

# Appendix R - Patent Rules

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

### CHAPTER 1 - PATENT AND TRADEMARK OFFICE, DEPARTMENT OF COMMERCE

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## Subpart A - General Provisions

### GENERAL INFORMATION AND CORRESPONDENCE

#### § 1.1 All communications to be addressed to the 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.

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."

[46 FR 29181, May 29, 1981; para. (d) added, 49 FR 34724, Aug. 31, 1984, effective Nov. 1, 1984; para. (e), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985, para. (f) added, 52 FR 9394, Mar. 24, 1987]

#### § 1.2 Business to be transacted in writing.

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

#### § 1.3 Business to be conducted with decorum and courtesy.

Applicants and their attorneys or agents are required to conduct their business with the Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Commissioner and will be returned by his direct order. Complaints against examiners and other employees must be made in communications separate from other papers.

#### § 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 1.352; of international applications in Subpart C, §§ 1.401 to 1.482; of reexamination of patents in Subpart D, §§ 1.501 to 1.570; of interferences in Subpart E, §§ 1.601 to 1.688; 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.

[24 FR 10332, Dec. 22, 1959; 43 FR 20461, May 11, 1978; para. (a), 48 FR 2707, Jan. 20, 1983, effective Feb. 27, 1983; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985]

### § 1.5 Identification of application, patent or registration.

(a) When a letter concerns an application for patent, it should state the name of the applicant, the title of the invention, the serial number or international application number of the application, 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, it should state the number and date of issue of the patent, the name of the patentee, and the title of the invention.

(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 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.

[24 FR 10332, Dec 22, 1959; 46 FR 29181, May 29, 1981; para. (a) 49 FR 552, Jan. 4, 1984, effective Apr. 1, 1984; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985]

### § 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.

[48 FR 2707, Jan. 20, 1983, effective Feb. 27, 1983; 48 FR 4285, Jan. 31, 1983; para. (a), 49 FR 552, Jan. 4, 1984, effective Apr. 1, 1984]

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

Whenever periods of time are specified in this part in days, calendar days are intended. When the day, or the last day fixed by statute or by or under this part for taking any action or paying any fee in the Patent and Trademark Office falls on Saturday, Sunday, or on a Federal holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding day which is not a Saturday, Sunday, or a Federal holiday. See § 1.304 for time for appeal or for commencing civil action.

[48 FR 2707, Jan. 20, 1983, effective Feb. 27, 1983; corrected 48 FR 4285, Jan. 31, 1983]

### § 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.

(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.

[41 FR 43721, Oct. 4, 1976; 43 FR 20461, May 11, 1978; para. (a), 47 FR 47381, Oct. 26, 1982, effective Oct. 26, 1982; para. (a), 48 FR 2708, Jan. 20, 1983; para. (a) 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (a), 49 FR 5171, Feb. 6, 1985, effective Mar. 8, 1985; 52 FR 20046, May 28, 1987]

### § 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.

(c) 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.

[43 FR 20461, May 11, 1978; 47 FR 40139, Sept. 10, 1982, effective Oct. 1, 1982; 47 FR 43275, Sept. 30, 1982, effective Oct. 1, 1982; para. (d), 49 FR 34724, Aug. 31, 1984, effective Nov. 1, 1984; para. (g), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985]

### § 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. See § 1.6(a).

(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.

[48 FR 2708, Jan. 20, 1983, added effective Feb. 27, 1983; 48 FR 4285, Jan. 31, 1983, paras. (a) & (c), 49 FR 552, Jan. 4, 1984, effective Apr. 1, 1984]

## RECORDS AND FILES OF THE PATENT AND TRADEMARK OFFICE

### § 1.11 Files open to the public.

(a) After a patent has been issued or a statutory invention registration has been published, the specification, drawings, and

all papers relating to the case in the file of the patent or statutory invention registration are open to inspection by the public, and copies may be obtained upon paying the fee therefor. See § 2.27 for trademark files.

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

(c) All requests for reexamination for which the fee under § 1.20(c) has been paid, will be announced in the *Official Gazette*. Any reexaminations at the initiative of the Commissioner pursuant to § 1.520 will also be announced in the *Official Gazette*. The announcement shall include at least the date of the request, if any, the reexamination request control number or the Commissioner initiated order control number, patent number, title, class and subclass, name of the inventor, name of the patent owner of record, and the examining group to which the reexamination is assigned.

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

(e) The file of any interference involving a patent, a statutory invention registration, or an application on which a patent has been issued or which has been published as a statutory invention registration, is open to inspection by the public, and copies may be obtained upon paying the fee therefore, if: (1) the interference has terminated, or (2) an award of priority or judgment has been entered as to all parties and all counts.

[OMB Control Nos. 0651-0010 & 0651-0014]

[42 FR 5593, Jan. 28, 1977; 43 FR 28477, June 30, 1978; 46 FR 29181, May 29, 1981, Para. (c), 47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; paras. (a), (b) & (e), 50 FR 9378, Mar. 7, 1985, effective May 8, 1985]

### § 1.12 Assignment records open to public inspection.

(a) The assignment records, relating to original or reissue patents, including digests and indexes, and assignment records relating to pending or abandoned trademark applications and to trademark registrations are open to public inspection and copies of any instrument recorded may be obtained upon requests and payment of the fee set forth in § 1.19(a)(5).

(b) Assignment records, digests, and indexes, relating to any pending or abandoned patent application are not available to the public. Copies of any such assignment records and information with respect thereto shall be obtainable only upon written authority of the applicant or applicant's assignee or attorney or agent or upon a showing that the person seeking such information is a bona fide prospective or actual purchaser, mortgagee, or licensee of such application, unless it shall be necessary to the



proper conduct of business before the Office or as provided by these rules.

(c) Any request by a member of the public seeking copies of any assignment records of any pending or abandoned patent application preserved in secrecy under § 1.14, or any information with respect thereto, must (1) be in the form of a petition accompanied by the petition fee set forth in § 1.17(i) or (2) include written authority granting access to the member of the public to the particular assignment records from the applicant or applicant's assignee for attorney or agent of record.

(d) An order for a copy of an assignment should give the identification of the record. If identified only by the name of the patentee and number of the patent, or in the case of a trademark registration by the name of the registrant and number of the registration, or by name of the applicant and serial number or international application number of the application, an extra charge as set forth in § 1.21(f) will be made for the time consumed in making a search for such assignment.

[47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982]

### § 1.13 Copies and certified copies.

(a) Copies of patents and trademark registrations and of any records, books, papers, or drawings belonging to the Patent and Trademark Office and open to the public will be furnished by the Patent and Trademark Office to any person, and copies of other records or papers will be furnished to persons entitled thereto, upon payment of the fee therefor.

(b) Such copies will be authenticated by the seal of the Patent and Trademark Office and certified by the Commissioner, or in his name attested by an officer of the Patent and Trademark Office authorized by the Commissioner, upon payment of the fee for the authentication certificate in addition to the fee for the copies.

[OMB Control Nos. 0651-0009, 0651-0010 & 0651-0014]

### § 1.14 Patent applications preserved in secrecy.

(a) Except as provided in § 1.11(b) pending patent applications are preserved in secrecy. No information will be given by the Office respecting the filing by any particular person of an application for a patent, the pendency of any particular case before it, or the subject matter of any particular application, nor will access be given to or copies furnished of any pending application or papers relating thereto, without written authority in that particular application from the applicant or his assignee or attorney or agent of record, unless the application has been identified by serial number in a published patent document or the United States of America has been indicated as a Designated State in a published international application, in which case status information such as whether it is pending, abandoned or patented may be supplied, or unless it shall be necessary to the proper conduct of business before the Office or as provided by this part. Where an application has been patented, the patent number and issue date may also be supplied.

(b) Except as provided in § 1.11(b) abandoned applications are likewise not open to public inspection, except that if an application referred to in a U.S. patent, or in an application in which the applicants has filed an authorization to open the

complete application to the public, is abandoned and is available, it may be inspected or copies obtained by any person on written request, without notice to the applicant.

(c) Applications for patents which disclose or which appear to disclose, or which purport to disclose, inventions or discoveries relating to atomic energy are reported to the Department of Energy, which Department will be given access to such applications, but such reporting does not constitute a determination that the subject matter of each application so reported is in fact useful or an invention or discovery or that such application in fact discloses subject matter in categories specified by sections 151(c) and 151(d) of the Atomic Energy Act of 1954, 68 Stat. 919; 42 U.S.C. 2181 (c) and (d).

(d) Any decision of the Board of Patent Appeals and Interferences, or any decision of the Commissioner on petition, not otherwise open to public inspection shall be published or made available for public inspection if: (1) The Commissioner believes the decision involves an interpretation of patent laws or regulations that would be of important precedent value; and (2) the applicant, or any party involved in the interference, does not within two months after being notified of the intention to make the decision public, object in writing on the ground that the decision discloses a trade secret or other confidential information, if a decision discloses such information, the applicant or party shall identify the deletions in the text of the decision considered necessary to protect the information. If it is considered the entire decision must be withheld from the public to protect such information the applicant or party must explain why. Applicants or parties will be given time, not less than twenty days, to request reconsideration and seek court review before any portions of decisions are made public over their objection. See § 2.27 for trademark applications.

(e) Any request by a member of the public seeking access to, or copies of, any pending or abandoned application preserved in secrecy pursuant to paragraphs (a) and (b) of this section, or of any papers relating thereto, must (1) be in the form of a petition and be accompanied by the petition fee set forth in § 1.17(i) or (2) include written authority granting access to the member of the public in that particular application from the applicant or the applicant's assignee or attorney or agent of record.

[OMB Control Nos. 0651-0010 & 0651-0011]

[42 FR 5593, Jan. 28, 1977; 43 FR 20462, May 11, 1978; para. (e) added, 47 FR 41273, Sept. 17, 1982, effective Oct. 1, 1982; para. (b), 49 FR 552, Jan. 4, 1984, effective Apr. 1, 1984; para. (d), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (b), 50 FR 9378, Mar. 7, 1985, effective May 8, 1985]

### § 1.15 Requests for identifiable records.

(a) Requests for records not disclosed to the public as part of the regular informational activity of the Patent and Trademark Office and which are not otherwise dealt with in the rules in this part may be made by completing Form CD-244, "Application to Inspect Department Records," and submitting this form, in person or by mail, to the Commissioner of Patents and Trademarks, Washington, D.C. 20231. A nonrefundable application fee of \$2 must accompany each application. Copies of Form CD-244 are available in the Central Reference and Records

Inspection Facility, Room 2122, Department of Commerce Building, Washington, D.C. 20230, the search room of the Patent Reference Branch of the Patent and Trademark Office, the search room of the Trademark Examining Operation, and in many public information offices and field offices of the Department of Commerce. If the requested record is identifiable, the request will be reviewed by the appropriate official authorized to make an initial determination of the availability of the record. If it is determined that the material is not to be made available to the requesting person, said person shall be notified in writing of that fact and the reasons why the record will not be disclosed. If the record is to be made available, inspection will be permitted in the appropriate Patent and Trademark Office search room. Fees for copies of records and for searches and related services are payable in accordance with the schedule of fees and charges established in § 4.8 of Title 15, *Code of Federal Regulations*.

(b) Any person whose application to inspect a record has been refused may request a reconsideration of the initial denial by completing and submitting the appropriate section of the Form CD-244. The request for reconsideration should be made within 30 days of the date of the original denial. In submitting such request the party should include any written argument he desires to support his belief that the record requested should be made available. No personal appearance, oral argument, or hearing shall be permitted. The decision upon such request shall be made by the Commissioner of Patents and Trademarks and shall be based upon the original request, the denial, and any written argument submitted by the person seeking access to the record. The decision upon review shall be promptly made in writing and communicated to the person seeking access. If the decision is wholly or partly in favor of availability, the requested record to such extent shall be made available for inspection as described in paragraph (a) of this section. To the extent that the decision is adverse to the request, the reasons for the denial shall be stated. A decision upon review completed as provided herein shall constitute the final decision and action of the Patent and Trademark Office as to the availability of a requested record, except as may be required by court proceedings initiated pursuant to 5 U.S.C. 552(a)(3). Reconsiderations resulting in final decisions as prescribed herein shall be indexed and made available in the search room of the Patent Reference Branch.

(c) Procedures applicable in the event of a subpoena, order, or other compulsory process or demand of a court or other authority shall be those set forth in Section 7 of Department Order 64 (32 F.R. 9734, July 4, 1967).

[32 FR 13812, Oct. 4, 1967; 34 FR 18857, Nov. 26, 1969]

**FEES AND PAYMENT OF MONEY**

**§ 1.16 National application filing fees.**

(a) Basic fee for filing each application for an original patent, except design or plant cases:

- By a small entity (§ 1.9(f)) ..... \$170.00
- By other than a small entity ..... 340.00

(b) In addition to the basic filing fee in an original application, for filing or later presentation of each independent claim in excess of 3:

- By a small entity (§ 1.9(f)) ..... 17.00
- By other than a small entity ..... 34.00

(c) In addition to the basic filing fee in an original application, for filing or later presentation of each claim (whether independent or dependent) in excess of 20 (Note that § 1.75(c) indicates how multiple dependent claims are considered for fee calculation purposes.):

- By a small entity (§ 1.9(f)) ..... 6.00
- By other than a small entity ..... 12.00

(d) In addition to the basic filing fee in an original application, if the application contains, or is amended to contain, a multiple dependent claim(s), per application:

- By a small entity (§ 1.9(f)) ..... 55.00
- By other than a small entity ..... 110.00

(If the additional fees required by paragraphs (b), (c) and (d) are not paid on filing or on later presentation of the claims for which the additional fees are due, they must be paid or the claims cancelled by amendment, prior to the expiration of the time period set for response by the Office in any notice of fee deficiency.)

(e) Surcharge for filing the basic filing fee or oath or declaration on a date later than the filing date of the application:

- By a small entity (§ 1.9(f)) ..... 55.00
- By other than a small entity ..... 110.00

(f) For filing each design application:

- By a small entity (§ 1.9(f)) ..... 70.00
- By other than a small entity ..... 140.00

(g) Basic fee for filing each plant application:

- By a small entity (§ 1.9(f)) ..... 110.00
- By other than a small entity ..... 220.00

h) Basic fee for filing each reissue application:

- By a small entity (§ 1.9(f)) ..... 170.00
- By other than a small entity ..... 340.00

(i) In addition to the basic filing fee in a reissue application, for filing or later presentation of each independent claim which is in excess of the number of independent claims in the original patent:

- By a small entity (§ 1.9(f)) ..... 17.00
- By other than a small entity ..... 34.00

(j) In addition to the basic filing fee in a reissue application, for filing or later presentation of each claim (whether independent or dependent) in excess of 20 and also in excess of the number of claims in the original patent, (Note that § 1.75(c) indicates how multiple dependent claims are considered for fee purposes.):

- By a small entity (§ 1.9(f)) ..... 6.00
- By other than a small entity ..... 12.00

(Note, see § 1.445 for international application filing and processing fees.)

[Added 47 FR 41273, Sept. 17, 1982, effective date Oct. 1, 1982; 50 FR 31824, Aug. 6, 1985, effective date Oct. 5, 1985]

**§ 1.17 Patent application processing fees.**

(a) Extension fee for response within first month pursuant to § 1.136(a):

- By a small entity (§ 1.9(f)) ..... \$28.00
- By other than a small entity ..... 56.00

- (b) Extension fee for response within second month pursuant to § 1.136(a):
  - By a small entity (§ 1.9(f)) ..... 85.00
  - By other than a small entity ..... 170.00
- (c) Extension fee for response within third month pursuant to § 1.136(a):
  - By a small entity (§ 1.9(f)) ..... 195.00
  - By other than a small entity ..... 390.00
- (d) Extension fee for response within fourth month pursuant to § 1.136(a):
  - By a small entity (§ 1.9(f)) ..... 305.00
  - By other than a small entity ..... 610.00
- (e) For filing a notice of appeal from the examiner to the Board of Patent Appeals and Interferences:
  - By a small entity (§ 1.9(f)) ..... 65.00
  - By other than a small entity ..... 130.00
- (f) In addition to the fee for filing notice of appeal, for filing brief in support of an appeal:
  - By a small entity (§ 1.9(f)) ..... 65.00
  - By other than a small entity ..... 130.00
- (g) For filing a request for an oral hearing before the Board of Patent Appeals and Interferences:
  - By a small entity (§ 1.9(f)) ..... 55.00
  - By other than a small entity ..... 110.00
- (h) For filing a petition to the Commissioner under a section of this part listed below which refers to this paragraph ..... 140.00
  - § 1.47 — for filing by other than all the inventors or a person not the inventor
  - § 1.48 — for correction of inventorship
  - § 1.182 — for decision on questions not specifically provided for
  - § 1.183 — to suspend the rules
  - § 1.295 — for review of refusal to publish a statutory invention registration
  - § 1.377 — for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of patent.
  - § 1.378(e) — for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in expired patent
  - § 1.644(a) — for petition in an interference
  - § 1.644(f) — for request for reconsideration of a decision on petition in an interference
  - § 1.666(c) — for late filing of interference settlement agreement
  - §§ 5.12, 5.13 & 5.14 — for expedited handling of a foreign filing license
  - § 5.15 — for changing the scope of a license.
  - § 5.25 — for retroactive license.
- (i) For filing a petition to the Commissioner under a section of this part listed below which refers to this paragraph...72.00
  - § 1.12 — for access to an assignment record
  - § 1.14 — for access to an application
  - § 1.55 — for entry of late priority papers
  - § 1.102 — to make application special
  - § 1.103 — to suspend action in application

- § 1.177 — for divisional reissues to issue separately
  - § 1.312 — for amendment after payment of issue fee
  - § 1.313 — to withdraw an application from issue
  - § 1.314 — to defer issuance of a patent
  - § 1.334 — for patent to issue to assignee, assignment recorded late
  - § 1.666(b) — for access to interference settlement agreement
  - (j) for filing a petition to institute a public use proceeding under § 1.292 ..... 860.00
  - (k) For processing an application filed with a specification in a non-English language (§ 1.52(d)) ..... 26.00
  - (l) For filing a petition (1) for the revival of an abandoned application under 35 U.S.C. 133 or 371, or (2) for delayed payment of the issue fee under 35 U.S.C. 151:
    - By a small entity (§ 1.9(f)) ..... 28.00
    - By other than a small entity ..... 56.00
  - (m) For filing a petition (1) for revival of an unintentionally abandoned application or (2) for the unintentionally delayed payment of the fee for issuing a patent:
    - By a small entity (§ 1.9(f)) ..... 280.00
    - By other than a small entity ..... 560.00
  - (n) For requesting publication of a statutory invention registration prior to the mailing of the first examiner's action pursuant to § 1.104 - \$400.00 reduced by the amount of the application basic filing fee paid.
  - (o) For requesting publication of a statutory invention registration after the mailing of the first examiner's action pursuant to § 1.104 - \$800.00 reduced by the amount of the application basic filing fee paid.
    - [Added 47 FR 41273, Sept. 17, 1982, effective Oct. 1, 1982; para. (h), 48 FR 2708, Jan. 20, 1983, effective Feb. 27, 1983; para. (h), 49 FR 13461, Apr. 4, 1984, effective June 4, 1984; para. (h), 49 FR 34724, Aug. 31, 1984, effective Nov. 1, 1984; paras. (e), (g), (h) & (i), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; paras. (h), (n) & (c), 50 FR 9379, Mar. 7, 1985, effective May 8, 1985; 50 FR 31824, Aug. 6, 1985, effective Oct. 5, 1985]
- § 1.18 Patent issue fees.**
- (a) Issue fee for issuing each original or reissue patent, except a design or plant patent:
    - By a small entity (§ 1.9(f)) ..... \$280.00
    - By other than a small entity ..... 560.00
  - (b) Issue fee for issuing a design patent:
    - By a small entity (§ 1.9(f)) ..... 100.00
    - By other than a small entity ..... 200.00
  - (c) Issue fee for issuing a plant patent:
    - By a small entity (§ 1.9(f)) ..... 140.00
    - By other than a small entity ..... 280.00
  - [Added 47 FR 41273, Sept. 17, 1982, effective Oct. 1, 1982; 50 FR 31824, Aug. 6, 1985, effective Oct. 5, 1985]
- § 1.19 Document supply fees.**
- The Patent and Trademark Office will supply copies of the following documents upon payment of the fees indicated:
- (a) Uncertified copies of Office documents:
    - (1) Printed copy of a patent, including a design patent, statutory invention registration, or defensive publication docu-

ment, except color plant patent or color statutory invention registration ..... \$1.50

(2) Printed copy of a plant patent or statutory invention registration in color ..... 6.00

(3) Copy of patent application as filed ..... 9.00

(4) Copy of patent file wrapper and contents, each 200 pages or fraction thereof ..... 75.00

(5) Copy of Office records, except as provided in this section, per page ..... 0.50

(6) Microfiche copy of microfiche, per microfiche.. 0.50

(7) Copy of patent assignment record ..... 1.50

(b) Certified copies of Office documents:

(1) For certifying Office records, per certificate.. .... 3.00

(2) For a search of assignment records, abstract of title and certification, per patent ..... 12.00

(c) Subscription services:

(1) Subscription orders for printed copies of patents as issued, annual service charge for entry of order and ten subclasses ..... 7.00

(2) For annual subscription to each additional subclass in addition to the ten covered by the fee under paragraph (c)(1) of this section, per subclass ..... 0.70

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

(e) Lists of patents in subclass:

(1) For list of all United States patents and statutory invention registrations in a subclass, per 100 numbers or fraction thereof ..... 1.00

(2) For list of United States patents and statutory invention registrations in a subclass limited by date or number, per 50 numbers or fraction thereof ..... 1.00

(f) Microfiche copy of patent file record ..... 6.00

(g) Uncertified statement as to status of the payment of maintenance fees due on a patent or expiration of a patent. .... 3.00

(h) Uncertified copy of a non-United States patent document, per document ..... 10.00

(i) To compare and certify copies made from Patent and Trademark Office records but not prepared by the Patent and Trademark Office, per page of document ..... 5.00

(j) Additional filing receipts

(1) Duplicate ..... 14.00

(2) Corrected due to applicant error ..... 14.00

[Added 47 FR 41273, Sept. 17, 1982, effective date Oct. 1, 1982; para. (b), 49 FR 552, Jan. 4, 1984, effective date Apr. 1, 1984; paras. (f) & (g) added, 49 FR 34724, Aug. 31, 1984, effective date Nov. 1, 1984; paras. (a) & (c), 50 FR 9379, Mar. 7, 1985, effective date May 8, 1985; 50 FR 31825, Aug. 6, 1985, effective date Oct. 5, 1985]

§ 1.20 Post-issuance fees.

