

# Chapter 500 Receipt and Handling of Mail and Papers

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## 501 Papers Received by Correspondence and Mail Division [R-14]

*37 CFR 1.1. All communications to be addressed to \*Commissioner of Patents and Trademarks.*

(a) All letters and other communications intended for the Patent and Trademark Office must be addressed to "Commissioner of Patents and Trademarks," Washington, D.C. 20231. When appropriate, a letter should also be marked for the attention of a particular officer or individual.

(b) 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 "Box PCT."

(c) Requests for reexamination should be additionally marked "Box Reexam."

(d) Payments of maintenance fees in patents and other communications relating thereto should be additionally marked "Box M. Fee."

(e) Communications relating to interferences and applications or patents involved in an interference should be additionally marked "BOX INTERFERENCE."

(f) All applications for extension of patent term and any communications relating thereto intended for the Patent and Trademark Office should be additionally marked "Box Patent Ext." When appropriate, the communication should also be marked to the attention of a particular individual, as where a decision has been rendered.

(g) All communications relating to pending litigation which are required by the Federal Rules of Civil or Appellate Procedure or by a rule or order of a court to be served on the Solicitor shall be hand-delivered to the Office of the Solicitor or shall be mailed to: Office of the Solicitor, P.O. Box 15667, Arlington, Virginia 22215 or such other address as may be designated in writing in the litigation. All other communications to the Office of the Solicitor should be addressed to: Box 8, Commissioner of Patents and Trademarks, Washington, D.C. 20231. Any communication which does not involve pending litigation which is received at P.O. Box 15667 will not be filed in the Office but will be returned. See §§ 1.302(c) and 2.145(b)(3) for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.

(h) In applications under section 1(b) of the Trademark Act, 15 U.S.C. 1051(b), all statements of use filed under section 1(d) of the Act, and requests for extensions of time therefor, should be additionally

marked "Box ITU."<

NOTE. — Sections 1.1 to 1.26 are applicable to trademark cases as well as to national and international patent cases except for provisions specifically directed to patent cases. See § 1.9 for definitions of "national application" and "international application."

[Para. (h) added, 54 FR 37588, Sept. 11, 1989, effective Nov. 16, 1989]

### *37 CFR 1.4 Nature of correspondence.*

(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 or trademark registrations, 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, §§ 1.31 to 1.378; of international applications in Subpart C, §§ 1.401 to 1.499; of reexamination of patents in Subpart D, §§ 1.501 to 1.570; of interferences in Subpart E; §§ 1.601 to 1.690; of extension of patent term in Subpart F, §§ 1.710 to 1.785; and of trademark applications §§ 2.11 to 2.189.

(b) Since each application file should be complete in itself, a separate copy of every paper to be filed in an application should be furnished for each application to which the paper pertains, even though the contents of the papers filed in two or more applications may be identical.

(c) Since different matters may be considered by different branches or sections of the Patent and Trademark Office, each distinct subject, inquiry or order should be contained in a separate letter to avoid confusion and delay in answering letters dealing with different subjects.

The official mailing address for all communications sent to the Patent and Trademark Office is:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

The physical location of the Office is 2021 Jefferson Davis Highway, Arlington, Virginia. This address should not be used on mail sent to the Patent and Trademark Office.

All mailed communications are received by the Incoming-Mail Section of the Correspondence and Mail Division, which opens and distributes all official mail.

Section 1.1(b) provides a special box "PCT" for all mail related to applications filed under the Patent Cooperation Treaty in order to expedite internal Office mail handling. Section 1.1(c) provides a special box "Reexam" for reexamination requests only, for similar reasons.

File Wrapper Continuing Applications (37 CFR 1.62) should be addressed to "Box FWC."

## 502 Depositing Papers [R-14]

### *37 CFR 1.5 Identification of application, patent or registration.*

(a) No correspondence relating to an application should be filed prior to when notification of the application number is received from the Patent and Trademark Office. When a letter 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. 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 procedure under § 1.8 or the Express Mail 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 \*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. If for some reason returned correspondence is resubmitted with proper identification later than two weeks after the return mailing by the Patent and Trademark Office, the resubmitted correspondence will be accepted but given its date of receipt. In addition to the application number, all letters directed to the Patent and Trademark Office concerning applications for patent should also state "PATENT APPLICATION," the name of the applicant, 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 letter 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) A letter relating to a trademark application should identify it as such and by the name of the applicant and the serial number and filing date of the application. A letter relating to a registered trademark should identify it by the name of the registrant and by the number and date of the certificate.

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

(e) When a paper concerns an interference, it should state the names of the parties and the number of the interference. The name of the examiner-in-chief assigned to the interference (§ 1.610) and the name of the party filing the paper should appear conspicuously on the first page of the paper.

### *37 CFR 1.6 Receipt of letters and papers.*

(a) Letters and other papers received in the Patent and Trademark Office are stamped with the date of receipt\* except where such letters and papers are filed in accordance with § 1.10. Any such letters and papers filed in accordance with § 1.10 will be stamped with the date of deposit as "Express Mail" with the United States Postal Service unless the date of deposit 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. No papers are received in the Patent and Trademark Office on Saturdays, Sundays or Federal holidays within the District of Columbia.

(b) Mail placed in the Patent and Trademark Office pouch up to

midnight on weekdays, excepting Saturdays and federal holidays, by the post office at Washington, D.C., serving the Patent and Trademark Office, is considered as having been received in the Patent and Trademark Office on the day it was so placed in the pouch.

(c) In addition to being mailed or delivered by hand during office hours, letters and other papers may be deposited up to midnight in a box provided at the guard's desk at the lobby of building 3 of the Patent and Trademark Office at Crystal Plaza, Arlington, Virginia and at the main entrance (14th Street) of the Department of Commerce Building, Washington, D.C., on weekdays except Saturdays and Federal holidays, and all papers deposited therein are considered as received in the Patent and Trademark Office on the day of deposit.

(d) If interruptions or emergencies in the United States Postal Service which have been so designated by the Commissioner occur, the Patent and Trademark Office will consider as filed on a particular date in the Office any paper or fee which is: (1) Promptly filed after the ending of the designated interruption or emergency; and (2) Accompanied by a statement indicating that such paper or fee would have been filed on that particular date if it were not for the designated interruption or emergency in the United States Postal Service. Such statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office.

Applications, amendments and other papers may be sent to the Patent and Trademark Office by mail, or they may be deposited in the Correspondence and Mail Division \*\*. >Effective on April 21, 1992, the Patent and Trademark Office is discontinuing the use of drop boxes in the lobby of Crystal Plaza Building 3, Arlington, Virginia, and at the main entrance of the Department of Commerce Building, Washington, D.C. (37 CFR 1.6(c)) as means for receiving papers. See 1137 O.G. 7, April 7, 1992.<

The Patent and Trademark Office ZIP Code designation "20231" should be used when writing the Patent and Trademark Office for any matter. In addition, the sender's own ZIP Code designation should be given.

>All correspondence related to a national patent application already filed with the Patent and Trademark Office must include the identification of the serial number and either the series code or the filing date assigned to the application by the Office. Any correspondence not containing the proper identification set forth in 37 CFR 1.5(a) must be sent by the group with a signed note to the Correspondence Branch of the Mail Room for return to the sender. Each paper should be inspected to assure that the papers being returned contain either a mailroom date stamp or a group date stamp. A minor error in the identification of the application can be corrected by the group provided the correct identification can be quickly discovered. Examples of minor errors are transposed numbers, typographical errors and listing the parent application number. The failure to give any serial number is not a minor error.< The Office often experiences difficulty in matching incoming papers with the application file to which they pertain because insufficient or erroneous information is given. This applies especially to amendments, powers of attorney, changes of address, status letters, petitions for extension of time, and other petitions.

Frequently, there are errors in the serial number or in the group art unit number, or the incoming paper uses the old group art unit number where an application has been transferred and

acted on by a different examining group.

Where the group art unit number is entirely omitted, the routine operations of the \*>Correspondence and Mail< Division must be interrupted solely for the purpose of determining the location of the application so that the communication can be properly routed. Under these circumstances the efficiency of the \*>Correspondence and Mail< Division is impaired and the incoming paper is delayed in reaching its proper destination. Where such papers are not essential to compliance with a statutory period or time limit for response, they may be returned for completion to identify the location of the files.

It would be of great assistance to the Office if *all* incoming papers pertaining to a filed application carried the following items:

1. Serial number (checked for accuracy).
  2. Group art unit number (copied from filing receipt or most recent Office Action).
  3. Filing date.
  4. Name of the examiner who prepared the most recent Office Action.
  5. Title of invention.
- Applicants may be reminded of this provision by including Form Paragraph 5.01.

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#### ¶ 5.01 Proper Heading for Incoming Papers.

It would be of great assistance to the Office if all incoming papers pertaining to a filed application carried the following items:

1. Serial number (checked for accuracy).
2. Group art unit number (copied from filing receipt or most recent Office Action).
3. Filing date.
4. Name of the examiner who prepared the most recent Office Action.
5. Title of invention.

Except for the later filing of the oath or declaration and/or filing fee accompanied by the surcharge, under \*>37 CFR< 1.16(e), which must be filed within the time set in the request therefor, it is requested that the submission of additional or supplemental papers on a newly filed application be deferred until a filing receipt has been received. It also would be appreciated if the filing of additional papers relating to an allowed application were deferred until a notice of allowance (PTOL-85) is received.

All letters relating to a reexamination proceeding should identify the proceeding involved by patent number and reexamination request control number.

### ISSUE BATCH NUMBER

All papers filed by applicant in the Office after receiving the Notice of Allowance and before the time the Issue Fee Receipt is received should include the Issue Batch Number. The Issue Batch Number is printed on the Notice of Allowance form under the heading "Batch No.". The Issue Batch Number consists of a capital letter followed by two digits, for example; "AO3", "D18", "F42", "J79". Use of the Issue Batch Numbers is

important since the allowed applications are filed by these numbers.

Any paper filed after receiving the Issue Fee Receipt should include the indicated patent number rather than the Issue Batch Number. At this time in the processing, the Issue Batch Number is no longer useful since the application has been removed from the batch at the time the patent number was assigned.

If the above suggestions are adopted the processing of both new and allowed applications could proceed more efficiently and promptly through the Patent and Trademark Office.

### HAND DELIVERY OF PAPERS

Any paper which relates to a pending application may be personally delivered to an examining group. However, the examining group will accept the paper only if: (1) the paper is accompanied by some form of receipt which can be handed back to the person delivering the paper; and (2) the examining group being asked to receive the paper is responsible for acting on the paper. Patent applications, including those filed under 37 CFR 1.60 and 1.62, may be delivered in person to the Mail Room, but not to the examining groups.

The receipt accompanying a hand delivered paper may take the form of a card identifying the paper. The identifying data on the card should be so complete as to leave no uncertainty as to the paper filed. For example, the card should contain the applicant's name(s), Serial No., the filing date and a description of the paper being filed. If more than one paper is being filed for the same application, the card should contain a description of each paper or item.

Under this procedure, the paper and receipt will be date stamped with the group date stamp. Group personnel receiving a paper will check it against the receipt to make sure that the paper is accurately described on the receipt and that the receipt does not list papers which are not being filed. The receipt will be handed back to the person hand delivering the paper. The paper will be correlated with the application and made an official paper in the file, thereby avoiding the necessity of processing and forwarding the paper to the examining group via the Mail Room.

If duplicate copies of a request for an extension of time under 37 CFR 1.136(b) are hand delivered to an examining group, both copies are dated, either stamped approved or indicated as being denied, and signed. The duplicate copy is returned to the delivering person regardless of whether the request was signed by a registered attorney or agent, either of record or acting in a representative capacity, the applicant or the assignee of record of the entire interest.

The examining group will accept and date stamp a paper, other than an application, even though the paper is accompanied by a check or the paper contains an authorization to charge a Deposit Account. However, in such an instance, the paper will be hand carried by group personnel to the Office of Finance for processing and then made an official paper in the file.

All such papers, together with the cash, checks, or money orders, shall be hand carried to the Cashier's Window, Room 2-1B01, between the hours of 3:00 p.m. and 4:00 p.m.

The papers shall be processed by the accounting clerk, Office of Finance, for pickup at the Cashier's Window by 3:00 p.m. the following work day. Upon return to the group, the papers will be entered in the application file wrappers.

### EXPRESS MAIL SERVICE

There are two types of Express Mail delivery offered by the U.S. Postal Service — "Post Office to Addressee" and "Post Office to Post Office." The only type of service which can be used for Express Mail directed to the Patent and Trademark Office is "Post Office to Addressee." This service provides for the use of a mailing label which clearly indicates the date on which a particular paper or fee was deposited.

The only address that should be used for Express Mail sent to the Patent and Trademark Office is:

"Commissioner of Patents and Trademarks  
Washington, D.C. 20231."

"Post Office to Post Office" Express Mail *does not* provide for delivery but instead is retained at the postal facility of the addressee for pickup. The Postal Service *does not* notify the addressee that this type of Express Mail has been received and is awaiting pickup. If not picked up, this mail is held for 15 days and then returned to the sender.

Therefore, since the Patent and Trademark Office does not have resources for picking up any mail, including Express Mail, the "Post Office to Post Office" Express Mail will not reach the Patent and Trademark Office.

See MPEP § 513 for the use of Express Mail under the Certificate of Mailing procedure of 37 CFR 1.10.

