practitioner is authorized to participate. The services include:

(i) Considering the advisability of relying upon alternative forms of protection which may be available under state law, and

(ii) Drafting an assignment or causing an assignment to be executed for the patent owner in contemplation of filing or prosecution of a patent application for the patent owner, where the practitioner represents the patent owner after a patent issues in a proceeding before the Office, and when drafting the assignment the practitioner does no more than replicate the terms of a previously existing oral or written obligation of assignment from one person or party to another person or party.

(2) *Practice before the Office in trademark matters.* Practice before the Office in trademark matters includes, but is not limited to, consulting with or giving advice to a client in contemplation of filing a trademark application or other document with the Office; preparing and prosecuting an application for trademark registration; preparing an amendment which may require written argument to establish the registrability of the mark; and conducting an opposition, cancellation, or concurrent use proceeding; or conducting an appeal to the Trademark Trial and Appeal Board.

[Added, 69 FR 35427, June 24, 2004, effective July 26, 2004; revised, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008; para. (b)(1) introductory text revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

§ 11.6 Registration of attorneys and agents.

(a) *Attorneys.* Any citizen of the United States who is an attorney and who fulfills the requirements of this part may be registered as a patent attorney to practice before the Office. When appropriate, any alien who is an attorney, who lawfully resides in the United States, and who fulfills the requirements of this part may be registered as a patent attorney to practice before the Office, provided that such registration is not inconsistent with the terms upon which the alien was admitted to, and resides in, the United States and further provided that the alien may remain registered only:

(1) If the alien continues to lawfully reside in the United States and registration does not become inconsistent with the terms upon which the alien continues to lawfully reside in the United States, or

(2) If the alien ceases to reside in the United States, the alien is qualified to be registered under paragraph (c) of this section. See also § 11.9(b).

(b) *Agents.* Any citizen of the United States who is not an attorney, and who fulfills the requirements of this part may be registered as a patent agent to practice before the Office. When appropriate, any alien who is not an attorney, who lawfully resides in the United States, and who fulfills the requirements of this part may be registered as a patent agent to practice before the Office, provided that such registration is not inconsistent with the terms upon which the alien was admitted to, and resides in, the United States, and further provided that the alien may remain registered only:

(1) If the alien continues to lawfully reside in the United States and registration does not become inconsistent with the terms upon which the alien continues to lawfully reside in the United States or

(2) If the alien ceases to reside in the United States, the alien is qualified to be registered under paragraph (c) of this section. See also § 11.9(b).

(c) *Foreigners.* Any foreigner not a resident of the United States who shall file proof to the satisfaction of the OED Director that he or she is registered and in good standing before the patent office of the country in which he or she resides and practices, and who is possessed of the qualifications

stated in § 11.7, may be registered as a patent agent to practice before the Office for the limited purpose of presenting and prosecuting patent applications of applicants located in such country, provided that the patent office of such country allows substantially reciprocal privileges to those admitted to practice before the Office. Registration as a patent agent under this paragraph shall continue only during the period that the conditions specified in this paragraph obtain. Upon notice by the patent office of such country that a patent agent registered under this section is no longer registered or no longer in good standing before the patent office of such country, and absent a showing of cause why his or her name should not be removed from the register, the OED Director shall promptly remove the name of the patent agent from the register and publish the fact of removal. Upon ceasing to reside in such country, the patent agent registered under this section is no longer qualified to be registered under this section, and the OED Director shall promptly remove the name of the patent agent from the register and publish the fact of removal.

(d) *Patent Trial and Appeal Board matters.* For action by a person who is not registered in a proceeding before the Patent Trial and Appeal Board, see § 41.5(a) or § 42.10(c) of this title.

[Added, 69 FR 35427, June 24, 2004, effective July 26, 2004; para. (d) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (d) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

§ 11.7 Requirements for registration.

(a) No individual will be registered to practice before the Office unless he or she has:

(1) Applied to the USPTO Director in writing by completing an application for registration form supplied by the OED Director and furnishing all requested information and material; and

(2) Established to the satisfaction of the OED Director that he or she:

(i) Possesses good moral character and reputation;

(ii) Possesses the legal, scientific, and technical qualifications necessary for him or her to render applicants valuable service; and

(iii) Is competent to advise and assist patent applicants in the presentation and prosecution of their applications before the Office.

(b)(1) To enable the OED Director to determine whether an individual has the qualifications specified in paragraph (a)(2) of this section, the individual shall:

(i) File a complete application for registration each time admission to the registration examination is requested. A complete application for registration includes:

(A) An application for registration form supplied by the OED Director wherein all requested information and supporting documents are furnished,

(B) Payment of the fees required by § 1.21(a)(1) of this subchapter,

(C) Satisfactory proof of scientific and technical qualifications, and

(D) For aliens, provide proof that recognition is not inconsistent with the terms of their visa or entry into the United States;

(ii) Pass the registration examination, unless the taking and passing of the examination is waived as provided in paragraph (d) of this section. Unless examination is waived pursuant to paragraph (d) of this section, each individual seeking registration must take and pass the registration examination to enable the OED Director to determine whether the individual possesses the legal and competence qualifications specified in paragraphs (a)(2)(ii) and (a)(2)(iii) of this section. An individual failing the examination may, upon receipt of notice of failure from OED, reapply for admission to the examination. An individual failing the examination must wait thirty days after the date the individual last took the examination before retaking the examination. An individual reapplying shall:

(A) File a completed application for registration form wherein all requested information and supporting documents are furnished,

(B) Pay the fees required by § 1.21(a)(1) of this subchapter, and

(C) For aliens, provide proof that recognition is not inconsistent with the terms of their visa or entry into the United States; and

(iii) Provide satisfactory proof of possession of good moral character and reputation.

(2) An individual failing to file a complete application for registration will not be admitted to the examination and will be notified of the incompleteness. Applications for registration that are incomplete as originally submitted will be considered only when they have been completed and received by OED, provided that this occurs within sixty days of the mailing date of the notice of incompleteness. Thereafter, a new and complete application for registration must be filed. Only an individual approved as satisfying the requirements of paragraphs (b)(1)(i)(A), (b)(1)(i)(B), (b)(1)(i)(C) and (b)(1)(i)(D) of this section may be admitted to the examination.

(3) If an individual does not reapply until more than one year after the mailing date of a notice of failure, that individual must again comply with paragraph (b)(1)(i) of this section.

(c) Each individual seeking registration is responsible for updating all information and answers submitted in or with the application for registration based upon anything occurring between the date the application for registration is signed by the individual, and the date he or she is registered or recognized to practice before the Office in patent matters. The update shall be filed within thirty days after the date of the occasion that necessitates the update.

(d) *Waiver of the Registration Examination for Former Office Employees.*

(1) *Former patent examiners who by July 26, 2004, had not actively served four years in the patent examining corps, and were serving in the corps at the time of their separation.* The OED Director may waive the taking of a registration examination in the case of any individual meeting the requirements of paragraph (b)(1)(i)(C) of this section who is a former patent examiner but by July 26, 2004, had not served four years in the patent examining corps, if the individual demonstrates that he or she:

(i) Actively served in the patent examining corps of the Office and was serving in the corps at the time of separation from the Office;

(ii) Received a certificate of legal competency and negotiation authority;

(iii) After receiving the certificate of legal competency and negotiation authority, was rated at least fully successful in each quality performance element of his or her performance plan for the last two complete fiscal years as a patent examiner; and

(iv) Was not under an oral or written warning regarding the quality performance elements at the time of separation from the patent examining corps.

(2) *Former patent examiners who on July 26, 2004, had actively served four years in the patent examining corps, and were serving in the corps at the time of their separation.* The OED Director may waive the taking of a registration examination in the case of any individual meeting the requirements of paragraph (b)(1)(i)(C) of this section who is a former patent examiner and by July 26, 2004, had served four years in the patent examining corps, if the individual demonstrates that he or she:

(i) Actively served for at least four years in the patent examining corps of the Office by July 26, 2004, and was serving in the corps at the time of separation from the Office;

(ii) Was rated at least fully successful in each quality performance element of his or her performance plan for the last two complete fiscal years as a patent examiner in the Office; and

(iii) Was not under an oral or written warning regarding the quality performance elements at the time of separation from the patent examining corps.

(3) *Certain former Office employees who were not serving in the patent examining corps upon their separation from the Office.* The OED Director may waive the taking of a registration examination in the case of a former Office employee meeting the requirements of paragraph (b)(1)(i)(C) of this section who by petition demonstrates possession of the necessary legal qualifications to render to patent applicants and others valuable service and assistance in the preparation and prosecution of their applications or other business before the Office by showing that he or she has:

(i) Exhibited comprehensive knowledge of patent law equivalent to that shown by passing the registration examination as a result of having

been in a position of responsibility in the Office in which he or she:

(A) Provided substantial guidance on patent examination policy, including the development of rule or procedure changes, patent examination guidelines, changes to the Manual of Patent Examining Procedure, development of training or testing materials for the patent examining corps, or development of materials for the registration examination or continuing legal education; or

(B) Represented the Office in patent cases before Federal courts; and

(ii) Was rated at least fully successful in each quality performance element of his or her performance plan for said position for the last two complete rating periods in the Office, and was not under an oral or written warning regarding such performance elements at the time of separation from the Office.

(4) To be eligible for consideration for waiver, an individual formerly employed by the Office within the scope of one of paragraphs (d)(1), (d)(2) or (d)(3) of this section must file a complete application for registration and pay the fee required by § 1.21(a)(1)(i) of this subchapter within two years of the individual's date of separation from the Office. All other individuals formerly employed by the Office, including former examiners, filing an application for registration or fee more than two years after separation from the Office, are required to take and pass the registration examination. The individual or former examiner must pay the examination fee required by § 1.21(a)(1)(ii) of this subchapter within thirty days after notice of non-waiver.

(e) *Examination results.* Notification of the examination results is final. Within sixty days of the mailing date of a notice of failure, the individual is entitled to inspect, but not copy, the questions and answers he or she incorrectly answered. Review will be under supervision. No notes may be taken during such review. Substantive review of the answers or questions may not be pursued by petition for regrade. An individual who failed the examination has the right to retake the examination an unlimited number of times upon payment of the fees required by § 1.21(a)(1)(i) and (ii) of this subchapter, and a fee charged by a commercial entity administering the examination.

(f) *Application for reciprocal recognition.* An individual seeking reciprocal recognition under § 11.6(c), in addition to satisfying the provisions of paragraphs (a) and (b) of this section, and the provisions of § 11.8(c), shall pay the application fee required by § 1.21(a)(1)(i) of this subchapter upon filing an application for registration.

(g) *Investigation of good moral character and reputation.* (1) Every individual seeking recognition shall answer all questions in the application for registration and request(s) for comments issued by OED; disclose all relevant facts, dates and information; and provide verified copies of documents relevant to his or her good moral character and reputation. An individual who is an attorney shall submit a certified copy of each of his or her State bar applications and moral character determinations, if available.

(2)(i) If the OED Director receives information from any source that reflects adversely on the good moral character or reputation of an individual seeking registration or recognition, the OED Director shall conduct an investigation into the good moral character and reputation of that individual. The investigation will be conducted after the individual has passed the registration examination, or after the registration examination has been waived for the individual, as applicable. An individual failing to timely answer questions or respond to an inquiry by OED shall be deemed to have withdrawn his or her application, and shall be required to reapply, pass the examination, and otherwise satisfy all the requirements of this section. No individual shall be certified for registration or recognition by the OED Director until, to the satisfaction of the OED Director, the individual demonstrates his or her possession of good moral character and reputation.

(ii) The OED Director, in considering an application for registration by an attorney, may accept a State bar's character determination as meeting the requirements set forth in paragraph (g) of this section if, after review, the Office finds no substantial discrepancy between the information provided with his or her application for registration and the State bar application and moral character determination, provided that acceptance is not

inconsistent with other rules and the requirements of 35 U.S.C. 2(b)(2)(D).

(h) *Good moral character and reputation.* Evidence showing lack of good moral character and reputation may include, but is not limited to, conviction of a felony or a misdemeanor identified in paragraph (h)(1) of this section, drug or alcohol abuse; lack of candor; suspension or disbarment on ethical grounds from a State bar; and resignation from a State bar while under investigation.

(1) *Conviction of felony or misdemeanor.* An individual who has been convicted of a felony or a misdemeanor involving moral turpitude, breach of trust, interference with the administration of justice, false swearing, misrepresentation, fraud, deceit, bribery, extortion, misappropriation, theft, or conspiracy to commit any felony or misdemeanor, is presumed not to be of good moral character and reputation in the absence of a pardon or a satisfactory showing of reform and rehabilitation, and shall file with his or her application for registration the fees required by § 1.21(a)(1)(ii) and (a)(10) of this subchapter. The OED Director shall determine whether individuals convicted of said felony or misdemeanor provided satisfactory proof of reform and rehabilitation.

(i) An individual who has been convicted of a felony or a misdemeanor identified in paragraph (h)(1) of this section shall not be eligible to apply for registration during the time of any sentence (including confinement or commitment to imprisonment), deferred adjudication, and period of probation or parole as a result of the conviction, and for a period of two years after the date of completion of the sentence, deferred adjudication, and period of probation or parole, whichever is later.

(ii) The following presumptions apply to the determination of good moral character and reputation of an individual convicted of said felony or misdemeanor:

(A) The court record or docket entry of conviction is conclusive evidence of guilt in the absence of a pardon or a satisfactory showing of reform or rehabilitation; and

(B) An individual convicted of a felony or any misdemeanor identified in paragraph (h)(1) of this section is conclusively deemed not to have good moral character and reputation, and shall not be eligible to apply for registration for a period of two years after completion of the sentence, deferred adjudication, and period of probation or parole, whichever is later.

(iii) The individual, upon applying for registration, shall provide satisfactory evidence that he or she is of good moral character and reputation.

(iv) Upon proof that a conviction has been set aside or reversed, the individual shall be eligible to file a complete application for registration and the fee required by § 1.21(a)(1)(ii) of this subchapter and, upon passing the registration examination, have the OED Director determine, in accordance with paragraph (h)(1) of this section, whether, absent the conviction, the individual possesses good moral character and reputation.

(2) *Good moral character and reputation involving drug or alcohol abuse.* An individual's record is reviewed as a whole to see if there is a drug or alcohol abuse issue. An individual appearing to abuse drugs or alcohol may be asked to undergo an evaluation, at the individual's expense, by a qualified professional approved by the OED Director. In instances where, before an investigation commences, there is evidence of a present abuse or an individual has not established a record of recovery, the OED Director may request the individual to withdraw his or her application, and require the individual to satisfactorily demonstrate that he or she is complying with treatment and undergoing recovery.

(3) *Moral character and reputation involving lack of candor.* An individual's lack of candor in disclosing facts bearing on or relevant to issues concerning good moral character and reputation when completing the application or any time thereafter may be found to be cause to deny registration on moral character and reputation grounds.

(4) *Moral character and reputation involving suspension, disbarment, or resignation from a profession.*

(i) An individual who has been disbarred or suspended from practice of law or other profession, or has resigned in lieu of a disciplinary proceeding (excluded or disbarred on consent) shall be ineligible to apply for registration as follows:

(A) An individual who has been disbarred from practice of law or other profession,

or has resigned in lieu of a disciplinary proceeding (excluded or disbarred on consent) shall be ineligible to apply for registration for a period of five years from the date of disbarment or resignation.

(B) An individual who has been suspended on ethical grounds from the practice of law or other profession shall be ineligible to apply for registration until expiration of the period of suspension.

(C) An individual who was not only disbarred, suspended or resigned in lieu of a disciplinary proceeding, but also convicted in a court of a felony, or of a crime involving moral turpitude or breach of trust, shall be ineligible to apply for registration until the conditions in paragraphs (h)(1) and (h)(4) of this section are fully satisfied.

(ii) An individual who has been disbarred or suspended, or who resigned in lieu of a disciplinary proceeding shall file an application for registration and the fees required by § 1.21(a)(1)(ii) and (a)(10) of this subchapter; provide a full and complete copy of the proceedings that led to the disbarment, suspension, or resignation; and provide satisfactory proof that he or she possesses good moral character and reputation. The following presumptions shall govern the determination of good moral character and reputation of an individual who has been licensed to practice law or other profession in any jurisdiction and has been disbarred, suspended on ethical grounds, or allowed to resign in lieu of discipline, in that jurisdiction.

(A) A copy of the record resulting in disbarment, suspension or resignation is *prima facie* evidence of the matters contained in the record, and the imposition of disbarment or suspension, or the acceptance of the resignation of the individual shall be deemed conclusive that the individual has committed professional misconduct.

(B) The individual is ineligible for registration and is deemed not to have good moral character and reputation during the period of the imposed discipline.

(iii) The only defenses available with regard to an underlying disciplinary matter resulting in disbarment, suspension on ethical grounds, or resignation in lieu of a disciplinary proceeding are set out below, and must be shown to the satisfaction of the OED Director:

(A) The procedure in the disciplinary court was so lacking in notice or opportunity to be heard as to constitute a deprivation of due process;

(B) There was such infirmity of proof establishing the misconduct as to give rise to the clear conviction that the Office could not, consistently with its duty, accept as final the conclusion on that subject; or

(C) The finding of lack of good moral character and reputation by the Office would result in grave injustice.

(i) *Factors that may be taken into consideration when evaluating rehabilitation of an individual seeking a moral character and reputation determination.* The factors enumerated below are guidelines to assist the OED Director in determining whether an individual has demonstrated rehabilitation from an act of misconduct or moral turpitude. The factors include:

(1) The nature of the act of misconduct, including whether it involved moral turpitude, whether there were aggravating or mitigating circumstances, and whether the activity was an isolated event or part of a pattern;

(2) The age and education of the individual at the time of the misconduct and the age and education of the individual at the present time;

(3) The length of time that has passed between the misconduct and the present, absent any involvement in any further acts of moral turpitude, the amount of time and the extent of rehabilitation being dependent upon the nature and seriousness of the act of misconduct under consideration;

(4) Restitution by the individual to any person who suffered monetary losses through acts or omissions of the individual;

(5) Expungement of a conviction;

(6) Successful completion or early discharge from probation or parole;

(7) Abstinence from the use of controlled substances or alcohol for not less than two years if the specific misconduct was attributable in part to the use of a controlled substance or alcohol, where abstinence may be demonstrated by, but is not necessarily limited to, enrolling in and complying with a self-help or professional treatment program;

(8) If the specific misconduct was attributable in part to a medically recognized mental disease, disorder or illness, proof that the individual sought professional assistance, and complied with the treatment program prescribed by the professional, and submitted letters from the treating psychiatrist/psychologist verifying that the medically recognized mental disease, disorder or illness will not impede the individual's ability to competently practice before the Office;

(9) Payment of the fine imposed in connection with any criminal conviction;

(10) Correction of behavior responsible in some degree for the misconduct;

(11) Significant and conscientious involvement in programs designed to provide social benefits or to ameliorate social problems; and

(12) Change in attitude from that which existed at the time of the act of misconduct in question as evidenced by any or all of the following:

(i) Statements of the individual;

(ii) Statements from persons familiar with the individual's previous misconduct and with subsequent attitudes and behavioral patterns;

(iii) Statements from probation or parole officers or law enforcement officials as to the individual's social adjustments; and

(iv) Statements from persons competent to testify with regard to neuropsychiatry or emotional disturbances.

(j) *Notice to Show Cause.* The OED Director shall inquire into the good moral character and reputation of an individual seeking registration, providing the individual with the opportunity to create a record on which a decision is made. If, following inquiry and consideration of the record, the OED Director is of the opinion that the individual seeking registration has not satisfactorily established that he or she possesses good moral character and reputation, the OED Director shall issue to the individual a notice to show cause why the individual's application for registration should not be denied.

(1) The individual shall be given no less than ten days from the date of the notice to reply. The notice shall be given by certified mail at the address appearing on the application if the address is in the United States, and by any other reasonable means if the address is outside the United States.

(2) Following receipt of the individual's response, or in the absence of a response, the OED Director shall consider the individual's response, if any, and the record, and determine whether, in the OED Director's opinion, the individual has sustained his or her burden of satisfactorily demonstrating that he or she possesses good moral character and reputation.

(k) *Reapplication for registration.* An individual who has been refused registration for lack of good moral character or reputation may reapply for registration two years after the date of the decision, unless a shorter period is otherwise ordered by the USPTO Director. An individual, who has been notified that he or she is under investigation for good moral character and reputation may elect to withdraw his or her application for registration, and may reapply for registration two years after the date of withdrawal. Upon reapplication for registration, the individual shall pay the fees required by § 1.21(a)(1)(ii) and (a)(10) of this subchapter, and has the burden of showing to the satisfaction of the OED Director his or her possession of good moral character and reputation as prescribed in paragraph (b) of this section. Upon reapplication for registration, the individual also shall complete successfully the examination prescribed in paragraph (b) of this section, even though the individual has previously passed a registration examination.

[Added, 69 FR 35427, June 24, 2004, effective July 26, 2004]

§ 11.8 Oath and registration fee.

(a) After an individual passes the examination, or the examination is waived, the OED Director shall promptly publish a solicitation for information concerning the individual's good moral character and reputation. The solicitation shall include the individual's name, and business or communication postal address.

(b) An individual shall not be registered as an attorney under § 11.6(a), registered as an agent under § 11.6(b) or (c), or granted limited recognition under § 11.9(b) unless within two years of the mailing date of a notice of passing registration examination or of waiver of the examination the

individual files with the OED Director a completed Data Sheet, an oath or declaration prescribed by the USPTO Director, and the registration fee set forth in § 1.21(a)(2) of this subchapter. An individual seeking registration as an attorney under § 11.6(a) must provide a certificate of good standing of the bar of the highest court of a State that is no more than six months old.

(c) An individual who does not comply with the requirements of paragraph (b) of this section within the two-year period will be required to retake the registration examination.

(d) [Reserved]

[Added, 69 FR 35427, June 24, 2004, effective July 26, 2004; para. (d) added, 73 FR 67750, Nov. 17, 2008, effective Dec. 17, 2008; para. (d) removed and reserved, 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.9 Limited recognition in patent matters.

(a) Any individual not registered under § 11.6 may, upon a showing of circumstances which render it necessary or justifiable, and that the individual is of good moral character and reputation, be given limited recognition by the OED Director to prosecute as attorney or agent a specified patent application or specified patent applications. Limited recognition under this paragraph shall not extend further than the application or applications specified. Limited recognition shall not be granted while individuals who have passed the examination or for whom the examination has been waived are awaiting registration to practice before the Office in patent matters.

(b) A nonimmigrant alien residing in the United States and fulfilling the provisions of § 11.7(a) and (b) may be granted limited recognition if the nonimmigrant alien is authorized by the United States Government to be employed or trained in the United States in the capacity of representing a patent applicant by presenting or prosecuting a patent application. Limited recognition shall be granted for a period consistent with the terms of authorized employment or training. Limited recognition shall not be granted or extended to a non-United States citizen residing abroad. If granted, limited recognition shall automatically expire upon the nonimmigrant alien's departure from the United States.

(c) An individual not registered under § 11.6 may, if appointed by an applicant, prosecute an international patent application only before the United States International Searching Authority and the United States International Preliminary Examining Authority, provided that the individual has the right to practice before the national office with which the international application is filed as provided in PCT Art. 49, Rule 90 and § 1.455 of this subchapter, or before the International Bureau when the USPTO is acting as Receiving Office pursuant to PCT Rules 83.1 *bis* and 90.1.

[Added, 69 FR 35427, June 24, 2004, effective July 26, 2004; para. (b) revised, 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.10 Restrictions on practice in patent matters.

(a) Only practitioners who are registered under § 11.6 or individuals given limited recognition under § 11.9(a) or (b) are permitted to prosecute patent applications of others before the Office; or represent others in any proceedings before the Office.

(b) *Post employment agreement of former Office employee.* No individual who has served in the patent examining corps or elsewhere in the Office may practice before the Office after termination of his or her service, unless he or she signs a written undertaking agreeing:

(1) To not knowingly act as agent or attorney for, or otherwise represent, or assist in any manner the representation of, any other person:

(i) Before the Office,

(ii) In connection with any particular patent or patent application,

(iii) In which said employee participated personally and substantially as an employee of the Office; and

(2) To not knowingly act within two years after terminating employment by the Office as agent or attorney for, or otherwise represent, or assist in any manner the representation of any other person:

(i) Before the Office,

(ii) In connection with any particular patent or patent application,

(iii) If such patent or patent application was pending under the employee's official responsibility as an officer or employee within a period of one year prior to the termination of such responsibility.

(3) The words and phrases in paragraphs (b)(1) and (b)(2) of this section are construed as follows:

(i) *Represent* and *representation* mean acting as patent attorney or patent agent or other representative in any appearance before the Office, or communicating with an employee of the Office with intent to influence.

(ii) *Assist in any manner* means aid or help another person on a particular patent or patent application involving representation.

(iii) Particular patent or patent application means any patent or patent application, including, but not limited to, a provisional, substitute, international, international design, continuation, divisional, continuation-in-part, or reissue patent application, as well as any protest, reexamination, petition, appeal, interference, or trial proceeding based on the patent or patent application.

(iv) *Participate personally and substantially.* (A) Basic requirements. The restrictions of § 11.10(a)(1) apply only to those patents and patent applications in which a former Office employee had "personal and substantial participation," exercised "through decision, approval, disapproval, recommendation, the rendering of advice, investigation or otherwise." To *participate personally* means directly, and includes the participation of a subordinate when actually directed by the former Office employee in the patent or patent application. *Substantially* means that the employee's involvement must be of significance to the matter, or form a basis for a reasonable appearance of such significance. It requires more than official responsibility, knowledge, perfunctory involvement, or involvement on an administrative or peripheral issue. A finding of substantiality should be based not only on the effort devoted to a patent or patent application, but also on the importance of the effort. While a series of peripheral involvements may be insubstantial, the single act of approving or participation in a critical step may be substantial. It is essential that the participation be related to a "particular patent or patent application." (*See* paragraph (b)(3)(iii) of this section.)

(B) Participation on ancillary matters. An Office employee's participation on subjects not directly involving the substantive merits of a patent or patent application may not be "substantial," even if it is time-consuming. An employee whose official responsibility is the review of a patent or patent application solely for compliance with administrative control or budgetary considerations and who reviews a particular patent or patent application for such a purpose should not be regarded as having participated substantially in the patent or patent application, except when such considerations also are the subject of the employee's proposed representation.

(C) Role of official responsibility in determining substantial participation. *Official responsibility* is defined in paragraph (b)(3)(v) of this section. "Personal and substantial participation" is different from "official responsibility." One's responsibility may, however, play a role in determining the "substantiality" of an Office employee's participation.

(v) *Official responsibility* means the direct administrative or operating authority, whether intermediate or final, and either exercisable alone or with others, and either personally or through subordinates, to approve, disapprove, or otherwise direct Government actions.

(A) Determining official responsibility. Ordinarily, those areas assigned by statute, regulation, Executive Order, job description, or delegation of authority determine the scope of an employee's "official responsibility". All particular matters under consideration in the Office are under the "official responsibility" of the Director of the Office, and each is under that of any intermediate supervisor having responsibility for an employee who actually participates in the patent or patent application within the scope of his or her duties. A patent examiner would have "official responsibility" for the patent applications assigned to him or her.

(B) Ancillary matters and official responsibility. *Administrative* authority as used in paragraph (v) of this section means authority for planning, organizing and controlling a patent or patent application rather than authority to review or make decisions on ancillary aspects of a patent or

patent application such as the regularity of budgeting procedures, public or community relations aspects, or equal employment opportunity considerations. Responsibility for such an ancillary consideration does not constitute official responsibility for the particular patent or patent application, except when such a consideration is also the subject of the employee's proposed representation.

(C) Duty to inquire. In order for a former employee, *e.g.*, former patent examiner, to be barred from representing or assisting in representing another as to a particular patent or patent application, he or she need not have known, while employed by the Office, that the patent or patent application was pending under his or her official responsibility. The former employee has a reasonable duty of inquiry to learn whether the patent or patent application had been under his or her official responsibility. Ordinarily, a former employee who is asked to represent another on a patent or patent application will become aware of facts sufficient to suggest the relationship of the prior matter to his or her former office, *e.g.*, technology center, group or art unit. If so, he or she is under a duty to make further inquiry. It would be prudent for an employee to maintain a record of only patent application numbers of the applications actually acted upon by decision or recommendation, as well as those applications under the employee's official responsibility which he or she has not acted upon.

(D) Self-disqualification. A former employee, *e.g.*, former patent examiner, cannot avoid the restrictions of this section through self-disqualification with respect to a patent or patent application for which he or she otherwise had official responsibility. However, an employee who through self-disqualification does not participate personally and substantially in a particular patent or patent application is not subject to the lifetime restriction of paragraph (b)(1) of this section.

(vi) *Pending* means that the matter was in fact referred to or under consideration by persons within the employee's area of official responsibility.

(4) Measurement of the two-year restriction period. The two-year period under paragraph (b)(2) of this section is measured from the date when the employee's official responsibility in a particular area ends, not from the termination of service in the Office, unless the two occur simultaneously. The prohibition applies to all particular patents or patent applications subject to such official responsibility in the one-year period before termination of such responsibility.

(c) *Former employees of the Office.* This section imposes restrictions generally parallel to those imposed in 18 U.S.C. 207(a) and (b)(1). This section, however, does not interpret these statutory provisions or any other post-employment restrictions that may apply to former Office employees, and such former employees should not assume that conduct not prohibited by this section is otherwise permissible. Former employees of the Office, whether or not they are practitioners, are encouraged to contact the Department of Commerce for information concerning applicable post-employment restrictions.

(d) An employee of the Office may not prosecute or aid in any manner in the prosecution of any patent application before the Office.

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

[Added, 69 FR 35427, June 24, 2004, effective July 26, 2004; para. (b)(3)(iii) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012; para. (b)(3)(iii) revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 11.11 Administrative suspension, inactivation, resignation, reinstatement, and revocation.

(a) *Contact information.*

(1) A registered practitioner, or person granted limited recognition under § 11.9(b), must notify the OED director of the postal address for their office, at least one and up to three email addresses where they receive email, and a business telephone number, as well as every change to each of said addresses and telephone number within thirty days of the date of the change. A registered practitioner, or person granted limited recognition under § 11.9(b), shall, in addition to any notice of change of address and telephone number filed in individual patent applications, separately file written notice of the change of address or telephone number

with the OED director. A registered practitioner, or person granted limited recognition under § 11.9(b), who is an attorney in good standing with the bar of the highest court of one or more states shall provide the OED director with the identification number associated with each bar membership. The OED director shall publish a list containing the name, postal business addresses, business telephone number, registration number or limited recognition number, and registration status as an attorney or agent of each registered practitioner, or person granted limited recognition under [§] 11.9(b), recognized to practice before the Office in patent matters. The OED director may also publish the continuing legal education certification status of each registered practitioner, or person granted limited recognition under § 11.9(b).

(2) Biennially, registered practitioners and persons granted limited recognition may be required to file a registration statement with the OED director for the purpose of ascertaining whether such practitioner desires to remain in an active status. Any registered practitioner, or person granted limited recognition under § 11.9(b), failing to file the registration statement or give any information requested by the OED director within a time limit specified shall be subject to administrative suspension under paragraph (b) of this section.

(3)(i) A registered practitioner, or person granted limited recognition under § 11.9(b), who has completed, in the past 24 months, five hours of continuing legal education credits in patent law and practice and one hour of continuing legal education credit in ethics, may certify such completion to the OED director.

(ii) A registered practitioner, or person granted limited recognition under § 11.9(b), may earn up to two of the five hours of continuing legal education credit in patent law and practice by providing patent *pro bono* legal services through the USPTO Patent Pro Bono Program. One hour of continuing legal education credit in patent law and practice may be earned for every three hours of patent *pro bono* legal service.

(b) *Administrative suspension.*

(1) Whenever it appears that a registered practitioner, or person granted limited recognition under § 11.9(b), has failed to comply with paragraph (a)(2) of this section, the OED director shall publish and send a notice to the registered practitioner, or person granted limited recognition, advising of the noncompliance, the consequence of being administratively suspended set forth in paragraph (b)(6) of this section if noncompliance is not timely remedied, and the requirements for reinstatement under paragraph (f) of this section. The notice shall be published and sent to the registered practitioner, or person granted limited recognition, by mail to the last postal address furnished under paragraph (a) of this section or by email addressed to the last email address furnished under paragraph (a) of this section. The notice shall demand compliance and payment of a delinquency fee set forth in § 1.21(a)(9)(i) of this chapter within 60 days after the date of such notice.

(2) In the event a registered practitioner or person granted limited recognition fails to comply with the notice of paragraph (b)(1) of this section within the time allowed, the OED Director shall publish and send in the manner provided for in paragraph (b)(1) of this section to the registered practitioner or person granted limited recognition a Rule to Show Cause why his or her registration or recognition should not be administratively suspended, and he or she no longer be permitted to practice before the Office in patent matters or in any way hold himself or herself out as being registered or authorized to practice before the Office in patent matters. The OED Director shall file a copy of the Rule to Show Cause with the USPTO Director.

(3) Within 30 days of the OED Director's sending the Rule to Show Cause identified in paragraph (b)(2) of this section, the registered practitioner or person granted limited recognition may file a response to the Rule to Show Cause with the USPTO Director. The response must set forth the factual and legal bases why the person should not be administratively suspended. The registered practitioner or person granted limited recognition shall serve the OED Director with a copy of the response at the time it is filed with the USPTO Director. Within ten days of receiving a copy of the response, the OED Director may file a reply with the USPTO Director that includes documents demonstrating that the notice identified in paragraph (b)(1) of this section was published and sent to the practitioner in accordance with paragraph (b)(1) of this section. A copy of the reply by the OED Director shall be served on the registered practitioner

or person granted limited recognition. When acting on the Rule to Show Cause, if the USPTO Director determines that there are no genuine issues of material fact regarding the Office's compliance with the notice requirements under this section or the failure of the person to pay the requisite fees, the USPTO Director shall enter an order administratively suspending the registered practitioner or person granted limited recognition. Otherwise, the USPTO Director shall enter an appropriate order dismissing the Rule to Show Cause. Nothing herein shall permit an administratively suspended registered practitioner or person granted limited recognition to seek a stay of the administrative suspension during the pendency of any review of the USPTO Director's final decision.

(4) [Reserved]

(5) An administratively suspended registered practitioner or person granted limited recognition is subject to investigation and discipline for his or her conduct prior to, during, or after the period he or she was administratively suspended.

(6) An administratively suspended registered practitioner or person granted limited recognition is prohibited from practicing before the Office in patent cases while administratively suspended. A registered practitioner or person granted limited recognition who knows he or she has been administratively suspended under this section will be subject to discipline for failing to comply with the provisions of this paragraph (b).

(c) *Administrative Inactivation.*

(1) Any registered practitioner who shall become employed by the Office shall comply with § 11.116 for withdrawal from the applications, patents, and trademark matters wherein he or she represents an applicant or other person, and notify the OED Director in writing of said employment on the first day of said employment. The name of any registered practitioner employed by the Office shall be endorsed on the roster as administratively inactive. Upon separation from the Office, the administratively inactive practitioner may request reactivation by completing and filing an application, Data Sheet, signing a written undertaking required by § 11.10, and paying the fee set forth in § 1.21(a)(1)(i) of this subchapter. An administratively inactive practitioner remains subject to the provisions of the USPTO Rules of Professional Conduct and to proceedings and sanctions under §§ 11.19 through 11.58 for conduct that violates a provision of the USPTO Rules of Professional Conduct prior to or during employment at the Office. If, within 30 days after separation from the Office, the registered practitioner does not request active status or another status, the registered practitioner will be endorsed on the roster as voluntarily inactive and be subject to the provisions of paragraph (d) of this section.

(2) Any registered practitioner who is a judge of a court of record, full-time court commissioner, U.S. bankruptcy judge, U.S. magistrate judge, or a retired judge who is eligible for temporary judicial assignment and is not engaged in the practice of law may request, in writing, that his or her name be endorsed on the roster as administratively inactive. Upon acceptance of the request, the OED Director shall endorse the name of the practitioner as administratively inactive. Following separation from the bench, the practitioner may request restoration to active status by completing and filing an application, Data Sheet, and signing a written undertaking required by § 11.10.

(d) *Voluntary Inactivation.*

(1) Except as provided in paragraph (d)(4) of this section, any registered practitioner may voluntarily enter inactive status by filing a request, in writing, that his or her name be endorsed on the roster as voluntarily inactive. Upon acceptance of the request, the OED Director shall endorse the name as voluntarily inactive.

(2) [Reserved]

(3) A registered practitioner who seeks or enters into voluntary inactive status is subject to investigation and discipline for his or her conduct prior to, during, or after the period of his or her inactivation.

(4) [Reserved]

(5) A registered practitioner in voluntary inactive status is prohibited from practicing before the Office in patent cases while in voluntary inactive status. A registered practitioner in voluntary inactive status will be subject to discipline for failing to comply with the provisions of this paragraph. Upon acceptance of the request for voluntary inactive

status, the practitioner must comply with the provisions of § 11.116.

(6) Any registered practitioner whose name has been endorsed as voluntarily inactive pursuant to paragraph (d)(1) of this section and is not under investigation and not subject to a disciplinary proceeding may be restored to active status on the register as may be appropriate provided that the practitioner files a written request for restoration, a completed application for registration on a form supplied by the OED Director furnishing all requested information and material, including information and material pertaining to the practitioner's moral character and reputation under § 11.7(a)(2)(i) during the period of inactivation, a declaration or affidavit attesting to the fact that the practitioner has read the most recent revisions of the patent laws and the rules of practice before the Office, and pays the fees set forth in § 1.21(a)(7)(iii) and (iv) of this subchapter.

(e) *Resignation.* A registered practitioner who is not under investigation under § 11.22 for a possible violation of the USPTO Rules of Professional Conduct, is not subject to discipline under § 11.24 or 11.25, or against whom probable cause has not been found by a panel of the Committee on Discipline under § 11.23(b), may resign by notifying the OED director in writing that they desire to resign. Upon acceptance in writing by the OED director of such notice, that registered practitioner shall no longer be eligible to practice before the Office in patent matters but shall continue to file a change of address for five years thereafter in order that they may be located in the event information regarding the practitioner's conduct comes to the attention of the OED director or any grievance is made about their conduct while they engaged in practice before the Office. The name of any registered practitioner whose resignation is accepted shall be removed from active status, endorsed as resigned, and notice thereof published in the Official Gazette. Upon acceptance of the resignation by the OED director, the resigned practitioner must comply with the provisions of § 11.116. A resigned practitioner is subject to investigation and discipline for their conduct that occurred prior to, during, or after the period of their resignation.

(f) *Administrative reinstatement.*

(1)(i) Any administratively suspended registered practitioner, or person granted limited recognition under § 11.9(b), may be reinstated provided the practitioner:

(A) Is not the subject of a disciplinary investigation or a party to a disciplinary proceeding;

(B) Has applied for reinstatement on an application form supplied by the OED director;

(C) Has demonstrated good moral character and reputation and competence in advising and assisting patent applicants in the presentation and prosecution of their applications before the Office;

(D) Has submitted a declaration or affidavit attesting to the fact that the practitioner has read the most recent revisions of the patent laws and the rules of practice before the Office;

(E) Has paid the fees set forth in § 1.21(a)(9)(ii) of this chapter; and

(F) Has paid all applicable delinquency fees as set forth in § 1.21(a)(9)(i) of this chapter.

(2) Any registered practitioner whose registration has been administratively inactivated pursuant to paragraph (c) of this section may be reinstated to the register as may be appropriate provided within two years after his or her employment with the Office ceases or within two years after his or her employment in a judicial capacity ceases the following is filed with the OED Director: a request for reinstatement, a completed application for registration on a form supplied by the OED Director furnishing all requested information and material, and the fee set forth in § 1.21(a)(9)(ii) of this subchapter. Any registered practitioner inactivated or reinstated is subject to investigation and discipline for his or her conduct before, during, or after the period of his or her inactivation.

(3)(i) Any registered practitioner who has been endorsed as resigned pursuant to paragraph (e) of this section may be reinstated on the register provided the practitioner:

(A) Is not the subject of a disciplinary investigation or a party to a disciplinary proceeding;

(B) Has applied for reinstatement on an application form supplied by the OED director;

(C) Has demonstrated good moral character and reputation and competence in advising and assisting patent applicants in the presentation and prosecution of their applications before the Office;

(D) Has submitted a declaration or affidavit attesting to the fact that the practitioner has read the most recent revisions of the patent laws and the rules of practice before the Office;

(E) Has paid the fees set forth in § 1.21(a)(9)(ii) of this chapter; and

(F) Has paid all applicable delinquency fees as set forth in § 1.21(a)(9)(i) of this chapter.

(ii) Any resigned registered practitioner who applies for reinstatement more than five years after the effective date of the resignation additionally shall be required to file a petition to the OED director requesting reinstatement and providing objective evidence that they continue to possess the necessary legal qualifications to render valuable service to patent applicants.

[Added, 69 FR 35427, June 24, 2004, effective July 26, 2004; revised, 73 FR 67750, Nov. 17, 2008, effective Dec. 17, 2008; paras. (a), (b), and (c) revised, paras. (d)(2) and (d)(4) removed and reserved, and paras. (d)(5), (d)(6), (e) and (f)(1) revised, 78 FR 20180, Apr. 3, 2013, effective May 3, 2013; section heading and paras. (a)(1), (a)(2), (b)(1), (e), and (f)(1) revised and paras. (a)(3) and (f)(3) added, 85 FR 46932, Aug. 3, 2020, effective Oct. 2, 2020]

§ 11.12 - 11.13 [Reserved]

§ 11.14 Individuals who may practice before the Office in trademark and other non-patent matters.

(a) *Attorneys.* Any individual who is an attorney as defined in § 11.1 may represent others before the Office in trademark and other non-patent matters. An attorney is not required to apply for registration or recognition to practice before the Office in trademark and other non-patent matters. Registration as a patent practitioner does not itself entitle an individual to practice before the Office in trademark matters.

(b) *Non-lawyers.* Individuals who are not attorneys are not recognized to practice before the Office in trademark and other non-patent matters, except that individuals not attorneys who were recognized to practice before the Office in trademark matters under this chapter prior to January 1, 1957, will be recognized as agents to continue practice before the Office in trademark matters. Except as provided in the preceding sentence, registration as a patent agent does not itself entitle an individual to practice before the Office in trademark matters.

(c) *Foreigners.*

(1) Any foreign attorney or agent not a resident of the United States who shall file a written application for reciprocal recognition under paragraph (f) of this section and prove to the satisfaction of the OED Director that he or she is a registered and active member in good standing before the trademark office of the country in which he or she resides and practices and possesses good moral character and reputation, may be recognized for the limited purpose of representing parties located in such country before the Office in the presentation and prosecution of trademark matters, provided: The trademark office of such country and the USPTO have reached an official understanding to allow substantially reciprocal privileges to those permitted to practice in trademark matters before the Office. Recognition under this paragraph (c) shall continue only during the period that the conditions specified in this paragraph (c) obtain.

(2) In any trademark matter where a foreign attorney or agent authorized under paragraph (c)(1) of this section is representing an applicant, registrant, or party to a proceeding, an attorney, as defined in § 11.1 and qualified to practice under paragraph (a) of this section, must also be appointed pursuant to § 2.17(b) and (c) of this chapter as the representative who will file documents with the Office and with whom the Office will correspond.

(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) *Appearance.* 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 matters on behalf of a client. Except as specified in § 2.11(a) of this chapter, an individual may appear in a trademark or other

non-patent matter in his or her own behalf or on behalf of:

(1) A firm of which he or she is a member,

(2) A partnership of which he or she is a partner, or

(3) A corporation or association of which he or she is an officer and which he or she is authorized to represent.

(f) *Application for reciprocal recognition.* An individual seeking reciprocal recognition under paragraph (c) of this section, in addition to providing evidence satisfying the provisions of paragraph (c) of this section, shall apply in writing to the OED Director for reciprocal recognition, and shall pay the application fee required by § 1.21(a)(1)(i) of this subchapter.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008; paras. (c) and (e) revised, 84 FR 31498, July 2, 2019, effective Aug. 3, 2019]

§ 11.15 Refusal to recognize a practitioner.

Any practitioner authorized to appear before the Office may be suspended, excluded, or reprimanded in accordance with the provisions of this Part. Any practitioner who is suspended or excluded under this Part shall not be entitled to practice before the Office in patent, trademark, or other non-patent matters while suspended or excluded.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008]

§ 11.16 Requirements for admission to the USPTO Law School Clinic Certification Program.

(a) The USPTO Law School Clinic Certification Program allows students enrolled in a participating law school's clinic to practice before the Office in patent or trademark matters by drafting, filing, and prosecuting patent or trademark applications on a *pro bono* basis for clients that qualify for assistance from the law school's clinic. All law schools accredited by the American Bar Association are eligible for participation in the program, and shall be examined for acceptance using identical criteria.

(b) *Application for admission and renewal—*

(1) *Application for admission.* Non-participating law schools seeking admission to the USPTO Law School Clinic Certification Program, and participating law schools seeking to add a practice area, shall submit an application for admission for such practice area to OED in accordance with criteria and time periods set forth by the OED Director.

(2) *Renewal application.* Each participating law school desiring to continue in the USPTO Law School Clinic Certification Program shall, biennially from a date assigned to the law school by the OED Director, submit a renewal application to OED in accordance with criteria set forth by the OED Director.

(3) The OED Director may refuse admission or renewal of a law school to the USPTO Law School Clinic Certification Program if the OED Director determines that admission, or renewal, of the law school would fail to provide significant benefit to the public or the law students participating in the law school's clinic.

(c) *Faculty Clinic Supervisor.* Any law school seeking admission to or participating in the USPTO Law School Clinic Certification Program must have at least one Faculty Clinic Supervisor for the patent practice area, if the clinic includes patent practice; and at least one Faculty Clinic Supervisor for the trademark practice area, if the clinic includes trademark practice.

(1) *Patent Faculty Clinic Supervisor.* A Faculty Clinic Supervisor for a law school clinic's patent practice must:

(i) Be a registered patent practitioner in active status and good standing with OED;

(ii) Demonstrate at least 3 years experience in prosecuting patent applications before the Office within the 5 years immediately prior to the request for approval as a Faculty Clinic Supervisor;

(iii) Assume full responsibility for the instruction and guidance of law students participating in the law school clinic's patent practice;

(iv) Assume full responsibility for all patent applications and legal services, including filings with the Office, produced by the clinic; and

(v) Comply with all additional criteria established by the OED Director.

(2) *Trademark Faculty Clinic Supervisor.* A Faculty Clinic Supervisor for a law school clinic's trademark practice must:

(i) Be an attorney as defined in § 11.1;

(ii) Demonstrate at least 3 years experience in prosecuting trademark applications before the Office within the 5 years immediately prior to the date of the request for approval as a Faculty Clinic Supervisor;

(iii) Assume full responsibility for the instruction, guidance, and supervision of law students participating in the law school clinic's trademark practice;

(iv) Assume full responsibility for all trademark applications and legal services, including filings with the Office, produced by the clinic; and

(v) Comply with all additional criteria established by the OED Director.

(3) A Faculty Clinic Supervisor under paragraph (c) of this section must submit a statement:

(i) Assuming responsibility for performing conflicts checks for each law student and client in the relevant clinic practice area;

(ii) Assuming responsibility for student instruction and work, including instructing, mentoring, overseeing, and supervising all participating law school students in the clinic's relevant practice area;

(iii) Assuming responsibility for content and timeliness of all applications and documents submitted to the Office through the relevant practice area of the clinic;

(iv) Assuming responsibility for all communications by clinic students to clinic clients in the relevant clinic practice area;

(v) Assuming responsibility for ensuring that there is no gap in representation of clinic clients in the relevant practice area during student turnover, school schedule variations, inter-semester transitions, or other disruptions;

(vi) Attesting to meeting the criteria of paragraph (c)(1) or (2) of this section based on relevant practice area of the clinic; and

(vii) Attesting to all other criteria as established by the OED Director.

(d) *Limited recognition for law students participating in the USPTO Law School Clinic Certification Program.*

(1) The OED Director may grant limited recognition to practice before the Office in patent or trademark matters, or both, to law school students enrolled in a clinic of a law school that is participating in the USPTO Law School Clinic Certification Program upon submission and approval of an application by a law student to OED in accordance with criteria established by the OED Director.

(2) In order to be granted limited recognition to practice before the Office in patent matters under the USPTO Law School Clinic Certification Program, a law student must:

(i) Be enrolled in a law school that is an active participant in the USPTO Law School Clinic Certification Program;

(ii) Be enrolled in the patent practice area of a clinic of the participating law school;

(iii) Have successfully completed at least one year of law school or the equivalent;

(iv) Have read the USPTO Rules of Professional Conduct and the relevant rules of practice and procedure for patent matters;

(v) Be supervised by an approved Faculty Clinic Supervisor pursuant to paragraph (c)(1) of this section;

(vi) Be certified by the dean of the participating law school, or one authorized to act for the dean, as: Having completed the first year of law school or the equivalent, being in compliance with the law school's ethics code, and being of good moral character and reputation;

(vii) Neither ask for nor receive any fee or compensation of any kind for legal services from a clinic client on whose behalf service is rendered;

(viii) Have proved to the satisfaction of the OED Director that he or she possesses the scientific and technical qualifications necessary for him or her to render patent applicants valuable service; and

(ix) Comply with all additional criteria established by the OED Director.

(3) In order to be granted limited recognition to practice before the Office in trademark matters under the USPTO Law School Clinic Certification Program, a law student must:

(i) Be enrolled in a law school that is an active participant in the USPTO Law School Clinic Certification Program;

(ii) Be enrolled in the trademark practice area of a clinic of the participating law school;

(iii) Have successfully completed at least one year of law school or the equivalent;

(iv) Have read the USPTO Rules of Professional Conduct and the relevant USPTO rules of practice and procedure for trademark matters;

(v) Be supervised by an approved Faculty Clinic Supervisor pursuant to paragraph (c)(2) of this section;

(vi) Be certified by the dean of the participating law school, or one authorized to act for the dean, as: Having completed the first year of law school or the equivalent, being in compliance with the law school's ethics code, and being of good moral character and reputation;

(vii) Neither ask for nor receive any fee or compensation of any kind for legal services from a clinic client on whose behalf service is rendered; and

(viii) Comply with all additional criteria established by the OED Director.

(4) Students registered to practice before the Office in patent matters as a patent agent, or authorized to practice before the Office in trademark matters under § 11.14, must complete and submit a student application pursuant to paragraph (d)(1) of this section and meet the criteria of paragraph (d)(2) or (3) of this section, as applicable, in order to participate in the program.

[Added, 81 FR 33591, May 27, 2016, effective June 27, 2016]

§ 11.17 Requirements for participation in the USPTO Law School Clinic Certification Program.

(a) Each law school participating in the USPTO Law School Clinic Certification Program must provide its patent and/or trademark services on a *pro bono* basis.

(b) Each law school participating in the USPTO Law School Clinic Certification Program shall, on a semiannual basis, provide OED with a report regarding its clinic activity during the reporting period, which shall include:

(1) The number of law students participating in each of the patent and trademark practice areas of the school's clinic;

(2) The number of faculty participating in each of the patent and trademark practice areas of the school's clinic;

(3) The number of persons to whom the school's clinic provided assistance in any given patent or trademark matter but with whom no practitioner-client relationship had formed;

(4) The number of client representations undertaken for each of the patent and trademark practice areas of the school's clinic;

(5) The identity and number of applications and responses filed in each of the patent and/or trademark practice areas of the school's clinic;

(6) The number of patents issued, or trademarks registered, to clients of the clinic; and

(7) All other information specified by the OED Director.

(c) *Inactivation of law schools participating in the USPTO Law School Certification Program.*

(1) The OED Director may inactivate a patent and/or trademark practice area of a participating law school:

(i) If the participating law school does not have an approved Faculty Clinic Supervisor for the relevant practice area, as described in § 11.16(c);

(ii) If the participating law school does not meet each of the requirements and criteria for participation in the USPTO Law School Clinic Certification Program as set forth in § 11.16, this

section, or as otherwise established by the OED Director; or

(iii) For other good cause as determined by the OED Director.

(2) In the event that a practice area of a participating school is inactivated, the participating law school students must:

(i) Immediately cease all student practice before the Office in the relevant practice area and notify each client of such; and

(ii) Disassociate themselves from all client matters relating to practice before the Office in the relevant practice area, including complying with Office and State rules for withdrawal from representation.

(3) A patent or trademark practice area of a law school clinic that has been inactivated may be restored to active status, upon application to and approval by the OED Director.

(d) *Removal of law schools participating in the USPTO Law School Clinic Certification Program.*

(1) The OED Director may remove a patent and/or trademark practice area of the clinic of a law school participating in the USPTO Law School Clinic Certification Program:

(i) Upon request from the law school;

(ii) If the participating law school does not meet each of the requirements and criteria for participation in the USPTO Law School Clinic Certification Program as set forth in § 11.16, this section, or as otherwise established by the OED Director; or

(iii) For other good cause as determined by the OED Director.

(2) In the event that a practice area of a participating school is removed by the OED Director, the participating law school students must:

(i) Immediately cease all student practice before the Office in the relevant practice area and notify each client of such; and

(ii) Disassociate themselves from all client matters relating to practice before the Office in the relevant practice area, including complying with Office and State rules for withdrawal from representation.

(3) A school that has been removed from participation in the USPTO Law School Clinic Certification Program under this section may reapply to the program in compliance with § 11.16.

[Added, 81 FR 33591, May 27, 2016, effective June 27, 2016]

§ 11.18 Signature and certificate for correspondence filed in the Office.

(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, and all documents filed with a hearing officer in a disciplinary proceeding, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Office must bear a signature, personally signed or inserted by such practitioner, in compliance with § 1.4(d) or § 2.193(a) of this chapter.

(b) By presenting to the Office or hearing officer in a disciplinary proceeding (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 Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or knowingly and willfully makes any false, fictitious, or fraudulent statements or representations, or knowingly and willfully 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 any other applicable criminal statute, and violations of the provisions of this section may jeopardize the probative value of the paper; and

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

(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 any proceeding before the Office;

(ii) The 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 any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions or actions as deemed appropriate by the USPTO Director, which may include, but are not limited to, any combination of—

(1) Striking the offending paper;

(2) Referring a practitioner's conduct to the Director of Enrollment and Discipline for appropriate action;

(3) Precluding a party or practitioner from submitting a paper, or presenting or contesting an issue;

(4) Affecting the weight given to the offending paper; or

(5) Terminating the proceedings in the Office.

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008; para. (a) revised, 78 FR 62368, Oct. 21, 2013, effective Dec. 18, 2013]

Subpart C — Investigations and Disciplinary Proceedings; Jurisdiction, Sanctions, Investigations, and Proceedings

§ 11.19 Disciplinary jurisdiction; Jurisdiction to transfer to disability inactive status.

(a) All practitioners engaged in practice before the Office; all practitioners administratively suspended; all practitioners registered to practice before the Office in patent cases; all practitioners inactivated; all practitioners authorized under § 11.6(d) to take testimony; and all practitioners transferred to disability inactive status, reprimanded, suspended, or excluded from the practice of law by a duly constituted authority, including by the USPTO Director, are subject to the disciplinary jurisdiction of the Office. Practitioners who have resigned shall also be subject to such jurisdiction with respect to conduct undertaken prior to the resignation and conduct in regard to any practice before the Office following the resignation. A person not registered or recognized to practice before the Office is also subject to the disciplinary authority of the Office if the person provides or offers to provide any legal services before the Office.