(a) For providing a certificate of correction of applicant's mistake (§ 1.323) ..... \$29.00

(b) Petition for correction of inventorship in patent (§ 1.324) ..... 140.00

(c) For filing a request for reexamination (§ 1.510(a)) ..... 1,770.00

(d) For filing each statutory disclaimer (§ 1.321):  
By a small entity (§ 1.9(f)) ..... 28.00

By other than a small entity ..... 56.00

(e) For maintaining an original or reissue patent, except a design or plant patent, based on an application filed on or after December 12, 1980 and before August 27, 1982, in force beyond 4 years; the fee is due by three years and six months after the original grant ..... 225.00

(f) For maintaining an original or reissue patent, except a design or plant patent, based on an application filed on or after December 12, 1980 and before August 27, 1982, in force beyond 8 years; the fee is due by seven years and six months after the original grant ..... 445.00

(g) For maintaining an original or reissue patent, except a design or plant patent, based on an application filed on or after December 12, 1980 and before August 27, 1982, in force beyond 12 years; the fee is due by eleven years and six months after the original grant ..... 670.00

(h) For maintaining an original or reissue patent, except a design or plant patent, based on an application filed on or after August 27, 1982, in force beyond 4 years; the fee is due by three years and six months after the original grant:

By a small entity (§ 1.9(f)) ..... 225.00

By other than a small entity ..... 450.00

(i) For maintaining an original or reissue patent, except a design or plant patent, based on an application filed on or after August 27, 1982, in force beyond 8 years; the fee is due by seven years and six months after the original grant:

By a small entity (§ 1.9(f)) ..... 445.00

By other than a small entity ..... 890.00

(j) For maintaining an original or reissue patent, except a design or plant patent, based on an application filed on or after August 27, 1982, in force beyond 12 years; the fee is due by eleven years and six months after the original grant:

By a small entity (§ 1.9(f)) ..... 670.00

By other than a small entity ..... 1,340.00

(k) Surcharge for paying a maintenance fee during the 6-month grace period following the expiration of three years and six months, seven years and six months, and eleven years and six months after the date of the original grant of a patent based on an application filed on or after December 12, 1980 and before August 27, 1982 ..... 110.00

(l) Surcharge for paying a maintenance fee during the 6-month grace period following the expiration of three years and six months, seven years and six months, and eleven years and six months after the date of the original grant of a patent based on an application filed on or after August 27, 1982:

By a small entity (§ 1.9(f)) ..... 55.00

By other than a small entity ..... 110.00

(m) Surcharge for accepting a maintenance fee after expiration of a patent for non-timely payment of a maintenance fee where the delay in payment is shown to the satisfaction of the Commissioner to have been unavoidable ..... 500.00

(n) For filing an application for extension of the term of a patent (§ 1.740) ..... 550.00

[Added 47 FR 41273, Sept. 17, 1982, effective date Oct. 1, 1982; paras. (k), (l) & (m) added, 49 FR 34724, Aug. 31, 1984, effective date Nov. 1, 1984; paras. (c), (f), (g) & (m), 50 FR 9379, Mar. 7, 1985, effective date May 8, 1985; 50 FR 31825, Aug. 6, 1985, effective date Oct. 5, 1985; 51 FR 28057, Aug. 4, 1986]

**§ 1.21 Miscellaneous fees and charges.**

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

- (a) Registration of attorneys and agents:
  - (1) For admission to examination for registration to practice, fee payable upon application ..... \$250.00
  - (2) On registration to practice ..... 81.00
  - (3) For reinstatement to practice ..... 9.00
  - (4) For certificate of good standing as an attorney or agent ..... 10.00
    - Suitable for framing ..... 88.00
  - (5) For review of decision of the Director of Enrollment and Discipline under § 10.2(c) ..... 92.00
  - (6) For requesting regrading of an examination under § 10.7(c) ..... 92.00
- (b) Deposit accounts:
  - (1) For establishing or reinstating a deposit account ..... 8.00
  - (2) Service charge for each month when the balance at the end of the month is below \$1,000 ..... 20.00
  - (3) Service charge for each month when the balance at the end of the month is below \$300 for restricted subscription deposit accounts used exclusively for subscription order of patent copies as issued ..... 20.00
- (c) Disclosure document: For filing a disclosure document ..... 6.00
- (d) Delivery box: Local delivery box rental, per annum ..... 43.00
- (e) International-type search reports: For preparing an international-type search report of an international type search made at the time of the first action on the merits in a national patent application..... 28.00
- (f) Search of Office records: For searching Patent and Trademark Office records for purposes not otherwise specified, per one-half hour or fraction thereof ..... 14.00
- (g) CopiShare card: Cost per copy ..... 0.20
- (h) Recording of documents:
  - (1) For recording each assignment, agreement or other paper relating to the property in a patent or application ..... 7.00
  - (2) Where a document to be recorded under paragraph (h)(1) of this section refers to more than one patent or application, for each additional patent or application ..... 2.00
- (i) Publication in *Official Gazette*: For publication in the *Official Gazette* of a notice of the availability of an application or a patent for licensing or sale, each application or patent ..... 7.00
- (j) For a duplicate or replacement of a permanent Office user pass (There is no charge for the first permanent user pass) ..... 5.00
- (k) For items and services, that the Commissioner finds may be supplied, for which fees are not specified by statute or by this section, such charges as may be determined by the Commissioner with respect to each such item or service..... Actual cost
  - (l) For processing and retaining any application abandoned pursuant to § 1.53(d) unless the required basic filing fee has been paid ..... 100.00

(m) For processing each check returned "unpaid" by a bank ..... 20.00

[Added 47 FR 41274, Sept. 17, 1982, effective date Oct. 1, 1982; paras. (b) & (l), 49 FR 553, Jan. 4, 1984, effective date Apr. 1, 1984; paras. (a)(5) & (6) added, 50 FR 5171, Feb. 6, 1985, effective date Apr. 8, 1985; 50 FR 31825, Aug. 6, 1985, effective date Oct. 5, 1985]

**§ 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.

[48 FR 2708, Jan. 20, 1983, effective Feb. 27, 1983]

**§ 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.

[43 FR 20462, May 11, 1978]

**§ 1.24 Coupons.**

Coupons in denominations of one dollar and fifty cents 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 one dollar and fifty cent coupons are sold individually and in books of 50 with stubs for record for \$75.00. These coupons are good until used; they may be transferred but cannot be redeemed.

[OMB Control Nos. 0651-0010 & 0651-0014]

[47 FR 41274, Sept. 17, 1982, effective Oct. 1, 1982; 48 FR 2708, Jan. 20, 1983, effective date Feb. 27, 1983; 50 FR 31825, Aug. 6, 1985, effective Oct. 5, 1985; 51 FR 28057, Aug. 4, 1986]

**§ 1.25 Deposit accounts.**

(a) For the convenience of attorneys, and the general public in paying any fees due, in ordering services offered by the Office, copies of records, etc. deposit accounts may be established in the Patent and Trademark Office upon payment of the fee for establishing a deposit account (§ 1.21(b)(1)). A minimum deposit of \$1,000 is required for paying any fee due or in

ordering any services offered by the Office. However, a minimum deposit of \$300 may be paid to establish a restricted subscription deposit account used exclusively for subscription order of patent copies as issued. At the end of each month, a deposit account statement will be rendered. A remittance must be made promptly upon receipt of the statement to cover the value of items or services charged to the account and thus restore the account to its established normal deposit value. 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.

[OMB Control Nos. 0651-0010 & 0651-0014]

[49 FR 553, Jan. 4, 1984, effective Apr. 1, 1984; 47 FR 41274, Sept. 17, 1982, effective Oct. 1, 1982; 50 FR 31826, Aug. 6, 1985, effective Oct. 5, 1985]

### § 1.26 Refunds.

(a) Money paid by actual mistake or in excess, such as a payment not required by law, 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 one dollar or less will not be returned unless specifically demanded within a reasonable time, nor will the payer be notified of such amount; amounts over one dollar 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 \$1,300 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.

[47 FR 41274, Sept. 17, 1982, effective Oct. 1, 1982; 50 FR 31826 Aug. 6, 1985, effective Oct. 5, 1985]

### § 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.

[OMB Control No. 0651-0011]

47 FR 40139, Sept. 10, 1982, added effective Oct. 1, 1982; para. (c) added, 47 FR 43276, Sept. 30, 1982; paras. (b), (c), & (d), 49 FR 553, Jan. 4, 1984, effective Apr. 1, 1984]

### § 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 through gross negligence (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. See §§ 1.56(d) and 1.555 of this part.

[47 FR 40140, Sept. 10, 1982, added effective Oct. 1, 1982; para. (a), 49 FR 553, Jan. 4, 1984, effective Apr. 1, 1984]

## Subpart B - National Processing Provisions

### PROSECUTION OF APPLICATION AND APPOINTMENT OF ATTORNEY OR AGENT

#### § 1.31 Applicants may be represented by a registered attorney or agent.

An applicant for patent may file and prosecute his or her own case, or he or she may be represented by a registered attorney, registered agent, or other individual authorized to practice before the Patent and Trademark Office in patent cases. See §§ 10.6 and 10.9 of this subchapter. The Patent and Trademark Office cannot aid in the selection of a registered attorney or agent.

[OMB Control No. 0651-0011]

[50 FR 5171, Feb. 6, 1985, effective Mar. 8, 1985]

#### § 1.32 Prosecution by assignee.

The assignee of record of the entire interest in an application for patent is entitled to conduct the prosecution of the application to the exclusion of the inventor.

#### § 1.33 Correspondence respecting patent applications, reexamination proceedings, and other proceedings.

(a) The residence and post office address of the applicant must appear in the oath or declaration if not stated elsewhere in the application. The applicant may also specify an attorney or agent of record may specify a correspondence address to which communications about the application are to be directed. All notices, official letters, and other communications in the case will be directed to the correspondence address or, if no such correspondence address is specified, to an attorney or agent of record (see § 1.34(b)), or, if no attorney or agent is of record, to the applicant, or to any assignee of record of the entire interest if the applicant or such assignee so requests, or to an assignee of an undivided part if the applicant so requests, at the post office address of which the Office has been notified in the case. Amendments and other papers filed in the application must be

signed: (1) By the applicant, or (2) if there is an assignee of record of an undivided part interest, by the applicant and such assignee, or (3) if there is an assignee of record of the entire interest, by such assignee, or (4) by an attorney or agent of record, or (5) by a registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34(a). Double correspondence with an applicant and his attorney or agent, or with more than one attorney or agent, will not be undertaken. If more than one attorney or agent be made of record and a correspondence address has not been specified, correspondence will be held with the one last made of record.

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

(c) All notices, official letters, and other communications for the patent owner or owners in a reexamination proceeding will be directed to the attorney or agent of record (see § 1.34(b)) in the patent file at the address listed on the register of patent attorneys and agents maintained pursuant to §§ 10.5 and 10.11 or, if no attorney or agent is of record, to the patent owner or owners at the address or addresses of record. Amendments and other papers filed in a reexamination proceeding on behalf of the patent owner must be signed by the patent owner, or if there is more than one owner by all the owners, or by an attorney or agent of record in the patent file, or by a registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34(a). Double correspondence with the patent owner or owners and the patent owner's attorney or agent, or with more than one attorney or agent, will not be undertaken. If more than one attorney or agent is of record and a correspondence address has not been specified, correspondence will be held with the last attorney or agent made of record.

(d) A "correspondence address" or change thereto may be filed with the Patent and Trademark Office during the enforceable life of the patent. The "correspondence address" will be used in any correspondence relating to maintenance fees unless a separate "fee address" has been specified. See § 1.363 for "fee address" used solely for maintenance fee purposes.

[OMB Control Nos. 0651-0010 & 0651-0013]

[36 FR 12617, July 2, 1971; 46 FR 29181, May 29, 1981; para. (d) added, 49 FR 34724, Aug. 31, 1984, effective Nov. 1, 1984; para. (c), 50 FR 5171, Feb. 6, 1985, effective Mar. 8, 1985]

### § 1.34 Recognition for representation.

(a) When a registered attorney or agent acting in a representative capacity appears in person or signs a paper in practice before the Patent and Trademark Office in a patent case, his or her personal appearance or signature shall constitute a representa-

tion to the Patent and Trademark Office that under the provisions of this Subchapter and the law, he or she is authorized to represent the particular party in whose behalf he or she acts. In filing such a paper, the registered attorney or agent should specify his or her registration number with his or her signature. Further proof of authority to act in a representative capacity may be required.

(b) When an attorney or agent shall have filed his or her power of attorney, or authorization, duly executed by the person or persons entitled to prosecute an application or a patent involved in a reexamination proceeding, he or she is a principal attorney of record in the case. A principal attorney or agent, so appointed, may appoint an associate attorney or agent who shall also then be of record.

[OMB Control No. 0651-0011]

[46 FR 29181, May 29, 1981; para. (a), 50 FR 5171, Feb. 6, 1985, effective Mar. 6, 1985]

### § 1.36 Revocation of power of attorney or authorization; withdrawal of attorney or agent.

A power of attorney or authorization of agent may be revoked at any stage in the proceedings of a case, and an attorney or agent may withdraw, upon application to and approval by the Commissioner. An attorney or agent, except an associate attorney or agent whose address is the same as that of the principal attorney or agent, will be notified of the revocation of the power of attorney or authorization, and the applicant or patent owner will be notified of the withdrawal of the attorney or agent. An assignment will not itself operate as a revocation of a power or authorization previously given, but the assignee of the entire interest may revoke previous powers and be represented by an attorney or agent of assignee's own selection. See § 1.613(d) for withdrawal of an attorney or agent of record in an interference.

[OMB Control No. 0651-0011]

[49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985]

## WHO MAY APPLY FOR A PATENT

### § 1.41 Applicant for patent.

(a) A patent must be applied for in the name of the actual inventor or inventors. Full names must be stated, including the family name and at least one given name without abbreviation together with any other given name or initial.

(b) Unless the contrary is indicated the word "applicant" when used in these sections refers to the inventor or joint inventors who are applying for a patent, or to the person mentioned in §§ 1.42, 1.43 or 1.47 who is applying for a patent in place of the inventor.

(c) Any person authorized by the applicant may file an application for patent on behalf of the inventor or inventors, but an oath or declaration for the application (§ 1.63) can only be made in accordance with § 1.64.

(d) A showing may be required from the person filing the application that the filing was authorized where such authorization comes into question.

[48 FR 2708, Jan. 20, 1983; 48 FR 4285, Jan. 31, 1983]



**§ 1.42. When the inventor is dead.**

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent. Where the inventor dies during the time intervening between the filing of the application and the granting of a patent thereon, the letters patent may be issued to the legal representative upon proper intervention.

[48 FR 2709, Jan. 20, 1983, effective Feb. 27, 1983]

**§ 1.43 When the inventor is insane or legally incapacitated.**

In case an inventor is insane or otherwise legally incapacitated, the legal representative (guardian, conservator, etc.) of such inventor may make the necessary oath or declaration, and apply for and obtain the patent.

[48 FR 2709, Jan. 20, 1983, effective Feb. 27, 1983]

**§ 1.44 Proof of authority.**

In the cases mentioned in §§ 1.42 and 1.43, proof of the power or authority of the legal representative must be recorded in the Patent and Trademark Office or filed in the application before the grant of a patent.

**§ 1.45 Joint inventors.**

(a) Joint inventors must apply for a patent jointly and each must make the required oath or declaration; neither of them alone, nor less than the entire number, can apply for a patent for an invention invented by them jointly, except as provided in § 1.47.

(b) Inventors may apply for a patent jointly even though

(1) They did not physically work together or at the same time,

(2) Each inventor did not make the same amount of contribution, or

(3) Each inventor did not make a contribution to the subject matter of every claim of the application.

(c) If multiple inventors are named in an application, each named inventor must have made a contribution, individually or jointly, to the subject matter of at least one claim of the application and the application will be considered to be a joint application under 35 U.S.C. 116.

[Paras. (b) & (c), 47 FR 41274, Sept. 17, 1982, effective Oct. 1, 1982; 48 FR 2709, Jan. 20, 1983, effective Feb. 27, 1983; 50 FR 9379, Mar. 7, 1985, effective May 8, 1985]

**§ 1.46 Assigned inventions and patents.**

In case the whole or a part interest in the invention or in the patent to be issued is assigned, the application must still be made or authorized to be made, and an oath or declaration signed, by the inventor or one of the persons mentioned in §§ 1.42, 1.43, or 1.47. However, the patent may be issued to the assignee or jointly to the inventor and the assignee as provided in § 1.334.

[48 FR 2709, Jan. 20, 1983, effective Feb. 27, 1983]

**§ 1.47 Filing when an inventor refuses to sign or cannot be reached.**

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the omitted inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts and by the required fee (§ 1.17(h)) and must state the last known address of the omitted inventor. The Patent and Trademark Office shall forward notice of the filing of the application to the omitted inventor at said address. Should such notice be returned to the Office undelivered, or should the address of the omitted inventor be unknown, notice of the filing of the application shall be published in the *Official Gazette*. The omitted inventor may subsequently join in the application on filing an oath or declaration of the character required by § 1.63. A patent may be granted to the inventor making the application, upon a showing satisfactory to the Commissioner, subject to the same rights which the omitted inventor would have had if he or she had been joined.

(b) Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action may make application for patent on behalf of and as agent for the inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, and by the required fee (§ 1.17(h)) and must state the last known address of the inventor. The assignment, written agreement to assign or other evidence of proprietary interest, or a verified copy thereof, must be filed in the Patent and Trademark Office. The Office shall forward notice of the filing of the application to the inventor at the address stated in the application. Should such notice be returned to the Office undelivered, or should the address of the inventor be unknown, notice of the filing of the application shall be published in the *Official Gazette*. The inventor may subsequently join in the application on filing an oath or declaration of the character required by § 1.63. A patent may be granted to the inventor upon a showing satisfactory to the Commissioner.

[47 FR 41275, Sept. 17, 1982, effective Oct. 1, 1982; 48 FR 2709, Jan. 20, 1983, effective Feb. 27, 1983]

**§ 1.48 Correction of inventorship.**

(a) If the correct inventor or inventors are not named in an application for patent through error without any deceptive intention on the part of the actual inventor or inventors, the application may be amended to name only the actual inventor or inventors. Such amendment must be diligently made and must be accompanied by (a) a petition including a statement of facts verified by the original named inventor or inventors establishing when the error without deceptive intention was discovered and how it occurred; (b) an oath or declaration by each actual inventor or inventors as required by § 1.63; (c) the fee set forth in § 1.17(h); and (d) the written consent of any assignee. When the application is involved in an interference, the petition shall

comply with the requirements of this section and shall be accompanied by a motion under § 1.634.

(b) If the correct inventors are named in the application when filed and the prosecution of the application results in the amendment or cancellation of claims so that less than all of the originally named inventors are the actual inventors of the invention being claimed in the application, an amendment shall be filed deleting the names of the person or persons who are not inventors of the invention being claimed. The amendment must be diligently made and shall be accompanied by:

(1) A petition including a statement identifying each named inventor who is being deleted and acknowledging that the inventor's invention is no longer being claimed in the application, and

(2) The fee set forth in § 1.17(h).

(c) If an application discloses unclaimed subject matter by an inventor or inventors not named in the application, the application may be amended pursuant to paragraph (a) of this section to add claims to the subject matter and name the correct inventors for the application.

[OMB Control No. 0651-0018]

[48 FR 270-9, Jan. 20, 1983, effective Feb. 27, 1983; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; 50 FR 9379, Mar. 7, 1985, effective May 8, 1985]

## THE APPLICATION

### § 1.51 General requisites of an application.

(a) Applications for patents must be made to the Commissioner of Patents and Trademarks. A complete application comprises:

(1) A specification, including a claim or claims, see §§ 1.71 to 1.77.

(2) A oath or declaration, see §§ 1.63 and 1.68

(3) Drawings, when necessary, see §§ 1.81 to 1.88.

(4) The prescribed filing fee, see § 1.16.

(b) Applicants are encouraged to file an information disclosure statement. See §§ 1.97 through 1.99.

(c) Applicants may desire and are permitted to file with, or in, the application an authorization to charge, at any time during the pendency of the application, any fees required under any of §§ 1.16 to 1.18 to a deposit account established and maintained in accordance with § 1.25.

[42 FR 5593, Jan. 28, 1977; paras. (a) & (c), 47 FR 41275, Sept. 17, 1982, effective Oct. 1, 1982; paras. (a) & (b), 48 FR 2709, Jan. 20, 1983, effective Feb. 27, 1983]

### § 1.52 Language, paper, writing, margins.

(a) The application, any amendments or corrections thereto, and the oath or declaration must be in the English language except as provided for in § 1.69 and paragraph (d) of this section, or be accompanied by a verified translation of the application and a translation of any corrections or amendments into the English language. All papers which are to become part of the permanent records of the Patent and Trademark Office must be legibly written, typed, or printed in permanent ink or its equivalent in quality. All of the application papers must be presented in a form having sufficient clarity and contrast between the

paper and the writing, typing, or printing thereon to permit the direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes. If the papers are not of the required quality, substitute typewritten or printed papers of suitable quality may be required.

(b) The application papers (specification, including claims, abstract, oath or declaration, and papers as provided for in §§ 1.42, 1.43, 1.47, etc.) and also papers subsequently filed, must be plainly written on but one side of the paper. The size of all sheets of paper should be 8 to 8 1/2 by 10 1/2 to 13 inches (20.3 to 21.6 cm. by 26.6 to 33.0 cm.). A margin of at least approximately one inch (2.5 cm.) must be reserved on the left-hand of each page. The top of each page of the application, including claims must have a margin of at least approximately 3/4 inch (2 cm.). The lines must not be crowded too closely together; typewritten lines should be 1 1/2 or double spaced. The pages of the application including claims and abstract should be numbered consecutively, starting with 1, the numbers being centrally located above or preferably, below, the text.

(c) Any interlineation, erasure, or cancellation or other alteration of the application papers filed must be made before the signing of any accompanying oath or declaration pursuant to § 1.63 referring to those application papers and should be dated and initialed or signed by the applicant on the same sheet of paper. No such alterations in the application papers are permissible after the signing of an oath or declaration referring to those application papers (§ 1.56(c)). After the signing of the oath or declaration referring to the application papers, amendments may only be made in the manner provided by §§ 1.121 and 1.123 through 1.125.

(d) An application may be filed in a language other than English. A verified English translation of the non-English-language application and the fee set forth in § 1.17(k) are required to be filed with the application or within such time as may be set by the Office.

[OMB Control No. 0651-0011]

43 FR 20462, May 11, 1978; paras. (a) & (d), 47 FR 41275, Sept. 17, 1982, effective Oct. 1, 1982; para. (c), 48 FR 2709, Jan. 20, 1983, effective Feb. 27, 1983; par. (d), 49 FR 554, Jan. 4, 1984, effective Apr. 1, 1984]

### § 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 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).

(c) If any application is filed without the specification or drawing required by paragraph (b) of this section, applicant will be so notified and given a time period within which to submit the

omitted specification or drawing in order to obtain a filing date as of the date of filing of such submission. 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 a \$15.00 handling fee.

(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. 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 this paragraph may be made simultaneously with any 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 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 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).

[48 FR 2709, Jan. 20, 1983, effective Feb. 27, 1983; paras. (b) & (d), 49 FR 554, Jan. 4, 1984, effective Apr. 1, 1984; para. (c), 50 FR 31826, Aug. 6, 1985, effective Oct. 5, 1985]

#### § 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.

[48 FR 2710, Jan. 20, 1983, effective Feb. 27, 1983]

#### § 1.55 Claim for foreign priority.

(a) An applicant may claim the benefit of the filing date of a prior foreign application under the conditions specified in 35 U.S.C. 119 and 172. The claim to priority need be in no special form and may be made by the attorney or agent if the foreign application is referred to in the oath or declaration as required by

§ 1.63. The claim for priority and the certified copy of the foreign application specified in the second paragraph of 35 U.S.C. 119 must be filed in the case of interference (§ 1.630); when necessary to overcome the date of a reference relied upon by the examiner; or when specifically required by the examiner; and in all other cases they must be filed not later than the date the issue fee is paid. If the papers filed are not in the English language, a translation need not be filed except in the three particular instances specified in the preceding sentence, in which event a sworn translation or a translation certified as accurate by a sworn or official translator must be filed. If the priority papers are submitted after the date the issue fee is paid, they must be accompanied by a petition requesting their entry and the fee set forth in § 1.17(i).

(b) An applicant may under certain circumstances claim priority on the basis of an application for an inventor's certificate in a country granting both inventor's certificates and patents. When an applicant wishes to claim the right of priority as to a claim or claims of the application on the basis of an application for an inventor's certificate in such a country under 35 U.S.C. 119, last paragraph (as amended July 28, 1972), the applicant or his attorney or agent, when submitting a claim for such right as specified in paragraph (a) of this section, shall include an affidavit or declaration including a specific statement that, upon an investigation, he or she has satisfied himself or herself that to the best of his or her knowledge the applicant, when filing his or her application for the inventor's certificate, had the option to file an application either for a patent or an inventor's certificate as to the subject matter of the identified claim or claims forming the basis for the claim of priority.