### 503 Serial Number and Filing Receipt [R-11]

37 CFR 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 with regard to completion of an application.

(b) Applicant will be informed of the application serial number and filing date by a filing receipt.

Serial Numbers are assigned in the Correspondence and Mail Division immediately after mail has been opened.

If a self addressed post card is submitted with a patent application, that post card will be stamped with both the receipt date and serial number prior to returning it to the addressee.

The identifying data on the post card should include: (1) applicant's name(s); (2) title of invention; (3) number of pages of specification, claims, and sheets of drawing; (4) whether oath or declaration included; and (5) amount and manner of paying the fee.

A return post card should be attached to *each* patent application for which a receipt is desired.

It is important that the return post card itemize all of the components of the application. If the post card does not itemize each of the components of the application, it will not serve as evidence that any component which was not itemized was received by the Office.

It should be recognized that the identification of an application by Serial Number does not necessarily signify that the Patent and Trademark Office has accepted the application as complete (>37 CFR< 1.53(a)).

An application is entitled to a filing date as of the date of the identification of all of the inventors and receipt of the specification, including claims, and any required drawing. However, the filing receipt will not be mailed until the oath or declaration and basic filing fee have also been received. The oath or declaration and filing fee may be filed later than the remaining application papers, but if so, they must be accompanied by the required surcharge. If the oath or declaration, and/or filing fee, and appropriate surcharge are not timely filed, the application will be abandoned and no filing receipt will be mailed. Otherwise, the filing receipt will be mailed upon the timely receipt of the oath or declaration, and/or filing fee and surcharge.

In the Application Division each application which meets the requirements is given a filing date. It is important, when referring to application files, to identify them by their filing dates as well as by serial numbers.

The Application Division mails a filing receipt to the attorney or agent, if any, otherwise to the applicant, for each complete application filed, giving the serial number, filing date, and group to which assigned. See >MPEP< § 506.

In the Application Division the application papers are placed in a file wrapper and certain data placed thereon.

### RETURN POST CARD

If a receipt of any paper filed in the Patent and Trademark Office is desired, it may be obtained by enclosing with the paper a self-addressed post card identifying the paper. The Patent and Trademark Office will stamp the receipt date on the card and place it in the outgoing mail.

The identifying data on the card should be so complete as to clearly identify the paper for which receipt is requested. For example, the card should identify the applicant's name(s), serial number, filing date, interference number, etc., and the paper(s) should be identified by specifying the type thereof, namely affidavit, amendment, appeal, components of applications, brief, drawings, fees, motions, supplemental oath or declaration, petition, etc.

The person receiving the paper(s) in the Patent and Trademark Office should check the listing on the post card against the papers being filed to be sure they are properly identified and that all the items listed are present. If any of the items listed are not being filed those items should be crossed off and the card initialed by the person receiving the papers.

A post card receipt which itemizes and properly identifies the papers which are being filed serves as prima facie evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO.

When papers for more than one document are filed under a single cover a return addressed post card should be attached to the paper for *each* document for which a receipt is desired.

## 504 Assignment of Applications for Examination

The Application Division assigns the application to the examining group to which it appears to belong.

## 505 "Office Date" Stamp of Receipt [R-11]

The Office stamps papers and fees with the date of their receipt in the Patent and Trademark Office or the date of their deposit in accordance with 37 CFR 1.10 except when the date of deposit in accordance with 37 CFR 1.10 is a Saturday, Sunday, or federal holiday within the District of Columbia. Papers and fees filed in accordance with 37 CFR 1.10 on a Saturday, Sunday, or a federal holiday within the District of Columbia are date stamped with the date of the next succeeding day which is not a Saturday, Sunday, or federal holiday within the District of Columbia. The stamp is referred to as the "Office Date" stamp.

When the last day for taking any action or paying any fee in the U.S. Patent and Trademark Office falls on a Saturday, Sunday, or a federal holiday within the District of Columbia, the action or the fee is considered timely if the action is taken or the fee is paid on the next succeeding business day.

If an application includes the necessary components for a filing date (see 37 CFR 1.41(a) and 1.53(b) and MPEP § 506), the "Office Date" stamp establishes the "filing date." Applications will not be accepted and stamped in the examining groups. They must be date stamped in the Mail Room.

## 506 Completeness of Original Application [R-14]

*37 CFR 1.53 Serial number, filing date, and completion of application.*

(a) Any application for a patent received in the Patent and Trademark Office will be assigned a serial number for identification purposes.

(b) The filing date of an application for patent filed under this section is the date on which: (1) a specification containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75; and (2) any drawing required by § 1.81(a), are filed in the Patent and Trademark Office in the name of the actual inventor or inventors as required by § 1.41. No new matter may be introduced into an application after its filing date (§ 1.118). If all the names of the actual inventor or inventors are not supplied when the specification and any required drawing are filed, the application will not be given a filing date earlier than the date upon which the names are supplied unless a petition with fee set forth in § 1.17(i)(1) is filed which sets forth the reasons the delay in supplying the names should be excused. A continuation or divisional application (filed under the conditions specified in 35 U.S.C. 120 or 121 and § 1.78(a)) may be filed pursuant to this section, § 1.60 or § 1.62. A continuation-in-part application may be filed pursuant to this section or § 1.62.

(c) If any application is filed without the specification, drawing, or name, or names of the actual inventor or inventors required by paragraph (b) of this section, applicant will be so notified and given a time period within which to submit the omitted specification, drawing, name, or names, of the actual inventor, or inventors, in order to obtain a filing date as of the date of filing of such submission. A copy of the "Notice of Incomplete Application" form notifying the applicant should accompany any response thereto submitted to the

Office. If the omission is not corrected within the time period set, the application will be returned or otherwise disposed of; the fee, if submitted, will be refunded less the handling fee set forth in § 1.21(n).

(d) If an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include the appropriate filing fee or an oath or declaration by the applicant, applicant will be so notified, if a correspondence address has been provided and given a period of time within which to file the fee, oath, or declaration and to pay the surcharge as set forth in § 1.16(e) in order to prevent abandonment of the application. A copy of the "Notice to File Missing Parts" form mailed to applicant should accompany any response thereto submitted to the Office. If the required filing fee is not timely paid, or if the processing and retention fee set forth in § 1.21(l) is not paid within one year of the date of mailing of the notification required by this paragraph, the application will be disposed of. No copies will be provided or certified by the Office of an application which has been disposed of or in which neither the required basic filing fee nor the processing and retention fee has been paid. The notification pursuant to paragraph (c) of this section. If no correspondence address is included in the application, applicant has two months from the filing date to file the basic filing fee, oath or declaration and to pay the surcharge as set forth in § 1.16(e) in order to prevent abandonment of the application; or, if no basic filing fee has been paid, one year from the filing date to pay the processing and retention fee set forth in § 1.21(l) to prevent disposal of the application.

(e) An application for a patent will not be placed upon 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.

(f) The filing date of an international application designating the United States of America shall be treated as the filing date in the United States of America under PCT Article 11(3), except as provided in 35 U.S.C. 102(e).

[Paras. (b) & (c), 54 FR 47518, Nov. 15, 1989, effective Jan. 16, 1990]

## INCOMPLETE APPLICATIONS

If the application papers do not identify all the inventors or include at least a specification containing a description and at least one claim and any required drawing, whether prescribed by 35 U.S.C. 113 or because it is described in the specification, or if the submitted application papers are too informal to be given a filing date, the case is held in the Application Division as an *incomplete* application and the applicant is informed of the shortcomings of the papers. No filing date is granted until the incompleteness is corrected.

Form PTO-1123, Notice of Incomplete Application Papers, is prepared and mailed by the Application Division when application papers are deemed incomplete under 35 U.S.C. 111.

Such incompleteness may consist of the omission of any one of the following parts of an application. The component parts of an application necessary to obtain a filing date are:

An identification of the names of all of the inventors.

A specification, 35 U.S.C. 112.

A claim, 35 U.S.C. 112.

A drawing, if required by 35 U.S.C. 113 or if described in the specification.

Filing dates are accorded to applications filed without the basic filing fee and without the oath or declaration. In such cases

a notice is mailed by Application Division requiring at least the basic filing fee and the oath or declaration be filed, accompanied by a surcharge (§ 1.16(e)). In those cases where the basic filing fee is paid, but additional fees are required, a notice is mailed by the examining group, requiring that the balance of the fee be paid.

Occasionally applications which have already been signed by the inventors contain informal claims that the attorney or agent feels should not be present in the application upon filing. However, since alteration after execution by the inventor and before filing is prohibited\*\*, such applications must be filed by the attorney or agent in the form in which they were executed by the inventors. An application may be filed with a preliminary amendment which is limited to the cancellation of claims. This will diminish the number of claims to be considered for calculation of the filing fee. Any other changes to the application should be the subject of a separate amendment which may be entered after the filing fee has been calculated and the filing date granted. If a preliminary amendment which cancels claims does not accompany the application at the time the application is filed, the notification of insufficient fee will inform the inventor, attorney or agent of the possibility of correcting the insufficient payment by either (1) paying the additional required fee amount, or (2) filing an amendment which cancels claims to where the remaining claims are covered by the fee submitted upon filing. However, no refund will be made once the fee for claims is properly paid, even though claims are later canceled.

Since the oath or declaration may be filed later than the specification, including claims, and drawing, without changing the filing date of the application, no need is seen for the filing of oaths or declarations with facsimile signatures. Unsigned copies of the oath or declaration may of course be filed to provide the names of the inventors. However, a facsimile declaration does not meet the requirements of an executed oath or declaration. Therefore, in those instances where a facsimile oath or declaration has been filed, a new oath or declaration will be required, as well as the payment of the surcharge (37 CFR 1.16(e)).

In the past the Application Division has reviewed the claimed subject matter of newly filed applications to determine whether a filing date should be granted. Such applications included those drawn to perpetual motion devices and methods of doing business and applications for reissue signed by assignees or filed more than two years after the grant of the patent which appear to contain broadened reissue claims.

Under the current practice, a filing date is normally granted in such cases if the application is otherwise sufficient, and then forwarded to the examiner for consideration and decision during the regular course of examination.

### INFORMAL APPLICATIONS

An application is informal if it is typed on both sides of the paper, or is not permanent, legible or reproducible. If such informalities are timely corrected, the application is given the filing date on which the original informal papers were filed.

The Application Division accords a filing date, as of the date

indicated by the "Office Date" stamp (see MPEP >§< 505), to application papers which include the names of all of the inventors, a specification containing a description and at least one claim, and any drawing required by 35 U.S.C. 113 or described in the specification but are informal because they do not comply with the rules or notices. In such applications, the Application Division prepares form PTO-152, Notice of Informal Application indicating the informality and places it in the file wrapper. The examining group mails the letter to applicant. Failure to correct the informality within the specified time results in abandonment of the application.

The letter of transmittal accompanying the filing of continuing applications should include such additional information as the identification by serial number of the parent application, its status, and location in the Patent and Trademark Office. The supplying of this information will simplify the processing of these applications.

When a new application is filed with a request to transfer drawings under 37 CFR 1.88, the application papers should include drawing prints to enable the Application Division to process the case before transfer of the formal drawings is effected.

### 506.01 Return of Incomplete Application

If a request is made, the parts of an incomplete application which has not been assigned a filing date may be returned by the Application Division. They may be used by applicant as part of a later complete application if the missing parts are later supplied. See 37 CFR 1.53.

### 506.02 Review of Refusal To Accord Filing Date [R-14]

The filing date of the application is the date of receipt in the Office of the application which identifies the names of all the inventors and includes a specification containing description pursuant to \*>37 CFR< 1.71 and at least one claim pursuant to \*>37 CFR< 1.75, and drawings required by \*>37 CFR< 1.81(a) or which have been described in the specification. See 37 CFR 1.41(a) and 1.53(b).

If any of these items are missing, applicant will be notified to file them and the filing date will be the date of receipt of the missing part(s). See MPEP § 601.01.

Any review of the refusal to grant a filing date as of the date of deposit of the application would be by way of petition, accompanied by the petition fee (37 CFR 1.17(h)). Petitioner should provide any arguments that he or she has that the items noted were not missing or that a filing date should be assigned in the absence of such items if they are believed to be unnecessary. If petitioner alleges that no defect exists, a request for refund of the petition fee may be included in the petition.

For applications properly filed under 37 CFR 1.10, the filing date is the date that the application was deposited as "Express Mail" in the U.S. Postal Service, unless it was deposited on a Saturday, Sunday, or federal holiday within the District of

Columbia in which case the filing date is the next succeeding day which is not a Saturday, Sunday, or federal holiday within the District of Columbia. If the proper procedures were not followed, the application will receive a filing date as of the date it was received in the Office. Any review of these matters would be by way of petition, accompanied by the petition fee (37 CFR 1.17(h)), providing whatever arguments and evidence petitioner has that the application is entitled to a filing date as of the date it was mailed via "Express Mail".

Any petition under this section should be marked to the attention of the Office of the Assistant Commissioner for Patents.

### 507 Drafting Division [R-11]

The drawing is inspected by the Drafting Division for formal compliance with the rules. If the drawing is satisfactory, it is stamped "approved". If the drawing contains defects which are not so serious as to warrant holding the application to be incomplete, the Draftsman checks the appropriate notation on the "Notice of Informal Patent Drawing" form PTO-948.

- See >MPEP< § 608.02(a) for handling of photoprints filed in lieu of drawings.