(b) *Grounds for discipline; Grounds for transfer to disability inactive status.* The following, whether done individually by a practitioner or in concert with any other person or persons and whether or not done in the course of providing legal services to a client, or in a matter pending before the Office, constitute grounds for discipline or grounds for transfer to disability inactive status.

(1) Grounds for discipline include:

(i) Conviction of a serious crime;

(ii) Discipline on ethical grounds imposed in another jurisdiction or disciplinary disqualification from participating in or appearing before any Federal program or agency;

(iii) Failure to comply with any order of a Court disciplining a practitioner, or any final decision of the USPTO Director in a disciplinary matter;

(iv) Violation of any USPTO Rule of Professional Conduct; or

(v) Violation of the oath or declaration taken by the practitioner. See § 11.8.

(2) Grounds for transfer to disability inactive status include:

(i) Being transferred to disability inactive status in another jurisdiction;

(ii) Being judicially declared incompetent, being judicially ordered to be involuntarily committed after a hearing on the grounds of insanity, incompetency or disability, or

being placed by court order under guardianship or conservatorship; or

(iii) Filing a motion requesting a disciplinary proceeding be held in abeyance because the practitioner is suffering from a disability or addiction that makes it impossible for the practitioner to adequately defend the charges in the disciplinary proceeding.

(c) Petitions to disqualify a practitioner in *ex parte* or *inter partes* matters in the Office are not governed by §§ 11.19 through 11.60 and will be handled on a case-by-case basis under such conditions as the USPTO Director deems appropriate.

(d) The OED Director may refer the existence of circumstances suggesting unauthorized practice of law to the authorities in the appropriate jurisdiction(s).

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008; paras. (a) and (b)(1)(iv) revised, 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.20 Disciplinary sanctions; Transfer to disability inactive status.

(a) *Types of discipline.* The USPTO Director, after notice and opportunity for a hearing, and where grounds for discipline exist, may impose on a practitioner the following types of discipline:

(1) Exclusion from practice before the Office;

(2) Suspension from practice before the Office for an appropriate period of time;

(3) Reprimand or censure; or

(4) *Probation.* Probation may be imposed *in lieu* of or in addition to any other disciplinary sanction. Any conditions of probation shall be stated in writing in the order imposing probation. The order shall also state whether, and to what extent, the practitioner shall be required to notify clients of the probation. Violation of any condition of probation shall be cause for imposition of the disciplinary sanction. Imposition of the disciplinary sanction predicated upon violation of probation shall occur only after an order to show cause why the disciplinary sanction should not be imposed is resolved adversely to the practitioner.

(b) *Conditions imposed with discipline.* When imposing discipline, the USPTO Director may condition reinstatement upon the practitioner making restitution, successfully completing a professional responsibility course or examination, or any other condition deemed appropriate under the circumstances.

(c) *Transfer to disability inactive status.* The USPTO Director, after notice and opportunity for a hearing may, and where grounds exist to believe a practitioner has been transferred to disability inactive status in another jurisdiction, or has been judicially declared incompetent; judicially ordered to be involuntarily committed after a hearing on the grounds of incompetency or disability, or placed by court order under guardianship or conservatorship, transfer the practitioner to disability inactive status.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008; paras. (a)(4) and (b) revised, 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.21 Warnings.

A warning is neither public nor a disciplinary sanction. The OED Director may conclude an investigation with the issuance of a warning. The warning shall contain a brief statement of facts and USPTO Rules of Professional Conduct relevant to the facts.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008; revised, 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.22 Disciplinary Investigations.

(a) The OED Director is authorized to investigate possible grounds for discipline. An investigation may be initiated when the OED Director receives a grievance, information or evidence from any source suggesting possible grounds for discipline. Neither unwillingness nor neglect by a grievant to prosecute a charge, nor settlement, compromise, or restitution with the grievant, shall in itself justify abatement of an investigation.

(b) Any person possessing information or evidence concerning possible grounds for discipline of a practitioner may report the information or evidence to the OED Director. The OED Director

may request that the report be presented in the form of an affidavit or declaration.

(c) [Reserved]

(d) *Preliminary screening of information or evidence.* The OED Director shall examine all information or evidence concerning possible grounds for discipline of a practitioner.

(e) *Notification of investigation.* The OED Director shall notify the practitioner in writing of the initiation of an investigation into whether a practitioner has engaged in conduct constituting possible grounds for discipline.

(f) *Request for information and evidence by OED Director.*

(1) In the course of the investigation, the OED Director may request information and evidence regarding possible grounds for discipline of a practitioner from:

(i) The grievant,

(ii) The practitioner, or

(iii) Any person who may reasonably be expected to provide information and evidence needed in connection with the grievance or investigation.

(2) The OED Director may request information and evidence regarding possible grounds for discipline of a practitioner from a non-grieving client either after obtaining the consent of the practitioner or upon a finding by a Contact Member of the Committee on Discipline, appointed in accordance with § 11.23(d), that good cause exists to believe that the possible ground for discipline alleged has occurred with respect to non-grieving clients. Neither a request for, nor disclosure of, such information shall constitute a violation of any USPTO Rules of Professional Conduct.

(g) Where the OED Director makes a request under paragraph (f)(2) of this section to a Contact Member of the Committee on Discipline, such Contact Member shall not, with respect to the practitioner connected to the OED Director's request, participate in the Committee on Discipline panel that renders a probable cause determination under paragraph (b)(1) of this section concerning such practitioner, and that forwards the probable cause finding and recommendation to the OED Director under paragraph (b)(2) of this section.

(h) *Disposition of investigation.* Upon the conclusion of an investigation, the OED Director may:

(1) Close the investigation without issuing a warning, or taking disciplinary action;

(2) Issue a warning to the practitioner;

(3) Institute formal charges upon the approval of the Committee on Discipline; or

(4) Enter into a settlement agreement with the practitioner and submit the same for approval of the USPTO Director.

(i) *Closing investigation.* The OED Director shall terminate an investigation and decline to refer a matter to the Committee on Discipline if the OED Director determines that:

(1) The information or evidence is unfounded;

(2) The information or evidence relates to matters not within the jurisdiction of the Office;

(3) As a matter of law, the conduct about which information or evidence has been obtained does not constitute grounds for discipline, even if the conduct may involve a legal dispute; or

(4) The available evidence is insufficient to conclude that there is probable cause to believe that grounds exist for discipline.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008; para. (c) removed and reserved, 77 FR 45247, July 31, 2012, effective August 30, 2012; section heading, para. (f)(2), and para. (i) introductory text revised, 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.23 Committee on Discipline.

(a) The USPTO Director shall appoint a Committee on Discipline. The Committee on Discipline shall consist of at least three employees of the Office. None of the Committee members shall report directly or indirectly to the OED Director or any employee designated by the USPTO Director to decide disciplinary matters. Each Committee member shall be a member in good standing of the bar of the highest court of a State. The Committee members shall select a Chairperson from among themselves. Three Committee members will constitute a panel of the Committee.

(b) *Powers and duties of the Committee on Discipline.* The Committee shall have the power and duty to:

(1) Meet in panels at the request of the OED Director and, after reviewing evidence presented by the OED Director, by majority vote of the panel, determine whether there is probable cause to bring charges under § 11.32 against a practitioner; and

(2) Prepare and forward its own probable cause findings and recommendations to the OED Director.

(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 or of any panel.

(d) The Chairperson shall appoint the members of the panels and a Contact Member of the Committee on Discipline.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008]

§ 11.24 Reciprocal discipline.

(a) *Notification of OED Director.* Within thirty days of being publicly censured, publicly reprimanded, subjected to probation, disbarred or suspended by another jurisdiction, or being disciplinarily disqualified from participating in or appearing before any Federal program or agency, a practitioner subject to the disciplinary jurisdiction of the Office shall notify the OED Director in writing of the same. A practitioner is deemed to be disbarred if he or she is disbarred, excluded on consent, or has resigned in lieu of a disciplinary proceeding. Upon receiving notification from any source or otherwise learning that a practitioner subject to the disciplinary jurisdiction of the Office has been so publicly censured, publicly reprimanded, subjected to probation, disbarred, suspended or disciplinarily disqualified, the OED Director shall obtain a certified copy of the record or order regarding the public censure, public reprimand, probation, disbarment, suspension or disciplinary disqualification and file the same with the USPTO Director. The OED Director shall, in addition, without Committee on Discipline authorization, file with the USPTO Director a complaint complying with § 11.34 against the practitioner predicated upon the public censure, public reprimand, probation, disbarment, suspension or disciplinary disqualification. The OED Director shall request the USPTO Director to issue a notice and order as set forth in paragraph (b) of this section.

(b) *Notification served on practitioner.* Upon receipt of a certified copy of the record or order regarding the practitioner being so publicly censured, publicly reprimanded, subjected to probation, disbarred, suspended or disciplinarily disqualified together with the complaint, the USPTO Director shall issue a notice directed to the practitioner in accordance with § 11.35 and to the OED Director containing:

(1) A copy of the record or order regarding the public censure, public reprimand, probation, disbarment, suspension or disciplinary disqualification;

(2) A copy of the complaint; and

(3) An order directing the practitioner to file a response with the USPTO Director and the OED Director, within forty days of the date of the notice establishing a genuine issue of material fact predicated upon the grounds set forth in paragraphs (d)(1)(i) through (d)(1)(iv) of this section that the imposition of the identical public censure, public reprimand, probation, disbarment, suspension or disciplinary disqualification would be unwarranted and the reasons for that claim.

(c) *Effect of stay in another jurisdiction.* In the event the public censure, public reprimand, probation, disbarment, suspension imposed by another jurisdiction or disciplinary disqualification imposed in the Federal program or agency has been stayed, any reciprocal discipline imposed by the USPTO may be deferred until the stay expires.

(d) *Hearing and discipline to be imposed.*

(1) The USPTO Director shall hear the matter on the documentary record unless the USPTO Director determines that an oral hearing is necessary. After expiration of the forty days from the date of the notice pursuant to provisions of paragraph (b) of this section, the USPTO Director shall consider any timely filed response and shall impose the identical public censure, public reprimand, probation, disbarment, suspension or disciplinary disqualification unless the practitioner clearly and convincingly demonstrates, and the USPTO Director finds there is a genuine issue of material fact that:

(i) The procedure elsewhere was so lacking in notice or opportunity to be heard as to constitute a deprivation of due process;

(ii) There was such infirmity of proof establishing the conduct as to give rise to the clear conviction that the Office could not, consistently with its duty, accept as final the conclusion on that subject;

(iii) The imposition of the same public censure, public reprimand, probation, disbarment, suspension or disciplinary disqualification by the Office would result in grave injustice; or

(iv) Any argument that the practitioner was not publicly censured, publicly reprimanded, placed on probation, disbarred, suspended or disciplinarily disqualified.

(2) If the USPTO Director determines that there is no genuine issue of material fact, the USPTO Director shall enter an appropriate final order. If the USPTO Director is unable to make such determination because there is a genuine issue of material fact, the USPTO Director shall enter an appropriate order:

(i) Referring the complaint to a hearing officer for a formal hearing and entry of an initial decision in accordance with the other rules in this part, and

(ii) Directing the practitioner to file an answer to the complaint in accordance with § 11.36.

(e) *Adjudication in another jurisdiction or Federal agency or program.* In all other respects, a final adjudication in another jurisdiction or Federal agency or program that a practitioner, whether or not admitted in that jurisdiction, has been guilty of misconduct shall establish a prima facie case by clear and convincing evidence that the practitioner has engaged in misconduct under § 11.804.

(f) *Reciprocal discipline —action where practice has ceased.* Upon request by the practitioner, reciprocal discipline may be imposed *nunc pro tunc* only if the practitioner promptly notified the OED Director of his or her censure, public reprimand, probation, disbarment, suspension or disciplinary disqualification in another jurisdiction, and establishes by clear and convincing evidence that the practitioner voluntarily ceased all activities related to practice before the Office and complied with all provisions of § 11.58. The effective date of any public censure, public reprimand, probation, suspension, disbarment or disciplinary disqualification imposed nunc pro tunc shall be the date the practitioner voluntarily ceased all activities related to practice before the Office and complied with all provisions of § 11.58.

(g) *Reinstatement following reciprocal discipline proceeding.* A practitioner may petition for reinstatement under conditions set forth in § 11.60 no sooner than completion of the period of reciprocal discipline imposed, and compliance with all provisions of § 11.58.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008; para. (e) revised, 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.25 Interim suspension and discipline based upon conviction of committing a serious crime.

(a) *Notification of OED Director.* Upon being convicted of a crime in a court of the United States, any State, or a foreign country, a practitioner subject to the disciplinary jurisdiction of the Office shall notify the OED Director in writing of the same within thirty days from the date of such conviction. Upon being advised or learning that a practitioner subject to the disciplinary jurisdiction of the Office has been convicted of a crime, the OED Director shall make a preliminary determination whether the crime constitutes a serious crime warranting interim suspension. If the crime is a serious crime, the OED Director shall file with the USPTO Director proof of the conviction and request the USPTO Director to issue a notice and order set forth in paragraph (b)(2) of this section. The OED Director shall in addition, without Committee on Discipline authorization, file with the USPTO Director a complaint against the practitioner complying with § 11.34 predicated upon the conviction of a serious crime. If the crime is not a serious crime, the OED Director shall process the matter in the same manner as any other information or evidence of a possible violation of any USPTO Rule of Professional Conduct coming to the attention of the OED Director.

(b) *Interim suspension and referral for disciplinary proceeding.* All proceedings under this section shall be handled as expeditiously as possible.

(1) The USPTO Director has authority to place a practitioner on interim suspension after hearing the request for interim suspension on the documentary record.

(2) *Notification served on practitioner.* Upon receipt of a certified copy of the court record, docket entry or judgment demonstrating that the practitioner has been so convicted together with the complaint, the USPTO Director shall forthwith issue a notice directed to the practitioner in accordance with §§ 11.35(a), (b), or (c), and to the OED Director, containing:

(i) A copy of the court record, docket entry, or judgment of conviction;

(ii) A copy of the complaint; and

(iii) An order directing the practitioner to file a response with the USPTO Director and the OED Director, within forty days of the date of the notice, establishing that there is a genuine issue of material fact that the crime did not constitute a serious crime, the practitioner is not the individual found guilty of the crime, or that the conviction was so lacking in notice or opportunity to be heard as to constitute a deprivation of due process.

(3) *Hearing and final order on request for interim suspension.* The request for interim suspension shall be heard by the USPTO Director on the documentary record unless the USPTO Director determines that the practitioner's response establishes a genuine issue of material fact that: The crime did not constitute a serious crime, the practitioner is not the person who committed the crime, or that the conviction was so lacking in notice or opportunity to be heard as to constitute a deprivation of due process. If the USPTO Director determines that there is no genuine issue of material fact regarding the defenses set forth in the preceding sentence, the USPTO Director shall enter an appropriate final order regarding the OED Director's request for interim suspension regardless of the pendency of any criminal appeal. If the USPTO Director is unable to make such determination because there is a genuine issue of material fact, the USPTO Director shall enter a final order dismissing the request and enter a further order referring the complaint to a hearing officer for a hearing and entry of an initial decision in accordance with the other rules in this part and directing the practitioner to file an answer to the complaint in accordance with § 11.36.

(4) *Termination.* The USPTO Director has authority to terminate an interim suspension. In the interest of justice, the USPTO Director may terminate an interim suspension at any time upon a showing of extraordinary circumstances, after affording the OED Director an opportunity to respond to the request to terminate interim suspension.

(5) *Referral for disciplinary proceeding.* Upon entering a final order imposing interim suspension, the USPTO Director shall refer the complaint to a hearing officer to conduct a formal disciplinary proceeding. The formal disciplinary proceeding, however, shall be stayed by the hearing officer until all direct appeals from the conviction are concluded. Review of the initial decision of the hearing officer shall be pursuant to § 11.55.

(c) Proof *of conviction and guilt*—(1) *Conviction in the United States.* For purposes of a hearing for interim suspension and a hearing on the formal charges in a complaint filed as a consequence of the conviction, a certified copy of the court record, docket entry, or judgment of conviction in a court of the United States or any State shall establish a prima facie case by clear and convincing evidence that the practitioner was convicted of a serious crime and that the conviction was not lacking in notice or opportunity to be heard as to constitute a deprivation of due process.

(2) *Conviction in a foreign country.* For purposes of a hearing for interim suspension and on the formal charges filed as a result of a finding of guilt, a certified copy of the court record, docket entry, or judgment of conviction in a court of a foreign country shall establish a prima facie case by clear and convincing evidence that the practitioner was convicted of a serious crime and that the conviction was not lacking in notice or opportunity to be heard as to constitute a deprivation of due process. However, nothing in this paragraph shall preclude the practitioner from demonstrating by clear and convincing evidence in any hearing on a request for interim suspension there is a genuine issue of material fact to be considered when determining if the elements of a serious crime were committed in violating the criminal law of the

foreign country and whether a disciplinary sanction should be entered.

(d) *Crime determined not to be serious crime.* If the USPTO Director determines that the crime is not a serious crime, the complaint shall be referred to the OED Director for investigation under § 11.22 and processing as is appropriate.

(e) *Reinstatement*—(1) *Upon reversal or setting aside a finding of guilt or a conviction.* If a practitioner suspended solely under the provisions of paragraph (b) of this section demonstrates that the underlying finding of guilt or conviction of serious crimes has been reversed or vacated, the order for interim suspension shall be vacated and the practitioner shall be placed on active status unless the finding of guilt was reversed or the conviction was set aside with respect to less than all serious crimes for which the practitioner was found guilty or convicted. The vacating of the interim suspension will not terminate any other disciplinary proceeding then pending against the practitioner, the disposition of which shall be determined by the hearing officer before whom the matter is pending, on the basis of all available evidence other than the finding of guilt or conviction.

(2) *Following conviction of a serious crime.* Any practitioner convicted of a serious crime and disciplined in whole or in part in regard to that conviction, may petition for reinstatement under conditions set forth in § 11.60 no sooner than five years after being discharged following completion of service of his or her sentence, or after completion of service under probation or parole, whichever is later.

(f) *Notice to clients and others of interim suspension.* An interim suspension under this section shall constitute a suspension of the practitioner for the purpose of § 11.58.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008; para. (a) revised, 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.26 Settlement.

Before or after a complaint under § 11.34 is filed, a settlement conference may occur between the OED Director and the practitioner. Any offers of compromise and any statements made during the course of settlement discussions shall not be admissible in subsequent proceedings. The OED Director may recommend to the USPTO Director any settlement terms deemed appropriate, including steps taken to correct or mitigate the matter forming the basis of the action, or to prevent recurrence of the same or similar conduct. A settlement agreement shall be effective only upon entry of a final decision by the USPTO Director.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008]

§ 11.27 Exclusion on consent.

(a) *Required affidavit.* The OED Director may confer with a practitioner concerning possible violations by the practitioner of the Rules of Professional Conduct whether or not a disciplinary proceeding has been instituted. A practitioner who is the subject of an investigation or a pending disciplinary proceeding based on allegations of grounds for discipline, and who desires to resign, may only do so by consenting to exclusion and delivering to the OED Director an affidavit declaring the consent of the practitioner to exclusion and stating:

(1) That the practitioner's consent is freely and voluntarily rendered, that the practitioner is not being subjected to coercion or duress, and that the practitioner is fully aware of the implications of consenting to exclusion;

(2) That the practitioner is aware that there is currently pending an investigation into, or a proceeding involving allegations of misconduct, the nature of which shall be specifically set forth in the affidavit to the satisfaction of the OED Director;

(3) That the practitioner acknowledges that, if and when he or she applies for reinstatement under § 11.60, the OED Director will conclusively presume, for the limited purpose of determining the application for reinstatement, that:

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

(ii) The practitioner could not have successfully defended himself or herself against the allegations in the investigation or charges in the complaint.

(b) *Action by the USPTO Director.* Upon receipt of the required affidavit, the OED Director shall file the affidavit and any related papers with the USPTO Director for review and approval. Upon such approval, the USPTO Director will enter an order excluding the practitioner on consent and providing other appropriate actions. Upon entry of the order, the excluded practitioner shall comply with the requirements set forth in § 11.58.

(c) When an affidavit under paragraph (a) of this section is received after a complaint under § 11.34 has been filed, the OED Director shall notify the hearing officer. The hearing officer shall enter an order transferring the disciplinary proceeding to the USPTO Director, who may enter an order excluding the practitioner on consent.

(d) *Reinstatement.* Any practitioner excluded on consent under this section may not petition for reinstatement for five years. A practitioner excluded on consent who intends to reapply for admission to practice before the Office must comply with the provisions of § 11.58, and apply for reinstatement in accordance with § 11.60. Failure to comply with the provisions of § 11.58 constitutes grounds for denying an application for reinstatement.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008]

§ 11.28 Incapacitated practitioners in a disciplinary proceeding.

(a) *Holding in abeyance a disciplinary proceeding because of incapacitation due to a current disability or addiction —*

(1) *Practitioner's motion.* In the course of a disciplinary proceeding under § 11.32, but before the date set by the hearing officer for a hearing, the practitioner may file a motion requesting the hearing officer to enter an order holding such proceeding in abeyance based on the contention that the practitioner is suffering from a disability or addiction that makes it impossible for the practitioner to adequately defend the charges in the disciplinary proceeding.

(i) *Content of practitioner's motion.* The practitioner's motion shall, in addition to any other requirement of § 11.43, include or have attached thereto:

(A) A brief statement of all material facts;

(B) Affidavits, medical reports, official records, or other documents and the opinion of at least one medical expert setting forth and establishing any of the material facts on which the practitioner is relying;

(C) A statement that the practitioner acknowledges the alleged incapacity by reason of disability or addiction;

(D) Written consent that the practitioner be transferred to disability inactive status if the motion is granted; and

(E) A written agreement by the practitioner to not practice before the Office in patent, trademark or other non-patent cases while on disability inactive status.

(ii) *Response.* The OED Director's response to any motion hereunder shall be served and filed within thirty days after service of the practitioner's motion unless such time is shortened or enlarged by the hearing officer for good cause shown, and shall set forth the following:

(A) All objections, if any, to the actions requested in the motion;

(B) An admission, denial or allegation of lack of knowledge with respect to each of the material facts in the practitioner's motion and accompanying documents; and

(C) Affidavits, medical reports, official records, or other documents setting forth facts on which the OED Director intends to rely for purposes of disputing or denying any material fact set forth in the practitioner's papers.

(2) *Disposition of practitioner's motion.* The hearing officer shall decide the motion and any response thereto. The motion shall be granted upon a showing of good cause to believe the practitioner to be incapacitated as alleged. If the required showing is made, the hearing officer shall enter an order holding the disciplinary proceeding in abeyance. In the case of addiction to drugs or intoxicants, the order may provide that the practitioner will not be returned to active status absent satisfaction of specified conditions. Upon receipt of the order, the OED Director shall transfer the practitioner to disability inactive status, give notice to the practitioner, cause notice to be

published, and give notice to appropriate authorities in the Office that the practitioner has been placed on disability inactive status. The practitioner shall comply with the provisions of § 11.58, and shall not engage in practice before the Office in patent, trademark and other non-patent law until a determination is made of the practitioner's capability to resume practice before the Office in a proceeding under paragraph (c) or paragraph (d) of this section. A practitioner on disability inactive status must seek permission from the OED Director to engage in an activity authorized under § 11.58(e). Permission will be granted only if the practitioner has complied with all the conditions of §§ 11.58(a) through 11.58(d) applicable to disability inactive status. In the event that permission is granted, the practitioner shall fully comply with the provisions of § 11.58(e).

(b) *Motion for reactivation.* Any practitioner transferred to disability inactive status in a disciplinary proceeding may file with the hearing officer a motion for reactivation once a year beginning at any time not less than one year after the initial effective date of inactivation, or once during any shorter interval provided by the order issued pursuant to paragraph (a)(2) of this section or any modification thereof. If the motion is granted, the disciplinary proceeding shall resume under such schedule as may be established by the hearing officer.

(c) *Contents of motion for reactivation.* A motion by the practitioner for reactivation alleging that a practitioner has recovered from a prior disability or addiction shall be accompanied by all available medical reports or similar documents relating thereto. The hearing officer may require the practitioner to present such other information as is necessary.

(d) *OED Director' s motion to resume disciplinary proceeding held in abeyance.* (1) The OED Director, having good cause to believe a practitioner is no longer incapacitated, may file a motion requesting the hearing officer to terminate a prior order holding in abeyance any pending proceeding because of the practitioner's disability or addiction. The hearing officer shall decide the matter presented by the OED Director's motion hereunder based on the affidavits and other admissible evidence attached to the OED Director's motion and the practitioner's response. The OED Director bears the burden of showing by clear and convincing evidence that the practitioner is able to defend himself or herself. If there is any genuine issue as to one or more material facts, the hearing officer will hold an evidentiary hearing.

(2) The hearing officer, upon receipt of the OED Director's motion under paragraph (d)(1) of this section, may direct the practitioner to file a response. If the hearing officer requires the practitioner to file a response, the practitioner must present clear and convincing evidence that the prior self-alleged disability or addiction continues to make it impossible for the practitioner to defend himself or herself in the underlying proceeding being held in abeyance.

(e) *Action by the hearing officer.* If, in deciding a motion under paragraph (b) or (d) of this section, the hearing officer determines that there is good cause to believe the practitioner is not incapacitated from defending himself or herself, or is not incapacitated from practicing before the Office, the hearing officer shall take such action as is deemed appropriate, including the entry of an order directing the reactivation of the practitioner and resumption of the disciplinary proceeding.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008]

§ 11.29 Reciprocal transfer or initial transfer to disability inactive status.

(a) *Notification of OED Director.*

(1) Transfer to disability inactive status in another jurisdiction as grounds for reciprocal transfer by the Office. Within thirty days of being transferred to disability inactive status in another jurisdiction, a practitioner subject to the disciplinary jurisdiction of the Office shall notify the OED Director in writing of the transfer. Upon notification from any source that a practitioner subject to the disciplinary jurisdiction of the Office has been transferred to disability inactive status in another jurisdiction, the OED Director shall obtain a certified copy of the order. The OED Director shall file with the USPTO Director:

(i) The order;

(ii) A request that the practitioner be transferred to disability inactive status, including the specific grounds therefor; and

(iii) A request that the USPTO Director issue a notice and order as set forth in paragraph (b) of this section.

(2) *Involuntary commitment, adjudication of incompetency or court ordered placement under guardianship or conservatorship as grounds for initial transfer to disability inactive status.* Within thirty days of being judicially declared incompetent, being judicially ordered to be involuntarily committed after a hearing on the grounds of incompetency or disability, or being placed by court order under guardianship or conservatorship in another jurisdiction, a practitioner subject to the disciplinary jurisdiction of the Office shall notify the OED Director in writing of such judicial action. Upon notification from any source that a practitioner subject to the disciplinary jurisdiction of the Office has been subject to such judicial action, the OED Director shall obtain a certified copy of the order. The OED Director shall file with the USPTO Director:

(i) The order;

(ii) A request that the practitioner be transferred to disability inactive status, including the specific grounds therefor; and

(iii) A request that the USPTO Director issue a notice and order as set forth in paragraph (b) of this section.

(b) *Notice served on practitioner.* Upon receipt of a certified copy of an order or declaration issued by another jurisdiction demonstrating that a practitioner subject to the disciplinary jurisdiction of the Office has been transferred to disability inactive status, judicially declared incompetent, judicially ordered to be involuntarily committed after a judicial hearing on the grounds of incompetency or disability, or placed by court order under guardianship or conservatorship, together with the OED Director's request, the USPTO Director shall issue a notice, comporting with § 11.35, directed to the practitioner containing:

(1) A copy of the order or declaration from the other jurisdiction,

(2) A copy of the OED Director's request; and

(3) An order directing the practitioner to file a response with the USPTO Director and the OED Director, within 30 days from the date of the notice, establishing a genuine issue of material fact supported by an affidavit and predicated upon the grounds set forth in § 11.29(d)(1) through (4) that a transfer to disability inactive status would be unwarranted and the reasons therefor.

(c) *Effect of stay of transfer, judicially declared incompetence, judicially ordered involuntarily commitment on the grounds of incompetency or disability, or court-ordered placement under guardianship or conservatorship.* In the event the transfer, judicially declared incompetence, judicially ordered involuntary commitment on the grounds of incompetency or disability, or court-ordered placement under guardianship or conservatorship in the other jurisdiction has been stayed there, any reciprocal transfer or transfer by the Office may be deferred until the stay expires.

(d) *Hearing and transfer to disability inactive status.* The request for transfer to disability inactive status shall be heard by the USPTO Director on the documentary record unless the USPTO Director determines that there is a genuine issue of material fact, in which case the USPTO Director may deny the request. Upon the expiration of 30 days from the date of the notice pursuant to the provisions of paragraph (b) of this section, the USPTO Director shall consider any timely filed response and impose the identical transfer to disability inactive status based on the practitioner's transfer to disability status in another jurisdiction, or shall transfer the practitioner to disability inactive status based on judicially declared incompetence, judicially ordered involuntary commitment on the grounds of incompetency or disability, or court-ordered placement under guardianship or conservatorship, unless the practitioner demonstrates by clear and convincing evidence, or the USPTO Director finds there is a genuine issue of material fact by clear and convincing evidence that:

(1) The procedure was so lacking in notice or opportunity to be heard as to constitute a deprivation of due process;

(2) There was such infirmity of proof establishing the transfer to disability status, judicial declaration of incompetence, judicial order for involuntary commitment on the grounds of incompetency or disability, or placement by court order under guardianship or conservatorship that the USPTO Director could not, consistent with

Office's duty, accept as final the conclusion on that subject;

(3) The imposition of the same disability status or transfer to disability status by the USPTO Director would result in grave injustice; or

(4) The practitioner is not the individual transferred to disability status, judicially declared incompetent, judicially ordered for involuntary commitment on the grounds of incompetency or disability, or placed by court order under guardianship or conservatorship.

(5) If the USPTO Director determines that there is no genuine issue of material fact with regard to any of the elements of paragraphs (d)(1) through (4) of this section, the USPTO Director shall enter an appropriate final order. If the USPTO Director is unable to make that determination because there is a genuine issue of material fact, the USPTO Director shall enter an appropriate order dismissing the OED Director's request for such reason.

(e) *Adjudication in other jurisdiction.* In all other aspects, a final adjudication in another jurisdiction that a practitioner be transferred to disability inactive status, is judicially declared incompetent, is judicially ordered to be involuntarily committed on the grounds of incompetency or disability, or is placed by court order under guardianship or conservatorship shall establish the disability for purposes of a reciprocal transfer to or transfer to disability status before the Office.

(f) A practitioner who is transferred to disability inactive status under this section shall be deemed to have been refused recognition to practice before the Office for purposes of 35 U.S.C. 32.

(g) *Order imposing reciprocal transfer to disability inactive status or order imposing initial transfer to disability inactive status.* An order by the USPTO Director imposing reciprocal transfer to disability inactive status, or transferring a practitioner to disability inactive status shall be effective immediately, and shall be for an indefinite period until further order of the USPTO Director. A copy of the order transferring a practitioner to disability inactive status shall be served upon the practitioner, the practitioner's guardian, and/or the director of the institution to which the practitioner has been committed in the manner the USPTO Director may direct. A practitioner reciprocally transferred or transferred to disability inactive status shall comply with the provisions of § 11.58, and shall not engage in practice before the Office in patent, trademark and other non-patent law unless and until reinstated to active status.

(h) *Confidentiality of proceeding; Orders to be public*—(1) *Confidentiality of proceeding.* All proceedings under this section involving allegations of disability of a practitioner shall be kept confidential until and unless the USPTO Director enters an order reciprocally transferring or transferring the practitioner to disability inactive status.

(2) *Orders to be public.* The OED Director shall publicize any reciprocal transfer to disability inactive status or transfer to disability inactive status in the same manner as for the imposition of public discipline.

(i) *Employment of practitioners on disability inactive status.* A practitioner on disability inactive status must seek permission from the OED Director to engage in an activity authorized under § 11.58(e). Permission will be granted only if the practitioner has complied with all the conditions of §§ 11.58(a) through 11.58(d) applicable to disability inactive status. In the event that permission is granted, the practitioner shall fully comply with the provisions of § 11.58(e).

(j) *Reinstatement from disability inactive status.* (1) *Generally.* No practitioner reciprocally transferred or transferred to disability inactive status under this section may resume active status except by order of the OED Director.

(2) *Petition.* A practitioner reciprocally transferred or transferred to disability inactive status shall be entitled to petition the OED Director for transfer to active status once a year, or at whatever shorter intervals the USPTO Director may direct in the order transferring or reciprocally transferring the practitioner to disability inactive status or any modification thereof.

(3) *Examination.* Upon the filing of a petition for transfer to active status, the OED Director may take or direct whatever action is deemed necessary or proper to determine whether the incapacity has been removed, including a direction for an examination of the practitioner by qualified medical or psychological experts designated by the OED Director. The expense of

the examination shall be paid and borne by the practitioner.

(4) *Required disclosure, waiver of privilege.* With the filing of a petition for reinstatement to active status, the practitioner shall be required to disclose the name of each psychiatrist, psychologist, physician and hospital or other institution by whom or in which the practitioner has been examined or treated for the disability since the transfer to disability inactive status. The practitioner shall furnish to the OED Director written consent to the release of information and records relating to the incapacity if requested by the OED Director.

(5) *Learning in the law, examination.* The OED Director may direct that the practitioner establish proof of competence and learning in law, which proof may include passing the registration examination.

(6) *Granting of petition for transfer to active status.* The OED Director shall grant the petition for transfer to active status upon a showing by clear and convincing evidence that the incapacity has been removed.

(7) *Reinstatement in other jurisdiction.* If a practitioner is reciprocally transferred to disability inactive status on the basis of a transfer to disability inactive status in another jurisdiction, the OED Director may dispense with further evidence that the disability has been removed and may immediately direct reinstatement to active status upon such terms as are deemed proper and advisable.

(8) *Judicial declaration of competency.* If a practitioner is transferred to disability inactive status on the basis of a judicially declared incompetence, judicially ordered involuntary commitment on the grounds of incompetency or disability, or court-ordered placement under guardianship or conservatorship has been declared to be competent, the OED Director may dispense with further evidence that the incapacity to practice law has been removed and may immediately direct reinstatement to active status.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008]

§ 11.30 - 11.31 [Reserved]

§ 11.32 Instituting a disciplinary proceeding.

If after conducting an investigation under § 11.22(a), the OED Director is of the opinion that grounds exist for discipline under § 11.19(b), the OED Director, after complying where necessary with the provisions of 5 U.S.C. 558(c), may convene a meeting of a panel of the Committee on Discipline. If convened, the panel of the Committee on Discipline shall then determine as specified in § 11.23(b) whether there is probable cause to bring disciplinary charges. If the panel of the Committee on Discipline determines that probable cause exists to bring charges, the OED Director may institute a disciplinary proceeding by filing a complaint under § 11.34.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008; revised, 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.33 [Reserved]

§ 11.34 Complaint.

(a) A complaint instituting a disciplinary proceeding shall:

(1) Name the person who is the subject of the complaint who may then be referred to as the "respondent";

(2) Give a plain and concise description of the respondent’s alleged grounds for discipline;

(3) State the place and time, not less than thirty days from the date the complaint is filed, for filing an answer by the respondent;

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

(5) Be signed by the OED Director.

(b) A complaint will be deemed sufficient if it fairly informs the respondent of any grounds for discipline, and where applicable, the USPTO Rules of Professional Conduct that form the basis for the disciplinary proceeding so that the respondent is able to adequately prepare a defense.

(c) The complaint shall be filed in the manner prescribed by the USPTO Director.

(d) *Time for filing a complaint.* A complaint shall be filed within one year after the date on which the OED Director receives a grievance forming the basis of the complaint. No complaint shall be filed more than ten years after the date on which the misconduct forming the basis for the proceeding occurred.

(e) *Tolling agreements.* The one-year period for filing a complaint under paragraph (d) of this section shall be tolled if the involved practitioner and the OED Director agree in writing to such tolling.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008; paras. (d) and (e) added, 77 FR 45247, July 31, 2012, effective August 30, 2012; para. (a) introductory text and paras. (a)(1) and (b) revised, 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.35 Service of complaint.

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

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

(2) By mailing a copy of the complaint by Priority Mail Express®, first-class mail, or any delivery service that provides ability to confirm delivery or attempted delivery to:

(i) A respondent who is a registered practitioner at the address provided to OED pursuant to § 11.11, or

(ii) A respondent who is not registered at the last address for the respondent known to the OED Director.

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

(4) In the case of a respondent who resides outside the United States, by sending a copy of the complaint by any delivery service that provides ability to confirm delivery or attempted delivery, to:

(i) A respondent who is a registered practitioner at the address provided to OED pursuant to § 11.11; or

(ii) A respondent who is not registered at the last address for the respondent known to the OED Director.

(b) If a copy of the complaint cannot be delivered to the respondent through any one of the procedures in paragraph (a) of this section, the OED Director shall serve the respondent by causing an appropriate notice to be published in the Official Gazette for two consecutive weeks, in which case, the time for filing an answer shall be thirty days from the second publication of the notice. Failure to timely file an answer will constitute an admission of the allegations in the complaint in accordance with paragraph (d) of § 11.36, and the hearing officer may enter an initial decision on default.

(c) If the respondent is known to the OED Director to be represented by an attorney under § 11.40(a), a copy of the complaint shall be served on the attorney in lieu of service on the respondent in the manner provided for in paragraph (a) or (b) of this section.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008; paras. (a)(2)(ii) and (a)(4)(ii) revised, 78 FR 20180, Apr. 3, 2013, effective May 3, 2013; para. (a)(2) revised, 79 FR 63036, Oct. 22, 2014, effective Oct. 22, 2014]

§ 11.36 Answer to complaint.

(a) *Time for answer.* An answer to a complaint shall be filed within the time set in the complaint but in no event shall that time be less than thirty days from the date the complaint is filed.

(b) *With whom filed.* The answer shall be filed in writing with the hearing officer at the address specified in the complaint. The hearing officer may extend the time for filing an answer once for a period of no more than thirty days 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 served on respondent. A copy of the answer, and any exhibits or attachments thereto, shall be served on the OED Director.

(c) *Content.* The respondent shall include in the answer a statement of the facts that 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 that 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 in the answer special matters of defense and any intent to raise a disability as a mitigating factor. If respondent intends to raise a special matter of defense or disability, the answer shall specify the defense or disability, its nexus to the misconduct, and the reason it provides a defense or mitigation. A respondent who fails to do so cannot rely on a special matter of defense or disability. The hearing officer may, for good cause, allow the respondent to file the statement late, grant additional hearing preparation time, or make other appropriate orders.

(d) *Failure to deny allegations in complaint.* Every allegation in the complaint that is not denied by a respondent in the answer shall be deemed to be admitted and may be considered proven. The hearing officer at any hearing need receive no further evidence with respect to that allegation.

(e) *Default judgment.* Failure to timely file an answer will constitute an admission of the allegations in the complaint and may result in entry of default judgment.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008]

§ 11.37 [Reserved]

§ 11.38 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 hearing officer.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008]

§ 11.39 Hearing officer; appointment; responsibilities; review of interlocutory orders; stays.

(a) *Appointment.* A hearing officer, appointed by the USPTO Director under 5 U.S.C. 3105 or 35 U.S.C. 32, shall conduct disciplinary proceedings as provided by this Part.

(b) *Independence of the Hearing Officer.*

(1) A hearing officer appointed in accordance with paragraph (a) of this section shall not be subject to first level or second level supervision by either the USPTO Director or OED Director, or his or her designee.

(2) A hearing officer appointed in accordance with paragraph (a) of this section shall not be subject to supervision of the person(s) investigating or prosecuting the case.

(3) A hearing officer appointed in accordance with paragraph (a) of this section shall be impartial, shall not be an individual who has participated in any manner in the decision to initiate the proceedings, and shall not have been employed under the immediate supervision of the practitioner.

(4) A hearing officer appointed in accordance with paragraph (a) of this section shall be admitted to practice law and have suitable experience and training conducting hearings, reaching a determination, and rendering an initial decision in an equitable manner.

(c) *Responsibilities.* The hearing officer shall have authority, consistent with specific provisions of these regulations, 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 hearing officer;

(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 for the orderly disposition of proceedings;

(9) Make initial decisions under §§ 11.25 and 11.54; and

(10) Perform acts and take measures as necessary to promote the efficient, timely, and impartial conduct of any disciplinary proceeding.

(d) *Time for making initial decision.* The hearing officer shall set times and exercise control over a disciplinary proceeding such that an initial decision under § 11.54 is normally issued within nine months of the date a complaint is filed. The hearing officer may, however, issue an initial decision more than nine months after a complaint is filed if there exist circumstances, in his or her opinion, that preclude issuance of an initial decision within nine months of the filing of the complaint.

(e) *Review of interlocutory orders*. The USPTO Director will not review an interlocutory order of a hearing officer except:

(1) When the hearing officer 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 USPTO Director may materially advance the ultimate termination of the disciplinary proceeding, or

(2) In an extraordinary situation where the USPTO Director deems that justice requires review.

(f) *Stays pending review of interlocutory order.* If the OED Director or a respondent seeks review of an interlocutory order of a hearing officer under paragraph (b)(2) of this section, any time period set by the hearing officer for taking action shall not be stayed unless ordered by the USPTO Director or the hearing officer.

(g) The hearing officer shall engage in no *ex parte* discussions with any party on the merits of the complaint, beginning with appointment and ending when the final agency decision is issued.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008]

§ 11.40 Representative for OED Director or respondent.

(a) A respondent may represent himself or herself, or be represented by an attorney before the Office in connection with an investigation or disciplinary proceeding. The attorney shall file a written declaration that he or she is an attorney within the meaning of § 11.1 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 Deputy General Counsel for Intellectual Property and Solicitor, and attorneys in the Office of the Solicitor shall represent the OED Director. The attorneys representing the OED Director in disciplinary proceedings shall not consult with the USPTO Director, the General Counsel, the Deputy General Counsel for General Law, or an individual designated by the USPTO Director to decide disciplinary matters regarding the proceeding. The General Counsel and the Deputy General Counsel for General Law shall remain screened from the investigation and prosecution of all disciplinary proceedings in order that they shall be available as counsel to the USPTO Director in deciding disciplinary proceedings unless access is appropriate to perform their duties. After a final decision is entered in a disciplinary proceeding, the OED Director and attorneys representing the OED Director shall be available to counsel the USPTO Director, the General Counsel, and the Deputy General Counsel for General Law in any further proceedings.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008]

§ 11.41 Filing of papers.

(a) The provisions of §§ 1.8 and 2.197 of this subchapter do not apply to disciplinary proceedings. All papers filed after the complaint and prior to entry of an initial decision by the hearing officer shall be filed with the hearing officer at an address or place designated by the hearing officer.

(b) All papers filed after entry of an initial decision by the hearing officer shall be filed with

the USPTO Director. A copy of the paper shall be served on the OED Director. The hearing officer or the OED Director may provide for filing papers and other matters by hand, by Priority Mail Express®, or by other means.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008; para. (b) revised, 79 FR 63036, Oct. 22, 2014, effective Oct. 22, 2014]

§ 11.42 Service of papers.

(a) All papers other than a complaint shall be served on a respondent who is 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, Priority Mail Express®, or other delivery service to the attorney at the address provided by the attorney under § 11.40(a)(1); or

(3) Any other method mutually agreeable to the attorney and a representative for the OED 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, Priority Mail Express®, or other delivery service 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 OED Director.

(c) A respondent shall serve on the representative for the OED Director one copy of each paper filed with the hearing officer or the OED Director. A paper may be served on the representative for the OED Director by:

(1) Delivering a copy of the paper to the representative; or

(2) Mailing a copy of the paper by first-class mail, Priority Mail Express®, or other delivery service 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 on which service was made; and

(2) The method by which service was made.

(e) The hearing officer or the USPTO Director may require that a paper be served by hand or by Priority Mail Express®.

(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, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008; revised, 79 FR 63036, Oct. 22, 2014, effective Oct. 22, 2014]

§ 11.43 Motions.

Motions, including all prehearing motions commonly filed under the Federal Rules of Civil Procedure, shall be filed with the hearing officer. The hearing officer will determine whether replies to responses will be authorized and the time period for filing such a response. No motion shall be filed with the hearing officer 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, prior to a decision on the motion, the parties resolve issues raised by a motion presented to the hearing officer, the parties shall promptly notify the hearing officer.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008]

§ 11.44 Hearings.

(a) The hearing officer shall preside over hearings in disciplinary proceedings. The hearing officer shall set the time and place for the hearing.

In cases involving an incarcerated respondent, any necessary oral hearing may be held at the location of incarceration. Oral hearings will be stenographically recorded and transcribed, and the testimony of witnesses will be received under oath or affirmation. The hearing officer shall conduct the hearing as if the proceeding were subject to 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 OED 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 hearing officer, the hearing officer 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 hearing officer 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,* a protective order is entered to exclude from public disclosure information which is privileged or confidential under applicable laws or regulations.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008]

§ 11.45 Amendment of pleadings.

The OED Director may, without Committee on Discipline authorization, but with the authorization of the hearing officer, amend the complaint to include additional charges based upon conduct committed before or after the complaint was filed. If amendment of the complaint is authorized, the hearing officer shall authorize amendment of the answer. Any party who would otherwise be prejudiced by the amendment will be given reasonable opportunity to meet the allegations in the complaint or answer as amended, and the hearing officer shall make findings on any issue presented by the complaint or answer as amended.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008]

§ 11.46 - 11.48 [Reserved]

§ 11.49 Burden of proof.

In a disciplinary proceeding, the OED Director shall have the burden of proving the violation by clear and convincing evidence and a respondent shall have the burden of proving any affirmative defense by clear and convincing evidence.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008]

§ 11.50 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 hearing officer shall exclude evidence that is irrelevant, immaterial, or unduly repetitious.

(b) *Depositions.* Depositions of witnesses taken pursuant to § 11.51 may be admitted as evidence.

(c) *Government documents.* Official documents, records, and papers of the Office, including, but not limited to, all papers in the file of a disciplinary investigation, 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 hearing officer may authorize the withdrawal of the exhibit subject to any conditions the hearing officer 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, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008]

§ 11.51 Depositions.

(a) Depositions for use at the hearing in lieu of personal appearance of a witness before the hearing officer may be taken by respondent or the OED Director upon a showing of good cause and with

the approval of, and under such conditions as may be deemed appropriate by, the hearing officer. 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 parties may waive the requirement of ten days' notice 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 Priority Mail Express® 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 hearing officer 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. Depositions may not be taken to obtain discovery, except as provided for in paragraph (b) of this section.

(b) When the OED 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 OED Director and the respondent. The deposition shall not be filed with the hearing officer and may not be admitted in evidence before the hearing officer unless he or she orders the deposition admitted in evidence. The admissibility of the deposition shall lie within the discretion of the hearing officer 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 hearing officer.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008; para. (a) revised, 79 FR 63036, Oct. 22, 2014, effective Oct. 22, 2014]

§ 11.52 Discovery.

Discovery shall not be authorized except as follows:

(a) After an answer is filed under § 11.36 and when a party establishes that discovery is reasonable and relevant, the hearing officer, 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;

(2) Is not available to the party under 35 U.S.C. 122;

(3) Relates to any other disciplinary proceeding;

(4) Relates to experts except as the hearing officer 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 hearing officer 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) Consists of information that 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 hearing officer shall require the party seeking discovery to file a motion (§ 11.43) and explain in detail, for each request made, how the discovery sought is

reasonable and relevant to an issue actually raised in the complaint or the answer.

(e) The hearing officer may require parties to file and serve, prior to any hearing, a pre-hearing statement that 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) Copies of memoranda reflecting respondent's own statements to administrative representatives.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008]

§ 11.53 Proposed findings and conclusions; post-hearing memorandum.

Except in cases in which the respondent has failed to answer the complaint or amended complaint, the hearing officer, 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, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008]

§ 11.54 Initial decision of hearing officer.

(a) The hearing officer shall make an initial decision in the case. The decision will include:

(1) A statement of findings of fact and conclusions of law, as well as the reasons or bases for those findings and conclusions 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 default judgment, of suspension or exclusion from practice, of reprimand, of probation or an order dismissing the complaint. The order also may impose any conditions deemed appropriate under the circumstances. The hearing officer shall transmit a copy of the decision to the OED Director and to the respondent. After issuing the decision, the hearing officer shall transmit the entire record to the OED Director. In the absence of an appeal to the USPTO Director, the decision of the hearing officer, including a default judgment, will, without further proceedings, become the decision of the USPTO Director thirty days from the date of the decision of the hearing officer.

(b) The initial decision of the hearing officer shall explain the reason for any default judgment, reprimand, suspension, exclusion, or probation, and shall explain any conditions imposed with discipline. In determining any sanction, the following four factors must be considered if they are applicable:

(1) Whether the practitioner has violated a duty owed to a client, to the public, to the legal system, or to the profession;

(2) Whether the practitioner acted intentionally, knowingly, or negligently;

(3) The amount of the actual or potential injury caused by the practitioner's misconduct; and

(4) The existence of any aggravating or mitigating factors.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008; para. (a)(2) and para. (b) introductory text revised, 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.55 Appeal to the USPTO Director.

(a) Within thirty days after the date of the initial decision of the hearing officer under §§ 11.25 or 11.54, either party may appeal to the USPTO Director. The appeal shall include the appellant's brief. If more than one appeal is filed, the party who files the appeal first is the appellant for purpose of this rule. If appeals are filed on the same day, the respondent is the appellant. If an appeal is filed, then the OED Director shall transmit the entire record to the USPTO Director. Any cross-appeal shall be filed within fourteen days after the date of service of the appeal pursuant to § 11.42, or thirty days after the date of the initial decision of the hearing officer,

whichever is later. The cross-appeal shall include the cross-appellant's brief. Any appellee or cross-appellee brief must be filed within thirty days after the date of service pursuant to § 11.42 of an appeal or cross-appeal. Any reply brief must be filed within fourteen days after the date of service of any appellee or cross-appellee brief.

(b) An appeal or cross-appeal must include exceptions to the decisions of the hearing officer and supporting reasons for those exceptions. Any exception not raised will be deemed to have been waived and will be disregarded by the USPTO Director in reviewing the initial decision.

(c) All briefs shall:

(1) Be filed with the USPTO Director at the address set forth in § 1.1(a)(3)(ii) of this subchapter and served on the opposing party;

(2) Include separate sections containing a concise statement of the disputed facts and disputed points of law; and

(3) Be typed on 8 1/2 by 11-inch paper, and comply with Rule 32(a)(4)-(6) of the Federal Rules of Appellate Procedure.

(d) An appellant's, cross-appellant's, appellee's, and cross-appellee's brief shall be no more than thirty pages in length, and comply with Rule 28(a)(2), (3), and (5) through (10) of the Federal Rules of Appellate Procedure. Any reply brief shall be no more than fifteen pages in length, and shall comply with Rule 28 (a)(2), (3), (8), and (9) of the Federal Rules of Appellate Procedure.

(e) The USPTO Director may refuse entry of a nonconforming brief.

(f) The USPTO Director will decide the appeal on the record made before the hearing officer.

(g) Unless the USPTO Director permits, no further briefs or motions shall be filed.

(h) The USPTO Director may order reopening of a disciplinary proceeding in accordance with the principles that govern the granting of new trials. Any request to reopen a disciplinary proceeding on the basis of newly discovered evidence must demonstrate that the newly discovered evidence could not have been discovered by due diligence.

(i) In the absence of an appeal by the OED Director, failure by the respondent to appeal under the provisions of this section shall result in the initial decision being final and effective thirty days from the date of the initial decision of the hearing officer.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008]

§ 11.56 Decision of the USPTO Director.

(a) The USPTO Director shall decide an appeal from an initial decision of the hearing officer. On appeal from the initial decision, the USPTO Director has authority to conduct a de novo review of the factual record. The USPTO Director may affirm, reverse, or modify the initial decision or remand the matter to the hearing officer for such further proceedings as the USPTO Director may deem appropriate. In making a final decision, the USPTO Director shall review the record or the portions of the record designated by the parties. The USPTO Director shall transmit a copy of the final decision to the OED Director and to the respondent.

(b) A final decision of the USPTO Director may dismiss a disciplinary proceeding, reverse or modify the initial decision, reprimand a practitioner, or may suspend or exclude the practitioner from practice before the Office. A final decision suspending or excluding a practitioner shall require compliance with the provisions of § 11.58. The final decision may also condition the reinstatement of the practitioner upon a showing that the practitioner has taken steps to correct or mitigate the matter forming the basis of the action, or to prevent recurrence of the same or similar conduct.

(c) The respondent or the OED Director may make a single request for reconsideration or modification of the decision by the USPTO Director if filed within twenty days from the date of entry of the decision. No request for reconsideration or modification shall be granted unless the request is based on newly discovered evidence or error of law or fact, and the requestor must demonstrate that any newly discovered evidence could not have been discovered any earlier by due diligence. Such a request shall have the effect of staying the effective date of the order of discipline in the final decision. The decision by the USPTO Director is effective on its date of entry.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008]

§ 11.57 Review of final decision of the USPTO Director.

(a) Review of the final decision by the USPTO Director in a disciplinary case may be had, subject to § 11.55(d), by a petition filed in accordance with 35 U.S.C. 32. The Respondent must serve the USPTO Director with the petition. Respondent must serve the petition in accordance with Rule 4 of the Federal Rules of Civil Procedure and § 104.2 of this Title.

(b) Except as provided for in § 11.56(c), an order for discipline in a final decision will not be stayed except on proof of exceptional circumstances.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008]

§ 11.58 Duties of disciplined or resigned practitioner, or practitioner on disability inactive status.

(a) An excluded, suspended or resigned practitioner, or practitioner transferred to disability inactive status shall not engage in any practice of patent, trademark and other non-patent law before the Office. An excluded, suspended or resigned practitioner will not be automatically reinstated at the end of his or her period of exclusion or suspension. An excluded, suspended or resigned practitioner, or practitioner transferred to disability inactive status must comply with the provisions of this section and § 11.60 to be reinstated. Failure to comply with the provisions of this section may constitute both grounds for denying reinstatement or readmission; and cause for further action, including seeking further exclusion, suspension, and for revocation of any pending probation.