[Para. (b), 48 FR 41275, Sept. 17, 1982, effective Oct. 1 1982; 48 FR 2710, Jan. 20, 1983, effective Feb. 27, 1983; par. (b), 49 FR 554, Jan. 4, 1984, effective Apr. 1, 1984; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985]

#### § 1.56 Duty of disclosure; fraud; striking or rejection of applications.

(a) A duty of candor and good faith toward the Patent and Trademark Office rests on the inventor, on each attorney or agent who prepares or prosecutes the application and on every other individual who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application. All such individuals have a duty to disclose to the Office information they are aware of which is material to the examination of the application. Such information is material where there is a substantial likelihood that a reasonable examiner would consider it important in deciding whether to allow the application to issue as a patent. The duty is commensurate with the degree of involvement in the preparation or prosecution of the application.

(b) Disclosures pursuant to this section must be accompanied by a copy of each foreign patent document, non-patent publication, or other non-patent item of information in written form which is being disclosed or by a statement that the copy is not in the possession of the person making the disclosure and may be made to the Office through an attorney or agent having re-

sponsibility for the preparation or prosecution of the application or through an inventor who is acting in his or her own behalf. Disclosure to such an attorney, agent, or inventor shall satisfy the duty, with respect to the information disclosed, of any other individual. Such an attorney, agent or inventor has no duty to transmit information which is not material to the examination of the application.

(c) Any application may be stricken from the files if:

(1) An oath or declaration pursuant to § 1.63 is signed in blank;

(2) An oath or declaration pursuant to § 1.63 is signed without review thereof by the person making the oath or declaration;

(3) An oath or declaration pursuant to § 1.63 is signed without review of the specification, including the claims, as required by § 1.63(b); or

(4) The application papers filed in the Office are altered after the signing of an oath or declaration pursuant to § 1.63 referring to those application papers.

(d) No patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or gross negligence. The claims in an application shall be rejected if upon examination pursuant to 35 U.S.C. 131 and 132, it is established by clear and convincing evidence (1) that any fraud was practiced or attempted on the Office in connection with the application, or in connection with any previous application upon which the application relies, or (2) that there was any violation of the duty of disclosure through bad faith or gross negligence in connection with the application, or in connection with any previous application upon which the application relies.

(e) The examination of an application for compliance with paragraph (d) of this section will normally be delayed until such time as (1) all other matters are resolved, or (2) appellant's reply brief pursuant to § 1.193(b) has been received and the application is otherwise prepared for consideration by the Board of Appeals, at which time the appeal will be suspended for examination pursuant to paragraph (d) of this section. The prosecution of the application will be reopened to the extent necessary to conduct the examination pursuant to paragraph (d) of this section including any appeal pursuant to § 1.191. If an appeal has already been filed based on a rejection on other grounds, any further rejection under this section shall be treated in accordance with § 1.193(c).

(f) Any member of the public may seek to have an application stricken from the files pursuant to paragraph (c) of this section by filing a timely petition to strike the application from the files. Any such timely petition and any accompanying papers will be entered in the application file if the petition and accompanying papers (1) specifically identify the application to which the petition is directed, and (2) are either served upon the applicant in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible. Any such petition filed by an attorney or agent must be in compliance with § 10.18.

(g) A petition to strike an application from the files submitted in accordance with the second sentence of paragraph (f) of this section will be considered by the Office. An acknowledgment

of the entry of such a petition in a reissue application file will be sent to the member of the public filing the petition. A member of the public filing such a petition in an application for an original patent will not receive any communications from the Office relating to the petition, other than the return of a self-addressed postcard which the member of the public may include with the petition in order to receive an acknowledgement by the Office that the petition has been received. The Office will communicate with the applicant regarding any such petition entered in the application file and may require the applicant to respond to the Office on matters raised by the petition. The active participation of the member of the public filing a petition pursuant to paragraph (f) of this section ends with the filing of the petition and no further submission on behalf of the petitioner will be acknowledged or considered unless such submission raises new issues which could not have been earlier presented, and thereby constitutes a new petition.

(h) Any member of the public may seek to have the claims in an application rejected pursuant to paragraph (d) of this section by filing a timely protest in accordance with § 1.291. Any such protest filed by an attorney or agent must be in compliance with § 10.18.

(i) The Office may require applicant to supply information pursuant to paragraph (a) of this section in order for the Office to decide any issues relating to paragraphs (c) and (d) of this section which are raised by a petition or a protest, or are otherwise discovered by the Office.

(j) If any disclosure pursuant to this section does not include a copy of each foreign patent document, non-patent publication, or other non-patent item of information in written form which is being disclosed or a statement that a copy thereof is not in the possession of the person making the disclosure, applicant will be so notified and given a period of time within which to file the copy or a statement that a copy is not in the possession of the person making the disclosure. The time period set may be extended under § 1.136.

[OMB Control No. 0651-0011]

[42 FR 5593, Jan. 28, 1977; paras. (d) & (e) - (i), 47 FR 21751, May 19, 1982, effective July 1, 1982; para. (c), 48 FR 2710, Jan. 20, 1983, effective Feb. 27, 1983; paras. (b) & (j), 49 FR 554, Jan. 4, 1984, effective Apr. 1, 1984; paras. (d) & (h), 50 FR 5171, Feb. 6, 1985, effective Mar. 8, 1985]

### § 1.57 [Reserved]

[48 FR 2710, Jan. 20, 1983, effective Feb. 27, 1983]

### § 1.58 Chemical and mathematical formulas and tables.

(a) The specification, including the claims, may contain chemical and mathematical formulas, but shall not contain drawings or flow diagrams. The description portion of the specification may contain tables; claims may contain tables either if necessary to conform to 35 U.S.C. 112 or if otherwise found to be desirable.

(b) All tables and chemical and mathematical formulas in the specification, including claims, and amendments thereto, must be on paper which is flexible, strong, white, smooth, nonshiny, and durable in order to permit use as camera copy

when printing any patent which may issue. A good grade of bond paper is acceptable; watermarks should not be prominent. India ink or its equivalent, or solid black typewriter, should be used to secure perfectly black solid lines.

(c) To facilitate camera copying when printing, the width of formulas and tables as presented should be limited normally to 5 inches (12.7 cm.) so that it may appear as a single column in the printed patent. If it is not possible to limit the width of a formula or table to 5 inches (12.7 cm.), it is permissible to present the formula or table with a maximum width of 10 3/4 inches (27.3 cm.) and to place it sideways on the sheet. Type-written characters used in such formulas and tables must be from a block (nonscript) type font or lettering style having capital letters which are at least 0.08 inch (2.1 mm.) high (e.g. elite type). Hand lettering must be neat, clean, and have a minimum character height of 0.08 inch (2.1 mm.). A space at least 1/4 inch (6.4 mm.) high should be provided between complex formulas and tables and the text. Tables should have the lines and columns of data closely spaced to conserve space, consistent with high degree of legibility.

[43 FR 20463, May 11, 1978]

#### § 1.59 Papers of application with filing date not to be returned.

Papers in an application which has received a filing date pursuant to § 1.53 will not be returned for any purpose whatever. If applicants have not preserved copies of the papers, the Office will furnish copies at the usual cost of any application in which either the required basic filing fee (§ 1.16) or the processing and retention fee (§ 1.21(l)) has been paid. See § 1.618 for return of unauthorized and improper papers in interferences.

[48 FR 2710, Jan. 20, 1983, effective Feb. 27, 1983; 49 FR 554, Jan. 4, 1984, effective Apr. 1, 1984; 49 FR 48416, Dec. 12, 1984; 50 FR 23123, May 31, 1985, effective Feb. 11, 1985]

#### § 1.60 Continuation or divisional application for invention disclosed in a prior application.

(a) A continuation or divisional application (filed under the conditions specified in 35 U.S.C. 120 or 121 and § 1.78(a)), naming as inventors the same or less than all the inventors named in a prior application and which discloses and claims only subject matter disclosed in the prior application may be filed as a separate application before the patenting or abandonment of or termination of proceedings on the prior application.

(b) An applicant may omit signing of the oath or declaration in a continuation or divisional application if (1) the prior application was a complete application as set forth in § 1.51(a), (2) applicant files a true copy of the prior complete application as filed including the specification (including claims), drawings, oath or declaration showing the signature or an indication it was signed, and any amendments referred to in the oath or declaration filed to complete the prior application, and (3) the inventors named in the continuation or divisional application are the same or less than all the inventors named in the prior application. The copy of the prior application must be accompanied by a statement that the application papers filed are a true copy of the prior application and that no amendments referred to in the oath or

declaration filed to complete the prior application introduced new matter therein. Such statement must be by the applicant or applicant's attorney or agent and must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office. Only amendments reducing the number of claims or adding a reference to the prior application (§ 1.78(a)) will be entered before calculating the filing fee and granting the filing date. If the continuation or divisional application is filed by less than all the inventors named in the prior application a statement must accompany the application when filed requesting deletion of the names of the person or persons who are not inventors of the invention being claimed in the continuation or divisional application.

[OMB Control No. 0651-0011]

[48 FR 2710, Jan. 20, 1983, effective Feb. 27, 1983; 49 FR 554, Jan. 4, 1984, effective Apr. 1, 1984; 50 FR 9397, Mar. 7, 1985, effective May 8, 1985]

#### § 1.61 [Reserved]

(Editor's note: Substance moved to § 1.494)

[52 FR 20046, May 28, 1987, effective July 1, 1987]

#### § 1.62 File wrapper continuing procedure

(a) A continuation, continuation-in-part, or divisional application, which uses the specification, drawings and oath or declaration from a prior complete application (§ 1.51(a)) which is to be abandoned, may be filed before the payment of the issue fee, abandonment of, or termination of proceedings on the prior application. The filing date of an application filed under this section is the date on which a request is filed for an application under this section including identification of the Serial Number, filing date, and applicant's name of the prior complete application. If the continuation, continuation-in-part, or divisional application is filed by less than all the inventors named in the prior application a statement must accompany the application when filed requesting deletion of the names of the person or persons who are not inventors of the invention being claimed in the continuation, continuation-in-part, or divisional application.

(b) The filing fee for a continuation, continuation-in-part, or divisional application under this section is based on the number of claims remaining in the application after entry of any preliminary amendment and entry of any amendments under § 1.116 unentered in the prior application which applicant has requested to be entered in the continuing application.

(c) In the case of a continuation-in-part application which adds and claims additional disclosure by amendment, an oath or declaration as required by § 1.63 must also be filed. In those situations where a new oath or declaration is required due to additional subject matter being claimed, additional inventors may be named in the continuing application. In a continuation or divisional application which discloses and claims only subject matter disclosed in a prior application, no additional oath or declaration is required and the application must name as inventors the same or less than all the inventors named in the prior application.

(d) If an application which has been accorded a filing date pursuant to paragraph (a) of this section does not include the

appropriate basic filing fee pursuant to paragraph (b) of this section, or an oath or declaration by the applicant in the case of a continuation-in-part application pursuant to paragraph (c) of this section, applicant will be so notified 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. The notification pursuant to this paragraph may be made simultaneously with any notification of a defect pursuant to paragraph (a) of this section.

(e) An application filed under this section will utilize the file wrapper and contents of the prior application to constitute the new continuation, continuation-in-part, or divisional application but will be assigned a new application serial number.

(f) The filing of an application under this section will be construed to include a waiver of secrecy by the applicant under 35 U.S.C. 122 to the extent that any member of the public who is entitled under the provisions of 37 CFR 1.14 to access to, or information concerning either the prior application or any continuing application filed under the provisions of this section may be given similar access to, or similar information concerning, the other application(s) in the file wrapper.

(g) The filing of a request for a continuing application under this section will be considered to be a request to expressly abandon the prior application as of the filing date granted the continuing application.

(h) The applicant is urged to furnish the following information relating to the prior and continuing applications to the best of his or her ability:

- (1) Title as originally filed and as last amended;
- (2) Name of applicant as originally filed and as last amended;
- (3) Current correspondence address of applicant;
- (4) Identification of prior foreign application and any priority claim under 35 U.S.C. 119.
- (5) The title of the invention and names of applicants to be named in the continuing application.

(i) Envelopes containing only application papers and fees for filing under this section should be marked "Box FWC".

[OMB Control No. 0651-0011]

[47 FR 47244, Oct. 25, 1982, added effective Feb. 27, 1983; 48 FR 2710, Jan. 20, 1983, effective date Feb. 27, 1983; paras. (a) & (d), 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; paras. (a), (c) & (h), 50 FR 9380, Mar. 7, 1985, effective May 8, 1985]

## OATH OR DECLARATION

### § 1.63 Oath or declaration.

(a) An oath or declaration filed under § 1.51(a)(2) as a part of an application must:

- (1) Be executed in accordance with either § 1.66 or § 1.68;
- (2) Identify the specification to which it is directed;
- (3) Identify each inventor and the residence and country of citizenship of each inventor; and
- (4) State whether the inventor is a sole or joint inventor of the invention claimed.

(b) In addition to meeting the requirements of paragraph (a), the oath or declaration must state that the person making the oath or declaration:

(1) Has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration;

(2) Believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought; and

(3) Acknowledges the duty to disclose information which is material to the examination of the application in accordance with § 1.56(a).

(c) In addition to meeting the requirements of paragraphs (a) and (b) of this section, the oath or declaration in any application in which a claim for foreign priority is made pursuant to § 1.55 must identify the foreign application for patent or inventor's certificate on which priority is claimed, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month and year of its filing.

(d) In any continuation-in-part application filed under the conditions specified in 35 U.S.C. 120 which discloses and claims subject matter in addition to that disclosed in the prior copending application, the oath or declaration must also state that the person making the oath or declaration acknowledges the duty to disclose material information as defined in § 1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

[OMB Control No. 0651-0011]

[48 FR 2711, Jan. 20, 1983, added effective Feb. 27, 1983; 48 FR 4285, Jan. 31, 1983]

### § 1.64 Person making oath or declaration.

(a) The oath or declaration must be made by all of the actual inventors except as provided for in §§ 1.42, 1.43, or 1.47.

(b) If the person making the oath or declaration is not the inventor (§§ 1.42, 1.43, or 1.47), the oath or declaration shall state the relationship of the person to the inventor and, upon information and belief, the facts which the inventor is required to state.

[OMB Control No. 0651-0011]

[48 FR 2711, Jan. 20, 1983, added effective Feb. 27, 1983]

### § 1.66 Officers authorized to administer oaths.

(a) The oath or affirmation may be made before any person within the United States authorized by law to administer oaths. An oath made in a foreign country may be made before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by a certificate of a diplomatic or consular officer of the United States, or by an apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States. The oath shall be attested in all cases in this and other countries, by the proper official seal of the officer before whom the oath or affirmation is made. Such oath or affirmation shall be valid as to execution if it complies with the laws of the State or country

where made. When the person before whom the oath or affirmation is made in this country is not provided with a seal, his official character shall be established by competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal.

(b) When the oath is taken before an officer in a country foreign to the United States, any accompanying application papers, except the drawings, must be attached together with the oath and a ribbon passed one or more times through all the sheets of the application, except the drawings, and the ends of said ribbon brought together under the seal before the latter is affixed and impressed, or each sheet must be impressed with the official seal of the officer before whom the oath is taken. If the papers as filed are not properly ribboned or each sheet impressed with the seal, the case will be accepted for examination, but before it is allowed, duplicate papers, prepared in compliance with the foregoing sentence, must be filed.

[OMB Control No. 0651-0011]

[47 FR 41275, Sept. 17, 1982, effective Oct. 1, 1982]

### § 1.67 Supplemental oath or declaration.

(a) A supplemental oath or declaration meeting the requirements of § 1.63 may be required to be filed to correct any deficiencies or inaccuracies present in an earlier filed oath or declaration.

(b) A supplemental oath or declaration meeting the requirements of § 1.63 must be filed: (1) When a claim is presented for matter originally shown or described but not substantially embraced in the statement or invention or claims originally presented; and (2) When an oath or declaration submitted in accordance with § 1.53(d) after the filing of the specification and any required drawings specifically and improperly refers to an amendment which includes new matter. No new matter may be introduced into an application after its filing date even if a supplemental oath or declaration is filed (§ 1.53(b); § 1.118). In proper cases the oath or declaration here required may be made on information and belief by an applicant other than inventor.

[OMB Control No. 0651-0011]

[48 FR 2711, Jan. 20, 1983, effective Feb. 27, 1983]

### § 1.68 Declaration in lieu of oath.

Any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be under oath may be subscribed to by a written declaration. Such declaration may be used in lieu of the oath otherwise required, if, and only if, the declarant is on the same document, warned that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon. The declarant must set forth in the body of the declaration that all statements made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true.

[OMB Control No. 0651-0011]

[49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985]

### § 1.69 Foreign language oaths and declarations.

(a) Whenever an individual making an oath or declaration

cannot understand English, the oath or declaration must be in a language that such individual can understand and shall state that such individual understands the content of any documents to which the oath or declaration relates.

(b) Unless the text of any oath or declaration in a language other than English is a form provided or approved by the Patent and Trademark Office, it must be accompanied by a verified English translation, except that in the case of an oath or declaration filed under § 1.63 the translation may be filed in the Office no later than two months from the date applicant is notified to file the translation.

[OMB Control No. 0651-0011]

[42 FR 5594, Jan. 28, 1977; para. (b), 48 FR 2711, Jan. 20, 1983, effective Feb. 27, 1983]

### § 1.70 [Reserved]

(Editor's note: Substance moved to § 1.497)

[52 FR 20046, May 28, 1987, effective July 1, 1987]

## SPECIFICATION

### § 1.71 Detailed description and specification of the invention.

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

### § 1.72 Title and abstract.

(a) The title of the invention, which should be as short and specific as possible, should appear as a heading on the first page of the specification, if it does not otherwise appear at the beginning of the application.

(b) A brief abstract of the technical disclosure in the specification must be set forth on a separate sheet, preferably following the claims under the heading "Abstract of the Disclosure". The purpose of the abstract is to enable the Patent and Trademark Office and the public generally to determine quickly from a cursory inspection the nature and gist of the technical disclosure. The abstract shall not be used for interpreting the scope of the claims.

[31 FR 12922, Oct. 4, 1966; 43 FR 20464, May 11, 1978]

### § 1.73 Summary of the invention.

A brief summary of the invention indicating its nature and substance, which may include a statement of the object of the invention, should precede the detailed description. Such summary should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed.

### § 1.74 Reference to drawings.

When there are drawings, there shall be a brief description of the several views of the drawings and the detailed description of the invention shall refer to the different views by specifying the numbers of the figures, and to the different parts by use of reference letters or numerals (preferably the latter).

### § 1.75 Claim(s).

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

(b) More than one claim may be presented provided they differ substantially from each other and are not unduly multiplied.

(c) One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application. Any dependent claim which refers to more than one other claim ("multiple dependent claim") shall refer to such other claims in the alternative only. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. For fee calculation purposes under § 1.16, a multiple dependent claim will be considered to be that number of claims to which direct reference is made therein. For fee calculation purposes, also, any claim depending from a multiple dependent claim will be considered to be that number of claims to which direct reference is made in that multiple dependent claim. In addition to the other filing fees, any original application which is filed with, or is amended to include, multiple dependent claims must have paid therein the fee set forth in § 1.16(d). Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of each of the particular claims in relation to which it is being considered.

(d)(1) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See § 1.58(a).)

(2) See §§ 1.141 to 1.146 as to claiming different inventions in one application.

(e) Where the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order, (1) a preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known, (2) a phrase such as "wherein

the improvement comprises," and (3) those elements, steps and/or relationships which constitute that portion of the claimed combination which the applicant considers as the new or improved portion.

(f) If there are several claims, they shall be numbered consecutively in Arabic numerals.

(g) All dependent claims should be grouped together with the claim or claims to which they refer to the extent possible.

[31 FR 12922, Oct. 4, 1966; 36 FR 12690, July 3, 1971; 37 FR 21995, Oct. 18, 1972; 43 FR 4015, Jan. 31, 1978; para. (c), 47 FR 41276, Sept. 17, 1982, effective Oct. 1, 1982]

### § 1.77 Arrangement of application elements.

The elements of the application should appear in the following order:

(a) Title of the invention; or an introductory portion stating the name, citizenship, and residence of the applicant, and the title of the invention may be used.

(b) (Reserved).

(c) (1) Cross-reference to related applications, if any.

(2) Reference to a "microfiche appendix" if any. (See § 1.96(b)). The total number of microfiche and total number of frames should be specified.

(d) Brief summary of the invention.

(e) Brief description of the several views of the drawing, if there are drawings.

(f) Detailed description.

(g) Claim or claims.

(h) Abstract of the disclosure.

(i) Signed oath or declaration.

(j) Drawings.

[43 FR 20464, May 11, 1978; 46 FR 2612, Jan. 12, 1981; paras. (h) & (i), 48 FR 2712, Jan. 20, 1983, effective Feb. 27, 1983]

### § 1.78 Claiming benefit of earlier filing date and cross-references to other applications.

(a) An application may claim an invention disclosed in a prior filed copending national application or international application designating the United States of America. In order for an application to claim the benefit of a prior copending national application, the prior application must name as an inventor at least one inventor named in the later filed application and disclose the named inventor's invention claimed in at least one claim of the later filed application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, the prior application must be (1) complete as set forth in § 1.51, or (2) entitled to a filing date as set forth in § 1.53(b) and include the basic filing fee set forth in § 1.16; or (3) entitled to a filing date as set forth in § 1.53(b) and have paid therein the processing and retention fee set forth in § 1.21(f) within the time period set forth in § 1.53(d). Any application claiming the benefit of a prior filed copending national or international application must contain or be amended to contain in the first sentence of the specification following the title a reference to such prior application, identifying it by serial number and filing date or international application number and international filing date and indicating the relationship of the applications. Cross-references to other



related applications may be made when appropriate. (See § 1.14(b).)

(b) Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

(c) Where two or more applications, or an application and a patent naming different inventors and owned by the same party contain conflicting claims, and there is no statement of record indicating that the claimed inventions were commonly owned or subject to an obligation of assignment to the same person at the time the later invention was made, the assignee may be called upon to state whether the claimed inventions were commonly owned or subject to an obligation of assignment to the same person at the time the later invention was made, and if not, indicate which named inventor is the prior inventor. In addition to making said statement, the assignee may also explain why an interference should or should not be declared.

(d) Where an application claims an invention which is not patentably distinct from an invention claimed in a commonly owned patent with the same or a different inventive entity, a double patenting rejection will be made in the application. An obviousness-type double patenting rejection may be obviated by filing a terminal disclaimer in accordance with § 1.321(b).

[36 FR 7312, Apr. 17, 1971; 49 FR 555, Jan. 4, 1984; paras. (a), (c) & (d), 50 FR 9380, Mar. 7, 1985, effective May 8, 1985; 50 FR 11366, Mar. 21, 1985]

§ 1.79 Reservation clauses not permitted.

A reservation for a future application of subject matter disclosed but not claimed in a pending application will not be permitted in the pending application, but an application disclosing unclaimed subject matter may contain a reference to a later filed application of the same applicant or owned by a common assignee disclosing and claiming that subject matter.

THE DRAWING

§ 1.81 Drawings required.

(a) The applicant for a patent is required to furnish a drawing of his invention where necessary for the understanding of the subject matter sought to be patented; this drawing must be filed with the application.

(b) Drawings may include illustrations which facilitate an understanding of the invention (for example, flow sheets in cases of processes, and diagrammatic views).