### 508 Distribution [R-11]

The Customer Services Division prepares permanent prints made of the drawings of all complete applications and secures the prints in the file wrappers. The drawings and files are then assembled and forwarded to the examining operation.

When a new or substitute drawing is received, a print is made and forwarded to the group to be placed in the file as an official paper.

As to the procedure to be followed when a model is filed, see >MPEP< § 608.03 and § 608.03(a).

#### 508.01 Papers Sent to Wrong Group

If drawings, amendments or other papers are delivered to the wrong group, the current group assignment should be obtained from PALM and be placed on the paper and then forwarded to the appropriate group. The assignment indicated by PALM may be verified by calling the group indicated before forwarding the paper.

A terminal disclaimer should not be routed directly to an examining group. If such a paper (without the file) is received, it should be promptly forwarded *without the file* to the Patent Issue Division. In some situations the Patent Issue Division may be holding a terminal disclaimer. This may be checked by calling the >Supervisor< of the Patent Issue Division by telephone.

#### 508.02 Papers Received After Patenting or Abandonment

After an application is patented or abandoned, any incoming

communication which is not to become part of the record is sent to the Correspondence and Mail Division for handling with the status of the application indicated thereon.

### 508.03 Unmatched Papers [R-14]

Unmatched papers within a group should be frequently reviewed to determine which should be sent to the Paper Correlating Office (PCO).

Item 1 below treats the papers in the "Serial number too high" category. Items 2-6 below are directed to all other unmatched papers not in the "Serial number too high category."

#### 1. Unmatched papers in the "Serial No. Too High" category

This collection of papers being held by the group should be reviewed *at least* once a week. Any paper having a serial number which clearly should have already been received by the group should be removed from this collection. Where the group does not have a corresponding application for any of these papers, inquiry should be made of the Application Division to determine the group of record. If another group number is indicated, the paper should be forwarded to that group. If the Application Division does not yield a new group number for the indicated Serial No., the paper should be sent to the PCO.

#### 2. Unmatched papers having a serial number

It can be assumed that either the group number or the serial number on these papers is incorrect. Inquiry should be made of the Application Division and PALM to determine the group of record and the procedure set out in item 1 above followed. An exception to this practice should be made where the paper has thereon the name of an examiner in the group. In these situations a careful check of the group records and files as well as consultation with the indicated examiner should be made to determine the correct serial number. If this does not yield a new serial number the paper should be sent to the PCO.

#### 3. Unmatched papers relating to cases abandoned from group

The file should be ordered from Abandoned Files. If the file is not received therefrom, the paper should be forwarded to the PCO. Charge Card, PTO-125, returned by Abandoned Files should be stapled to the paper when it is sent to the PCO.

#### 4. Papers for applications which have been sent to the Patent Issue Division

All papers for applications which PALM indicates to be located in any of the locations 730 through 765 should be forwarded to the Query and Correspondence Section of the Allowed Files Branch of the Patent Issue Division, \*via the Office of Publications messenger. Such papers may be left for pickup by the messenger in the "Allowed Files Pickup/Delivery" boxes which are located in each examining group.

The instructions of this section (4) apply to all files in Issue including those which have been assigned a Patent Number and Issue Date. Papers requiring examiner review and action will be returned to the examining group after the Patent Issue Division personnel have matched the paper to the appropriate file.

### 5. Papers for applications which have been sent to the Record Room

If PALM indicates that the application for a paper is in the Record Room (location code 810 or 820), the paper should be forwarded to the Paper Correlating Office for response.

### 6. Unmatched papers for cases which are known to be pending in the group but cannot be located

Generally these are applications which PALM indicates are present in the group, but the file is not immediately available. These papers should be retained in the group for processing.

Each paper sent to the PCO must have a PCO Transmittal Form stapled thereto. Each form attached to a paper should be filled out as completely as possible. Transmittal Forms attached to papers in categories 1 and 2 must have an indication of the information obtained from both Application Division and PALM. The PALM information should be inserted in the large space at the bottom of the Form. This will help eliminate duplication of effort by PCO personnel. Papers received without transmittal forms or with incompletely filled out transmittal forms may be returned to the originating group.

## 509 Payment of Fees [R-14]

For national application filing fees, see 37 CFR 1.16.

For patent application processing fees, see 37 CFR 1.17.

For patent issue fees, see 37 CFR 1.18.

For document supply fees, see 37 CFR 1.19.

For post-issuance fees, see 37 CFR 1.20.

For miscellaneous fees and charges, see 37 CFR 1.21.

### 37 CFR 1.22 Fees payable in advance.

(a) Patent and trademark fees and charges payable to the 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 patent and trademark fees paid to the Patent and Trademark Office should 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.

### 37 CFR 1.23 Method of payment.

All payments of money required for Patent and Trademark Office fees, including fees for the processing of international applications (§ 1.445), should be made in U.S. specie, Treasury notes, national bank notes, post office money orders, or by certified check. If sent in any other form, the Office may delay or cancel the credit until collection is made. Money orders and checks must be made payable to the Commissioner of Patents and Trademarks. Remittances from foreign countries must be payable and immediately negotiable in the United States for the full amount of the fee required. Money sent by mail to the Patent and Trademark Office will be at the risk of the sender; letters containing money should be registered.

### 37 CFR 1.24 Coupons.

Coupons in denominations of three dollars for the purchase of patents, designs, defensive publications, statutory invention registrations, and trademark registrations are sold by the Patent and Trademark Office for the convenience of the general public; these coupons may not be used for any other purpose. The three-dollar coupons are sold individually and in books of 50 for \$150.00. These coupons are good until used; they may be transferred but cannot be redeemed.

[Amended Dec. 13, 1991, 56 FR 65142, effective Dec. 16, 1991]

### 37 CFR 1.26 Refunds.

(a) Money paid in excess will be refunded, but a mere change of purpose after the payment of money, as when a party desires to withdraw an application, an appeal, or a request for oral hearing, will not entitle a party to demand such a return. Amounts of twenty five dollars or less will not be returned unless specifically requested within a reasonable time, nor will the payer be notified of such amount; amounts over twenty five dollars may be returned by check or, if requested, by credit to a deposit account.

(b) [Reserved]

(c) If the Commissioner decides not to institute a reexamination proceeding, a refund of \$1,690 will be made to the requester of the proceeding. Reexamination requesters should indicate whether any refund should be made by check or by credit to a deposit account.

[Paras. (a) & (c), 57 FR 38190, Aug. 21, 1992, effective Oct. 1, 1992]

## 509.01 Deposit Accounts [R-14]

### 37 CFR 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 fees 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, 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 to 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 respect to a particular paper filed. An authorization to charge to a deposit account the fee for a request for reexamination pursuant to § 1.510 and any other fees required in a reexamination proceeding in a patent may also be filed with the request for reexamination. 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 as to the particular fee to be charged unless sufficient funds are present in the account to cover



the fee.

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An overdrawn account will be immediately suspended and no charges will be accepted against it until a proper balance is restored, together with a payment of ten dollars (37 CFR 1.21(b)(1)) to cover the work done by the Patent and Trademark Office incident to suspending and reinstating the account and dealing with charges which may have been made in the meantime.

For applications filed prior to February 27, 1983, if the Office discovers that a filing fee for an application was charged to an account with insufficient funds, or to an overdrawn account, the filing date of the application will be withdrawn.

For applications filed after February 27, 1983, if there is an authorization to charge the filing fee to a deposit account which is overdrawn or has insufficient funds, a surcharge (37 CFR 1.16(e)) is required in addition to payment of the filing fee. Failure to timely pay the filing fee and surcharge will result in abandonment of the application.

It is expected, however, that reasonable precautions will be taken in all cases to avoid overdrafts, and if an account is suspended repeatedly it will be necessary to close it.

Similarly, because of the burden placed on the Patent and Trademark Office incident to the operation of deposit accounts, a charge of ten dollars (37 CFR 1.21(b)(1)) will be made for opening each new account.

#### DEPOSIT ACCOUNT AUTHORIZATIONS

The rules of practice were amended effective Oct. 1, 1982, at 37 CFR 1.25(b) to state that: "A general authorization to charge all fees or only certain fees set forth in 37 CFR 1.16 to 1.18 to a deposit account may be filed in an individual application, either for the entire pendency of the application or with respect to a particular paper filed." A general authorization does not apply to document supply fees under 37 CFR 1.19, such as those required for certified copies, to post-issuance fees under 37 CFR 1.20, such as those required for maintenance fees; or to miscellaneous fees and charges under 37 CFR 1.21, such as assignment recording fees.

Many applications filed prior to Oct. 1, 1982, contain broad language authorizing any additional fees which might have been due to be charged to a deposit account. The Patent and Trademark Office does not interpret such broad authorizations, filed prior to Oct. 1, 1982, to include authorization to charge to a deposit account the issue fee or other fees in 37 CFR 1.16, 1.17 and 1.18 except those associated with the paper containing the broad authorization. However, such a broad authorization filed in an application on or after Oct. 1, 1982, will be interpreted as authorization to charge the issue fee; as well as any other fee set forth in 37 CFR 1.16, 1.17 or 1.18. Fees under 37 CFR 1.19, 1.20 and 1.21 will not be charged as a result of a general authorization under 37 CFR 1.25.

It is recommended that authorizations to charge fees to deposit accounts include reference to the particular fees or fee sections of the rules which applicant intends to authorize. For

example, if filing and processing fees under 37 CFR 1.16 and 1.17 only are intended to be included in the authorization, and not the issue fee under 37 CFR 1.18, the authorization could read: "The Commissioner is hereby authorized to charge any fees under 37 CFR 1.16 and 1.17 which may be required during the entire pendency of the application to Deposit Account No. — — — ." Such an authorization would clearly exclude issue fees under 37 CFR 1.18 while including all the filing and processing fees listed in 37 CFR 1.16 and 1.17. Similarly, if it were intended to authorize the charging of fees relating only to a specific paper, the authorization could read "The Commissioner is hereby authorized to charge any fees under 37 CFR 1.16 and 1.17 which may be required by this paper to Deposit Account No. — — — ." Such authorizations would cover situations in which a check to cover a filing and processing fee under 37 CFR 1.16 and 1.17 was omitted or was for an amount less than the amount required.

It is extremely important that the authorization be clear and unambiguous. If applicants file authorizations which are ambiguous and deviate from the usual forms of authorizations, the Office may not interpret the authorizations in the manner applicants intend. In such cases applicants could be subject to further expenses, petitions, etc. in order to correct fees which were not charged as intended due to an ambiguous authorization.

#### 509.02 Small Entity Status — Definitions [R-14]

Public Law 97-247, enacted August 27, 1982, provides that effective October 1, 1982 funds available under the Act to the Patent and Trademark Office "shall be used to reduce by 50 per centum the payment of fees under section 41 (a) and (b) of title 35, United States Code, by independent inventors and nonprofit organizations as defined in regulations established by the Commissioner of Patents and Trademarks, and by small business concerns as defined in Section 3 of the Small Business Act and by regulations established by the Small Business Administration." The fees which are reduced include patent application filing fees (37 CFR 1.16), extension of time, revival, and appeal fees (37 CFR 1.17), patent issue fees (37 CFR 1.18), statutory disclaimer fee (37 CFR 1.20(d)) and maintenance fees on patents **\*\***(37 CFR 1.20**\*\***). Other fees, established under section 41 (c) or (d) of Title 37, United States Code, are not reduced for small entities since such a reduction is not permitted or authorized by Public Law 97-247.

Fees which are not reduced include petition and processing fees (other than revival), 37 CFR 1.17(h)-(k), document supply fees, 37 CFR 1.19, certificate of correction fees, 37 CFR 1.20(a), request for reexamination fees, 37 CFR 1.20(c), **\*\***miscellaneous fees and charges, 37 CFR 1.21, and international application fees, 37 CFR 1.445.

Public Law 97-247 gave the Commissioner authority to establish regulations defining independent inventors and nonprofit organizations. These definitions have been established as 37 CFR 1.9 (c) and (e). The Small Business Administration was given authority to establish the definition of a small business

concern. This definition is published in 37 CFR 1.9(d). A small entity for purposes of paying reduced fees is defined in 37 CFR 1.9(f) as an independent inventor, a small business concern or a nonprofit organization.

#### § 1.9 Definitions.

(a) A national application as used in this chapter means a U.S. national application for patent which was either filed in the Office under 35 U.S.C. 111 or which resulted from an international application after compliance with 37 CFR 371.

(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) An independent inventor as used in this chapter means any inventor who (1) has not assigned, granted, conveyed, or licensed, and (2) is under no obligation under contract or law to assign, grant, convey, or license, any rights in the invention to any person who could not likewise be classified as an independent inventor if that person had made the invention, or to any concern which would not qualify as a small business concern or a nonprofit organization under this section.

(d) A small business concern as used in this chapter means any business concern as defined by the Small Business Administration in 13 CFR 121.12. For the convenience of the users of these regulations, that definition states:

#### § 121.12 Small business for paying reduced patent fees.

(a) Pursuant to Pub. L. 97-247, a small business concern for purposes of paying reduced fees under 35 U.S. Code 41 (a) and (b) to the Patent and Trademark Office means any business concern (1) whose number of employees, including those of its affiliates, does not exceed 500 persons and (2) which 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 who could not be classified as an independent inventor if that person had made the invention, or to any concern which would not qualify as a small business concern or a nonprofit organization under this section. For the purpose of this section concerns are affiliates of each other when either, directly or indirectly, one concern controls or has the power to control the other, or a third party or parties controls or has the power to control both. The number of employees of the business concern is the average over the fiscal year of the persons employed during each of the pay periods of the fiscal year. Employees are those persons employed on a full-time, part-time or temporary basis during the previous fiscal year of the concern.