(b) Unless otherwise ordered by the USPTO Director, any excluded, suspended or resigned practitioner, or practitioner transferred to disability inactive status shall:

(1) Within thirty days after the date of entry of the order of exclusion, suspension, acceptance of resignation, or transfer to disability inactive status:

(i) File a notice of withdrawal as of the effective date of the exclusion, suspension, acceptance of resignation, or transfer to disability inactive status in each pending patent and trademark application, each pending reexamination and interference or trial proceeding, and every other matter pending in the Office, together with a copy of the notices sent pursuant to paragraphs (b) and (c) of this section;

(ii) Provide notice to all State and Federal jurisdictions and administrative agencies to which the practitioner is admitted to practice and all clients the practitioner represents having immediate or prospective business before the Office in patent, trademark and other non-patent matters of the order of exclusion, suspension, acceptance of resignation, or transferred to disability inactive status and of the practitioner's consequent inability to act as a practitioner after the effective date of the order; and that, if not represented by another practitioner, the client should act promptly to substitute another practitioner, or to seek legal advice elsewhere, calling attention to any urgency arising from the circumstances of the case;

(iii) Provide notice to the practitioner(s) for all opposing parties (or, to the parties in the absence of a practitioner representing the parties) in matters pending before the Office of the practitioner's exclusion, suspension, resignation, or transfer to disability inactive status and, that as a consequence, the practitioner is disqualified from acting as a practitioner regarding matters before the Office after the effective date of the suspension, exclusion, resignation or transfer to disability inactive status, and state in the notice the mailing address of each client of the excluded, suspended or resigned practitioner, or practitioner transferred to disability inactive status who is a party in the pending matter;

(iv) Deliver to all clients having immediate or prospective business before the Office in patent, trademark or other non-patent matters any papers or other property to which the clients are entitled, or shall notify the clients and any co-practitioner of a suitable time and place where the papers and other property may be obtained, calling attention to any urgency for obtaining the papers or other property;

(v) Relinquish to the client, or other practitioner designated by the client, all funds for practice before the Office, including any legal fees paid in advance that have not been earned and any advanced costs not expended;

(vi) Take any necessary and appropriate steps to remove from any telephone, legal, or other directory any advertisement, statement, or representation which would reasonably suggest that the practitioner is authorized to practice patent, trademark, or other non-patent law before the Office; and

(vii) Serve all notices required by paragraphs (b)(1)(ii) and (b)(1)(iii) of this section by certified mail, return receipt requested, unless mailed abroad. If mailed abroad, all notices shall be served with a receipt to be signed and returned to the practitioner.

(2) Within forty-five days after entry of the order of suspension, exclusion, or of acceptance of resignation, the practitioner shall file with the OED Director an affidavit of compliance certifying that the practitioner has fully complied with the provisions of the order, this section, and with § 11.116 for withdrawal from representation. Appended to the affidavit of compliance shall be:

(i) A copy of each form of notice, the names and addresses of the clients, practitioners, courts, and agencies to which notices were sent, and all return receipts or returned mail received up to the date of the affidavit. Supplemental affidavits shall be filed covering subsequent return receipts and returned mail. Such names and addresses of clients shall remain confidential unless otherwise ordered by the USPTO Director;

(ii) A schedule showing the location, title and account number of every bank account designated as a client or trust account, deposit account in the Office, or other fiduciary account, and of every account in which the practitioner holds or held as of the entry date of the order any client, trust, or fiduciary funds for practice before the Office;

(iii) A schedule describing the practitioner's disposition of all client and fiduciary funds for practice before the Office in the practitioner's possession, custody or control as of the date of the order or thereafter;

(iv) Such proof of the proper distribution of said funds and the closing of such accounts as has been requested by the OED Director, including copies of checks and other instruments;

(v) A list of all other State, Federal, and administrative jurisdictions to which the practitioner is admitted to practice; and

(vi) An affidavit describing the precise nature of the steps taken to remove from any telephone, legal, or other directory any advertisement, statement, or representation which would reasonably suggest that the practitioner is authorized to practice patent, trademark, or other non-patent law before the Office. The affidavit shall also state the residence or other address of the practitioner to which communications may thereafter be directed, and list all State and Federal jurisdictions, and administrative agencies to which the practitioner is admitted to practice. The OED Director may require such additional proof as is deemed necessary. In addition, for the period of discipline, an excluded or suspended practitioner, or a practitioner transferred to disability inactive status shall continue to file a statement in accordance with § 11.11, regarding any change of residence or other address to which communications may thereafter be directed, so that the excluded or suspended practitioner, or practitioner transferred to disability inactive status may be located if a grievance is received regarding any conduct occurring before or after the exclusion or suspension. The practitioner shall retain copies of all notices sent and shall maintain complete records of the steps taken to comply with the notice requirements.

(3) Not hold himself or herself out as authorized to practice law before the Office.

(4) Not advertise the practitioner's availability or ability to perform or render legal services for any person having immediate or prospective business before the Office as to that business.

(5) Not render legal advice or services to any person having immediate or prospective business before the Office as to that business.

(6) Promptly take steps to change any sign identifying the practitioner's or the practitioner's firm's office and the practitioner's or the practitioner's firm's stationery to delete therefrom any advertisement, statement, or representation which would reasonably suggest that the practitioner is authorized to practice law before the Office.

(c) An excluded, suspended or resigned practitioner, or practitioner transferred to disability inactive status after entry of the order of exclusion or suspension, acceptance of resignation, or transfer to disability inactive status shall not accept any new retainer regarding immediate or prospective business before the Office, or engage as a practitioner for another in any new case or legal matter regarding practice before the Office. The excluded, suspended or resigned practitioner, or practitioner transferred to disability inactive status shall be granted limited recognition for a period of thirty days. During the thirty-day period of limited recognition, the excluded, suspended or resigned practitioner, or practitioner transferred to disability inactive status shall conclude work on behalf of a client on any matters that were pending before the Office on the date of entry of the order of exclusion or suspension, or acceptance of resignation. If such work cannot be concluded, the excluded, suspended or resigned practitioner, or practitioner transferred to disability inactive status shall so advise the client so that the client may make other arrangements.

(d) *Required records.* An excluded, suspended or resigned practitioner, or practitioner transferred to disability inactive status shall keep and maintain records of the various steps taken under this section, so that in any subsequent proceeding proof of compliance with this section and with the exclusion or suspension order will be available. The OED Director will require the practitioner to submit such proof as a condition precedent to the granting of any petition for reinstatement.

(e) An excluded, suspended or resigned practitioner, or practitioner on disability inactive status who aids another practitioner in any way in the other practitioner's practice of law before the Office, may, under the direct supervision of the other practitioner, act as a paralegal for the other practitioner or perform other services for the other practitioner which are normally performed by laypersons, provided:

(1) The excluded, suspended or resigned practitioner, or practitioner transferred to disability inactive status is a salaried employee of:

(i) The other practitioner;

(ii) The other practitioner's law firm; or

(iii) A client-employer who employs the other practitioner as a salaried employee;

(2) The other practitioner assumes full professional responsibility to any client and the Office for any work performed by the excluded, suspended or resigned practitioner for the other practitioner;

(3) The excluded, suspended or resigned practitioner, or practitioner transferred to disability inactive status does not:

(i) Communicate directly in writing, orally, or otherwise with a client of the other practitioner in regard to any immediate or prospective business before the Office;

(ii) Render any legal advice or any legal services to a client of the other practitioner in regard to any immediate or prospective business before the Office; or

(iii) Meet in person or in the presence of the other practitioner in regard to any immediate or prospective business before the Office, with:

(A) Any Office employee in connection with the prosecution of any patent, trademark, or other case;

(B) Any client of the other practitioner, the other practitioner's law firm, or the client-employer of the other practitioner; or

(C) Any witness or potential witness whom the other practitioner, the other practitioner's law firm, or the other practitioner's client-employer may or intends to call as a witness in any proceeding before the Office. The term "witness" includes individuals who will testify orally in a proceeding before, or sign an affidavit or any other document to be filed in, the Office.

(f) When an excluded, suspended or resigned practitioner, or practitioner transferred to disability inactive status acts as a paralegal or performs services under paragraph (e) of this section, the practitioner shall not thereafter be reinstated to practice before the Office unless:

(1) The practitioner shall have filed with the OED Director an affidavit which:

(i) Explains in detail the precise nature of all paralegal or other services performed by the excluded, suspended or resigned practitioner, or practitioner transferred to disability inactive status, and

(ii) Shows by clear and convincing evidence that the excluded, suspended or resigned practitioner, or practitioner transferred to disability inactive status has complied with the provisions of this section and all USPTO Rules of Professional Conduct; and

(2) The other practitioner shall have filed with the OED Director a written statement which:

(i) Shows that the other practitioner has read the affidavit required by paragraph (d)(1) of this section and that the other practitioner believes every statement in the affidavit to be true, and

(ii) States why the other practitioner believes that the excluded, suspended or resigned practitioner, or practitioner transferred to disability inactive status has complied with paragraph (c) of this section.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008; para. (b)(1)(i) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012; para. (b)(2) introductory text and para. (f)(1)(ii) revised, 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.59 Dissemination of disciplinary and other information.

(a) The OED Director shall inform the public of the disposition of each matter in which public discipline has been imposed, and of any other changes in a practitioner's registration status. Public discipline includes exclusion, as well as exclusion on consent; suspension; and public reprimand. Unless otherwise ordered by the USPTO Director, the OED Director shall give notice of public discipline and the reasons for the discipline to disciplinary enforcement agencies in the State where the practitioner is admitted to practice, to courts where the practitioner is known to be admitted, and the public. If public discipline is imposed, the OED Director shall cause a final decision of the USPTO Director to be published. Final decisions of the USPTO Director include default judgments. See § 11.54(a)(2). If a private reprimand is imposed, the OED Director shall cause a redacted version of the final decision to be published.

(b) *Records available to the public.* Unless the USPTO Director orders that the proceeding or a portion of the record be kept confidential, the OED Director's records of every disciplinary proceeding where a practitioner is reprimanded, suspended, or excluded, including when said sanction is imposed by default judgment, shall be made available to the public upon written request, except that information may be withheld as necessary to protect the privacy of third parties or as directed in a protective order issued pursuant to § 11.44(c). The record of a proceeding that results in a practitioner's transfer to disability inactive status shall not be available to the public.

(c) *Access to records of exclusion by consent.* Unless the USPTO Director orders that the proceeding or a portion of the record be kept confidential, an order excluding a practitioner on consent under § 11.27 and the affidavit required under paragraph (a) of § 11.27 shall be available to the public, except that information in the order or affidavit may be withheld as necessary to protect the privacy of third parties or as directed in a protective order under § 11.44(c). The affidavit required under paragraph (a) of § 11.27 shall not be used in any other proceeding except by order of the USPTO Director or upon written consent of the practitioner.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008]

§ 11.60 Petition for reinstatement.

(a) *Restrictions on reinstatement.* An excluded, suspended or resigned practitioner shall not resume practice of patent, trademark, or other non-patent law before the Office until reinstated by order of the OED Director or the USPTO Director.

(b) *Petition for reinstatement.* An excluded or suspended practitioner shall be eligible to apply for reinstatement only upon expiration of the period of suspension or exclusion and the practitioner's full compliance with § 11.58. An excluded practitioner shall be eligible to apply for reinstatement no earlier than at least five years from the effective date of the exclusion. A resigned practitioner shall be eligible to petition for reinstatement and must show compliance with § 11.58 no earlier than at least five years from the date the practitioner's resignation is accepted and an order is entered excluding the practitioner on consent.

(c) *Review of reinstatement petition.* An excluded, suspended or resigned practitioner shall file a petition for reinstatement accompanied by the

fee required by § 1.21(a)(10) of this subchapter. The petition for reinstatement shall be filed with the OED Director. An excluded or suspended practitioner who has violated any provision of § 11.58 shall not be eligible for reinstatement until a continuous period of the time in compliance with § 11.58 that is equal to the period of suspension or exclusion has elapsed. A resigned practitioner shall not be eligible for reinstatement until compliance with § 11.58 is shown. If the excluded, suspended or resigned practitioner is not eligible for reinstatement, or if the OED Director determines that the petition is insufficient or defective on its face, the OED Director may dismiss the petition. Otherwise the OED Director shall consider the petition for reinstatement. The excluded, suspended or resigned practitioner seeking reinstatement shall have the burden of proof by clear and convincing evidence. Such proof shall be included in or accompany the petition, and shall establish:

(1) That the excluded, suspended or resigned practitioner has the good moral character and reputation, competency, and learning in law required under § 11.7 for admission;

(2) That the resumption of practice before the Office will not be detrimental to the administration of justice or subversive to the public interest; and

(3) That the suspended practitioner has complied with the provisions of § 11.58 for the full period of suspension, that the excluded practitioner has complied with the provisions of § 11.58 for at least five continuous years, or that the resigned practitioner has complied with § 11.58 upon acceptance of the resignation.

(d) *Petitions for reinstatement — Action by the OED Director granting reinstatement.* (1) If the excluded, suspended or resigned practitioner is found to have complied with paragraphs(c)(1) through (c)(3) of this section, the OED Director shall enter an order of reinstatement, which shall be conditioned on payment of the costs of the disciplinary proceeding to the extent set forth in paragraphs (d)(2) and (3) of this section.

(2) *Payment of costs of disciplinary proceedings.* Prior to reinstatement to practice, the excluded or suspended practitioner shall pay the costs of the disciplinary proceeding. The costs imposed pursuant to this section include all of the following:

(i) The actual expense incurred by the OED Director or the Office for the original and copies of any reporter's transcripts of the disciplinary proceeding, and any fee paid for the services of the reporter;

(ii) All expenses paid by the OED Director or the Office which would qualify as taxable costs recoverable in civil proceedings; and

(iii) The charges determined by the OED Director to be "reasonable costs" of investigation, hearing, and review. These amounts shall serve to defray the costs, other than fees for services of attorneys and experts, of the Office of Enrollment and Discipline in the preparation or hearing of the disciplinary proceeding, and costs incurred in the administrative processing of the disciplinary proceeding.

(3) An excluded or suspended practitioner may be granted relief, in whole or in part, only from an order assessing costs under this section or may be granted an extension of time to pay these costs, in the discretion of the OED Director, upon grounds of hardship, special circumstances, or other good cause.

(e) *Petitions for reinstatement — Action by the OED Director denying reinstatement.* If the excluded, suspended or resigned practitioner is found unfit to resume the practice of patent law before the Office, the OED Director shall first provide the excluded, suspended or resigned practitioner with an opportunity to show cause in writing why the petition should not be denied. Failure to comply with § 11.12(c) shall constitute unfitness. If unpersuaded by the showing, the OED Director shall deny the petition. The OED Director may require the excluded, suspended or resigned practitioner, in meeting the requirements of § 11.7, to take and pass an examination under § 11.7(b), ethics courses, and/or the Multistate Professional Responsibility Examination. The OED Director shall provide findings, together with the record. The findings shall include on the first page, immediately beneath the caption of the case, a separate section entitled "Prior Proceedings" which shall state the docket number of the original disciplinary proceeding in which the exclusion or suspension was ordered.

(f) *Resubmission of petitions for reinstatement.* If a petition for reinstatement is denied, no further petition for reinstatement may be filed until the expiration of at least one year following the denial unless the order of denial provides otherwise.

(g) *Reinstatement proceedings open to public.* Proceedings on any petition for reinstatement shall be open to the public. Before reinstating any excluded or suspended practitioner, the OED Director shall publish a notice of the excluded or suspended practitioner's petition for reinstatement and shall permit the public a reasonable opportunity to comment or submit evidence with respect to the petition for reinstatement.

[Added, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008]

§ 11.61 [Reserved]

[Removed and reserved, 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.62 -11.99 [Reserved]

Subpart D — USPTO Rules of Professional Conduct

§ 11.100 [Reserved]

CLIENT-PRACTITIONER RELATIONSHIP

§ 11.101 Competence.

A practitioner shall provide competent representation to a client. Competent representation requires the legal, scientific, and technical knowledge, skill, thoroughness and preparation reasonably necessary for the representation.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.102 Scope of representation and allocation of authority between client and practitioner.

(a) Subject to paragraphs (c) and (d) of this section, a practitioner shall abide by a client's decisions concerning the objectives of representation and, as required by § 11.104, shall consult with the client as to the means by which they are to be pursued. A practitioner may take such action on behalf of the client as is impliedly authorized to carry out the representation. A practitioner shall abide by a client's decision whether to settle a matter.

(b) [Reserved]

(c) A practitioner may limit the scope of the representation if the limitation is reasonable under the circumstances and the client gives informed consent.

(d) A practitioner shall not counsel a client to engage, or assist a client, in conduct that the practitioner knows is criminal or fraudulent, but a practitioner may discuss the legal consequences of any proposed course of conduct with a client and may counsel or assist a client to make a good-faith effort to determine the validity, scope, meaning or application of the law.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.103 Diligence.

A practitioner shall act with reasonable diligence and promptness in representing a client.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.104 Communication.

(a) A practitioner shall:

(1) Promptly inform the client of any decision or circumstance with respect to which the client's informed consent is required by the USPTO Rules of Professional Conduct;

(2) Reasonably consult with the client about the means by which the client's objectives are to be accomplished;

(3) Keep the client reasonably informed about the status of the matter;

(4) Promptly comply with reasonable requests for information from the client; and

(5) Consult with the client about any relevant limitation on the practitioner's conduct when the practitioner knows that the client expects assistance not permitted by the USPTO Rules of Professional Conduct or other law.

(b) A practitioner shall explain a matter to the extent reasonably necessary to permit the client to make informed decisions regarding the representation.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.105 Fees.

(a) A practitioner shall not make an agreement for, charge, or collect an unreasonable fee or an unreasonable amount for expenses. The factors to be considered 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 in the locality 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; and

(8) Whether the fee is fixed or contingent.

(b) The scope of the representation and the basis or rate of the fee and expenses for which the client will be responsible shall be communicated to the client, preferably in writing, before or within a reasonable time after commencing the representation, except when the practitioner will charge a regularly represented client on the same basis or rate. Any changes in the basis or rate of the fee or expenses shall also be communicated to the client.

(c) A fee may be contingent on the outcome of the matter for which the service is rendered, except in a matter in which a contingent fee is prohibited by law. A contingent fee agreement shall be in a writing signed by the client and shall state the method by which the fee is to be determined, including the percentage or percentages that shall accrue to the practitioner in the event of settlement, trial or appeal; litigation and other expenses to be deducted from the recovery; and whether such expenses are to be deducted before or after the contingent fee is calculated. The agreement must clearly notify the client of any expenses for which the client will be liable whether or not the client is the prevailing party. Upon conclusion of a contingent fee matter, the practitioner shall provide the client with a written statement stating the outcome of the matter and, if there is a recovery, showing the remittance to the client and the method of its determination.

(d) [Reserved]

(e) A division of a fee between practitioners who are not in the same firm may be made only if:

(1) The division is in proportion to the services performed by each practitioner or each practitioner assumes joint responsibility for the representation;

(2) The client agrees to the arrangement, including the share each practitioner will receive, and the agreement is confirmed in writing; and

(3) The total fee is reasonable.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.106 Confidentiality of information.

(a) A practitioner shall not reveal information relating to the representation of a client unless the client gives informed consent, the disclosure is impliedly authorized in order to carry out the representation, the disclosure is permitted by paragraph (b) of this section, or the disclosure is required by paragraph (c) of this section.

(b) A practitioner may reveal information relating to the representation of a client to the extent the practitioner reasonably believes necessary:

(1) To prevent reasonably certain death or substantial bodily harm;

(2) To prevent the client from engaging in inequitable conduct before the Office or from committing a crime or fraud that is reasonably certain to result in substantial injury to the financial interests or property of another and in furtherance of which the client has used or is using the practitioner's services;

(3) To prevent, mitigate or rectify substantial injury to the financial interests or property of another that is reasonably certain to result or has resulted from the client's commission of a crime, fraud, or inequitable conduct before the Office in furtherance of which the client has used the practitioner's services;

(4) To secure legal advice about the practitioner's compliance with the USPTO Rules of Professional Conduct;

(5) To establish a claim or defense on behalf of the practitioner in a controversy between the practitioner and the client, to establish a defense to a criminal charge or civil claim against the practitioner based upon conduct in which the client was involved, or to respond to allegations in any proceeding concerning the practitioner's representation of the client; or

(6) To comply with other law or a court order.

(c) A practitioner shall disclose to the Office information necessary to comply with applicable duty of disclosure provisions.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.107 Conflict of interest; Current clients.

(a) Except as provided in paragraph (b) of this section, a practitioner shall not represent a client if the representation involves a concurrent conflict of interest. A concurrent conflict of interest exists if:

(1) The representation of one client will be directly adverse to another client; or

(2) There is a significant risk that the representation of one or more clients will be materially limited by the practitioner's responsibilities to another client, a former client or a third person or by a personal interest of the practitioner.

(b) Notwithstanding the existence of a concurrent conflict of interest under paragraph (a) of this section, a practitioner may represent a client if:

(1) The practitioner reasonably believes that the practitioner will be able to provide competent and diligent representation to each affected client;

(2) The representation is not prohibited by law;

(3) The representation does not involve the assertion of a claim by one client against another client represented by the practitioner in the same litigation or other proceeding before a tribunal; and

(4) Each affected client gives informed consent, confirmed in writing.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.108 Conflict of interest; Current clients; Specific rules.

(a) A practitioner shall not enter into a business transaction with a client or knowingly acquire an ownership, possessory, security or other pecuniary interest adverse to a client unless:

(1) The transaction and terms on which the practitioner acquires the interest are fair and reasonable to the client and are fully disclosed and transmitted in writing in a manner that can be reasonably understood by the client;

(2) The client is advised in writing of the desirability of seeking and is given a reasonable opportunity to seek the advice of independent legal counsel in the transaction; and

(3) The client gives informed consent, in a writing signed by the client, to the essential terms of the transaction and the practitioner's role in the transaction, including whether the practitioner is representing the client in the transaction.

(b) A practitioner shall not use information relating to representation of a client to the

disadvantage of the client unless the client gives informed consent, except as permitted or required by the USPTO Rules of Professional Conduct.

(c) A practitioner shall not solicit any substantial gift from a client, including a testamentary gift, or prepare on behalf of a client an instrument giving the practitioner or a person related to the practitioner any substantial gift unless the practitioner or other recipient of the gift is related to the client. For purposes of this paragraph, related persons include a spouse, child, grandchild, parent, grandparent or other relative or individual with whom the practitioner or the client maintains a close, familial relationship.

(d) Prior to the conclusion of representation of a client, a practitioner shall not make or negotiate an agreement giving the practitioner literary or media rights to a portrayal or account based in substantial part on information relating to the representation.

(e) A practitioner shall not provide financial assistance to a client in connection with pending or contemplated litigation or a proceeding before the Office, except that:

(1) A practitioner may advance court costs and expenses of litigation, the repayment of which may be contingent on the outcome of the matter;

(2) A practitioner representing an indigent client may pay court costs and expenses of litigation or a proceeding before the Office on behalf of the client;

(3) A practitioner may advance costs and expenses in connection with a proceeding before the Office provided the client remains ultimately liable for such costs and expenses; and

(4) A practitioner may also 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.

(f) A practitioner shall not accept compensation for representing a client from one other than the client unless:

(1) The client gives informed consent;

(2) There is no interference with the practitioner's independence of professional judgment or with the client-practitioner relationship; and

(3) Information relating to representation of a client is protected as required by § 11.106.

(g) A practitioner who represents two or more clients shall not participate in making an aggregate settlement of the claims of or against the clients, unless each client gives informed consent, in a writing signed by the client. The practitioner's disclosure shall include the existence and nature of all the claims involved and of the participation of each person in the settlement.

(h) A practitioner shall not:

(1) Make an agreement prospectively limiting the practitioner's liability to a client for malpractice unless the client is independently represented in making the agreement; or

(2) Settle a claim or potential claim for such liability with an unrepresented client or former client unless that person is advised in writing of the desirability of seeking and is given a reasonable opportunity to seek the advice of independent legal counsel in connection therewith.

(i) A practitioner shall not acquire a proprietary interest in the cause of action, subject matter of litigation, or a proceeding before the Office which the practitioner is conducting for a client, except that the practitioner may, subject to the other provisions in this section:

(1) Acquire a lien authorized by law to secure the practitioner's fee or expenses;

(2) Contract with a client for a reasonable contingent fee in a civil case; and

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

(j) [Reserved]

(k) While practitioners are associated in a firm, a prohibition in paragraphs (a) through (i) of this section that applies to any one of them shall apply to all of them.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.109 Duties to former clients.

(a) A practitioner who has formerly represented a client in a matter shall not thereafter represent another person in the same or a substantially related matter in which that person's interests are materially adverse to the interests of the former client unless the former client gives informed consent, confirmed in writing.

(b) A practitioner shall not knowingly represent a person in the same or a substantially related matter in which a firm with which the practitioner formerly was associated had previously represented a client:

(1) Whose interests are materially adverse to that person; and

(2) About whom the practitioner had acquired information protected by §§ 11.106 and 11.109(c) that is material to the matter; unless the former client gives informed consent, confirmed in writing.

(c) A practitioner who has formerly represented a client in a matter or whose present or former firm has formerly represented a client in a matter shall not thereafter:

(1) Use information relating to the representation to the disadvantage of the former client except as the USPTO Rules of Professional Conduct would permit or require with respect to a client, or when the information has become generally known; or

(2) Reveal information relating to the representation except as the USPTO Rules of Professional Conduct would permit or require with respect to a client.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.110 Imputation of conflicts of interest; General rule.

(a) While practitioners are associated in a firm, none of them shall knowingly represent a client when any one of them practicing alone would be prohibited from doing so by §§ 11.107 or 11.109, unless:

(1) The prohibition is based on a personal interest of the disqualified practitioner and does not present a significant risk of materially limiting the representation of the client by the remaining practitioners in the firm; or

(2) The prohibition is based upon § 11.109(a) or (b), and arises out of the disqualified practitioner's association with a prior firm, and

(i) The disqualified practitioner is timely screened from any participation in the matter and is apportioned no part of the fee therefrom; and

(ii) Written notice is promptly given to any affected former client to enable the former client to ascertain compliance with the provisions of this section, which shall include a description of the screening procedures employed; a statement of the firm's and of the screened practitioner's compliance with the USPTO Rules of Professional Conduct; a statement that review may be available before a tribunal; and an agreement by the firm to respond promptly to any written inquiries or objections by the former client about the screening procedures.

(b) When a practitioner has terminated an association with a firm, the firm is not prohibited from thereafter representing a person with interests materially adverse to those of a client represented by the formerly associated practitioner and not currently represented by the firm, unless:

(1) The matter is the same or substantially related to that in which the formerly associated practitioner represented the client; and

(2) Any practitioner remaining in the firm has information protected by §§ 11.106 and 11.109(c) that is material to the matter.

(c) A disqualification prescribed by this section may be waived by the affected client under the conditions stated in § 11.107.

(d) The disqualification of practitioners associated in a firm with former or current Federal Government lawyers is governed by § 11.111.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.111 Former or current Federal Government employees.

A practitioner who is a former or current Federal Government employee shall not engage in any conduct which is contrary to applicable Federal ethics law, including conflict of interest statutes and

regulations of the department, agency or commission formerly or currently employing said practitioner.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.112 Former judge, arbitrator, mediator or other third-party neutral.

(a) Except as stated in paragraph (d) of this section, a practitioner shall not represent anyone in connection with a matter in which the practitioner participated personally and substantially as a judge or other adjudicative officer or law clerk to such a person or as an arbitrator, mediator or other third-party neutral, unless all parties to the proceeding give informed consent, confirmed in writing.

(b) A practitioner shall not negotiate for employment with any person who is involved as a party or as practitioner for a party in a matter in which the practitioner is participating personally and substantially as a judge or other adjudicative officer or as an arbitrator, mediator or other third-party neutral. A practitioner serving as a law clerk to a judge or other adjudicative officer may negotiate for employment with a party or practitioner involved in a matter in which the clerk is participating personally and substantially, but only after the practitioner has notified the judge, or other adjudicative officer.

(c) If a practitioner is disqualified by paragraph (a) of this section, no practitioner in a firm with which that practitioner is associated may knowingly undertake or continue representation in the matter unless:

(1) The disqualified practitioner is timely screened from any participation in the matter and is apportioned no part of the fee therefrom; and

(2) Written notice is promptly given to the parties and any appropriate tribunal to enable them to ascertain compliance with the provisions of this section.

(d) An arbitrator selected as a partisan of a party in a multimember arbitration panel is not prohibited from subsequently representing that party.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.113 Organization as client.

(a) A practitioner employed or retained by an organization represents the organization acting through its duly authorized constituents.

(b) If a practitioner for an organization knows that an officer, employee or other person associated with the organization is engaged in action, intends to act or refuses to act in a matter related to the representation that is a violation of a legal obligation to the organization, or a violation of law that reasonably might be imputed to the organization, and that is likely to result in substantial injury to the organization, then the practitioner shall proceed as is reasonably necessary in the best interest of the organization. Unless the practitioner reasonably believes that it is not necessary in the best interest of the organization to do so, the practitioner shall refer the matter to higher authority in the organization, including, if warranted by the circumstances, to the highest authority that can act on behalf of the organization as determined by applicable law.

(c) Except as provided in paragraph (d) of this section, if

(1) Despite the practitioner's efforts in accordance with paragraph (b) of this section the highest authority that can act on behalf of the organization insists upon or fails to address in a timely and appropriate manner an action, or a refusal to act, that is clearly a violation of law, and

(2) The practitioner reasonably believes that the violation is reasonably certain to result in substantial injury to the organization, then the practitioner may reveal information relating to the representation whether or not § 11.106 permits such disclosure, but only if and to the extent the practitioner reasonably believes necessary to prevent substantial injury to the organization.

(d) Paragraph (c) of this section shall not apply with respect to information relating to a practitioner's representation of an organization to investigate an alleged violation of law, or to defend the organization or an officer, employee or other constituent associated with the organization against a claim arising out of an alleged violation of law.

(e) A practitioner who reasonably believes that he or she has been discharged because of the

practitioner's actions taken pursuant to paragraphs (b) or (c) of this section, or who withdraws under circumstances that require or permit the practitioner to take action under either of those paragraphs, shall proceed as the practitioner reasonably believes necessary to assure that the organization's highest authority is informed of the practitioner's discharge or withdrawal.

(f) In dealing with an organization's directors, officers, employees, members, shareholders, or other constituents, a practitioner shall explain the identity of the client when the practitioner knows or reasonably should know that the organization's interests are adverse to those of the constituents with whom the practitioner is dealing.

(g) A practitioner representing an organization may also represent any of its directors, officers, employees, members, shareholders or other constituents, subject to the provisions of § 11.107. If the organization's consent to the dual representation is required by § 11.107, the consent shall be given by an appropriate official of the organization other than the individual who is to be represented, or by the shareholders.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.114 Client with diminished capacity.

(a) When a client's capacity to make adequately considered decisions in connection with a representation is diminished, whether because of minority, mental impairment or for some other reason, the practitioner shall, as far as reasonably possible, maintain a normal client-practitioner relationship with the client.

(b) When the practitioner reasonably believes that the client has diminished capacity, is at risk of substantial physical, financial or other harm unless action is taken and cannot adequately act in the client's own interest, the practitioner may take reasonably necessary protective action, including consulting with individuals or entities that have the ability to take action to protect the client and, in appropriate cases, seeking the appointment of a guardian ad litem, conservator or guardian.

(c) Information relating to the representation of a client with diminished capacity is protected under § 11.106. When taking protective action pursuant to paragraph (b) of this section, the practitioner is impliedly authorized under § 11.106(a) to reveal information about the client, but only to the extent reasonably necessary to protect the client's interests.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.115 Safekeeping property.

(a) A practitioner shall hold property of clients or third persons that is in a practitioner's possession in connection with a representation separate from the practitioner's own property. Funds shall be kept in a separate account maintained in the state where the practitioner's office is situated, or elsewhere with the consent of the client or third person. Where the practitioner's office is situated in a foreign country, funds shall be kept in a separate account maintained in that foreign country or elsewhere with the consent of the client or third person. Other property shall be identified as such and appropriately safeguarded. Complete records of such account funds and other property shall be kept by the practitioner and shall be preserved for a period of five years after termination of the representation.

(b) A practitioner may deposit the practitioner's own funds in a client trust account for the sole purpose of paying bank service charges on that account, but only in an amount necessary for that purpose.

(c) A practitioner shall deposit into a client trust account legal fees and expenses that have been paid in advance, to be withdrawn by the practitioner only as fees are earned or expenses incurred.

(d) Upon receiving funds or other property in which a client or third person has an interest, a practitioner shall promptly notify the client or third person. Except as stated in this section or otherwise permitted by law or by agreement with the client, a practitioner shall promptly deliver to the client or third person any funds or other property that the client or third person is entitled to receive and, upon request by the client or third person, shall promptly render a full accounting regarding such property.

(e) When in the course of representation a practitioner is in possession of property in which two or more persons (one of whom may be the practitioner) claim interests, the property shall be kept separate by the practitioner until the dispute is

resolved. The practitioner shall promptly distribute all portions of the property as to which the interests are not in dispute.

(f) All separate accounts for clients or third persons kept by a practitioner must also comply with the following provisions:

(1) *Required records.* The records to be kept include:

(i) Receipt and disbursement journals containing a record of deposits to and withdrawals from client trust accounts, specifically identifying the date, source, and description of each item deposited, as well as the date, payee and purpose of each disbursement;

(ii) Ledger records for all client trust accounts showing, for each separate trust client or beneficiary, the source of all funds deposited, the names of all persons for whom the funds are or were held, the amount of such funds, the descriptions and amounts of charges or withdrawals, and the names of all persons or entities to whom such funds were disbursed;

(iii) Copies of retainer and compensation agreements with clients;

(iv) Copies of accountings to clients or third persons showing the disbursement of funds to them or on their behalf;

(v) Copies of bills for legal fees and expenses rendered to clients;

(vi) Copies of records showing disbursements on behalf of clients;

(vii) The physical or electronic equivalents of all checkbook registers, bank statements, records of deposit, prenumbered canceled checks, and substitute checks provided by a financial institution;

(viii) Records of all electronic transfers from client trust accounts, including the name of the person authorizing transfer, the date of transfer, the name of the recipient and confirmation from the financial institution of the trust account number from which money was withdrawn and the date and the time the transfer was completed;

(ix) Copies of monthly trial balances and quarterly reconciliations of the client trust accounts maintained by the practitioner; and

(x) Copies of those portions of client files that are reasonably related to client trust account transactions.

(2) *Client trust account safeguards.* With respect to client trust accounts required by paragraphs (a) through (e) of this section:

(i) Only a practitioner or a person under the direct supervision of the practitioner shall be an authorized signatory or authorize transfers from a client trust account;

(ii) Receipts shall be deposited intact and records of deposit should be sufficiently detailed to identify each item; and

(iii) Withdrawals shall be made only by check payable to a named payee and not to cash, or by authorized electronic transfer.

(3) *Availability of records.* Records required by paragraph (f)(1) of this section may be maintained by electronic, photographic, or other media provided that they otherwise comply with paragraphs (f)(1) and (f)(2) of this section and that printed copies can be produced. These records shall be readily accessible to the practitioner.

(4) *Lawyers.* The records kept by a lawyer are deemed to be in compliance with this section if the types of records that are maintained meet the recordkeeping requirements of a state in which the lawyer is licensed and in good standing, the recordkeeping requirements of the state where the lawyer's principal place of business is located, or the recordkeeping requirements of this section.

(5) *Patent agents and persons granted limited recognition who are employed in the United States by a law firm.* The records kept by a law firm employing one or more registered patent agents or persons granted limited recognition under § 11.9 are deemed to be in compliance with this section if the types of records that are maintained meet the recordkeeping requirements of the state where at least one practitioner of the law firm is licensed and in good standing, the recordkeeping requirements of the state where the law firm's principal place of business is located, or the recordkeeping requirements of this section.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.116 Declining or terminating representation.

(a) Except as stated in paragraph (c) of this section, a practitioner shall not represent a client, or where representation has commenced, shall withdraw from the representation of a client if:

(1) The representation will result in violation of the USPTO Rules of Professional Conduct or other law;

(2) The practitioner's physical or mental condition materially impairs the practitioner's ability to represent the client; or

(3) The practitioner is discharged.

(b) Except as stated in paragraph (c) of this section, a practitioner may withdraw from representing a client if:

(1) Withdrawal can be accomplished without material adverse effect on the interests of the client;

(2) The client persists in a course of action involving the practitioner's services that the practitioner reasonably believes is criminal or fraudulent;

(3) The client has used the practitioner's services to perpetrate a crime or fraud;

(4) A client insists upon taking action that the practitioner considers repugnant or with which the practitioner has a fundamental disagreement;

(5) The client fails substantially to fulfill an obligation to the practitioner regarding the practitioner's services and has been given reasonable warning that the practitioner will withdraw unless the obligation is fulfilled;

(6) The representation will result in an unreasonable financial burden on the practitioner or has been rendered unreasonably difficult by the client; or

(7) Other good cause for withdrawal exists.

(c) A practitioner must comply with applicable law requiring notice to or permission of a tribunal when terminating a representation. When ordered to do so by a tribunal, a practitioner shall continue representation notwithstanding good cause for terminating the representation.

(d) Upon termination of representation, a practitioner shall take steps to the extent reasonably practicable to protect a client's interests, such as giving reasonable notice to the client, allowing time for employment of other counsel, surrendering papers and property to which the client is entitled and refunding any advance payment of fee or expense that has not been earned or incurred. The practitioner may retain papers relating to the client to the extent permitted by other law.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.117 Sale of law practice.

A practitioner or a law firm may sell or purchase a law practice, or an area of law practice, including good will, if the following conditions are satisfied:

(a) The seller ceases to engage in the private practice of law, or in the area of practice that has been sold, in a geographic area in which the practice has been conducted;

(b)(1) Except as provided in paragraph (b)(2) of this section, the entire practice, or the entire area of practice, is sold to one or more lawyers or law firms;

(2) To the extent the practice or the area of practice involves patent proceedings before the Office, that practice or area of practice may be sold only to one or more registered practitioners or law firms that include at least one registered practitioner;

(c)(1) The seller gives written notice to each of the seller's clients regarding:

(i) The proposed sale;

(ii) The client's right to retain other counsel or to take possession of the file; and

(iii) The fact that the client's consent to the transfer of the client's files will be presumed if the client does not take any action or does not otherwise object within ninety (90) days after receipt of the notice.

(2) If a client cannot be given notice, the representation of that client may be transferred to the purchaser only upon entry of an order so authorizing by a court having jurisdiction. The seller may disclose to the court in camera information relating to the representation only to the extent

necessary to obtain an order authorizing the transfer of a file; and

(d) The fees charged clients shall not be increased by reason of the sale.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.118 Duties to prospective client.

(a) A person who discusses with a practitioner the possibility of forming a client-practitioner relationship with respect to a matter is a prospective client.

(b) Even when no client-practitioner relationship ensues, a practitioner who has had discussions with the prospective client shall not use or reveal information learned in the consultation, except as § 11.109 would permit with respect to information of a former client.

(c) A practitioner subject to paragraph (b) of this section shall not represent a client with interests materially adverse to those of a prospective client in the same or a substantially related matter if the practitioner received information from the prospective client that could be significantly harmful to that person in the matter, except as provided in paragraph (d) of this section. If a practitioner is disqualified from representation under this paragraph, no practitioner in a firm with which that practitioner is associated may knowingly undertake or continue representation in such a matter, except as provided in paragraph (d) of this section.

(d) When the practitioner has received disqualifying information as defined in paragraph (c) of this section, representation is permissible if:

(1) Both the affected client and the prospective client have given informed consent, confirmed in writing; or

(2) The practitioner who received the information took reasonable measures to avoid exposure to more disqualifying information than was reasonably necessary to determine whether to represent the prospective client; and

(i) The disqualified practitioner is timely screened from any participation in the matter and is apportioned no part of the fee therefrom; and

(ii) Written notice is promptly given to the prospective client.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.119 - 11.200 [Reserved]

COUNSELOR

§ 11.201 Advisor.

In representing a client, a practitioner shall exercise independent professional judgment and render candid advice. In rendering advice, a practitioner may refer not only to law but to other considerations such as moral, economic, social and political factors that may be relevant to the client's situation.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.202 [Reserved]

§ 11.203 Evaluation for use by third persons.

(a) A practitioner may provide an evaluation of a matter affecting a client for the use of someone other than the client if the practitioner reasonably believes that making the evaluation is compatible with other aspects of the practitioner's relationship with the client.

(b) When the practitioner knows or reasonably should know that the evaluation is likely to affect the client's interests materially and adversely, the practitioner shall not provide the evaluation unless the client gives informed consent.

(c) Except as disclosure is authorized in connection with a report of an evaluation, information relating to the evaluation is otherwise protected by § 11.106.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.204 Practitioner serving as third-party neutral.

(a) A practitioner serves as a third-party neutral when the practitioner assists two or more persons who are not clients of the practitioner to reach a resolution of a dispute or other matter that has arisen between them. Service as a third-party neutral may

include service as an arbitrator, a mediator or in such other capacity as will enable the practitioner to assist the parties to resolve the matter.

(b) A practitioner serving as a third-party neutral shall inform unrepresented parties that the practitioner is not representing them. When the practitioner knows or reasonably should know that a party does not understand the practitioner's role in the matter, the practitioner shall explain the difference between the practitioner's role as a third-party neutral and a practitioner's role as one who represents a client.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.205 - 11.300 [Reserved]

ADVOCATE

§ 11.301 Meritorious claims and contentions.

A practitioner shall not bring or defend a proceeding, or assert or controvert an issue therein, unless there is a basis in law and fact for doing so that is not frivolous, which includes a good-faith argument for an extension, modification or reversal of existing law.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.302 Expediting proceedings.

A practitioner shall make reasonable efforts to expedite proceedings before a tribunal consistent with the interests of the client.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.303 Candor toward the tribunal.

(a) A practitioner shall not knowingly:

(1) Make a false statement of fact or law to a tribunal or fail to correct a false statement of material fact or law previously made to the tribunal by the practitioner;

(2) Fail to disclose to the tribunal legal authority in the controlling jurisdiction known to the practitioner to be directly adverse to the position of the client and not disclosed by opposing counsel in an *inter partes* proceeding, or fail to disclose such authority in an *ex parte* proceeding before the Office if such authority is not otherwise disclosed; or

(3) Offer evidence that the practitioner knows to be false. If a practitioner, the practitioner's client, or a witness called by the practitioner, has offered material evidence and the practitioner comes to know of its falsity, the practitioner shall take reasonable remedial measures, including, if necessary, disclosure to the tribunal. A practitioner may refuse to offer evidence that the practitioner reasonably believes is false.

(b) A practitioner who represents a client in a proceeding before a tribunal and who knows that a person intends to engage, is engaging or has engaged in criminal or fraudulent conduct related to the proceeding shall take reasonable remedial measures, including, if necessary, disclosure to the tribunal.

(c) The duties stated in paragraphs (a) and (b) of this section continue to the conclusion of the proceeding, and apply even if compliance requires disclosure of information otherwise protected by § 11.106.

(d) In an *ex parte* proceeding, a practitioner shall inform the tribunal of all material facts known to the practitioner that will enable the tribunal to make an informed decision, whether or not the facts are adverse.

(e) In a proceeding before the Office, a practitioner shall disclose to the Office information necessary to comply with applicable duty of disclosure provisions.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.304 Fairness to opposing party and counsel.

A practitioner shall not:

(a) Unlawfully obstruct another party's access to evidence or unlawfully alter, destroy or conceal a document or other material having potential evidentiary value. A practitioner shall not counsel or assist another person to do any such act;

(b) Falsify evidence, counsel or assist a witness to testify falsely, or offer an inducement to a witness that is prohibited by law;

(c) Knowingly disobey an obligation under the rules of a tribunal except for an open refusal based on an assertion that no valid obligation exists;

(d) Make a frivolous discovery request or fail to make a reasonably diligent effort to comply with a legally proper discovery request by an opposing party;

(e) In a proceeding before a tribunal, allude to any matter that the practitioner does not reasonably believe is relevant or that will not be supported by admissible evidence, assert personal knowledge of facts in issue except when testifying as a witness, or state a personal opinion as to the justness of a cause, the credibility of a witness, the culpability of a civil litigant or the guilt or innocence of an accused; or

(f) Request a person other than a client to refrain from voluntarily giving relevant information to another party unless:

(1) The person is a relative or an employee or other agent of a client; and

(2) The practitioner reasonably believes that the person's interests will not be adversely affected by refraining from giving such information.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.305 Impartiality and decorum of the tribunal.

A practitioner shall not:

(a) Seek to influence a judge, hearing officer, administrative law judge, administrative patent judge, administrative trademark judge, juror, prospective juror, employee or officer of the Office, or other official by means prohibited by law;

(b) Communicate *ex parte* with such a person during the proceeding unless authorized to do so by law, rule or court order; or

(c) [Reserved]

(d) Engage in conduct intended to disrupt any proceeding before a tribunal.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.306 Trial publicity.

(a) A practitioner who is participating or has participated in the investigation or litigation of a matter shall not make an extrajudicial statement that the practitioner knows or reasonably should know will be disseminated by means of public communication and will have a substantial likelihood of materially prejudicing an adjudicative proceeding in the matter.

(b) Notwithstanding paragraph (a) of this section, a practitioner may state:

(1) The claim, offense or defense involved and, except when prohibited by law, the identity of the persons involved;

(2) Information contained in a public record;

(3) That an investigation of a matter is in progress;

(4) The scheduling or result of any step in litigation;

(5) A request for assistance in obtaining evidence and information necessary thereto; and

(6) A warning of danger concerning the behavior of a person involved, when there is reason to believe that there exists the likelihood of substantial harm to an individual or to the public interest.

(c) Notwithstanding paragraph (a) of this section, a practitioner may make a statement that a reasonable practitioner would believe is required to protect a client from the substantial undue prejudicial effect of recent publicity not initiated by the practitioner or the practitioner's client. A statement made pursuant to this paragraph shall be limited to such information as is necessary to mitigate the recent adverse publicity.

(d) No practitioner associated in a firm or government agency with a practitioner subject to paragraph (a) of this section shall make a statement prohibited by paragraph (a).

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.307 Practitioner as witness.

(a) A practitioner shall not act as advocate at a proceeding before a tribunal in which the practitioner is likely to be a necessary witness unless:

(1) The testimony relates to an uncontested issue;

(2) The testimony relates to the nature and value of legal services rendered in the case; or

(3) Disqualification of the practitioner would work substantial hardship on the client.

(b) A practitioner may act as advocate in a proceeding before a tribunal in which another practitioner in the practitioner's firm is likely to be called as a witness unless precluded from doing so by §§ 11.107 or 11.109.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.308 [Reserved]

§ 11.309 Advocate in nonadjudicative proceedings.

A practitioner representing a client before a legislative body or administrative agency in a nonadjudicative proceeding shall disclose that the appearance is in a representative capacity and shall conform to the provisions of §§ 11.303(a) through (c), 11.304(a) through (c), and 11.305.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.310 - 11.400 [Reserved]

TRANSACTIONS WITH PERSONS OTHER THAN CLIENTS

§ 11.401 Truthfulness in statements to others.

In the course of representing a client, a practitioner shall not knowingly:

(a) Make a false statement of material fact or law to a third person; or

(b) Fail to disclose a material fact to a third person when disclosure is necessary to avoid assisting a criminal or fraudulent act by a client, unless disclosure is prohibited by § 11.106.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.402 Communication with person represented by a practitioner.

(a) In representing a client, a practitioner shall not communicate about the subject of the representation with a person the practitioner knows to be represented by another practitioner in the matter, unless the practitioner has the consent of the other practitioner or is authorized to do so by law, rule, or a court order.

(b) This section does not prohibit communication by a practitioner with government officials who are otherwise represented by counsel and who have the authority to redress the grievances of the practitioner's client, provided that, if the communication relates to a matter for which the government official is represented, then prior to the communication the practitioner must disclose to such government official both the practitioner's identity and the fact that the practitioner represents a party with a claim against the government.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.403 Dealing with unrepresented person.

In dealing on behalf of a client with a person who is not represented by a practitioner, a practitioner shall not state or imply that the practitioner is disinterested. When the practitioner knows or reasonably should know that the unrepresented person misunderstands the practitioner's role in the matter, the practitioner shall make reasonable efforts to correct the misunderstanding. The practitioner shall not give legal advice to an unrepresented person, other than the advice to secure counsel, if the practitioner knows or reasonably should know that the interests of such a person are or have a reasonable possibility of being in conflict with the interests of the client.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.404 Respect for rights of third persons.

(a) In representing a client, a practitioner shall not use means that have no substantial purpose other than to embarrass, delay, or burden a third person, or use methods of obtaining evidence that violate the legal rights of such a person.

(b) A practitioner who receives a document or electronically stored information relating to the representation of the practitioner's client and knows or reasonably should know that the document or electronically stored information was inadvertently sent shall promptly notify the sender.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.405 - 11.500 [Reserved]

LAW FIRMS AND ASSOCIATIONS

§ 11.501 Responsibilities of partners, managers, and supervisory practitioners.

(a) A practitioner who is a partner in a law firm, and a practitioner who individually or together with other practitioners possesses comparable managerial authority in a law firm, shall make reasonable efforts to ensure that the firm has in effect measures giving reasonable assurance that all practitioners in the firm conform to the USPTO Rules of Professional Conduct.

(b) A practitioner having direct supervisory authority over another practitioner shall make reasonable efforts to ensure that the other practitioner conforms to the USPTO Rules of Professional Conduct.

(c) A practitioner shall be responsible for another practitioner's violation of the USPTO Rules of Professional Conduct if:

(1) The practitioner orders or, with knowledge of the specific conduct, ratifies the conduct involved; or

(2) The practitioner is a partner or has comparable managerial authority in the law firm in which the other practitioner practices, or has direct supervisory authority over the other practitioner, and knows of the conduct at a time when its consequences can be avoided or mitigated but fails to take reasonable remedial action.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.502 Responsibilities of a subordinate practitioner.

(a) A practitioner is bound by the USPTO Rules of Professional Conduct notwithstanding that the practitioner acted at the direction of another person.

(b) A subordinate practitioner does not violate the USPTO Rules of Professional Conduct if that practitioner acts in accordance with a supervisory practitioner's reasonable resolution of an arguable question of professional duty.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.503 Responsibilities regarding non-practitioner assistance.

With respect to a non-practitioner assistant employed or retained by or associated with a practitioner:

(a) A practitioner who is a partner, and a practitioner who individually or together with other practitioners possesses comparable managerial authority in a law firm shall make reasonable efforts to ensure that the firm has in effect measures giving reasonable assurance that the person's conduct is compatible with the professional obligations of the practitioner;

(b) A practitioner having direct supervisory authority over the non-practitioner assistant shall make reasonable efforts to ensure that the person's conduct is compatible with the professional obligations of the practitioner; and

(c) A practitioner shall be responsible for conduct of such a person that would be a violation of the USPTO Rules of Professional Conduct if engaged in by a practitioner if:

(1) The practitioner orders or, with the knowledge of the specific conduct, ratifies the conduct involved; or

(2) The practitioner is a partner or has comparable managerial authority in the law firm in which the person is employed, or has direct supervisory authority over the person, and knows of the conduct at a time when its consequences can be avoided or mitigated but fails to take reasonable remedial action.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.504 Professional independence of a practitioner.

(a) A practitioner or law firm shall not share legal fees with a non-practitioner, except that:

(1) 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;

(2) A practitioner who purchases the practice of a deceased, disabled, or disappeared practitioner may, pursuant to the provisions of § 11.117, pay to the estate or other representative of that practitioner the agreed-upon purchase price;

(3) A practitioner or law firm 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; and

(4) A practitioner may share legal fees, whether awarded by a tribunal or received in settlement of a matter, with a nonprofit organization that employed, retained or recommended employment of the practitioner in the matter and that qualifies under Section 501(c)(3) of the Internal Revenue Code.

(b) A practitioner shall not form a partnership with a non-practitioner if any of the activities of the partnership consist of the practice of law.

(c) A practitioner shall not permit a person who recommends, employs, or pays the practitioner to render legal services for another to direct or regulate the practitioner's professional judgment in rendering such legal services.

(d) A practitioner shall not practice with or in the form of a professional corporation or association authorized to practice law for a profit, if:

(1) A non-practitioner owns any interest therein, except that a fiduciary representative of the estate of a practitioner may hold the stock or interest of the practitioner for a reasonable time during administration;

(2) A non-practitioner is a corporate director or officer thereof or occupies the position of similar responsibility in any form of association other than a corporation; or

(3) A non-practitioner has the right to direct or control the professional judgment of a practitioner.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.505 Unauthorized practice of law.

A practitioner shall not practice law in a jurisdiction in violation of the regulation of the legal profession in that jurisdiction, or assist another in doing so.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.506 Restrictions on right to practice.

A practitioner shall not participate in offering or making:

(a) A partnership, shareholders, operating, employment, or other similar type of agreement that restricts the right of a practitioner to practice after termination of the relationship, except an agreement concerning benefits upon retirement; or

(b) An agreement in which a restriction on the practitioner's right to practice is part of the settlement of a client controversy.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.507 Responsibilities regarding law-related services.

A practitioner shall be subject to the USPTO Rules of Professional Conduct with respect to the provision

of law-related services if the law-related services are provided:

(a) By the practitioner in circumstances that are not distinct from the practitioner's provision of legal services to clients; or

(b) In other circumstances by an entity controlled by the practitioner individually or with others if the practitioner fails to take reasonable measures to assure that a person obtaining the law-related services knows that the services are not legal services and that the protections of the client-practitioner relationship do not exist.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.508 - 11.700 [Reserved]

INFORMATION ABOUT LEGAL SERVICES

§ 11.701 Communications concerning a practitioner's services.

A practitioner shall not make a false or misleading communication about the practitioner or the practitioner's services. A communication is false or misleading if it contains a material misrepresentation of fact or law, or omits a fact necessary to make the statement considered as a whole not materially misleading.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.702 Advertising.

(a) Subject to the requirements of §§ 11.701 and 11.703, a practitioner may advertise services through written, recorded or electronic communication, including public media.

(b) A practitioner shall not give anything of value to a person for recommending the practitioner's services except that a practitioner may:

(1) Pay the reasonable costs of advertisements or communications permitted by this section;

(2) [Reserved]

(3) Pay for a law practice in accordance with § 11.117; and

(4) Refer clients to another practitioner or a non-practitioner professional pursuant to an agreement not otherwise prohibited under the USPTO Rules of Professional Conduct that provides for the other person to refer clients or customers to the practitioner, if:

(i) The reciprocal referral agreement is not exclusive, and

(ii) The client is informed of the existence and nature of the agreement.

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

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.703 Direct contact with prospective clients.

(a) A practitioner shall not by in-person, live telephone or real-time electronic contact solicit professional employment from a prospective client when a significant motive for the practitioner's doing so is the practitioner's pecuniary gain, unless the person contacted:

(1) Is a practitioner; or

(2) Has a family, close personal, or prior professional relationship with the practitioner.

(b) A practitioner shall not solicit professional employment from a prospective client by written, recorded or electronic communication or by in-person, telephone or real-time electronic contact even when not otherwise prohibited by paragraph (a) of this section, if:

(1) The prospective client has made known to the practitioner a desire not to be solicited by the practitioner; or

(2) The solicitation involves coercion, duress or harassment.

(c) Every written, recorded or electronic communication from a practitioner soliciting professional employment from a prospective client known to be in need of legal services in a particular matter shall include the words "Advertising

Material" on the outside envelope, if any, and at the beginning and ending of any recorded or electronic communication, unless the recipient of the communication is a person specified in paragraphs (a)(1) or (a)(2) of this section.

(d) Notwithstanding the prohibitions in paragraph (a) of this section, a practitioner may participate with a prepaid or group legal service plan operated by an organization not owned or directed by the practitioner that uses in-person or telephone contact to solicit memberships or subscriptions for the plan from persons who are not known to need legal services in a particular matter covered by the plan.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.704 Communication of fields of practice and specialization.

(a) A practitioner may communicate the fact that the practitioner does or does not practice in particular fields of law.