(c) Whenever the nature of the subject matter sought to be patented admits of illustration by a drawing without its being necessary for the understanding of the subject matter and the applicant has not furnished such a drawing, the examiner will require its submission within a time period of not less than two months from the date of the sending of a notice thereof.

(d) Drawings submitted after the filing date of the application may not be used to overcome any insufficiency of the specification due to lack of an enabling disclosure or otherwise inadequate disclosure therein, or to supplement the original disclo-

sure thereof for the purpose of interpretation of the scope of any claim.

[43 FR 4015, Jan. 31, 1978]

§ 1.83 Content of drawing.

(a) The drawing must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g. a labeled rectangular box).

(b) When the invention consists of an improvement on an old machine the drawing must when possible exhibit, in one or more views, the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

(c) Where the drawings do not comply with the requirements of paragraphs (a) and (b) of this section, the examiner shall require such additional illustration within a time period of not less than two months from the date of the sending of a notice thereof. Such corrections are subject to the requirements of § 1.81(d).

[31 FR 12923, Oct. 4, 1966; 43 FR 4015, Jan. 31, 1978]

§ 1.84 Standards for drawings.

(a) *Paper and ink.* Drawings must be made upon paper which is flexible, strong, white, smooth, nonshiny and durable. Two-ply or three-ply bristol board is preferred. The surface of the paper should be calendered and of a quality which will permit erasure and correction with India ink. India ink, or its equivalent in quality, is preferred for pen drawings to secure perfectly black solid lines. The use of white pigment to cover lines is not normally acceptable.

(b) *Size of sheet and margins.* The size of the sheets on which drawings are made may either be exactly 8 1/2 by 14 inches (21.6 by 35.6 cm.) or exactly 21.0 by 29.7 cm. (DIN size A4). All drawing sheets in a particular application must be the same size. One of the shorter sides of the sheet is regarded as its top.

(1) On 8 1/2 by 14 inch drawing sheets, the drawing must include a top margin of 2 inches (5.1 cm.) and bottom and side margins of 1/4 inch (6.4 mm.) from the edges, thereby leaving a "sight" precisely 8 by 11 3/4 inches (20.3 by 29.8 cm.). Margin border lines are not permitted. All work must be included within the "sight". The sheets may be provided with two 1/4 inch (6.4 mm.) diameter holes having their centerlines spaced 11/16 inch (17.5 mm.) below the top edge and 2 3/4 inches (7.0 cm.) apart, said holes being equally spaced from the respective side edges.

(2) On 21.0 by 29.7 cm. drawing sheets, the drawing must include a top margin of at least 2.5 cm., a left side margin of 2.5 cm., a right side margin of 1.5 cm., and a bottom margin of 1.0 cm. Margin border lines are not permitted. All work must be contained within a sight size not to exceed 17 by 26.2 cm.

(c) *Character of lines.* All drawings must be made with drafting instruments or by a process which will give them satisfactory reproduction characteristics. Every line and letter

must be durable, black, sufficiently dense and dark, uniformly thick and well defined; the weight of all lines and letters must be heavy enough to permit adequate reproduction. This direction applies to all lines however fine, to shading, and to lines representing cut surfaces in sectional views. All lines must be clean, sharp, and solid. Fine or crowded lines should be avoided. Solid black should not be used for sectional or surface shading. Freehand work should be avoided wherever it is possible to do so.

(d) *Hatching and shading.* (1) Hatching should be made by oblique parallel lines spaced sufficiently apart to enable the lines to be distinguished without difficulty.

(2) Heavy lines on the shade side of objects should preferably be used except where they tend to thicken the work and obscure reference characters. The light should come from the upper left-hand corner at an angle of 45°. Surface delineations should preferably be shown by proper shading, which should be open.

(e) *Scale.* The scale to which a drawing is made ought to be large enough to show the mechanism without crowding when the drawing is reduced in size to two-thirds in reproduction, and views of portions of the mechanism on a larger scale should be used when necessary to show details clearly; two or more sheets should be used if one does not give sufficient room to accomplish this end, but the number of sheets should not be more than is necessary.

(f) *Reference characters.* The different views should be consecutively numbered figures. Reference numerals (and letters, but numerals are preferred) must be plain, legible and carefully formed, and not be encircled. They should, if possible, measure at least one-eighth of an inch (3.2 mm.) in height so that they may bear reduction to one twenty-fourth of an inch (1.1 mm.); and they may be slightly larger when there is sufficient room. They should not be so placed in the close end complex parts of the drawing as to interfere with a thorough comprehension of the same, and therefore should rarely cross or mingle with the lines. When necessarily grouped around a certain part, they should be placed at a little distance, at the closest point where there is available space, and connected by lines with the parts to which they refer. They should not be placed upon hatched or shaded surfaces but when necessary, a blank space may be left in the hatching or shading where the character occurs so that it shall appear perfectly distinct and separate from the work. The same part of an invention appearing in more than one view of the drawing must always be designated by the same character, and the same character must never be used to designate different parts. Reference signs not mentioned in the description shall not appear in the drawing and vice versa.

(g) *Symbols, legends.* Graphical drawing symbols and other labeled representations may be used for conventional elements when appropriate, subject to approval by the Office. The elements for which such symbols and labeled representations are used must be adequately identified in the specification. While descriptive matter on drawings is not permitted, suitable legends may be used, or may be required, in proper cases, as in diagrammatic views and flowsheets or to show materials or where labeled representations are employed to illustrate con-

ventional elements. Arrows may be required, in proper cases, to show direction of movement. The lettering should be as large as, or larger than, the reference characters.

(h) [Reserved]

(i) *Views.* The drawing must contain as many figures as may be necessary to show the invention; the figures should be consecutively numbered if possible in the order in which they appear. The figures may be plain, elevation, section, or perspective views, and detail views of portions or elements, on a larger scale if necessary, may also be used. Exploded views, with the separated parts of the same figure embraced by a bracket, to show the relationship or order of assembly of various parts are permissible. When necessary, a view of a large machine or device in its entirety may be broken and extended over several sheets if there is no loss in facility of understanding the view. Where figures on two or more sheets form in effect a single complete figure, the figures on the several sheets should be so arranged that the complete figure can be understood by laying the drawing sheets adjacent to one another. The arrangement should be such that no part of any of the figures appearing on the various sheets are concealed and that the complete figure can be understood even though spaces will occur in the complete figure because of the margins on the drawing sheets. The plane upon which a sectional view is taken should be indicated on the general view by a broken line, the ends of which should be designated by numerals corresponding to the figure number of the sectional view and have arrows applied to indicate the direction in which the view is taken. A moved position may be shown by a broken line superimposed upon a suitable figure if this can be done without crowding, otherwise a separate figure must be used for this purpose. Modified forms of construction can only be shown in separate figures. Views should not be connected by projection lines nor should center lines be used.

(j) *Arrangement of views.* All views on the same sheet should stand in the same direction and, if possible, stand so that they can be read with the sheet held in an upright position. If views longer than the width of the sheet are necessary for the clearest illustration of the invention, the sheet may be turned on its side so that the top of the sheet with the appropriate top margin is on the right-hand side. One figure must not be placed upon another or within the outline of another.

(k) *Figure for Official Gazette.* The drawing should, as far as possible, be so planned that one of the views will be suitable for publication in the *Official Gazette* as the illustration of the invention.

(l) *Extraneous matter.* Identifying indicia (such as the attorney's docket number, inventor's name, number of sheets, etc.) not to exceed 2 3/4 inches (7.0 cm.) in width may be placed in a centered location between the side edges within three-fourths inch (19.1 mm.) of the top edge. Authorized security markings may be placed on the drawings provided they are outside the illustrations and are removed when the material is declassified. Other extraneous matter will not be permitted upon the face of a drawing.

(m) *Transmission of drawings.* Drawings transmitted to the Office should be sent flat, protected by a sheet of heavy binder's board, or may be rolled for transmission in a suitable mailing

tube; but must never be folded. If received creased or mutilated, new drawings will be required.

(See § 1.152 for design drawings, § 1.165 for plant drawings, and § 1.174 for reissue drawings.)

[24 FR 10332, Dec. 22, 1959; 31 FR 12923, Oct. 4, 1966; 36 FR 9775, May 28, 1971; 43 FR 20464, May 11, 1978; 45 FR 73657, Nov. 6, 1980]

#### § 1.85 Informal drawings.

The requirement of § 1.84 relating to drawings will be strictly enforced. A drawing not executed in conformity thereto, if suitable for reproduction, may be admitted but in such case the drawing must be corrected or a new one furnished, as required.

[47 FR 41276, Sept. 17, 1982, effective Oct. 1, 1982]

#### § 1.88 Use of old drawings.

If the drawings of a new application are to be identical with the drawings of a previous application of the applicant on file in the Office, or with part of such drawings, the old drawings or any sheets thereof may be used if the prior application is, or is about to be, abandoned, or if the sheets to be used are cancelled in the prior application. The new application must be accompanied by a letter requesting the transfer of the drawings, which should be completely identified.

### MODELS, EXHIBITS, SPECIMENS

#### § 1.91 Models not generally required as part of application or patent.

Models were once required in all cases admitting a model, as a part of the application, and these models became a part of the record of the patent. Such models are no longer generally required (the description of the invention in the specification, and the drawings, must be sufficiently full and complete, and capable of being understood, to disclose the invention without the aid of a model), and will not be admitted unless specifically called for.

#### § 1.92 Model or exhibit may be required.

A model, working model, or other physical exhibit, may be required if deemed necessary for any purpose on examination of the application.

#### § 1.93 Specimens.

When the invention relates to a composition of matter, the applicant may be required to furnish specimens of the composition, or of its ingredients or intermediates, for the purpose of inspection or experiment.

#### § 1.94 Return of models, exhibits or specimens.

Models, exhibits, or specimens in applications which have become abandoned, and also in other applications on conclusion of the prosecution, may be returned to the applicant upon demand and at his expense, unless it is deemed necessary that they be preserved in the Office. Such physical exhibits in contested cases may be returned to the parties at their expense. If not claimed within a reasonable time, they may be disposed

of at the discretion of the Commissioner.

#### § 1.95 Copies of exhibits.

Copies of models or other physical exhibits will not ordinarily be furnished by the Office, and any model or exhibit in an application or patent shall not be taken from the Office except in the custody of an employee of the Office specially authorized by the Commissioner.

#### § 1.96 Submission of computer program listings.

Descriptions of the operation and general content of computer program listings should appear in the description portion of the specification. A computer program listing for the purpose of these rules is defined as a print-out that lists in appropriate sequence the instructions, routines, and other contents of a program for a computer. The program listing may be either in machine or machine-independent (object or source) language which will cause a computer to perform a desired procedure or task such as solve a problem, regulate the flow of work in a computer, or control or monitor events. Computer program listings may be submitted in patent applications in the following forms:

(a) *Material which will be printed in the patent.* If the computer program listing is contained on 10 printout pages or less, it must be submitted either as drawings or as part of the specification.

(1) *Drawings.* The listing may be submitted in the manner and complying with the requirements for drawings as provided in § 1.84. At least one figure numeral is required on each sheet of drawing.

(2) *Specification.* (i) The listing may be submitted as part of the specification in accordance with the provisions of § 1.52, at the end of the description but before the claims.

(ii) The listing may be submitted as part of the specification in the form of computer printout sheets (commonly 14 by 11 inches in size) for use as "camera ready copy" when a patent is subsequently printed. Such computer printout sheets must be original copies from the computer with dark solid black letters not less than 0.21 cm high, on white, unshaded and unlined paper, the printing on each sheet must be limited to an area 9 inches high by 13 inches wide, and the sheets should be submitted in a protective cover. When printed in patents, such computer printout sheets will appear at the end of the description but before the claims and will usually be reduced about 1/2 in size with two printout sheets being printed as one patent specification page. Any amendments must be made by way of submission of a substitute sheet if the copy is to be used for camera ready copy.

(b) *As an appendix which will not be printed.* If a computer program listing printout is 11 or more pages long, applicants may submit such listing in the form of microfiche, referred to in the specification (see § 1.77(c)(2)). Such microfiche filed with a patent application is to be referred to as a "microfiche appendix." The "microfiche appendix" will not be part of the printed patent. Reference in the application to the "microfiche appendix" should be made at the beginning of the specification at the location indicated in § 1.77(c)(2). Any amendments thereto

must be made by way of revised microfiche. All computer program listings submitted on paper will be printed as part of the patent.

(1) *Availability of appendix.* Such computer program listings on microfiche will be available to the public for inspection, and paper or microfiche copies thereof will be separately available for purchase, after a patent based on such an application is granted or the application is otherwise made publicly available.

(2) *Submission requirements.* Computer-generated information submitted as an appendix to an application for patent shall be in the form of microfiche in accordance with the standards set forth in the following American National (ANSI) or National Micrographics Association (NMA) Standards (Note: As new editions of these standards are published, the latest shall apply):

ANSI PH 1.28-1976-Specifications for Photographic Film for Archival records, Silver-Gelatin Type, on Cellulose Ester Base.

ANSI PH 1.41-1976 Specifications for Photographic Film for Archival Records, Silver-Gelatin Type, on Polyester Base.

NMA-MSI (1971) Quality Standards for Computer Output Microfilm.

ANSI/NMA MS2 (1978) Format and Coding Standards for Computer Output Microfilm.

NMA MS5 (ANSI PH 5.9-1975) Microfiche of Documents.

ANSI PH 2.19 (1959)-Diffuse Transmission Density.

except as modified or clarified below:

(i) Either Computer-Output-Microfilm (COM) output or copies of photographed paper copy may be submitted. In the former case, NMA standards MS1 and MS2 apply; in the latter case, standard MS5 applies.

(ii) Film submitted shall be first generation (camera film) negative appearing microfiche (with emulsion on the back side of the film when viewed with the images right reading).

(iii) Reduction ratio of microfiche submitted should be 24:1 or a similar ratio where variation from said ratio is required in order to fit the documents into the image area of the microfiche format used.

(iv) Film submitted shall have a thickness of at least .005 inches (0.13 mm) and not more than .009 inches (0.23 mm) for either cellulose acetate base or polyester base type.

(v) Both microfiche formats A1 (98 frames, 14 columns x 7 rows) and A3 (63 frames, 9 columns x 7 rows) which are described in NMA standard MS2 (A1 is also described in MS5) are acceptable for use in preparation of microfiche submitted.

(vi) At least the left-most 1/3 (50 mm x 12 mm) of the header or title area of each microfiche submitted shall be clear or positive appearing so that the Patent and Trademark Office can apply serial number and filing date thereto in an eye-readable form. The middle portion of the header shall be used by applicant to apply an eye-readable application identification such as the title and/or the first inventor's name. The attorney's docket number may be included. The final right-hand portion of the microfiche shall contain sequence information for the microfiche, such as 1 of 4, 2 of 4, etc.

(vii) Additional requirements which apply specifically to microfiche of filmed paper copy:

(A) The first frame of each microfiche submitted shall contain a standard test target which contains five NBS Microcopy Resolution Test Charts (No. 1010A), one in the center and one in each corner. See illustration on page 2 of NMA Recommended Practice MS104, Inspection and Quality Control of First Generation Silver Halide Microfilm. See also paragraph 7 of NMA-MS5.

(B) The second frame of each microfiche submitted must contain a fully descriptive title and the inventor's name as filed.

(C) The pages or lines appearing on the microfiche frames should be consecutively numbered.

(D) Pagination of the microfiche frames shall be from left to right and from top to bottom.

(E) At a reduction of 24:1 resolution of the original microfilm shall be at least 120 lines per mm (5.0 target) so that reproduction copies may be expected to comply with provisions of paragraph 7.1.4 of NMA Standard MS5.

(F) Background density of negative appearing camera master microfiche of filmed paper documents shall be within the range of 0.9 to 1.2 and line density should be no greater than 0.08. The density shall be visual diffuse density as measured using the method described in ANSI Standard PH 2.19.

(G) An index, when included, should appear in the last frame (lower right hand corner when data is right-reading) of each microfiche. See NMA-MS5, paragraph 6.6.

(viii) Microfiche generated by Computer Output Microfilm (COM).

(A) Background density of negative-appearing COM-generated camera master microfiche shall be within the range of 1.5 to 2.0 and line density should be no greater than 0.2. The density shall be visual diffuse density as described in ANSI PH2.19.

(B) The first frame of each microfiche submitted should contain a resolution test frame in conformance with NMA standard MS1.

(C) The second frame of each microfiche submitted must contain a fully descriptive title and the inventor's name as filed.

(D) The pages or lines appearing on the microfiche frames should be consecutively numbered.

(E) It is preferred that pagination of the microfiche frames be from left to right and top to bottom but the alternative, i.e., from top to bottom and from left to right, is also acceptable.

(F) An index, when included, should appear on the last frame (lower right hand corner when data is right reading) of each microfiche.

(G) Amendment of microfiche must be made by way of replacement microfiche.

[46 FR 2612, Jan. 12, 1981]

## INFORMATION DISCLOSURE STATEMENT

### § 1.97 Filing of information disclosure statement.

(a) As a means of complying with the duty of disclosure set forth in § 1.56, applicants are encouraged to file an information disclosure statement at the time of filing the application or

within the later of three months after the filing date of the application or two months after applicant receives the filing receipt. If filed separately, the disclosure statement should, in addition to the identification of the application, include the Group Art Unit to which the application is assigned as indicated on the filing receipt. The disclosure statement may either be separate from the specification or may be incorporated therein.

(b) A disclosure statement filed in accordance with paragraph (a) of this section shall not be construed as a representation that a search has been made or that no other material information as defined in § 1.56(a) exists.

[OMB Control No. 0651-0011

[48 FR 2712, Jan. 20, 1983, effective date Feb. 27, 1983]

#### § 1.98 Content of information disclosure statement.

(a) Any disclosure statement filed under § 1.97 or § 1.99 shall include: (1) A listing of patents, publications or other information; and (2) A concise explanation of the relevance of each listed item. The disclosure statement shall be accompanied by a copy of each listed patent or publication or other item of information in written form or of at least the portions thereof considered by the person filing the disclosure statement to be pertinent. All United States patents listed should be identified by their patent numbers, patent dates and names of the patentees. Each foreign published application or patent should be cited by identifying the country or office which issued it, the document number and publication date indicated on the document. Each printed publication should be identified by author (if any), title of the publication, pages, date and place of publication.

(b) When two or more patents or publications considered material are substantially identical, a copy of a representative one may be included in the statement and others merely listed. A translation of the pertinent portions of foreign language patents or publications considered material should be transmitted if an existing translation is readily available to the applicant.

[OMB Control No. 0651-0011]

[42 FR 5594, Jan. 28, 1977; para. (a) 48 FR 2712, Jan. 20, 1983, effective date Feb. 27, 1983]

#### § 1.99 Updating of information disclosure statement.

If prior to issuance of a patent an applicant, pursuant to his or her duty of disclosure under § 1.56, wishes to bring to the attention of the Office additional patents, publications or other information not previously submitted, the additional information should be submitted to the Office with reasonable promptness. It may be included in a supplemental information disclosure statement or may be incorporated into other communications to be considered by the examiner. Any transmittal of additional information shall be accompanied by explanations of relevance and by copies in accordance with the requirements of § 1.98.

[OMB Control No. 0651-0011]

[48 FR 2712, Jan. 20, 1983; effective date Feb. 27, 1983]

### EXAMINATION OF APPLICATIONS

#### § 1.101 Order of examination.

(a) Applications filed in the Patent and Trademark Office and

accepted as complete applications are assigned for examination to the respective examining groups having the classes of inventions to which the applications relate. Applications shall be taken up for examination by the examiner to whom they have been assigned in the order in which they have been filed except for those applications in which examination has been advanced pursuant to § 1.102. See § 1.496 for order of examination of International applications in the national stage.

(b) Applications which have been acted upon by the examiner, and which have been placed by the applicant in condition for further action by the examiner (amended applications) shall be taken up for action in such order as shall be determined by the Commissioner.

[29 FR 13470, Sept. 30, 1964; para. (a), 48 FR 2712, Jan. 20, 1983, effective Feb. 27, 1983; para. (a), 50 FR 9381, Mar. 7, 1985, effective May 8, 1985; 52 FR 20046, May 28, 1987, effective July 1, 1987]

#### § 1.102 Advancement of examination.

(a) Applications will not be advanced out of turn for examination or for further action except as provided by this part, or upon order of the Commissioner to expedite the business of the Office, or upon filing of a request under paragraph (b) of this section or upon filing a petition under paragraphs (c) or (d) of this section with a verified showing which, in the opinion of the Commissioner, will justify so advancing it.

(b) Applications wherein the inventions are deemed of peculiar importance to some branch of the public service and the head of some department of the Government requests immediate action for that reason, may be advanced for examination.

(c) A petition to make an application special may be filed without a fee if the basis for the petition is the applicant's age or health or that the invention will materially enhance the quality of the environment or materially contribute to the development or conservation of energy resources.

(d) A petition to make an application special on grounds other than those referred to in paragraph (c) of this section must be accompanied by the petition fee set forth in § 1.17(i).

[24 FR 10332, Dec. 22, 1959; paras. (a), (c) & (d), 47 FR 41276, Sept. 17, 1982, effective Oct. 1, 1982]

#### § 1.103 Suspension of action.

(a) Suspension of action by the Office will be granted for good and sufficient cause and for a reasonable time specified upon petition by the applicant and, if such cause is not the fault of the Office, the payment of the fee set forth in § 1.17(i). Action will not be suspended when a response by the applicant to an Office action is required.

(b) If action by the Office on an application is suspended when not requested by the applicant, the applicant shall be notified of the reasons therefor.

(c) Action by the examiner may be suspended by order of the Commissioner in the case of applications owned by the United States whenever publication of the invention by the granting of a patent thereon might be detrimental to the public safety or defense, at the request of the appropriate department or agency.

(d) Action on applications in which the Office has accepted a request to publish a defensive publication will be suspended

for the entire pendency of these applications except for purposes relating to patent interference proceedings under Subpart E.

[24 FR 10332, Dec. 22, 1959; 33 FR 5624, Apr. 11, 1968; paras. (a) & (b), 47 FR 41276, Sept. 17, 1982, effective Oct. 1, 1982; para. (d), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (d), 50 FR 9381, Mar. 7, 1985, effective May 8, 1985]

#### § 1.104 Nature of examination; examiner's action.

(a) On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.

(b) The applicant, or in the case of a reexamination proceeding, both the patent owner and the requester, will be notified of the examiner's action. The reasons for any adverse action or any objection or requirement will be stated and such information or references will be given as may be useful in aiding the applicant, or in the case of a reexamination proceeding the patent owner, to judge the propriety of continuing the prosecution.

(c) An international-type search will be made in all national applications filed on and after June 1, 1978.

(d) Any national application may also have an international-type search report prepared thereon at the time of the national examination on the merits, upon specific written request therefor and payment of the international-type search report fee. See § 1.21(e) for amount of fee for preparation of international-type search report.

NOTE. — The Patent and Trademark Office does not require that a formal report of an international-type search be prepared in order to obtain a search fee refund in a later filed international application.

(e) Co-pending applications will be considered by the examiner to be owned by, or subject to an obligation of assignment to, the same person if (1) the application files refer to assignments recorded in the Patent and Trademark Office in accordance with § 1.331 which convey the entire rights in the applications to the same person or organization; or (2) copies of unrecorded assignments which convey the entire rights in the applications to the same person or organization are filed in each of the applications; or (3) an affidavit or declaration by the common owner is filed which states that there is common ownership and states facts which explain why the affiant or declarant believes there is common ownership; or (4) other evidence is submitted which establishes common ownership of the applications. In circumstances where the common owner is a corporation or other organization an affidavit or declaration may be signed by an official of the corporation or organization empowered to act on behalf of the corporation or organization.