(b) If the Patent and Trademark Office determines that a concern is not eligible as a small business concern within this section, the concern shall have a right to appeal that determination to the Small Business Administration. The Patent and Trademark Office shall transmit its written decision and the pertinent size determination file to the SBA in the event of such adverse determination and size appeal. Such appeals by concerns should be submitted to the SBA at 1441 L Street, NW., Washington, D.C. 20416 (Attention: SBA Office of General Counsel). The appeal should state the basis upon which it is claimed that the Patent and Trademark Office initial size determination on the concern was in error; and the facts and arguments supporting the concern's claimed status as a small business concern under this section.

(e) A nonprofit organization as used in this chapter means (1) a university or other institution of higher education located in any country; (2) an organization of the type described in section 501(c)(3) of the Internal Revenue Code of 1954 (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)); (3) 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 (4) any nonprofit organization located in a foreign country which would qualify as a nonprofit organization under paragraphs (e) (2) or (3) of this section if it were located in this country.

(f) A small entity as used in this chapter means an independent inventor, a small business concern or a nonprofit organization.

(g) For definitions in interferences see § 1.601.

## INDEPENDENT INVENTOR

37 CFR 1.9(c) defines an independent inventor as any inventor who (1) has not assigned, granted, conveyed, or licensed, and (2) is under no obligation under contract or law to assign, grant, convey, or license, any rights in the invention \*\*to any person who could not likewise be classified as an independent inventor if that person had made the invention, or to any concern which would not qualify as a small business concern or a nonprofit organization. >The "rights in the invention" are the rights in the United States.< Once an individual sole inventor, or one of several joint inventors, has assigned, granted, conveyed, or licensed, or comes under an obligation to assign, grant, convey, or license, any rights to the invention to anyone who could not likewise obtain status as a small entity, the inventor(s) will no longer be entitled to pay fees in the amounts established for an independent inventor (37 CFR 1.9(c)).

Rights in the invention include the right to make, use or sell the invention or the right to exclude others from making, using or selling the invention. Therefore, for example, status as a small entity is lost by an inventor who has transferred or has an obligation to transfer a shop right to an employer who could not qualify as a small entity.

37 CFR 1.9(c) permits an individual inventor to make an assignment, grant, conveyance, or license of partial rights in the invention to another individual or individuals who could qualify as an independent inventor or inventors if they had made the invention. In addition, 37 CFR 1.9(c) permits an individual inventor to make an assignment, grant, conveyance, or license of partial rights in the invention to a small business concern or nonprofit organization. Under the circumstances described in the previous two sentences the individual inventor could still qualify as an independent inventor. However, if the independent inventor assigned, granted, conveyed, or licensed, or came under an obligation to assign, grant, convey, or license, any rights to the invention to any individual or organization which could not qualify as a small entity (37 CFR 1.9(f)), then the inventor would no longer qualify as an independent inventor.

## SMALL BUSINESS CONCERN

37 CFR 1.9(d) provides that, in order to be a small business, the number of employees of the concern, including those of its affiliates, may not exceed 500 persons. Concerns are affiliates of each other when either, directly or indirectly, one concern controls or has the power to control the other, or a third party or parties controls or has the power to control both. For discussion and example of what constitutes "control" see the regulations of the Small Business Administration. The number of employees

of a business concern is determined by counting the number of persons of the concern and its affiliates employed on a full-time, part-time or temporary basis during the previous fiscal year of the concern and of its affiliates. The number of employees is the average over the fiscal year of the persons employed during each of the pay periods of the fiscal year.

The definition also requires a small business for this purpose to be one "which 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 who could not be classified as an independent inventor if that person had made the invention, or to any concern which would not qualify as a small business concern or a nonprofit organization under this section."

#### NONPROFIT ORGANIZATIONS

37 CFR 1.9(e) defines a nonprofit organization by utilizing and broadening the definition contained in 35 U.S.C. 201(i). The term "university or other institution of higher education" as used in 37 CFR 1.9(e) means an educational institution which (1) admits as regular students only persons having a certificate of graduation from a school providing secondary education, or the recognized equivalent of such a certificate, (2) is legally authorized within the jurisdiction in which it operates to provide a program of education beyond secondary education, (3) provides an educational program for which it awards a bachelor's degree or provides not less than a two-year program which is acceptable for full credit toward such a degree, (4) is a public or other nonprofit institution, and (5) is accredited by a nationally recognized accrediting agency or association. The definition of "university or other institution of higher education" as set forth herein essentially follows the definition of "institution of higher education" contained in 20 U.S.C. 1141(a). Institutions which are strictly research facilities, manufacturing facilities, service organizations, etc., are not intended to be included within the term "other institution of higher education" even though such institutions may perform an educational function or publish the results of their work.

Nonprofit organizations also include organizations of the type described in section 501(c)(3) of the Internal Revenue Code of 1954 (26 U.S.C. 501(c)(3)) and which are exempt from taxation under 26 U.S.C. 501(a). Organizations described in 26 U.S.C. 501(c)(3) include corporations, and any community chest, fund, or foundation, organized and operated exclusively for religious, charitable, scientific, testing for public safety, literary, or educational purposes, or to foster national or international amateur sports competition (but only if no part of its activities involve the provision of athletic facilities or equipment), or for the prevention of cruelty to children or animals, no part of the net earnings of which inures to the benefit of any private shareholder or individual, no substantial part of the activities of which is carrying on propaganda, or otherwise attempting to influence legislation and which does not participate in, or intervene in (including the publishing or distributing of statements), any political campaign on behalf of any candi-

date for public office.

#### LOCATION OF SMALL ENTITY

Small entities may claim reduced fees regardless of the country in which they are located. There is no restriction requiring that the independent inventor, small business concern or nonprofit organization be located in the United States. The same definitions apply to all applicants equally in accordance with the Paris Convention for the Protection of Industrial Property.

#### TRANSFER OF RIGHTS

With regard to transfer of rights in the invention, the rights in question are those in the United States to be covered by the application or patent. Transfer of rights to a Japanese patent, for example, would not affect small entity status if no rights in the United States patent were likewise transferred.

The payment of reduced fees under section 41 (a) and (b) of Title 35, United States Code, is limited to those situations in which all of the rights in the invention are owned by small entities, i.e., independent inventors, small business concerns, or nonprofit organizations. To do otherwise would be clearly contrary to the intended purpose of the legislation which contains no indication that fees are to be reduced in circumstances where rights are owned by non-small entities. For example, a non-small entity is not permitted to transfer patent rights to a small business concern which would pay the reduced fees and grant an exclusive license to the non-small entity.

If rights transferred to a non-small entity are later returned to a small entity so that all rights are held by small entities, reduced fees may be claimed.

The term "license" in the definitions includes non-exclusive as well as exclusive licenses and royalty free as well as royalty generating licenses. Implied licenses to use and resell patented articles purchased from a small entity, however, will not preclude the proper claiming of small entity status. Likewise, an order by an applicant to a firm to build a prototype machine or product for the applicant's own use is not considered to constitute a license for purposes of the definitions.

#### RIGHTS HELD BY GOVERNMENT ORGANIZATIONS

Also, although the Federal government agencies do not qualify as nonprofit organizations for paying reduced fees under the rules, a license to a Federal agency resulting from a funding agreement with the agency pursuant to 35 U.S.C. 202(c)(4) will not preclude the proper claiming of small entity status.

Public Law 96-517 added a new chapter 38 of Title 35 of the United States Code entitled "Patent Rights in Inventions Made With Federal Assistance." Under the provisions of the statute, each funding agreement between a Federal agency and an individual, small business firm or nonprofit organization must provide, inter alia, that ". . . the Federal agency shall have a nonexclusive, nontransferrable, irrevocable, paid up license to

practice or have practiced for or on behalf of the United States any subject invention . . ." See 35 U.S.C. 202(c)(4).

Under the provisions of 37 CFR 1.9 and 1.27, an independent inventor, small business concern or nonprofit organization cannot qualify for reduced patent fees if it has assigned, granted, conveyed or licensed or is under an obligation under contract or law to assign, grant, convey or license any rights in the invention to other than an individual who could be classified as an independent inventor if that person had made the invention, a small business concern or a nonprofit organization. The Federal agencies do not qualify as nonprofit organizations for paying reduced patent fees under the rules. Applying this construction to the licensing of an invention to a Federal agency by an independent inventor, small business concern or nonprofit organization pursuant to a funding agreement under 35 U.S.C. 202(c)(4) would preclude their qualifying for paying reduced fees. This, however, would frustrate the intent of Public Law 97-247 and Public Law 96-517 when taken together.

Government organizations as such, whether domestic or foreign, cannot qualify as nonprofit organizations as defined in 37 CFR 1.9(e). Thus, for example, a government research facility or other government-owned corporation could not qualify. 37 CFR 1.9(e) was based upon 35 U.S.C. 201(i), as established by Public Law 96-517. The limitation to "an organization of the type described in section 501(c)(3) of the Internal Revenue Code of 1954 (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))" would by its nature exclude the U.S. government and its agencies and facilities, including research facilities and government corporations. State and foreign governments and governmental agencies and facilities would be similarly excluded. 37 CFR 1.9(e) is not intended to include within the definition of a nonprofit organization government organizations of any kind located in any country. A university or other institution of higher education located in any country would qualify, however, as a "nonprofit organization" under 37 CFR 1.9(e) even though it has some government affiliation since such institutions are specifically included.

A wholly owned subsidiary of a nonprofit organization or of a university is considered a part of the nonprofit organization or university and is not precluded from qualifying for small entity status.

### 509.03 Claiming Small Entity Status [R-14]

#### *37 CFR 1.27 Statement of status as small entity.*

(a) Any person seeking to establish status as a small entity (§ 1.9(f) of this part) for purposes of paying fees in an application or a patent must file a verified statement in the application or patent prior to or with the first fee paid as a small entity. Such a verified statement need only be filed once in an application or patent and remains in effect until changed.

(b) Any verified statement filed pursuant to paragraph (a) of this section on behalf of an independent inventor must be signed by the independent inventor except as provided in § 1.42, § 1.43, or § 1.47 of this part, and must aver that the inventor qualifies as an independent inventor in accordance with § 1.9(c) of this part. Where there are joint inventors in an application, each inventor must file a verified statement

establishing status as an independent inventor in order to qualify as a small entity. Where any rights have been assigned, granted, conveyed, or licensed, or there is an obligation to assign, grant, convey, or license, any rights to a small business concern, a nonprofit organization, or any other individual, a verified statement must be filed by the individual, the owner of the small business concern, or an official of the small business concern or nonprofit organization empowered to act on behalf of the small business concern or nonprofit organization averring to their status. For purposes of a verified statement under this paragraph, 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 as set forth in § 1.9 of this part.

(c) Any verified statement filed pursuant to paragraph (a) of this section on behalf of a small business concern must (1) be signed by the owner or an official of the small business concern empowered to act on behalf of the concern; (2) aver that the concern qualifies as a small business concern as defined in § 1.9(d); and (3) aver that exclusive rights to the invention have been conveyed to and remain with the small business concern, or if the rights are not exclusive, that all other rights belong to small entities as defined in § 1.9. Where the rights of the small business concern as a small entity are not exclusive, a verified statement must also be filed by the other small entities having rights averring to their status as such. For purposes of a verified statement under this paragraph, 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 as set forth in § 1.9 of this part.

(d) Any verified statement filed pursuant to paragraph (a) of this section on behalf of a nonprofit organization must (1) be signed by an official of the nonprofit organization empowered to act on behalf of the organization; (2) aver that the organization qualifies as a nonprofit organization as defined in § 1.9(e) of this part specifying under which one of § 1.9(e)(1), (2), (3), or (4) of this part the organization qualifies; and (3) aver that exclusive rights to the invention have been conveyed to and remain with the organization or if the rights are not exclusive, that all other rights belong to small entities as defined in § 1.9 of this part. Where the rights of the nonprofit organization as a small entity are not exclusive, a verified statement must also be filed by the other small entities having rights averring to their status as such. For purposes of a verified statement under this paragraph, 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 conveyance of rights as set forth in this paragraph.

37 CFR 1.27 provides in paragraph (a) that any person seeking to establish status as a small entity, as defined in 37 CFR 1.9(f) for the purpose of paying reduced fees, must file a statement to that effect prior to or with the payment of the first fee paid as a small entity. 37 CFR 1.27(b) provides specifically for inventors filing statements claiming status as independent inventors.

37 CFR 1.27(c) provides for claiming status as a small business concern.

37 CFR 1.27(d) provides for claiming status as a nonprofit organization. Under 37 CFR 1.27, as long as all of the rights remain in small entities, the fees established for a small entity can be paid. This includes circumstances where the rights were divided between an independent inventor, a small business concern and a nonprofit organization or any combination thereof.

The statement claiming small entity status must be a verified statement, i.e., an oath or declaration. It is not required that a new verified statement be filed with each fee paid, but rather, once

a statement is filed in an application or patent, small entity status remains in the application or patent until the Office is notified of a change in status. Notification of change in status is required by 37 CFR 1.28(b).