(b) A registered practitioner who is an attorney may use the designation "Patents," "Patent Attorney," "Patent Lawyer," "Registered Patent Attorney," or a substantially similar designation. A registered practitioner who is not an attorney may use the designation '"Patents," "Patent Agent," "Registered Patent Agent," or a substantially similar designation. Unless authorized by § 11.14(b), a registered patent agent shall not hold himself or herself out as being qualified or authorized to practice before the Office in trademark matters or before a court.

(c) [Reserved]

(d) A practitioner shall not state or imply that a practitioner is certified as a specialist in a particular field of law, unless:

(1) The practitioner has been certified as a specialist by an organization that has been approved by an appropriate state authority or that has been accredited by the American Bar Association; and

(2) The name of the certifying organization is clearly identified in the communication.

(e) An individual granted limited recognition under § 11.9 may use the designation "Limited Recognition."

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.705 Firm names and letterheads.

(a) A practitioner shall not use a firm name, letterhead or other professional designation that violates § 11.701. A trade name may be used by a practitioner in private practice if it does not imply a connection with a government agency or with a public or charitable legal services organization and is not otherwise in violation of § 11.701.

(b) [Reserved]

(c) The name of a practitioner holding a public office shall not be used in the name of a law firm, or in communications on its behalf, during any substantial period in which the practitioner is not actively and regularly practicing with the firm.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.706 - 11.800 [Reserved]

MAINTAINING THE INTEGRITY OF THE PROFESSION

§ 11.801 Registration, recognition and disciplinary matters.

An applicant for registration or recognition to practice before the Office, or a practitioner in connection with an application for registration or recognition, or a practitioner in connection with a disciplinary or reinstatement matter, shall not:

(a) Knowingly make a false statement of material fact; or

(b) Fail to disclose a fact necessary to correct a misapprehension known by the person to have arisen in the matter, fail to cooperate with the Office of Enrollment and Discipline in an investigation of any matter before it, or knowingly fail to respond to a lawful demand or request for information from an admissions or disciplinary authority, except that the provisions of this section do not require disclosure of information otherwise protected by § 11.106.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.802 Judicial and legal officials.

(a) A practitioner shall not make a statement that the practitioner knows to be false or with reckless disregard as to its truth or falsity concerning the qualifications or integrity of a judge, adjudicatory officer or public legal officer, or of a candidate for election or appointment to judicial or legal office.

(b) A practitioner who is a candidate for judicial office shall comply with the applicable provisions of the Code of Judicial Conduct.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.803 Reporting professional misconduct.

(a) A practitioner who knows that another practitioner has committed a violation of the USPTO Rules of Professional Conduct that raises a substantial question as to that practitioner's honesty, trustworthiness or fitness as a practitioner in other respects, shall inform the OED Director and any other appropriate professional authority.

(b) A practitioner who knows that a judge, hearing officer, administrative law judge, administrative patent judge, or administrative trademark judge has committed a violation of applicable rules of judicial conduct that raises a substantial question as to the individual's fitness for office shall inform the appropriate authority.

(c) The provisions of this section do not require disclosure of information otherwise protected by § 11.106 or information gained while participating in an approved lawyers assistance program.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.804 Misconduct.

It is professional misconduct for a practitioner to:

(a) Violate or attempt to violate the USPTO Rules of Professional Conduct, knowingly assist or induce another to do so, or do so through the acts of another;

(b) Commit a criminal act that reflects adversely on the practitioner's honesty, trustworthiness or fitness as a practitioner in other respects;

(c) Engage in conduct involving dishonesty, fraud, deceit or misrepresentation;

(d) Engage in conduct that is prejudicial to the administration of justice;

(e) State or imply an ability to influence improperly a government agency or official or to achieve results by means that violate the USPTO Rules of Professional Conduct or other law;

(f) Knowingly assist a judge, hearing officer, administrative law judge, administrative patent judge, administrative trademark judge, or judicial officer in conduct that is a violation of applicable rules of judicial conduct or other law;

(g) Knowingly assist an officer or employee of the Office in conduct that is a violation of applicable rules of conduct or other law;

(h) Be publicly disciplined on ethical or professional misconduct grounds by any duly constituted authority of:

(1) A State,

(2) The United States, or

(3) The country in which the practitioner resides; or

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

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 11.805 - 11.900 [Reserved]

§ 11.901 Savings clause.

(a) A disciplinary proceeding based on conduct engaged in prior to the effective date of these regulations may be instituted subsequent to such effective date, if such conduct would continue to justify disciplinary sanctions under the provisions of this part.

(b) No practitioner shall be subject to a disciplinary proceeding under this part based on conduct engaged in before the effective date hereof if such conduct would not have been subject to disciplinary action before such effective date.

[Added 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

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Subpart A — General Provisions

§ 41.1 Policy.

(a) *Scope.* Part 41 governs appeals and interferences before the Patent Trial and Appeal Board. Sections 1.1 to 1.36 and 1.181 to 1.183 of this title also apply to practice before the Board, as do other sections of part 1 of this title that are incorporated by reference into part 41.

(b) *Construction.* The provisions of Part 41 shall be construed to secure the just, speedy, and

inexpensive resolution of every proceeding before the Board.

(c) *Decorum.* Each party must act with courtesy and decorum in all proceedings before the Board, including interactions with other parties.

[Added, 65 FR 52916, Aug. 31, 2000, effective Oct. 2, 2000; para. (a) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

§ 41.2 Definitions.

Unless otherwise clear from the context, the following definitions apply to proceedings under this part:

Affidavit means affidavit, declaration under § 1.68 of this title, or statutory declaration under 28 U.S.C. 1746. A transcript of an ex parte deposition may be used as an affidavit in a contested case.

Board means the Patent Trial and Appeal Board and includes:

(1) For a final Board action:

(i) In an appeal or contested case, a panel of the Board.

(ii) In a proceeding under § 41.3, the Chief Administrative Patent Judge or another official acting under an express delegation from the Chief Administrative Patent Judge.

(2) For non-final actions, a Board member or employee acting with the authority of the Board.

Board member means the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, the Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office, the Commissioner for Patents, the Commissioner for Trademarks, and the administrative patent judges.

Contested case means a Board proceeding other than an appeal under 35 U.S.C. 134 or a petition under § 41.3. An appeal in an *inter partes* reexamination is not a contested case.

Final means, with regard to a Board action, final for the purposes of judicial review. A decision is final only if:

(1) *In a panel proceeding.* The decision is rendered by a panel, disposes of all issues with regard to the party seeking judicial review, and does not indicate that further action is required; and

(2) *In other proceedings.* The decision disposes of all issues or the decision states it is final.

Hearing means consideration of the issues of record. *Rehearing* means reconsideration.

Office means United States Patent and Trademark Office.

Panel means at least three Board members acting in a panel proceeding.

Panel proceeding means a proceeding in which final action is reserved by statute to at least three Board members, but includes a non-final portion of such a proceeding whether administered by a panel or not.

Party, in this part, means any entity participating in a Board proceeding, other than officers and employees of the Office, including:

(1) An appellant;

(2) A participant in a contested case;

(3) A petitioner; and

(4) Counsel for any of the above, where context permits.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; introductory text of the definition of "Board" revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

§ 41.3 Petitions.

(a) *Deciding official.* Petitions must be addressed to the Chief Administrative Patent Judge. A panel or an administrative patent judge may certify a question of policy to the Chief Administrative Patent Judge for decision. The Chief Administrative Patent Judge may delegate authority to decide petitions.

(b) *Scope.* This section covers petitions on matters pending before the Board (§§ 41.35, 41.64, 41.103, and 41.205); otherwise, see §§ 1.181 to 1.183 of this title. The following matters are not subject to petition:

(1) Issues committed by statute to a panel, and

(2) In pending contested cases, procedural issues. See § 41.121(a)(3) and § 41.125(c).

(c) *Petition fee.* The fee set in § 41.20(a) must accompany any petition under this section except no fee is required for a petition under this section seeking supervisory review.

(d) *Effect on proceeding.* The filing of a petition does not stay the time for any other action in a Board proceeding.

(e) *Time for action.*

(1) Except as otherwise provided in this part or as the Board may authorize in writing, a party may:

(i) File the petition within 14 days from the date of the action from which the party is requesting relief, and

(ii) File any request for reconsideration of a petition decision within 14 days of the decision on petition or such other time as the Board may set.

(2) A party may not file an opposition or a reply to a petition without Board authorization.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (e)(1) revised, 69 FR 58260, Sept. 30, 2004, effective Sept. 30, 2004]

§ 41.4 Timeliness.

(a) *Extensions of time.* Extensions of time will be granted only on a showing of good cause except as otherwise provided by rule.

(b) *Late filings.* (1) A late filing that results in either an application becoming abandoned or a reexamination prosecution becoming terminated under §§ 1.550(d) or 1.957(b) of this title or limited under § 1.957(c) of this title may be revived as set forth in § 1.137 of this title.

(2) A late filing that does not result in either an application becoming abandoned or a reexamination prosecution becoming terminated under §§ 1.550(d) or 1.957(b) of this title or limited under § 1.957(c) of this title will be excused upon a showing of excusable neglect or a Board determination that consideration on the merits would be in the interest of justice.

(c) *Scope.* This section governs all proceedings before the Board, but does not apply to filings related to Board proceedings before or after the Board has jurisdiction, such as:

(1) Extensions during prosecution (see § 1.136 of this title),

(2) Filing of a brief or request for oral hearing (see §§ 41.37, 41.41, 41.47, 41.67, 41.68, 41.71 and 41.73), or

(3) Seeking judicial review (see §§ 1.301 to 1.304 of this title).

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (b) revised, 72 FR 18892, Apr. 16, 2007, effective May 16, 2007]

§ 41.5 Counsel.

While the Board has jurisdiction:

(a) *Appearance pro hac vice.* The Board may authorize a person other than a registered practitioner to appear as counsel in a specific proceeding.

(b) *Disqualification.* (1) The Board may disqualify counsel in a specific proceeding after notice and an opportunity to be heard.

(2) A decision to disqualify is not final for the purposes of judicial review until certified by the Chief Administrative Patent Judge.

(c) *Withdrawal.* Counsel may not withdraw from a proceeding before the Board unless the Board authorizes such withdrawal. *See* § 11.116 of this subchapter regarding conditions for withdrawal.

(d) *Procedure.* The Board may institute a proceeding under this section on its own or a party in a contested case may request relief under this section.

(e) *Referral to the Director of Enrollment and Discipline.* Possible violations of the disciplinary rules in part 11 of this subchapter may be referred to the Office of Enrollment and Discipline for investigation. See § 11.22 of this subchapter.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (e) revised, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008; para. (c) revised, 78 FR 20180, Apr. 3, 2013, effective May 3, 2013]

§ 41.6 Public availability of Board records.

(a) *Publication.* (1) *Generally.* Any Board action is available for public inspection without a party's permission if rendered in a file open to the public pursuant to § 1.11 of this title or in an application that has been published in accordance with §§ 1.211 to 1.221 of this title. The Office may independently publish any Board action that is available for public inspection.

(2) *Determination of special circumstances.* Any Board action not publishable under paragraph (a)(1) of this section may be published or made available for public inspection if the Director believes that special circumstances warrant publication and a party does not, within two months after being notified of the intention to make the action public, object in writing on the ground that the action discloses the objecting party's trade secret or other confidential information and states with specificity that such information is not otherwise publicly available. If the action discloses such information, the party shall identify the deletions in the text of the action considered necessary to protect the information. If the affected party considers that the entire action must be withheld from the public to protect such information, the party must explain why. The party will be given time, not less than twenty days, to request reconsideration and seek court review before any contested portion of the action is made public over its objection.

(b) *Record of proceeding.* (1) The record of a Board proceeding is available to the public unless a patent application not otherwise available to the public is involved.

(2) Notwithstanding paragraph (b)(1) of this section, after a final Board action in or judgment in a Board proceeding, the record of the Board proceeding will be made available to the public if any involved file is or becomes open to the public under § 1.11 of this title or an involved application is or becomes published under §§ 1.211 to 1.221 of this title.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.7 Management of the record.

(a) The Board may expunge any paper directed to a Board proceeding, or filed while an application or patent is under the jurisdiction of the Board, that is not authorized under this part or in a Board order, or that is filed contrary to a Board order.

(b) A party may not file a paper previously filed in the same Board proceeding, not even as an exhibit or appendix, without Board authorization or as required by rule.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.8 Mandatory notices.

(a) In an appeal brief (§§ 41.37, 41.67, or 41.68) or at the initiation of a contested case (§ 41.101), and within 20 days of any change during the proceeding, a party must identify:

(1) Its real party-in-interest, and

(2) Each judicial or administrative proceeding that could affect, or be affected by, the Board proceeding.

(b) For contested cases, a party seeking judicial review of a Board proceeding must file a notice with the Board of the judicial review within 20 days of the filing of the complaint or the notice of appeal. The notice to the Board must include a copy of the complaint or notice of appeal. See also §§ 1.301 to 1.304 of this title.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.9 Action by owner.

[Editor Note: Para. (a) below is applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012*]

(a) *Entire interest.* An owner of the entire interest in an application or patent involved in a Board proceeding may act in the proceeding to the exclusion of the inventor (*see* §§ 3.71 and 3.73 of this title).

(b) *Part interest.* An owner of a part interest in an application or patent involved in a Board proceeding may petition to act in the proceeding to the exclusion of an inventor or a co-owner. The

petition must show the inability or refusal of an inventor or co-owner to prosecute the proceeding or other cause why it is in the interest of justice to permit the owner of a part interest to act in the proceeding. An order granting the petition may set conditions on the actions of the parties during the proceeding.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (a) revised, 77 FR 48776, Aug. 14, 2012, effective Sept. 16, 2012]

[*The revisions to para. (a) effective Sept. 16, 2012 are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012. See § 41.9 (pre-AIA) for the rule otherwise in effect.]

§ 41.9 (pre-AIA) Action by owner.

[Editor Note: Para. (a) below is **not applicable** to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012*]

(a) *Entire interest.* An owner of the entire interest in an application or patent involved in a Board proceeding may act in the proceeding to the exclusion of the inventor (see 3.73(b) of this title).

(b) *Part interest.* An owner of a part interest in an application or patent involved in a Board proceeding may petition to act in the proceeding to the exclusion of an inventor or a co-owner. The petition must show the inability or refusal of an inventor or co-owner to prosecute the proceeding or other cause why it is in the interest of justice to permit the owner of a part interest to act in the proceeding. An order granting the petition may set conditions on the actions of the parties during the proceeding.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

[*See § 41.9 for more information and for § 41.9(a) applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012]

§ 41.10 Correspondence addresses.

Except as the Board may otherwise direct,

(a) *Appeals.* Correspondence in an application or a patent involved in an appeal (subparts B and C of this part) during the period beginning when an appeal docketing notice is issued and ending when a decision has been rendered by the Board, as well as any request for rehearing of a decision by the Board, shall be mailed to: Patent Trial and Appeal Board, United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313–1450. Notices of appeal, appeal briefs, reply briefs, requests for oral hearing, as well as all other correspondence in an application or a patent involved in an appeal to the Board for which an address is not otherwise specified, should be addressed as set out in § 1.1(a)(1)(i) of this title.

(b) *Interferences.* Mailed correspondence in interference (subpart D of this part) shall be sent to Mail Stop INTERFERENCE, Patent Trial and Appeal Board, United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313–1450.

(c) *Trial Proceedings.* Correspondence in trial proceedings (part 42 of this title) are governed by § 42.6(b) of this title.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

§ 41.11 Ex parte communications in inter partes proceedings.

An ex parte communication about an inter partes reexamination (subpart C of this part) or about a contested case (subparts D and E of this part) with a Board member, or with a Board employee assigned to the proceeding, is not permitted.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.12 Citation of authority.

(a) For any United States Supreme Court decision, citation to the United States Reports is preferred.

(b) For any decision other than a United States Supreme Court decision, citation to the West Reporter System is preferred.

(c) Citations to authority must include pinpoint citations whenever a specific holding or portion of an authority is invoked.

(d) Non-binding authority should be used sparingly. If the authority is not an authority of the Office and is not reproduced in the United States

Reports or the West Reporter System, a copy of the authority should be provided.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; revised, 76 FR 72270, Nov. 22, 2011, effective Jan. 23, 2012]

§ 41.20 Fees.

(a) *Petition fee.* The fee for filing a petition under this part is:.....$420.00.

(b) *Appeal fees.*

(1) For filing a notice of appeal from the examiner to the Patent Trial and Appeal Board:

TABLE 1 TO PARAGRAPH (b)(1)

By a micro entity (§ 1.29).....$210.00

By a small entity (§ 1.27(a)).....420.00

By other than a small or micro entity.....840.00

(2)

(i) For filing a brief in support of an appeal in an application or *ex parte* reexamination proceeding:.....$0.00.

(ii) In addition to the fee for filing a notice of appeal, for filing a brief in support of an appeal in an *inter partes* reexamination proceeding:

TABLE 2 TO PARAGRAPH (b)(2)(ii)

By a micro entity (§ 1.29)....$525.00

By a small entity (§ 1.27(a)).....1,050.00

By other than a small or micro entity.....2,100.00

(3) For filing a request for an oral hearing before the Board in an appeal under 35 U.S.C. 134:

TABLE 3 TO PARAGRAPH (b)(3)

By a micro entity (§ 1.29).....$340.00

By a small entity (§ 1.27(a).....680.00

By other than a small or micro entity.....1,360.00

(4) In addition to the fee for filing a notice of appeal, for forwarding an appeal in an application or *ex parte* reexamination proceeding to the Board:

TABLE 4 TO PARAGRAPH (b)(4)

By a micro entity (§ 1.29 of this chapter).....$590.00

By a small entity (§ 1.27(a) of this chapter).....1,180.00

By other than a small or micro entity.....2,360.00

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; paras. (b)(1) through (b)(3) revised, 69 FR 52604, Aug. 27, 2004, effective Oct. 1, 2004; para. (b)(3) corrected, 69 FR 55505, Sept. 15, 2004, effective Oct. 1, 2004; para. (a) revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004; para. (b) revised, 70 FR 3880, Jan. 27, 2005, effective Dec. 8, 2004; paras. (b)(1) through (b)(3) revised, 72 FR 46899, Aug. 22, 2007, effective Sept. 30, 2007; para. (b) revised, 73 FR 47534, Aug. 14, 2008, effective Oct. 2, 2008; para. (b) revised, 77 FR 54360, Sept. 5, 2012, effective Oct. 5, 2012; revised, 78 FR 4212, Jan. 18, 2013, effective Mar. 19, 2013; para. (b)(4) revised, 82 FR 52780, Nov. 14, 2017, effective Jan. 16, 2018; paras. (a), (b)(1), (b)(2)(ii), (b)(3), and (b)(4) revised, 85 FR 46932, Aug. 3, 2020, effective Oct. 2, 2020]

Subpart B — Ex Parte Appeals

§ 41.30 Definitions.

In addition to the definitions in § 41.2, the following definitions apply to proceedings under this subpart unless otherwise clear from the context:

Applicant means either the applicant in a national application for a patent or the applicant in an application for reissue of a patent.

Evidence means something (including testimony, documents and tangible objects) that tends to prove or disprove the existence of an alleged fact, except that for the purpose of this subpart *Evidence* does not include dictionaries, which may be cited before the Board.

Owner means the owner of the patent undergoing ex parte reexamination under § 1.510 of this title.

Proceeding means either a national application for a patent, an application for reissue of a patent, an *ex parte* reexamination proceeding, or a trial before

the Patent Trial and Appeal Board. Appeal to the Board in an *inter partes* reexamination proceeding is controlled by subpart C of this part.

Record means the items listed in the content listing of the Image File Wrapper of the official file of the application or reexamination proceeding on appeal or the official file of the Office if other than the Image File Wrapper, excluding amendments, Evidence, and other documents that were not entered. In the case of an issued patent being reissued or reexamined, the *Record* further includes the *Record* of the patent being reissued or reexamined.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; definitions of "evidence" and "record" added, 76 FR 72270, Nov. 22, 2011, effective Jan. 23, 2012; definition of "proceeding" revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

§ 41.31 Appeal to Board.

(a) *Who may appeal and how to file an appeal.* An appeal is taken to the Board by filing a notice of appeal.

(1) Every applicant, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134 of this title for reply.

(2) Every owner of a patent under *ex parte* reexamination filed under § 1.510 of this title before November 29, 1999, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134 of this title for reply.

(3) Every owner of a patent under *ex parte* reexamination filed under § 1.510 of this title on or after November 29, 1999, any of whose claims has been finally (§ 1.113 of this title) rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134 of this title for reply.

(b) The signature requirements of §§ 1.33 and 11.18(a) of this title do not apply to a notice of appeal filed under this section.

(c) An appeal, when taken, is presumed to be taken from the rejection of all claims under rejection unless cancelled by an amendment filed by the applicant and entered by the Office. Questions relating to matters not affecting the merits of the invention may be required to be settled before an appeal can be considered.

(d) The time periods set forth in paragraphs (a)(1) through (a)(3) of this section are extendable under the provisions of § 1.136 of this title for patent applications and § 1.550(c) of this title for ex parte reexamination proceedings.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (a) introductory text, para. (b), and para. (c) first sentence revised, 76 FR 72270, Nov. 22, 2011, effective Jan. 23, 2012]

§ 41.33 Amendments and affidavits or other Evidence after appeal.

(a) Amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date a brief is filed pursuant to § 41.37 may be admitted as provided in § 1.116 of this title.

(b) Amendments filed on or after the date of filing a brief pursuant to § 41.37 may be admitted:

(1) To cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or

(2) To rewrite dependent claims into independent form.

(c) All other amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i), and 41.50(b)(1).

(d)(1) An affidavit or other Evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date of filing a brief pursuant to § 41.37 may be admitted if the examiner determines that the affidavit or other Evidence overcomes all rejections under appeal and that a showing of good and sufficient reasons why the affidavit or other Evidence is necessary and was not earlier presented has been made.

(2) All other affidavits or other Evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i), and 41.50(b)(1).

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; section heading and paras. (c) and (d) revised, 76 FR 72270, Nov. 22, 2011, effective Jan. 23, 2012]

§ 41.35 Jurisdiction over appeal.

(a) *Beginning of jurisdiction.* Jurisdiction over the proceeding passes to the Board upon the filing of a reply brief under § 41.41 or the expiration of the time in which to file such a reply brief, whichever is earlier.

(b) *End of jurisdiction.* The jurisdiction of the Board ends when:

(1) The Director or the Board enters a remand order (*see* §§ 41.35(c), 41.35(e), and 41.50(a)(1)),

(2) The Board enters a final decision (*see* § 41.2) and judicial review is sought or the time for seeking judicial review has expired,

(3) An express abandonment which complies with § 1.138 of this title is recognized,

(4) A request for continued examination is filed which complies with § 1.114 of this title,

(5) Appellant fails to take any required action under §§ 41.39(b), 41.50(a)(2), 41.50(b), or 41.50(d), and the Board enters an order of dismissal, or

(6) Appellant reopens prosecution pursuant to § 41.40(b) or in response to a new ground of rejection entered in a decision of the Board (*see* § 41.50(b)(1)).

(c) *Remand ordered by the Director.* Prior to the entry of a decision on the appeal by the Board (*see* § 41.50), the Director may sua sponte order the proceeding remanded to the examiner.

(d) *Documents filed during Board's jurisdiction.* Except for petitions authorized by this part, consideration of any information disclosure statement or petition filed while the Board possesses jurisdiction over the proceeding will be held in abeyance until the Board's jurisdiction ends.

(e) *Administrative remands ordered by the Board.* If, after receipt and review of the proceeding, the Board determines that the file is not complete or is not in compliance with the requirements of this subpart, the Board may relinquish jurisdiction to the examiner or take other appropriate action to permit completion of the file.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; revised, 76 FR 72270, Nov. 22, 2011, effective Jan. 23, 2012]

§ 41.37 Appeal brief.

(a) *Timing.* Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31. The appeal brief fee in an application or *ex parte* reexamination proceeding is $0.00, but if the appeal results in an examiner's answer, the appeal forwarding fee set forth in § 41.20(b)(4) must be paid within the time period specified in § 41.45 to avoid dismissal of an appeal.

(b) *Failure to file a brief.* On failure to file the brief within the period specified in paragraph (a) of this section, the appeal will stand dismissed.

(c) *Content of appeal brief.*

(1) Except as otherwise provided in this paragraph, the brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (v) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i), (c)(1)(ii), (c)(1)(iv), and (c)(1)(v) of this section:

(i) *Real party in interest.* A statement identifying by name the real party in interest at the time the appeal brief is filed, except that such statement is not required if the named inventor or inventors are themselves the real party in interest. If an appeal brief does not contain a statement of the real party in interest, the Office may assume that the named inventor or inventors are the real party in interest.

(ii) *Related appeals, interferences, and trials.* A statement identifying by application, patent, appeal, interference, or trial number all other prior and pending appeals, interferences, trials before the Board, or judicial proceedings (collectively, "related cases") which satisfy all of the following conditions:

involve an application or patent owned by the appellant or assignee, are known to appellant, the appellant's legal representative, or assignee, and may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal, except that such statement is not required if there are no such related cases. If an appeal brief does not contain a statement of related cases, the Office may assume that there are no such related cases.

(iii) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the rejected independent claims, which shall refer to the specification in the Record by page and line number or by paragraph number, and to the drawing, if any, by reference characters. For each rejected independent claim, and for each dependent claim argued separately under the provisions of paragraph (c)(1)(iv) of this section, if the claim contains a means plus function or step plus function recitation as permitted by 35 U.S.C. 112(f), then the concise explanation must identify the structure, material, or acts described in the specification in the Record as corresponding to each claimed function with reference to the specification in the Record by page and line number or by paragraph number, and to the drawing, if any, by reference characters. Reference to the patent application publication does not satisfy the requirements of this paragraph.

(iv) *Argument.* The arguments of appellant with respect to each ground of rejection, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the Record relied on. The arguments shall explain why the examiner erred as to each ground of rejection contested by appellant. Except as provided for in §§ 41.41, 41.47 and 41.52, any arguments or authorities not included in the appeal brief will be refused consideration by the Board for purposes of the present appeal. Each ground of rejection contested by appellant must be argued under a separate heading, and each heading shall reasonably identify the ground of rejection being contested (*e.g.*, by claim number, statutory basis, and applied reference, if any). For each ground of rejection applying to two or more claims, the claims may be argued separately (claims are considered by appellant as separately patentable), as a group (all claims subject to the ground of rejection stand or fall together), or as a subgroup (a subset of the claims subject to the ground of rejection stand or fall together). When multiple claims subject to the same ground of rejection are argued as a group or subgroup by appellant, the Board may select a single claim from the group or subgroup and may decide the appeal as to the ground of rejection with respect to the group or subgroup on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Under each heading identifying the ground of rejection being contested, any claim(s) argued separately or as a subgroup shall be argued under a separate subheading that identifies the claim(s) by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

(v) *Claims appendix.* An appendix containing a copy of the claims involved in the appeal.

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other Evidence. *See* § 1.116 of this title for treatment of amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for treatment of amendments, affidavits or other Evidence filed after the date of filing the appeal. Review of an examiner's refusal to admit an amendment or Evidence is by petition to the Director. *See* § 1.181 of this title.

(d) *Notice of non-compliance.* If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not, within the set time period, file an amended brief that overcomes all the reasons for non-compliance stated in the notification, the appeal will stand dismissed. Review of a determination of non-compliance is by petition to the Chief Administrative Patent Judge. *See* § 41.3.

(e) *Extensions of time.* The time periods set forth in this section are extendable under the provisions of § 1.136 of this title for patent applications and § 1.550(c) of this title for ex parte reexamination proceedings.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; headings of paragraphs (a), (b), (c), (d) and (e) revised, para. (c) revised; para. (d) second sentence revised and new third and fourth sentences added, 76 FR 72270, Nov. 22, 2011, effective Jan. 23, 2012; paras. (c)(1)(ii)-(iii) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012; paras. (a) and (b) revised, 78 FR 4212, Jan. 18, 2013, effective Mar. 19, 2013; paras. (a) and (b) revised, 78 FR 17102, Mar. 20, 2013, effective Mar. 20, 2013]

§ 41.39 Examiner's answer.

(a) *Content of examiner's answer.* The primary examiner may, within such time as may be directed by the Director, furnish a written answer to the appeal brief.

(1) An examiner's answer is deemed to incorporate all of the grounds of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory action and pre-appeal brief conference decision), unless the examiner's answer expressly indicates that a ground of rejection has been withdrawn.

(2) An examiner's answer may include a new ground of rejection. For purposes of the examiner's answer, any rejection that relies upon any Evidence not relied upon in the Office action from which the appeal is taken (as modified by any advisory action) shall be designated by the primary examiner as a new ground of rejection. The examiner must obtain the approval of the Director to furnish an answer that includes a new ground of rejection.

(b) *Appellant's response to new ground of rejection.* If an examiner's answer contains a rejection designated as a new ground of rejection, appellant must within two months from the date of the examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) *Reopen prosecution.* Request that prosecution be reopened before the primary examiner by filing a reply under § 1.111 of this title with or without amendment or submission of affidavits (§§ 1.130, 1.131 or 1.132 of this of this [*sic*] title) or other Evidence. Any amendment or submission of affidavits or other Evidence must be relevant to the new ground of rejection. A request that complies with this paragraph will be entered and the application or the patent under ex parte reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

(2) *Maintain appeal.* Request that the appeal be maintained by filing a reply brief as set forth in § 41.41. Such a reply brief must address as set forth in § 41.37(c)(1)(iv) each new ground of rejection and should follow the other requirements of a brief as set forth in § 41.37(c). A reply brief may not be accompanied by any amendment, affidavit (§§ 1.130 , 1.131 or 1.132 of this of this [*sic*] title) or other Evidence. If a reply brief filed pursuant to this section is accompanied by any amendment, affidavit or other Evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under paragraph (b)(1) of this section.

(c) *Extensions of time.* Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (a) revised, heading added to (b) introductory text, (b)(1) first two sentences revised, (b)(2) second, third and fourth sentences revised, and heading added to para.(c), 76 FR 72270, Nov. 22, 2011, effective Jan. 23, 2012]

§ 41.40 Tolling of time period to file a reply brief.

(a) *Timing.* Any request to seek review of the primary examiner's failure to designate a rejection as a new ground of rejection in an examiner's answer must be by way of a petition to the Director under § 1.181 of this title filed within two months from the entry of the examiner's answer and before the filing of any reply brief. Failure of appellant to timely file such a petition will constitute a waiver of any arguments that a rejection must be designated as a new ground of rejection.

(b) *Petition granted and prosecution reopened.* A decision granting a petition under § 1.181 to designate a new ground of rejection in an examiner's

answer will provide a two-month time period in which appellant must file a reply under § 1.111 of this title to reopen the prosecution before the primary examiner. On failure to timely file a reply under § 1.111, the appeal will stand dismissed.

(c) *Petition not granted and appeal maintained.* A decision refusing to grant a petition under § 1.181 of this title to designate a new ground of rejection in an examiner's answer will provide a two-month time period in which appellant may file only a single reply brief under § 41.41.

(d) *Withdrawal of petition and appeal maintained.* If a reply brief under § 41.41 is filed within two months from the date of the examiner's answer and on or after the filing of a petition under § 1.181 to designate a new ground of rejection in an examiner's answer, but before a decision on the petition, the reply brief will be treated as a request to withdraw the petition and to maintain the appeal.

(e) *Extensions of time.* Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for *ex parte* reexamination proceedings.

[Added, 76 FR 72270, Nov. 22, 2011, effective Jan. 23, 2012]

§ 41.41 Reply brief.

(a) *Timing.* Appellant may file only a single reply brief to an examiner's answer within the later of two months from the date of either the examiner's answer, or a decision refusing to grant a petition under § 1.181 of this title to designate a new ground of rejection in an examiner's answer.

(b) *Content.*

(1) A reply brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other Evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other Evidence filed after the date of filing the appeal.

(2) Any argument raised in the reply brief which was not raised in the appeal brief, or is not responsive to an argument raised in the examiner's answer, including any designated new ground of rejection, will not be considered by the Board for purposes of the present appeal, unless good cause is shown.

(c) *Extensions of time.* Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; paras. (a) and (b) revised and heading added to (c), 76 FR 72270, Nov. 22, 2011, effective Jan. 23, 2012]

§ 41.43 [Removed]

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; removed, 76 FR 72270, Nov. 22, 2011, effective Jan. 23, 2012]

§ 41.45 Appeal forwarding fee.

(a) *Timing.* Appellant in an application or *ex parte* reexamination proceeding must pay the fee set forth in § 41.20(b)(4) within the later of two months from the date of either the examiner's answer, or a decision refusing to grant a petition under § 1.181 of this chapter to designate a new ground of rejection in an examiner's answer.

(b) *Failure to pay appeal forwarding fee.* On failure to pay the fee set forth in § 41.20(b)(4) within the period specified in paragraph (a) of this section, the appeal will stand dismissed.

(c) *Extensions of time.* Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. *See* § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for *ex parte* reexamination proceedings.

[Added, 78 FR 4212, Jan. 18, 2013, effective Mar. 19, 2013; revised 78 FR 17102, Mar. 20, 2013, effective Mar. 20, 2013]

§ 41.47 Oral hearing.

(a) An oral hearing should be requested only in those circumstances in which appellant considers

such a hearing necessary or desirable for a proper presentation of the appeal. An appeal decided on the briefs without an oral hearing will receive the same consideration by the Board as appeals decided after an oral hearing.

(b) If appellant desires an oral hearing, appellant must file, as a separate paper captioned "REQUEST FOR ORAL HEARING," a written request for such hearing accompanied by the fee set forth in § 41.20(b)(3) within two months from the date of the examiner's answer or on the date of filing of a reply brief, whichever is earlier.

(c) If no request and fee for oral hearing have been timely filed by appellant as required by paragraph (b) of this section, the appeal will be assigned for consideration and decision on the briefs without an oral hearing.

(d) If appellant has complied with all the requirements of paragraph (b) of this section, a date for the oral hearing will be set, and due notice thereof given to appellant. If an oral hearing is held, an oral argument may be presented by, or on behalf of, the primary examiner if considered desirable by either the primary examiner or the Board. A hearing will be held as stated in the notice, and oral argument will ordinarily be limited to twenty minutes for appellant and fifteen minutes for the primary examiner unless otherwise ordered.

(e)(1) Appellant will argue first and may reserve time for rebuttal. At the oral hearing, appellant may only rely on Evidence that has been previously entered and considered by the primary examiner and present argument that has been relied upon in the brief or reply brief except as permitted by paragraph (e)(2) of this section. The primary examiner may only rely on argument and Evidence relied upon in an answer except as permitted by paragraph (e)(2) of this section.

(2) Upon a showing of good cause, appellant and/or the primary examiner may rely on a new argument based upon a recent relevant decision of either the Board or a Federal Court.

(f) Notwithstanding the submission of a request for oral hearing complying with this rule, if the Board decides that a hearing is not necessary, the Board will so notify appellant.

(g) Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time periods set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (b) revised and (e)(1) second and third sentences revised, 76 FR 72270, Nov. 22, 2011, effective Jan. 23, 2012]

§ 41.50 Decisions and other actions by the Board.

(a)(1) *Affirmance and reversal.* The Board, in its decision, may affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner. The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed. The Board may also remand an application to the examiner.

(2) If a substitute examiner's answer is written in response to a remand by the Board for further consideration of a rejection pursuant to paragraph (a)(1) of this section, the appellant must within two months from the date of the substitute examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding:

(i) *Reopen prosecution.* Request that prosecution be reopened before the examiner by filing a reply under § 1.111 of this title with or without amendment or submission of affidavits (§§ 1.130 , 1.131 or 1.132 of this title) or other Evidence. Any amendment or submission of affidavits or other Evidence must be relevant to the issues set forth in the remand or raised in the substitute examiner's answer. A request that complies with this paragraph (a) will be entered and the application or the patent under *ex parte* reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

(ii) *Maintain appeal.* Request that the appeal be maintained by filing a reply brief as provided in § 41.41. If such a reply brief is

accompanied by any amendment, affidavit or other Evidence, it shall be treated as a request that prosecution be reopened before the examiner under paragraph (a)(2)(i) of this section.

(b) *New ground of rejection.* Should the Board have knowledge of any grounds not involved in the appeal for rejecting any pending claim, it may include in its opinion a statement to that effect with its reasons for so holding, and designate such a statement as a new ground of rejection of the claim. A new ground of rejection pursuant to this paragraph shall not be considered final for judicial review. When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

(c) *Review of undesignated new ground of rejection.* Any request to seek review of a panel's failure to designate a new ground of rejection in its decision must be raised by filing a request for rehearing as set forth in § 41.52. Failure of appellant to timely file such a request for rehearing will constitute a waiver of any arguments that a decision contains an undesignated new ground of rejection.

(d) *Request for briefing and information.* The Board may order appellant to additionally brief any matter that the Board considers to be of assistance in reaching a reasoned decision on the pending appeal. Appellant will be given a time period within which to respond to such an order. Failure to timely comply with the order may result in the sua sponte dismissal of the appeal.

(e) *Remand not final action.* Whenever a decision of the Board includes a remand, that decision shall not be considered final for judicial review. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board may enter an order otherwise making its decision final for judicial review.

(f) *Extensions of time.* Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time periods set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for *ex parte* reexamination proceedings.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; revised, 76 FR 72270, Nov. 22, 2011, effective Jan. 23, 2012]

§ 41.52 Rehearing.

(a)(1) Appellant may file a single request for rehearing within two months of the date of the original decision of the Board. No request for rehearing from a decision on rehearing will be permitted, unless the rehearing decision so modified the original decision as to become, in effect, a new decision, and the Board states that a second request for rehearing would be permitted. The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised, and Evidence not previously relied upon, pursuant to §§ 41.37, 41.41, or 41.47 are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) through (a)(4) of this section. When a request for rehearing is made, the Board shall render a decision on the request for rehearing. The decision on the request for rehearing is deemed to incorporate the earlier opinion reflecting its decision for appeal, except for those portions specifically withdrawn on rehearing, and is final for the purpose of judicial review, except when noted otherwise in the decision on rehearing.

(2) Appellant may present a new argument based upon a recent relevant decision of either the Board or a Federal Court.

(3) New arguments responding to a new ground of rejection designated pursuant to § 41.50(b) are permitted.

(4) New arguments that the Board's decision contains an undesignated new ground of rejection are permitted.

(b) Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; (a)(1) fourth sentence, (a)(2) and (a)(3) revised and (a)(4) added, 76 FR 72270, Nov. 22, 2011, effective Jan. 23, 2012]

§ 41.54 Action following decision.

After decision by the Board, jurisdiction over an application or patent under *ex parte* reexamination proceeding passes to the examiner, subject to appellant's right of appeal or other review, for such further action by appellant or by the examiner, as the condition of the application or patent under *ex parte* reexamination proceeding may require, to carry into effect the decision.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; revised, 76 FR 72270, Nov. 22, 2011, effective Jan. 23, 2012]

Subpart C — *Inter Partes* Appeals

§ 41.60 Definitions.

In addition to the definitions in § 41.2, the following definitions apply to proceedings under this subpart unless otherwise clear from the context:

Appellant means any party, whether the owner or a requester, filing a notice of appeal or cross appeal under § 41.61. If more than one party appeals or cross appeals, each appealing or cross appealing party is an appellant with respect to the claims to which his or her appeal or cross appeal is directed.

Filing means filing with a certificate indicating service of the document under § 1.903 of this title.

Owner means the owner of the patent undergoing *inter partes* reexamination under § 1.915 of this title.

Proceeding means an *inter partes* reexamination proceeding. Appeal to the Board in an *ex parte* reexamination proceeding is controlled by subpart B of this part. An *inter partes* reexamination proceeding is not a contested case subject to subpart D.

Requester means each party, other than the owner, who requested that the patent undergo *inter partes* reexamination under § 1.915 of this title.

Respondent means any requester responding under § 41.68 to the appellant's brief of the owner, or the owner responding under § 41.68 to the appellant's brief of any requester. No requester may be a respondent to the appellant brief of any other requester.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.61 Notice of appeal and cross appeal to Board.

(a)(1) Upon the issuance of a Right of Appeal Notice under § 1.953 of this title, the owner may appeal to the Board with respect to the final rejection of any claim of the patent by filing a notice of appeal within the time provided in the Right of Appeal Notice and paying the fee set forth in § 41.20(b)(1).

(2) Upon the issuance of a Right of Appeal Notice under § 1.953 of this title, the requester may appeal to the Board with respect to any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent by filing a notice of appeal within the time provided in the Right of Appeal Notice and paying the fee set forth in § 41.20(b)(1).

(b)(1) Within fourteen days of service of a requester's notice of appeal under paragraph (a)(2) of this section and upon payment of the fee set forth in § 41.20(b)(1), an owner who has not filed a notice of appeal may file a notice of cross appeal with respect to the final rejection of any claim of the patent.

(2) Within fourteen days of service of an owner's notice of appeal under paragraph (a)(1) of this section and upon payment of the fee set forth in § 41.20(b)(1), a requester who has not filed a notice of appeal may file a notice of cross appeal with respect to any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent.

(c) The notice of appeal or cross appeal in the proceeding must identify the appealed claim(s) and must be signed by the owner, the requester, or a duly authorized attorney or agent.

(d) An appeal or cross appeal, when taken, must be taken from all the rejections of the claims in a Right of Appeal Notice which the patent owner proposes to contest or from all the determinations favorable to patentability, including any final determination not to make a proposed rejection, in a Right of Appeal Notice which a requester proposes to contest. Questions relating to matters not affecting the merits of the invention may be required to be settled before an appeal is decided.

(e) The time periods for filing a notice of appeal or cross appeal may not be extended.

(f) If a notice of appeal or cross appeal is timely filed but does not comply with any requirement of this section, appellant will be notified of the reasons for non-compliance and given a non-extendable time period within which to file an amended notice of appeal or cross appeal. If the appellant does not then file an amended notice of appeal or cross appeal within the set time period, or files a notice which does not overcome all the reasons for non-compliance stated in the notification of the reasons for non-compliance, that appellant's appeal or cross appeal will stand dismissed.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.63 Amendments and affidavits or other evidence after appeal.

(a) Amendments filed after the date of filing an appeal pursuant to § 41.61 canceling claims may be admitted where such cancellation does not affect the scope of any other pending claim in the proceeding.

(b) All other amendments filed after the date of filing an appeal pursuant to § 41.61 will not be admitted except as permitted by § 41.77(b)(1).

(c) Affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.61 will not be admitted except as permitted by reopening prosecution under § 41.77(b)(1).

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.64 Jurisdiction over appeal in *inter partes* reexamination.

(a) Jurisdiction over the proceeding passes to the Board upon transmittal of the file, including all briefs and examiner's answers, to the Board.

(b) If, after receipt and review of the proceeding, the Board determines that the file is not complete or is not in compliance with the requirements of this subpart, the Board may relinquish jurisdiction to the examiner or take other appropriate action to permit completion of the file.

(c) Prior to the entry of a decision on the appeal by the Board, the Director may sua sponte order the proceeding remanded to the examiner.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.66 Time for filing briefs.

(a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.

(b) Once an appellant's brief has been properly filed, any brief must be filed by respondent within one month from the date of service of the appellant's brief. The time for filing a respondent's brief or an amended respondent's brief may not be extended.

(c) The examiner will consider both the appellant's and respondent's briefs and may prepare an examiner's answer under § 41.69.

(d) Any appellant may file a rebuttal brief under § 41.71 within one month of the date of the examiner's answer. The time for filing a rebuttal brief or an amended rebuttal brief may not be extended.

(e) No further submission will be considered and any such submission will be treated in accordance with § 1.939 of this title.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.67 Appellant's brief.

(a)(1) Appellant(s) may once, within time limits for filing set forth in § 41.66, file a brief and serve the brief on all other parties to the proceeding in accordance with § 1.903 of this title.

(2) The brief must be signed by the appellant, or the appellant's duly authorized attorney or agent and must be accompanied by the requisite fee set forth in § 41.20(b)(2).

(b) An appellant's appeal shall stand dismissed upon failure of that appellant to file an appellant's brief, accompanied by the requisite fee, within the time allowed under § 41.66(a).

(c)(1) The appellant's brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(xi) of this section.

(i) *Real party in interest.* A statement identifying by name the real party in interest.

(ii) *Related appeals, interferences, and trials.* A statement identifying by application, patent, appeal or interference number all other prior and pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph must be included in an appendix as required by paragraph (c)(1)(xi) of this section.

(iii) *Status of claims.* A statement of the status of all the claims in the proceeding (*e.g.*, rejected, allowed or confirmed, withdrawn, objected to, canceled). If the appellant is the owner, the appellant must also identify the rejected claims whose rejection is being appealed. If the appellant is a requester, the appellant must identify the claims that the examiner has made a determination favorable to patentability, which determination is being appealed.

(iv) *Status of amendments.* A statement of the status of any amendment filed subsequent to the close of prosecution.

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by column and line number, and to the drawing(s), if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112(f), must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

(vi) *Issues to be reviewed on appeal.* A concise statement of each issue presented for review. No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

(vii) *Argument.* The contentions of appellant with respect to each issue presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief permitted under this section or §§ 41.68

and 41.71 will be refused consideration by the Board, unless good cause is shown. Each issue must be treated under a separate heading. If the appellant is the patent owner, for each ground of rejection in the Right of Appeal Notice which appellant contests and which applies to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

(viii) *Claims appendix.* An appendix containing a copy of the claims to be reviewed on appeal.

(ix) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.63 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner in any ground of rejection to be reviewed on appeal.

(x) *Related proceedings appendix.* An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

(xi) *Certificate of service.* A certification that a copy of the brief has been served in its entirety on all other parties to the reexamination proceeding. The names and addresses of the parties served must be indicated.

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence after the date of filing the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (a) and paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a non-extendable time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, that appellant's appeal will stand dismissed.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; paras. (c)(1)(ii) and (c)(1)(v) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

§ 41.68 Respondent's brief.

(a)(1) Respondent(s) in an appeal may once, within the time limit for filing set forth in § 41.66, file a respondent brief and serve the brief on all parties in accordance with § 1.903 of this title.

(2) The brief must be signed by the party, or the party's duly authorized attorney or agent, and must be accompanied by the requisite fee set forth in § 41.20(b)(2).

(3) The respondent brief shall be limited to issues raised in the appellant brief to which the respondent brief is directed.

(4) A requester's respondent brief may not address any brief of any other requester.

(b)(1) The respondent brief shall contain the following items under appropriate headings and in the order here indicated, and may include an appendix containing only those portions of the record on which reliance has been made.

(i) *Real Party in Interest.* A statement identifying by name the real party in interest.

(ii) *Related Appeals, Interferences, and trials.* A statement identifying by application, patent,

appeal, interference, or trial number all other prior and pending appeals, interferences or judicial proceedings known to respondent, the respondent's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph must be included in an appendix as required by paragraph (b)(1)(ix) of this section.

(iii) *Status of claims.* A statement accepting or disputing appellant's statement of the status of claims. If appellant's statement of the status of claims is disputed, the errors in appellant's statement must be specified with particularity.

(iv) *Status of amendments.* A statement accepting or disputing appellant's statement of the status of amendments. If appellant's statement of the status of amendments is disputed, the errors in appellant's statement must be specified with particularity.

(v) *Summary of claimed subject matter.* A statement accepting or disputing appellant's summary of the subject matter defined in each of the independent claims involved in the appeal. If appellant's summary of the subject matter is disputed, the errors in appellant's summary must be specified.

(vi) *Issues to be reviewed on appeal.* A statement accepting or disputing appellant's statement of the issues presented for review. If appellant's statement of the issues presented for review is disputed, the errors in appellant's statement must be specified. A counter statement of the issues for review may be made. No new ground of rejection can be proposed by a requester respondent.

(vii) *Argument.* A statement accepting or disputing the contentions of appellant with each of the issues presented by the appellant for review. If a contention of the appellant is disputed, the errors in appellant's argument must be specified, stating the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Each issue must be treated under a separate heading. An argument may be made with each of the issues stated in the counter statement of the issues, with each counter-stated issue being treated under a separate heading.

(viii) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by respondent in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the respondent's brief. See § 41.63 for treatment of evidence submitted after appeal.

(ix) *Related proceedings appendix.* An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (b)(1)(ii) of this section.

(x) *Certificate of service.* A certification that a copy of the respondent brief has been served in its entirety on all other parties to the reexamination proceeding. The names and addresses of the parties served must be indicated.

(2) A respondent brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(c) If a respondent brief is filed which does not comply with all the requirements of paragraph (a) and paragraph (b) of this section, respondent will be notified of the reasons for non-compliance and given a non-extendable time period within which to file an amended brief. If respondent does not file an amended respondent brief within the set time period, or files an amended respondent brief which does not overcome all the reasons for non-compliance stated in the notification, the respondent brief and any amended respondent brief by that respondent will not be considered.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (b)(1)(ii) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

§ 41.69 Examiner's answer.

(a) The primary examiner may, within such time as directed by the Director, furnish a written answer

to the owner's and/or requester's appellant brief or respondent brief including, as may be necessary, such explanation of the invention claimed and of the references relied upon, the grounds of rejection, and the reasons for patentability, including grounds for not adopting any proposed rejection. A copy of the answer shall be supplied to the owner and all requesters. If the primary examiner determines that the appeal does not comply with the provisions of §§ 41.61, 41.66, 41.67 and 41.68 or does not relate to an appealable action, the primary examiner shall make such determination of record.

(b) An examiner's answer may not include a new ground of rejection.

(c) An examiner's answer may not include a new determination not to make a proposed rejection of a claim.

(d) Any new ground of rejection, or any new determination not to make a proposed rejection, must be made in an Office action reopening prosecution.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.71 Rebuttal brief.

(a) Within one month of the examiner's answer, any appellant may once file a rebuttal brief.

(b)(1) The rebuttal brief of the owner may be directed to the examiner's answer and/or any respondent brief.

(2) The rebuttal brief of the owner shall not include any new or non-admitted amendment, or an affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(c)(1) The rebuttal brief of any requester may be directed to the examiner's answer and/or the respondent brief of the owner.

(2) The rebuttal brief of a requester may not be directed to the respondent brief of any other requester.

(3) No new ground of rejection can be proposed by a requester.

(4) The rebuttal brief of a requester shall not include any new or non-admitted affidavit or other evidence. See § 1.116(d) of this title for affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63(c) for affidavits or other evidence filed after the date of filing the appeal.

(d) The rebuttal brief must include a certification that a copy of the rebuttal brief has been served in its entirety on all other parties to the proceeding. The names and addresses of the parties served must be indicated.

(e) If a rebuttal brief is timely filed under paragraph (a) of this section but does not comply with all the requirements of paragraphs (a) through (d) of this section, appellant will be notified of the reasons for non-compliance and provided with a non-extendable period of one month within which to file an amended rebuttal brief. If the appellant does not file an amended rebuttal brief during the one-month period, or files an amended rebuttal brief which does not overcome all the reasons for non-compliance stated in the notification, that appellant's rebuttal brief and any amended rebuttal brief by that appellant will not be considered.

[Added, 69 FR 4995 9, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.73 Oral hearing.

(a) An oral hearing should be requested only in those circumstances in which an appellant or a respondent considers such a hearing necessary or desirable for a proper presentation of the appeal. An appeal decided on the briefs without an oral hearing will receive the same consideration by the Board as an appeal decided after an oral hearing.

(b) If an appellant or a respondent desires an oral hearing, he or she must file, as a separate paper captioned "REQUEST FOR ORAL HEARING," a written request for such hearing accompanied by the fee set forth in § 41.20(b)(3) within two months after the date of the examiner's answer. The time for requesting an oral hearing may not be extended. The request must include a certification that a copy of the request has been served in its entirety on all other parties to the proceeding. The names and addresses of the parties served must be indicated.

(c) If no request and fee for oral hearing have been timely filed by appellant or respondent as required by paragraph (b) of this section, the appeal will be assigned for consideration and decision on the briefs without an oral hearing.

(d) If appellant or respondent has complied with all the requirements of paragraph (b) of this section, a hearing date will be set, and notice given to the owner and all requesters. If an oral hearing is held, an oral argument may be presented by, or on behalf of, the primary examiner if considered desirable by either the primary examiner or the Board. The notice shall set a non-extendable period within which all requests for oral hearing shall be submitted by any other party to the appeal desiring to participate in the oral hearing. A hearing will be held as stated in the notice, and oral argument will be limited to thirty minutes for each appellant or respondent who has requested an oral hearing, and twenty minutes for the primary examiner unless otherwise ordered. No appellant or respondent will be permitted to participate in an oral hearing unless he or she has requested an oral hearing and submitted the fee set forth in § 41.20(b)(3).

(e)(1) At the oral hearing, each appellant and respondent may only rely on evidence that has been previously entered and considered by the primary examiner and present argument that has been relied upon in the briefs except as permitted by paragraph (e)(2) of this section. The primary examiner may only rely on argument and evidence relied upon in an answer except as permitted by paragraph (e)(2) of this section. The Board will determine the order of the arguments presented at the oral hearing.

(2) Upon a showing of good cause, appellant, respondent and/or the primary examiner may rely on a new argument based upon a recent relevant decision of either the Board or a Federal Court.

(f) Notwithstanding the submission of a request for oral hearing complying with this rule, if the Board decides that a hearing is not necessary, the Board will so notify the owner and all requesters.

[Added, 69 FR 4 9959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.77 Decisions and other actions by the Board.

(a) The Patent Trial and Appeal Board, in its decision, may affirm or reverse each decision of the examiner on all issues raised on each appealed claim, or remand the reexamination proceeding to the examiner for further consideration. The reversal of the examiner's determination not to make a rejection proposed by the third party requester constitutes a decision adverse to the patentability of the claims which are subject to that proposed rejection which will be set forth in the decision of the Patent Trial and Appeal Board as a new ground of rejection under paragraph (b) of this section. The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed.

(b) Should the Board reverse the examiner's determination not to make a rejection proposed by a requester, the Board shall set forth in the opinion in support of its decision a new ground of rejection; or should the Board have knowledge of any grounds not raised in the appeal for rejecting any pending claim, it may include in its opinion a statement to that effect with its reasons for so holding, which statement shall constitute a new ground of rejection of the claim. Any decision which includes a new ground of rejection pursuant to this paragraph shall not be considered final for judicial review. When the Board makes a new ground of rejection, the owner, within one month from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal proceeding as to the rejected claim:

(1) *Reopen prosecution.* The owner may file a response requesting reopening of prosecution before the examiner. Such a response must be either an amendment of the claims so rejected or new evidence relating to the claims so rejected, or both.

(2) *Request rehearing.* The owner may request that the proceeding be reheard under § 41.79 by the Board upon the same record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering

the new ground of rejection and also state all other grounds upon which rehearing is sought.

(c) Where the owner has filed a response requesting reopening of prosecution under paragraph (b)(1) of this section, any requester, within one month of the date of service of the owner's response, may once file comments on the response. Such written comments must be limited to the issues raised by the Board's opinion reflecting its decision and the owner's response. Any requester that had not previously filed an appeal or cross appeal and is seeking under this subsection to file comments or a reply to the comments is subject to the appeal and brief fees under § 41.20(b)(1) and (2), respectively, which must accompany the comments or reply.

(d) Following any response by the owner under paragraph (b)(1) of this section and any written comments from a requester under paragraph (c) of this section, the proceeding will be remanded to the examiner. The statement of the Board shall be binding upon the examiner unless an amendment or new evidence not previously of record is made which, in the opinion of the examiner, overcomes the new ground of rejection stated in the decision. The examiner will consider any owner response under paragraph (b)(1) of this section and any written comments by a requester under paragraph (c) of this section and issue a determination that the rejection is maintained or has been overcome.