[43 FR 20465, May 11, 1978; 46 FR 29182, May 29, 1981; para. (d), 47 FR 41276, Sept. 17, 1982, effective date Oct. 1, 1982; para. (e), 50 FR 9381, Mar. 7, 1985, effective May 8, 1985]

#### § 1.105 Completeness of examiner's action.

The examiner's action will be complete as to all matters,

except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.

#### § 1.106 Rejection of claims.

(a) If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable will be rejected.

(b) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

(c) In rejecting claims the examiner may rely upon admissions by the applicant, or the patent owner in a reexamination proceeding, as to any matter affecting patentability and, insofar as rejections in applications are concerned, may also rely upon facts within his or her knowledge pursuant to § 1.107.

(d) Subject matter which is developed by another person which qualifies as prior art only under 35 U.S.C. 102(f) or (g) may be used as prior art under 35 U.S.C. 103 against a claimed invention unless the entire rights to the subject matter and the claimed invention were commonly owned by the same person or organization or subject to an obligation of assignment to the same person or organization at the time the claimed invention was made.

(e) The claims in any original application naming an inventor will be rejected as being precluded by a waiver in a published statutory invention registration naming that inventor if the same subject matter is claimed in the application and the statutory invention registration. The claims in any reissue application naming an inventor will be rejected as being precluded by a waiver in a published statutory invention registration naming that inventor if the reissue application seeks to claim subject matter (1) which was not covered by claims issued in the patent prior to the date of publication of the statutory invention registration and (2) which was the same subject matter waived in the statutory invention registration.

[24 FR 10332, Dec. 22, 1959; 34 FR 18857, Nov. 26, 1969; para. (c) added, 47 FR 21752, May 19, 1982, effective July 1, 1982; paras. (d) & (e), 50 FR 9381, Mar. 7, 1985, effective May 8, 1985]

#### § 1.107 Citation of references.

(a) If domestic patents are cited by the examiner, their numbers and dates, and the names of the patentees, and the classes of inventions must be stated. If foreign published applications or patents are cited, their nationality or country, numbers and dates, and the names of the patentees must be stated, and such other data must be furnished as may be necessary to enable the applicant, or in the case of a reexamination proceeding, the patent owner, to identify the published applications or patents cited. In citing foreign published applications or patents, in case only a part of the document is involved, the particular pages and

sheets containing the parts relied upon must be identified. If printed publications are cited, the author (if any), title, date, pages or plates, and place of publication, or place where a copy can be found, shall be given.

(b) When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

[46 FR 29182, May 29, 1981]

#### § 1.108 Abandoned applications not cited.

Abandoned applications as such will not be cited as references except those which have been opened to inspection by the public following a defensive publication.

[50 FR 9381, Mar. 7, 1985, effective May 8, 1985]

#### § 1.109 Reasons for allowance.

If the examiner believes that the record of the prosecution as a whole does not make clear his or her reasons for allowing a claim or claims, the examiner may set forth such reasoning. The reasons shall be incorporated into an Office action rejecting other claims of the application or patent under reexamination or be the subject of a separate communication to the applicant or patent owner. The applicant or patent owner may file a statement commenting on the reasons for allowance within such time as may be specified by the examiner. Failure to file such a statement shall not give rise to any implication that the applicant or patent owner agrees with or acquiesces in the reasoning of the examiner.

[46 FR 29182, May 29, 1981]

#### § 1.110 Inventorship and date of invention of the subject matter of individual claims.

When more than one inventor is named in an application or patent, the Patent and Trademark Office, when necessary for purposes of an Office proceeding, may require an applicant, patentee, or owner to identify the inventive entity of the subject matter of each claim in the application or patent. Where appropriate, the invention dates of the subject matter of each claim and the ownership of the subject matter on the date of invention may be required of the applicant, patentee or owner. See also §§ 1.78(c) and (d).

[OMB Control No. 0651-0018]

[50 FR 9381, Mar. 7, 1985, effective date May 8, 1985]

### ACTION BY APPLICANT AND FURTHER CONSIDERATION

#### § 1.111. Reply by applicant or patent owner.

(a) After the Office action, if adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply thereto and may request reconsideration or further examination, with or without amendment.

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must make request therefor in writing. The reply by the applicant or patent owner must distinctly and specifically point out the supposed errors in the examiner's action and must respond to every ground of objection and rejection in the prior Office action. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the case to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

(c) In amending in response to a rejection of claims in an application or patent undergoing reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections. (See §§ 1.135 and 1.136 for time for reply.)

[46 FR 29182, May 29, 1981]

#### § 1.112 Reconsideration.

After response by applicant or patent owner (§ 1.111), the application or patent under reexamination will be reconsidered and again examined. The applicant or patent owner will be notified if claims are rejected, or objections or requirements made, in the same manner as after the first examination. Applicant or patent owner may respond to such Office action in the same manner provided in § 1.111, with or without amendment. Any amendments after the second Office action must ordinarily be restricted to the rejection or to the objections or requirements made. The application or patent under reexamination will be again considered, and so on repeatedly, unless the examiner has indicated that the action is final.

[46 FR 29182, May 29, 1981]

#### § 1.113 Final rejection or action.

(a) On the second or any subsequent examination or consideration the rejection or other action may be made final, whereupon applicant's or patent owner's response is limited to appeal in the case of rejection of any claim (§ 1.191), or to amendment as specified in § 1.116. Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Response to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the response to a final rejection or action must comply with any requirements or objections to form.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the case, clearly stating the reasons therefor.

[24 FR 10332, Dec. 22, 1959; 46 FR 29182, May 29, 1981]

## AMENDMENTS

## § 1.115 Amendment.

The applicant may amend before or after the first examination and action and also after the second or subsequent examination or reconsideration as specified in § 1.112 or when and as specifically required by the examiner. The patent owner may amend in accordance with §§ 1.510(e) and 1.530(b) prior to reexamination, and during reexamination proceedings in accordance with §§ 1.112 and 1.116.

[46 FR 29183, May 29, 1981]

## § 1.116 Amendments after final action.

(a) After final rejection or action (§ 1.113) amendments may be made cancelling claims or complying with any requirement of form which has been made. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. The admission of, or refusal to admit, any amendment after final rejection, and any proceedings relative thereto, shall not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135.

(b) If amendments touching the merits of the application or patent under reexamination are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon a showing of good and sufficient reasons why they are necessary and were not earlier presented.

(c) No amendment can be made as a matter of right in appealed cases. After decision on appeal, amendments can only be made as provided in § 1.198, or to carry into effect a recommendation under § 1.196.

[24 FR 10332, Dec. 22, 1959; 46 FR 29183, May 29, 1981]

## § 1.117 Amendment and revision required.

The specification, claims and drawings must be amended and revised when required, to correct inaccuracies of description and definition or unnecessary prolixity, and to secure correspondence between the claims, the specification and the drawing.

## § 1.118 Amendment of disclosure.

(a) No amendment shall introduce new matter into the disclosure of an application after the filing date of the application (§ 1.53(b)). All amendments to the specification, including the claims, and the drawings filed after the filing date of the application must conform to at least one of them as it was at the time of the filing of the application. Matter not found in either, involving a departure from or an addition to the original disclosure, cannot be added to the application after its filing date even though supported by an oath or declaration in accordance with § 1.63 or § 1.67 filed after the filing date of the application.

(b) If it is determined that an amendment filed after the filing date of the application introduces new matter, claims containing new matter will be rejected and deletion of the new matter in the specification and drawings will be required even if the amendment is accompanied by an oath or declaration in accordance

with § 1.63 or § 1.67. [48 FR 2712, Jan. 20, 1983, effective Feb. 27, 1983]

## § 1.119 Amendment of claims.

The claims may be amended by canceling particular claims, by presenting new claims, or by rewriting particular claims as indicated in § 1.121. The requirements of § 1.111 must be complied with by pointing out the specific distinctions believed to render the claims patentable over the references in presenting arguments in support of new claims and amendments.

[32 FR 13583, Sept. 28, 1967]

## § 1.121 Manner of making amendments.

(a) Erasures, additions, insertions, or alterations of the Office file of papers and records must not be physically entered by the applicant. Amendments to the application (excluding the claims) are made by filing a paper (which should conform to § 1.52), directing or requesting that specified amendments be made. The exact word or words to be stricken out or inserted by said amendment must be specified and the precise point indicated where the deletion or insertion is to be made.

(b) Except as otherwise provided herein, a particular claim may be amended only by directions to cancel or by rewriting such claim with underlining below the word or words added and brackets around the word or words deleted. The rewriting of a claim in this form will be construed as directing the cancellation of the original claim; however, the original claim number followed by the parenthetical word "amended" must be used for the rewritten claim. If a previously rewritten claim is rewritten, underlining and bracketing will be applied in reference to the previously rewritten claim with the parenthetical expression "twice amended," "three times amended," etc., following the original claim number.

(c) A particular claim may be amended in the manner indicated for the application in paragraph (a) of this section to the extent of corrections in spelling, punctuation, and typographical errors. Additional amendments in this manner will be admitted provided the changes are limited to (1) deletions and/or (2) the addition of no more than five words in any one claim. Any amendment submitted with instructions to amend particular claims but failing to conform to the provisions of paragraphs (b) and (c) of this section may be considered nonresponsive and treated accordingly.

(d) Where underlining or brackets are intended to appear in the printed patent or are properly part of the claimed material and not intended as symbolic of changes in the particular claim, amendment by rewriting in accordance with paragraph (b) of this section shall be prohibited.

(e) In reissue applications, both the descriptive portion and the claims are to be amended by either (1) submitting a copy of a portion of the description or an entire claim with all matter to be deleted from the patent being placed between brackets and all matter to be added to the patent being underlined, or (2) indicating the exact word or words to be stricken out or inserted and the precise point where the deletion or insertion is to be made. Any word or words to be inserted must be underlined. See § 1.173.



(f) Proposed amendments presented in patents involved in reexamination proceedings must be presented in the form of a full copy of the text of: (1) Each claim which is amended and (2) each paragraph of the description which is amended. Matter deleted from the patent shall be placed between brackets and matter added shall be underlined. Copies of the printed claims from the patent may be used with any additions being indicated by carets and deleted material being placed between brackets. Claims must not be renumbered and the numbering of the claims added for reexamination must follow the number of the highest numbered patent claim. No amendment may enlarge the scope of the claims of the patent. No new matter may be introduced into the patent.

[32 FR 13583, Sept. 28, 1967; 46 FR 29183, May 29, 1981; para. (e), 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984]

#### § 1.122 Entry and consideration of amendments.

(a) Amendments are "entered" by the Office by making the proposed deletions by drawing a line in red ink through the word or words cancelled, and by making the proposed substitutions or insertions in red ink, small insertions being written in at the designated place and large insertions being indicated by reference.

(b) Ordinarily all amendments presented in a paper filed while the application is open to amendment are entered and considered, subsequent cancellation or correction being required of improper amendments. Untimely amendment papers may be refused entry and consideration in whole or in part. For amendments presented during an interference see § 1.664.

[24 FR 10332, Dec. 22, 1959; para. (b), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985]

#### § 1.123 Amendments to the drawing.

No change in the drawing may be made except by permission of the Office. Permissible changes in the construction shown in any drawing may be made only by bonded draftsmen, at applicant's expense, or by the submission of substitute drawings by applicant. A sketch in permanent ink showing proposed changes, to become part of the record, must be filed for approval by the examiner and should be a separate paper.

[48 FR 2712, Jan. 20, 1983, effective Feb. 27, 1983; 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984]

#### § 1.124 Amendment of amendments.

When an amendatory clause is to be amended, it should be wholly rewritten and the original insertion canceled, so that no interlineations or deletions shall appear in the clause as finally presented. Matter canceled by amendment can be reinstated only by a subsequent amendment presenting the canceled matter as a new insertion.

#### § 1.125 Substitute specification.

If the number or nature of the amendments shall render it difficult to consider the case, or to arrange the papers for printing or copying, the examiner may require the entire specification, including the claims, or any part thereof, to be rewritten. A substitute specification may not be accepted unless it has been required by the examiner or unless it is clear to the examiner that

acceptance of a substitute specification would facilitate processing of the application. Any substitute specification filed must be accompanied by a statement that the substitute specification includes no new matter. Such statement must be a verified statement if made by a person not registered to practice before the Office.

[48 FR 2712, Jan. 20, 1983, effective Feb. 27, 1983]

#### § 1.126 Numbering of claims.

The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When claims are added, except when presented in accordance with § 1.121(b), they must be numbered by the applicant consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not). When the application is ready for allowance, the examiner, if necessary, will renumber the claims consecutively in the order in which they appear or in such order as may have been requested by applicant.

[32 FR 13583, Sept. 28, 1967]

#### § 1.127 Petition from refusal to admit amendment.

From the refusal of the primary examiner to admit an amendment, in whole or in part, a petition will lie to the Commissioner under § 1.181.

### AFFIDAVITS OVERCOMING REJECTIONS

#### § 1.131 Affidavit or declaration of prior invention to overcome cited patent or publication.

(a) When any claim of an application or a patent under reexamination is rejected on reference to a domestic patent which substantially shows or describes but does not claim the rejected invention, or on reference to a foreign patent or to a printed publication, and the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the person qualified under §§ 1.42, 1.43 or 1.47, shall make oath or declaration as to facts showing a completion of the invention in this country before the filing date of the application on which the domestic patent issued, or before the date of the foreign patent, or before the date of the printed publication, then the patent or publication cited shall not bar the grant of a patent to the inventor or the confirmation of the patentability of the claims of the patent, unless the date of such patent or printed publication is more than one year prior to the date on which the inventor's or patent owners application was filed in this country.

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained.

[24 FR 10332, Dec. 22, 1959; 34 FR 18857, Nov. 26, 1969; para. (a), 48 FR 2713, Jan. 20, 1983, effective Feb. 27, 1983; para. (a),

50 FR 9381, Mar. 7, 1985, effective May 8, 1985; 50 FR 11366, Mar. 21, 1985]

### § 1.132 Affidavits or declarations traversing grounds of rejection.

When any claim of an application or a patent under reexamination is rejected on reference to a domestic patent which substantially shows or describes but does not claim the invention, or on reference to a foreign patent, or to a printed publication, or to facts within the personal knowledge of an employee of the Office, or when rejected upon a mode or capability of operation attributed to a reference, or because the alleged invention is held to be inoperative or lacking in utility, or frivolous or injurious to public health or morals, affidavits or declarations traversing these references or objections may be received.

[48 FR 2713, Jan. 20, 1983, effective Feb. 27, 1983]

## INTERVIEWS

### § 1.133 Interviews.

(a) Interviews with examiners concerning applications and other matters pending before the Office must be had in the examiners' rooms at such times, within office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Commissioner. Interviews for the discussion of the patentability of pending applications will not be had before the first official action thereon. Interviews should be arranged for in advance.

(b) In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for response to Office actions as specified in §§ 1.111, 1.135.

## TIME FOR RESPONSE BY APPLICANT; ABANDONMENT OF APPLICATION

### § 1.134 Time period for response to an Office action.

An Office action will notify the applicant of any non-statutory or shortened statutory time period set for response to an Office action. Unless the applicant is notified in writing that response is required in less than six months, a maximum period of six months is allowed.

[47 FR 41276, Sept. 17, 1982, effective Oct. 1, 1982]

### § 1.135 Abandonment for failure to repond within time limit.

(a) If an applicant of a patent application fails to respond within the time period provided under §§ 1.134 and 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper action as the condition of the case may require. The admission of an amendment not responsive to the

last Office action, or refusal to admit the same, and any proceedings relative thereto, shall not operate to save the application from abandonment.

(c) When action by the applicant is a bona fide attempt to respond and to advance the case to final action, and is substantially a complete response to the Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, opportunity to explain and supply the omission may be given before the question of abandonment is considered.

[paras. (a), (b) & (c), 47 FR 41276, Sept. 17, 1982, effective Oct. 1, 1982; para. (d) deleted, 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984]

### § 1.136 Filing of timely responses with petition and fee for extension of time and extensions of time for cause.

(a) If an applicant is required to respond within a non-statutory or shortened statutory time period, applicant may respond up to four months after the time period set if a petition for an extension of time and the fee set in § 1.17 are filed prior to or with the response, unless (1) applicant is notified otherwise in an Office action or (2) the application is involved in an interference declared pursuant to § 1.611. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for purposes of determining the period of extension and the corresponding amount of the fee. The expiration of the time period is determined by the amount of the fee paid. In no case may an applicant respond later than the maximum time period set by statute, or be granted an extension of time under paragraph (b) of this section when the provisions of this paragraph are available. See § 1.645 for extension of time in interference proceedings and § 1.550(c) for extension of time in reexamination proceedings.

(b) When a response with petition and fee for extension of time cannot be filed pursuant to paragraph (a) of this section, the time for response will be extended only for sufficient cause, and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the applicant is due, but in no case will the mere filing of the request effect any extension. In no case can any extension carry the date on which response to an Office action is due beyond the maximum time period set by statute or be granted when the provisions of paragraph (a) of this section are available. See § 1.645 for extension of time in interference proceedings and § 1.550(c) for extension of time in reexamination proceedings.

[OMB Contro No. 0651-0011]

47 FR 41277, Sept. 17, 1982, effective Oct. 1, 1982; 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985]

### § 1.137 Revival of abandoned application.

(a) An application abandoned for failure to prosecute may be revived as a pending application if it is shown to the satisfaction of the Commissioner that the delay was unavoidable. A petition to revive an abandoned application must be promptly filed after the applicant is notified of, or otherwise becomes aware of, the abandonment, and must be accompanied by a showing of the

causes of the delay, by the proposed response unless it has been previously filed, and by the petition fee set forth in § 1.17(1). Such showing must be a verified showing if made by a person not registered to practice before the Patent and Trademark Office.

(b) An application unintentionally abandoned for failure to prosecute, except pursuant of § 1.53(d), may be revived as a pending application if the delay was unintentional. A petition to revive an unintentionally abandoned application must be filed within one year of the date on which the application became abandoned or be filed within three months of the date of the first decision on a petition to revive under paragraph (a) of this section which was filed within one year of the date of abandonment of the application. A petition to revive an unintentionally abandoned application must be accompanied by: (1) A statement that the abandonment was unintentional; (2) A proposed response unless it has been previously filed, and (3) a petition fee as set forth in § 1.17(m). Such statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office. The Commissioner may require additional information where there is a question whether the abandonment was unintentional. The three month period set forth in this paragraph may be extended under the provisions of § 1.136(a), but no further extensions under § 1.136(b) will be granted. Petitions to the Commissioner under § 1.183 to waive any time periods for requesting revival of an unintentionally abandoned application will not be considered, but will be returned to the applicant.

(c) Any petition pursuant to paragraph (a) of this section not filed within six months of the date of abandonment must be accompanied by a terminal disclaimer with fee under § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application.

[OMB Control No. 0651-0011]

[47 FR 41277, Sept. 17, 1982, effective Oct. 1, 1982; para. (b), 48 FR 2713, Jan. 20, 1983, effective Feb. 27, 1983]

**§ 1.138 Express abandonment.**

An application may be expressly abandoned by filing in the Patent and Trademark Office a written declaration of abandonment signed by the applicant and the assignee of record, if any, and identifying the application. An application may also be expressly abandoned by filing a written declaration of abandonment signed by the attorney or agent of record. A registered attorney or agent acting under the provision of § 1.34(a), or of record, may also expressly abandon a prior application as of the filing date granted to a continuing application when filing such a continuing application. Express abandonment of the application may not be recognized by the Office unless it is actually received by appropriate officials in time to act thereon before the date of issue.

[OMB Control No. 0651-0011]

[47 FR 47244, Oct. 25, 1982, effective Feb. 27, 1983; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985]

**JOINDER OF INVENTIONS IN ONE APPLICATION;  
RESTRICTION**

**§ 1.141 Different inventions in one national application.**

(a) Two or more independent and distinct inventions may not be claimed in one national application, except that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (§ 1.75) or otherwise include all the limitations of the generic claim.

(b) Where claims to all three categories, product, process of making and process of use, are included in a national application, a three way requirement for restriction can only be made where the process of making is distinct from the product. If the process of making and the product are not distinct, the process of using may be joined with the claims directed to the product and the process of making the product even though a showing of distinctness between the product and process of using the product can be made.

[52 FR 20046, May 28, 1987, effective July 1, 1987]

**§ 1.142 Requirement for restriction.**

(a) If two or more independent and distinct inventions are claimed in a single application, the examiner in his action shall require the applicant in his response to that action to elect that invention to which his claim shall be restricted, this official action being called a requirement for restriction (also known as a requirement for division). If the distinctness and independence of the inventions be clear, such requirement will be made before any action on the merits; however, it may be made at any time before final action in the case at the discretion of the examiner.

(b) Claims to the invention or inventions not elected, if not cancelled, are nevertheless withdrawn from further consideration by the examiner by the election, subject however to reinstatement in the event the requirement for restriction is withdrawn or overruled.

**§ 1.143 Reconsideration of requirement.**

If the applicant disagrees with the requirement for restriction, he may request reconsideration and withdraw or modification of the requirement, giving the reasons therefor (see § 1.111). In requesting reconsideration the applicant must indicate a provisional election of one invention for prosecution, which invention shall be the one elected in the event the requirement becomes final. The requirement for restriction will be reconsidered on such a request. If the requirement is repeated and made final, the examiner will at the same time act on the claims to the invention elected.

**§ 1.144 Petition from requirement for restriction.**

After a final requirement for restriction, the applicant, in addition to making any response due on the remainder of the action, may petition the Commissioner to review the requirement. Petition may be deferred until after final action on or allowance of claims to the invention elected, but must be filed not later than appeal. A petition will not be considered if reconsideration of the requirement was not requested. (See § 1.181.)

**§ 1.145 Subsequent presentation of claims for different invention.**

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144.

**§ 1.146 Election of species.**

In the first action on an application containing a generic claim and claims restricted separately to each of more than one species embraced thereby, the examiner may require the applicant in his response to that action to elect that species of his or her invention to which his or her claim shall be restricted if no generic claim is held allowable. However, if such application contains claims directed to more than a reasonable number of species, the examiner may require restriction of the claims to not more than a reasonable number of species before taking further action in the case.

[43 FR 20465, May 11, 1978]

**DESIGN PATENTS**

**§ 1.151 Rules applicable.**

The rules relating to applications for patents for other inventions or discoveries are also applicable to applications for patents for designs except as otherwise provided.

**§ 1.152 Drawing.**

The design must be represented by a drawing made in conformity with the rules laid down for drawings of mechanical inventions and must contain a sufficient number of views to constitute a complete disclosure of the appearance of the article. Appropriate surface shading must be used to show the character or contour of the surfaces represented.

**§ 1.153 Title, description and claim, oath or declaration.**

(a) The title of the design must designate the particular article. No description, other than a reference to the drawing, is ordinarily required. The claim shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described. More than one claim is neither required nor permitted.

(b) The oath or declaration required of the applicant must comply with § 1.63.

[24 FR 10332, Dec. 22, 1959; 29 FR 18503, Dec. 29, 1964; para. (b), 48 FR 2712, Jan. 20, 1983, effective Feb. 27, 1983]

**§ 1.154 Arrangement of specification.**

The following order of arrangement should be observed in framing design specifications:

(a) Preamble, stating name of the applicant and title of the design.

(b) Description of the figure or figures of the drawing.

(c) Description, if any.

(d) Claim.

(e) Signed oath or declaration (See § 1.153(b)).

[24 FR 10332, Dec. 22, 1959, para. (e), 48 FR 2713, Jan. 20, 1983, effective date Feb. 27, 1983]

**§ 1.155 Issue and term of design patents.**

(a) If, on examination, it shall appear that the applicant is entitled to a design patent under the law, a notice of allowance will be sent to the applicant, or applicant's attorney or agent, calling for the payment of the issue fee (§ 1.18(b)). If this issue fee is not paid within 3 months of the date of the notice of allowance, the application shall be regarded as abandoned.