A verified statement is required to be filed in each application or patent in which it is desired to pay reduced fees except for those filed under 37 CFR 1.60 and 1.62. Applications filed under 37 CFR 1.60 and 1.62 may include reference to a verified statement in a parent application if status as a small entity is still proper and desired.

The rules do not authorize a patent attorney to sign a verified statement establishing status as a small entity on behalf of a client. The client has to sign the verified statement. Paragraph (b) of 37 CFR 1.27 requires that any verified statement filed on behalf of an independent inventor must be signed by the independent inventor except as provided in 37 CFR 1.42, 1.43, or 1.47. Paragraphs (c) and (d) of 37 CFR 1.27 require that any verified statement filed on behalf of a small business concern or nonprofit organization must be signed by an official of the concern or nonprofit organization empowered to act on behalf of the concern or organization.

- The term "official" is intended to include any officer, employee, or part-owner empowered to act on behalf of a small business concern or nonprofit organization. For example an officer or employee of a corporation empowered to act for the corporation by its board of directors would be qualified to sign such a verified statement. The intent of paragraphs (b)-(d) of 37 CFR 1.27 is that the verified statement be signed by the person in the best position to know the facts as to whether or not status as a small entity can be properly established. Insofar as the attorney's responsibilities and duty to investigate are concerned.

**37 CFR 1.28** *Effect on fees of failure to establish status, or change status, as a small entity.*

(a) The failure to establish status as a small entity (§§ 1.9(f) and 1.27 of this part) in any application or patent prior to paying, or at the time of paying, any fee precludes payment of the fee in the amount established for small entities. A refund pursuant to § 1.26 of this part, 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 a verified statement under § 1.27 and a request for a refund of the excess amount are filed within two months of the date of the timely payment of the full fee. The two-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 two months of the date of payment of, the fee. Status as a small entity must be specifically established by a verified statement filed in each application or patent in which the status is available and desired, except those applications filed under § 1.60 or § 1.62 of this part where the status as a small entity has been established in a parent application and is still proper. Once status as a small entity has been established in an application or patent, the status remains in that application or patent without the filing of a further verified statement pursuant to § 1.27 of this part unless the Office is notified of a change in status. Status as a small entity in one application or patent does not affect any other application or patent, including applications or patents which are directly or indirectly dependent upon the application or patent in which the status has been established, except those filed under § 1.60 or § 1.62 of this part. Applications filed under § 1.60 or § 1.62

of this part must include a reference to a verified statement in a parent application if status as a small entity is still proper and desired.

(b) 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. Notification of any change in status resulting in 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 is no longer appropriate pursuant to § 1.9 of this part. The notification of change in status may be signed by the applicant, any person authorized to sign on behalf of the assignee, or an attorney or agent of record or acting in a representative capacity pursuant to § 1.34(a) of this part.

(c) 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 change in status as required by paragraph (b) of this section, the error will be excused (1) if any deficiency between the amount paid and the amount due is paid within three months after the date the error occurred or (2) if any deficiency between the amount paid and the amount due is paid more than three months after the date the error occurred and the payment is accompanied by a verified statement explaining how the error in good faith occurred and how and when it was discovered.

(d)(1) Any attempt to fraudulently (i) establish status as a small entity or (ii) 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 (i) establishing status as a small entity or (ii) paying fees as a small entity shall be considered as a fraud practiced or attempted on the Office. \*\*

37 CFR 1.28 provides guidance to the effect of failure to establish, or notify the Office of any change from small entity status. 37 CFR 1.28(a) provides that once status as a small entity has been established in an application or patent, the status remains in that application or patent without the filing of a further verified statement pursuant to 37 CFR 1.27, unless the Office is notified of a change in status. Under 37 CFR 1.28(a), status as a small entity in one application or patent does not affect any other application or patent except in applications filed under 37 CFR 1.60 or 1.62 where a reference is made to a verified statement in a parent application. 37 CFR 1.28(b) requires that notification of any change in status resulting in loss of entitlement to small entity status 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 is no longer appropriate. Notification is not required if rights to an invention are transferred from one small entity to another small entity but small entity status is not lost thereby. This means that only four checks are required during the pendency and term of a patent after initial establishment of small entity status if such establishment was made prior to payment of the issue fee.

The Office will ordinarily require verified statements claiming small entity status only from parties holding rights in the invention. For example, if an independent inventor has transferred all rights in the invention to a small business concern, the Office will not require a verified statement from the inventor as well as from the small business concern. A verified statement

from the independent inventor, however, will be required in the situation where all rights in the invention have been transferred to an individual who files the verified statement form entitled "Verified Statement (Declaration) By a Non-inventor Supporting A Claim by Another For Small Entity Status". The language of this latter form clearly shows that it is meant to be filed in addition to another verified statement form.

No confirming statement is required where there has been no change in small entity status. Paragraph (c) of 37 CFR 1.28 requires a verified statement explaining how error in good faith establishing small entity status and paying fees as a small entity occurred only in situations where the error is not corrected within three months of the date on which the error occurred. This will reduce paperwork and provides a three-month grace period to correct errors with no explanations required for correction during that three-month period.

37 CFR 1.28 also provides guidance as to the effect of improperly establishing status as a small entity. The intent of the reduced fees for small entities is to soften the impact of the fee increases under § 41(a) and (b) of Title 35, United States Code, as such sections are amended by Public Law 97-247, upon those who are least able to absorb the increased fees without overall damage to their ability to participate in the patent system through the filing, issuing and maintaining of patents. Accordingly, any attempt to improperly establish status as a small entity will be viewed as a serious matter by the Office and 37 CFR 1.28(d) indicates that any attempt to fraudulently establish status as a small entity or pay fees as a small entity will be considered as a fraud practiced or attempted on the Office. In addition, improperly and **\*\*>**with intent to deceive< establishing status as a small entity or paying fees as a small entity will be considered as a fraud practiced or attempted on the Office. Normally, the Office will not question a claim to status as a small entity. However, if the Office must resolve such an issue in a question arising before it, the Office will look to the actual or practical status of the individual or organization claiming status as a small entity rather than the professed or apparent status.

Request for refunds, along with the verified statements, should be addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231, and directed to the attention of the Refund Section, Accounting Division, Office of Finance. **\*\***

The Patent and Trademark Office does not give advisory opinions as to whether or not a specific individual or organization qualifies for status as a small entity. In establishing reduced fees for independent inventors, small business concerns and nonprofit organizations, the Congressional consideration of the legislation which became Public Law 97-247 indicated an intent that the Patent and Trademark Office rely exclusively on a self-certification that a patent applicant qualifies as an independent inventor, small business concern, or nonprofit organization. In addition, it was also stated during Congressional consideration of the legislation that no additional resources would be required to administer the system whereby fees would be reduced for small entities.

In view of the intent expressed during Congressional consideration of the legislation it would be inappropriate for the Patent and Trademark Office to give advisory opinions as to entitlement to small entity status. Accordingly, any person seeking to establish status as a small entity for purposes of paying fee in an application or patent must file the verified statement required by 37 CFR 1.27 and in so doing is self-certifying entitlement to small entity status.

Small entity status must not be established unless the person or persons signing the verified statement can unequivocally make the required self-certification. Any appropriately signed and filed verified statement will be considered by the Patent and Trademark Office to be a self-certification.

If a verified statement claiming small entity status is filed in a language other than English, it must be accompanied by a verified English translation. 37 CFR 1.69(b). A non-English language verified statement claiming small entity status will not be given any effect until the verified English translation is filed and the full fees will be due until then.

**VERIFIED STATEMENT CLAIMING SMALL ENTITY STATUS  
(37 CFR 1.9(f) & 1.27(b))--INDEPENDENT INVENTOR**

Docket Number (Optional)

Applicant or Patentee: \_\_\_\_\_

Serial or Patent No.: \_\_\_\_\_

Filed or Issued: \_\_\_\_\_

Title: \_\_\_\_\_

As a below named inventor, I hereby declare that I qualify as an independent inventor as defined in 37 CFR 1.9(c) for purposes of paying reduced fees to the Patent and Trademark Office described in:

- the specification filed herewith with title as listed above.
- the application identified above.
- the patent identified above.

I have not assigned, granted, conveyed or licensed and am under no obligation under contract or law to assign, grant, convey or license, any rights in the invention to any person who would not qualify as an independent inventor under 37 CFR 1.9(c) if that person had made the invention, or to any concern which would not qualify as a small business concern under 37 CFR 1.9(d) or a nonprofit organization under 37 CFR 1.9(e).

Each person, concern or organization to which I have assigned, granted, conveyed, or licensed or am under an obligation under contract or law to assign, grant, convey, or license any rights in the invention is listed below:

- No such person, concern, or organization exists.
- Each such person, concern or organization is listed below.

Separate verified statements are required from each named person, concern or organization having rights to the invention averring to their status as small entities. (37 CFR 1.27)

I acknowledge the duty to file, in this application or patent, notification of any change in status resulting in loss of entitlement to small entity status 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 is no longer appropriate. (37 CFR 1.28(b))

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

\_\_\_\_\_  
NAME OF INVENTOR

\_\_\_\_\_  
NAME OF INVENTOR

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NAME OF INVENTOR

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Signature of inventor

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Signature of inventor

\_\_\_\_\_  
Signature of inventor

\_\_\_\_\_  
Date

\_\_\_\_\_  
Date

\_\_\_\_\_  
Date

<p style="text-align: center;"><b>VERIFIED STATEMENT CLAIMING SMALL ENTITY STATUS (37 CFR 1.9(f) &amp; 1.27(c))--SMALL BUSINESS CONCERN</b></p>	<p style="text-align: center;">Docket Number (Optional)</p>
<p>Applicant or Patentee: _____          Serial or Patent No.: _____          Filed or Issued: _____          Title: _____</p>	
<p>I hereby declare that I am  <input type="checkbox"/> the owner of the small business concern identified below:  <input type="checkbox"/> an official of the small business concern empowered to act on behalf of the concern identified below:</p>	
<p>NAME OF SMALL BUSINESS CONCERN _____          ADDRESS OF SMALL BUSINESS CONCERN _____</p>	
<p>I hereby declare that the above identified small business concern qualifies as a small business concern as defined in 13 CFR 121.12, and reproduced in 37 CFR 1.9(d), for purposes of paying reduced fees to the United States Patent and Trademark Office, in that the number of employees of the concern, including those of its affiliates, does not exceed 500 persons. For purposes of this statement, (1) the number of employees of the business concern is the average over the previous fiscal year of the concern of the persons employed on a full-time, part-time or temporary basis during each of the pay periods of the fiscal year, and (2) concerns are affiliates of each other when either, directly or indirectly, one concern controls or has the power to control the other, or a third party or parties controls or has the power to control both.</p>	
<p>I hereby declare that rights under contract or law have been conveyed to and remain with the small business concern identified above with regard to the invention described in:</p>	
<p><input type="checkbox"/> the specification filed herewith with title as listed above.  <input type="checkbox"/> the application identified above.  <input type="checkbox"/> the patent identified above.</p>	
<p>If the rights held by the above identified small business concern are not exclusive, each individual, concern or organization having rights in the invention must file separate verified statements averring to their status as small entities, and no rights to the invention are held by any person, other than the inventor, who would not qualify as an independent inventor under 37 CFR 1.9(c) if that person made the invention, or by any concern which would not qualify as a small business concern under 37 CFR 1.9(d), or a nonprofit organization under 37 CFR 1.9(e).</p>	
<p>Each person, concern or organization having any rights in the invention is listed below:  <input type="checkbox"/> no such person, concern, or organization exists.  <input type="checkbox"/> each such person, concern or organization is listed below.</p>	
<p>Separate verified statements are required from each named person, concern or organization having rights to the invention averring to their status as small entities. (37 CFR 1.27)</p>	
<p>I acknowledge the duty to file, in this application or patent, notification of any change in status resulting in loss of entitlement to small entity status 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 is no longer appropriate. (37 CFR 1.28(b))</p>	
<p>I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.</p>	
<p>NAME OF PERSON SIGNING _____</p>	
<p>TITLE OF PERSON IF OTHER THAN OWNER _____</p>	
<p>ADDRESS OF PERSON SIGNING _____</p>	
<p>SIGNATURE _____ DATE _____</p>	



<b>VERIFIED STATEMENT CLAIMING SMALL ENTITY STATUS (37 CFR 1.9(f) &amp; 1.27(d))--NONPROFIT ORGANIZATION</b>	Docket Number (Optional)
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Applicant or Patentee: \_\_\_\_\_  
 Serial or Patent No. : \_\_\_\_\_  
 Filed or Issued: \_\_\_\_\_  
 Title: \_\_\_\_\_

I hereby declare that I am an official empowered to act on behalf of the nonprofit organization identified below:

NAME OF NONPROFIT ORGANIZATION \_\_\_\_\_  
 ADDRESS OF NONPROFIT ORGANIZATION \_\_\_\_\_

**TYPE OF NONPROFIT ORGANIZATION:**

- UNIVERSITY OR OTHER INSTITUTION OF HIGHER EDUCATION
- TAX EXEMPT UNDER INTERNAL REVENUE SERVICE CODE (26 U.S.C. 501(a) and 501(c)(3))
- NONPROFIT SCIENTIFIC OR EDUCATIONAL UNDER STATUTE OF STATE OF THE UNITED STATES OF AMERICA  
 (NAME OF STATE \_\_\_\_\_)  
 (CITATION OF STATUTE \_\_\_\_\_)
- WOULD QUALIFY AS TAX EXEMPT UNDER INTERNAL REVENUE SERVICE CODE (26 U.S.C. 501(a) and 501(c)(3)) IF  
 LOCATED IN THE UNITED STATES OF AMERICA
- WOULD QUALIFY AS NONPROFIT SCIENTIFIC OR EDUCATIONAL UNDER STATUTE OF STATE OF THE UNITED  
 STATES OF AMERICA IF LOCATED IN THE UNITED STATES OF AMERICA  
 (NAME OF STATE \_\_\_\_\_)  
 (CITATION OF STATUTE \_\_\_\_\_)

I hereby declare that the nonprofit organization identified above qualifies as a nonprofit organization as defined in 37 CFR 1.9(e) for purposes of paying reduced fees to the United States Patent and Trademark Office regarding the invention described in:

- the specification filed herewith with title as listed above.
- the application identified above.
- the patent identified above.