(e) Within one month of the examiner's determination pursuant to paragraph (d) of this section, the owner or any requester may once submit comments in response to the examiner's determination. Within one month of the date of service of comments in response to the examiner's determination, the owner and any requesters may file a reply to the comments. No requester reply may address the comments of any other requester reply. Any requester that had not previously filed an appeal or cross appeal and is seeking under this subsection to file comments or a reply to the comments is subject to the appeal and brief fees under § 41.20(b)(1) and (2), respectively, which must accompany the comments or reply.

(f) After submission of any comments and any reply pursuant to paragraph (e) of this section, or after time has expired, the proceeding will be returned to the Board which shall reconsider the matter and issue a new decision. The new decision is deemed to incorporate the earlier decision, except for those portions specifically withdrawn.

(g) The time period set forth in paragraph (b) of this section is subject to the extension of time provisions of § 1.956 of this title when the owner is responding under paragraph (b)(1) of this section. The time period set forth in paragraph (b) of this section may not be extended when the owner is responding under paragraph (b)(2) of this section. The time periods set forth in paragraphs (c) and (e) of this section may not be extended.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (a) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

§ 41.79 Rehearing.

(a) Parties to the appeal may file a request for rehearing of the decision within one month of the date of:

(1) The original decision of the Board under § 41.77(a),

(2) The original § 41.77(b) decision under the provisions of § 41.77(b)(2),

(3) The expiration of the time for the owner to take action under § 41.77(b)(2), or

(4) The new decision of the Board under § 41.77(f).

(b)(1) The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked in rendering the Board's opinion reflecting its decision. Arguments not raised in the briefs before the Board and evidence not previously relied upon in the briefs are not permitted in the request for rehearing except as permitted by paragraphs (b)(2) and (b)(3) of this section.

(2) Upon a showing of good cause, appellant and/or respondent may present a new argument based upon a recent relevant decision of either the Board or a Federal Court.

(3) New arguments responding to a new ground of rejection made pursuant to § 41.77(b) are permitted.

(c) Within one month of the date of service of any request for rehearing under paragraph (a) of this

section, or any further request for rehearing under paragraph (d) of this section, the owner and all requesters may once file comments in opposition to the request for rehearing or the further request for rehearing. The comments in opposition must be limited to the issues raised in the request for rehearing or the further request for rehearing.

(d) If a party to an appeal files a request for rehearing under paragraph (a) of this section, or a further request for rehearing under this section, the Board shall render a decision on the request for rehearing. The decision on the request for rehearing is deemed to incorporate the earlier opinion reflecting its decision for appeal, except for those portions specifically withdrawn on rehearing and is final for the purpose of judicial review, except when noted otherwise in the decision on rehearing. If the Board opinion reflecting its decision on rehearing becomes, in effect, a new decision, and the Board so indicates, then any party to the appeal may, within one month of the new decision, file a further request for rehearing of the new decision under this subsection. Such further request for rehearing must comply with paragraph (b) of this section.

(e) The times for requesting rehearing under paragraph (a) of this section, for requesting further rehearing under paragraph (c) of this section, and for submitting comments under paragraph (b) of this section may not be extended.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.81 Action following decision.

The parties to an appeal to the Board may not appeal to the U.S. Court of Appeals for the Federal Circuit under § 1.983 of this title until all parties' rights to request rehearing have been exhausted, at which time the decision of the Board is final and appealable by any party to the appeal to the Board.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

Subpart D — Contested Cases

§ 41.100 Definitions.

In addition to the definitions in § 41.2, the following definitions apply to proceedings under this subpart:

Business day means a day other than a Saturday, Sunday, or Federal holiday within the District of Columbia.

Involved means the Board has declared the patent application, patent, or claim so described to be a subject of the contested case.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.101 Notice of proceeding.

(a) Notice of a contested case will be sent to every party to the proceeding. The entry of the notice initiates the proceeding.

(b) When the Board is unable to provide actual notice of a contested case on a party through the correspondence address of record for the party, the Board may authorize other modes of notice, including:

(1) Sending notice to another address associated with the party, or

(2) Publishing the notice in the Official Gazette of the United States Patent and Trademark Office.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.102 Completion of examination.

Before a contested case is initiated, except as the Board may otherwise authorize, for each involved application and patent:

(a) Examination or reexamination must be completed, and

(b) There must be at least one claim that:

(1) Is patentable but for a judgment in the contested case, and

(2) Would be involved in the contested case.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.103 Jurisdiction over involved files.

The Board acquires jurisdiction over any involved file when the Board initiates a contested case. Other proceedings for the involved file within the Office are suspended except as the Board may order.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.104 Conduct of contested cases.

(a) The Board may determine a proper course of conduct in a proceeding for any situation not specifically covered by this part and may enter non-final orders to administer the proceeding.

(b) An administrative patent judge may waive or suspend in a proceeding the application of any rule in this subpart, subject to such conditions as the administrative patent judge may impose.

(c) Times set in this subpart are defaults. In the event of a conflict between a time set by rule and a time set by order, the time set by order is controlling. Action due on a day other than a business day may be completed on the next business day unless the Board expressly states otherwise.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.106 Filing and service.

(a) *General format requirements.*

(1) The paper used for filings must be durable and white. A party must choose to file on either A4-sized paper or 8½ inch x 11 inch paper except in the case of exhibits that require a larger size in order to preserve details of the original. A party may not switch between paper sizes in a single proceeding. Only one side of the paper may be used.

(2) In papers, including affidavits, created for the proceeding:

(i) Markings must be in black ink or must otherwise provide an equivalently permanent, dark, high-contrast image on the paper. The quality of printing must be equivalent to the quality produced by a laser printer. Either a proportional or monospaced font may be used, but the proportional font must be 12-point or larger and a monospaced font must not contain more than 4 characters per centimeter (10 characters per inch). Case names must be underlined or italicized.

(ii) Double spacing must be used except in headings, tables of contents, tables of authorities, indices, signature blocks, and certificates of service. Block quotations may be single-spaced and must be indented. Margins must be at least 2.5 centimeters (1 inch) on all sides.

(b) *Papers other than exhibits—*

(1) *Cover sheet.*

(i) The cover sheet must include the caption the Board specifies for the proceeding, a header indicating the party and contact information for the party, and a title indicating the sequence and subject of the paper. For example, “JONES MOTION 2, For benefit of an earlier application”.

(ii) If the Board specifies a color other than white for the cover sheet, the cover sheet must be that color.

(2) Papers must have two 0.5 cm (¼ inch) holes with centers 1 cm (½ inch) from the top of the page and 7 cm (2¾ inch) apart, centered horizontally on the page.

(3) *Incorporation by reference; combined papers.* Arguments must not be incorporated by reference from one paper into another paper. Combined motions, oppositions, replies, or other combined papers are not permitted.

(4) *Exhibits.* Additional requirements for exhibits appear in § 41.154(c).

(c) *Working copy.* Every paper filed must be accompanied by a working copy marked “APJ Copy”.

(d) *Specific filing forms—*

(1) *Filing by mail.* A paper filed using the Priority Mail Express® service of the United States Postal Service will be deemed to be filed as of “date accepted” on the Priority Mail Express® mailing label; otherwise, mail will be deemed to be filed as of the stamped date of receipt at the Board.

(2) *Other modes of filing.* The Board may authorize other modes of filing, including electronic

filing and hand filing, and may set conditions for the use of such other modes.

(e) *Service.*

(1) Papers filed with the Board, if not previously served, must be served simultaneously on every opposing party except as the Board expressly directs.

(2) If a party is represented by counsel, service must be on counsel.

(3) Service must be by Priority Mail Express® or by means at least as fast and reliable as Priority Mail Express®. Electronic service is not permitted without Board authorization.

(4) The date of service does not count in computing the time for responding.

(f) *Certificate of service.*

(1) Papers other than exhibits must include a certificate of service as a separate page at the end of each paper that must be served on an opposing party.

(2) Exhibits must be accompanied by a certificate of service, but a single certificate may accompany any group of exhibits submitted together.

(3) A certificate of service must state:

(i) The date and manner of service,

(ii) The name and address of every person served, and

(iii) For exhibits filed as a group, the name and number of each exhibit served.

(4) A certificate made by a person other than a registered patent practitioner must be in the form of an affidavit.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; paras. (d)(1) and (e)(3) revised, 79 FR 63036, Oct. 22, 2014, effective Oct. 22, 2014;]

§ 41.108 Lead counsel.

(a) A party may be represented by counsel. The Board may require a party to appoint a lead counsel. If counsel is not of record in a party's involved application or patent, then a power of attorney for that counsel for the party's involved application or patent must be filed with the notice required in paragraph (b) of this section.

(b) Within 14 days of the initiation of each contested case, each party must file a separate notice identifying its counsel, if any, and providing contact information for each counsel identified or, if the party has no counsel, then for the party. Contact information must, at a minimum, include:

(1) A mailing address;

(2) An address for courier delivery when the mailing address is not available for such delivery (for example, when the mailing address is a Post Office box);

(3) A telephone number;

(4) A facsimile number; and

(5) An electronic mail address.

(c) A party must promptly notify the Board of any change in the contact information required in paragraph (b) of this section.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.109 Access to and copies of Office records.

(a) *Request for access or copies.* Any request from a party for access to or copies of Office records directly related to a contested case must be filed with the Board. The request must precisely identify the records and in the case of copies include the appropriate fee set under § 1.19(b) of this title.

(b) *Authorization of access and copies.* Access and copies will ordinarily only be authorized for the following records:

(1) The application file for an involved patent;

(2) An involved application; and

(3) An application for which a party has been accorded benefit under subpart E of this part.

(c) *Missing or incomplete copies.* If a party does not receive a complete copy of a record within 21 days of the authorization, the party must promptly notify the Board.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.110 Filing claim information.

(a) *Clean copy of claims.* Within 14 days of the initiation of the proceeding, each party must file a clean copy of its involved claims and, if a biotechnology material sequence is a limitation, a clean copy of the sequence.

(b) *Annotated copy of claims.* Within 28 days of the initiation of the proceeding, each party must:

(1) For each involved claim having a limitation that is illustrated in a drawing or biotechnology material sequence, file an annotated copy of the claim indicating in bold face between braces ({}) where each limitation is shown in the drawing or sequence.

(2) For each involved claim that contains a means-plus-function or step-plus-function limitation in the form permitted under 35 U.S.C. 112(f), file an annotated copy of the claim indicating in bold face between braces ({ }) the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function.

(c) Any motion to add or amend a claim must include:

(1) A clean copy of the claim,

(2) A claim chart showing where the disclosure of the patent or application provides written description of the subject matter of the claim, and

(3) Where applicable, a copy of the claims annotated according to paragraph (b) of this section.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (b)(2) revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012]

§ 41.120 Notice of basis for relief.

(a) The Board may require a party to provide a notice stating the relief it requests and the basis for its entitlement to relief. The Board may provide for the notice to be maintained in confidence for a limited time.

(b) *Effect.* If a notice under paragraph (a) of this section is required, a party will be limited to filing substantive motions consistent with the notice. Ambiguities in the notice will be construed against the party. A notice is not evidence except as an admission by a party-opponent.

(c) *Correction.* A party may move to correct its notice. The motion should be filed promptly after the party becomes aware of the basis for the correction. A correction filed after the time set for filing notices will only be entered if entry would serve the interests of justice.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.121 Motions.

(a) *Types of motions—*

(1) *Substantive motions.* Consistent with the notice of requested relief, if any, and to the extent the Board authorizes, a party may file a motion:

(i) To redefine the scope of the contested case,

(ii) To change benefit accorded for the contested subject matter, or

(iii) For judgment in the contested case.

(2) *Responsive motions.* The Board may authorize a party to file a motion to amend or add a claim, to change inventorship, or otherwise to cure a defect raised in a notice of requested relief or in a substantive motion.

(3) *Miscellaneous motions.* Any request for relief other than a substantive or responsive motion must be filed as a miscellaneous motion.

(b) *Burden of proof.* The party filing the motion has the burden of proof to establish that it is entitled to the requested relief.

(c) *Content of motions; oppositions and replies.*

(1) Each motion must be filed as a separate paper and must include:

(i) A statement of the precise relief requested,

(ii) A statement of material facts (see paragraph (d) of this section), and

(iii) A full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence and the governing law, rules, and precedent.

(2) *Compliance with rules.* Where a rule in part 1 of this title ordinarily governs the relief

sought, the motion must make any showings required under that rule in addition to any showings required in this part.

(3) The Board may order additional showings or explanations as a condition for filing a motion.

(d) *Statement of material facts.* (1) Each material fact shall be set forth as a separate numbered sentence with specific citations to the portions of the record that support the fact.

(2) The Board may require that the statement of material facts be submitted as a separate paper.

(e) *Claim charts.* Claim charts must be used in support of any paper requiring the comparison of a claim to something else, such as another claim, prior art, or a specification. Claim charts must accompany the paper as an appendix. Claim charts are not a substitute for appropriate argument and explanation in the paper.

(f) The Board may order briefing on any issue that could be raised by motion.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.122 Oppositions and replies.

(a) Oppositions and replies must comply with the content requirements for motions and must include a statement identifying material facts in dispute. Any material fact not specifically denied shall be considered admitted.

(b) All arguments for the relief requested in a motion must be made in the motion. A reply may only respond to arguments raised in the corresponding opposition.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.123 Default filing times.

(a) A *motion*, other than a miscellaneous motion, may only be filed according to a schedule the Board sets. The default times for acting are:

(1) An *opposition* is due 30 days after service of the motion.

(2) A *reply* is due 30 days after service of the opposition.

(3) A *responsive motion* is due 30 days after the service of the motion.

(b) *Miscellaneous motions.*

(1) If no time for filing a specific miscellaneous motion is provided in this part or in a Board order:

(i) The opposing party must be consulted prior to filing the miscellaneous motion, and

(ii) If an opposing party plans to oppose the miscellaneous motion, the movant may not file the motion without Board authorization. Such authorization should ordinarily be obtained through a telephone conference including the Board and every other party to the proceeding. Delay in seeking relief may justify a denial of the motion.

(2) An opposition may not be filed without authorization. The default times for acting are:

(i) An *opposition* to a miscellaneous motion is due five business days after service of the motion.

(ii) A *reply* to a miscellaneous motion opposition is due three business days after service of the opposition.

(c) *Exhibits.* Each exhibit must be filed and served with the first paper in which it is cited except as the Board may otherwise order.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.124 Oral argument.

(a) *Request for oral argument.* A party may request an oral argument on an issue raised in a paper within five business days of the filing of the paper. The request must be filed as a separate paper and must specify the issues to be considered.

(b) *Copies for panel.* If an oral argument is set for a panel, the movant on any issue to be argued must provide three working copies of the motion, the opposition, and the reply. Each party is responsible for providing three working copies of its exhibits relating to the motion.

(c) *Length of argument.* If a request for oral argument is granted, each party will have a total of 20 minutes to present its arguments, including any time for rebuttal.

(d) *Demonstrative exhibits* must be served at least five business days before the oral argument and filed no later than the time of the oral argument.

(e) *Transcription.* The Board encourages the use of a transcription service at oral arguments but, if such a service is to be used, the Board must be notified in advance to ensure adequate facilities are available and a transcript must be filed with the Board promptly after the oral argument.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.125 Decision on motions.

(a) *Order of consideration.* The Board may take up motions for decisions in any order, may grant, deny, or dismiss any motion, and may take such other action appropriate to secure the just, speedy, and inexpensive determination of the proceeding. A decision on a motion may include deferral of action on an issue until a later point in the proceeding.

(b) *Interlocutory decisions.* A decision on motions without a judgment is not final for the purposes of judicial review. A panel decision on an issue will govern further proceedings in the contested case.

(c) *Rehearing*—(1) Time for request. A request for rehearing of a decision on a motion must be filed within fourteen days of the decision.

(2) *No tolling.* The filing of a request for rehearing does not toll times for taking action.

(3) *Burden on rehearing.* The burden of showing a decision should be modified lies with the party attacking the decision. The request must specifically identify:

(i) All matters the party believes to have been misapprehended or overlooked, and

(ii) The place where the matter was previously addressed in a motion, opposition, or reply.

(4) *Opposition; reply.* Neither an opposition nor a reply to a request for rehearing may be filed without Board authorization.

(5) *Panel rehearing.* If a decision is not a panel decision, the party requesting rehearing may request that a panel rehear the decision. A panel rehearing a procedural decision will review the decision for an abuse of discretion.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.126 Arbitration.

(a) Parties to a contested case may resort to binding arbitration to determine any issue in a contested case. The Office is not a party to the arbitration. The Board is not bound and may independently determine questions of patentability, jurisdiction, and Office practice.

(b) The Board will not authorize arbitration unless:

(1) It is to be conducted according to Title 9 of the United States Code.

(2) The parties notify the Board in writing of their intention to arbitrate.

(3) The agreement to arbitrate:

(i) Is in writing,

(ii) Specifies the issues to be arbitrated,

(iii) Names the arbitrator, or provides a date not more than 30 days after the execution of the agreement for the selection of the arbitrator, and

(iv) Provides that the arbitrator's award shall be binding on the parties and that judgment thereon can be entered by the Board.

(4) A copy of the agreement is filed within 20 days after its execution.

(5) The arbitration is completed within the time the Board sets.

(c) The parties are solely responsible for the selection of the arbitrator and the conduct of proceedings before the arbitrator.

(d) Issues not disposed of by the arbitration will be resolved in accordance with the procedures established in this subpart.

(e) The Board will not consider the arbitration award unless it:

(1) Is binding on the parties,

(2) Is in writing,

(3) States in a clear and definite manner each issue arbitrated and the disposition of each issue, and

(4) Is filed within 20 days of the date of the award.

(f) Once the award is filed, the parties to the award may not take actions inconsistent with the award. If the award is dispositive of the contested subject matter for a party, the Board may enter judgment as to that party.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.127 Judgment.

(a) *Effect within Office*—(1) *Estoppel.* A judgment disposes of all issues that were, or by motion could have properly been, raised and decided. A losing party who could have properly moved for relief on an issue, but did not so move, may not take action in the Office after the judgment that is inconsistent with that party's failure to move, except that a losing party shall not be estopped with respect to any contested subject matter for which that party was awarded a favorable judgment.

(2) *Final disposal of claim.* Adverse judgment against a claim is a final action of the Office requiring no further action by the Office to dispose of the claim permanently.

(b) *Request for adverse judgment.* A party may at any time in the proceeding request judgment against itself. Actions construed to be a request for adverse judgment include:

(1) Abandonment of an involved application such that the party no longer has an application or patent involved in the proceeding,

(2) Cancellation or disclaiming of a claim such that the party no longer has a claim involved in the proceeding,

(3) Concession of priority or unpatentability of the contested subject matter, and

(4) Abandonment of the contest.

(c) *Recommendation.* The judgment may include a recommendation for further action by the examiner or by the Director. If the Board recommends rejection of a claim of an involved application, the examiner must enter and maintain the recommended rejection unless an amendment or showing of facts not previously of record is filed which, in the opinion of the examiner, overcomes the recommended rejection.

(d) *Rehearing.* A party dissatisfied with the judgment may file a request for rehearing within 30 days of the entry of the judgment. The request must specifically identify all matters the party believes to have been misapprehended or overlooked, and the place where the matter was previously addressed in a motion, opposition or reply.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (d) revised, 69 FR 58260, Sept. 30, 2004, effective Sept. 30, 2004]

§ 41.128 Sanctions.

(a) The Board may impose a sanction against a party for misconduct, including:

(1) Failure to comply with an applicable rule or order in the proceeding;

(2) Advancing a misleading or frivolous request for relief or argument; or

(3) Engaging in dilatory tactics.

(b) Sanctions include entry of:

(1) An order holding certain facts to have been established in the proceeding;

(2) An order expunging, or precluding a party from filing, a paper;

(3) An order precluding a party from presenting or contesting a particular issue;

(4) An order precluding a party from requesting, obtaining, or opposing discovery;

(5) An order excluding evidence;

(6) An order awarding compensatory expenses, including attorney fees;

(7) An order requiring terminal disclaimer of patent term; or

(8) Judgment in the contested case.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.150 Discovery.

(a) *Limited discovery.* A party is not entitled to discovery except as authorized in this subpart. The parties may agree to discovery among themselves at any time.

(b) *Automatic discovery.*

(1) Within 21 days of a request by an opposing party, a party must:

(i) Serve a legible copy of every requested patent, patent application, literature reference, and test standard mentioned in the specification of the party's involved patent or application, or application upon which the party will rely for benefit, and, if the requested material is in a language other than English, a translation, if available, and

(ii) File with the Board a notice (without copies of the requested materials) of service of the requested materials.

(2) Unless previously served, or the Board orders otherwise, any exhibit cited in a motion or in testimony must be served with the citing motion or testimony.

(c) *Additional discovery.* (1) A party may request additional discovery. The requesting party must show that such additional discovery is in the interests of justice. The Board may specify conditions for such additional discovery.

(2) When appropriate, a party may obtain production of documents and things during cross examination of an opponent's witness or during testimony authorized under § 41.156.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.151 Admissibility.

Evidence that is not taken, sought, or filed in accordance with this subpart shall not be admissible.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.152 Applicability of the Federal Rules of Evidence.

(a) *Generally.* Except as otherwise provided in this subpart, the Federal Rules of Evidence shall apply to contested cases.

(b) *Exclusions.* Those portions of the Federal Rules of Evidence relating to criminal proceedings, juries, and other matters not relevant to proceedings under this subpart shall not apply.

(c) *Modifications in terminology.* Unless otherwise clear from context, the following terms of the Federal Rules of Evidence shall be construed as indicated:

Appellate court means United States Court of Appeals for the Federal Circuit or a United States district court when judicial review is under 35 U.S.C. 146.

Civil action, civil proceeding, action, and *trial* mean contested case.

Courts of the United States, U.S. Magistrate, court, trial court, and *trier of fact* mean Board.

Hearing means:

(i) In Federal Rule of Evidence 703, the time when the expert testifies.

(ii) In Federal Rule of Evidence 804(a)(5), the time for taking testimony.

Judge means the Board.

Judicial notice means official notice.

Trial or hearing means, in Federal Rule of Evidence 807, the time for taking testimony.

(d) The Board, in determining foreign law, may consider any relevant material or source, including testimony, whether or not submitted by a party or admissible under the Federal Rules of Evidence.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.153 Records of the Office.

Certification is not necessary as a condition to admissibility when the evidence to be submitted is a record of the Office to which all parties have access.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.154 Form of evidence.

(a) Evidence consists of affidavits, transcripts of depositions, documents, and things. All evidence must be submitted in the form of an exhibit.

(b) *Translation required.* When a party relies on a document or is required to produce a document in a language other than English, a translation of the

document into English and an affidavit attesting to the accuracy of the translation must be filed with the document.

(c)(1) Each exhibit must have an exhibit label with a unique number in a range assigned by the Board, the names of the parties, and the proceeding number in the following format:

JONES EXHIBIT 2001

Jones v. Smith

Contested Case 104,999

(2) When the exhibit is a paper:

(i) Each page must be uniquely numbered in sequence, and

(ii) The exhibit label must be affixed to the lower right corner of the first page of the exhibit without obscuring information on the first page or, if obscuring is unavoidable, affixed to a duplicate first page.

(d) *Exhibit list.* Each party must maintain an exhibit list with the exhibit number and a brief description of each exhibit. If the exhibit is not filed, the exhibit list should note that fact. The Board may require the filing of a current exhibit list prior to acting on a motion.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (c)(1) revised, 69 FR 58260, Sept. 30, 2004, effective Sept. 30, 2004]

§ 41.155 Objection; motion to exclude; motion in limine.

(a) *Deposition.* Objections to deposition evidence must be made during the deposition. Evidence to cure the objection must be provided during the deposition unless the parties to the deposition stipulate otherwise on the deposition record.

(b) *Other than deposition.*For evidence other than deposition evidence:

(1) *Objection.* Any objection must be served within five business days of service of evidence, other than deposition evidence, to which the objection is directed.

(2) *Supplemental evidence.* The party relying on evidence for which an objection is timely served may respond to the objection by serving supplemental evidence within ten business days of service of the objection.

(c) *Motion to exclude.* A miscellaneous motion to exclude evidence must be filed to preserve any objection. The motion must identify the objections in the record in order and must explain the objections.

(d) *Motion in limine.* A party may file a miscellaneous motion in limine for a ruling on the admissibility of evidence.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (b) revised, 69 FR 58260, Sept. 30, 2004, effective Sept. 30, 2004]

§ 41.156 Compelling testimony and production.

(a) *Authorization required.* A party seeking to compel testimony or production of documents or things must file a miscellaneous motion for authorization. The miscellaneous motion must describe the general relevance of the testimony, document, or thing and must:

(1) In the case of testimony, identify the witness by name or title, and

(2) In the case of a document or thing, the general nature of the document or thing.

(b) *Outside the United States.* For testimony or production sought outside the United States, the motion must also:

(1) *In the case of testimony.* (i) Identify the foreign country and explain why the party believes the witness can be compelled to testify in the foreign country, including a description of the procedures that will be used to compel the testimony in the foreign country and an estimate of the time it is expected to take to obtain the testimony; and

(ii) Demonstrate that the party has made reasonable efforts to secure the agreement of the witness to testify in the United States but has been unsuccessful in obtaining the agreement, even though the party has offered to pay the expenses of the witness to travel to and testify in the United States.

(2) *In the case of production of a document or thing.* (i) Identify the foreign country and explain why the party believes production of the document

or thing can be compelled in the foreign country, including a description of the procedures that will be used to compel production of the document or thing in the foreign country and an estimate of the time it is expected to take to obtain production of the document or thing; and

(ii) Demonstrate that the party has made reasonable efforts to obtain the agreement of the individual or entity having possession, custody, or control of the document to produce the document or thing in the United States but has been unsuccessful in obtaining that agreement, even though the party has offered to pay the expenses of producing the document or thing in the United States.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.157 Taking testimony.

(a) *Form.* Direct testimony must be submitted in the form of an affidavit except when the testimony is compelled under 35 U.S.C. 24, in which case it may be in the form of a deposition transcript.

(b) *Time and location.* (1) *Uncompelled direct testimony* may be taken at any time; otherwise, testimony may only be taken during such time period as the Board may authorize.

(2) *Other testimony.* (i) Except as the Board otherwise orders, authorized testimony may be taken at any reasonable time and location within the United States before any disinterested official authorized to administer oaths at that location.

(ii) Testimony outside the United States may only be taken as the Board specifically directs.

(c) *Notice of deposition.* (1) Prior to the taking of testimony, all parties to the proceeding must agree on the time and place for taking testimony. If the parties cannot agree, the party seeking the testimony must initiate a conference with the Board to set a time and place.

(2) Cross-examination should ordinarily take place after any supplemental evidence relating to the direct testimony has been filed and more than a week before the filing date for any paper in which the cross-examination testimony is expected to be used. A party requesting cross-examination testimony of more than one witness may choose the order in which the witnesses are to be cross-examined.

(3) In the case of direct testimony, at least three business days prior to the conference in paragraph (c)(1) of this section, the party seeking the direct testimony must serve:

(i) A list and copy of each document under the party's control and on which the party intends to rely, and

(ii) A list of, and proffer of reasonable access to, any thing other than a document under the party's control and on which the party intends to rely.

(4) Notice of the deposition must be filed at least two business days before a deposition. The notice limits the scope of the testimony and must list:

(i) The time and place of the deposition,

(ii) The name and address of the witness,

(iii) A list of the exhibits to be relied upon during the deposition, and

(iv) A general description of the scope and nature of the testimony to be elicited.

(5) *Motion to quash.* Objection to a defect in the notice is waived unless a miscellaneous motion to quash is promptly filed.

(d) *Deposition in a foreign language.* If an interpreter will be used during the deposition, the party calling the witness must initiate a conference with the Board at least five business days before the deposition.

(e) *Manner of taking testimony.* (1) Each witness before giving a deposition shall be duly sworn according to law by the officer before whom the deposition is to be taken. The officer must be authorized to take testimony under 35 U.S.C. 23.

(2) The testimony shall be taken in answer to interrogatories with any questions and answers recorded in their regular order by the officer, or by some other disinterested person in the presence of the officer, unless the presence of the officer is waived on the record by agreement of all parties.

(3) Any exhibits relied upon must be numbered according to the numbering scheme assigned for the contested case and must, if not previously served, be served at the deposition.

(4) All objections made at the time of the deposition to the qualifications of the officer taking the deposition, the manner of taking it, the evidence presented, the conduct of any party, and any other objection to the proceeding shall be noted on the record by the officer. Evidence objected to shall be taken subject to a ruling on the objection.

(5) When the testimony has been transcribed, the witness shall read and sign (in the form of an affidavit) a transcript of the deposition unless:

(i) The parties otherwise agree in writing,

(ii) The parties waive reading and signature by the witness on the record at the deposition, or

(iii) The witness refuses to read or sign the transcript of the deposition.

(6) The officer shall prepare a certified transcript by attaching to the transcript of the deposition a certificate in the form of an affidavit signed and sealed by the officer. Unless the parties waive any of the following requirements, in which case the certificate shall so state, the certificate must state:

(i) The witness was duly sworn by the officer before commencement of testimony by the witness;

(ii) The transcript is a true record of the testimony given by the witness;

(iii) The name of the person who recorded the testimony and, if the officer did not record it, whether the testimony was recorded in the presence of the officer;

(iv) The presence or absence of any opponent;

(v) The place where the deposition was taken and the day and hour when the deposition began and ended;

(vi) The officer has no disqualifying interest, personal or financial, in a party; and

(vii) If a witness refuses to read or sign the transcript, the circumstances under which the witness refused.

(7) The officer must promptly provide a copy of the transcript to all parties. The proponent of the testimony must file the original as an exhibit.

(8) Any objection to the content, form, or manner of taking the deposition, including the qualifications of the officer, is waived unless made on the record during the deposition and preserved in a timely filed miscellaneous motion to exclude.

(f) *Costs.* Except as the Board may order or the parties may agree in writing, the proponent of the testimony shall bear all costs associated with the testimony, including the reasonable costs associated with making the witness available for the cross-examination.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.158 Expert testimony; tests and data.

(a) Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight. Testimony on United States patent law will not be admitted.

(b) If a party relies on a technical test or data from such a test, the party must provide an affidavit explaining:

(1) Why the test or data is being used,

(2) How the test was performed and the data was generated,

(3) How the data is used to determine a value,

(4) How the test is regarded in the relevant art, and

(5) Any other information necessary for the Board to evaluate the test and data.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

Subpart E — Patent Interferences

§ 41.200 Procedure; pendency.

(a) A patent interference is a contested case subject to the procedures set forth in subpart D of this part.

(b) Any reference to 35 U.S.C. 102 or 135 in this subpart refers to the statute in effect on March 15, 2013, unless otherwise expressly indicated. Any reference to 35 U.S.C. 141 or 146 in this subpart

refers to the statute applicable to the involved application or patent.

(c) Patent interferences shall be administered such that pendency before the Board is normally no more than two years.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (b) removed and reserved, 75 FR 19958, Apr. 15, 2010, effective Apr. 15, 2010; para. (b) added, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 41.201 Definitions.

In addition to the definitions in §§ 41.2 and 41.100, the following definitions apply to proceedings under this subpart:

Accord benefit means Board recognition that a patent application provides a proper constructive reduction to practice under 35 U.S.C. 102(g)(1).

Constructive reduction to practice means a described and enabled anticipation under 35 U.S.C. 102(g)(1), in a patent application of the subject matter of a count. Earliest constructive reduction to practice means the first constructive reduction to practice that has been continuously disclosed through a chain of patent applications including in the involved application or patent. For the chain to be continuous, each subsequent application must comply with the requirements of 35 U.S.C. 119–121, 365, or 386.

Count means the Board's description of the interfering subject matter that sets the scope of admissible proofs on priority. Where there is more than one count, each count must describe a patentably distinct invention.

Involved claim means, for the purposes of 35 U.S.C. 135(a), a claim that has been designated as corresponding to the count.

Senior party means the party entitled to the presumption under § 41.207(a)(1) that it is the prior inventor. Any other party is a *junior party.*

Threshold issue means an issue that, if resolved in favor of the movant, would deprive the opponent of standing in the interference. Threshold issues may include:

(1) No interference-in-fact, and

(2) In the case of an involved application claim first made after the publication of the movant's application or issuance of the movant's patent:

(i) Repose under 35 U.S.C. 135(b) in view of the movant's patent or published application, or

(ii) Unpatentability for lack of written description under 35 U.S.C. 112 of an involved application claim where the applicant suggested, or could have suggested, an interference under § 41.202(a).

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (2)(ii) of the definition of "Threshold issue" revised, 77 FR 46615, Aug. 6, 2012, effective Sept. 16, 2012; definition of "Constructive reduction to practice" and para. (2)(ii) of the definition of "Threshold issue" revised, 80 FR 17918, Apr. 2, 2015, effective May 13, 2015]

§ 41.202 Suggesting an interference.

(a) *Applicant.* An applicant, including a reissue applicant, may suggest an interference with another application or a patent. The suggestion must:

(1) Provide sufficient information to identify the application or patent with which the applicant seeks an interference,

(2) Identify all claims the applicant believes interfere, propose one or more counts, and show how the claims correspond to one or more counts,

(3) For each count, provide a claim chart comparing at least one claim of each party corresponding to the count and show why the claims interfere within the meaning of § 41.203(a),

(4) Explain in detail why the applicant will prevail on priority,

(5) If a claim has been added or amended to provoke an interference, provide a claim chart showing the written description for each claim in the applicant's specification, and

(6) For each constructive reduction to practice for which the applicant wishes to be accorded benefit, provide a chart showing where the disclosure provides a constructive reduction to practice within the scope of the interfering subject matter.

(b) *Patentee.* A patentee cannot suggest an interference under this section but may, to the extent permitted under § 1.291 of this title, alert the examiner of an application claiming interfering subject matter to the possibility of an interference.

(c) *Examiner.* An examiner may require an applicant to add a claim to provoke an interference. Failure to satisfy the requirement within a period (not less than one month) the examiner sets will operate as a concession of priority for the subject matter of the claim. If the interference would be with a patent, the applicant must also comply with paragraphs (a)(2) through (a)(6) of this section. The claim the examiner proposes to have added must, apart from the question of priority under 35 U.S.C. 102(g):

(1) Be patentable to the applicant, and

(2) Be drawn to patentable subject matter claimed by another applicant or patentee.

(d) *Requirement to show priority under 35 U.S.C. 102(g).*(1) When an applicant has an earliest constructive reduction to practice that is later than the apparent earliest constructive reduction to practice for a patent or published application claiming interfering subject matter, the applicant must show why it would prevail on priority.

(2) If an applicant fails to show priority under paragraph (d)(1) of this section, an administrative patent judge may nevertheless declare an interference to place the applicant under an order to show cause why judgment should not be entered against the applicant on priority. New evidence in support of priority will not be admitted except on a showing of good cause. The Board may authorize the filing of motions to redefine the interfering subject matter or to change the benefit accorded to the parties.

(e) *Sufficiency of showing.* (1) A showing of priority under this section is not sufficient unless it would, if unrebutted, support a determination of priority in favor of the party making the showing.

(2) When testimony or production necessary to show priority is not available without authorization under § 41.150(c) or § 41.156(a), the showing shall include:

(i) Any necessary interrogatory, request for admission, request for production, or deposition request, and

(ii) A detailed proffer of what the response to the interrogatory or request would be expected to be and an explanation of the relevance of the response to the question of priority.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (b) revised, 77 FR 42150, July 17, 2012, effective Sept. 16, 2012]

§ 41.203 Declaration.

(a) *Interfering subject matter.* An interference exists if the subject matter of a claim of one party would, if prior art, have anticipated or rendered obvious the subject matter of a claim of the opposing party and vice versa.

(b) *Notice of declaration.* An administrative patent judge declares the patent interference on behalf of the Director. A notice declaring an interference identifies:

(1) The interfering subject matter;

(2) The involved applications, patents, and claims;

(3) The accorded benefit for each count; and

(4) The claims corresponding to each count.

(c) *Redeclaration.* An administrative patent judge may redeclare a patent interference on behalf of the Director to change the declaration made under paragraph (b) of this section.

(d) A party may suggest the addition of a patent or application to the interference or the declaration of an additional interference. The suggestion should make the showings required under § 41.202(a) of this part.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.204 Notice of basis for relief.

(a) *Priority statement.* (1) A party may not submit evidence of its priority in addition to its accorded benefit unless it files a statement setting forth all bases on which the party intends to establish its entitlement to judgment on priority.

(2) The priority statement must:

(i) State the date and location of the party's earliest corroborated conception,

(ii) State the date and location of the party's earliest corroborated actual reduction to practice,

(iii) State the earliest corroborated date on which the party's diligence began, and

(iv) Provide a copy of the earliest document upon which the party will rely to show conception.

(3) If a junior party fails to file a priority statement overcoming a senior party's accorded benefit, judgment shall be entered against the junior party absent a showing of good cause.

(b) *Other substantive motions.* The Board may require a party to list the motions it intends to file, including sufficient detail to place the Board and the opponent on notice of the precise relief sought.

(c) *Filing and service.* The Board will set the times for filing and serving statements required under this section.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.205 Settlement agreements.

(a) *Constructive notice; time for filing.* Pursuant to 35 U.S.C. 135(c), an agreement or understanding, including collateral agreements referred to therein, made in connection with or in contemplation of the termination of an interference must be filed prior to the termination of the interference between the parties to the agreement. After a final decision is entered by the Board, an interference is considered terminated when no appeal (35 U.S.C. 141) or other review (35 U.S.C. 146) has been or can be taken or had. If an appeal to the U.S. Court of Appeals for the Federal Circuit (under 35 U.S.C. 141) or a civil action (under 35 U.S.C. 146) has been filed the interference is considered terminated when the appeal or civil action is terminated. A civil action is terminated when the time to appeal the judgment expires. An appeal to the U.S. Court of Appeals for the Federal Circuit, whether from a decision of the Board or a judgment in a civil action, is terminated when the mandate is issued by the Court.

(b) *Untimely filing.* The Chief Administrative Patent Judge may permit the filing of an agreement under paragraph (a) of this section up to six months after termination upon petition and a showing of good cause for the failure to file prior to termination.

(c) *Request to keep separate.* Any party to an agreement under paragraph (a) of this section may request that the agreement be kept separate from the interference file. The request must be filed with or promptly after the agreement is filed.

(d) *Access to agreement.* Any person, other than a representative of a Government agency, may have access to an agreement kept separate under paragraph (c) of this section only upon petition and on a showing of good cause. The agreement will be available to Government agencies on written request.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.206 Common interests in the invention.

An administrative patent judge may decline to declare, or if already declared the Board may issue judgment in, an interference between an application and another application or patent that are commonly owned.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.207 Presumptions.

(a) *Priority*—(1) *Order of invention.* Parties are presumed to have invented interfering subject matter in the order of the dates of their accorded benefit for each count. If two parties are accorded the benefit of the same earliest date of constructive reduction to practice, then neither party is entitled to a presumption of priority with respect to the other such party.

(2) *Evidentiary standard.* Priority may be proved by a preponderance of the evidence except a party must prove priority by clear and convincing evidence if the date of its earliest constructive reduction to practice is after the issue date of an involved patent or the publication date under 35 U.S.C. 122(b) of an involved application or patent.

(b) *Claim correspondence.* (1) For the purposes of determining priority and derivation, all claims of a party corresponding to the count are presumed to stand or fall together. To challenge this presumption, a party must file a timely substantive motion to have a corresponding claim designated as not corresponding to the count. No presumption based

on claim correspondence regarding the grouping of claims exists for other grounds of unpatentability.

(2) A claim corresponds to a count if the subject matter of the count, treated as prior art to the claim, would have anticipated or rendered obvious the subject matter of the claim.

(c) *Cross-applicability of prior art.* When a motion for judgment of unpatentability against an opponent's claim on the basis of prior art is granted, each of the movant's claims corresponding to the same count as the opponent's claim will be presumed to be unpatentable in view of the same prior art unless the movant in its motion rebuts this presumption.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.208 Content of substantive and responsive motions.

The general requirements for motions in contested cases are stated at § 41.121(c).

(a) In an interference, substantive motions must:

(1) Raise a threshold issue,

(2) Seek to change the scope of the definition of the interfering subject matter or the correspondence of claims to the count,

(3) Seek to change the benefit accorded for the count, or

(4) Seek judgment on derivation or on priority.

(b) To be sufficient, a motion must provide a showing, supported with appropriate evidence, such that, if unrebutted, it would justify the relief sought. The burden of proof is on the movant.

(c) *Showing patentability.* (1) A party moving to add or amend a claim must show the claim is patentable.

(2) A party moving to add or amend a count must show the count is patentable over prior art.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

PART 42 — TRIAL PRACTICE BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Subpart A — Trial Practice and Procedure

GENERAL

§ 42.1 Policy.

(a) *Scope.* Part 42 governs proceedings before the Patent Trial and Appeal Board. Sections 1.4,

1.7, 1.14, 1.16, 1.22, 1.23, 1.25, 1.26, 1.32, 1.34, and 1.36 of this chapter also apply to proceedings before the Board, as do other sections of part 1 of this chapter that are incorporated by reference into this part.

(b) *Construction.* This part shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding.

(c) *Decorum.* Every party must act with courtesy and decorum in all proceedings before the Board, including in interactions with other parties.

(d) *Evidentiary standard.* The default evidentiary standard is a preponderance of the evidence.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

§ 42.2 Definitions.

The following definitions apply to this part:

Affidavit means affidavit or declaration under § 1.68 of this chapter. A transcript of an *ex parte* deposition or a declaration under 28 U.S.C. 1746 may be used as an affidavit.

Board means the Patent Trial and Appeal Board. Board means a panel of the Board, or a member or employee acting with the authority of the Board, including:

(1) For petition decisions and interlocutory decisions, a Board member or employee acting with the authority of the Board.

(2) For final written decisions under 35 U.S.C. 135(d), 318(a) , and 328(a), a panel of the Board.

Business day means a day other than a Saturday, Sunday, or Federal holiday within the District of Columbia.

Confidential information means trade secret or other confidential research, development, or commercial information.

Final means final for the purpose of judicial review to the extent available. A decision is final only if it disposes of all necessary issues with regard to the party seeking judicial review, and does not indicate that further action is required.

Hearing means consideration of the trial.

Involved means an application, patent, or claim that is the subject of the proceeding.

Judgment means a final written decision by the Board, or a termination of a proceeding.

Motion means a request for relief other than by petition.

Office means the United States Patent and Trademark Office.

Panel means at least three members of the Board.

Party means at least the petitioner and the patent owner and, in a derivation proceeding, any applicant or assignee of the involved application.

Petition is a request that a trial be instituted.

Petitioner means the party filing a petition requesting that a trial be instituted.

Preliminary Proceeding begins with the filing of a petition for instituting a trial and ends with a written decision as to whether a trial will be instituted.

Proceeding means a trial or preliminary proceeding.

Rehearing means reconsideration.

Trial means a contested case instituted by the Board based upon a petition. A trial begins with a written decision notifying the petitioner and patent owner of the institution of the trial. The term trial specifically includes a derivation proceeding under 35 U.S.C. 135; an *inter partes* review under Chapter 31 of title 35, United States Code; a post-grant review under Chapter 32 of title 35, United States Code; and a transitional business-method review under section 18 of the Leahy-Smith America Invents Act. Patent interferences are administered under part 41 and not under part 42 of this title, and therefore are not trials.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

§ 42.3 Jurisdiction.

(a) The Board may exercise exclusive jurisdiction within the Office over every involved application and patent during the proceeding, as the Board may order.

(b) A petition to institute a trial must be filed with the Board consistent with any time period required by statute.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

§ 42.4 Notice of trial.

(a) *Institution of trial.* The Board institutes the trial on behalf of the Director.

(b) Notice of a trial will be sent to every party to the proceeding. The entry of the notice institutes the trial.

(c) The Board may authorize additional modes of notice, including:

(1) Sending notice to another address associated with the party, or

(2) Publishing the notice in the Official Gazette of the United States Patent and Trademark Office or the **Federal Register**.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

§ 42.5 Conduct of the proceeding.

(a) The Board may determine a proper course of conduct in a proceeding for any situation not specifically covered by this part and may enter non-final orders to administer the proceeding.

(b) The Board may waive or suspend a requirement of parts 1, 41, and 42 and may place conditions on the waiver or suspension.

(c) *Times.*

(1) *Setting times.* The Board may set times by order. Times set by rule are default and may be modified by order. Any modification of times will take any applicable statutory pendency goal into account.

(2) *Extension of time.* A request for an extension of time must be supported by a showing of good cause.

(3) *Late action.* A late action will be excused on a showing of good cause or upon a Board decision that consideration on the merits would be in the interests of justice.

(d) *Ex parte communications.* Communication regarding a specific proceeding with a Board member defined in 35 U.S.C. 6(a) is not permitted unless both parties have an opportunity to be involved in the communication.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

§ 42.6 Filing of documents, including exhibits; service.

(a) *General format requirements.*

(1) Page size must be 81⁄2 inch × 11 inch except in the case of exhibits that require a larger size in order to preserve details of the original.

(2) In documents, including affidavits, created for the proceeding:

(i) Markings must be in black or must otherwise provide an equivalent dark, high-contrast image;

(ii) 14-point, Times New Roman proportional font, with normal spacing, must be used;

(iii) Double spacing must be used except in claim charts, headings, tables indices, signature blocks, and certificates of service. Block quotations may be 1.5 spaced, but must be indented from both the left and the right margins; and

(iv) Margins must be at least 2.5 centimeters (1 inch) on all sides.

(3) *Incorporation by reference; combined documents.* Arguments must not be incorporated by reference from one document into another document. Combined motions, oppositions, replies, or other combined documents are not permitted.

(4) *Signature; identification.* Documents must be signed in accordance with §§ 1.33 and 11.18(a) of this title, and should be identified by the trial number (where known).

(b) *Modes of filing.*

(1) *Electronic filing.* Unless otherwise authorized, submissions are to be made to the Board electronically via the Internet according to the parameters established by the Board and published on the Web site of the Office.

(2)(i) *Filing by means other than electronic filing.* A document filed by means other than electronic filing must:

(A) Be accompanied by a motion requesting acceptance of the submission; and

(B) Identify a date of transmission where a party seeks a filing date other than the date of receipt at the Board.

(ii) Mailed correspondence shall be sent to: Mail Stop PATENT BOARD, Patent Trial and Appeal Board, United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313–1450.

(c) *Exhibits.* Each exhibit must be filed with the first document in which it is cited except as the Board may otherwise order.

(d) *Previously filed paper.* A document already in the record of the proceeding must not be filed again, not even as an exhibit or an appendix, without express Board authorization.

(e) *Service.*

(1) *Electronic or other mode.* Service may be made electronically upon agreement of the parties. Otherwise, service may be by Priority Mail Express® or by means at least as fast and reliable as Priority Mail Express®.

(2) *Simultaneous with filing.* Each document filed with the Board, if not previously served, must be served simultaneously on each opposing party.

(3) *Counsel of record.* If a party is represented by counsel of record in the proceeding, service must be on counsel.

(4) *Certificate of service.*

(i) Each document, other than an exhibit, must include a certificate of service at the end of that document. Any exhibit filed with the document may be included in the certification for the document.

(ii) For an exhibit filed separately, a transmittal letter incorporating the certificate of service must be filed. If more than one exhibit is filed at one time, a single letter should be used for all of the exhibits filed together. The letter must state the name and exhibit number for every exhibit filed with the letter.

(iii) The certificate of service must state:

(A) The date and manner of service; and

(B) The name and address of every person served.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012; para. (e)(1) revised, 79 FR 63036, Oct. 22, 2014, effective Oct. 22, 2014; para. (a)(2)(ii) revised, 80 FR 28561, May 19, 2015, effective May 19, 2015]

§ 42.7 Management of the record.

(a) The Board may expunge any paper directed to a proceeding or filed while an application or patent is under the jurisdiction of the Board that is not authorized under this part or in a Board order or that is filed contrary to a Board order.

(b) The Board may vacate or hold in abeyance any non-Board action directed to a proceeding while an application or patent is under the jurisdiction of the Board unless the action was authorized by the Board.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

§ 42.8 Mandatory notices.

(a) Each notice listed in paragraph (b) of this section must be filed with the Board:

(1) By the petitioner, as part of the petition;

(2) By the patent owner, or applicant in the case of derivation, within 21 days of service of the petition; or

(3) By either party, within 21 days of a change of the information listed in paragraph (b) of this section stated in an earlier paper.

(b) Each of the following notices must be filed:

(1) *Real party-in-interest.* Identify each real party-in-interest for the party.

(2) *Related matters.* Identify any other judicial or administrative matter that would affect, or be affected by, a decision in the proceeding.

(3) *Lead and back-up counsel.* If the party is represented by counsel, then counsel must be identified.

(4) *Service information.* Identify (if applicable):

(i) An electronic mail address;

(ii) A postal mailing address;

(iii) A hand-delivery address, if different than the postal mailing address;

(iv) A telephone number; and

(v) A facsimile number.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

§ 42.9 Action by patent owner.

(a) *Entire interest.* An owner of the entire interest in an involved application or patent may act to the exclusion of the inventor (*see* § 3.71 of this title).

(b) *Part interest.* An owner of a part interest in the subject patent may move to act to the exclusion of an inventor or a co-owner. The motion must show the inability or refusal of an inventor or co-owner to prosecute the proceeding or other cause why it is in the interests of justice to permit the owner of a part interest to act in the trial. In granting the motion, the Board may set conditions on the actions of the parties.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

§ 42.10 Counsel.

(a) If a party is represented by counsel, the party must designate a lead counsel and at least one back-up counsel who can conduct business on behalf of the lead counsel.

(b) A power of attorney must be filed with the designation of counsel, except the patent owner should not file an additional power of attorney if the designated counsel is already counsel of record in the subject patent or application.

(c) The Board may recognize counsel *pro hac vice* during a proceeding upon a showing of good cause, subject to the condition that lead counsel be a registered practitioner and to any other conditions as the Board may impose. For example, where the lead counsel is a registered practitioner, a motion to appear *pro hac vice* by counsel who is not a registered practitioner may be granted upon showing that counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.

(d) A panel of the Board may disqualify counsel for cause after notice and opportunity for hearing. A decision to disqualify is not final for the purposes of judicial review until certified by the Chief Administrative Patent Judge.

(e) Counsel may not withdraw from a proceeding before the Board unless the Board authorizes such withdrawal.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012; para. (a) revised, 80 FR 28561, May 19, 2015, effective May 19, 2015]

§ 42.11 Duty of candor; signing papers; representations to the Board; sanctions.

(a) *Duty of candor.* Parties and individuals involved in the proceeding have a duty of candor and good faith to the Office during the course of a proceeding.

(b) *Signature.* Every petition, response, written motion, and other paper filed in a proceeding must comply with the signature requirements set forth in § 11.18(a) of this chapter. The Board may expunge any unsigned submission unless the omission is promptly corrected after being called to the counsel's or party's attention.

(c) *Representations to the Board.* By presenting to the Board a petition, response, written motion, or other paper—whether by signing, filing, submitting, or later advocating it—an attorney, registered practitioner, or unrepresented party attests to compliance with the certification requirements under § 11.18(b)(2) of this chapter.

(d) *Sanctions*—

(1) *In general.* If, after notice and a reasonable opportunity to respond, the Board determines that paragraph (c) of this section has been violated, the Board may impose an appropriate sanction on any attorney, registered practitioner, or party that violated the rule or is responsible for the violation.

(2) *Motion for sanctions.* A motion for sanctions must be made separately from any other motion and must describe the specific conduct that allegedly violates paragraph (c) of this section. The motion must be authorized by the Board under § 42.20 prior to filing the motion. At least 21 days prior to seeking authorization to file a motion for sanctions, the moving party must serve the other

party with the proposed motion. A motion for sanctions must not be filed or be presented to the Board if the challenged paper, claim, defense, contention, or denial is withdrawn or appropriately corrected within 21 days after service of such motion or within another time the Board sets. If warranted, the Board may award to the prevailing party the reasonable expenses, including attorney's fees, incurred for the motion.

(3) *On the Board's initiative.* On its own, the Board may order an attorney, registered practitioner, or party to show cause why conduct specifically described in the order has not violated paragraph (c) of this section and why a specific sanction authorized by the Board should not be imposed.

(4) *Nature of a sanction.* A sanction imposed under this rule must be limited to what suffices to deter repetition of the conduct or comparable conduct by others similarly situated and should be consistent with § 42.12.

(5) *Requirements for an order.* An order imposing a sanction must describe the sanctioned conduct and explain the basis for the sanction.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012; revised, 81 FR 18750, Apr. 1, 2016, effective May 2, 2016]

§ 42.12 Sanctions.

(a) The Board may impose a sanction against a party for misconduct, including:

(1) Failure to comply with an applicable rule or order in the proceeding;

(2) Advancing a misleading or frivolous argument or request for relief;

(3) Misrepresentation of a fact;

(4) Engaging in dilatory tactics;

(5) Abuse of discovery;

(6) Abuse of process; or

(7) Any other improper use of the proceeding, including actions that harass or cause unnecessary delay or an unnecessary increase in the cost of the proceeding.

(b) Sanctions include entry of one or more of the following:

An order holding facts to have been established in the proceeding;

(2) An order expunging or precluding a party from filing a paper;

(3) An order precluding a party from presenting or contesting a particular issue;

(4) An order precluding a party from requesting, obtaining, or opposing discovery;

(5) An order excluding evidence;

(6) An order providing for compensatory expenses, including attorney fees;

(7) An order requiring terminal disclaimer of patent term; or

(8) Judgment in the trial or dismissal of the petition.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

§ 42.13 Citation of authority.

(a) For any United States Supreme Court decision, citation to the United States Reports is preferred.

(b) For any decision other than a United States Supreme Court decision, citation to the West Reporter System is preferred.

(c) Citations to authority must include pinpoint citations whenever a specific holding or portion of an authority is invoked.

(d) Non-binding authority should be used sparingly. If the authority is not an authority of the Office and is not reproduced in the United States Reports or the West Reporter System, a copy of the authority should be provided.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

§ 42.14 Public availability.

The record of a proceeding, including documents and things, shall be made available to the public, except as otherwise ordered. A party intending a document or thing to be sealed shall file a motion to seal concurrent with the filing of the document or thing to be sealed. The document or thing shall be provisionally sealed on receipt of the motion and

remain so pending the outcome of the decision on the motion.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

FEES

§ 42.15 Fees.

(a) On filing a petition for *inter partes* review of a patent, payment of the following fees are due:

(1) *Inter Partes* Review request fee:.....$19,000.00

(2) *Inter Partes* Review Post-Institution fee:.....$22,500.00

(3) In addition to the *Inter Partes* Review request fee, for requesting review of each claim in excess of 20:.....$375.00

(4) In addition to the *Inter Partes* Post-Institution request fee, for requesting a review of each claim in excess of 20:.....$750.00

(b) On filing a petition for post-grant review or covered business method patent review of a patent, payment of the following fees are due:

(1) Post-Grant or Covered Business Method Patent Review request fee:.....$20,000.00

(2) Post-Grant or Covered Business Method Patent Review Post-Institution fee:.....$27,500.00

(3) In addition to the Post-Grant or Covered Business Method Patent Review request fee, for requesting review of each claim in excess of 20:.....$475.00

(4) In addition to the Post-Grant or Covered Business Method Patent Review Post-Institution fee, for requesting review of each claim in excess of 20:.....$1,050.00

(c) On the filing of a petition for a derivation proceeding, payment of the following fee is due:

(1) Derivation petition fee:.....$420.00.