(b) The Commissioner may accept the payment of the issue fee later than three months after the mailing of the notice of allowance as though no abandonment had ever occurred if upon petition the delay in payment is shown to have been unavoidable. The petition to accept the delayed payment must be promptly filed after the applicant is notified of, or otherwise becomes aware of, the abandonment, and must be accompanied by (1) the issue fee, unless it has been previously submitted, (2) the fee for delayed payment (§ 1.17(1)), and (3) a showing that the delay was unavoidable. Such showing must be a verified showing if made by a person not registered to practice before the Patent and Trademark Office.

(c) The Commissioner may, upon petition, accept the payment of the issue fee later than three months after the mailing of the notice of allowance as though no abandonment had ever occurred if the delay in payment was unintentional. The petition to accept the delayed payment must be filed within one year of the date on which the application became abandoned or be filed within three months of the date of the first decision on a petition under paragraph (b) of this section which was filed within one year of the date of abandonment of the application. The petition to accept the delayed payment must be accompanied by (1) the issue fee, unless it has been previously submitted, (2) the fee for unintentionally delayed payment (§ 1.17(m)), and (3) a statement that the delay was unintentional. Such statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office. The Commissioner may require additional information where there is a question whether the abandonment was unintentional. The three-month period from the date of the first decision referred to in this paragraph may be extended under the provisions of § 1.136(a), but no further extensions under § 1.136(b) will be granted. Petitions to the Commissioner under § 1.183 to waive any time periods for requesting revival of an unintentionally abandoned application will not be considered, but will be returned to applicant.

(d) Any petition pursuant to paragraph (b) of this section not filed within six months of the date of abandonment must be accompanied by a terminal disclaimer with fee under § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application.

[47 FR 41277, Sept. 17, 1982, effective date Oct. 1, 1982]

## PLANT PATENTS

**§ 1.161 Rules applicable.**

The rules relating to applications for patent for other inventions or discoveries are also applicable to applications for patents for plants except as otherwise provided.

**§ 1.162 Applicant, oath or declaration.**

The applicant for a plant patent must be the person who has invented or discovered and asexually reproduced the new and distinct variety of plant for which a patent is sought (or as provided in §§ 1.42, 1.43 and 1.47). The oath or declaration required of the applicant, in addition to the averments required by § 1.63, must state that he or she has asexually reproduced the plant. Where the plant is a newly found plant the oath or declaration must also state that it was found in a cultivated area.

[OMB Control No. 0651-0011]

[48 FR 2713, Jan. 20, 1983, effective Feb. 27, 1983]

**§ 1.163 Specification.**

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

(b) Two copies of the specification (including the claim) must be submitted, but only one signed oath or declaration is required. The second copy of the specification may be a legible carbon copy of the original.

[24 FR 10332, Dec. 22, 1959, para. (b), 48 FR 2713, Jan. 20, 1983, effective Feb. 27, 1983]

**§ 1.164 Claim.**

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

**§ 1.165 Drawings.**

(a) Plant patent drawings are not mechanical drawings and should be artistically and competently executed. Figure numbers and reference characters need not be employed unless required by the examiner. The drawing must disclose all the distinctive characteristics of the plant capable of visual representation.

(b) The drawing may be in color and when color is a distinguishing characteristic of the new variety, the drawing must be in color. Two copies of color drawings must be submitted. Color drawings may be made either in permanent water color or oil, or in lieu thereof may be photographs made by color photography or properly colored on sensitized paper. Permanently mounted color photographs are acceptable. The paper in any case must correspond in size, weight and quality to the paper required for other drawings. See § 1.84.

[24 FR 10332, Dec. 22, 1959; para. (b), 47 FR 41277, Sept. 17, 1982, effective Oct. 1, 1982]

**§ 1.166 Specimens.**

The applicant may be required to furnish specimens of the plant, or its flower or fruit, in a quantity and at a time in its stage of growth as may be designated, for study and inspection. Such specimens, properly packed, must be forwarded in conformity with instructions furnished to the applicant. When it is not possible to forward such specimens, plants must be made available for official inspection where grown.

**§ 1.167 Examination.**

(a) Applications may be submitted by the Patent and Trademark Office to the Department of Agriculture for study and report.

(b) Affidavits or declarations from qualified agricultural or horticultural experts regarding the novelty and distinctiveness of the variety of plant may be received when the need of such affidavits or declarations is indicated.

[24 FR 10332, Dec. 22, 1959; 34 FR 18857, Nov. 26, 1969]

## REISSUES

**§ 1.171 Application for reissue.**

An application for reissue must contain the same parts required for an application for an original patent, complying with all the rules relating thereto except as otherwise provided, and in addition, must comply with the requirements of the rules relating to reissue applications. The application must be accompanied by a certified copy of an abstract of title or an order for a title report accompanied by the fee set forth in § 1.19(b)(2), to be placed in the file, and by an offer to surrender the original patent (§ 1.178).

[OMB Control No. 0651-0011]

[47 FR 41278, Sept. 17, 1982, effective Oct. 1, 1982]

**§ 1.172 Applicants, assignees.**

(a) A reissue oath must be signed and sworn to or declaration made by the inventor or inventors except as otherwise provided (see §§ 1.42, 1.43, 1.47), and must be accompanied by the written assent of all assignees, if any, owning an undivided interest in the patent, but a reissue oath may be made and sworn to or declaration made by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

(b) A reissue will be granted to the original patentee, his legal representative or assigns as the interest may appear.

[OMB Control No. 0651-0011]

[24 FR 10332, Dec. 22, 1959, para. (a), 48 FR 2713, Jan. 20, 1983, effective Feb. 27, 1983]

**§ 1.173 Specification.**

The specification of the reissue application must include the entire specification and claims of the patent, with the matter to be omitted by reissue enclosed in square brackets; and any additions made by the reissue must be underlined, so that the old and the new specifications and claims may be readily compared.

Claims should not be renumbered and the numbering of claims added by reissue should follow the number of the highest numbered patent claim. No new matter shall be introduced into the specification.

#### § 1.174 Drawings.

(a) The drawings upon which the original patent was issued may be used in reissue applications if no changes whatsoever are to be made in the drawings. In such cases, when the reissue application is filed, the applicant must submit a temporary drawing which may consist of a copy of the printed drawings of the patent or a photoprint of the original drawings of the size required for original drawing.

(b) Amendments which can be made in a reissue drawing, that is, changes from the drawing of the patent, are restricted.

[24 FR 10332, Dec. 22, 1959; para. (a), 48 FR 2713, Jan. 20, 1983, effective Feb. 27, 1983]

#### § 1.175 Reissue oath or declaration.

(a) Applicants for reissue, in addition to complying with the requirements of § 1.63, must also file with their applications a statement under oath or declaration as follows:

(1) When the applicant verily believes the original patent to be wholly or partly inoperative or invalid, stating such belief and the reasons why.

(2) When it is claimed that such patent is so inoperative or invalid "by reason of a defective specification or drawing," particularly specifying such defects.

(3) When it is claimed that such patent is inoperative or invalid "by reason of the patentee claiming more or less than he had the right to claim in the patent," distinctly specifying the excess or insufficiency in the claims.

(4) [Reserved]

(5) Particularly specifying the errors relied upon, and how they arose or occurred.

(6) Stating that said errors arose "without any deceptive intention" on the part of the applicant.

(7) Acknowledging a duty to disclose information applicant is aware of which is material to the examination of the application.

(b) Corroborating affidavits or declarations of others may be filed and the examiner may, in any case, require additional information or affidavits or declarations concerning the application for reissue and its object.

[OMB Control No. 0651-0011]

[24 FR 10332, Dec. 22, 1959; 29 FR 18503, Dec. 29, 1964; 34 FR 18857, Nov. 26, 1969; para. (a), 47 FR 21752, May 19, 1982, effective July 1, 1982; para. (a), 48 FR 2713, Jan. 20, 1983, effective Feb. 27, 1983]

#### § 1.176 Examination of reissue.

An original claim, if re-presented in the reissue application, is subject to reexamination, and the entire application will be examined in the same manner as original applications, subject to the rules relating thereto, excepting that division will not be required. Applications for reissue will be acted on by the examiner in advance of other applications, but not sooner than two months after the announcement of the filing of the reissue

application has appeared in the *Official Gazette*.

[42 FR 5595, Jan. 28, 1977]

#### § 1.177 Reissue in divisions.

The Commissioner may, in his or her discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for each division. Each division of a reissue constitutes the subject of a separate specification descriptive of the part or parts of the invention claimed in such division; and the drawing may represent only such part or parts, subject to the provisions of §§ 1.83 and 1.84. On filing divisional reissue applications, they shall be referred to the Commissioner. Unless otherwise ordered by the Commissioner upon petition and payment of the fee set forth in § 1.17(i), all the divisions of a reissue will issue simultaneously; if there be any controversy as to one division, the others will be withheld from issue until the controversy is ended, unless the Commissioner shall otherwise order.

[47 FR 41278, Sept. 17, 1982, effective date Oct. 1, 1982]

#### § 1.178 Original patent.

The application for a reissue must be accompanied by an offer to surrender the original patent. The application should also be accompanied by the original patent, or if the original is lost or inaccessible, by an affidavit or declaration to that effect. The application may be accepted for examination in the absence of the original patent or the affidavit or declaration, but one or the other must be supplied before the case is allowed. If a reissue be refused, the original patent will be returned to applicant upon his request.

[OMB Control No. 0651-0011]

[24 FR 10332, Dec. 22, 1959; 34 FR 18857, Nov. 26, 1969]

#### § 1.179 Notice of reissue application.

When an application for a reissue is filed, there will be placed in the file of the original patent a notice stating that an application for reissue has been filed. When the reissue is granted or the reissue application is otherwise terminated, the fact will be added to the notice in the file of the original patent.

### PETITIONS AND ACTIONS BY THE COMMISSIONER

#### § 1.181 Petition to the Commissioner.

(a) Petition may be taken to the Commissioner: (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court; (2) in cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) to invoke the supervisory authority of the Commissioner in appropriate circumstances. For petitions in interferences, see § 1.644.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or

declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specific time, setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.

(d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

(e) Oral hearing will not be granted except when considered necessary by the Commissioner.

(f) Except as otherwise provided in these rules, any such petition not filed within 2 months from the action complained of, may be dismissed as untimely. The mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor act as a stay of other proceedings.

(g) The Commissioner may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

[24 FR 10332, Dec. 22, 1959; 34 FR 18857, Nov. 26, 1969; paras. (d) & (g), 47 FR 41278, Sept. 17, 1982, effective Oct. 1, 1982; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985]

#### § 1.182 Questions not specifically provided for.

All cases not specifically provided for in the regulations of this part will be decided in accordance with the merits of each case by or under the authority of the Commissioner, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(h).

[47 FR 41278, Sept. 17, 1982, effective date Oct. 1, 1982]

#### § 1.183 Suspension of rules.

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the fee set forth in § 1.17(h).

[47 FR 41278, Sept. 17, 1982, effective Oct. 1, 1982]

#### § 1.184 Reconsideration of cases decided by former Commissioners.

Cases which have been decided by one Commissioner will not be reconsidered by his successor except in accordance with the principles which govern the granting of new trials.

### APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

AUTHORITY: Secs. 1.191 to 1.198 also issued under 35 U.S.C. 134.

#### § 1.191 Appeal to Board of Patent Appeals and Interferences.

(a) Every applicant for a patent or for reissue of a patent, or every owner of a patent under reexamination, any of the claims of which have been twice rejected or who has been given a final rejection (§ 1.113), may, upon the payment of the fee set forth in § 1.17(e), appeal from the decision of the examiner to the Board of Patent Appeals and Interferences within the time allowed for response.

(b) The appeal in an application must identify the rejected claim or claims appealed, and must be signed by the applicant or duly authorized attorney or agent. An appeal in a reexamination proceeding must identify the rejected claim or claims appealed, and must be signed by the patent owner or duly authorized attorney or agent.

(c) An appeal when taken must be taken from the rejection of all claims under rejection which the applicant or patent owner proposes to contest. Questions relating to matters not affecting the merits of the invention may be required to be settled before an appeal can be considered.

(d) The time periods set forth in §§ 1.191 through 1.194, 1.196 and 1.197 are subject to the provisions of § 1.136 for patent applications or § 1.550(c) for reexamination proceedings.

[OMB Control No. 0651-0011]

[46 FR 29182, May 29, 1981; para. (a), 47 FR 41278, Sept. 17, 1982, effective Oct. 1, 1982; para. (d), 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985]

#### § 1.192 Appellant's brief.

(a) The appellant shall, within 2 months from the date of the notice of appeal under § 1.191 in an application, reissue application, or patent under reexamination, or within the time allowed for response to the action appealed from, if such time is later, file a brief in triplicate. The brief must be accompanied by the requisite fee set forth in § 1.17(f) and must set forth the authorities and arguments on which the appellant will rely to maintain the appeal. The brief must include a concise explanation of the invention which should refer to the drawing by reference characters, and a copy of the claims involved.

(b) On failure to file the brief, accompanied by the requisite fee, within the time allowed, the appeal shall stand dismissed.

[36 FR 5850, Mar. 30, 1971; para. (a), 47 FR 41278, Sept. 17, 1982, effective Oct. 1, 1982; para. (a), 49 FR 556, Jan. 4, 1984, effective Apr. 1, 1984]

#### § 1.193 Examiner's answer.

(a) The primary examiner may, within such time as may be directed by the Commissioner, furnish a written statement in answer to the appellant's brief including such explanation of the invention claimed and of the references and grounds of rejection as may be necessary, supplying a copy to the appellant. If the primary examiner shall find that the appeal is not regular in form or does not relate to an appealable action, he shall so state and a petition from such decision may be taken to the Commissioner as provided in § 1.181.

(b) The appellant may file a reply brief directed only to such new points of argument as may be raised in the examiner's answer, within one month from the date of such answer. However, if the examiner's answer states a new ground of rejection appellant may file a reply thereto within two months from the date of such answer; such reply may include any amendment or material appropriate to the new ground.

(c) Any decision pursuant to § 1.56(d) rejecting claims in an application already under appeal of a rejection based on other grounds shall constitute a supplemental examiner's answer introducing a new ground of rejection and removing the suspension of the appeal introduced pursuant to § 1.56(e), in which case appellant may file a reply thereto within two months from the date of the supplemental examiner's answer. Such reply will be considered and responded to as necessary. Appellant may file a reply brief directed to any such response within one month of the date of response or within such other time as may be set in the response.

[24 FR 10332, Dec. 22, 1959; 34 FR 18858, Nov. 26, 1969; para. (c), 47 FR 21752, May 19, 1982, added effective July 1, 1982; para. (b), 50 FR 9382, Mar. 7, 1985, effective May 8, 1985]

#### § 1.194 Oral hearing.

(a) An oral hearing should be requested only in those circumstances in which the appellant considers such a hearing necessary or desirable for a proper presentation of his appeal. An appeal decided without an oral hearing will receive the same consideration by the Board of Patent Appeals and Interferences as appeals decided after oral hearing.

(b) If appellant desires an oral hearing, appellant must file a written request for such hearing accompanied by the fee set forth in § 1.17(g) within one month after the date of the examiner's answer. If appellant requests an oral hearing and submits therewith the fee set forth in § 1.17(g), an oral argument may be presented by, or on behalf of, the primary examiner if considered desirable by either the primary examiner or the Board.

(c) If no request and fee for oral hearing have been timely filed by the appellant, the appeal will be assigned for consideration and decision. If the appellant has requested an oral hearing and has submitted the fee set forth in § 1.17(g), a day of hearing will be set, and due notice thereof given to the appellant and to the primary examiner. Hearing will be held as stated in the notice, and oral argument will be limited to twenty minutes for the appellant and fifteen minutes for the primary examiner unless otherwise ordered before the hearing begins.

[42 FR 5595, Jan. 28, 1977; paras. (b) & (c), 47 FR 41278, Sept. 17, 1982, effective Oct. 1, 1982; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985]

#### § 1.195 Affidavits or declarations after appeal.

Affidavits, declarations, or exhibits submitted after the case has been appealed will not be admitted without a showing of good and sufficient reasons why they were not earlier presented.

[34 FR 18858, Nov. 26, 1969]

#### § 1.196 Decision by the Board of Patent Appeals and Interferences.

(a) The Board of Patent Appeals and Interferences, in its decision, may affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner. The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed.

(b) Should the Board of Patent Appeals and Interferences have knowledge of any grounds not involved in the appeal for rejecting any appealed claim, it may include in the decision a statement to that effect with its reasons for so holding, which statement shall constitute a new rejection of the claims. When the Board of Patent Appeals and Interferences make a new rejection of an appealed claim, the appellant may exercise any one of the following three options:

(1) The appellant may submit an appropriate amendment of the claims so rejected or a showing of facts, or both, and have the matter reconsidered by the examiner in which event the application will be remanded to the examiner and the decision of the Board of Patent Appeals and Interferences shall not be considered final for the purpose of judicial review. The statement shall be binding upon the examiner unless an amendment or showing of facts not previously of record be made, which, in the opinion of the examiner, overcomes the new ground for rejection stated in the decision. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board of Patent Appeals and Interferences may enter an order otherwise making its decision final.

(2) The appellant may have the case reconsidered under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. Where request for such reconsideration is made the Board of Patent Appeals and Interferences shall, if necessary, render a new decision which shall include all grounds upon which a patent is refused.

(3) The appellant may treat the decision, including the new grounds for rejection given by the Board of Patent Appeals and Interferences, as a final decision in the case.

(c) Should the decision of the Board of Patent Appeals and Interferences include an explicit statement that a claim may be allowed in amended form, appellant shall have the right to amend in conformity with such statement which shall be binding on the examiner in the absence of new references or grounds of rejection.

(d) Although the Board of Patent Appeals and Interferences normally will confine its decision to a review of rejections made by the examiner, should it have knowledge of any grounds for rejecting any allowed claim it may include in its decision a recommended rejection of the claim and remand the case to the examiner. In such event, the Board shall set a period, not less than one month, within which the appellant may submit to the examiner an appropriate amendment, a showing of facts or reasons, or both, in order to avoid the grounds set forth in the recommendation of the Board of Patent Appeals and Interferences. The examiner shall be bound by the recommendation and shall enter and maintain the recommended rejection unless an amendment or showing of facts not previously of record is filed which, in the opinion of the examiner, overcomes the recom-



mended rejection. Should the examiner make the recommended rejection final the applicant may again appeal to the Board of Patent Appeals and Interferences. Whenever a decision of the Board of Patent Appeals and Interferences includes a remand, that decision shall not be considered a final decision. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board of Patent Appeals and Interferences may enter an order otherwise making its decision final.

[24 FR 10332, Dec. 12, 1959; 49 FR 29183, May 29, 1981; 49 FR 48416, Dec. 12, 1984, effective Feb. 12, 1985]

### § 1.197 Action following decision.

(a) After decision by the Board of Patent Appeals and Interferences, the case shall be returned to the examiner, subject to the appellant's right of appeal or other review, for such further action by the appellant or by the examiner, as the condition of the case may require, to carry into effect the decision.

(b) A single request for reconsideration or modification of the decision may be made if filed within one month from the date of the original decision, unless that decision is so modified as to become, in effect, a new decision, and the Board of Patent Appeals and Interferences so states.

(c) Proceedings are considered terminated by the dismissal of an appeal or the failure to timely file an appeal to the court or a civil action (§ 1.304) except: (1) Where claims stand allowed in an application or (2) where the nature of the decision requires further action by the examiner. In such cases, the date of termination of proceedings is the date on which the appeal is dismissed or the date on which the time for appeal to the court or review by civil action (§ 1.304) expires. If an appeal to the court or a civil action has been filed, proceedings are similarly considered terminated when the appeal or civil action is terminated.

[46 FR 29184, May 29, 1981; para. (a), 47 FR 41278, Sept. 17, 1982, effective Oct. 1, 1982; 49 FR 556, Jan. 4, 1984, effective Apr. 1, 1984; paras. (a) & (b), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985]

### § 1.198 Reopening after decision.

Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.196 without the written authority of the Commissioner, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

[24 FR 10332, Dec. 22, 1959; 49 FR 48416, Dec. 12, 1984, effective date Feb. 11, 1985]

## MISCELLANEOUS PROVISIONS

### § 1.248 Service of papers; manner of service; proof of service in cases other than interferences.

(a) Service of papers must be on the attorney or agent of the party if there be such or on the party if there is no attorney or agent, and may be made in any of the following ways:

- (1) By delivering a copy of the paper to the person served;
- (2) By leaving a copy at usual place of business of the person served with someone in his employment;

(3) When the person served has no usual place of business, by leaving a copy at the person's residence, with some person of suitable age and discretion who resides there;

(4) Transmissions by first class mail. When service is by mail the date of mailing will be regarded as the date of service.

(5) Whenever it shall be satisfactorily shown to the Commissioner that none of the above modes of obtaining or serving the paper is practicable, service may be by notice published in the *Official Gazette*.

(b) Papers filed in the Patent and Trademark Office which are required to be served shall contain proof of service. Proof of service may appear on or be affixed to papers filed. Proof of service shall include the date and manner of service. In the case of personal service, proof of service shall also include the name of any person served, certified by the person who made service. Proof of service may be made by: (1) An acknowledgement of service by or on behalf of the person served or (2) a statement signed by the attorney or agent containing the information required by this section.

(c) See § 1.646 for service of papers in interferences.

[46 FR 29184, May 29, 1981; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985]

## PROTESTS AND PUBLIC USE PROCEEDINGS

### § 1.291 Protests by the public against pending applications.

(a) Protests by a member of the public against pending applications will be referred to the examiner having charge of the subject matter involved. A protest specifically identifying the application to which the protest is directed will be entered in the application file if (1) the protest is timely submitted; and (2) the protest is either served upon the applicant in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible.

(b) A protest submitted in accordance with the second sentence of paragraph (a) of this section will be considered by the Office if it includes (1) a listing of the patents, publications or other information relied upon; (2) a concise explanation of the relevance of each listed item; (3) a copy of each listed patent or publication or other item of information in written form or at least the pertinent portions thereof; and (4) an English language translation of all the necessary and pertinent parts of any non-English language patent, publication, or other item of information in written form relied upon.

(c) An acknowledgement of the entry of a protest under paragraph (a) of this section in a reissue application file will be sent to the member of the public filing the protest. A member of the public filing a protest under paragraph (a) of this section in an application for an original patent will not receive any communications from the Office relating to the protest, other than the return of a self-addressed postcard which the member of the public may include with the protest in order to receive an acknowledgment by the Office that the protest has been received. The Office will communicate with the applicant regarding any protest entered in the application file and may require the applicant to supply information pursuant to paragraph (a) of

§ 1.56, including responses to specific questions raised by the protest, in order for the Office to decide any issues raised by the protest. The active participation of the member of the public filing a protest pursuant to paragraph (a) of this section ends with the filing of the protest and no further submission on behalf of the protestor will be acknowledged or considered unless such submission raises new issues which could not have been earlier presented, and thereby constitutes a new protest.

[47 FR 21752, May 19, 1982, effective July 1, 1982]

### § 1.292 Public use proceedings.

(a) When a petition for the institution of public use proceedings, supported by affidavits or declarations and the fee set forth in § 1.17(j), is filed by one having information of the pendency of an application and is found, on reference to the examiner, to make a *prima facie* showing that the invention claimed in an application believed to be on file had been in public use or on sale more than one year before the filing of the application, a hearing may be had before the Commissioner to determine whether a public use proceeding should be instituted. If instituted, the Commissioner may designate an appropriate official to conduct the public use proceeding including the setting of times for taking testimony, which shall be taken as provided by §§ 1.671 to 1.685. The petitioner will be heard in the proceedings but after decision therein will not be heard further in the prosecution of the application for patent.