I hereby declare that rights under contract or law have been conveyed to and remain with the nonprofit organization regarding the above identified invention. If the rights held by the nonprofit organization are not exclusive, each individual, concern or organization having rights in the invention must file separate verified statements averring to their status as small entities and that no rights to the invention are held by any person, other than the inventor, who would not qualify as an independent inventor under 37 CFR 1.9(c) if that person made the invention, or by any concern which would not qualify as a small business concern under 37 CFR 1.9(d) or a nonprofit organization under 37 CFR 1.9(e).

Each person, concern or organization having any rights in the invention is listed below:

- no such person, concern, or organization exists.
- each such person, concern or organization is listed below.

I acknowledge the duty to file, in this application or patent, notification of any change in status resulting in loss of entitlement to small entity status 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 is no longer appropriate. (37 CFR 1.28(b))

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

NAME OF PERSON SIGNING \_\_\_\_\_

TITLE IN ORGANIZATION OF PERSON SIGNING \_\_\_\_\_

ADDRESS OF PERSON SIGNING \_\_\_\_\_

SIGNATURE \_\_\_\_\_ DATE \_\_\_\_\_

<b>VERIFIED STATEMENT BY A NON-INVENTOR SUPPORTING A CLAIM BY ANOTHER FOR SMALL ENTITY STATUS</b>	Docket Number (Optional)
Applicant or Patentee: _____ Serial or Patent No.: _____ Filed or Issued: _____ Title: _____	
I hereby declare that I am making this verified statement to support a claim by _____ for small entity status for purposes of paying reduced fees to the United States Patent and Trademark Office, regarding the invention described in:	
<input type="checkbox"/> the specification filed herewith with title as listed above. <input type="checkbox"/> the application identified above. <input type="checkbox"/> the patent identified above	
I hereby declare that I would qualify as an independent inventor as defined in 37 CFR 1.9(c) for purposes of paying fees to the United States Patent and Trademark Office, if I had made the above identified invention.	
I have not assigned, granted, conveyed or licensed and am under no obligation under contract or law to assign, grant, convey or license, any rights in the invention to any person who would not qualify as an independent inventor under 37 CFR 1.9(c) if that person had made the invention, or to any concern which would not qualify as a small business concern under 37 CFR 1.9(d) or a nonprofit organization under 37 CFR 1.9(e). Note: Separate verified statements are required from each person, concern or organization having rights to the invention averring to their status as small entities. (37 CFR 1.27)	
Each person, concern or organization to which I have assigned, granted, conveyed, or licensed or am under an obligation under contract or law to assign, grant, convey, or license any rights in the invention is listed below:	
<input type="checkbox"/> no such person, concern, or organization exists. <input type="checkbox"/> each such person, concern or organization is listed below.	
I acknowledge the duty to file, in this application or patent, notification of any change in status resulting in loss of entitlement to small entity status 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 is no longer appropriate. (37 CFR 1.28(b))	
I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.	
_____ <b>NAME OF PERSON SIGNING</b>	
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## 510 Patent and Trademark Office Business Hours [R-14]

The Patent and Trademark Office working hours are 8:30 a.m. to 5:00 p.m., Monday through Friday, excluding federal holidays in the District of Columbia. Outside these hours, only Patent and Trademark Office employees are authorized to be in areas of the Patent and Trademark Office other than the Public Search Rooms.

The hours for the Public Search Room are 8:00 a.m. to 8:00 p.m., and the hours for the Trademark Search Room are 8:00 a.m. to 6:00 p.m., Monday through Friday, excluding federal holidays in the District of Columbia.

During working hours, all applicants, attorneys, and other members of the public should announce their presence to the Office personnel in the area of their visit. In the examining groups visitors should inform the group receptionist of their presence before visiting other areas of the group.

### REGULATIONS FOR THE PUBLIC USE OF RECORDS IN THE PUBLIC SEARCH ROOM FOR PATENTS OF THE PATENT AND TRADEMARK OFFICE

The Patent and Trademark Office has established Procedures and Regulations for using the facilities of the Public Search Room for Patents. The procedures for the Search Room include the requirement that users obtain and show, prior to entering the Search Room facilities, a User Pass. This pass can be obtained at the receptionist's desk in the lobby of Building 3. User Passes will be issued to persons not under prohibition from using the search facilities who sign an application form and acknowledge receipt of a copy of the noted Regulations. User Passes are nontransferrable and are valid until reissue or revocation for cause. Office employees must show their building pass in order to enter the Public Search Room.

The procedures also include the requirement that persons entering and exiting the Search Room use designated lanes. Persons exiting the Search Room will automatically pass electronic sensing equipment designed to detect any marked documents or materials being removed from the Search Room. The sensing equipment is capable of detecting marked documents and materials in briefcases and parcels and under clothing. The equipment does not use X-ray or other high energy radiation and is, therefore, completely safe and harmless to persons, photographic film, magnetic tape and electronic or mechanical devices such as wrist watches. New patents are marked for sensing before being placed in the Classified files.

Whenever a marked document is transported past the sensing equipment, Patent and Trademark Office officials and the security guards will be alerted to the removal of the document, and a gate on the exit lane will lock. Persons triggering the alarm will be asked to cooperate in identifying the source for the alarm. Failure to cooperate when the alarm is triggered could result in detention of the person, seizure of any briefcase or the like, or other legal measures deemed necessary and appropriate in the specific case.

The Regulations for the Search Room are reprinted in a Regulation brochure. It is available in the Search Room. In order to maintain an environment conducive to search, the Regulations will be strictly enforced.

Although these procedures and Regulations may cause some inconvenience, it is hoped that with understanding and cooperation they will result in improvement in search facilities which will benefit all participants in the U.S. patent system.

Persons violating the regulations may be denied the use of the facilities in the Public Search Room for Patents, and may further be subjected to prosecution under the Criminal Code. Additionally, the name of any person violating these regulations who is registered to practice before the Patent and Trademark Office may be forwarded to the \*>Office of Enrollment and Discipline< for appropriate action under \*\*>37 CFR Part 10<.

### USE OF PATENT EXAMINING GROUP FACILITIES

The primary function of the Patent and Trademark Office is the examination of applications for patents and the issuance of valid patents based upon a search and consideration of the best available prior art. This can be accomplished only through maintaining strict search file integrity within the patent examining group facilities.

Therefore, the regulations appearing below were established for those authorized members of the public using the facilities of the patent examining groups.

Although these regulations may cause some inconvenience, it is believed that with the cooperation and understanding of the public, a more efficient and reliable examination system within the patent examining groups will result.

A copy of the following "Regulations for Users of the Patent Examining Group Facilities," is posted in each of the Patent Examining Groups and the Public Search Room for Patents:

### REGULATIONS FOR USERS OF THE PATENT EXAMINING GROUP SEARCH FACILITIES

1. Group facilities are defined as those areas in \*\*>Crystal City where the< Examining Groups >are located<.
2. The use of the Group facilities for search purposes by members of the public is strictly limited to the search of materials not available in the Public Search Room for Patents or the Scientific Library and when it does not conflict with the regular business of Patent and Trademark personnel and only between the hours of 8:45 a.m. and 4:45 p.m. on regular business days.
3. Authorized Officials, under these Regulations, include Supervisory Patent Examiners and Examining Group Directors.
4. Under applicable statutes and regulations, including 40 U.S.C. 486(c); 41 CFR Subpart 101-20.3; and appropriate Sections of Department Organization Orders 30-3A and 30-3B of the Department of Commerce, the Regulations appearing below are established for those members of the public using the Group Facilities.
  - A. All persons using these facilities are subject to the Regulations Governing Conduct on Federal Property, as speci-

fied in 41 CFR Subpart 101-20.3.

B. All posted Official Notices are to be complied with.

C. A valid User Pass must be prominently displayed when searching in the Group Facilities. User Passes are nontransferable and must be surrendered upon request to authorized officials.

D. All persons holding User Passes must register with the Group Receptionist, unless otherwise directed, in each Examining Group where they search and must sign a log (e.g., indicating time-in, time-out, name, User Pass number, class(es) and subclass(es) searched).

E. No patents, records or other documents of the Patent and Trademark Office shall be removed from the Group Facilities except by express written authorization by an authorized official in the Examining Group where the material resides. Such authorization will not be given for U.S. patents and other material readily available through the Scientific Library.

F. Smoking is not permitted except in designated areas.

G. No food or beverages in any form are to be consumed except in designated areas.

H. Loud talking, use of radios, and any other form of activity which may disturb other members of the public or Patent and Trademark Office personnel are forbidden.

I. Children brought into the Group Facilities must not be allowed to disturb others.

J. The presence or use of equipment such as dictation equipment, reproducing machines, typewriters and photographic equipment is prohibited without prior permission from an authorized official in the Examining Group where the use is intended and then is permitted where its use does not conflict with Regulation H.

K. Patents and other documents must not be removed from their shoes for any reason other than for cursory study thereof while kept in close proximate association with the shoe and must not be moved out of their normal sequence.

L. All patent shoes must be promptly replaced in their proper location in the shoe case.

M. All textbooks, journals and the like must be returned to their proper location.

N. The reserving of seats and/or working areas is prohibited.

O. All packages, briefcases or other personal effects brought into the Group Facilities are subject to search by authorized officials upon request and must be removed when leaving the Group Facilities.

P. All verbal requests for compliance with these regulations or other posted Patent and Trademark Office Notices pertaining to activity in the Group Facilities, when made by authorized officials, must be promptly complied with.

5. Persons violating these regulations may be denied the use of the facilities in the Examining Groups and Public Search Room for Patents, and may further be subject to prosecution under the Criminal Code. Additionally, the name of any person violating these regulations who is registered to practice before the Patent and Trademark Office may be forwarded to the Office of Enrollment and Discipline for appropriate action under 37 CFR Part 10.

If any individual is observed in violation of any of the regulations, immediate compliance should be courteously requested. If a verbal request is not complied with, a note should be made of the individual's name and User's Pass number, if possible (the User's Pass is required to be prominently displayed) and report the incident to the Supervisory Primary Examiner, Supervisory Applications Examiner or other appropriate supervisor who will take further action.

In addition, if any individual in a search area appears to be a stranger and is not wearing a User's Pass, some identification, such as a Building or User's Pass should be requested. If the individual refuses, notify a supervisor. Consequently, all Office employees are expected to carry their Building Pass with them at all times, especially when searching outside of their assigned groups.

Supervisors, when aware of violations of the posted regulations should prepare a memorandum detailing the facts of the incident and forward this memorandum to the Deputy Assistant Commissioner for Patents via their Group Director. Supervisory Patent Examiners and Group Directors are authorized to demand surrender of User Passes on-the-spot. If the Supervisory Patent Examiner exercises this function, the Group Director should be immediately notified followed up by a memorandum as previously set forth.

## 511 Postal Service Emergency Contingency Plan [R-14]

*35 U.S.C. 21 Filing date and day for taking action.*

(a) The Commissioner may by rule prescribe that any paper or fee required to be filed in the Patent and Trademark Office will be considered filed in the Office on the date on which it was deposited with the United States Postal Service or would have been deposited with the United States Postal Service but for postal service interruptions or emergencies designated by the Commissioner.

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*37 CFR 1.6 Receipt of letters and papers.*

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(d) If interruptions or emergencies in the United States Postal Service which have been so designated by the Commissioner occur, the Patent and Trademark Office will consider as filed on a particular date in the Office any paper or fee which is: (1) Promptly filed after the ending of the designated interruption or emergency; and (2) Accompanied by a statement indicating that such paper or fee would have been filed on that particular date if it were not for the designated interruption or emergency in the United States Postal Service. Such statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office.

37 CFR 1.6(d) provides a procedure under which papers and fees which could not be filed on a particular date because of an interruption or emergency in the United States Postal Service which is so designated by the Commissioner, may be promptly filed after the ending of such a designated interruption or emergency and be considered as having been filed on that particular date. Authority for such a practice is found in 35 U.S.C. 21(a), as amended by Pub. L. 97-247.

The U.S. Patent and Trademark Office is establishing the

following contingency plan for filing any paper or paying any fee in the Office in the event of an emergency caused by any major interruption in the mail service in the United States. Upon determination by the Commissioner of Patents and Trademarks that such an emergency exists, a notice activating the plan will be issued by the Commissioner. The activating notice will be published in the Wall Street Journal and made available by telephone at area code 703, 557-INFO. Also, certain publications, patent bar groups, and other organizations closely associated with the patent system, will be notified. Termination of the program will be similarly announced. Where the postal emergency is not nationwide, the Commissioner will designate the areas of the United States in which the procedures outlined below will be in effect.