(2) [Reserved]

(d) Any request requiring payment of a fee under this part, including a written request to make a settlement agreement available:.....$420.00.

(e) Fee for non-registered practitioners to appear *pro hac vice* before the Patent Trial and Appeal Board: .....$250.00.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012; revised, 78 FR 4212, Jan. 18, 2013, effective Mar. 19, 2013; paras. (a)(3), (a)(4), (b)(3), and (b)(4) revised, 80 FR 28561, May 19, 2015, effective May 19, 2015; paras. (a) and (b) revised, 82 FR 52780, Nov. 14, 2017, effective Jan. 16, 2018; revised, 85 FR 46932, Aug. 3, 2020, effective Oct. 2, 2020]

PETITION AND MOTION PRACTICE

§ 42.20 Generally.

(a) *Relief.* Relief, other than a petition requesting the institution of a trial, must be requested in the form of a motion.

(b) *Prior authorization.* A motion will not be entered without Board authorization. Authorization may be provided in an order of general applicability or during the proceeding.

(c) *Burden of proof.* The moving party has the burden of proof to establish that it is entitled to the requested relief.

(d) *Briefing.* The Board may order briefing on any issue involved in the trial.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

§ 42.21 Notice of basis for relief.

(a) *Notice of request for relief.* The Board may require a party to file a notice stating the relief it requests and the basis for its entitlement to relief. A notice must include sufficient detail to place the Board and each opponent on notice of the precise relief requested. A notice is not evidence except as an admission by a party-opponent.

(b) *Filing and service.* The Board may set the times and conditions for filing and serving notices required under this section. The Board may provide for the notice filed with the Board to be maintained in confidence for a limited time.

(c) *Effect.* If a notice under paragraph (a) of this section is required:

(1) A failure to state a sufficient basis for relief may result in a denial of the relief requested;

(2) A party will be limited to filing motions consistent with the notice; and

(3) Ambiguities in the notice will be construed against the party.

(d) *Correction.* A party may move to correct its notice. The motion should be filed promptly after the party becomes aware of the basis for the correction. A correction filed after the time set for filing notices will only be entered if entry would serve the interests of justice.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

§ 42.22 Content of petitions and motions.

(a) Each petition or motion must be filed as a separate paper and must include:

(1) A statement of the precise relief requested; and

(2) A full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence including material facts, and the governing law, rules, and precedent.

(b) *Relief requested.* Where a rule in part 1 of this title ordinarily governs the relief sought, the petition or motion must make any showings required under that rule in addition to any showings required in this part.

(c) *Statement of material facts.* Each petition or motion may include a statement of material fact. Each material fact preferably shall be set forth as a separately numbered sentence with specific citations to the portions of the record that support the fact.

(d) The Board may order additional showings or explanations as a condition for authorizing a motion (*see* § 42.20(b)).

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

§ 42.23 Oppositions, replies, and sur-replies.

(a) Oppositions, replies, and sur-replies must comply with the content requirements for motions and, if the paper to which the opposition, reply, or sur-reply is responding contains a statement of material fact, must include a listing of facts that are admitted, denied, or cannot be admitted or denied. Any material fact not specifically denied may be considered admitted.

(b) All arguments for the relief requested in a motion must be made in the motion. A reply may only respond to arguments raised in the corresponding opposition, patent owner preliminary response, patent owner response, or decision on institution. A sur-reply may only respond to arguments raised in the corresponding reply and may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012; para. (a) first sentence revised, 80 FR 28561, May 19, 2015, effective May 19, 2015; para. (b) revised, 81 FR 18750, Apr. 1, 2016, effective May 2, 2016; revised, 85 FR 79120, Dec. 9, 2020, effective Jan. 8, 2021]

§ 42.24 Type-volume or page limits for petitions, motions, oppositions, replies, and sur-replies.

(a) *Petitions and motions.*

(1) The following word counts or page limits for petitions and motions apply and include any statement of material facts to be admitted or denied in support of the petition or motion. The word count or page limit does not include a table of contents, a table of authorities, mandatory notices under § 42.8, a certificate of service or word count, or appendix of exhibits or claim listing.

(i) Petition requesting *inter partes* review: 14,000 words.

(ii) Petition requesting post-grant review: 18,700 words.

(iii) Petition requesting covered business method patent review: 18,700 words.

(iv) Petition requesting derivation proceeding: 14,000 words.

(v) Motions (excluding motions to amend): 15 pages.

(vi) Motions to Amend: 25 pages.

(2) Petitions to institute a trial must comply with the stated word counts but may be accompanied by a motion to waive the word counts. The petitioner must show in the motion how a waiver of the word counts is in the interests of justice and must append

a copy of proposed petition exceeding the word count to the motion. If the motion is not granted, the proposed petition exceeding the word count may be expunged or returned. Any other motion to waive word counts or page limits must be granted in advance of filing a motion, opposition, or reply for which the waiver is necessary.

(b) *Patent owner responses and oppositions.* The word counts or page limits set forth in this paragraph (b) do not include a listing of facts which are admitted, denied, or cannot be admitted or denied.

(1) The word counts for a patent owner preliminary response to petition are the same as the word counts for the petition.

(2) The word counts for a patent owner response to petition are the same as the word counts for the petition.

(3) The page limits for oppositions are the same as those for corresponding motions.

(c) *Replies and sur-replies.* The following word counts or page limits for replies and sur-replies apply and include any statement of facts in support of the reply. The word counts or page limits do not include a table of contents; a table of authorities; a listing of facts that are admitted, denied, or cannot be admitted or denied; a certificate of service or word count; or an appendix of exhibits.

(1) *Replies to patent owner responses to petitions:* 5,600 words.

(2) *Replies to oppositions (excluding replies to oppositions to motions to amend):* 5 pages.

(3) *Replies to oppositions to motions to amend:* 12 pages.

(4) *Sur-replies to replies to patent owner responses to petitions:* 5,600 words.

(d) *Certification.* Any paper whose length is specified by type-volume limits must include a certification stating the number of words in the paper. A party may rely on the word count of the word-processing system used to prepare the paper.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012; para. (a)(1) introductory text, para. (a)(1)(v), para. (c) introductory text first sentence, and paras. (c)(1) and (c)(2) revised and paras. (a)(1)(vi) and (c)(3) added, 80 FR 28561, May 19, 2015, effective May 19, 2015; revised, 81 FR 18750, Apr. 1, 2016, effective May 2, 2016; para. (a)(1) corrected, 81 FR 24702, Apr. 27, 2016, effective May 2, 2016; section heading and para. (c) introductory text revised and para. (c)(4) added, 85 FR 79120, Dec. 9, 2020, effective Jan. 8, 2021]

§ 42.25 Default filing times.

(a) A motion may only be filed according to a schedule set by the Board. The default times for acting are:

(1) An opposition is due one month after service of the motion; and

(2) A reply is due one month after service of the opposition.

(b) A party should seek relief promptly after the need for relief is identified. Delay in seeking relief may justify a denial of relief sought.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

TESTIMONY AND PRODUCTION

§ 42.51 Discovery.

(a) *Mandatory initial disclosures.*

(1) *With agreement.* Parties may agree to mandatory discovery requiring the initial disclosures set forth in the Office Patent Trial Practice Guide.

(i) The parties must submit any agreement reached on initial disclosures by no later than the filing of the patent owner preliminary response or the expiration of the time period for filing such a response. The initial disclosures of the parties shall be filed as exhibits.

(ii) Upon the institution of a trial, parties may automatically take discovery of the information identified in the initial disclosures.

(2) *Without agreement.* Where the parties fail to agree to the mandatory discovery set forth in paragraph (a)(1), a party may seek such discovery by motion.

(b) *Limited discovery.* A party is not entitled to discovery except as provided in paragraph (a) of this section, or as otherwise authorized in this subpart.

(1) *Routine discovery.* Except as the Board may otherwise order:

(i) Unless previously served or otherwise by agreement of the parties, any exhibit cited in a paper or in testimony must be served with the citing paper or testimony.

(ii) Cross examination of affidavit testimony prepared for the proceeding is authorized within such time period as the Board may set.

(iii) Unless previously served, a party must serve relevant information that is inconsistent with a position advanced by the party during the proceeding concurrent with the filing of the documents or things that contains the inconsistency. This requirement does not make discoverable anything otherwise protected by legally recognized privileges such as attorney-client or attorney work product. This requirement extends to inventors, corporate officers, and persons involved in the preparation or filing of the documents or things.

(2) *Additional discovery.*

(i) The parties may agree to additional discovery between themselves. Where the parties fail to agree, a party may move for additional discovery. The moving party must show that such additional discovery is in the interests of justice, except in post-grant reviews where additional discovery is limited to evidence directly related to factual assertions advanced by either party in the proceeding (*see* § 42.224). The Board may specify conditions for such additional discovery.

(ii) When appropriate, a party may obtain production of documents and things during cross examination of an opponent's witness or during authorized compelled testimony under § 42.52.

(c) *Production of documents.* Except as otherwise ordered by the Board, a party producing documents and things shall either provide copies to the opposing party or make the documents and things available for inspection and copying at a reasonable time and location in the United States.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012; para. (b)(1)(ii) revised, 80 FR 28561, May 19, 2015, effective May 19, 2015]

§ 42.52 Compelling testimony and production.

(a) *Authorization required.* A party seeking to compel testimony or production of documents or things must file a motion for authorization. The motion must describe the general relevance of the testimony, document, or thing, and must:

(1) In the case of testimony, identify the witness by name or title; and

(2) In the case of a document or thing, the general nature of the document or thing.

(b) *Outside the United States.* For testimony or production sought outside the United States, the motion must also:

(1) *In the case of testimony.*

(i) Identify the foreign country and explain why the party believes the witness can be compelled to testify in the foreign country, including a description of the procedures that will be used to compel the testimony in the foreign country and an estimate of the time it is expected to take to obtain the testimony; and

(ii) Demonstrate that the party has made reasonable efforts to secure the agreement of the witness to testify in the United States but has been unsuccessful in obtaining the agreement, even though the party has offered to pay the travel expenses of the witness to testify in the United States.

(2) *In the case of production of a document or thing.*

(i) Identify the foreign country and explain why the party believes production of the document or thing can be compelled in the foreign country, including a description of the procedures that will be used to compel production of the document or thing in the foreign country and an estimate of the time it is expected to take to obtain production of the document or thing; and

(ii) Demonstrate that the party has made reasonable efforts to obtain the agreement of the individual or entity having possession, custody, or control of the document or thing to produce the document or thing in the United States but has been unsuccessful in obtaining that agreement, even though the party has offered to pay the expenses of producing the document or thing in the United States.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

§ 42.53 Taking testimony.

(a) *Form.* Uncompelled direct testimony must be submitted in the form of an affidavit. All other testimony, including testimony compelled under 35 U.S.C. 24, must be in the form of a deposition transcript. Parties may agree to video-recorded testimony, but may not submit such testimony without prior authorization of the Board. In addition, the Board may authorize or require live or video-recorded testimony.

(b) *Time and location.*

(1) Uncompelled direct testimony may be taken at any time to support a petition, motion, opposition, or reply; otherwise, testimony may only be taken during a testimony period set by the Board.

(2) Except as the Board otherwise orders, during the testimony period, deposition testimony may be taken at any reasonable time and location within the United States before any disinterested official authorized to administer oaths at that location.

(3) Uncompelled deposition testimony outside the United States may only be taken upon agreement of the parties or as the Board specifically directs.

(c) *Duration.*

(1) Unless stipulated by the parties or ordered by the Board, direct examination, cross-examination, and redirect examination for compelled deposition testimony shall be subject to the following time limits: Seven hours for direct examination, four hours for cross-examination, and two hours for redirect examination.

(2) Unless stipulated by the parties or ordered by the Board, cross-examination, redirect examination, and re-cross examination for uncompelled direct testimony shall be subject to the follow time limits: Seven hours for cross-examination, four hours for redirect examination, and two hours for re-cross examination.

(d) *Notice of deposition.*

(1) Prior to the taking of deposition testimony, all parties to the proceeding must agree on the time and place for taking testimony. If the parties cannot agree, the party seeking the testimony must initiate a conference with the Board to set a time and place.

(2) Cross-examination should ordinarily take place after any supplemental evidence relating to the direct testimony has been filed and more than a week before the filing date for any paper in which the cross-examination testimony is expected to be used. A party requesting cross-examination testimony of more than one witness may choose the order in which the witnesses are to be cross-examined.

(3) In the case of direct deposition testimony, at least three business days prior to the conference in paragraph (d)(1) of this section, or if there is no conference, at least ten days prior to the deposition, the party seeking the direct testimony must serve:

(i) A list and copy of each document under the party's control and on which the party intends to rely; and

(ii) A list of, and proffer of reasonable access to, anything other than a document under the party's control and on which the party intends to rely.

(4) The party seeking the deposition must file a notice of the deposition at least ten business days before a deposition.

(5) *Scope and content—*

(i) For direct deposition testimony, the notice limits the scope of the testimony and must list:

(A) The time and place of the deposition;

(B) The name and address of the witness;

(C) A list of the exhibits to be relied upon during the deposition; and

(D) A general description of the scope and nature of the testimony to be elicited.

(ii) For cross-examination testimony, the scope of the examination is limited to the scope of the direct testimony.

(iii) The notice must list the time and place of the deposition.

(iv) Where an additional party seeks to take direct testimony of a third party witness at the time and place noticed in paragraph (d)(5) of this

section, the additional party must provide a counter notice that lists the exhibits to be relied upon in the deposition and a general description of the scope and nature of the testimony to be elicited.

(6) *Motion to quash*—Objection to a defect in the notice is waived unless the objecting party promptly seeks authorization to file a motion to quash.

(e) *Deposition in a foreign language.* If an interpreter will be used during the deposition, the party calling the witness must initiate a conference with the Board at least five business days before the deposition.

(f) *Manner of taking deposition testimony.*

(1) Before giving deposition testimony, each witness shall be duly sworn according to law by the officer before whom the deposition is to be taken. The officer must be authorized to take testimony under 35 U.S.C. 23.

(2) The testimony shall be taken with any questions and answers recorded in their regular order by the officer, or by some other disinterested person in the presence of the officer, unless the presence of the officer is waived on the record by agreement of all parties.

(3) Any exhibits used during the deposition must be numbered as required by § 42.63(c), and must, if not previously served, be served at the deposition. Exhibits objected to shall be accepted pending a decision on the objection.

(4) All objections made at the time of the deposition to the qualifications of the officer taking the deposition, the manner of taking it, the evidence presented, the conduct of any party, and any other objection to the deposition shall be noted on the record by the officer.

(5) When the testimony has been transcribed, the witness shall read and sign (in the form of an affidavit) a transcript of the deposition unless:

(i) The parties otherwise agree in writing;

(ii) The parties waive reading and signature by the witness on the record at the deposition; or

(iii) The witness refuses to read or sign the transcript of the deposition.

(6) The officer shall prepare a certified transcript by attaching a certificate in the form of an affidavit signed and sealed by the officer to the transcript of the deposition. Unless the parties waive any of the following requirements, in which case the certificate shall so state, the certificate must state:

(i) The witness was duly sworn by the officer before commencement of testimony by the witness;

(ii) The transcript is a true record of the testimony given by the witness;

(iii) The name of the person who recorded the testimony, and if the officer did not record it, whether the testimony was recorded in the presence of the officer;

(iv) The presence or absence of any opponent;

(v) The place where the deposition was taken and the day and hour when the deposition began and ended;

(vi) The officer has no disqualifying interest, personal or financial, in a party; and

(vii) If a witness refuses to read or sign the transcript, the circumstances under which the witness refused.

(7) Except where the parties agree otherwise, the proponent of the testimony must arrange for providing a copy of the transcript to all other parties. The testimony must be filed as an exhibit.

(8) Any objection to the content, form, or manner of taking the deposition, including the qualifications of the officer, is waived unless made on the record during the deposition and preserved in a timely filed motion to exclude.

(g) *Costs.* Except as the Board may order or the parties may agree in writing, the proponent of the direct testimony shall bear all costs associated with the testimony, including the reasonable costs associated with making the witness available for the cross-examination.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012; paras. (c)(2) and (f)(7) revised, 80 FR 28561, May 19, 2015, effective May 19, 2015]

§ 42.54 Protective order.

(a) A party may file a motion to seal where the motion to seal contains a proposed protective order, such as the default protective order set forth in the Office Patent Trial Practice Guide. The motion must include a certification that the moving party has in good faith conferred or attempted to confer with other affected parties in an effort to resolve the dispute. The Board may, for good cause, issue an order to protect a party or person from disclosing confidential information, including, but not limited to, one or more of the following:

(1) Forbidding the disclosure or discovery;

(2) Specifying terms, including time and place, for the disclosure or discovery;

(3) Prescribing a discovery method other than the one selected by the party seeking discovery;

(4) Forbidding inquiry into certain matters, or limiting the scope of disclosure or discovery to certain matters;

(5) Designating the persons who may be present while the discovery is conducted;

(6) Requiring that a deposition be sealed and opened only by order of the Board;

(7) Requiring that a trade secret or other confidential research, development, or commercial information not be revealed or be revealed only in a specified way; and

(8) Requiring that the parties simultaneously file specified documents or information in sealed envelopes, to be opened as the Board directs.

(b) [Reserved].

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

§ 42.55 Confidential information in a petition.

A petitioner filing confidential information with a petition may, concurrent with the filing of the petition, file a motion to seal with a proposed protective order as to the confidential information. The institution of the requested trial will constitute a grant of the motion to seal unless otherwise ordered by the Board.

(a) *Default protective order.* Where a motion to seal requests entry of the default protective order set forth in the Office Patent Trial Practice Guide, the petitioner must file, but need not serve, the confidential information under seal. The patent owner may only access the filed sealed information prior to the institution of the trial by agreeing to the terms of the default protective order or obtaining relief from the Board.

(b) *Protective orders other than default protective order.* Where a motion to seal requests entry of a protective order other than the default protective order, the petitioner must file, but need not serve, the confidential information under seal. The patent owner may only access the sealed confidential information prior to the institution of the trial by:

(1) agreeing to the terms of the protective order requested by the petitioner;

(2) agreeing to the terms of a protective order that the parties file jointly; or

(3) obtaining entry of a protective order (*e.g.*, the default protective order).

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

§ 42.56 Expungement of confidential information.

After denial of a petition to institute a trial or after final judgment in a trial, a party may file a motion to expunge confidential information from the record.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

§ 42.57 Privilege for patent practitioners.

(a) *Privileged communications.* A communication between a client and a USPTO patent practitioner or a foreign jurisdiction patent practitioner that is reasonably necessary and incident to the scope of the practitioner's authority shall receive the same protections of privilege under Federal law as if that communication were between a client and an attorney authorized to practice in the United States, including all limitations and exceptions.

(b) *Definitions.* The term "USPTO patent practitioner" means a person who has fulfilled the requirements to practice patent matters before the United States Patent and Trademark Office under § 11.7 of this chapter. "Foreign jurisdiction patent practitioner" means a person who is authorized to provide legal advice on patent matters in a foreign jurisdiction, provided that the jurisdiction establishes professional qualifications and the practitioner satisfies them. For foreign jurisdiction practitioners, this rule applies regardless of whether that jurisdiction provides privilege or an equivalent under its laws.

(c) *Scope of coverage.* USPTO patent practitioners and foreign jurisdiction patent practitioners shall receive the same treatment as attorneys on all issues affecting privilege or waiver, such as communications with employees or assistants of the practitioner and communications between multiple practitioners.

[Added, 82 FR 51570, Nov. 7, 2017, effective Dec. 7, 2017]

§ 42.61 Admissibility.

(a) Evidence that is not taken, sought, or filed in accordance with this subpart is not admissible.

(b) *Records of the Office.* Certification is not necessary as a condition to admissibility when the evidence to be submitted is a record of the Office to which all parties have access.

(c) *Specification and drawings.* A specification or drawing of a United States patent application or patent is admissible as evidence only to prove what the specification or drawing describes. If there is data in the specification or a drawing upon which a party intends to rely to prove the truth of the data, an affidavit by an individual having first-hand knowledge of how the data was generated must be filed.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

§ 42.62 Applicability of the Federal rules of evidence.

(a) *Generally.* Except as otherwise provided in this subpart, the Federal Rules of Evidence shall apply to a proceeding.

(b) *Exclusions.* Those portions of the Federal Rules of Evidence relating to criminal proceedings, juries, and other matters not relevant to proceedings under this subpart shall not apply.

(c) *Modifications in terminology.* Unless otherwise clear from context, the following terms of the Federal Rules of Evidence shall be construed as indicated:

Appellate court means United States Court of Appeals for the Federal Circuit.

Civil action, civil proceeding, and *action* mean a proceeding before the Board under part 42.

Courts of the United States, U.S. Magistrate, court, trial court, trier of fact, and *judge* mean Board.

Hearing means, as defined in Federal Rule of Evidence 804(a)(5), the time for taking testimony.

Judicial notice means official notice.

Trial or *hearing* in Federal Rule of Evidence 807 means the time for taking testimony.

(d) In determining foreign law, the Board may consider any relevant material or source, including testimony, whether or not submitted by a party or admissible under the Federal Rules of Evidence.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

§ 42.63 Form of evidence.

(a) *Exhibits required.* Evidence consists of affidavits, transcripts of depositions, documents, and things. All evidence must be filed in the form of an exhibit.

(b) *Translation required.* When a party relies on a document or is required to produce a document in a language other than English, a translation of the document into English and an affidavit attesting to the accuracy of the translation must be filed with the document.

(c) *Exhibit numbering.* Each party's exhibits must be uniquely numbered sequentially in a range the Board specifies. For the petitioner, the range is 1001–1999, and for the patent owner, the range is 2001–2999.

(d) *Exhibit format.* An exhibit must conform with the requirements for papers in § 42.6 and the requirements of this paragraph.

(1) Each exhibit must have an exhibit label.

(i) An exhibit filed with the petition must include the petitioner's name followed by a unique exhibit number.

(ii) For exhibits not filed with the petition, the exhibit label must include the party's name followed by a unique exhibit number, the names of the parties, and the trial number.

(2) When the exhibit is a paper:

(i) Each page must be uniquely numbered in sequence; and

(ii) The exhibit label must be affixed to the lower right corner of the first page of the exhibit without obscuring information on the first page or, if obscuring is unavoidable, affixed to a duplicate first page.

(e) *Exhibit list.* Each party must maintain an exhibit list with the exhibit number and a brief description of each exhibit. If the exhibit is not filed, the exhibit list should note that fact. A current exhibit list must be served whenever evidence is served and the current exhibit list must be filed when filing exhibits.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

§ 42.64 Objection; motion to exclude.

(a) *Deposition evidence.* An objection to the admissibility of deposition evidence must be made during the deposition. Evidence to cure the objection must be provided during the deposition, unless the parties to the deposition stipulate otherwise on the deposition record.

(b) *Other evidence.* For evidence other than deposition evidence:

(1) *Objection.* Any objection to evidence submitted during a preliminary proceeding must be filed within ten business days of the institution of the trial. Once a trial has been instituted, any objection must be filed within five business days of service of evidence to which the objection is directed. The objection must identify the grounds for the objection with sufficient particularity to allow correction in the form of supplemental evidence.

(2) *Supplemental evidence.* The party relying on evidence to which an objection is timely served may respond to the objection by serving supplemental evidence within ten business days of service of the objection.

(c) *Motion to exclude.* A motion to exclude evidence must be filed to preserve any objection. The motion must identify the objections in the record in order and must explain the objections. The motion may be filed without prior authorization from the Board.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012; section heading and first two sentences of para. (b)(1) revised, 80 FR 28561, May 19, 2015, effective May 19, 2015]

§ 42.65 Expert testimony; tests and data.

(a) Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight. Testimony on United States patent law or patent examination practice will not be admitted.

(b) If a party relies on a technical test or data from such a test, the party must provide an affidavit explaining:

(1) Why the test or data is being used;

(2) How the test was performed and the data was generated;

(3) How the data is used to determine a value;

(4) How the test is regarded in the relevant art; and

(5) Any other information necessary for the Board to evaluate the test and data.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

ORAL ARGUMENT, DECISION, AND SETTLEMENT

§ 42.70 Oral argument.

(a) *Request for oral argument.* A party may request oral argument on an issue raised in a paper at a time set by the Board. The request must be filed as a separate paper and must specify the issues to be argued.

(b) Demonstrative exhibits must be served at least seven business days before the oral argument and filed no later than the time of the oral argument.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012; para. (b) revised, 81 FR 18750, Apr. 1, 2016, effective May 2, 2016]

§ 42.71 Decision on petitions or motions.

(a) *Order of consideration.* The Board may take up petitions or motions for decisions in any order, may grant, deny, or dismiss any petition or motion, and may enter any appropriate order.

(b) *Interlocutory decisions.* A decision on a motion without a judgment is not final for the purposes of judicial review. If a decision is not a panel decision, the party may request that a panel rehear the decision. When rehearing a non-panel decision, a panel will review the decision for an abuse of discretion. A panel decision on an issue will govern the trial.

(c) *Petition decisions.* A decision by the Board on whether to institute a trial is final and nonappealable. A party may request rehearing on a decision by the Board on whether to institute a trial pursuant to paragraph (d) of this section. When rehearing a decision on petition, a panel will review the decision for an abuse of discretion.

(d) *Rehearing.* A party dissatisfied with a decision may file a single request for rehearing without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, a reply, or a sur-reply. A request for rehearing does not toll times for taking action. Any request must be filed:

(1) Within 14 days of the entry of a non-final decision or a decision to institute a trial as to at least one ground of unpatentability asserted in the petition; or

(2) Within 30 days of the entry of a final decision or a decision not to institute a trial.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012; para. (d) first sentence revised, 80 FR 28561, May 19, 2015, effective May 19, 2015; third sentence of para. (d) introductory text revised, 85 FR 79120, Dec. 9, 2020, effective Jan. 8, 2021]

§ 42.72 Termination of trial.

The Board may terminate a trial without rendering a final written decision, where appropriate, including where the trial is consolidated with another proceeding or pursuant to a joint request under 35 U.S.C. 317(a) or 327(a).

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

§ 42.73 Judgment.

(a) A judgment, except in the case of a termination, disposes of all issues that were, or by motion reasonably could have been, raised and decided.

(b) *Request for adverse judgment.* A party may request judgment against itself at any time during a proceeding. Actions construed to be a request for adverse judgment include:

(1) Disclaimer of the involved application or patent;

(2) Cancellation or disclaimer of a claim such that the party has no remaining claim in the trial;

(3) Concession of unpatentability or derivation of the contested subject matter; and

(4) Abandonment of the contest.

(c) *Recommendation.* The judgment may include a recommendation for further action by an examiner or by the Director.

(d) *Estoppel.*

(1) *Petitioner other than in derivation proceeding.* A petitioner, or the real party in interest or privy of the petitioner, is estopped in the Office from requesting or maintaining a proceeding with respect to a claim for which it has obtained a final written decision on patentability in an *inter partes* review, post-grant review, or a covered business method patent review, on any ground that the petitioner raised or reasonably could have raised during the trial, except that estoppel shall not apply to a petitioner, or to the real party in interest or privy

of the petitioner who has settled under 35 U.S.C. 317 or 327.

(2) *In a derivation*, the losing party who could have properly moved for relief on an issue, but did not so move, may not take action in the Office after the judgment that is inconsistent with that party's failure to move, except that a losing party shall not be estopped with respect to any contested subject matter for which that party was awarded a favorable judgment.

(3) *Patent applicant or owner.* A patent applicant or owner is precluded from taking action inconsistent with the adverse judgment, including obtaining in any patent:

(i) A claim that is not patentably distinct from a finally refused or canceled claim; or

(ii) An amendment of a specification or of a drawing that was denied during the trial proceeding, but this provision does not apply to an application or patent that has a different written description.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

§ 42.74 Settlement.

(a) *Board role.* The parties may agree to settle any issue in a proceeding, but the Board is not a party to the settlement and may independently determine any question of jurisdiction, patentability, or Office practice.

(b) *Agreements in writing.* Any agreement or understanding between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and a true copy shall be filed with the Board before the termination of the trial.

(c) *Request to keep separate.* A party to a settlement may request that the settlement be treated as business confidential information and be kept separate from the files of an involved patent or application. The request must be filed with the settlement. If a timely request is filed, the settlement shall only be available:

(1) To a Government agency on written request to the Board; or

(2) To any other person upon written request to the Board to make the settlement agreement available, along with the fee specified in § 42.15(d) and on a showing of good cause.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

CERTIFICATE

§ 42.80 Certificate.

After the Board issues a final written decision in an *inter partes* review, post-grant review, or covered business method patent review and the time for appeal has expired or any appeal has terminated, the Office will issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable, confirming any claim of the patent determined to be patentable, and incorporating in the patent any new or amended claim determined to be patentable by operation of the certificate.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

Subpart B — *Inter Partes* Review

GENERAL

§ 42.100 Procedure; pendency.

(a) An *inter partes* review is a trial subject to the procedures set forth in subpart A of this part.

(b) In an *inter partes* review proceeding, a claim of a patent, or a claim proposed in a motion to amend under § 42.121, shall be construed using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent. Any prior claim construction determination concerning a term of the claim in a civil action, or a proceeding before the International Trade Commission, that is timely made of record in the *inter partes* review proceeding will be considered.

(c) An *inter partes* review proceeding shall be administered such that pendency before the Board after institution is normally no more than one year.

The time can be extended by up to six months for good cause by the Chief Administrative Patent Judge, or adjusted by the Board in the case of joinder.

[Added, 77 FR 48680, Aug. 14, 2012, effective Sept. 16, 2012; para. (b) revised, 81 FR 18750, Apr. 1, 2016, effective May 2, 2016; para. (b) revised, 83 FR 51340, Oct. 11, 2018, effective Nov. 13, 2018]

§ 42.101 Who may petition for *inter partes* review.

A person who is not the owner of a patent may file with the Office a petition to institute an *inter partes* review of the patent unless:

(a) Before the date on which the petition for review is filed, the petitioner or real party-in-interest filed a civil action challenging the validity of a claim of the patent;

(b) The petition requesting the proceeding is filed more than one year after the date on which the petitioner, the petitioner's real party-in-interest, or a privy of the petitioner is served with a complaint alleging infringement of the patent; or

(c) The petitioner, the petitioner's real party-in-interest, or a privy of the petitioner is estopped from challenging the claims on the grounds identified in the petition.

[Added, 77 FR 48680, Aug. 14, 2012, effective Sept. 16, 2012]

§ 42.102 Time for filing.

(a) A petition for *inter partes* review of a patent must be filed after the later of the following dates, where applicable:

(1) If the patent is a patent described in section 3(n)(1) of the Leahy-Smith America Invents Act, the date that is nine months after the date of the grant of the patent;

(2) If the patent is a patent that is not described in section 3(n)(1) of the Leahy-Smith American Invents Act, the date of the grant of the patent; or

(3) If a post-grant review is instituted as set forth in subpart C of this part, the date of the termination of such post-grant review.

(b) [Reserved]

[Added, 77 FR 48680, Aug. 14, 2012, effective Sept. 16, 2012; para. (a) revised, 78 FR 17873, Mar. 25, 2013, effective Mar. 25, 2013; para. (b) removed and reserved, 84 FR 51977, Oct. 1, 2019, effective Oct. 31, 2019]

§ 42.103 *Inter partes* review fee.

(a) An *inter partes* review fee set forth in § 42.15(a) must accompany the petition.

(b) No filing date will be accorded to the petition until full payment is received.

[Added, 77 FR 48680, Aug. 14, 2012, effective Sept. 16, 2012]

§ 42.104 Content of petition.

In addition to the requirements of §§ 42.6, 42.8, 42.22, and 42.24, the petition must set forth:

(a) *Grounds for standing.* The petitioner must certify that the patent for which review is sought is available for *inter partes* review and that the petitioner is not barred or estopped from requesting an *inter partes* review challenging the patent claims on the grounds identified in the petition.

(b) *Identification of challenge.* Provide a statement of the precise relief requested for each claim challenged. The statement must identify the following:

(1) The claim;

(2) The specific statutory grounds under 35 U.S.C. 102 or 103 on which the challenge to the claim is based and the patents or printed publications relied upon for each ground;

(3) How the challenged claim is to be construed. Where the claim to be construed contains a means-plus-function or step-plus-function limitation as permitted under 35 U.S.C. 112(f), the construction of the claim must identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function;

(4) How the construed claim is unpatentable under the statutory grounds identified in paragraph (b)(2) of this section. The petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon; and

(5) The exhibit number of the supporting evidence relied upon to support the challenge and the relevance of the evidence to the challenge raised, including identifying specific portions of the evidence that support the challenge. The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge.

(c) A motion may be filed that seeks to correct a clerical or typographical mistake in the petition. The grant of such a motion does not change the filing date of the petition.

[Added, 77 FR 48680, Aug. 14, 2012, effective Sept. 16, 2012]

§ 42.105 Service of petition.

In addition to the requirements of § 42.6, the petitioner must serve the petition and exhibits relied upon in the petition as follows:

(a) The petition and supporting evidence must be served on the patent owner at the correspondence address of record for the subject patent. The petitioner may additionally serve the petition and supporting evidence on the patent owner at any other address known to the petitioner as likely to effect service.

(b) Upon agreement of the parties, service may be made electronically. Service may be by Priority Mail Express® or by means at least as fast and reliable as Priority Mail Express®. Personal service is not required.

[Added, 77 FR 48680, Aug. 14, 2012, effective Sept. 16, 2012; para. (b) revised, 79 FR 63036, Oct. 22, 2014, effective Oct. 22, 2014;]

§ 42.106 Filing date.

(a) *Complete petition.* A petition to institute *inter partes* review will not be accorded a filing date until the petition satisfies all of the following requirements:

(1) Complies with § 42.104;

(2) Effects service of the petition on the correspondence address of record as provided in § 42.105(a); and

(3) Is accompanied by the fee to institute required in § 42.15(a).

(b) *Incomplete petition.* Where a party files an incomplete petition, no filing date will be accorded, and the Office will dismiss the petition if the deficiency in the petition is not corrected within one month from the notice of an incomplete petition.

[Added, 77 FR 48680, Aug. 14, 2012, effective Sept. 16, 2012]

§ 42.107 Preliminary response to petition.

(a) The patent owner may file a preliminary response to the petition. The response is limited to setting forth the reasons why no *inter partes* review should be instituted under 35 U.S.C. 314 and can include supporting evidence. The preliminary response is subject to the word count under § 42.24.

(b) *Due date.* The preliminary response must be filed no later than three months after the date of a notice indicating that the request to institute an *inter partes* review has been granted a filing date. A patent owner may expedite the proceeding by filing an election to waive the patent owner preliminary response.

(c) [Reserved]

(d) *No amendment.* The preliminary response shall not include any amendment.

(e) *Disclaim Patent Claims.* The patent owner may file a statutory disclaimer under 35 U.S.C. 253(a) in compliance with § 1.321(a) of this chapter, disclaiming one or more claims in the patent. No *inter partes* review will be instituted based on disclaimed claims.

[Added, 77 FR 48680, Aug. 14, 2012, effective Sept. 16, 2012; para. (a) revised and para. (c) removed and reserved, 81 FR 18750, Apr. 1, 2016, effective May 2, 2016]

INSTITUTING *INTER PARTES* REVIEW

§ 42.108 Institution of *inter partes* review.

(a) When instituting *inter partes* review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.

(b) At any time prior to a decision on institution of *inter partes* review, the Board may deny all grounds for unpatentability for all of the challenged claims. Denial of all grounds is a Board decision not to institute *inter partes* review.

(c) *Inter partes* review shall not be instituted unless the Board decides that the information presented in the petition demonstrates that there is a reasonable likelihood that at least one of the claims challenged in the petition is unpatentable. The Board's decision will take into account a patent owner preliminary response where such a response is filed, including any testimonial evidence. A petitioner may seek leave to file a reply to the preliminary response in accordance with §§ 42.23 and 42.24(c). Any such request must make a showing of good cause.

[Added, 77 FR 48680, Aug. 14, 2012, effective Sept. 16, 2012; para. (c) revised, 81 FR 18750, Apr. 1, 2016, effective May 2, 2016; revised, 85 FR 79120, Dec. 9, 2020, effective Jan. 8, 2021]

AFTER INSTITUTION OF *INTER PARTES* REVIEW

§ 42.120 Patent owner response.

(a) *Scope.* A patent owner may file a single response to the petition and/or decision on institution. A patent owner response is filed as an opposition and is subject to the page limits provided in § 42.24.

(b) *Due date for response.* If no time for filing a patent owner response to a petition is provided in a Board order, the default date for filing a patent owner response is three months from the date the *inter partes* review was instituted.

[Added, 77 FR 48680, Aug. 14, 2012, effective Sept. 16, 2012; para. (a) revised, 85 FR 79120, Dec. 9, 2020, effective Jan. 8, 2021]

§ 42.121 Amendment of the patent.

(a) *Motion to amend.* A patent owner may file one motion to amend a patent, but only after conferring with the Board.

(1) *Due date.* Unless a due date is provided in a Board order, a motion to amend must be filed no later than the filing of a patent owner response.

(2) *Scope.* A motion to amend may be denied where:

(i) The amendment does not respond to a ground of unpatentability involved in the trial; or

(ii) The amendment seeks to enlarge the scope of the claims of the patent or introduce new subject matter.

(3) *A reasonable number of substitute claims.* A motion to amend may cancel a challenged claim or propose a reasonable number of substitute claims. The presumption is that only one substitute claim would be needed to replace each challenged claim, and it may be rebutted by a demonstration of need.

(b) *Content.* A motion to amend claims must include a claim listing, which claim listing may be contained in an appendix to the motion, show the changes clearly, and set forth:

(1) The support in the original disclosure of the patent for each claim that is added or amended; and

(2) The support in an earlier-filed disclosure for each claim for which benefit of the filing date of the earlier filed disclosure is sought.

(c) *Additional motion to amend.* In addition to the requirements set forth in paragraphs (a) and (b) of this section, any additional motion to amend may not be filed without Board authorization. An additional motion to amend may be authorized when there is a good cause showing or a joint request of the petitioner and the patent owner to materially advance a settlement. In determining whether to authorize such an additional motion to amend, the Board will consider whether a petitioner has submitted supplemental information after the time period set for filing a motion to amend in paragraph (a)(1) of this section.

(d) *Burden of Persuasion.* On a motion to amend:

(1) A patent owner bears the burden of persuasion to show, by a preponderance of the evidence, that the motion to amend complies with the requirements of paragraphs (1) and (3) of 35 U.S.C. 316(d), as well as paragraphs (a)(2), (a)(3), (b)(1), and (b)(2) of this section;

(2) A petitioner bears the burden of persuasion to show, by a preponderance of the

evidence, that any proposed substitute claims are unpatentable; and

(3) Irrespective of paragraphs (d)(1) and (2) of this section, the Board may, in the interests of justice, exercise its discretion to grant or deny a motion to amend only for reasons supported by readily identifiable and persuasive evidence of record. In doing so, the Board may make of record only readily identifiable and persuasive evidence in a related proceeding before the Office or evidence that a district court can judicially notice. Where the Board exercises its discretion under this paragraph, the parties will have an opportunity to respond.

[Added, 77 FR 48680, Aug. 14, 2012, effective Sept. 16, 2012; para. (b) introductory text revised, 80 FR 28561, May 19, 2015, effective May 19, 2015; para. (d) added, 85 FR 82923, Dec. 21, 2020, effective Jan. 20, 2021, corrected to effective Jan. 21, 2021, 86 FR 2542, Jan. 13, 2021, correction withdrawn 86 FR 3815, Jan. 15, 2021]

§ 42.122 Multiple proceedings and Joinder.

(a) *Multiple proceedings.* Where another matter involving the patent is before the Office, the Board may during the pendency of the *inter partes* review enter any appropriate order regarding the additional matter including providing for the stay, transfer, consolidation, or termination of any such matter.

(b) *Request for joinder.* Joinder may be requested by a patent owner or petitioner. Any request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any *inter partes* review for which joinder is requested. The time period set forth in § 42.101(b) shall not apply when the petition is accompanied by a request for joinder.

[Added, 77 FR 48680, Aug. 14, 2012, effective Sept. 16, 2012]

§ 42.123 Filing of supplemental information.

(a) *Motion to submit supplemental information.* Once a trial has been instituted, a party may file a motion to submit supplemental information in accordance with the following requirements:

(1) A request for the authorization to file a motion to submit supplemental information is made within one month of the date the trial is instituted.

(2) The supplemental information must be relevant to a claim for which the trial has been instituted.

(b) *Late submission of supplemental information.* A party seeking to submit supplemental information more than one month after the date the trial is instituted, must request authorization to file a motion to submit the information. The motion to submit supplemental information must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice.

(c) *Other supplemental information.* A party seeking to submit supplemental information not relevant to a claim for which the trial has been instituted must request authorization to file a motion to submit the information. The motion must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice.

[Added, 77 FR 48680, Aug. 14, 2012, effective Sept. 16, 2012]

Subpart C — Post-Grant Review

§ § 42.200 - 42.224 Applicability Note

[Editor Note: Subpart C (Post-Grant Review) generally applies to patents issuing from applications subject to first-inventor-to-file provisions of the AIA. In addition, the Chief Administrative Patent Judge may, in the interests-of-justice, order an interference commenced before September 16, 2012 to be dismissed without prejudice to the filing of a petition for post-grant review. See § 42.200(d) and the Leahy-Smith America Invents Act, Public Law 112-29, sec. 6(f)(3)(A).]

GENERAL

§ 42.200 Procedure; pendency.

(a) A post-grant review is a trial subject to the procedures set forth in subpart A of this part.

(b) In a post-grant review proceeding, a claim of a patent, or a claim proposed in a motion to amend under § 42.221, shall be construed using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent. Any prior claim construction determination concerning a term of the claim in a civil action, or a proceeding before the International Trade Commission, that is timely made of record in the post-grant review proceeding will be considered.

(c) A post-grant review proceeding shall be administered such that pendency before the Board after institution is normally no more than one year. The time can be extended by up to six months for good cause by the Chief Administrative Patent Judge, or adjusted by the Board in the case of joinder.

(d) Interferences commenced before September 16, 2012, shall proceed under part 41 of this chapter except as the Chief Administrative Patent Judge, acting on behalf of the Director, may otherwise order in the interests-of-justice.

[Added, 77 FR 48680, Aug. 14, 2012, effective Sept. 16, 2012; para. (b) revised, 81 FR 18750, Apr. 1, 2016, effective May 2, 2016; para. (b) revised, 83 FR 51340, Oct. 11, 2018, effective Nov. 13, 2018]

[See §§ 42.200 - 42.224 Applicability Note]

§ 42.201 Who may petition for a post-grant review.

A person who is not the owner of a patent may file with the Office a petition to institute a post-grant review of the patent unless:

(a) Before the date on which the petition for review is filed, the petitioner or real party-in-interest filed a civil action challenging the validity of a claim of the patent; or

(b) The petitioner, the petitioner's real party-in-interest, or a privy of the petitioner is estopped from challenging the claims on the grounds identified in the petition.

[Added, 77 FR 48680, Aug. 14, 2012, effective Sept. 16, 2012]

[See §§ 42.200 - 42.224 Applicability Note]

§ 42.202 Time for filing.

(a) A petition for a post-grant review of a patent must be filed no later than the date that is nine months after the date of the grant of a patent or of the issuance of a reissue patent. A petition, however, may not request a post-grant review for a claim in a reissue patent that is identical to or narrower than a claim in the original patent from which the reissue patent was issued unless the petition is filed not later than the date that is nine months after the date of the grant of the original patent.

(b) [Reserved]

[Added, 77 FR 48680, Aug. 14, 2012, effective Sept. 16, 2012; para. (b) removed and reserved, 84 FR 51977, Oct. 1, 2019, effective Oct. 31, 2019]

[See §§ 42.200 - 42.224 Applicability Note]

§ 42.203 Post-grant review fee.

(a) A post-grant review fee set forth in § 42.15(b) must accompany the petition.

(b) No filing date will be accorded to the petition until full payment is received.

[Added, 77 FR 48680, Aug. 14, 2012, effective Sept. 16, 2012]

[See §§ 42.200 - 42.224 Applicability Note]

§ 42.204 Content of petition.

In addition to the requirements of §§ 42.6, 42.8, 42.22, and 42.24, the petition must set forth:

(a) *Grounds for standing.* The petitioner must certify that the patent for which review is sought is available for post-grant review and that the petitioner is not barred or estopped from requesting a post-grant review challenging the patent claims on the grounds identified in the petition.

(b) *Identification of challenge.* Provide a statement of the precise relief requested for each claim challenged. The statement must identify the following:

(1) The claim;

(2) The specific statutory grounds permitted under 35 U.S.C. 282(b)(2) or (3) on which the challenge to the claim is based;

(3) How the challenged claim is to be construed. Where the claim to be construed contains a means-plus-function or step-plus-function limitation as permitted under 35 U.S.C. 112(f), the construction of the claim must identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function;

(4) How the construed claim is unpatentable under the statutory grounds identified in paragraph (b)(2) of this section. Where the grounds for unpatentability are based on prior art, the petition must specify where each element of the claim is found in the prior art. For all other grounds of unpatentability, the petition must identify the specific part of the claim that fails to comply with the statutory grounds raised and state how the identified subject matter fails to comply with the statute; and

(5) The exhibit number of the supporting evidence relied upon to support the challenge and the relevance of the evidence to the challenge raised, including identifying specific portions of the evidence that support the challenge. The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge.

(c) A motion may be filed that seeks to correct a clerical or typographical mistake in the petition. The grant of such a motion does not change the filing date of the petition.

[Added, 77 FR 48680, Aug. 14, 2012, effective Sept. 16, 2012]

[See §§ 42.200 - 42.224 Applicability Note]

§ 42.205 Service of petition.

In addition to the requirements of § 42.6, the petitioner must serve the petition and exhibits relied upon in the petition as follows:

(a) The petition and supporting evidence must be served on the patent owner at the correspondence address of record for the subject patent. The petitioner may additionally serve the petition and supporting evidence on the patent owner at any other address known to the petitioner as likely to effect service.

(b) Upon agreement of the parties, service may be made electronically. Service may be by Priority Mail Express® or by means at least as fast and reliable as Priority Mail Express®. Personal service is not required.

[Added, 77 FR 48680, Aug. 14, 2012, effective Sept. 16, 2012; para. (b) revised, 79 FR 63036, Oct. 22, 2014, effective Oct. 22, 2014;]

[See §§ 42.200 - 42.224 Applicability Note]

§ 42.206 Filing date.

(a) *Complete petition.* A petition to institute a post-grant review will not be accorded a filing date until the petition satisfies all of the following requirements:

(1) Complies with § 42.204 or § 42.304, as the case may be,

(2) Effects service of the petition on the correspondence address of record as provided in § 42.205(a); and

(3) Is accompanied by the filing fee in § 42.15(b).

(b) *Incomplete petition.* Where a party files an incomplete petition, no filing date will be accorded and the Office will dismiss the request if the deficiency in the petition is not corrected within the earlier of either one month from the notice of an incomplete petition, or the expiration of the statutory deadline in which to file a petition for post-grant review.

[Added, 77 FR 48680, Aug. 14, 2012, effective Sept. 16, 2012]

[See §§ 42.200 - 42.224 Applicability Note]

§ 42.207 Preliminary response to petition.

(a) The patent owner may file a preliminary response to the petition. The response is limited to setting forth the reasons why no post-grant review should be instituted under 35 U.S.C. 324 and can include supporting evidence. The preliminary response is subject to the word count under § 42.24.

(b) *Due date.* The preliminary response must be filed no later than three months after the date of a notice indicating that the request to institute a post-grant review has been granted a filing date. A patent owner may expedite the proceeding by filing an election to waive the patent owner preliminary response.

(c) [Reserved]

(d) *No amendment.* The preliminary response shall not include any amendment.

(e) *Disclaim Patent Claims.* The patent owner may file a statutory disclaimer under 35 U.S.C. 253(a) in compliance with § 1.321(a), disclaiming one or more claims in the patent. No post-grant review will be instituted based on disclaimed claims.

[Added, 77 FR 48680, Aug. 14, 2012, effective Sept. 16, 2012; para. (a) revised and para. (c) removed and reserved, 81 FR 18750, Apr. 1, 2016, effective May 2, 2016]

[See §§ 42.200 - 42.224 Applicability Note]

INSTITUTING POST-GRANT REVIEW

§ 42.208 Institution of post-grant review.

(a) When instituting post-grant review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.

(b) At any time prior to institution of post-grant review, the Board may deny all grounds for unpatentability for all of the challenged claims. Denial of all grounds is a Board decision not to institute post-grant review.

(c) Post-grant review shall not be instituted unless the Board decides that the information presented in the petition demonstrates that it is more likely than not that at least one of the claims challenged in the petition is unpatentable. The Board's decision will take into account a patent owner preliminary response where such a response is filed, including any testimonial evidence. A petitioner may seek leave to file a reply to the preliminary response in accordance with §§ 42.23 and 42.24(c). Any such request must make a showing of good cause.

(d) *Additional grounds.* Sufficient grounds under § 42.208(c) may be a showing that the petition raises a novel or unsettled legal question that is important to other patents or patent applications.

[Added, 77 FR 48680, Aug. 14, 2012, effective Sept. 16, 2012; para. (c) revised, 81 FR 18750, Apr. 1, 2016, effective May 2, 2016; paras. (a), (b), and (c) revised, 85 FR 79120, Dec. 9, 2020, effective Jan. 8, 2021]

[See §§ 42.200 - 42.224 Applicability Note]

AFTER INSTITUTION OF POST-GRANT REVIEW

§ 42.220 Patent owner response.

(1) *Scope.* A patent owner may file a single response to the petition and/or decision on institution. A patent owner response is filed as an opposition and is subject to the page limits provided in § 42.24.

(b) *Due date for response.* If no date for filing a patent owner response to a petition is provided in a Board order, the default date for filing a patent owner response is three months from the date the post-grant review is instituted.

[Added, 77 FR 48680, Aug. 14, 2012, effective Sept. 16, 2012; para. (a) revised, 85 FR 79120, Dec. 9, 2020, effective Jan. 8, 2021]

[See §§ 42.200 - 42.224 Applicability Note]

§ 42.221 Amendment of the patent.

(a) *Motion to amend.* A patent owner may file one motion to amend a patent, but only after conferring with the Board.

(1) *Due date.* Unless a due date is provided in a Board order, a motion to amend must be filed no later than the filing of a patent owner response.

(2) *Scope.* A motion to amend may be denied where:

(i) The amendment does not respond to a ground of unpatentability involved in the trial; or

(ii) The amendment seeks to enlarge the scope of the claims of the patent or introduce new subject matter.

(3) *A reasonable number of substitute claims.* A motion to amend may cancel a challenged claim or propose a reasonable number of substitute claims. The presumption is that only one substitute

claim would be needed to replace each challenged claim, and it may be rebutted by a demonstration of need.

(b) *Content*. A motion to amend claims must include a claim listing, which claim listing may be contained in an appendix to the motion, show the changes clearly, and set forth:

(1) The support in the original disclosure of the patent for each claim that is added or amended; and

(2) The support in an earlier-filed disclosure for each claim for which benefit of the filing date of the earlier filed disclosure is sought.

(c) *Additional motion to amend.* In addition to the requirements set forth in paragraphs (a) and (b) of this section, any additional motion to amend may not be filed without Board authorization. An additional motion to amend may be authorized when there is a good cause showing or a joint request of the petitioner and the patent owner to materially advance a settlement. In determining whether to authorize such an additional motion to amend, the Board will consider whether a petitioner has submitted supplemental information after the time period set for filing a motion to amend in paragraph (a)(1) of this section.

(d) *Burden of Persuasion*. On a motion to amend:

(1) A patent owner bears the burden of persuasion to show, by a preponderance of the evidence, that the motion to amend complies with the requirements of paragraphs (1) and (3) of 35 U.S.C. 326(d), as well as paragraphs (a)(2), (a)(3), (b)(1), and (b)(2) of this section;

(2) A petitioner bears the burden of persuasion to show, by a preponderance of the evidence, that any proposed substitute claims are unpatentable; and

(3) Irrespective of paragraphs (d)(1) and (2) of this section, the Board may, in the interests of justice, exercise its discretion to grant or deny a motion to amend only for reasons supported by readily identifiable and persuasive evidence of record. In doing so, the Board may make of record only readily identifiable and persuasive evidence in a related proceeding before the Office or evidence that a district court can judicially notice. Where the Board exercises its discretion under this paragraph, the parties will have an opportunity to respond.

[Added, 77 FR 48680, Aug. 14, 2012, effective Sept. 16, 2012; para. (b) introductory text revised, 80 FR 28561, May 19, 2015, effective May 19, 2015; para. (d) added, 85 FR 82923, Dec. 21, 2020, effective Jan. 20, 2021, corrected to effective Jan. 21, 2021, 86 FR 2542, Jan. 13, 2021, correction withdrawn 86 FR 3815, Jan. 15, 2021]

[See §§ 42.200 - 42.224 Applicability Note]

§ 42.222 Multiple proceedings and Joinder.

(a) *Multiple proceedings.* Where another matter involving the patent is before the Office, the Board may during the pendency of the post-grant review enter any appropriate order regarding the additional matter including providing for the stay, transfer, consolidation, or termination of any such matter.

(b) *Request for joinder.* Joinder may be requested by a patent owner or petitioner. Any request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any post-grant review for which joinder is requested.

[Added, 77 FR 48680, Aug. 14, 2012, effective Sept. 16, 2012]

[See §§ 42.200 - 42.224 Applicability Note]

§ 42.223 Filing of supplemental information.

(a) *Motion to submit supplemental information.* Once a trial has been instituted, a party may file a motion to submit supplemental information in accordance with the following requirements:

(1) A request for the authorization to file a motion to submit supplemental information is made within one month of the date the trial is instituted.

(2) The supplemental information must be relevant to a claim for which the trial has been instituted.

(b) *Late submission of supplemental information.* A party seeking to submit supplemental information more than one month after the date the trial is instituted, must request authorization to file a motion to submit the information. The motion to submit supplemental information must show why the supplemental information reasonably could not have been obtained earlier, and that consideration

of the supplemental information would be in the interests-of-justice.

(c) *Other supplemental information.* A party seeking to submit supplemental information not relevant to a claim for which the trial has been instituted must request authorization to file a motion to submit the information. The motion must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice.

[Added, 77 FR 48680, Aug. 14, 2012, effective Sept. 16, 2012]

[See §§ 42.200 - 42.224 Applicability Note]

§ 42.224 Discovery.

Notwithstanding the discovery provisions of subpart A:

(a) Requests for additional discovery may be granted upon a showing of good cause as to why the discovery is needed; and

(b) Discovery is limited to evidence directly related to factual assertions advanced by either party in the proceeding.

[Added, 77 FR 48680, Aug. 14, 2012, effective Sept. 16, 2012]

[See §§ 42.200 - 42.224 Applicability Note]

Subpart D — Transitional Program for Covered Business Method Patents

§ 42.300 Procedure; pendency.