(b) The petition and accompanying papers should either: (1) Reflect that a copy of the same has been served upon the applicant or upon his attorney or agent of record; or (2) be filed with the Office in duplicate in the event service is not possible. The petition and accompanying papers, or a notice that such a petition has been filed, shall be entered in the application file.

(c) A petition for institution of public use proceedings shall not be filed by a party to an interference as to an application involved in the interference. Public use and on sale issues in an interference shall be raised by a preliminary motion under § 1.633(a).

[42 FR 5595, Jan. 28, 1977; para. (a), 47 FR 41279, Sept. 17, 1982; paras. (a) & (c), 49 FR 48416, Dec. 12, 1984, effective Feb. 12, 1985]

### § 1.293 Statutory invention registration.

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

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

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

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

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

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

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

[OMB Control No. 0651-0018]

[50 FR 9382, Mar. 7, 1985, effective date May 8, 1985]

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

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

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

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

[50 FR 9382, Mar. 7, 1985, effective date May 8, 1985]

**§ 1.295 Review of decision finally refusing to publish a statutory invention registration.**

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

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

[OMB Control No. 0651-0018]

[50 FR 9382, Mar. 7, 1985, effective May 8, 1985]

**§ 1.296 Withdrawal of request for publication of statutory invention registration.**

A request for a statutory invention registration which has been filed, may be withdrawn prior to the date of the notice of intent to publish a statutory invention registration issued pursuant to § 1.294(c) by filing a request to withdraw the request for publication of a statutory invention registration. The request to withdraw may also include a request for a refund of any amount paid in excess of the application filing fee and a handling fee of \$100 which will be retained. Any request to withdraw the request for publication of a statutory invention registration filed on or after the date of the notice of intent to publish issued pursuant to § 1.294(c) must be in the form of a petition pursuant to § 1.183 accompanied by the fee set forth in § 1.17(h).

[OMB Control No. 0651-0018]

[50 FR 9382, Mar. 7, 1985, effective date May 8, 1985]

**§ 1.297 Publication of statutory invention registration.**

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

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

A statutory invention registration is not a patent. It has the defensive attributes of a patent but does not have the enforce-

able attributes of a patent. No article or advertisement or the like may use the term patent, or any term suggestive of a patent, when referring to a statutory invention registration. For more specific information on the rights associated with a statutory invention registration see 35 U.S.C. 157.

[50 FR 9383, Mar. 7, 1985, effective May 8, 1985; 50 FR 31826, Aug. 6, 1985, effective Oct. 5, 1985]

**REVIEW OF PATENT AND TRADEMARK OFFICE DECISIONS BY COURT**

**§ 1.301 Appeal to U.S. Court of Appeals for the Federal Circuit.**

Any applicant or any owner of a patent involved in a reexamination proceeding dissatisfied with the decision of the Board of Patent Appeals and Interferences, and any party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences, may appeal to the U.S. Court of Appeals for the Federal Circuit. The appellant must take the following steps in such an appeal: (a) In the Patent and Trademark Office file a written notice of appeal directed to the Commissioner (see §§ 1.302 and 1.304); and (b) in the Court, file a copy of the notice of appeal and pay the fee for appeal, as provided by the rules of the Court. The certified list of documents and any original or certified copies of such documents required by the Court will be transmitted to the Court by the Patent and Trademark Office.

[47 FR 47381, Oct. 26, 1982, effective Oct. 26, 1982; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; 50 FR 9383, Mar. 7, 1985, effective May 8, 1985]

**§ 1.302 Notice of appeal.**

(a) When an appeal is taken to the U.S. Court of Appeals for the Federal Circuit, the appellant shall give notice thereof to the Commissioner within the time specified in § 1.304.

(b) In interferences, the notice must be served as provided in § 1.646.

[24 FR 10332, Dec. 22, 1959; par. (a), 47 FR 47381, Oct. 26, 1982, effective Oct. 26, 1982; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; 50 FR 9383, Mar. 7, 1985, effective May 8, 1985]

**§ 1.303 Civil action under 35 U.S.C. 145, 146, 306.**

(a) Any applicant or any owner of a patent involved in a reexamination proceeding dissatisfied with the decision of the Board of Patent Appeals and Interferences, and any party dissatisfied with the decision of the Board of Patent Appeals and Interferences may, instead of appealing to the U.S. Court of Appeals for the Federal Circuit (§ 1.301), have remedy by civil action under 35 U.S.C. 145 or 146, as appropriate. Such civil action must be commenced within the time specified in § 1.304.

(b) If an applicant in an ex parte case or an owner of a patent involved in a reexamination proceeding has taken an appeal to the U.S. Court of Appeals for the Federal Circuit, he or she thereby waives his or her right to proceed under 35 U.S.C. 145.

(c) If any adverse party to an appeal taken to the U.S. Court of Appeals for the Federal Circuit by a defeated party in an interference proceeding files notice with the Commissioner within twenty days after the filing of the defeated party's notice

of appeal to the court (§ 1.302), that he or she elects to have all further proceedings conducted as provided in 35 U.S.C. 146, certified copies of such notices will be transmitted to the U.S. Court of Appeals for the Federal Circuit for such action as may be necessary. The notice of election must be served as provided in § 1.646.

[47 FR 47381, Oct. 26, 1982, effective Oct. 26, 1982; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985]

### § 1.304 Time for appeal or civil action.

(a) The time for filing the notice of appeal to the U.S. Court of Appeals for the Federal Circuit (§ 1.302) or for commencing a civil action (§ 1.303) is sixty days from the date of the decision of the Board of Patent Appeals and Interferences. If a request for reconsideration or modification of the decision is filed within the time period provided under § 1.197(b) or § 1.658(b), the time for filing an appeal or commencing a civil action shall expire at the end of the sixty-day period or thirty days after action on the request, whichever is later. Except for an appeal from or commencing a civil action after a decision of the Board of Patent Appeals and Interferences in a reexamination proceeding or an interference proceeding, the time periods set forth herein are subject to the provisions of § 1.136. See § 1.550(c) for extensions of time to appeal or commence a civil action in a reexamination proceeding. See § 1.645(a) for extensions of time to appeal or commence a civil action in an interference. An examiner-in-chief, upon a showing of excusable neglect, may extend the time for seeking judicial review of a decision of the Board of Patent Appeals and Interferences in an interference case when a request is untimely filed after expiration of the time prescribed by this section.

(b) The times specified herein are calendar days. If the last day of the time specified for appeal or commencing a civil action falls on a Saturday, Sunday or legal holiday, the time is extended to the next day which is neither a Saturday, Sunday nor a holiday.

(c) If a defeated party to an interference has taken an appeal to the U.S. Court of Appeals for the Federal Circuit and an adverse party has filed notice under 35 U.S.C. 141 that he or she elects to have all further proceedings conducted under 35 U.S.C. 146 (§ 1.303(c)), the time for filing a civil action thereafter is specified in 35 U.S.C. 141.

[41 FR 758, Jan. 5, 1976; para. (a) & (c), 47 FR 47382, Oct. 26, 1982; para. (a), 49 FR 556, Jan. 4, 1984, effective Apr. 1, 1984; para. (a) 49 FR Dec. 12, 1984, effective Feb. 11, 1985; para. (a), 50 FR 9383, Mar. 7, 1985, effective May 8, 1985]

## ALLOWANCE AND ISSUE OF PATENT

### § 1.311 Notice of Allowance.

(a) If, on examination, it shall appear that the applicant is entitled to a patent under the law, a notice of allowance will be sent to applicant at the correspondence address indicated in § 1.33, calling for the payment of a specified sum constituting the issue fee (§ 1.18), which shall be paid within 3 months from the date of the mailing of the notice of allowance.

(b) An authorization to charge the issue fee (§ 1.18) to a

deposit account may be filed in an individual application, either before or after mailing of the notice of allowance. Where an authorization to charge the issue fee to a deposit account has been filed before the mailing of the notice of allowance, the issue fee will be automatically charged to the deposit account at the time of mailing the notice of allowance.

[OMB Control No. 0651-0011]

[47 FR 41279, Sept. 17, 1982, effective date Oct. 1, 1982]

### § 1.312 Amendments after allowance.

(a) No amendment may be made as a matter of right in an application after the mailing of the notice of allowance. Any amendment pursuant to this paragraph filed before the payment of the issue fee may be entered on the recommendation of the primary examiner, approved by the Commissioner, without withdrawing the case from issue.

(b) Any amendment pursuant to paragraph (a) of this section filed after the date the issue fee is paid must be accompanied by a petition including the fee set forth in § 1.17(i) and a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

[47 FR 41280, Sept. 17, 1982]

### § 1.313 Withdrawal from issue.

(a) Applications may be withdrawn from issue for further action at the initiative of the Office or upon petition by the applicant. Any such petition by the applicant must include a showing of good and sufficient reasons why withdrawal of the application is necessary and, if the reason for the withdrawal is not the fault of the Office, must be accompanied by the fee set forth in § 1.17(i). If the application is withdrawn from issue, a new notice of allowance will be sent if the application is again allowed. Any amendment accompanying a petition to withdraw an application from issue must comply with the requirements of § 1.312.

(b) When the issue fee has been paid, and the patent to be issued has received its issue date and patent number, the application will not be withdrawn from issue for any reason except (1) mistake on the part of the Office, (2) a violation of § 1.56 or illegality in the application, (3) unpatentability of one or more claims, or (4) for interference.

[47 FR 41280, Sept. 17, 1982, effective Oct. 1, 1982]

### § 1.314 Issuance of patent.

If payment of the issue fee is timely made, the patent will issue in regular course unless (a) the application is withdrawn from issue (§ 1.313) or (b) issuance of the patent is deferred. Any petition by the applicant requesting a deferral of the issuance of a patent must be accompanied by the fee set forth in § 1.17(i) and must include a showing of good and sufficient reasons why it is necessary to defer issuance of the patent.

[OMB Control No. 0651-0011]

[47 FR 41280, Sept. 17, 1982, effective date Oct. 1, 1982]

### § 1.315 Delivery of patent.

The patent will be delivered or mailed on the day of its date to the attorney or agent of record, if there be one; or if the attorney or agent so request, to the patentee or assignee of an

interest therein; or, if there be no attorney or agent, to the patentee or to the assignee of the entire interest, if he so request.

**§ 1.316 Application abandoned for failure to pay issue fee.**

(a) If the issue fee is not paid within 3 months from the date of the notice of allowance, the application will be regarded as abandoned. Such an abandoned application will not be considered as pending before the Patent and Trademark Office.

(b) The Commissioner may accept the payment of the issue fee later than three months after the mailing of the notice of allowance as though no abandonment had ever occurred if upon petition the delay in payment is shown to have been unavoidable. The petition to accept the delayed payment must be promptly filed after the applicant is notified of, or otherwise becomes aware of, the abandonment, and must be accompanied by (1) the issue fee, unless it has been previously submitted, (2) the fee for delayed payment (§ 1.17(1)), and (3) a showing that the delay was unavoidable. Such showing must be a verified showing if made by a person not registered to practice before the Patent and Trademark Office.

(c) The Commissioner may, upon petition, accept the payment of the issue fee later than three months after the mailing of the notice of allowance as though no abandonment had ever occurred if the delay in payment was unintentional. The petition to accept the delayed payment must be filed within one year of the date on which the application became abandoned or be filed within three months of the date of the first decision on a petition under paragraph (b) of this section which was filed within one year of the date of abandonment of the application. The petition to accept the delayed payment must be accompanied by (1) the issue fee, unless it has been previously submitted, (2) the fee for unintentionally delayed payment (§ 1.17(m)), and (3) a statement that the delay was unintentional. Such statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office. The Commissioner may require additional information where there is a question whether the abandonment was unintentional. The three-month period from the date of the first decision referred to in this paragraph may be extended under the provisions of § 1.136(a), but no further extensions under § 1.136(b) will be granted. Petitions to the Commissioner under § 1.183 to waive any time periods for requesting revival of an unintentionally abandoned application will not be considered, but will be returned to the applicant.

(d) Any petition pursuant to paragraph (b) of this section not filed within six months of the date of abandonment must be accompanied by a terminal disclaimer with fee under § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application.

[47 FR 41280, Sept. 17, 1982]

**§ 1.317 Lapsed patents; delayed payment of balance of issue fee.**

(a) If the issue fee was paid prior to October 1, 1982, any remaining balance of the issue fee is to be paid within three

months from the date of notice thereof and, if not paid, the patent will lapse at the termination of the three month period.

(b) The Commissioner may accept the payment of the remaining balance of the issue fee later than three months after the mailing of the notice thereof as though no lapse had ever occurred if upon petition the delay in payment is shown to have been unavoidable. The petition to accept the delayed payment must be promptly filed after the applicant is notified of, or otherwise becomes aware of, the lapse, and must be accompanied by (1) the remaining balance of the issue fee, unless it has been previously submitted, (2) the fee for delayed payment (§ 1.17(1)), and (3) a showing that the delay was unavoidable. Such showing must be a verified showing if made by a person not registered to practice before the Patent and Trademark Office.

(c) The Commissioner may, upon petition, accept the payment of the remaining balance of the fee later than three months after the mailing of the notice thereof as though no lapse had ever occurred if the delay in payment was unintentional. The petition to accept the delayed payment must be filed within one year of the date on which the patent lapsed or be filed within three months of the date of the first decision on a petition under paragraph (b) of this section which was filed within one year of the date of the lapse of the patent. The petition to accept the delayed payment must be accompanied by (1) the remaining balance of the issue fee, unless it has been previously submitted, (2) the fee for unintentionally delayed payment (§ 1.17(m)), and (3) a statement that the delay was unintentional. Such statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office. The Commissioner may require additional information where there is a question whether the delay in payment was unintentional. The three-month period from the date of the first decision referred to in this paragraph may be extended under the provisions of § 1.136(a), but no further extensions under § 1.136(b) will be granted. Petitions to the Commissioner under § 1.183 to waive any time periods for requesting acceptance of an unintentionally delayed payment will not be considered, but will be returned to the applicant.

(d) Any petition pursuant to paragraph (b) of this section not filed within six months of the date of lapse must be accompanied by a terminal disclaimer with fee under § 1.321 dedicating to the public a terminal part of the term of the patent equivalent to the period of lapse of the patent.

[47 FR 41280, Sept. 17, 1982, effective date Oct. 1, 1982]

**§ 1.318 Notification of national publication of a patent based on an international application.**

The Office will notify the International Bureau when a patent is issued on an application filed under 35 U.S.C. 371, and there has been no previous international publication.

[43 FR 20465, May 11, 1978]

**DISCLAIMER**

**§ 1.321 Statutory disclaimer**

(a) A disclaimer under 35 U.S.C. 253 must be accompanied by the fee set forth in § 1.20(d) and identify the patent and the

claim or claims which are disclaimed, and be signed by the person making the disclaimer, who shall state therein the extent of his or her interest in the patent. A disclaimer which is not a disclaimer of a complete claim or claims may be refused recordation. A notice of the disclaimer is published in the *Official Gazette* and attached to the printed copies of the specification. In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

(b) A terminal disclaimer, when filed in an application to obviate a double patenting rejection, must be accompanied by the fee set forth in § 1.20(d) and include a provision that any patent granted on that application shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection.

[OMB Control No. 0651-0011]

[47 FR 41281, Sept. 17, 1982, effective Oct. 1, 1982]

### CORRECTION OF ERRORS IN PATENT

#### § 1.322 Certificate of correction of Office mistake.

(a) A certificate of correction under 35 U.S.C. 254 may be issued at the request of the patentee or the patentee's assignee. Such certificate will not be issued at the request or suggestion of anyone not owning an interest in the patent, nor on motion of the Office, without first notifying the patentee (including any assignee of record) and affording the patentee an opportunity to be heard. When the request relates to a patent involved in an interference, the request shall comply with the requirements of this section and shall be accompanied by a motion under § 1.635.

(b) If the nature of the mistake on the part of the Office is such that a certificate of correction is deemed inappropriate in form, the Commissioner may issue a corrected patent in lieu thereof as a more appropriate form for certificate of correction, without expense to the patentee.

[OMB Control No. 0651-0011]

[24 FR 10332, Dec. 22, 1959; 34 FR 5550, Mar. 22, 1969; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985]

#### § 1.323 Certificate of correction of applicant's mistake.

Whenever a mistake of a clerical or typographical nature or of minor character which was not the fault of the Office, appears in a patent and a showing is made that such mistake occurred in good faith, the Commissioner may, upon payment of the fee set forth in § 1.20(a), issue a certificate, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination. A request for a certificate of correction of a patent involved in an interference shall comply with the requirements of this section and shall be accompanied by a motion under § 1.635.

[34 FR 5550, Mar. 22, 1969; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985]

#### § 1.324 Correction of inventorship in patent.

Whenever a patent is issued and it appears that the correct

inventor or inventors were not named through error without deceptive intention on the part of the actual inventor or inventors, the Commissioner may, on petition of all the parties and the assignees and satisfactory proof of the facts and payment of the fee set forth in § 1.20(b), or on order of a court before which such matter is called in question, issue a certificate naming only the actual inventor or inventors. A request to correct inventorship of a patent involved in an interference shall comply with the requirements of this section and shall be accompanied by a motion under § 1.634.

[OMB Control No. 0651-0011]

[47 FR 41281, Sept. 17, 1982, effective Oct. 1, 1982; 48 FR 2713, Jan. 20, 1983, effective Feb. 27, 1983; 49 FR 48416, Dec. 12, 1984; 50 FR 23123, May 31, 1985, effective Feb. 11, 1985]

#### § 1.325 Other mistakes not corrected.

Mistakes other than those provided for in §§ 1.322, 1.323, 1.324, and not affording legal grounds for reissue or for reexamination, will not be corrected after the date of the patent.

[48 FR 2714, Jan. 20, 1983, effective date Feb. 27, 1983]

### ASSIGNMENTS AND RECORDING

#### § 1.331 Recording of assignments.

(a) Assignments, including grants and conveyances, of patents, national applications, or international applications which designate the United States of America, will be recorded in the Patent and Trademark Office under 35 U.S.C. 261. Other instruments affecting title to a patent, a national application, or an international application which designates the United States of America, and licenses, even though the recording thereof may not serve as constructive notice under 35 U.S.C. 261, will be recorded as provided in this section or at the discretion of the Commissioner. Any instrument to be recorded, except those under Part 7 of this title, must be accompanied by the fee set forth in § 1.21(h).

(b) No instrument will be recorded which is not in the English language and which does not amount to an assignment, grant, mortgage, lien, incumbrance, or license, or which does not affect the title of the patent or invention to which it relates, and which does not identify the patent or application to which it relates, except as ordered by the Commissioner.

(c) An instrument relating to a patent should identify the patent by number and date (the name of the inventor and title of the invention as stated in the patent should also be given); an instrument relating to a national application, or an international application which designates the United States of America should identify the application by serial number or international application number and date of filing (the name of the inventor and title of the invention as stated in the application should also be given) but if an assignment is executed concurrently with or subsequent to the execution of the application but before the application is filed or before its serial number or international application number and filing date are ascertained, it should adequately identify the application, as by its date of execution and name of the inventor and title of the invention; so that there can be no mistake as to the patent or application intended.

[24 FR 10332, Dec. 22, 1959; 43 FR 20465, May 11, 1978; 47 FR 41281, Sept. 17, 1982]

### § 1.332 Receipt and recording.

Assignments are recorded in regular order as promptly as possible, and then transmitted with the date and identification of the record stamped thereon to the persons entitled to them. The date of record is the date of the receipt of the assignment at the Office in proper form and accompanied by the fee set forth in § 1.21(h).

[47 FR 41281, Sept. 17, 1982]

### § 1.333 Conditional assignments.

Assignments which are made conditional on the performance of certain acts or events, as the payment of money or other condition subsequent, if recorded in the Office are regarded as absolute assignments for Office purposes until cancelled with the written consent of both parties or by the decree of a competent court. The Office has no means for determining whether such conditions have been fulfilled.

### § 1.334 Issue of patent to assignee.

(a) In case of an assignment of the entire interest in the invention and application, or of the entire interest in the patent to be granted, the patent will normally issue to the assignee. If the assignee should hold an undivided part interest, the patent will normally issue jointly to the inventor and the assignee. If it is desired that the patent so issue, the assignment in either case must first have been recorded, and at a day not later than the date payment is made of the issue fee.

(b) At the time of payment of the issue fee, a statement must be furnished indicating whether or not an assignment has been filed with the Patent and Trademark Office. In the event an assignment has been filed, such statement must include the name and address of the assignee and indicate whether or not an acknowledgment of a recorded assignment has been received from the Patent and Trademark Office.

(c) If the assignment is recorded after the date of payment of the issue fee, the assignee may petition that the patent issue to the assignee as recorded. Any such petition must be accompanied by the fee set forth in § 1.17(i).

[47 FR 41281, Sept. 17, 1982, effective Oct. 1, 1982]

### § 1.335 Filing of notice of arbitration awards.

(a) Written notice of any award by an arbitrator pursuant to 35 U.S.C. 294 must be filed in the Patent and Trademark Office by the patentee, or the patentee's assignee or licensee. If the award involves more than one patent a separate notice must be filed for placement in the file of each patent. The notice must set forth the patent number, the names of the inventor and patent owner, and the names and addresses of the parties to the arbitration. The notice must also include a copy of the award.

(b) If an award by an arbitrator pursuant to 35 U.S.C. 294 is modified by a court, the party requesting the modification must file in the Patent and Trademark Office, a notice of the modification for placement in the file of each patent to which the modification applies. The notice must set forth the patent

number, the names of the inventor and patent owner, and the names and addresses of the parties to the arbitration. The notice must also include a copy of the court's order modifying the award.

(c) Any award by an arbitrator pursuant to 35 U.S.C. 294 shall be unenforceable until any notices required by paragraph (a) or (b) of this section are filed in the Patent and Trademark Office. If any required notice is not filed by the party designated in paragraph (a) or (b) of this section, any party to the arbitration proceeding may file such a notice.

[48 FR 2718, Jan. 20, 1983, effective Feb. 8, 1983]

## AMENDMENT OF RULES

### § 1.351 Amendments to rules will be published.

All amendments to the regulations in this part will be published in the *Official Gazette* and in the Federal Register.

### § 1.352 Publication of notice of proposed amendments.

(a) Whenever required by law, and in other cases whenever practicable, notice of proposed amendments to the regulations in this part will be published in the *Official Gazette* and in the Federal Register. If not published with the notice, copies of the text will be furnished to any person requesting the same. All comments, suggestions, and briefs received within a time specified in the notice will be considered before adoption of the proposed amendments which may be modified in the light thereof.

(b) Oral hearings may be held at the discretion of the Commissioner.

## MAINTENANCE FEES

### § 1.362 Time for payment of maintenance fees.

(a) Maintenance fees as set forth in § 1.20(e)-(j) are required to be paid in all patents based on applications filed on or after December 12, 1980, except as noted in paragraph (b) of this section, to maintain a patent in force beyond 4, 8 and 12 years after the date of grant.

(b) Maintenance fees are not required for plant patents based on applications filed on or after August 27, 1982 or for any design patents. Maintenance fees are not required for a reissue patent if the patent being reissued did not require maintenance fees.

(c) The application filing dates for purposes of payment of maintenance fees are as follows:

(1) For an application not claiming benefit of an earlier application, the actual United States filing date of the application.

(2) For an application claiming benefit of an earlier foreign application under 35 U.S.C. 119, the United States filing date of the application.

(3) For a continuing (continuation, division, continuation-in-part) application claiming the benefit of a prior patent application under 35 U.S.C. 120, the actual United States filing date of the continuing application.

(4) For a reissue application, the United States filing date of the original non-reissue application on which the patent reissued is based.