U.S. Department of Commerce District Offices will be designated on an emergency basis, as receiving stations for filing papers and paying fees in the U.S. Patent and Trademark Office.

Upon determination that an emergency exists, the following procedures may be followed: All papers and fees should be enclosed in a sealed envelope addressed to the Patent and Trademark Office and deposited in one of the District Offices. Such papers will be considered as received in the U.S. Patent and Trademark Office on the day of deposit. The District Office will date stamp each envelope and the accompanying receipt card which completely identifies the deposited papers. The receipt card will be returned to the depositor. Applicants or their representatives should assure the legibility of the date stamp.

District Office deposits should be limited to checks in payment of issue fees, new application papers wherein priority dates or statutory bars may be involved, amendments where the six month statutory period for response is about to expire, trademark oppositions, Section 8 affidavits, trademark renewals, and to other papers for which the patent and trademark statutes do not provide a remedy for failure to obtain a particular date.

Where papers originate from overseas, it is suggested that the papers be mailed to a registered agent in Canada, with a request that the papers be forwarded by courier to the nearest District Office in the United States.

In regard to pending applications, if the time for taking any action or paying any fee expires during the period that the Commissioner declares to be an emergency, the time will be extended until one month after the end of the emergency period, provided that such extension does not exceed the maximum period for response provided for in the statutes.

Since this extension of time will be automatic, there will be no record in the individual files to indicate that a response filed during the extended period is in fact timely. In order to provide a complete record, applicants or their representatives should file a paper referring to this notice in each case in which a response is filed during the extended period.

The addresses of the Department of Commerce District Offices, subject to subsequent changes, are as follows:

#### ALABAMA

Birmingham — Room 302, 2015 2nd Avenue North, 3rd floor,

Berry Bldg. 35203 Area Code 205 Tel 731-1331.

#### ALASKA

Anchorage — \*\*>222 West 7th Ave., 99513-7591<, Area Code 907 Tel 271-5041.

#### ARIZONA

Phoenix — Federal Building and U.S. Courthouse, 230 North 1st Avenue, Rm 3412, 85025, Area Code 602 Tel 261-3285.

#### ARKANSAS

Little Rock — Suite 811, Savers Federal Building, 320 W. Capital Avenue 72201, Area Code 501 Tel 378-5794. - Denotes Trade Specialist.

#### CALIFORNIA

Los Angeles — Room 800, \*\*>11000 Wilshire Boulevard< 90049, Area Code 213 Tel \*>209-7104<.

Santa Ana — 116\* W 4th St., Suite #1, 92701, Area Code 714 Tel 836-2461.

San Diego — Suite \*>145<, 6363 Greenwich Drive 92122, Area Code 619 Tel \*>557-5395<.

San Francisco — \*\*>14th Fl., 250 Montgomery St. 94104<, Area Code 415 Tel \*>705-2310<.

#### COLORADO

Denver — \*\*>Rm. 680, 1625 Broadway, 721 19th St.< 80202, Area Code 303 Tel 844-3246.

#### CONNECTICUT

Hartford — Room 610-B, Federal Office Building, 450 Main Street 06103, Area Code 203 Tel 240-3530.

#### FLORIDA

Miami — Suite 224, Federal Building, 51 S.W. First Avenue 33130, Area Code 305 Tel \*>536-5268<.

Clearwater — 128 North Osceola Avenue \*>34615<, Area Code 813 Tel 461-0011.

\*\*

Orlando — \*\*>c/o College of Business Administration CEBA II, Rm. 346, University of Florida, 32816 Area Code 407 Tel 648-1608.<

Tallahassee — Collins Bldg., Rm. 401, 107 W. Gaines St. \*>32399-2000<, Area Code 904 Tel 488-6469.

#### GEORGIA

Atlanta — \*\*>Suite 310, 4360 Chamblee-Dunwoody Rd., 30341, Area Code 404 Tel 452-9102<.

Savannah — 120 Barnard Street, A-107 31401, Area Code 912 Tel 944-4204.

**HAWAII**

Honolulu — \*\*P.O. Box 50026, 300 Ala Moana Boulevard  
96850, Area Code 808 Tel 541-1782.

**IDAHO**

Boise — \*\*>2nd Fl., Hall of Mirrors, 700 W. State St.,  
83720, Area Code 208 Tel 334-3857<.

**ILLINOIS**

Chicago — 1406 Mid Continental Plaza Building, 55 East  
Monroe Street 60603, Area Code 312 Tel 353-4450.

\*\*

Rockford — 515 North Court Street, P.O. Box 1747 61110-  
0247, Area Code 815 Tel 987-8123

**INDIANA**

Indianapolis — \*\*>One North Capital, Ste., 520, 46204, Area  
Code 317 Tel 226-6124<.

**IOWA**

Des Moines — 817 Federal Building, 210 Walnut Street 50309,  
Area Code 515 Tel 284-4222.

**KANSAS**

Wichita — \*\*>151 North Wolutsia, 67214-4695<, Area Code  
316 Tel 269-6160.

**KENTUCKY**

Louisville — Room 636B, \*\*>Gene Snyder Courthouse and  
Customhouse, 601 W. Broadway,< 40202, Area Code 502 Tel  
582-5066.

**LOUISIANA**

New Orleans — 432 World Trade Center, No. 2 Canal Street  
70130, Area Code 504 Tel 589-6546.

**MAINE**

Augusta — \*\*>77 Sewell St< 04330, Area Code 207 Tel 622-  
8249.

**MARYLAND**

Baltimore — 415 U.S. Customhouse, \*\*>40 South Gay Street<  
21202, Area Code 301 Tel 962-3560.

**MASSACHUSETTS**

Boston — World Trade Center, Suite 307 Commonwealth Pier  
Area, 02210, Area Code 617 Tel 565-8563.

**MICHIGAN**

Detroit — \*>1140< NcNamara Bldg. 477 Michigan Avenue,  
48226, Area Code 313 Tel 226-3650.

Grand Rapids — 300 Monroe N.W., Rm. 409 49503, Area Code  
616 Tel 456-2411.

**MINNESOTA**

Minneapolis — 108 Federal Building, 110 South Fourth Street  
55401, Area Code 612 Tel \*>348-1638<.

**MISSISSIPPI**

Jackson — \*\*>328 Jackson Mall Office<, 300 Woodrow Wil-  
son Blvd. 39213, Area Code 601 Tel \*>965-4388<.

**MISSOURI**

St. Louis — \*\*>7911 Forsyth Blvd., Suite 610,< 63105, Area  
Code 314 Tel 425-3302-4.

Kansas City — Room \*>635<, 601 East 12th Street 64106, Area  
Code 816 Tel \*>374-3141<.

**NEBRASKA**

Omaha — \*\*>11133 O Street 68137<, Area Code 402 Tel 221-  
3664.

**NEVADA**

Reno — 1755 E. Plumb Lane, #152 89502, Area Code 702 Tel  
784-5203.

**NEW JERSEY**

\*\*>Trenton — 3131 Princeton Pike Bldg., 6, Suite 100, 08648<,  
Area Code 609 Tel 989-2100.

**NEW MEXICO**

Albuquerque — \*\*>625 Silver, S.W., 3rd Fl.,< 87102, Area  
Code 505 Tel \*>766-2070<.

**NEW YORK**

Buffalo — 1312 Federal Building, 111 West Huron Street  
14202, Area Code 716 Tel 846-4191.

New York — Room 3718, Federal Office Building, 26 Federal  
Plaza, \*\*10278, Area Code 212 Tel 264-0634.

**NORTH CAROLINA**

Greensboro — \*\*>Suite 400, 324<West Market Street,  
\*\*> 27401<, Area Code 919 Tel \*>333-5345<.

**OHIO**

Cincinnati — 9504 Federal Office Building, 550 Main Street  
45202, Area Code 513 Tel 684-2944.

Cleveland — Room 600, 666 Euclid Avenue 44114, Area Code  
216 Tel 522-4750.

**OKLAHOMA**

Oklahoma City — \*\*>6601 Broadway Extension, Suite 200<  
73105, Area Code 405 Tel 231-5302.

Tulsa — 440 S. Houston St. 74127, Area Code 918 Tel 581-  
7650.

## OREGON

Portland — \*\*>One World Trade Center, 121 S.W. Salmon, Suite 242< 97204, Area Code 503 Tel 221-3001.

## PENNSYLVANIA

Philadelphia — \*\*>Suite 202, 475 Allendale Rd., King Of Prussia 19406<, Area Code 215 Tel \*>962-4980<.

Pittsburgh — 2002 Federal Building, 1000 Liberty Avenue 15222, Area Code 412 Tel 644-2850.

## PUERTO RICO

San Juan (Hato Rey) — Room \*>G-55< Federal Building, >Chardon Ave.< 00918, Area Code 809 Tel \*\*>766-5555<.

## RHODE ISLAND

Providence — 7 Jackson Walkway 02903, Area Code 401 Tel \*\*>528-5104<.

## SOUTH CAROLINA

Charleston — \*\*>Rm. 128, 9 Liberty St., 29424<, Area Code 803 Tel \*>724-4361<.

Columbia — Strom Thurmond Fed. Bldg., Suite 172, 1835 Assembly Street 29201, Area Code 803 Tel 765-5345.

## TENNESSEE

Memphis — \*\*>22 N. Front St., Suite 200, 38101<, Area Code 901 Tel \*>521-4173<.

Nashville — Suite \*\*>1114, Parkway Towers, 404 James Robertson Pkwy., 37219-1505<, Area Code 615 Tel \*>736-5161<.

## TEXAS

Dallas — Room 7A5, 1100 Commerce Street 75242, Area Code 214 Tel \*>729-0542<.

Houston — 2625 Federal \*Courthouse >Bldg.<, 515 Rusk Street 77002, Area Code 713 Tel 229-2578.

## UTAH

Salt Lake City — \*\*>324 South State St., Suite 105, 84111<, Area Code 801 Tel 524-5116.

## VIRGINIA

Richmond — 8010 Federal Building, 400 North 8th Street 23240, Area Code 804 Tel 771-2246.

## WASHINGTON

Seattle — \*\*>3131 Elliott Ave., Suite 290, 98121<, Area Code 206 Tel \*>553-5616<.

## WEST VIRGINIA

Charleston — \*\*>405 Capitol Street< 25301, Area Code 304 Tel \*\*>347-5408<.

## WISCONSIN

Milwaukee — >605< Federal Bldg\*\*\*, 517 East Wisconsin Avenue 53202, Area Code 414 Tel \*>291-3470<.

## 512 Certificate of Mailing [R-14]

## 37 CFR 1.8. Certificate of mailing.

(a) Except in the cases enumerated below, papers and fees required to be filed in the Patent and Trademark Office within a set period of time will be considered as being timely filed if:<

(1) They are addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231, and deposited with the U.S. Postal Service with sufficient postage as first class mail prior to expiration of the set period, and

(2) They also include a certificate for each paper or fee stating the date of deposit. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed on or before the date indicated. The actual date of receipt of the paper or fee will be used for all other purposes. This procedure does not apply to the following:

(i) The filing of a national patent application specification and drawing or other papers for the purpose of obtaining an application filing date;

(ii) The filing of trademark applications;

(iii) The filing of agreements between parties to an interference under 35 U.S.C. 135(c);

(iv) The filing of an affidavit showing that a mark is still in use or containing an excuse for nonuse under section 8 (a) or (b) or section 12(c) of the Trademark Act, 15 U.S.C. 1058(a), 1058(b), 1062(c);

(v) The filing of an application for renewal of a mark registration under section 9 of the Trademark Act, 15 U.S.C. 1059;

(vi) The filing of a petition to cancel a registration of a mark under section 14 (a) or (b) of the Trademark Act, 15 U.S.C. 1064(a), 1064(b);

(vii) The filing of an affidavit under section 15, subsection (3) of the Trademark Act, 15 U.S.C. 1065;

(viii) The filing of a notice of election to proceed by civil action in an inter partes proceeding under 35 U.S.C. 141 or section 21(a)(1) of the Trademark Act, 15 U.S.C. 1071(a)(1), in response to another party's appeal to the Court of Appeals for the Federal Circuit;

(ix) The filing of a notice and reasons of appeal under 35 U.S.C. 142 or a notice of appeal under section 21(a)(2) of the Trademark Act, 15 U.S.C. 1071(a)(2);

(x) The filing of a statement under 42 U.S.C. 2182 or 42 U.S.C. 2457(c); and

(xi) The filing of international applications for patent and all papers and fees relating thereto;

(xii) The filing of \*>a paper< in an interference which an examiner-in-chief \*>orders< to be filed by hand or "Express Mail"; >and<

(xiii) Papers filed in connection with a disciplinary proceeding under \*>part< 10 of this subchapter.

>(xiv) In an application under section 1(b) of the Trademark Act (15 U.S.C. 1051(b)), the filing of a statement of use under § 2.88 (15 U.S.C. 1051(d)).

(xv) In an application under section 1(b) of the Trademark Act (15 U.S.C. 1051(b)), the filing of a request, under § 2.89 (15 U.S.C. 1051(d)), for an extension of time to file a statement of use under § 2.88 (15 U.S.C. 1051(d)).