(a) A covered business method patent review is a trial subject to the procedures set forth in subpart A of this part and is also subject to the post-grant review procedures set forth in subpart C except for §§ 42.200, 42.201, 42.202, and 42.204.

(b) In a covered business method patent review proceeding, a claim of a patent, or a claim proposed in a motion to amend under § 42.221, shall be construed using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent. Any prior claim construction determination concerning a term of the claim in a civil action, or a proceeding before the International Trade Commission, that is timely made of record in the covered business method patent review proceeding will be considered.

(c) A covered business method patent review proceeding shall be administered such that pendency before the Board after institution is normally no more than one year. The time can be extended by up to six months for good cause by the Chief Administrative Patent Judge, or adjusted by the Board in the case of joinder.

(d) The rules in this subpart are applicable until September 15, 2020, except that the rules shall continue to apply to any petition for a covered business method patent review filed before the date of repeal.

[Added, 77 FR 48680, Aug. 14, 2012, effective Sept. 16, 2012; para. (c) revised, 80 FR 28561, May 19, 2015, effective May 19, 2015; para. (b) revised, 81 FR 18750, Apr. 1, 2016, effective May 2, 2016; para. (b) revised, 83 FR 51340, Oct. 11, 2018, effective Nov. 13, 2018]

§ 42.301 Definitions.

In addition to the definitions in § 42.2, the following definitions apply to proceedings under this subpart D:

(a) *Covered business method patent* means a patent that claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions.

(b) *Technological invention.* In determining whether a patent is for a technological invention solely for purposes of the Transitional Program for Covered Business Methods (section 42.301(a)), the following will be considered on a case-by-case basis: whether the claimed subject matter as a whole recites a technological feature that is novel and unobvious over the prior art; and solves a technical problem using a technical solution.

[Added, 77 FR 48734, Aug. 14, 2012, effective Sept. 16, 2012]

§ 42.302 Who may petition for a covered business method patent review.

(a) A petitioner may not file with the Office a petition to institute a covered business method patent review of the patent unless the petitioner, the petitioner's real party-in-interest, or a privy of the petitioner has been sued for infringement of the patent or has been charged with infringement under that patent. Charged with infringement means a real and substantial controversy regarding infringement of a covered business method patent exists such that the petitioner would have standing to bring a declaratory judgment action in Federal court.

(b) A petitioner may not file a petition to institute a covered business method patent review of the patent where the petitioner, the petitioner's real party-in-interest, or a privy of the petitioner is estopped from challenging the claims on the grounds identified in the petition.

(c) A petitioner may not file a petition to institute a covered business method patent review of the patent where, before the date on which the petition is filed, the petitioner or real party-in-interest filed a civil action challenging the validity of a claim of the patent.

[Added, 77 FR 48680, Aug. 14, 2012, effective Sept. 16, 2012; para. (c) added, 80 FR 28561, May 19, 2015, effective May 19, 2015]

§ 42.303 Time for filing.

A petition requesting a covered business method patent review may be filed any time except during the period in which a petition for a post-grant review of the patent would satisfy the requirements of 35 U.S.C. 321(c).

[Added, 77 FR 48680, Aug. 14, 2012, effective Sept. 16, 2012]

§ 42.304 Content of petition.

In addition to any other notices required by subparts A and C of this part, a petition must request judgment against one or more claims of a patent identified by patent number. In addition to the requirements of §§ 42.6, 42.8, 42.22, and 42.24 the petition must set forth:

(a) *Grounds for standing.* The petitioner must demonstrate that the patent for which review is sought is a covered business method patent, and that the petitioner meets the eligibility requirements of § 42.302.

(b) *Identification of challenge.* Provide a statement of the precise relief requested for each claim challenged. The statement must identify the following:

(1) The claim;

(2) The specific statutory grounds permitted under paragraph (2) or (3) of 35 U.S.C. 282(b), except as modified by section 18(a)(1)(C) of the Leahy-Smith America Invents Act (Pub. L. 112–29, 125 Stat. 284 (2011)), on which the challenge to the claim is based;

(3) How the challenged claim is to be construed. Where the claim to be construed contains a means-plus-function or step-plus-function limitation as permitted under 35 U.S.C. 112(f), the construction of the claim must identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function;

(4) How the construed claim is unpatentable under the statutory grounds identified in paragraph (b)(2) of this section. Where the grounds for unpatentability are based on prior art, the petition must specify where each element of the claim is found in the prior art. For all other grounds of unpatentability, the petition must identify the specific part of the claim that fails to comply with the statutory grounds raised and state how the identified subject matter fails to comply with the statute; and

(5) The exhibit number of supporting evidence relied upon to support the challenge and the relevance of the evidence to the challenge raised, including identifying specific portions of the evidence that support the challenge. The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge.

(c) A motion may be filed that seeks to correct a clerical or typographical mistake in the petition. The grant of such a motion does not change the filing date of the petition.

[Added, 77 FR 48680, Aug. 14, 2012, effective Sept. 16, 2012]

Subpart E — Derivation

GENERAL

§ 42.400 Procedure; pendency

(a) A derivation proceeding is a trial subject to the procedures set forth in subpart A of this part.

(b) The Board may for good cause authorize or direct the parties to address patentability issues that arise in the course of the derivation proceeding.

[Added 77 FR 56068, Sept. 11, 2012, effective Mar. 16, 2013]

§ 42.401 Definitions.

In addition to the definitions in § 42.2, the following definitions apply to proceedings under this subpart:

Agreement or understanding under 35 U.S.C. 135(e) means settlement for the purposes of § 42.74.

Applicant includes a reissue applicant.

Application includes both an application for an original patent and an application for a reissued patent.

First publication means either a patent or an application publication under 35 U.S.C. 122(b), including a publication of an international application designating the United States as provided by 35 U.S.C. 374.

Petitioner means a patent applicant who petitions for a determination that another party named in an earlier-filed patent application allegedly derived a claimed invention from an inventor named in the petitioner's application and filed the earlier application without authorization.

Respondent means a party other than the petitioner.

Same or substantially the same means patentably indistinct.

[Added 77 FR 56068, Sept. 11, 2012, effective Mar. 16, 2013]

§ 42.402 Who may file a petition for a derivation proceeding.

An applicant for patent may file a petition to institute a derivation proceeding in the Office.

[Added 77 FR 56068, Sept. 11, 2012, effective Mar. 16, 2013]

§ 42.403 Time for filing.

A petition for a derivation proceeding must be filed within the one-year period beginning on the date of the first publication of a claim to an invention that is the same or substantially the same as the earlier application's claim to the allegedly derived invention.

[Added 77 FR 56068, Sept. 11, 2012, effective Mar. 16, 2013]

§ 42.404 Derivation fee.

(a) A derivation fee set forth in § 42.15(c) must accompany the petition.

(b) No filing date will be accorded to the petition until payment is complete.

[Added 77 FR 56068, Sept. 11, 2012, effective Mar. 16, 2013]

§ 42.405 Content of petition.

(a) *Grounds for standing.* The petition must:

(1) Demonstrate compliance with §§ 42.402 and 42.403; and

(2) Show that the petitioner has at least one claim that is:

(i) The same or substantially the same as the respondent's claimed invention; and

(ii) The same or substantially the same as the invention disclosed to the respondent.

(b) In addition to the requirements of §§ 42.8 and 42.22, the petition must:

(1) Provide sufficient information to identify the application or patent for which the petitioner seeks a derivation proceeding;

(2) Demonstrate that a claimed invention was derived from an inventor named in the petitioner's application, and that the inventor from whom the invention was derived did not authorize the filing of the earliest application claiming such invention; and

(3) For each of the respondent's claims to the derived invention,

(i) Show why the claimed invention is the same or substantially the same as the invention disclosed to the respondent, and

(ii) Identify how the claim is to be construed. Where the claim to be construed contains a means-plus-function or step-plus-function limitation as permitted under 35 U.S.C. 112(f), the construction of the claim must identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function.

(c) *Sufficiency of showing.* A derivation showing is not sufficient unless it is supported by substantial evidence, including at least one affidavit addressing communication of the derived invention and lack of authorization that, if unrebutted, would support a determination of derivation. The showing of communication must be corroborated.

[Added 77 FR 56068, Sept. 11, 2012, effective Mar. 16, 2013]

§ 42.406 Service of petition.

In addition to the requirements of § 42.6, the petitioner must serve the petition and exhibits relied upon in the petition as follows:

(a) The petition and supporting evidence must be served on the respondent at the correspondence address of record for the earlier application or subject patent. The petitioner may additionally serve the petition and supporting evidence on the respondent at any other address known to the petitioner as likely to effect service.

(b) Upon agreement of the parties, service may be made electronically. Service may be by Priority Mail Express® or by means at least as fast and reliable as Priority Mail Express®. Personal service is not required.

[Added 77 FR 56068, Sept. 11, 2012, effective Mar. 16, 2013; para. (b) revised, 79 FR 63036, Oct. 22, 2014, effective Oct. 22, 2014;]

§ 42.407 Filing date.

(a) *Complete petition.* A petition to institute a derivation proceeding will not be accorded a filing date until the petition satisfies all of the following requirements:

(1) Complies with §§ 42.404 and 42.405, and

(2) Service of the petition on the correspondence address of record as provided in § 42.406.

(b) *Incomplete petition.* Where the petitioner files an incomplete petition, no filing date will be accorded, and the Office will dismiss the petition if the deficiency in the petition is not corrected within the earlier of either one month from notice of the incomplete petition, or the expiration of the statutory deadline in which to file a petition for derivation.

[Added 77 FR 56068, Sept. 11, 2012, effective Mar. 16, 2013]

INSTITUTING DERIVATION PROCEEDING

§ 42.408 Institution of derivation proceeding.

(a) An administrative patent judge institutes, and may as necessary reinstitute, the derivation proceeding on behalf of the Director.

(b) *Additional derivation proceeding.* The petitioner may suggest the addition of a patent or application to the derivation proceeding. The suggestion should make the showings required under § 42.405 and explain why the suggestion could not have been made in the original petition.

[Added 77 FR 56068, Sept. 11, 2012, effective Mar. 16, 2013]

AFTER INSTITUTION OF DERIVATION PROCEEDING

§ 42.409 Settlement agreements.

An agreement or understanding under 35 U.S.C. 135(e) is a settlement for the purposes of § 42.74.

[Added 77 FR 56068, Sept. 11, 2012, effective Mar. 16, 2013]

§ 42.410 Arbitration.

(a) Parties may resort to binding arbitration to determine any issue. The Office is not a party to the arbitration. The Board is not bound by, and may independently determine, any question of patentability.

(b) The Board will not set a time for, or otherwise modify the proceeding for, an arbitration unless:

(1) It is to be conducted according to Title 9 of the United States Code;

(2) The parties notify the Board in writing of their intention to arbitrate;

(3) The agreement to arbitrate:

(i) Is in writing;

(ii) Specifies the issues to be arbitrated;

(iii) Names the arbitrator, or provides a date not more than 30 days after the execution of the agreement for the selection of the arbitrator;

(iv) Provides that the arbitrator's award shall be binding on the parties and that judgment thereon can be entered by the Board;

(v) Provides that a copy of the agreement is filed within 20 days after its execution; and

(vi) Provides that the arbitration is completed within the time the Board sets.

(c) The parties are solely responsible for the selection of the arbitrator and the conduct of the arbitration.

(d) The Board may determine issues the arbitration does not resolve.

(e) The Board will not consider the arbitration award unless it:

(1) Is binding on the parties;

(2) Is in writing;

(3) States in a clear and definite manner each issue arbitrated and the disposition of each issue; and

(4) Is filed within 20 days of the date of the award.

(f) Once the award is filed, the parties to the award may not take actions inconsistent with the award. If the award is dispositive of the contested subject matter for a party, the Board may enter judgment as to that party.

[Added 77 FR 56068, Sept. 11, 2012, effective Mar. 16, 2013]

§ 42.411 Common interests in the invention.

The Board may decline to institute, or if already instituted the Board may issue judgment in, a derivation proceeding between an application and a patent or another application that are commonly owned.

[Added 77 FR 56068, Sept. 11, 2012, effective Mar. 16, 2013]

§ 42.412 Public availability of Board records.

(a) *Publication.*

(1) *Generally.* Any Board decision is available for public inspection without a party's permission if rendered in a file open to the public pursuant to § 1.11 of this chapter or in an application that has been published in accordance with §§ 1.211 to 1.221 of this chapter. The Office may independently publish any Board decision that is available for public inspection.

(2) *Determination of special circumstances.* Any Board decision not publishable under paragraph (a)(1) of this section may be published or made available for public inspection if the Director believes that special circumstances warrant publication and a party does not petition within two months after being notified of the intention to make the decision public, objecting in writing on the ground that the decision discloses the objecting party's trade secret or other confidential information and stating with specificity that such information is not otherwise publicly available.

(b) *Record of proceeding.*

(1) The record of a Board proceeding is available to the public, unless a patent application not otherwise available to the public is involved.

(2) Notwithstanding paragraph (b)(1) of this section, after a final Board decision in or judgment in a Board proceeding, the record of the Board proceeding will be made available to the public if any involved file is or becomes open to the public under § 1.11 of this chapter or an involved application is or becomes published under §§ 1.211 to 1.221 of this chapter.

[Added 77 FR 56068, Sept. 11, 2012, effective Mar. 16, 2013]

PART 90 — JUDICIAL REVIEW OF PATENT TRIAL AND APPEAL BOARD DECISIONS

Sec.
90.1 Scope.
90.2 Notice; service.
90.3 Time for appeal or civil action.

§ 90.1 Scope.

The provisions herein govern judicial review for Patent Trial and Appeal Board decisions under chapter 13 of title 35, United States Code. Judicial review of decisions arising out of *inter partes* reexamination proceedings that are requested under 35 U.S.C. 311, and where available, judicial review of decisions arising out of interferences declared pursuant to 35 U.S.C. 135 continue to be governed by the pertinent regulations in effect on July 1, 2012.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

§ 90.2 Notice; service.

(a) *For an appeal under 35 U.S.C. 141.*

(1) In all appeals, the notice of appeal required by 35 U.S.C. 142 must be filed with the Director of the United States Patent and Trademark Office as provided in § 104.2 of this title. A copy of the notice of appeal must also be filed with the Patent Trial and Appeal Board in the appropriate manner provided in § 41.10(a), 41.10(b), or 42.6(b).

(2) In all appeals, the party initiating the appeal must comply with the requirements of the Federal Rules of Appellate Procedure and Rules for the United States Court of Appeals for the Federal Circuit, including:

(i) Serving the requisite number of copies on the Court; and

(ii) Paying the requisite fee for the appeal.

(3) *Additional requirements.*

(i) In appeals arising out of an *ex parte* reexamination proceeding ordered pursuant to § 1.525, notice of the appeal must be served as provided in § 1.550(f) of this title.

(ii) In appeals arising out of an *inter partes* review, a post-grant review, a covered business method patent review, or a derivation proceeding, notice of the appeal must provide sufficient information to allow the Director to determine whether to exercise the right to intervene in the appeal pursuant to 35 U.S.C. 143, and it must be served as provided in § 42.6(e) of this title.

(b) *For a notice of election under 35 U.S.C. 141(d) to proceed under 35 U.S.C. 146.*

(1) Pursuant to 35 U.S.C. 141(d), if an adverse party elects to have all further review proceedings conducted under 35 U.S.C. 146 instead of under 35 U.S.C. 141, that party must file a notice of election with the United States Patent and Trademark Office as provided in § 104.2.

(2) A copy of the notice of election must also be filed with the Patent Trial and Appeal Board in the manner provided in § 42.6(b).

(3) A copy of the notice of election must also be served where necessary pursuant to § 42.6(e).

(c) *For a civil action under 35 U.S.C. 146.* The party initiating an action under 35 U.S.C. 146 must file a copy of the complaint no later than five business days after filing the complaint in district court with the Patent Trial and Appeal Board in the manner provided in § 42.6(b), and the Office of the Solicitor pursuant to § 104.2. Failure to comply with this requirement can result in further action within the United States Patent and Trademark Office consistent with the final Board decision.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

§ 90.3 Time for appeal or civil action.

(a) *Filing deadline.*

(1) *For an appeal under 35 U.S.C. 141*. The notice of appeal filed pursuant to 35 U.S.C. 142 must be filed with the Director of the United States Patent and Trademark Office no later than sixty-three (63) days after the date of the final Board decision. Any notice of cross-appeal is controlled by Rule 4(a)(3) of the Federal Rules of Appellate Procedure, and any other requirement imposed by the Rules of the United States Court of Appeals for the Federal Circuit.

(2) *For a notice of election under 35 U.S.C. 141(d)*. The time for filing a notice of election under 35 U.S.C. 141(d) is governed by 35 U.S.C. 141(d).

(3) *For a civil action under 35 U.S.C. 145 or 146.*

(i) A civil action must be commenced no later than sixty-three (63) days after the date of the final Board decision.

(ii) The time for commencing a civil action pursuant to a notice of election under 35 U.S.C. 141(d) is governed by 35 U.S.C. 141(d).

(b) *Time computation.*

(1) *Rehearing.* A timely request for rehearing will reset the time for appeal or civil action to no later than sixty-three (63) days after action on the request. Any subsequent request for rehearing from the same party in the same proceeding will not reset the time for seeking judicial review, unless the additional request is permitted by order of the Board.

(2) *Holidays.* If the last day for filing an appeal or civil action falls on a Federal holiday in the District of Columbia, the time is extended pursuant to 35 U.S.C. 21(b).

(c) *Extension of time.*

(1) The Director, or his designee, may extend the time for filing an appeal, or commencing a civil action, upon written request if:

(i) Requested before the expiration of the period for filing an appeal or commencing a civil action, and upon a showing of good cause; or

(ii) Requested after the expiration of the period for filing an appeal of commencing a civil action, and upon a showing that the failure to act was the result of excusable neglect.

(2) The request must be filed as provided in § 104.2 of this title.

[Added, 77 FR 48612, Aug. 14, 2012, effective Sept. 16, 2012]

SUBCHAPTER B — ADMINISTRATION

PART 102 — DISCLOSURE OF GOVERNMENT INFORMATION

Freedom of Information Act

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Subpart A — Freedom of Information Act

§ 102.1 General.

(a) The information in this part is furnished for the guidance of the public and in compliance with the requirements of the Freedom of Information Act (FOIA), as amended (5 U.S.C. 552). This part sets forth the procedures the United States Patent and Trademark Office (USPTO) follows to make publicly available the materials and indices specified in 5 U.S.C. 552(a)(2) and records requested under 5 U.S.C. 552(a)(3). Information routinely provided to the public as part of a regular USPTO activity (for example, press releases issued by the Office of Public Affairs) may be provided to the public without following this part. USPTO's policy is to make discretionary disclosures of records or information exempt from disclosure under FOIA whenever disclosure would not foreseeably harm an interest protected by a FOIA exemption, but this policy does not create any right enforceable in court.

(b) As used in this subpart, *FOIA Officer* means the USPTO employee designated to administer FOIA for USPTO. To ensure prompt processing of a request, correspondence should be addressed to the FOIA Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450, or delivered by hand to 10B20, Madison Building East, 600 Dulany Street, Alexandria, Virginia.

[Added, 65 FR 52916, Aug. 31, 2000, effective Oct. 2, 2000; para. (b) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (b) revised, 70 FR 10488, Mar. 4, 2005, effective Mar. 4, 2005]

§ 102.2 Public reference facilities.

(a) USPTO maintains a public reference facility that contains the records FOIA requires to be made regularly available for public inspection and copying; furnishes information and otherwise assists the public concerning USPTO operations under FOIA; and receives and processes requests for records under FOIA. The FOIA Officer is responsible for determining which of USPTO's records are required to be made available for public inspection and copying, and for making those records available in USPTO's reference and records inspection facility. The FOIA Officer shall maintain and make available for public inspection and copying a current subject-matter index of USPTO's public inspection facility records. Each index shall be updated regularly, at least quarterly, with respect to newly included records. In accordance with 5 U.S.C. 552(a)(2), USPTO has determined that it is unnecessary and impracticable to publish quarterly, or more frequently, and distribute copies of the index and supplements thereto. The public reference facility is located in the Public Search Room, Madison Building East, First Floor, 600 Dulany Street, Alexandria, Virginia.

(b) The FOIA Officer shall also make public inspection facility records created by USPTO on or after November 1, 1996, available electronically through USPTO's World Wide Web site (http://www.uspto.gov). Information available at the site shall include:

(1) The FOIA Officer's index of the public inspection facility records, which indicates which records are available electronically; and

(2) The general index referred to in paragraph (c)(3) of this section.

(c) USPTO maintains and makes available for public inspection and copying:

(1) A current index providing identifying information for the public as to any matter that is issued, adopted, or promulgated after July 4, 1967, and that is retained as a record and is required to be made available or published. Copies of the index are available upon request after payment of the direct cost of duplication;

(2) Copies of records that have been released and that the FOIA Officer determines, because of their subject matter, have become or are likely to become the subject of subsequent requests for substantially the same records;

(3) A general index of the records described in paragraph (c)(2) of this section;

(4) Final opinions and orders, including concurring and dissenting opinions made in the adjudication of cases;

(5) Those statements of policy and interpretations that have been adopted by USPTO and are not published in the *Federal Register* ; and

(6) Administrative staff manuals and instructions to staff that affect a member of the public.

[Added, 65 FR 52916, Aug. 31, 2000, effective Oct. 2, 2000; para. (a) revised, 75 FR 36294, June 25, 2010, effective June 25, 2010]

§ 102.3 Records under FOIA.

(a) Records under FOIA include all Government records, regardless of format, medium or physical characteristics, and include electronic records and information, audiotapes, videotapes, and photographs.

(b) There is no obligation to create, compile, or obtain from outside USPTO a record to satisfy a FOIA request. With regard to electronic data, the issue of whether records are created or merely extracted from an existing database is not always apparent. When responding to FOIA requests for electronic data where creation of a record or programming becomes an issue, USPTO shall undertake reasonable efforts to search for the information in electronic format.

(c) USPTO officials may, upon request, create and provide new information pursuant to user fee statutes, such as the first paragraph of 15 U.S.C. 1525, or in accordance with authority otherwise provided by law. This is outside the scope of FOIA.

(d) The FOIA Officer shall preserve all correspondence pertaining to the requests received under this subpart, as well as copies of all requested records, until disposition or destruction is authorized by Title 44 of the United States Code or a National Archives and Records Administration's General Records Schedule. The FOIA Officer shall not dispose of records while they are the subject of a pending request, appeal, or lawsuit under FOIA.

[Added, 65 FR 52916, Aug. 31, 2000, effective Oct. 2, 2000]

§ 102.4 Requirements for making requests.

(a) A request for USPTO records that are not customarily made available to the public as part of USPTO's regular informational services must be in writing, and shall be processed under FOIA, regardless of whether FOIA is mentioned in the request. Requests should be sent to the USPTO FOIA Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450 (records FOIA requires to be made regularly available for public inspection and copying are addressed in § 102.2(c)). For the quickest handling, the request letter and envelope should be marked "Freedom of Information Act Request." For requests for records about oneself, § 102.24 contains additional requirements. For requests for records about another individual, either a written authorization signed by that individual permitting disclosure of those records to the requester or proof that individual is deceased (for example, a copy of a death certificate or an obituary) facilitates processing the request.

(b) The records requested must be described in enough detail to enable USPTO personnel to locate them with a reasonable amount of effort. Whenever possible, a request should include specific information about each record sought, such as the date, title or name, author, recipient, and subject matter of the record, and the name and location of the office where the record is located. Also, if records about a court case are sought, the title of the case, the court in which the case was filed, and the nature of the case should be included. If known, any file designations or descriptions for the requested records should be included. In general, the more specifically the request describes the records sought, the greater the likelihood that USPTO will locate those records. If the FOIA Officer determines that a request does not reasonably describe records, the FOIA Officer will inform the requester what additional information is needed or why the request is otherwise insufficient. The FOIA Officer also may give the requester an opportunity to discuss the request so that it may be modified to meet the requirements of this section.

[Added, 65 FR 52916, Aug. 31, 2000, effective Oct. 2, 2000; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

§ 102.5 Responsibility for responding to requests.

(a) *In general*. Except as stated in paragraph (b) of this section, the USPTO will process FOIA requests directed to USPTO. In determining records responsive to a request, the FOIA Officer shall include only those records within USPTO's

possession and control as of the date the FOIA Officer receives the request.

(b) *Consultations and referrals.* If the FOIA Officer receives a request for a record in USPTO's possession in which another Federal agency subject to FOIA has the primary interest, the FOIA Officer shall refer the record to that agency for direct response to the requester. The FOIA Officer shall consult with another Federal agency before responding to a requester if the FOIA Officer receives a request for a record in which another Federal agency subject to FOIA has a significant interest, but not the primary interest; or another Federal agency not subject to FOIA has the primary interest or a significant interest. Ordinarily, the agency that originated a record will be presumed to have the primary interest in it.

(c) *Notice of referral.* Whenever a FOIA Officer refers a document to another Federal agency for direct response to the requester, the FOIA Officer will ordinarily notify the requester in writing of the referral and inform the requester of the name of the agency to which the document was referred.

(d) *Timing of responses to consultations and referrals.* All consultations and referrals shall be handled according to the date the FOIA request was received by the first Federal agency.

(e) *Agreements regarding consultations and referrals.* The FOIA Officer may make agreements with other Federal agencies to eliminate the need for consultations or referrals for particular types of records.

[Added, 65 FR 52916, Aug. 31, 2000, effective Oct. 2, 2000]

§ 102.6 Time limits and expedited processing.

(a) *In general.* The FOIA Officer ordinarily shall respond to requests according to their order of receipt.

(b) *Initial response and appeal.* Subject to paragraph (c)(1) of this section, an initial response shall be made within 20 working days (*i.e.*, excluding Saturdays, Sundays, and legal public holidays) of the receipt of a request for a record under this part by the proper FOIA Officer identified in accordance with § 102.5(a), and an appeal shall be decided within 20 working days of its receipt by the Office of the General Counsel.

(c) *Unusual circumstances.*

(1) In unusual circumstances as specified in paragraph (c)(2) of this section, the FOIA Officer may extend the time limits in paragraph (b) of this section by notifying the requester in writing as soon as practicable of the unusual circumstances and of the date by which processing of the request is expected to be completed. Extensions of time for the initial determination and extensions on appeal may not exceed a total of ten working days, unless the requester agrees to a longer extension, or the FOIA Officer provides the requester with an opportunity either to limit the scope of the request so that it may be processed within the applicable time limit, or to arrange an alternative time frame for processing the request or a modified request.

(2) As used in this section, *unusual circumstances*, means, but only to the extent reasonably necessary to properly process the particular request:

(i) The need to search for and collect the requested records from field facilities or other establishments separate from the office processing the request;

(ii) The need to search for, collect, and appropriately examine a voluminous amount of separate and distinct records that are the subject of a single request; or

(iii) The need for consultation, which shall be conducted with all practicable speed, with another Federal agency having a substantial interest in the determination of the request.

(3) Unusual circumstances do not include a delay that results from a predictable workload of requests, unless USPTO demonstrates reasonable progress in reducing its backlog of pending requests. Refusal to reasonably modify the scope of a request or arrange an alternate time frame may affect a requester's ability to obtain judicial review.

(4) If the FOIA Officer reasonably believes that multiple requests submitted by a requester, or by a group of requesters acting in concert, constitute a single request that would otherwise involve unusual circumstances, and the requests involve clearly related matters, the FOIA Officer may

aggregate them. Multiple requests involving unrelated matters will not be aggregated.

(d) *Multitrack processing.*

(1) The FOIA Officer may use two or more processing tracks by distinguishing between simple and more complex requests based on the number of pages involved, or some other measure of the amount of work and/or time needed to process the request, and whether the request qualifies for expedited processing as described in paragraph (e) of this section.

(2) The FOIA Officer may provide requesters in a slower track with an opportunity to limit the scope of their requests in order to qualify for faster processing. The FOIA Officer may contact the requester by telephone or by letter, whichever is most efficient in each case.

(e) *Expedited processing.*

(1) Requests and appeals shall be taken out of order and given expedited treatment whenever it is determined they involve:

(i) Circumstances in which the lack of expedited treatment could reasonably be expected to pose an imminent threat to the life or physical safety of an individual;

(ii) The loss of substantial due process rights;

(iii) A matter of widespread and exceptional media interest in which there exist questions about the Government's integrity that affect public confidence; or

(iv) An urgency to inform the public about an actual or alleged Federal Government activity, if made by a person primarily engaged in disseminating information.

(2) A request for expedited processing may be made at the time of the initial request for records or at any later time. For a prompt determination, a request for expedited processing should be sent to the FOIA Officer.

(3) A requester who seeks expedited processing must submit a statement, certified to be true and correct to the best of that person's knowledge and belief, explaining in detail the basis for requesting expedited processing. For example, a requester within the category described in paragraph (e)(1)(iv) of this section, if not a full-time member of the news media, must establish that he or she is a person whose main professional activity or occupation is information dissemination, though it need not be his or her sole occupation. A requester within the category described in paragraph (e)(1)(iv) of this section must also establish a particular urgency to inform the public about the Government activity involved in the request, beyond the public's right to know about Government activity generally. The formality of certification may be waived as a matter of administrative discretion.

(4) Within ten calendar days of receipt of a request for expedited processing, the FOIA Officer will decide whether to grant it and shall notify the requester of the decision. If a request for expedited treatment is granted, the request shall be given priority and processed as soon as practicable. If a request for expedited processing is denied, any appeal of that decision shall be acted on expeditiously.

[Added, 65 FR 52916, Aug. 31, 2000, effective Oct. 2, 2000]

§ 102.7 Responses to requests.

(a) *Grants of requests.* If the FOIA Officer makes a determination to grant a request in whole or in part, the FOIA Officer will notify the requester in writing. The FOIA Officer will inform the requester in the notice of any fee charged under § 102.11 and disclose records to the requester promptly upon payment of any applicable fee. Records disclosed in part shall be marked or annotated to show each applicable FOIA exemption and the amount of information deleted, unless doing so would harm an interest protected by an applicable exemption. The location of the information deleted shall also be indicated on the record, if feasible.

(b) *Adverse determinations of requests.* If the FOIA Officer makes an adverse determination regarding a request, the FOIA Officer will notify the requester of that determination in writing. An adverse determination is a denial of a request in any respect, namely: A determination to withhold any requested record in whole or in part; a determination that a requested record does not exist or cannot be located; a determination that a record is not readily reproducible in the form or format sought by the requester; a determination that what has been requested is not a record subject to FOIA (except

that a determination under § 102.11(j) that records are to be made available under a fee statute other than FOIA is not an adverse determination); a determination against the requester on any disputed fee matter, including a denial of a request for a fee waiver; or a denial of a request for expedited treatment. Each denial letter shall be signed by the FOIA Officer and shall include:

(1) The name and title or position of the denying official;

(2) A brief statement of the reason(s) for the denial, including applicable FOIA exemption(s);

(3) An estimate of the volume of records or information withheld, in number of pages or some other reasonable form of estimation. This estimate need not be provided if the volume is otherwise indicated through deletions on records disclosed in part, or if providing an estimate would harm an interest protected by an applicable FOIA exemption; and

(4) A statement that the denial may be appealed, and a list of the requirements for filing an appeal under § 102.10(b).

[Added, 65 FR 52916, Aug. 31, 2000, effective Oct. 2, 2000]

§ 102.9 Business Information.

(a) *In general.* Business information obtained by USPTO from a submitter will be disclosed under FOIA only under this section.

(b) *Definitions.* For the purposes of this section:

(1) *Business information* means commercial or financial information, obtained by USPTO from a submitter, which may be protected from disclosure under FOIA exemption 4 (5 U.S.C. 552(b)(4)).

(2) *Submitter* means any person or entity outside the Federal Government from whom USPTO obtains business information, directly or indirectly. The term includes corporations; state, local and tribal governments; and foreign governments.

(c) *Designation of business information.* A submitter of business information should designate by appropriate markings, either at the time of submission or at a reasonable time thereafter, any portions of its submission that it considers to be protected from disclosure under FOIA exemption 4. These designations will expire ten years after the date of the submission unless the submitter requests, and provides justification for, a longer designation period.

(d) *Notice to submitters.* The FOIA Officer shall provide a submitter with prompt written notice of a FOIA request or administrative appeal that seeks its business information whenever required under paragraph (e) of this section, except as provided in paragraph (h) of this section, in order to give the submitter an opportunity under paragraph (f) of this section to object to disclosure of any specified portion of that information. Such written notice shall be sent via certified mail, return receipt requested, or similar means. The notice shall either describe the business information requested or include copies of the requested records containing the information. When notification of a large number of submitters is required, notification may be made by posting or publishing the notice in a place reasonably likely to accomplish notification.

(e) *When notice is required.* Notice shall be given to the submitter whenever:

(1) The information has been designated in good faith by the submitter as protected from disclosure under FOIA exemption 4; or

(2) The FOIA Officer has reason to believe that the information may be protected from disclosure under FOIA exemption 4.

(f) *Opportunity to object to disclosure.* The FOIA Officer shall allow a submitter seven working days (*i.e.*, excluding Saturdays, Sundays, and legal public holidays) from the date of receipt of the written notice described in paragraph (d) of this section to provide the FOIA Officer with a detailed statement of any objection to disclosure. The statement must specify all grounds for withholding any portion of the information under any exemption of FOIA and, in the case of exemption 4, it must show why the information is a trade secret or commercial or financial information that is privileged or confidential. If a submitter fails to respond to the notice within the time specified, the submitter will be considered to have no objection to disclosure of the information. Information a submitter provides under this paragraph may itself be subject to disclosure under FOIA.

(g) *Notice of intent to disclose.* The FOIA Officer shall consider a submitter's objections and specific grounds under FOIA for nondisclosure in

deciding whether to disclose business information. If the FOIA Officer decides to disclose business information over the objection of a submitter, the FOIA Officer shall give the submitter written notice via certified mail, return receipt requested, or similar means, which shall include:

(1) A statement of reason(s) why the submitter's objections to disclosure were not sustained;

(2) A description of the business information to be disclosed; and

(3) A statement that the FOIA Officer intends to disclose the information seven working days from the date the submitter receives the notice.

(h) *Exceptions to notice requirements.* The notice requirements of paragraphs (d) and (g) of this section shall not apply if:

(1) The FOIA Officer determines that the information should not be disclosed;

(2) The information has been lawfully published or has been officially made available to the public;

(3) Disclosure of the information is required by statute (other than FOIA) or by a regulation issued in accordance with Executive Order 12600; or

(4) The designation made by the submitter under paragraph (c) of this section appears obviously frivolous, in which case the FOIA Officer shall provide the submitter written notice of any final decision to disclose the information seven working days from the date the submitter receives the notice.

(i) *Notice of FOIA lawsuit.* Whenever a requester files a lawsuit seeking to compel the disclosure of business information, the FOIA Officer shall promptly notify the submitter.

(j) *Corresponding notice to requesters.* Whenever a FOIA Officer provides a submitter with notice and an opportunity to object to disclosure under paragraph (d) of this section, the FOIA Officer shall also notify the requester(s). Whenever a submitter files a lawsuit seeking to prevent the disclosure of business information, the FOIA Officer shall notify the requester(s).

[Added, 65 FR 52916, Aug. 31, 2000, effective Oct. 2, 2000]

§ 102.10 Appeals from initial determinations or untimely delays.

(a) If a request for records is initially denied in whole or in part, or has not been timely determined, or if a requester receives an adverse initial determination regarding any other matter under this subpart (as described in § 102.7(b)), the requester may file a written appeal, which must be received by the Office of General Counsel within thirty calendar days of the date of the written denial or, if there has been no determination, may be submitted anytime after the due date, including the last extension under § 102.6(c), of the determination.

(b) Appeals shall be decided by a Deputy General Counsel. Appeals should be addressed to the General Counsel, United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450. Both the letter and the appeal envelope should be clearly marked "Freedom of Information Appeal". The appeal must include a copy of the original request and the initial denial, if any, and may include a statement of the reasons why the records requested should be made available and why the initial denial, if any, was in error. No opportunity for personal appearance, oral argument or hearing on appeal is provided.

(c) If an appeal is granted, the person making the appeal shall be immediately notified and copies of the releasable documents shall be made available promptly thereafter upon receipt of appropriate fees determined in accordance with § 102.11.

(d) If no determination of an appeal has been sent to the requester within the twenty-working-day period specified in § 102.6(b) or the last extension thereof, the requester is deemed to have exhausted his administrative remedies with respect to the request, giving rise to a right of judicial review under 5 U.S.C. 552(a)(6)(C). If the person making a request initiates a civil action against USPTO based on the provision in this paragraph, the administrative appeal process may continue.

(e) A determination on appeal shall be in writing and, when it denies records in whole or in part, the letter to the requester shall include:

(1) A brief explanation of the basis for the denial, including a list of applicable FOIA

exemptions and a description of how the exemptions apply;

(2) A statement that the decision is final;

(3) Notification that judicial review of the denial is available in the United States district court for the district in which the requester resides or has its principal place of business, the United States District Court for the Eastern District of Virginia, or the District of Columbia; and

(4) The name and title or position of the official responsible for denying the appeal.

[Added, 65 FR 52916, Aug. 31, 2000, effective Oct. 2, 2000; para. (b) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

§ 102.11 Fees.

(a) *In general.* USPTO shall charge for processing requests under FOIA in accordance with paragraph (c) of this section, except when fees are limited under paragraph (d) of this section or when a waiver or reduction of fees is granted under paragraph (k) of this section. USPTO shall collect all applicable fees before sending copies of requested records to a requester. Requesters must pay fees by check or money order made payable to the Treasury of the United States.

(b) *Definitions.* For purposes of this section:

(1) *Commercial use request* means a request from or on behalf of a person who seeks information for a use or purpose that furthers his or her commercial, trade, or profit interests, which can include furthering those interests through litigation. The FOIA Officer shall determine, whenever reasonably possible, the use to which a requester will put the requested records. When it appears that the requester will put the records to a commercial use, either because of the nature of the request itself or because the FOIA Officer has reasonable cause to doubt a requester's stated use, the FOIA Officer shall provide the requester a reasonable opportunity to submit further clarification.

(2) *Direct costs* means those expenses USPTO incurs in searching for and duplicating (and, in the case of commercial use requests, reviewing) records to respond to a FOIA request. Direct costs include, for example, the labor costs of the employee performing the work (the basic rate of pay for the employee, plus 16 percent of that rate to cover benefits). Not included in direct costs are overhead expenses such as the costs of space and heating or lighting of the facility in which the records are kept.

(3) *Duplication* means the making of a copy of a record, or of the information contained in it, necessary to respond to a FOIA request. Copies may take the form of paper, microform, audiovisual materials, or electronic records (for example, magnetic tape or disk), among others. The FOIA Officer shall honor a requester's specified preference of form or format of disclosure if the record is readily reproducible with reasonable efforts in the requested form or format.

(4) *Educational institution* means a preschool, a public or private elementary or secondary school, an institution of undergraduate higher education, an institution of graduate higher education, an institution of professional education, or an institution of vocational education, that operates a program of scholarly research. To be in this category, a requester must show that the request is authorized by and is made under the auspices of a qualifying institution, and that the records are sought to further scholarly research rather than for a commercial use.

(5) *Noncommercial scientific institution* means an institution that is not operated on a "commercial" basis, as that term is defined in paragraph (b)(1) of this section, and that is operated solely for the purpose of conducting scientific research, the results of which are not intended to promote any particular product or industry. To be in this category, a requester must show that the request is authorized by and is made under the auspices of a qualifying institution and that the records are sought to further scientific research rather than for a commercial use.

(6) *Representative of the news media, or news media requester* means any person actively gathering news for an entity that is organized and operated to publish or broadcast news to the public. The term "news" means information that is about current events or that would be of current interest to the public. Examples of news media entities include television or radio stations broadcasting to the public at large and publishers of periodicals (but only if they can qualify as disseminators of "news") that make their products available for purchase or subscription by the general public. For "freelance"

journalists to be regarded as working for a news organization, they must demonstrate a solid basis for expecting publication through that organization. A publication contract would be the clearest proof, but the FOIA Officer shall also look to the past publication record of a requester in making this determination. To be in this category, a requester must not be seeking the requested records for a commercial use. However, a request for records supporting the news-dissemination function of the requester shall not be considered to be for a commercial use.

(7) *Review* means the examination of a record located in response to a request in order to determine whether any portion of it is exempt from disclosure. It also includes processing any record for disclosure—for example, doing all that is necessary to redact it and prepare it for disclosure. Review costs are recoverable even if a record ultimately is not disclosed. Review time does not include time spent resolving general legal or policy issues regarding the application of exemptions.

(8) *Search* means the process of looking for and retrieving records or information responsive to a request. It includes page-by-page or line-by-line identification of information within records and also includes reasonable efforts to locate and retrieve information from records maintained in electronic form or format. The FOIA Officer shall ensure that searches are done in the most efficient and least expensive manner reasonably possible.

(c) *Fees.* In responding to FOIA requests, the FOIA Officer shall charge the fees summarized in chart form in paragraphs (c)(1) and (c)(2) of this section and explained in paragraphs (c)(3) through (c)(5) of this section, unless a waiver or reduction of fees has been granted under paragraph (k) of this section.

(1) The four categories and chargeable fees are:

Category	Chargeable fees
(i) Commercial Use Requesters	Search, Review, and Duplication.
(ii) Educational and Non-commercial Scientific Institution Requesters	Duplication (excluding the cost of the first 100 pages).
(iii) Representatives of the News Media	Duplication (excluding the cost of the first 100 pages).
(iv) All Other Requesters	Search and Duplication (excluding the cost of the first 2 hours of search and 100 pages).

(2) *Uniform fee schedule.*

Service	Rate
(i) Manual search	Actual salary rate of employee involved, plus 16 percent of salary rate.
(ii) Computerized search	Actual direct cost, including operator time.
(iii) Duplication of records: (A) Paper copy reproduction (B) Other reproduction (*e.g.*, computer disk or printout, microfilm, microfiche, or microform)	$.15 per page Actual direct cost, including operator time
(iv) Review of records (includes preparation for release, *i.e.* excising)	Actual salary rate of employee conducting review, plus 16 percent of salary rate.

(3) *Search.*

(i) Search fees shall be charged for all requests—other than requests made by educational institutions, noncommercial scientific institutions, or representatives of the news media—subject to the limitations of paragraph (d) of this section. The FOIA Officer will charge for time spent searching even if no responsive records are located or if located records are entirely exempt from disclosure. Search fees shall be the direct costs of conducting the search by the involved employees

(ii) For computer searches of records, requesters will be charged the direct costs of conducting the search, although certain requesters (as provided in paragraph (d)(1) of this section) will be charged no search fee and certain other requesters (as provided in paragraph (d)(3) of this section) are entitled to the cost equivalent of two hours of manual search time without charge. These direct costs include the costs, attributable to the search, of

operating a central processing unit and operator/programmer salary.

(4) *Duplication.* Duplication fees will be charged to all requesters, subject to the limitations of paragraph (d) of this section. For a paper photocopy of a record (no more than one copy of which need be supplied), the fee shall be $.15 cents per page. For copies produced by computer, such as tapes or printouts, the FOIA Officer shall charge the direct costs, including operator time, of producing the copy. For other forms of duplication, the FOIA Officer will charge the direct costs of that duplication.

(5) *Review.* Review fees shall be charged to requesters who make a commercial use request. Review fees shall be charged only for the initial record review—the review done when the FOIA Officer determines whether an exemption applies to a particular record at the initial request level. No charge will be made for review at the administrative appeal level for an exemption already applied. However, records withheld under an exemption that is subsequently determined not to apply may be reviewed again to determine whether any other exemption not previously considered applies, and the costs of that review are chargeable. Review fees shall be the direct costs of conducting the review by the involved employees.

(d) *Limitations on charging fees.*

(1) No search fee will be charged for requests by educational institutions, noncommercial scientific institutions, or representatives of the news media.

(2) No search fee or review fee will be charged for a quarter-hour period unless more than half of that period is required for search or review.

(3) Except for requesters seeking records for a commercial use, the FOIA Officer will provide without charge:

(i) The first 100 pages of duplication (or the cost equivalent); and

(ii) The first two hours of search (or the cost equivalent).

(4) Whenever a total fee calculated under paragraph (c) of this section is $20.00 or less for any request, no fee will be charged.

(5) The provisions of paragraphs (d) (3) and (4) of this section work together. This means that for requesters other than those seeking records for a commercial use, no fee will be charged unless the cost of the search in excess of two hours plus the cost of duplication in excess of 100 pages totals more than $20.00.

(e) *Notice of anticipated fees over $20.00.* When the FOIA Officer determines or estimates that the fees to be charged under this section will be more than $20.00, the FOIA Officer shall notify the requester of the actual or estimated fees, unless the requester has indicated a willingness to pay fees as high as those anticipated. If only a portion of the fee can be estimated readily, the FOIA Officer shall advise the requester that the estimated fee may be only a portion of the total fee. If the FOIA Officer has notified a requester that actual or estimated fees are more than $20.00, the FOIA Officer shall not consider the request received or process it further until the requester agrees to pay the anticipated total fee. Any such agreement should be in writing. A notice under this paragraph shall offer the requester an opportunity to discuss the matter with USPTO personnel in order to reformulate the request to meet the requester's needs at a lower cost.

(f) *Charges for other services.* Apart from the other provisions of this section, the FOIA Officer shall ordinarily charge the direct cost of special services. Such special services could include certifying that records are true copies or sending records by other than ordinary mail.

(g) *Charging interest.* The FOIA Officer shall charge interest on any unpaid bill starting on the 31st calendar day following the date of billing the requester. Interest charges shall be assessed at the rate provided in 31 U.S.C. 3717 and accrue from the date of the billing until payment is received by the FOIA Officer. The FOIA Officer shall follow the provisions of the Debt Collection Improvement Act of 1996 (Pub. L. 104-134), as amended, and its administrative procedures, including the use of consumer reporting agencies, collection agencies, and offset.

(h) *Aggregating requests.* If a FOIA Officer reasonably believes that a requester or a group of requesters acting together is attempting to divide a request into a series of requests for the purpose of avoiding fees, the FOIA Officer may aggregate those

requests and charge accordingly. The FOIA Officer may presume that multiple requests of this type made within a 30-calendar-day period have been made in order to avoid fees. If requests are separated by a longer period, the FOIA Officer shall aggregate them only if a solid basis exists for determining that aggregation is warranted under all the circumstances involved. Multiple requests involving unrelated matters shall not be aggregated.

(i) *Advance payments.*

(1) For requests other than those described in paragraphs (i)(2) and (3) of this section, the FOIA Officer shall not require the requester to make an advance payment: a payment made before work is begun or continued on a request. Payment owed for work already completed (*i.e.,* a payment before copies are sent to a requester) is not an advance payment.

(2) If the FOIA Officer determines or estimates that a total fee to be charged under this section will be more than $250.00, the requester must pay the entire anticipated fee before beginning to process the request, unless the FOIA Officer receives a satisfactory assurance of full payment from a requester who has a history of prompt payment.

(3) If a requester has previously failed to pay a properly charged FOIA fee to USPTO or another responsible Federal agency within 30 calendar days of the date of billing, the FOIA Officer shall require the requester to pay the full amount due, plus any applicable interest, and to make an advance payment of the full amount of any anticipated fee, before the FOIA Officer begins to process a new request or continues to process a pending request from that requester.

(4) In cases in which the FOIA Officer requires payment under paragraphs (i)(2) or (3) of this section, the request shall not be considered received and further work will not be done on it until the required payment is received.

(5) Upon the completion of processing of a request, when a specific fee is determined to be payable and appropriate notice has been given to the requester, the FOIA Officer shall make records available to the requester only upon receipt of full payment of the fee.

(j) *Other statutes specifically providing for fees.* The fee schedule of this section does not apply to fees charged under any statute (except for FOIA) that specifically requires USPTO or another responsible Federal agency to set and collect fees for particular types of records. If records responsive to requests are maintained for distribution by agencies operating such statutorily based fee schedule programs, the FOIA Officer shall inform requesters of how to obtain records from those sources.

(k) *Requirements for waiver or reduction of fees.*

(1) Records responsive to a request will be furnished without charge or at a charge reduced below that established under paragraph (c) of this section if the FOIA Officer determines, based on all available information, that the requester has demonstrated that:

(i) Disclosure of the requested information is in the public interest because it is likely to contribute significantly to public understanding of the operations or activities of the Government; and

(ii) Disclosure of the information is not primarily in the commercial interest of the requester.

(2) To determine whether the first fee waiver requirement is met, the FOIA Officer shall consider the following factors:

(i) *The subject of the request:* whether the subject of the requested records concerns the operations or activities of the Government. The subject of the requested records must concern identifiable operations or activities of the Federal Government, with a connection that is direct and clear, not remote or attenuated.

(ii) *The informative value of the information to be disclosed:* whether the disclosure is "likely to contribute" to an understanding of Government operations or activities. The disclosable portions of the requested records must be meaningfully informative about Government operations or activities in order to be "likely to contribute" to an increased public understanding of those operations or activities. The disclosure of information that already is in the public domain, in either a duplicative or a substantially identical form,

would not be likely to contribute to such understanding.

(iii) *The contribution to an understanding of the subject by the public likely to result from disclosure:* whether disclosure of the requested information will contribute to the understanding of a reasonably broad audience of persons interested in the subject, as opposed to the individual understanding of the requester. A requester's expertise in the subject area and ability and intention to effectively convey information to the public shall be considered. It shall be presumed that a representative of the news media satisfies this consideration. It shall be presumed that a requester who merely provides information to media sources does not satisfy this consideration.

(iv) *The significance of the contribution to public understanding:* whether the disclosure is likely to contribute "significantly" to public understanding of Government operations or activities. The public's understanding of the subject in question prior to the disclosure must be significantly enhanced by the disclosure.

(3) To determine whether the second fee waiver requirement is met, the FOIA Officer shall consider the following factors:

(i) *The existence and magnitude of a commercial interest:* whether the requester has a commercial interest that would be furthered by the requested disclosure. The FOIA Officer shall consider any commercial interest of the requester (with reference to the definition of "commercial use request" in paragraph (b)(1) of this section), or of any person on whose behalf the requester may be acting, that would be furthered by the requested disclosure. Requesters shall be given an opportunity to provide explanatory information regarding this consideration.

(ii) *The primary interest in disclosure:* whether any identified commercial interest of the requester is sufficiently large, in comparison with the public interest in disclosure, that disclosure is "primarily in the commercial interest of the requester." A fee waiver or reduction is justified if the public interest standard (paragraph (k)(1)(i) of this section) is satisfied and the public interest is greater than any identified commercial interest in disclosure. The FOIA Officer ordinarily shall presume that if a news media requester has satisfied the public interest standard, the public interest is the primary interest served by disclosure to that requester. Disclosure to data brokers or others who merely compile and market Government information for direct economic return shall not be presumed to primarily serve the public interest.

(4) If only some of the records to be released satisfy the requirements for a fee waiver, a waiver shall be granted for those records.

(5) Requests for the waiver or reduction of fees should address the factors listed in paragraphs (k)(2) and (3) of this section, insofar as they apply to each request.

[Added, 65 FR 52916, Aug. 31, 2000, effective Oct. 2, 2000]

Subpart B — Privacy Act

§ 102.21 Purpose and scope.

(a) The purpose of this subpart is to establish policies and procedures for implementing the Privacy Act of 1974, as amended (5 U.S.C. 552a) (the Act). The main objectives are to facilitate full exercise of rights conferred on individuals under the Act and to ensure the protection of privacy as to individuals on whom USPTO maintains records in systems of records under the Act. USPTO accepts the responsibility to act promptly and in accordance with the Act upon receipt of any inquiry, request or appeal from a citizen of the United States or an alien lawfully admitted for permanent residence into the United States, regardless of the age of the individual. Further, USPTO accepts the obligations to maintain only such information on individuals as is relevant and necessary to the performance of its lawful functions, to maintain that information with such accuracy, relevancy, timeliness, and completeness as is reasonably necessary to assure fairness in determinations made by USPTO about the individual, to obtain information from the individual to the extent practicable, and to take every reasonable step to protect that information from unwarranted disclosure. USPTO will maintain no record describing how an individual exercises rights guaranteed by the First Amendment unless expressly authorized by statute or by the individual about whom the record is maintained or unless pertinent to and within the scope of an authorized law enforcement activity. An individual's name and

address will not be sold or rented by USPTO unless such action is specifically authorized by law; however, this provision shall not be construed to require the withholding of names and addresses otherwise permitted to be made public.

(b) This subpart is administered by the Privacy Officer of USPTO.

(c) Matters outside the scope of this subpart include the following:

(1) Requests for records which do not pertain to the individual making the request, or to the individual about whom the request is made if the requester is the parent or guardian of the individual;

(2) Requests involving information pertaining to an individual which is in a record or file but not within the scope of a system of records notice published in the Federal Register;

(3) Requests to correct a record where a grievance procedure is available to the individual either by regulation or by provision in a collective bargaining agreement with USPTO, and the individual has initiated, or has expressed in writing the intention of initiating, such grievance procedure. An individual selecting the grievance procedure waives the use of the procedures in this subpart to correct or amend a record; and,

(4) Requests for employee-employer services and counseling which were routinely granted prior to enactment of the Act, including, but not limited to, test calculations of retirement benefits, explanations of health and life insurance programs, and explanations of tax withholding options.

(d) Any request for records which pertains to the individual making the request, or to the individual about whom the request is made if the requester is the parent or guardian of the individual, shall be processed under the Act and this subpart and under the Freedom of Information Act and USPTO's implementing regulations at Subpart A of this part, regardless whether the Act or the Freedom of Information Act is mentioned in the request.

[Added, 65 FR 52916, Aug. 31, 2000, effective Oct. 2, 2000]

§ 102.22 Definitions.

(a) All terms used in this subpart which are defined in 5 U.S.C. 552a shall have the same meaning herein.

(b) As used in this subpart:

(1) *Act* means the "Privacy Act of 1974, as amended (5 U.S.C. 552a)".

(2) *Appeal* means a request by an individual to review and reverse an initial denial of a request by that individual for correction or amendment.

(3) *USPTO* means the United States Patent and Trademark Office.

(4) *Inquiry* means either a request for general information regarding the Act and this subpart or a request by an individual (or that individual's parent or guardian) that USPTO determine whether it has any record in a system of records which pertains to that individual.

(5) *Person* means any human being and also shall include but not be limited to, corporations, associations, partnerships, trustees, receivers, personal representatives, and public or private organizations.

(6) *Privacy Officer* means a USPTO employee designated to administer this subpart.

(7) *Request for access* means a request by an individual or an individual's parent or guardian to see a record which is in a particular system of records and which pertains to that individual.

(8) *Request for correction or amendment* means the request by an individual or an individual's parent or guardian that USPTO change (either by correction, amendment, addition or deletion) a particular record in a system of records which pertains to that individual.

[Added, 65 FR 52916, Aug. 31, 2000, effective Oct. 2, 2000]

§ 102.23 Procedures for making inquiries.

(a) Any individual, regardless of age, who is a citizen of the United States or an alien lawfully admitted for permanent residence into the United States may submit an inquiry to USPTO. The inquiry should be made either in person at 10B20, Madison Building East, 600 Dulany Street,

Alexandria, Virginia, or by mail addressed to the Privacy Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450, or to the official identified in the notification procedures paragraph of the systems of records notice published in the *Federal Register*. If an individual believes USPTO maintains a record pertaining to that individual but does not know which system of records might contain such a record, the USPTO Privacy Officer will provide assistance in person or by mail.

(b) Inquiries submitted by mail should include the words "PRIVACY ACT INQUIRY" in capital letters at the top of the letter and on the face of the envelope. If the inquiry is for general information regarding the Act and this subpart, no particular information is required. USPTO reserves the right to require compliance with the identification procedures appearing at § 102.24(d) where circumstances warrant. If the inquiry is a request that USPTO determine whether it has, in a given system of records, a record which pertains to the individual, the following information should be submitted:

(1) Name of individual whose record is sought;

(2) Individual whose record is sought is either a U.S. citizen or an alien lawfully admitted for permanent residence;

(3) Identifying data that will help locate the record (for example, maiden name, occupational license number, period or place of employment, etc.);

(4) Record sought, by description and by record system name, if known;

(5) Action requested (that is, sending information on how to exercise rights under the Act; determining whether requested record exists; gaining access to requested record; or obtaining copy of requested record);

(6) Copy of court guardianship order or minor's birth certificate, as provided in § 102.24(f)(3), but only if requester is guardian or parent of individual whose record is sought;

(7) Requester's name (printed), signature, address, and telephone number (optional);

(8) Date; and,

(9) Certification of request by notary or other official, but only if

(i) Request is for notification that requested record exists, for access to requested record or for copy of requested record;

(ii) Record is not available to any person under 5 U.S.C. 552; and

(iii) Requester does not appear before an employee of USPTO for verification of identity.

(c) Any inquiry which is not addressed as specified in paragraph (a) of this section or which is not marked as specified in paragraph (b) of this section will be so addressed and marked by USPTO personnel and forwarded immediately to the Privacy Officer. An inquiry which is not properly addressed by the individual will not be deemed to have been "received" for purposes of measuring the time period for response until actual receipt by the Privacy Officer. In each instance when an inquiry so forwarded is received, the Privacy Officer shall notify the individual that his or her inquiry was improperly addressed and the date the inquiry was received at the proper address.

(d)(1) Each inquiry received shall be acted upon promptly by the Privacy Officer. Every effort will be made to respond within ten working days (*i.e.*, excluding Saturdays, Sundays and legal public holidays) of the date of receipt. If a response cannot be made within ten working days, the Privacy Officer shall send an acknowledgment during that period providing information on the status of the inquiry and asking for such further information as may be necessary to process the inquiry. The first correspondence sent by the Privacy Officer to the requester shall contain USPTO's control number assigned to the request, as well as a note that the requester should use that number in all future contacts in order to facilitate processing. USPTO shall use that control number in all subsequent correspondence.

(2) If the Privacy Officer fails to send an acknowledgment within ten working days, as provided above, the requester may ask the General Counsel to take corrective action. No failure of the Privacy Officer to send an acknowledgment shall confer administrative finality for purposes of judicial review.

(e) An individual shall not be required to state a reason or otherwise justify his or her inquiry.

(f) Special note should be taken of the fact that certain agencies are responsible for publishing notices of systems of records having Government-wide application to other agencies, including USPTO. The agencies known to be publishing these general notices and the types of records covered therein appear in an appendix to this part. The provisions of this section, and particularly paragraph (a) of this section, should be followed in making inquiries with respect to such records. Such records in USPTO are subject to the provisions of this part to the extent indicated in the appendix to this part. The exemptions, if any, determined by an agency publishing a general notice shall be invoked and applied by USPTO after consultation, as necessary, with that other agency.

[Added, 65 FR 52916, Aug. 31, 2000, effective Oct. 2, 2000; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (a) revised, 70 FR 10488, Mar. 4, 2005, effective Mar. 4, 2005]

§ 102.24 Procedures for making requests for records.

(a) Any individual, regardless of age, who is a citizen of the United States or an alien lawfully admitted for permanent residence into the United States may submit a request for access to records to USPTO. The request should be made either in person at 10B20, Madison Building East, 600 Dulany Street, Alexandria, Virginia, or by mail addressed to the Privacy Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450.

(b) Requests submitted by mail should include the words "PRIVACY ACT REQUEST" in capital letters at the top of the letter and on the face of the envelope. Any request which is not addressed as specified in paragraph (a) of this section or which is not marked as specified in this paragraph will be so addressed and marked by USPTO personnel and forwarded immediately to the Privacy Officer. A request which is not properly addressed by the individual will not be deemed to have been "received" for purposes of measuring time periods for response until actual receipt by the Privacy Officer. In each instance when a request so forwarded is received, the Privacy Officer shall notify the individual that his or her request was improperly addressed and the date when the request was received at the proper address.

(c) If the request follows an inquiry under § 102.23 in connection with which the individual's identity was established by USPTO, the individual need only indicate the record to which access is sought, provide the USPTO control number assigned to the request, and sign and date the request. If the request is not preceded by an inquiry under § 102.23, the procedures of this section should be followed.

(d) The requirements for identification of individuals seeking access to records are as follows:

(1) *In person.* Each individual making a request in person shall be required to present satisfactory proof of identity. The means of proof, in the order of preference and priority, are:

(i) A document bearing the individual's photograph (for example, driver's license, passport or military or civilian identification card);

(ii) A document, preferably issued for participation in a federally sponsored program, bearing the individual's signature (for example, unemployment insurance book, employer's identification card, national credit card, and professional, craft or union membership card); and

(iii) A document bearing neither the photograph nor the signature of the individual, preferably issued for participation in a federally sponsored program (for example, Medicaid card). In the event the individual can provide no suitable documentation of identity, USPTO will require a signed statement asserting the individual's identity and stipulating that the individual understands the penalty provision of 5 U.S.C. 552a(i)(3) recited in § 102.32(a). In order to avoid any unwarranted disclosure of an individual's records, USPTO reserves the right to determine the adequacy of proof of identity offered by any individual, particularly when the request involves a sensitive record.

(2) *Not in person.* If the individual making a request does not appear in person before the Privacy Officer or other employee authorized to determine identity, a certification of a notary public or equivalent officer empowered to administer oaths must accompany the request under the circumstances prescribed in § 102.23(b)(9). The certification in or

attached to the letter must be substantially in accordance with the following text:

City of _____

County of _____:ss

(Name of individual), who affixed (his) (her) signature below in my presence, came before me, a (title), in and for the aforesaid County and State, this _____ day of _____, 20__, and established (his) (her) identity to my satisfaction.

My commission expires _____.

(Signature)

(3) *Parents of minors and legal guardians.* An individual acting as the parent of a minor or the legal guardian of the individual to whom a record pertains shall establish his or her personal identity in the same manner prescribed in either paragraph (d)(1) or (d)(2) of this section. In addition, such other individual shall establish his or her identity in the representative capacity of parent or legal guardian. In the case of the parent of a minor, the proof of identity shall be a certified or authenticated copy of the minor's birth certificate. In the case of a legal guardian of an individual who has been declared incompetent due to physical or mental incapacity or age by a court of competent jurisdiction, the proof of identity shall be a certified or authenticated copy of the court's order. For purposes of the Act, a parent or legal guardian may represent only a living individual, not a decedent. A parent or legal guardian may be accompanied during personal access to a record by another individual, provided the provisions of § 102.25(f) are satisfied.

(e) When the provisions of this subpart are alleged to impede an individual in exercising his or her right to access, USPTO will consider, from an individual making a request, alternative suggestions regarding proof of identity and access to records.

(f) An individual shall not be required to state a reason or otherwise justify his or her request for access to a record.

[Added, 65 FR 52916, Aug. 31, 2000, effective Oct. 2, 2000; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (a) revised, 70 FR 10488, Mar. 4, 2005, effective Mar. 4, 2005]

§ 102.25 Disclosure of requested records to individuals.

(a)(1) The Privacy Officer shall act promptly upon each request. Every effort will be made to respond within ten working days (*i.e.*, excluding Saturdays, Sundays, and legal public holidays) of the date of receipt. If a response cannot be made within ten working days due to unusual circumstances, the Privacy Officer shall send an acknowledgment during that period providing information on the status of the request and asking for any further information that may be necessary to process the request. "Unusual circumstances" shall include circumstances in which

(i) A search for and collection of requested records from inactive storage, field facilities or other establishments is required;

(ii) A voluminous amount of data is involved;

(iii) Information on other individuals must be separated or expunged from the particular record; or

(iv) Consultations with other agencies having a substantial interest in the determination of the request are necessary.

(2) If the Privacy Officer fails to send an acknowledgment within ten working days, as provided above in paragraph (a) of this section, the requester may ask the General Counsel to take corrective action. No failure of the Privacy Officer to send an acknowledgment shall confer administrative finality for purposes of judicial review.

(b) *Grant of access—*

(1) *Notification.* An individual shall be granted access to a record pertaining to him or her, except where the provisions of paragraph (g)(1) of this section apply. The Privacy Officer will notify the individual of a determination to grant access, and provide the following information:

(i) The methods of access, as set forth in paragraph (b)(2) of this section;

(ii) The place at which the record may be inspected;

(iii) The earliest date on which the record may be inspected and the period of time that the

records will remain available for inspection. In no event shall the earliest date be later than thirty calendar days from the date of notification;

(iv) The estimated date by which a copy of the record could be mailed and the estimate of fees pursuant to § 102.31. In no event shall the estimated date be later than thirty calendar days from the date of notification;

(v) The fact that the individual, if he or she wishes, may be accompanied by another individual during personal access, subject to the procedures set forth in paragraph (f) of this section; and,

(vi) Any additional requirements needed to grant access to a specific record.

(2) *Methods of access.* The following methods of access to records by an individual may be available depending on the circumstances of a given situation:

(i) Inspection in person may be had in a location specified by the Privacy Officer during business hours;

(ii) Transfer of records to a Federal facility more convenient to the individual may be arranged, but only if the Privacy Officer determines that a suitable facility is available, that the individual's access can be properly supervised at that facility, and that transmittal of the records to that facility will not unduly interfere with operations of USPTO or involve unreasonable costs, in terms of both money and manpower; and

(iii) Copies may be mailed at the request of the individual, subject to payment of the fees prescribed in § 102.31. USPTO, on its own initiative, may elect to provide a copy by mail, in which case no fee will be charged the individual.

(c) Access to medical records is governed by the provisions of § 102.26.

(d) USPTO will supply such other information and assistance at the time of access as to make the record intelligible to the individual.

(e) USPTO reserves the right to limit access to copies and abstracts of original records, rather than the original records. This election would be appropriate, for example, when the record is in an automated data media such as tape or diskette, when the record contains information on other individuals, and when deletion of information is permissible under exemptions (for example, 5 U.S.C. 552a(k)(2)). In no event shall original records of USPTO be made available to the individual except under the immediate supervision of the Privacy Officer or the Privacy Officer's designee.

(f) Any individual who requests access to a record pertaining to that individual may be accompanied by another individual of his or her choice. "Accompanied" includes discussion of the record in the presence of the other individual. The individual to whom the record pertains shall authorize the presence of the other individual in writing. The authorization shall include the name of the other individual, a specific description of the record to which access is sought, the USPTO control number assigned to the request, the date, and the signature of the individual to whom the record pertains. The other individual shall sign the authorization in the presence of the Privacy Officer. An individual shall not be required to state a reason or otherwise justify his or her decision to be accompanied by another individual during personal access to a record.

(g) *Initial denial of access—*

(1) *Grounds.* Access by an individual to a record which pertains to that individual will be denied only upon a determination by the Privacy Officer that:

(i) The record is exempt under § 102.33 or § 102.34, or exempt by determination of another agency publishing notice of the system of records, as described in § 102.23(f);

(ii) The record is information compiled in reasonable anticipation of a civil action or proceeding;

(iii) The provisions of § 102.26 pertaining to medical records temporarily have been invoked; or

(iv) The individual has unreasonably failed to comply with the procedural requirements of this part.

(2) *Notification.* The Privacy Officer shall give notice of denial of access to records to the individual in writing and shall include the following information:

(i) The Privacy Officer's name and title or position;

(ii) The date of the denial;

(iii) The reasons for the denial, including citation to the appropriate section of the Act and this part;

(iv) The individual's opportunities, if any, for further administrative consideration, including the identity and address of the responsible official. If no further administrative consideration within USPTO is available, the notice shall state that the denial is administratively final; and

(v) If stated to be administratively final within USPTO, the individual's right to judicial review provided under 5 U.S.C. 552a(g)(1), as limited by 5 U.S.C. 552a(g)(5).

(3) *Administrative review.* When an initial denial of a request is issued by the Privacy Officer, the individual's opportunities for further consideration shall be as follows:

(i) As to denial under paragraph (g)(1)(i) of this section, two opportunities for further consideration are available in the alternative:

(A) If the individual contests the application of the exemption to the records, review procedures in § 102.25(g)(3)(ii) shall apply; or

(B) If the individual challenges the exemption itself, the procedure is a petition for the issuance, amendment, or repeal of a rule under 5 U.S.C. 553(e). If the exemption was determined by USPTO, such petition shall be filed with the General Counsel. If the exemption was determined by another agency (as described in § 102.23(f)), USPTO will provide the individual with the name and address of the other agency and any relief sought by the individual shall be that provided by the regulations of the other agency. Within USPTO, no such denial is administratively final until such a petition has been filed by the individual and disposed of on the merits by the General Counsel.

(ii) As to denial under paragraphs (g)(1)(ii) of this section, (g)(1)(iv) of this section or (to the limited extent provided in paragraph (g)(3)(i)(A) of this section) paragraph (g)(1)(i) of this section, the individual may file for review with the General Counsel, as indicated in the Privacy Officer's initial denial notification. The procedures appearing in § 102.28 shall be followed by both the individual and USPTO to the maximum extent practicable.

(iii) As to denial under paragraph (g)(1)(iii) of this section, no further administrative consideration within USPTO is available because the denial is not administratively final until expiration of the time period indicated in § 102.26(a).

(h) If a request is partially granted and partially denied, the Privacy Officer shall follow the appropriate procedures of this section as to the records within the grant and the records within the denial.

[Added, 65 FR 52916, Aug. 31, 2000, effective Oct. 2, 2000]

§ 102.26 Special procedures: Medical records.

(a) No response to any request for access to medical records by an individual will be issued by the Privacy Officer for a period of seven working days (*i.e.*, excluding Saturdays, Sundays, and legal public holidays) from the date of receipt.

(b) USPTO has published as a routine use, for all systems of records containing medical records, consultations with an individual's physician or psychologist if, in the sole judgment of USPTO, disclosure could have an adverse effect upon the individual. The mandatory waiting period set forth in paragraph (a) of this section will permit exercise of this routine use in appropriate cases. USPTO will pay no cost of any such consultation.

(c) In every case of a request by an individual for access to medical records, the Privacy Officer shall:

(1) Inform the individual of the waiting period prescribed in paragraph (a) of this section;

(2) Obtain the name and address of the individual's physician and/or psychologist, if the individual consents to give them;

(3) Obtain specific, written consent for USPTO to consult the individual's physician and/or psychologist in the event that USPTO believes such consultation is advisable, if the individual consents to give such authorization;

(4) Obtain specific, written consent for USPTO to provide the medical records to the individual's physician or psychologist in the event that USPTO believes access to the record by the

individual is best effected under the guidance of the individual's physician or psychologist, if the individual consents to give such authorization; and

(5) Forward the individual's medical record to USPTO's medical expert for review and a determination on whether consultation with or transmittal of the medical records to the individual's physician or psychologist is warranted. If the consultation with or transmittal of such records to the individual's physician or psychologist is determined to be warranted, USPTO's medical expert shall so consult or transmit. Whether or not such a consultation or transmittal occurs, USPTO's medical officer shall provide instruction to the Privacy Officer regarding the conditions of access by the individual to his or her medical records.

(d) If an individual refuses in writing to give the names and consents set forth in paragraphs (c)(2) through (c)(4) of this section and USPTO has determined that disclosure could have an adverse effect upon the individual, USPTO shall give the individual access to said records by means of a copy, provided without cost to the requester, sent registered mail return receipt requested.

[Added, 65 FR 52916, Aug. 31, 2000, effective Oct. 2, 2000]

§ 102.27 Procedures for making requests for correction or amendment.

(a) Any individual, regardless of age, who is a citizen of the United States or an alien lawfully admitted for permanent residence into the United States may submit a request for correction or amendment to USPTO. The request should be made either in person or by mail addressed to the Privacy Officer who processed the individual's request for access to the record, and to whom is delegated authority to make initial determinations on requests for correction or amendment. The office of the Privacy Officer is open to the public between the hours of 9 a.m. and 4 p.m., Monday through Friday (excluding legal public holidays).

(b) Requests submitted by mail should include the words "PRIVACY ACT REQUEST" in capital letters at the top of the letter and on the face of the envelope. Any request which is not addressed as specified in paragraph (a) of this section or which is not marked as specified in this paragraph will be so addressed and marked by USPTO personnel and forwarded immediately to the Privacy Officer. A request which is not properly addressed by the individual will not be deemed to have been "received" for purposes of measuring the time period for response until actual receipt by the Privacy Officer. In each instance when a request so forwarded is received, the Privacy Officer shall notify the individual that his or her request was improperly addressed and the date the request was received at the proper address.

(c) Since the request, in all cases, will follow a request for access under § 102.25, the individual's identity will be established by his or her signature on the request and use of the USPTO control number assigned to the request.

(d) A request for correction or amendment should include the following:

(1) Specific identification of the record sought to be corrected or amended (for example, description, title, date, paragraph, sentence, line and words);

(2) The specific wording to be deleted, if any;

(3) The specific wording to be inserted or added, if any, and the exact place at which to be inserted or added; and

(4) A statement of the basis for the requested correction or amendment, with all available supporting documents and materials which substantiate the statement. The statement should identify the criterion of the Act being invoked, that is, whether the information in the record is unnecessary, inaccurate, irrelevant, untimely or incomplete.

[Added, 65 FR 52916, Aug. 31, 2000, effective Oct. 2, 2000]

§ 102.28 Review of requests for correction or amendment.

(a)

(1)

(i) Not later than ten working days (*i.e.*, excluding Saturdays, Sundays and legal public holidays) after receipt of a request to correct or amend a record, the Privacy Officer shall send an acknowledgment providing an estimate of time within which action will be taken on the request and

asking for such further information as may be necessary to process the request. The estimate of time may take into account unusual circumstances as described in § 102.25(a). No acknowledgment will be sent if the request can be reviewed, processed, and the individual notified of the results of review (either compliance or denial) within the ten working days. Requests filed in person will be acknowledged in writing at the time submitted.

(ii) If the Privacy Officer fails to send the acknowledgment within ten working days, as provided in paragraph (a)(1)(i) of this section, the requester may ask the General Counsel to take corrective action. No failure of the Privacy Officer to send an acknowledgment shall confer administrative finality for purposes of judicial review.

(2) Promptly after acknowledging receipt of a request, or after receiving such further information as might have been requested, or after arriving at a decision within the ten working days, the Privacy Officer shall either:

(i) Make the requested correction or amendment and advise the individual in writing of such action, providing either a copy of the corrected or amended record or a statement as to the means whereby the correction or amendment was effected in cases where a copy cannot be provided (for example, erasure of information from a record maintained only in magnetically recorded computer files); or

(ii) Inform the individual in writing that his or her request is denied and provide the following information:

(A) The Privacy Officer's name and title or position;

(B) The date of the denial;

(C) The reasons for the denial, including citation to the appropriate sections of the Act and this subpart; and

(D) The procedures for appeal of the denial as set forth in § 102.29, including the address of the General Counsel.

(3) The term *promptly* in this section means within thirty working days (*i.e.*, excluding Saturdays, Sundays, and legal public holidays). If the Privacy Officer cannot make the determination within thirty working days, the individual will be advised in writing of the reason therefor and of the estimated date by which the determination will be made.

(b) Whenever an individual's record is corrected or amended pursuant to a request by that individual, the Privacy Officer shall be responsible for notifying all persons and agencies to which the corrected or amended portion of the record had been disclosed prior to its correction or amendment, if an accounting of such disclosure required by the Act was made. The notification shall require a recipient agency maintaining the record to acknowledge receipt of the notification, to correct or amend the record, and to apprise any agency or person to which it had disclosed the record of the substance of the correction or amendment.

(c) The following criteria will be considered by the Privacy Officer in reviewing a request for correction or amendment:

(1) The sufficiency of the evidence submitted by the individual;

(2) The factual accuracy of the information;

(3) The relevance and necessity of the information in terms of purpose for which it was collected;

(4) The timeliness and currency of the information in light of the purpose for which it was collected;

(5) The completeness of the information in terms of the purpose for which it was collected;

(6) The degree of risk that denial of the request could unfairly result in determinations adverse to the individual;

(7) The character of the record sought to be corrected or amended; and

(8) The propriety and feasibility of complying with the specific means of correction or amendment requested by the individual.

(d) USPTO will not undertake to gather evidence for the individual, but does reserve the right to verify the evidence which the individual submits.

(e) Correction or amendment of a record requested by an individual will be denied only upon a determination by the Privacy Officer that:

(1) The individual has failed to establish, by a preponderance of the evidence, the propriety of the correction or amendment in light of the criteria set forth in paragraph (c) of this section;

(2) The record sought to be corrected or amended is part of the official record in a terminated judicial, quasi-judicial, or quasi-legislative proceeding to which the individual was a party or participant;

(3) The information in the record sought to be corrected or amended, or the record sought to be corrected or amended, is the subject of a pending judicial, quasi-judicial, or quasi-legislative proceeding to which the individual is a party or participant;

(4) The correction or amendment would violate a duly enacted statute or promulgated regulation; or

(5) The individual has unreasonably failed to comply with the procedural requirements of this part.

(f) If a request is partially granted and partially denied, the Privacy Officer shall follow the appropriate procedures of this section as to the records within the grant and the records within the denial.

[Added, 65 FR 52916, Aug. 31, 2000, effective Oct. 2, 2000]

§ 102.29 Appeal of initial adverse determination on correction or amendment.

(a) When a request for correction or amendment has been denied initially under § 102.28, the individual may submit a written appeal within thirty working days (*i.e.,* excluding Saturdays, Sundays and legal public holidays) after the date of the initial denial. When an appeal is submitted by mail, the postmark is conclusive as to timeliness.

(b) An appeal should be addressed to the General Counsel, United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450. An appeal should include the words “PRIVACY APPEAL” in capital letters at the top of the letter and on the face of the envelope. An appeal not addressed and marked as provided herein will be so marked by USPTO personnel when it is so identified and will be forwarded immediately to the General Counsel. An appeal which is not properly addressed by the individual will not be deemed to have been “received” for purposes of measuring the time periods in this section until actual receipt by the General Counsel. In each instance when an appeal so forwarded is received, the General Counsel shall notify the individual that his or her appeal was improperly addressed and the date when the appeal was received at the proper address.

(c) The individual’s appeal shall include a statement of the reasons why the initial denial is believed to be in error and USPTO’s control number assigned to the request. The appeal shall be signed by the individual. The record which the individual requests be corrected or amended and all correspondence between the Privacy Officer and the requester will be furnished by the Privacy Officer who issued the initial denial. Although the foregoing normally will comprise the entire record on appeal, the General Counsel may seek additional information necessary to assure that the final determination is fair and equitable and, in such instances, disclose the additional information to the individual to the greatest extent possible, and provide an opportunity for comment thereon.

(d) No personal appearance or hearing on appeal will be allowed.

(e) The General Counsel shall act upon the appeal and issue a final determination in writing not later than thirty working days (*i.e.,* excluding Saturdays, Sundays and legal public holidays) from the date on which the appeal is received, except that the General Counsel may extend the thirty days upon deciding that a fair and equitable review cannot be made within that period, but only if the individual is advised in writing of the reason for the extension and the estimated date by which a final determination will issue. The estimated date should not be later than the sixtieth working day after receipt of the appeal unless unusual circumstances, as described in § 102.25(a), are met.

(f) If the appeal is determined in favor of the individual, the final determination shall include the specific corrections or amendments to be made and a copy thereof shall be transmitted promptly both to the individual and to the Privacy Officer who issued the initial denial. Upon receipt of such final determination, the Privacy Officer promptly shall

take the actions set forth in § 102.28(a)(2)(i) and (b).

(g) If the appeal is denied, the final determination shall be transmitted promptly to the individual and state the reasons for the denial. The notice of final determination also shall inform the individual of the following:

(1) The right of the individual under the Act to file a concise statement of reasons for disagreeing with the final determination. The statement ordinarily should not exceed one page and USPTO reserves the right to reject a statement of excessive length. Such a statement shall be filed with the General Counsel. It should provide the USPTO control number assigned to the request, indicate the date of the final determination and be signed by the individual. The General Counsel shall acknowledge receipt of such statement and inform the individual of the date on which it was received.

(2) The facts that any such disagreement statement filed by the individual will be noted in the disputed record, that the purposes and uses to which the statement will be put are those applicable to the record in which it is noted, and that a copy of the statement will be provided to persons and agencies to which the record is disclosed subsequent to the date of receipt of such statement;

(3) The fact that USPTO will append to any such disagreement statement filed by the individual, a copy of the final determination or summary thereof which also will be provided to persons and agencies to which the disagreement statement is disclosed; and,

(4) The right of the individual to judicial review of the final determination under 5 U.S.C. 552a(g)(1)(A), as limited by 5 U.S.C. 552a(g)(5).

(h) In making the final determination, the General Counsel shall employ the criteria set forth in § 102.28(c) and shall deny an appeal only on the grounds set forth in § 102.28(e).

(i) If an appeal is partially granted and partially denied, the General Counsel shall follow the appropriate procedures of this section as to the records within the grant and the records within the denial.

(j) Although a copy of the final determination or a summary thereof will be treated as part of the individual's record for purposes of disclosure in instances where the individual has filed a disagreement statement, it will not be subject to correction or amendment by the individual.

(k) The provisions of paragraphs (g)(1) through (g)(3) of this section satisfy the requirements of 5 U.S.C. 552a(e)(3).

[Added, 65 FR 52916, Aug. 31, 2000, effective Oct. 2, 2000; para. (b) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

§ 102.30 Disclosure of record to person other than the individual to whom it pertains.

(a) USPTO may disclose a record pertaining to an individual to a person other than the individual to whom it pertains only in the following instances:

(1) Upon written request by the individual, including authorization under § 102.25(f);

(2) With the prior written consent of the individual;

(3) To a parent or legal guardian under 5 U.S.C. 552a(h);

(4) When required by the Act and not covered explicitly by the provisions of 5 U.S.C. 552a(b); and

(5) When permitted under 5 U.S.C. 552a(b)(1) through (12), which read as follows:[1]

(i) To those officers and employees of the agency which maintains the record who have a need for the record in the performance of their duties;

(ii) Required under 5 U.S.C. 552;

(iii) For a routine use as defined in 5 U.S.C. 552a(a)(7) and described under 5 U.S.C. 552a(e)(4)(D);

(iv) To the Bureau of the Census for purposes of planning or carrying out a census or survey or related activity pursuant to the provisions of Title 13;

(v) To a recipient who has provided the agency with advance adequate written assurance that the record will be used solely as a statistical

[1] 5 U.S.C. 552a(b)(4) has no application within USPTO.

research or reporting record, and the record is to be transferred in a form that is not individually identifiable;

(vi) To the National Archives and Records Administration as a record which has sufficient historical or other value to warrant its continued preservation by the United States Government, or for evaluation by the Archivist of the United States or the designee of the Archivist to determine whether the record has such value;

(vii) To another agency or to an instrumentality of any governmental jurisdiction within or under the control of the United States for a civil or criminal law enforcement activity if the activity is authorized by law, and if the head of the agency or instrumentality has made a written request to the agency which maintains the record specifying the particular portion desired and the law enforcement activity for which the record is sought;

(viii) To a person pursuant to a showing of compelling circumstances affecting the health or safety of an individual if upon such disclosure notification is transmitted to the last known address of such individual;

(ix) To either House of Congress, or, to the extent of matter within its jurisdiction, any committee or subcommittee thereof, any joint committee of Congress or subcommittee of any such joint committee;

(x) To the Comptroller General, or any of his authorized representatives, in the course of the performance of the duties of the General Accounting Office;

(xi) Pursuant to the order of a court of competent jurisdiction; or

(xii) To a consumer reporting agency in accordance with section 3711(e) of Title 31.

(b) The situations referred to in paragraph (a)(4) of this section include the following:

(1) 5 U.S.C. 552a(c)(4) requires dissemination of a corrected or amended record or notation of a disagreement statement by USPTO in certain circumstances;

(2) 5 U.S.C. 552a(d) requires disclosure of records to the individual to whom they pertain, upon request; and

(3) 5 U.S.C. 552a(g) authorizes civil action by an individual and requires disclosure by USPTO to the court.

(c) The Privacy Officer shall make an accounting of each disclosure by him of any record contained in a system of records in accordance with 5 U.S.C. 552a(c) (1) and (2). Except for a disclosure made under 5 U.S.C. 552a(b)(7), the Privacy Officer shall make such accounting available to any individual, insofar as it pertains to that individual, on request submitted in accordance with § 102.24. The Privacy Officer shall make reasonable efforts to notify any individual when any record in a system of records is disclosed to any person under compulsory legal process, promptly upon being informed that such process has become a matter of public record.

[Added, 65 FR 52916, Aug. 31, 2000, effective Oct. 2, 2000]

§ 102.31 Fees.

The only fees to be charged to or collected from an individual under the provisions of this part are for duplication of records at the request of the individual. The Privacy Officer shall charge fees for duplication of records under the Act in the same way in which they charge duplication fees under § 102.11, except as provided in this section.

(a) No fees shall be charged or collected for the following: Search for and retrieval of the records; review of the records; copying at the initiative of USPTO without a request from the individual; transportation of records and personnel; and first-class postage.

(b) It is the policy of USPTO to provide an individual with one copy of each record corrected or amended pursuant to his or her request without charge as evidence of the correction or amendment.

(c) As required by the United States Office of Personnel Management in its published regulations implementing the Act, USPTO will charge no fee for a single copy of a personnel record covered by that agency's Government-wide published notice of systems of records.

[Added, 65 FR 52916, Aug. 31, 2000, effective Oct. 2, 2000]

§ 102.32 Penalties.

(a) The Act provides, in pertinent part:

> Any person who knowingly and willfully requests or obtains any record concerning an individual from an agency under false pretenses shall be guilty of a misdemeanor and fined not more than $5,000. (5 U.S.C. 552a(i)(3)).

(b) A person who falsely or fraudulently attempts to obtain records under the Act also may be subject to prosecution under such other criminal statutes as 18 U.S.C. 494, 495 and 1001.

[Added, 65 FR 52916, Aug. 31, 2000, effective Oct. 2, 2000]

§ 102.33 General exemptions.

(a) Individuals may not have access to records maintained by USPTO but which were provided by another agency which has determined by regulation that such information is subject to general exemption under 5 U.S.C. 552a(j). If such exempt records are within a request for access, USPTO will advise the individual of their existence and of the name and address of the source agency. For any further information concerning the record and the exemption, the individual must contact that source agency.

(b) The general exemption determined to be necessary and proper with respect to systems of records maintained by USPTO, including the parts of each system to be exempted, the provisions of the Act from which they are exempted, and the justification for the exemption, is as follows: *Investigative Records—Contract and Grant Frauds and Employee Criminal Misconduct—COMMERCE/DEPT.—12.* Pursuant to 5 U.S.C. 552a(j)(2), these records are hereby determined to be exempt from all provisions of the Act, except 5 U.S.C. 552a (b), (c) (1) and (2), (e)(4) (A) through (F), (e) (6), (7), (9), (10), and (11), and (i). These exemptions are necessary to ensure the proper functions of the law enforcement activity, to protect confidential sources of information, to fulfill promises of confidentiality, to prevent interference with law enforcement proceedings, to avoid the disclosure of investigative techniques, to avoid the endangering of law enforcement personnel, to avoid premature disclosure of the knowledge of criminal activity and the evidentiary bases of possible enforcement actions, and to maintain the integrity of the law enforcement process.

[Added, 65 FR 52916, Aug. 31, 2000, effective Oct. 2, 2000]

§ 102.34 Specific exemptions.

(a)(1) Some systems of records under the Act which are maintained by USPTO contain, from time-to-time, material subject to the exemption appearing at 5 U.S.C. 552a(k)(1), relating to national defense and foreign policy materials. The systems of records published in the *Federal Register* by USPTO which are within this exemption are:
COMMERCE/PAT-TM-6,
COMMERCE/PAT-TM-7,
COMMERCE/PAT-TM-8,
COMMERCE/PAT-TM-9.

(2) USPTO hereby asserts a claim to exemption of such materials wherever they might appear in such systems of records, or any systems of records, at present or in the future. The materials would be exempt from 5 U.S.C. 552a (c)(3), (d), (e)(1), (e)(4) (G), (H), and (I), and (f) to protect materials required by Executive order to be kept secret in the interest of the national defense and foreign policy.

(b) The specific exemptions determined to be necessary and proper with respect to systems of records maintained by USPTO, including the parts of each system to be exempted, the provisions of the Act from which they are exempted, and the justification for the exemption, are as follows:

(1)(i) Exempt under 5 U.S.C. 552a(k)(2). The systems of records exempt (some only conditionally), the sections of the Act from which exempted, and the reasons therefor are as follows:

(A) Investigative Records—Contract and Grant Frauds and Employee Criminal Misconduct—COMMERCE/DEPT—12, but only on condition that the general exemption claimed in § 102.33(b)(3) is held to be invalid;

(B) Investigative Records—Persons Within the Investigative Jurisdiction of USPTO—COMMERCE/DEPT-13;

(C) Litigation, Claims and Administrative Proceeding Records—COMMERCE/DEPT-14;

(D) Attorneys and Agents Registered to Practice Before the Office—COMMERCE/PAT-TM-1;

(E) Complaints, Investigations and Disciplinary Proceedings Relating to Registered Patent Attorneys and Agents—COMMERCE/PAT-TM-2; and

(F) Non-Registered Persons Rendering Assistance to Patent Applicants—COMMERCE/PAT-TM-5.

(ii) The foregoing are exempted from 5 U.S.C. 552a (c)(3), (d), (e)(1), (e)(4)(G), (H), and (I), and (f). The reasons for asserting the exemption are to prevent subjects of investigation from frustrating the investigatory process, to insure the proper functioning and integrity of law enforcement activities, to prevent disclosure of investigative techniques, to maintain the ability to obtain necessary information, to fulfill commitments made to sources to protect their identities and the confidentiality of information and to avoid endangering these sources and law enforcement personnel. Special note is taken of the fact that the proviso clause in this exemption imports due process and procedural protections for the individual. The existence and general character of the information exempted will be made known to the individual to whom it pertains.

(2)(i) Exempt under 5 U.S.C. 552a(k)(5). The systems of records exempt (some only conditionally), the sections of the act from which exempted, and the reasons therefor are as follows:

(A) Investigative Records—Contract and Grant Frauds and Employee Criminal Misconduct—COMMERCE/DEPT-12, but only on condition that the general exemption claimed in § 102.33(b)(3) is held to be invalid;

(B) Investigative Records—Persons Within the Investigative Jurisdiction of USPTO—COMMERCE/DEPT-13; and

(C) Litigation, Claims, and Administrative Proceeding Records—COMMERCE/DEPT-14.

(ii) The foregoing are exempted from 5 U.S.C. 552a (c)(3), (d), (e)(1), (e)(4)(G), (H), and (I), and (f). The reasons for asserting the exemption are to maintain the ability to obtain candid and necessary information, to fulfill commitments made to sources to protect the confidentiality of information, to avoid endangering these sources and, ultimately, to facilitate proper selection or continuance of the best applicants or persons for a given position or contract. Special note is made of the limitation on the extent to which this exemption may be asserted. The existence and general character of the information exempted will be made known to the individual to whom it pertains.

(c) At the present time, USPTO claims no exemption under 5 U.S.C. 552a(k)(3), (4), (6) and (7).

[Added, 65 FR 52916, Aug. 31, 2000, effective Oct. 2, 2000]

Appendix to Part 102 - Systems of Records Noticed by Other Federal Agencies1 and Applicable to USPTO Records and Applicability of this Part Thereto

Category of records	Other federal agency
Federal Personnel Records	Office of Personnel Management.[2]
Federal Employee Compensation Act Program	Department of Labor.[3]
Equal Employment Opportunity Appeal Complaints	Equal Employment Opportunity Commission.[4]
Formal Complaints/Appeals of Adverse Personnel Actions	Merit Systems Protection Board.[5]

[1] Other than systems of records noticed by the Department of Commerce. Where the system of records applies only to USPTO, these regulations apply. Where the system of records applies generally to components of the Department of Commerce, the regulations of that department attach at the point of any denial for access or for correction or amendment.

[2] The provisions of this part do not apply to these records covered by notices of systems of records published by the Office of Personnel Management for all agencies. The regulations of OPM alone apply.

[3] The provisions of this part apply only initially to these records covered by notices of systems of records published by the U.S. Department of Labor for all agencies. The regulations of that department attach at the point of any denial for access or for correction or amendment.

[4] The provisions of this part do not apply to these records covered by notices of systems of records published by the Equal Employment Opportunity Commission for all agencies. The regulations of the Commission alone apply.

[5] The provisions of this part do not apply to these records covered by notices of systems of records published by the Merit Systems Protection Board for all agencies. The regulations of the Board alone apply.

[Added, 65 FR 52916, Aug. 31, 2000, effective Oct. 2, 2000]

PART 104 — LEGAL PROCESSES

General Provisions

Sec.
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Service of Process

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104.21 Scope and purpose.
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104.41 Procedure for filing claims.
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Subpart A — General Provisions

§ 104.1 Definitions.

Demand means a request, order, or subpoena for testimony or documents for use in a legal proceeding.

Director means the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (*see* § 1.9(j)).

Document means any record, paper, and other property held by the Office, including without limitation, official letters, telegrams, memoranda, reports, studies, calendar and diary entries, maps, graphs, pamphlets, notes, charts, tabulations, analyses, statistical or informational accumulations, any kind of summaries of meetings and conversations, film impressions, magnetic tapes, and sound or mechanical reproductions.

Employee means any current or former officer or employee of the Office.

Legal proceeding means any pretrial, trial, and posttrial stages of existing or reasonably anticipated judicial or administrative actions, hearings, investigations, or similar proceedings before courts, commissions, boards or other tribunals, foreign or domestic. This phrase includes all phases of discovery as well as responses to formal or informal requests by attorneys or others involved in legal proceedings.

Office means the United States Patent and Trademark Office, including any operating unit in the United States Patent and Trademark Office, and its predecessors, the Patent Office and the Patent and Trademark Office.

Official business means the authorized business of the Office.

General Counsel means the General Counsel of the Office.

Testimony means a statement in any form, including personal appearances before a court or other legal tribunal, interviews, depositions, telephonic, televised, or videotaped statements or any responses given during discovery or similar proceedings, which response would involve more than the production of documents, including a declaration under 35 U.S.C. 25 or 28 U.S.C. 1746.

United States means the Federal Government, its departments and agencies, individuals acting on behalf of the Federal Government, and parties to the extent they are represented by the United States.

[Added, 66 FR 47387, Sept. 12, 2001, effective Sept. 12, 2001; second sentence revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

§ 104.2 Address for mail and service; telephone number.

(a) Mail under this part should be addressed to the Office of the General Counsel, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450.

(b) Service by hand should be made during business hours to the Office of the General Counsel, 10B20, Madison Building East, 600 Dulany Street, Alexandria, Virginia.

(c) The Office of the General Counsel may be reached by telephone at 571–272–7000 during business hours.

[Added, 66 FR 47387, Sept. 12, 2001, effective Sept. 12, 2001; paras. (b) and (c) revised, 70 FR 10488, Mar. 4, 2005, effective Mar. 4, 2005; para. (a) revised, 75 FR 36294, June 25, 2010, effective June 25, 2010]

§ 104.3 Waiver of rules.

In extraordinary situations, when the interest of justice requires, the General Counsel may waive or suspend the rules of this part, *sua sponte* or on petition of an interested party to the Director, subject to such requirements as the General Counsel may impose. Any such petition must be accompanied by a petition fee of $130.00.

[Added, 66 FR 47387, Sept. 12, 2001, effective Sept. 12, 2001; revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

§ 104.4 Relationship of this Part to the Federal Rules of Civil or Criminal Procedure.

Nothing in this part waives or limits any requirement under the Federal Rules of Civil or Criminal Procedure.

[Added, 66 FR 47387, Sept. 12, 2001, effective Sept. 12, 2001]

Subpart B — Service of Process

§ 104.11 Scope and purpose.

(a) This subpart sets forth the procedures to be followed when a summons and complaint is served on the Office or on the Director or an employee in his or her official capacity.

(b) This subpart is intended, and should be construed, to ensure the efficient administration of the Office and not to impede any legal proceeding.

(c) This subpart does not apply to subpoenas, the procedures for which are set out in subpart C.

(d) This subpart does not apply to service of process made on an employee personally on matters not related to official business of the Office or to the official responsibilities of the employee.

[Added, 66 FR 47387, Sept. 12, 2001, effective Sept. 12, 2001]

§ 104.12 Acceptance of service of process.

(a) Any summons and complaint to be served in person or by registered or certified mail or as otherwise authorized by law on the Office, on the Director, or on an employee in his or her official capacity, shall be served as indicated in § 104.2.

(b) Any employee of the Office served with a summons and complaint shall immediately notify,

and shall deliver the summons and complaint to, the Office of the General Counsel.

(c) Any employee receiving a summons and complaint shall note on the summons and complaint the date, hour, and place of service and whether service was by hand or by mail.

(d) When a legal proceeding is brought to hold an employee personally liable in connection with an action taken in the conduct of official business, rather than liable in an official capacity, the employee by law is to be served personally with process. *See Fed. R. Civ. P.* 4(e). An employee sued personally for an action taken in the conduct of official business shall immediately notify and deliver a copy of the summons and complaint to the General Counsel.

(e) An employee sued personally in connection with official business may be represented by the Department of Justice at its discretion (28 CFR 50.15 and 50.16).

(f) The Office will only accept service of process for an employee in the employee's official capacity.

[Added, 66 FR 47387, Sept. 12, 2001, effective Sept. 12, 2001]

Subpart C — Employee Testimony and Production of Documents in Legal Proceedings

§ 104.21 Scope and purpose.

(a) This subpart sets forth the policies and procedures of the Office regarding the testimony of employees as witnesses in legal proceedings and the production or disclosure of information contained in Office documents for use in legal proceedings pursuant to a demand.

(b) *Exceptions.* This subpart does not apply to any legal proceeding in which:

(1) An employee is to testify regarding facts or events that are unrelated to official business; or

(2) A former employee is to testify as an expert in connection with a particular matter in which the former employee did not participate personally while at the Office.

[Added, 66 FR 47387, Sept. 12, 2001, effective Sept. 12, 2001]

§ 104.22 Demand for testimony or production of documents.

(a) Whenever a demand for testimony or for the production of documents is made upon an employee, the employee shall immediately notify the Office of the General Counsel at the telephone number or addresses in §104.2 and make arrangements to send the subpoena to the General Counsel promptly.

(b) An employee may not give testimony, produce documents, or answer inquiries from a person not employed by the Office regarding testimony or documents subject to a demand or a potential demand under the provisions of this subpart without the approval of the General Counsel. The General Counsel may authorize the provision of certified copies not otherwise available under Part 1 of this title subject to payment of applicable fees under § 1.19.

(c)(1) *Demand for testimony or documents.* A demand for the testimony of an employee under this subpart shall be addressed to the General Counsel as indicated in § 104.2.

(2) *Subpoenas.* A subpoena for employee testimony or for a document shall be served in accordance with the Federal Rules of Civil or Criminal Procedure or applicable state procedure, and a copy of the subpoena shall be sent to the General Counsel as indicated in § 104.2.

(3) *Affidavits.* Except when the United States is a party, every demand shall be accompanied by an affidavit or declaration under 28 U.S.C. 1746 or 35 U.S.C. 25(b) setting forth the title of the legal proceeding, the forum, the requesting party's interest in the legal proceeding, the reason for the demand, a showing that the desired testimony or document is not reasonably available from any other source, and, if testimony is requested, the intended use of the testimony, a general summary of the desired testimony, and a showing that no document could be provided and used in lieu of testimony.

(d) Failure of the attorney to cooperate in good faith to enable the General Counsel to make an informed determination under this subpart may serve as a basis for a determination not to comply with the demand.

(e) A determination under this subpart to comply or not to comply with a demand is not a waiver or

an assertion of any other ground for noncompliance, including privilege, lack of relevance, or technical deficiency.

(f) *Noncompliance.* If the General Counsel makes a determination not to comply, he or she will seek Department of Justice representation for the employee and will attempt to have the subpoena modified or quashed. If Department of Justice representation cannot be arranged, the employee should appear at the time and place set forth in the subpoena. In such a case, the employee should produce a copy of these rules and state that the General Counsel has advised the employee not to provide the requested testimony nor to produce the requested document. If a legal tribunal rules that the demand in the subpoena must be complied with, the employee shall respectfully decline to comply with the demand, citing *United States ex rel. Touhy* v. *Ragen*, 340 U.S. 462 (1951).

[Added, 66 FR 47387, Sept. 12, 2001, effective Sept. 12, 2001]

§ 104.23 Expert or opinion testimony.

(a)(1) If the General Counsel authorizes an employee to give testimony in a legal proceeding not involving the United States, the testimony, if otherwise proper, shall be limited to facts within the personal knowledge of the employee. Employees, with or without compensation, shall not provide expert testimony in any legal proceedings regarding Office information, subjects, or activities except on behalf of the United States or a party represented by the United States Department of Justice.

(2) The General Counsel may authorize an employee to appear and give the expert or opinion testimony upon the requester showing, pursuant to § 104.3 of this part, that exceptional circumstances warrant such testimony and that the anticipated testimony will not be adverse to the interest of the Office or the United States.

(b)(1) If, while testifying in any legal proceeding, an employee is asked for expert or opinion testimony regarding Office information, subjects, or activities, which testimony has not been approved in advance in writing in accordance with the regulations in this subpart, the witness shall:

(i) Respectfully decline to answer on the grounds that such expert or opinion testimony is forbidden by this subpart;

(ii) Request an opportunity to consult with the General Counsel before giving such testimony; and

(iii) Explain that upon such consultation, approval for such testimony may be provided.

(2) If the tribunal conducting the proceeding then orders the employee to provide expert or opinion testimony regarding Office information, subjects, or activities without the opportunity to consult with the General Counsel, the employee shall respectfully refuse to provide such testimony, citing *United States ex rel. Touhy v. Ragen*, 340 U.S. 462 (1951).

(c) If an employee is unaware of the regulations in this subpart and provides expert or opinion testimony regarding Office information, subjects, or activities in a legal proceeding without the aforementioned consultation, the employee shall, as soon after testifying as possible, inform the General Counsel that such testimony was given and provide a written summary of the expert or opinion testimony provided.

(d) *Proceeding where the United States is a party.* In a proceeding in which the United States is a party or is representing a party, an employee may not testify as an expert or opinion witness for any party other than the United States.

[Added, 66 FR 47387, Sept. 12, 2001, effective Sept. 12, 2001]

§ 104.24 Demands or requests in legal proceedings for records protected by confidentiality statutes.

Demands in legal proceedings for the production of records, or for the testimony of employees regarding information protected by the confidentiality provisions of the Patent Act (35 U.S.C. 122), the Privacy Act (5 U.S.C. 552a), the Trade Secrets Act (18 U.S.C. 1905), or any other confidentiality statute, must satisfy the requirements for disclosure set forth in those statutes and associated rules before the records may be provided or testimony given.

[Added, 66 FR 47387, Sept. 12, 2001, effective Sept. 12, 2001]

Subpart D — Employee Indemnification

§ 104.31 Scope.

The procedure in this subpart shall be followed if a civil action or proceeding is brought, in any court, against an employee (including the employee's estate) for personal injury, loss of property, or death, resulting from the employee's activities while acting within the scope of the employee's office or employment. When the employee is incapacitated or deceased, actions required of an employee should be performed by the employee's executor, administrator, or comparable legal representative.

[Added, 66 FR 47387, Sept. 12, 2001, effective Sept. 12, 2001]

§ 104.32 Procedure for requesting indemnification.

(a) After being served with process or pleadings in such an action or proceeding, the employee shall within five (5) calendar days of receipt, deliver to the General Counsel all such process and pleadings or an attested true copy thereof, together with a fully detailed report of the circumstances of the incident giving rise to the court action or proceeding.

(b)(1) An employee may request indemnification to satisfy a verdict, judgment, or award entered against that employee only if the employee has timely satisfied the requirements of paragraph (a) of this section.

(2) No request for indemnification will be considered unless the employee has submitted a written request through the employee's supervisory chain to the General Counsel with:

(i) Appropriate documentation, including copies of the verdict, judgment, appeal bond, award, or settlement proposal;

(ii) The employee's explanation of how the employee was acting within the scope of the employee's employment; and;

(iii) The employee's statement of whether the employee has insurance or any other source of indemnification.

[Added, 66 FR 47387, Sept. 12, 2001, effective Sept. 12, 2001]

Subpart E — Tort Claims

§ 104.41 Procedure for filing claims.

Administrative claims against the Office filed pursuant to the administrative claims provision of the Federal Tort Claims Act (28 U.S.C. 2672) and the corresponding Department of Justice regulations (28 CFR Part 14) shall be filed with the General Counsel as indicated in §104.2.

[Added, 66 FR 47387, Sept. 12, 2001, effective Sept. 12, 2001]

§ 104.42 Finality of settlement or denial of claims.

Only a decision of the Director or the General Counsel regarding settlement or denial of any claim under this subpart may be considered final for the purpose of judicial review.

[Added, 66 FR 47387, Sept. 12, 2001, effective Sept. 12, 2001]

SUBCHAPTER C — PROTECTION OF FOREIGN MASK WORKS

PART 150 — REQUESTS FOR PRESIDENTIAL PROCLAMATIONS PURSUANT TO 17 U.S.C. 902(a)(2)

Sec.

150.1 Definitions.
150.2 Initiation of evaluation.
150.3 Submission of requests.
150.4 Evaluation.
150.5 Duration of proclamation.
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§ 150.1 Definitions.

(a) *Director* means the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (*see* § 1.9(j)).

(b) *Foreign government* means the duly-constituted executive of a foreign nation, or an international or regional intergovernmental organization which has been empowered by its

member states to request issuance of Presidential proclamations on their behalf under this part.

(c) *Interim order* means an order issued by the Secretary of Commerce under 17 U.S.C. 914.

(d) *Mask work* means a series of related images, however fixed or encoded —

(1) Having or representing the predetermined, three-dimensional pattern of metallic, insulating, or semiconductor material present or removed from the layers of a semiconductor chip product; and

(2) In which series the relation of the images to one another is that each image has the pattern of the surface of one form of the semiconductor chip product.

(e) *Presidential proclamation* means an action by the President extending to foreign nationals, domiciliaries and sovereign authorities the privilege of applying for registrations for mask works pursuant to 17 U.S.C. 902.

(f) *Request* means a request by a foreign government for the issuance of a Presidential proclamation.

(g) *Proceeding* means a proceeding to issue an interim order extending protection to foreign nationals, domiciliaries and sovereign authorities under 17 U.S.C. Chapter 9.

(h) *Secretary* means the Secretary of Commerce.

[Added, 53 FR 24447, June 29, 1988, effective August 1, 1988; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

§ 150.2 Initiation of evaluation.

(a) The Director independently or as directed by the Secretary, may initiate an evaluation of the propriety of recommending the issuance, revision, suspension or revocation of a section 902 proclamation.

(b) The Director shall initiate an evaluation of the propriety of recommending the issuance of a section 902 proclamation upon receipt of a request from a foreign government.

[Added, 53 FR 24447, June 29, 1988, effective August 1, 1988; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

§ 150.3 Submission of requests.

(a) Requests for the issuance of a section 902 proclamation shall be submitted by foreign governments for review by the Director.

(b) Requests for issuance of a proclamation shall include:

(1) A copy of the foreign law or legal rulings that provide protection for U.S. mask works which provide a basis for the request.

(2) A copy of any regulations or administrative orders implementing the protection.

(3) A copy of any laws, regulations, or administrative orders establishing or regulating the registration (if any) of mask works.

(4) Any other relevant laws, regulations, or administrative orders.

(5) All copies of laws, legal rulings, regulations, or administrative orders submitted must be in unedited, full-text form, and if possible, must be reproduced from the original document.

(6) All material submitted must be in the original language, and if not in English, must be accompanied by a certified English translation.

[Added, 53 FR 24447, June 29, 1988, effective August 1, 1988; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

§ 150.4 Evaluation.

(a) Upon submission of a request by a foreign government for the issuance of a section 902 proclamation, if an interim order under section 914 has not been issued, the Director may initiate a section 914 proceeding if additional information is required.

(b) If an interim order under section 914 has been issued, the information obtained during the section 914 proceeding will be used in evaluating the request for a section 902 proclamation.

(c) After the Director receives the request of a foreign government for a section 902 proclamation, or after a determination is made by the Director to initiate independently an evaluation pursuant to § 150.2(a) of this part, a notice will be published in the *Federal Register* to request relevant and material comments on the adequacy and

effectiveness of the protection afforded U.S. mask works under the system of law described in the notice. Comments should include detailed explanations of any alleged deficiencies in the foreign law or any alleged deficiencies in its implementation. If the alleged deficiencies include problems in administration such as registration, the respondent should include as specifically as possible full detailed explanations, including dates for and the nature of any alleged problems. Comments shall be submitted to the Director within sixty (60) days of the publication of the *Federal Register* notice.

(d) The Director shall notify the Register of Copyrights and the Committee on the Judiciary of the Senate and the House of Representatives of the initiation of an evaluation under these regulations.

(e) If the written comments submitted by any party present relevant and material reasons why a proclamation should not issue, the Director will:

(1) Contact the party raising the issue for verification and any needed additional information;

(2) Contact the requesting foreign government to determine if the issues raised by the party can be resolved; and,

(i) If the issues are resolved, continue with the evaluation; or,

(ii) If the issues cannot be resolved on this basis, hold a public hearing to gather additional information.

(f) The comments, the section 902 request, information obtained from a section 914 proceeding, if any, and information obtained in a hearing held pursuant to paragraph (e)(ii) of this section, if any, will be evaluated by the Director.

(g) The Director will forward the information to the Secretary, together with an evaluation and a draft recommendation.

(h) The Secretary will forward a recommendation regarding the issuance of a section 902 proclamation to the President.

[Added, 53 FR 24448, June 29, 1988, effective August 1, 1988; paras. (a) & (c)-(f) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

§ 150.5 Duration of proclamation.

(a) The recommendation for the issuance of a proclamation may include terms and conditions regarding the duration of the proclamation.

(b) Requests for the revision, suspension or revocation of a proclamation may be submitted by any interested party. Requests for revision, suspension or revocation of a proclamation will be considered in substantially the same manner as requests for the issuance of a section 902 proclamation.

[Added 53 FR 24448, June 29, 1988, effective August 1, 1988]

§ 150.6 Mailing address.

Requests and all correspondence pursuant to these guidelines shall be addressed to: Mail Stop Congressional Relations, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450.

[Added 53 FR 24448, June 29, 1988, effective Aug. 1, 1988; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; revised, 70 FR 10488, Mar. 4, 2005, effective Mar. 4, 2005]