(xvi) In an application under section 1(b) of the Trademark Act (15 U.S.C. 1051(b)), the filing of an amendment to allege use in commerce under § 2.76 (15 U.S.C. 1051(c)).<

(b) In the event that correspondence or fees are timely filed in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding dismissed, terminated, or decided with prejudice, the correspondence or fee will be considered timely if the party who forwarded such correspondence or fee (1) informs the Office of the previous mailing of the correspondence or fee promptly after becoming aware of the Office action, (2) supplies an additional copy of the previously mailed correspondence or fee and certificate, and (3) includes a declaration under § 1.68 or § 2.20 which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing.

[Subparas. (a)(2)(xiv) - (xvi) added, 54 FR 37588, Sept. 11, 1989, effective Nov. 16, 1989]

*A suggested format for the certificate under 37 CFR 1.8\* to be included with the correspondence.*

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on

.....  
(Date)

.....  
(Name of applicant, assignee, or Registered Representative)

.....  
(Signature)

.....  
(Date)

If improper wording has been used, applicants may be reminded of the suggested wording by including Form Paragraph 5.02.

¶ 5.02 *Format of Certificate of Mailing*

Following is a suggested format for the certificate of mailing under 37 CFR 1.8\* which should be included with all correspondence.

"I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on....."

Name of applicant, assignee, or Registered Representative.....

Signature.....

Date.....

For a Pro Se inventor, Form Paragraph 17.11 may precede Form Paragraph 5.02.

¶ 17.11 *Suggestion of Certificate of Mailing, Pro Se*

It is called to applicant's attention that if a communication is mailed before the response time has expired applicant may submit the response with a "Certificate of Mailing" in accordance with 37 CFR 1.8(a) which merely asserts that the response is being mailed on a given date. So mailed, before the period of response has lapsed, the response is

considered timely. A suggested format for a certificate follows.

**Examiner Note:**

See form paragraph 5.02.

37 CFR 1.8 and the suggested form for patent cases established a practice before the Patent and Trademark Office which is referred to as the "Certificate of Mailing Procedure." Under this procedure, a person may state on certain papers directed to the Office (exceptions are stated in 37 CFR 1.8), the date on which the paper will be deposited in the United States Postal Service. If the date of deposit is within the period for response, the response in most instances will be considered to be timely. This is true even if the paper does not actually reach the Office until after the end of the period for response. The Certificate of Mailing procedure does not apply to papers mailed in a foreign country.

It should be noted, however, that the Office will continue its normal practice of stamping the date of receipt (Mail Room Stamp) on all papers received through the mails except those filed under 37 CFR 1.10 (See MPEP § 513). The date stamped will also be the date which is entered on Office records and from which any subsequent periods are calculated. For example, 37 CFR 1.192 gives an appellant 2 months from the date of the appeal to file an appeal brief. For example, if the last day to respond to a final rejection was November 10, 1976, and applicant deposited a Notice of Appeal with fee in the U.S. mail on November 10, 1976 and so certified, that appeal is timely even if it was not received in the Patent and Trademark Office until November 17, 1976. Since the date of receipt will be used to calculate the time at which the brief is due, the brief was due on January 17, 1977. This is 2 months after the Mail Room date.

*Procedure by Applicant*

(A) The certification requires a signature. Specifically, if the certification appears on a paper that requires a signature, two signatures are required, one for the paper and one for the certification. Although not specifically required by 37 CFR 1.8, it is preferred that the certificate be signed by the applicant, assignee, or registered practitioner.

(B) When possible, the certification should appear on a portion of the paper being submitted. However, if there is insufficient space to make the certification on the same paper, such as in the case of the patent issue fee transmittal form PTO-85, the certification should be on a separate sheet securely attached to the paper.

(C) When the certification is presented on a separate sheet, that sheet must (1) be signed and (2) fully identify and be securely attached to the paper it accompanies. The required identification should include the serial number and filing date of the application as well as the type of paper being filed, e.g., response to rejection or refusal, Notice of Appeal, etc. An unsigned certification will not be considered acceptable.

Moreover, without the proper identifying data, a certification presented on a separate sheet will not be considered acceptable if there is any question or doubt concerning the



connection between the sheet and the paper filed.

If the sheet should become detached from the paper and thereafter not associated with the appropriate file, evidence that this sheet was received in the Office can be supported by submitting a copy of a post card receipt specifically identifying this sheet and the paper and by submitting a copy of the sheet as originally mailed. Attention is directed to MPEP § 503 relative to the use of post cards as receipts.

(D) In situations wherein the correspondence includes papers for more than one application (e.g., a single envelope containing separate papers responding to Office actions in different applications) or papers for various parts of the Office (e.g., a patent issue fee transmittal form PTO-85 and an assignment), each paper must have its own certification as a part thereof or attached thereto.

(E) In situations wherein the correspondence includes several papers directed to the same application (for example, a proposed response under 37 CFR 1.116 and a Notice of Appeal), each paper should have its own certification as a part thereof or attached thereto.

#### *Use of Stamped Certification*

Some practitioners place the certification language on the first page of a paper with an inked stamp. Such a practice is encouraged because the certification is not only readily visible but also forms an integral part of the paper.

#### *Office Procedure*

##### *Mail Room*

The Mail Room will continue to date stamp the actual date of receipt of all papers received by mail in the Office. No attempt will be made to retain the envelopes in which the papers are received or to indicate on the papers the postal cancellation date (post mark).

##### *Processing Areas*

When papers are received in an examining group, the date of receipt in the group should be stamped on the papers as at present.

The date of deposit indicated on the Certificate of Mailing will be used by the Office only to determine if the paper was deposited in the United States Postal Service within the period for response. If the paper was actually received in the Office within the period for response, there is no need to refer to the Certificate, or to note the date of deposit in the U.S. mail.

If, however, the paper was received in the Patent and Trademark Office after the end of the period for response, the paper should be inspected to determine if a Certificate of Mailing has been included. Where no such Certificate is found, the paper is untimely since applicant did not respond within the period for response. This may result in abandonment of the application or other loss of rights.

In those instances where a Certificate of Mailing does appear in the paper or a cover letter thereto, a check should be

made to determine whether the indicated date of deposit is within the period for response. If the date of deposit indicated in the Certificate is after the end of the period for response, the paper is untimely and no notation of the date of deposit need be made. Where the date of deposit indicated on the Certificate of Mailing is within the period for response, the paper should be considered to be timely filed. A notation should be made adjacent to the Office stamp indicating the date of receipt (Mail Room Stamp) which notes the date of deposit stated on the Certificate of Mailing. This notation should be "C of Mail" followed by the date. A paper deposited on November 10, 1976, would be noted next to the Mail Room Stamp "(C of Mail. 11/10/76)." This notation should also appear on the "Contents" portion of the file wrapper.

If the period set for taking an action in the Patent and Trademark Office ends on a Saturday, Sunday or Federal holiday within the District of Columbia (37 CFR 1.7), the action will be considered to be timely if deposited in the United States mail and certified under 37 CFR 1.8(a) on the next succeeding day which is not a Saturday, Sunday, or a Federal holiday.

It should be noted that the mailing of a paper for the purpose of obtaining a continuation or division application under 37 CFR 1.60 or 1.62 is excluded from the Certificate of Mailing practice under 37 CFR 1.8(a)(i) since it is considered to be the filing of a national patent application.

All Certificates of Mailing filed in applications should be placed in the file wrappers directly below the papers to which they refer.

Since the delay in receiving responses is usually small, there is no change in the time schedule used to pull abandoned applications.

#### *Original Mailed Paper Not Delivered*

Paragraph (b) of 37 CFR 1.8 concerns the situation where a paper containing a Certificate of Mailing was timely deposited in the U.S. mail, but never received by the Patent and Trademark Office. This paragraph provides that the person who forwarded such a paper may (1) inform the Office of the previous mailing of the paper, (2) supply a duplicate copy of the previously mailed paper and Certificate of Mailing, and (3) make a declaration which attests to the previous timely mailing. If the conditions of paragraph (b) have been satisfactorily fulfilled, the earlier mailed, but unreceived paper, will be considered as having been timely deposited on the date stated in the original Certificate. In the examining groups, all such declarations should be considered and the sufficiency thereof determined by the Group Director.

### **513 Deposit as Express Mail With U.S. Postal Service [R-14]**

*35 U.S.C. 21 Filing date and day for taking action.*

(a) The Commissioner may by rule prescribe that any paper or fee required to be filed in the Patent and Trademark Office will be considered filed in the Office on the date on which it was deposited with the United States Postal Service or would have been deposited with the

United States Postal Service but for postal service interruptions or emergencies designated by the Commissioner.

*37 CFR 1.10 Filing of papers and fees by "Express Mail" with certificate.*

(a) Any paper or fee to be filed in the Patent and Trademark Office can be filed utilizing the "Express Mail Post Office to Addressee" service of the United States Postal Service and be considered as having been filed in the Office on the date the paper or fee is shown to have been deposited as "Express Mail" with the United States Postal Service unless the date of deposit is a Saturday, Sunday, or Federal holiday within the District of Columbia.

(b) Any paper or fee filed by "Express Mail" must have the number of the "Express Mail" mailing label placed thereon prior to mailing, be addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231, and any such paper or fee must also include a certificate of mailing by "Express Mail" which states the date of mailing by "Express Mail" and is signed by the person mailing the paper or fee.

(c) The Patent and Trademark Office will accept the certificate of mailing by "Express Mail" and accord the paper or fee the certificate date under 35 U.S.C. 21(a) (unless the certificate date is a Saturday, Sunday, or Federal holiday within the District of Columbia - see § 1.6(a)) without further proof of the date on which the mailing by "Express Mail" occurred unless a question is present regarding the date of mailing. If more than a reasonable time has elapsed between the certificate date and the Patent and Trademark Office receipt date or if other questions regarding the date of mailing are present, the person mailing the paper or fee may be required to file a copy of the "Express Mail" receipt showing the actual date of mailing and a statement from the person who mailed the paper or fee averring to the fact that the mailing occurred on the date certified. Such statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office.

[*Paras. (a) & (c), 49 FR 552, Jan. 4, 1984, effective Apr. 1, 1984*]

37 CFR 1.10 provides a procedure for assigning the date on which any paper or fee is deposited as "Express Mail" with the United States Postal Service as the filing date of the paper or fee in the Patent and Trademark Office unless it was mailed on a Saturday, Sunday, or a federal holiday within the District of Columbia, in which case the filing date will be the next succeeding day which is not a Saturday, Sunday, or a federal Holiday within the District of Columbia. Authority for the Commissioner to establish such a procedure is provided in section 21(a) of Title 35, United States Code, as amended by Pub. L. 97-247 for any paper or fee required to be filed in the Patent and Trademark Office. This procedure covers the filing of all documents, including patent and trademark applications, and fees since they are required to be filed in the Patent and Trademark Office for processing.

The procedure, in 37 CFR 1.10(a), requires the use of the "Express Mail Post Office to Addressee" service of the United States Postal Service. This service provides for the use of a mailing label on which the Post Office clearly indicates the date on which it was deposited. 37 CFR 1.10(b) requires: (1) That the number of the "Express Mail" mailing label be placed on each paper or fee and (2) that a certificate of mailing by "Express

Mail", signed by the person mailing the paper or fee, be included on each paper or fee and state the date of deposit as "Express Mail" in the United States Postal Service. The requirement that each paper or fee have the number of the "Express Mail" mailing label and the certificate of mailing by "Express Mail" included thereon is necessary so that the Patent and Trademark Office can verify when each paper or fee was filed if questions relating thereto arise. The number and certificate must be placed on each separate paper and each fee transmittal either directly on the document or by a separate paper firmly and securely attached thereto. It is not necessary that the number and certificate be placed on each page of a particular paper or fee transmittal. Merely placing the number and certificate in one prominent location on each separate paper or fee transmittal will be sufficient.

Under 37 CFR 1.10(c), the Office will accord the paper or fee the date of deposit as "Express Mail" as the filing date without further proof unless a question is present regarding the date of mailing. If, however, more than a reasonable time has elapsed between the certificate date and the Patent and Trademark Office receipt date, or if other questions regarding the date of mailing are present, 37 CFR 1.10(c) provides that the person mailing the paper or fee may be required to file: (1) A copy of the "Express Mail" receipt showing the actual date of mailing and (2) a statement from the person who mailed the paper or fee averring to the fact that the mailing occurred on the date certified. Such statement must be a verified statement (oath or declaration) unless made by a person registered to practice before the Patent and Trademark Office.

The certificate of mailing procedure of 37 CFR 1.8(a) continues to be available in addition to the procedure under 37 CFR 1.10.

The "Express Mail" service is seen to be preferable to other types of postal services because a readily legible mailing date is provided to both the applicant and the Patent and Trademark Office on the "Express Mail" label. Also, the labels are of uniform size and can therefore be kept on file relatively easily by the Office, if such is determined to be necessary or desirable. Registered mail and certified mail, on the other hand, provide only a postmark for the mailing date when such mail arrives in the Patent and Trademark Office and such postmarks are often illegible. Also, such mail arrives in various size envelopes which do not easily lend themselves to being filed so that the postmark may be retained. Administrative burdens including lack of certainty of mailing date and storage are considered greater for registered or certified mail than for "Express Mail".

In those cases where the procedure has not been properly followed, e.g., the certificate is illegible, improperly worded, unsigned, or does not provide the "Express Mail" label number, the date stamped on the papers will be the date of actual receipt in the Office. If the filing date of an application is involved, applicants may wish to file a petition, accompanied by the petition fee ( 37 CFR 1.17(h)) presenting whatever arguments and evidence he or she may have that the application is entitled to a filing date as of the date it was sent by "Express Mail".

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