(5) For an international application which has entered the United States as a Designated Office under 35 U.S.C. 371, the international filing date granted under Article 11(1) of the Patent Cooperation Treaty which is considered to be the United States filing date under 35 U.S.C. 363.

(d) Maintenance fees may be paid in patents without surcharge during the periods extending respectively from:

(1) 3 years through 3 years and 6 months after grant for the first maintenance fee,

(2) 7 years through 7 years and 6 months after grant for the second maintenance fee, and

(3) 11 years through 11 years and 6 months after grant for the third maintenance fee.

(e) Maintenance fees may be paid with the surcharge set forth in § 1.20(k) or (l) during the respective grace periods after:

(1) 3 years and 6 months and through the day of the 4th anniversary of the grant for the first maintenance fee.

(2) 7 years and 6 months and through the day of the 8th anniversary of the grant for the second maintenance fee, and

(3) 11 years and 6 months and through the day of the 12th anniversary of the grant for the third maintenance fee.

(f) If the last day for paying a maintenance fee without surcharge set forth in paragraph (d) of this section, or the last day for paying a maintenance fee with surcharge set forth in paragraph (e) of this section, falls on a Saturday, Sunday, or a federal holiday within the District of Columbia, the maintenance fee and any necessary surcharge may be paid under paragraph (d) or paragraph (e) respectively on the next succeeding day which is not a Saturday, Sunday, or federal holiday.

(g) Unless the maintenance fee and any applicable surcharge is paid within the time periods set forth in paragraphs (d), (e) or (f) of this section, the patent will expire as of the end of the grace period set forth in paragraph (e) of this section. A patent which expires for the failure to pay the maintenance fee will expire at the end of the same date (anniversary date) the patent was granted in the 4th, 8th, or 12th year after grant.

[49 FR 34724, Aug. 31, 1984, added effective Nov. 1, 1984]

### § 1.363 Fee address for maintenance fee purposes.

(a) All notices, receipts, refunds, and other communications relating to payment or refund of maintenance fees will be directed to the correspondence address used during prosecution of the application as indicated in § 1.33(a) unless:

(1) A "fee address" for purposes of payment of maintenance fees is set forth when submitting the issue fee, or

(2) A change in the correspondence address for all purposes is filed after payment of the issue fee, or

(3) A "fee address" or a change in the "fee address" is filed for purposes of receiving notices, receipts and other correspondence relating to the payment of maintenance fees after the payment of the issue fee, in which instance, the latest such address will be used.

(b) An assignment of a patent application or patent does not result in a change of the "correspondence address" or "fee

address" for maintenance fee purposes.

[49 FR 34725, Aug. 31, 1984, added effective Nov. 1, 1984]

### § 1.366 Submission of maintenance fees.

(a) The patentee may pay maintenance fees and any necessary surcharges, or any person or organization may pay maintenance fees and any necessary surcharges on behalf of a patentee. Authorization by the patentee need not be filed in the Patent and Trademark Office to pay maintenance fees and any necessary surcharges on behalf of the patentee.

(b) A maintenance fee and any necessary surcharge submitted for a patent must be submitted in the amount due on the date the maintenance fee and any necessary surcharge are paid and may be paid in the manner set forth in § 1.23 or by an authorization to charge a deposit account established pursuant to § 1.25. Payment of a maintenance fee and any necessary surcharge or the authorization to charge a deposit account must be submitted within the periods set forth in § 1.362(d), (e) or (f). Any payment or authorization of maintenance fees and surcharges filed at any other time will not be accepted and will not serve as a payment of the maintenance fee except insofar as a delayed payment of the maintenance fee is accepted by the Commissioner in an expired patent pursuant to a petition filed under § 1.378. Any authorization to charge a deposit account must authorize the immediate charging of the maintenance fee and any necessary surcharge to the deposit account. Payment of less than the required amount, payment in a manner other than that set forth in § 1.23, or the filing of an authorization to charge a deposit account having insufficient funds will not constitute payment of a maintenance fee or surcharge on a patent. The certificate of mailing procedures of either § 1.8 or § 1.10 may be utilized in paying maintenance fees and any necessary surcharges.

(c) In submitting maintenance fees and any necessary surcharges, identification of the patents for which maintenance fees are being paid must include the following:

(1) The patent number, and

(2) The serial number of the United States application for the patent on which the maintenance fee is being paid.

(d) Payments of maintenance fees and any surcharges should identify the fee being paid for each patent as to whether it is the 3 1/2, 7 1/2 or 11 1/2 year fee, whether small entity status is being changed or claimed, the amount of the maintenance fee and any surcharge being paid, any assigned payor number, the patent issue date and the United States application filing date. If the maintenance fee and any necessary surcharge is being paid on a reissue patent, the payment must identify the reissue patent by reissue patent number and reissue application serial number as required by paragraph (c) of this section and should also include the original patent number, the original patent issue date and the original United States application filing date.

(e) Maintenance fee payments and surcharge payments relating thereto must be submitted separate from any other payments for fees or charges, whether submitted in the manner set forth in § 1.23 or by an authorization to charge a deposit account. If maintenance fee and surcharge payments for more than one patent are submitted together, they should be submitted on as few sheets as possible with the patent numbers listed in in-



creasing patent number order. If the payment submitted is insufficient to cover the maintenance fees and surcharges for all the listed patents, the payment will be applied in the order the patents are listed, beginning at the top of the listing.

(f) Notification of any change in status resulting in loss of entitlement to small entity status must be filed in a patent prior to paying, or at the time of paying, the earliest maintenance fee due after the date on which status as a small entity is no longer appropriate. See § 1.28(b).

(g) Maintenance fees and surcharges relating thereto will not be refunded except in accordance with §§ 1.26 and 1.28(a). [49 FR 34725, Aug. 31, 1984, added effective Nov. 1, 1984]

**§ 1.377 Review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of patent.**

(a) Any patentee who is dissatisfied with the refusal of the Patent and Trademark Office to accept and record a maintenance fee which was filed prior to the expiration of the patent may petition the Commissioner to accept and record the maintenance fee.

(b) Any petition under this section must be filed within 2 months of the action complained of, or within such other time as may be set in the action complained of, and must be accompanied by the fee set forth in § 1.17(h). The petition may include a request that the petition fee be refunded if the refusal to accept and record the maintenance fee is determined to result from an error by the Patent and Trademark Office.

(c) Any petition filed under this section must comply with the requirements of paragraph (b) of § 1.181 and must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest. Such petition must be in the form of a verified statement if made by a person not registered to practice before the Patent and Trademark Office.

[49 FR 34725, Aug. 31, 1984, added effective Nov. 1, 1984]

**§ 1.378 Acceptance of delayed payment of maintenance fee in expired patent to reinstate patent.**

(a) The Commissioner may accept the payment of any maintenance fee due on a patent after expiration of the patent if, upon petition, the delay in payment of the maintenance fee is shown to the satisfaction of the Commissioner to have been unavoidable and if the surcharge required by § 1.20(m) is paid as a condition of accepting payment of the maintenance fee. If the Commissioner accepts payment of the maintenance fee upon petition, the patent shall be considered as not having expired, but will be subject to the conditions set forth in 35 U.S.C. 41(c)(2).

(b) Any petition to accept the delayed payment of a maintenance fee filed under paragraph (a) of this section within six months of the expiration of the patent must include:

- (1) The required maintenance fee set forth in § 1.20(h) - (j);
- (2) The surcharge set forth in § 1.20(m); and
- (3) A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be timely paid. The showing must enumerate the steps taken to

ensure timely payment of the maintenance fee.

(c) Any petition to accept the delayed payment of a maintenance fee filed under paragraph (a) of this section more than six months after the expiration of the patent must include:

- (1) The required maintenance fee set forth in § 1.20(h) - (j);
- (2) The surcharge set forth in § 1.20(m); and
- (3) A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and the failure to timely pay the maintenance fee was due entirely to circumstances outside of the control of the patentee. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee and the circumstances which were outside of the control of the patentee and those acting on behalf of the patentee in paying the maintenance fee. The showing must be sufficient in scope and content to meet the heavy burden of proof required to show that a delay in payment of the maintenance fee of more than six months after expiration of the patent was unavoidable.

(d) Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest. Such petition must be in the form of a verified statement if made by a person not registered to practice before the Patent and Trademark Office.

(e) Reconsideration of a decision refusing to accept a maintenance fee upon petition filed pursuant to paragraph (a) of this section may be obtained by filing a petition for reconsideration within two months of, or such other time as set in, the decision refusing to accept the delayed payment of the maintenance fee. Any such petition for reconsideration must be accompanied by the petition fee set forth in § 1.17(h). After decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. If the delayed payment of the maintenance fee is not accepted, the maintenance fee and the surcharge set forth in § 1.20(m) will be refunded following the decision on the petition for reconsideration, or after the expiration of the time for filing such a petition for reconsideration, if none is filed. The fee set forth in § 1.17(h) for filing the petition for reconsideration will not be refunded unless the refusal to accept and record the maintenance fee is determined to result from an error by the Patent and Trademark Office.

[49 FR 34726, Aug. 31, 1984, added effective Nov. 1, 1984; para. (a), 50 FR 9383, Mar. 7, 1985, effective May 8, 1985]

**Subpart C - International Processing Provisions**

**GENERAL INFORMATION**

**§ 1.401 Definitions of terms under the Patent Cooperation Treaty.**

(a) The abbreviation "PCT" and the term "Treaty" mean the Patent Cooperation Treaty.

(b) "International Bureau" means the World Intellectual Property Organization located in Geneva, Switzerland.

(c) "Administrative Instructions" means that body of instructions for operating under the Patent Cooperation Treaty referred to in PCT Rule 89.

(d) "Request", when capitalized, means that element of the international application described in PCT Rules 3 and 4.

(e) "International application", as used in this subchapter is defined in § 1.9(b).

(f) "Priority date" for the purpose of computing time limits under the Patent Cooperation Treaty is defined in PCT Art. 2(xi). Note also § 1.465.

(g) "Demand," when capitalized, means that document filed with the International Preliminary Examining Authority which requests an international preliminary examination.

(h) "Annexes" means amendments made to the claims, description or the drawings before the International Preliminary Examining Authority.

(i) Other terms and expressions in this Subpart C not defined in this section are to be taken in the sense indicated in PCT Article 2 and 35 U.S.C. 351.

[OMB Control No. 0651-0011]

[43 FR 20466, May 11, 1978; 52 FR 20047, May 28, 1987, effective July 1, 1987]

#### § 1.412 The United States Receiving Office.

(a) The United States Patent and Trademark Office is a Receiving Office only for applicants who are residents or nationals of the United States of America.

(b) The Patent and Trademark Office, when acting as a Receiving Office, will be identified by the full title "United States Receiving Office" or by the abbreviation "RO/US."

(c) The major functions of the Receiving Office include:

(1) According of international filing dates to international applications meeting the requirements of PCT Art. 11(1), and PCT Rule 20;

(2) Assuring that international applications meet the standards for format and content of PCT Art. 14(1), PCT Rule 9, 26, 29.1, 37, 38, 91, and portions of PCT Rules 3 through 11;

(3) Collecting and, when required, transmitting fees due for processing international applications (PCT Rule 14, 15, 16);

(4) Transmitting the record and search copies to the International Bureau and International Searching Authority, respectively (PCT Rules 22 and 23); and

(5) Determining compliance with applicable requirements of Part 5 of this chapter.

[OMB Control No. 0651-0011]

#### § 1.413 The United States International Searching Authority.

(a) Pursuant to appointment by the Assembly, the United States Patent and Trademark Office will act as an International Searching Authority for international applications filed in the United States Receiving Office and in other Receiving Offices as may be agreed upon by the Commissioner, in accordance with agreement between the Patent and Trademark Office and the International Bureau (PCT Art. 16(3)(b)).

(b) The Patent and Trademark Office, when acting as an International Searching Authority, will be identified by the full title "United States International Searching Authority" or by the abbreviation "ISA/US."

(c) The major functions of the International Searching Authority include:

(1) Approving or establishing the title and abstract;

(2) Considering the matter of unity of invention;

(3) Conducting international and international-type searches and preparing international and international-type search reports (PCT Art. 15, 17 and 18, and PCT Rules 25, 33 to 45 and 47); and

(4) Transmitting the international search report to the applicant and the International Bureau.

[OMB Control No. 0651-0011]

#### § 1.414 The United States Patent and Trademark Office as a Designated Office or Elected Office.

(a) The United States Patent and Trademark Office will act as a Designated Office or Elected Office for international applications in which the United States of America has been designated or elected as a State in which patent protection is desired.

(b) The United States Patent and Trademark Office, when acting as a Designated Office or Elected Office during international processing will be identified by the full title "United States Designated Office" or by the abbreviation "DO/US" or by the full title "United States Elected Office" or by the abbreviation "EO/US".

(c) The major functions of the United States Designated Office or Elected Office in respect to international applications in which the United States of America has been designated or elected, include:

(1) Receiving various notifications throughout the international stage; and

(2) Accepting for national stage examination international applications which satisfy the requirements of 35 U.S.C. 371.

[OMB Control No. 0651-0011]

[52 FR 20047, May 28, 1987]

#### § 1.415 The International Bureau.

(a) The International Bureau is the World Intellectual Property Organization located at Geneva, Switzerland. It is the international intergovernmental organization which acts as the coordinating body under the Treaty and the Regulations (PCT Art. 2 (xix) and 35 U.S.C. 351(h)).

(b) The major functions of the International Bureau include:

(1) Publishing of international applications and the International Gazette;

(2) Transmitting copies of international applications to Designated Offices;

(3) Storing and maintaining record copies; and

(4) Transmitting information to authorities pertinent to the processing of specific international applications.

[OMB Control No. 0651-0011]

**§ 1.416 The United States International Preliminary Examining Authority.**

(a) Pursuant to appointment by the Assembly, the United States Patent and Trademark Office will act as an International Preliminary Examining Authority for international applications filed in the United States Receiving Office and in other Receiving Offices as may be agreed upon by the Commissioner, in accordance with agreement between the Patent and Trademark Office and the International Bureau.

(b) The United States Patent and Trademark Office, when acting as an International Preliminary Examining Authority, will be identified by the full title "United States International Preliminary Examining Authority" or by the abbreviation "IPEA/US."

(c) The major functions of the International Preliminary Examining Authority include:

- (1) Receiving and checking for defects in the Demand;
- (2) Collecting the handling fee for the International Bureau and the preliminary examination fee for the United States International Preliminary Examining Authority;
- (3) Informing applicant of receipt of the Demand;
- (4) Considering the matter of unity of invention;
- (5) Providing an international preliminary examination report which is a non-binding opinion on the questions whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), and to be industrially applicable; and

(6) Transmitting the international preliminary examination report to applicant and the International Bureau.

[52 FR 20047, May 28, 1987, effective July 1, 1987]

**WHO MAY FILE AN INTERNATIONAL APPLICATION**

**§ 1.421 Applicant for international application.**

(a) Only residents or nationals of the United States of America may file international applications in the United States Receiving Office.

(b) Although the United States Receiving Office will accept international applications filed by any resident or national of the United States of America for international processing, an international application designating the United States of America will be accepted by the Patent and Trademark Office for the national stage only if filed by the inventor or as provided in §§ 1.422, 1.423 or 1.425.

(c) International applications which do not designate the United States of America may be filed by the assignee or owner.

(d) The attorney or agent of the applicant may sign the international application Request and file the international application for the applicant if the international application when filed is accompanied by a separate power of attorney to that attorney or agent from the applicant. The separate power of attorney from the applicant may be submitted after filing if sufficient cause is shown for not submitting it at the time of filing. Note that paragraph (b) of this section requires that the applicant be the inventor if the United States of America is designated.

(e) Any indication of different applicants for the purpose of

different Designated Offices must be shown on the Request portion of the international application.

(f) Changes in the person, name, or address of the applicant of an international application shall be made in accordance with PCT Rule 18.5.

[OMB Control No. 0651-0011]

**§ 1.422 When the inventor is dead.**

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may file an international application which designates the United States of America.

[OMB Control No. 0651-0011]

**§ 1.423 When the inventor is insane or legally incapacitated.**

In case an inventor is insane or otherwise legally incapacitated, the legal representative (guardian, conservator, etc.) of such inventor may file an international application which designates the United States of America.

[OMB Control No. 0651-0011]

**§ 1.424 Joint inventors.**

Joint inventors must jointly file an international application which designates the United States of America; the signature of either of them alone, or less than the entire number will be insufficient for an invention invented by them jointly, except as provided in § 1.425.

[OMB Control No. 0651-0011]

**§ 1.425 Filing by other than inventor.**

(a) If a joint inventor refuses to join in an international application which designates the United States of America or cannot be found or reached after diligent effort, the international application which designates the United States of America may be filed by the other inventor on behalf of himself or herself and the omitted inventor. Such an international application which designates the United States of America must be accompanied by proof of the pertinent facts and must state the last known address of the omitted inventor. The Patent and Trademark Office shall forward notice of the filing of the international application to the omitted inventor at said address.

(b) Whenever an inventor refuses to execute an international application which designates the United States of America, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action may file the international application on behalf of and as agent for the inventor. Such an international application which designates the United States of America must be accompanied by proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, and must state the last known address of the inventor. The assignment, written agreement to assign or other evidence of proprietary interest, or a verified copy thereof, must be filed in the Patent and Trademark Office. The Office shall forward notice of

the filing of the application to the inventor at the address stated in the application.

[OMB Control No. 0651-0011]

## THE INTERNATIONAL APPLICATION

### § 1.431 International application requirements.

(a) An international application shall contain, as specified in the Treaty and the Regulations, a Request, a description, one or more claims, an abstract, and one or more drawings (where required). (PCT Art. 3(2) and Section 207 of the Administrative Instructions.)

(b) An international filing date will be accorded by the United States Receiving Office, at the time of receipt of the international application, provided that:

(1) The applicant is a United States resident or national (35 U.S.C. 361(a), PCT Art. 11(1)(i)).

(2) The international application is in the English language (35 U.S.C. 361(c), PCT Art. 11(1)(ii)).

(3) The international application contains at least the following elements (PCT Art. 11(1)(iii)):

(i) An indication that it is intended as an international application (PCT Rule 4.2);

(ii) The designation of at least one Contracting State of the International Patent Cooperation Union;

(iii) The name of the applicant, as prescribed (note §§ 1.421-1.424);

(iv) A part which on the face of it appears to be a description; and

(v) A part which on the face of it appears to be a claim.

(c) Payment of the basic portion of the international fee (PCT Rule 15.2) and the transmittal and search fees (§ 1.445) may be made in full at the time the international application papers required by paragraph (b) of this section are deposited or within one month thereafter. Failure to make full payment within one month of the deposit of the international application papers required by paragraph (b) of this section will result in the fees being charged to the International Bureau under the provisions of paragraph (d) of this section and PCT Rule 16 bis.

(d) The United States Receiving Office will charge to the International Bureau in accordance with PCT Rule 16 bis and will consider as having been timely paid:

(1) The transmittal fee, the basic fee portion of the international fee, or the search fee where these fees have not been fully paid by the applicant within one month of the date of deposit of the international application, and

(2) The designation fee, or the amount necessary to cover all the designations made in the request if not paid by the applicant within one year from the priority date or within one month from the date of receipt of the international application if that month expires after the expiration of one year from the priority date.

(e) The International Bureau will notify applicant of any amount charged under paragraph (d) of this section and invite the applicant to pay directly to the International Bureau within one month from the date of the notification, the amount charged, augmented by a surcharge of 50%, provided the surcharge will

not be less, and will not be more, than the amounts indicated in the Schedule of Fees appended to the PCT Rules. If the payment needed to cover the transmittal fees, the basic fee, one designation fee and the surcharge is not timely made to the International Bureau, the International Bureau will notify the Receiving Office which will declare the international application withdrawn under PCT Article 14(3)(a). If the applicant makes timely payment of the fees referred to in the previous sentence, but the amount paid is not sufficient to cover all designation fees, the Receiving Office will declare any designation not paid withdrawn under PCT Rule 14(3)(b) in accordance with PCT Rule 16 bis, 2(c).

[OMB Control No. 0651-0011]

[43 FR 20486, May 11, 1978; paras. (b), (c), (d) & (e), 50 FR 9383, Mar. 7, 1985, effective May 8, 1985; 52 FR 20047, May 28, 1987, effective July 1, 1987]

### § 1.432 Designation of States and payment of designation fees.

(a) The names of Designated States shall appear in the Request upon filing and must be indicated as set forth in Section 201 of the Administrative Instructions.

(b) The designation fees may be paid upon filing of the international application, but must be paid before the expiration of one year from the priority date or within one month from the date of receipt of the international application if that month expires after the expiration of one year from the priority date. Failure to timely pay the designation fee for a particular Designated State will result in the withdrawal of that designation. Failure to timely pay at least one designation fee will result in the withdrawal of the international application.

[OMB Control No. 0651-0011]

[43 FR 20466, May 11, 1978; 52 FR 20047, May 28, 1987, effective July 1, 1987]

### § 1.433 Physical requirements of international application.

(a) The international application and each of the documents that may be referred to in the check list of the Request (PCT Rule 3.3(a)(ii)) shall be filed in one copy only.

(b) All sheets of the international application must be on A4 size paper (21.0 x 29.7 cm.).

(c) Other physical requirements for international applications are set forth in PCT Rule 11 and Sections 201-207 of the Administrative Instructions.

[OMB Control No. 0651-0011]

### § 1.434 The request.

(a) The request shall be made on a standardized printed form (PCT Rules 3 and 4). Copies of such printed Request forms are available from the Patent and Trademark Office. Letters requesting such forms should be marked "Box PCT."

(b) The Check List portion of the Request form should indicate each document accompanying the international application on filing.

(c) All information, for example, addresses, names of States and dates, shall be indicated in the Request as required by PCT Rule 4 and Administrative Instructions 110 and 201.

(d) International applications which designate the United States of America shall include:

(1) The name, address and signature of the inventor, except as provided by §§ 1.421(d), 1.422, 1.423 and 1.425;

(2) A reference to any copending national application or international application designating the United States of America, if the benefit of the filing date for the prior copending application is to be claimed.

[OMB Control No. 0651-0011]

**§ 1.435 The description.**

(a) Requirements as to the content and form of the description are set forth in PCT Rules 5, 9, 10 and 11 and Administrative Instruction 204, and shall be adhered to.

(b) In international applications designating the United States the description must contain upon filing an indication of the best mode contemplated by the inventor for carrying out the claimed invention.

[OMB Control No. 0651-0011]

**§ 1.436 The claims.**

The requirements as to the content and format of claims are set forth in PCT Art. 6 and PCT Rules 6, 9, 10 and 11 and shall be adhered to. The number of the claims shall be reasonable, considering the nature of the invention claimed.

[OMB Control No. 0651-0011]

**§ 1.437 The drawings.**

(a) Subject to paragraph (b) of this section, when drawings are necessary for the understanding of the invention, or are mentioned in the description, they must be part of an international application as originally filed in the United States Receiving Office in order to maintain the international filing date during the national stage (PCT Art. 7).

(b) Drawings missing from the application upon filing will be accepted if such drawings are received within 30 days of the date of first receipt of the incomplete papers. If the missing drawings are received within the 30-day period, the international filing date shall be the date on which such drawings are received. If such drawings are not timely received, all references to drawings in the international application shall be considered non-existent (PCT Art. 14(2), Administrative Instruction 310).

(c) The physical requirements for drawings are set forth in PCT Rule 11 and shall be adhered to.

[OMB Control No. 0651-0011]

**§ 1.438 The abstract.**

(a) Requirements as to the content and form of the abstract are set forth in PCT Rule 8, and shall be adhered to.

(b) Lack of an abstract upon filing of an international application will not affect the granting of a filing date. However, failure to furnish an abstract within one month from the date of the notification by the Receiving Office will result in the international application being declared withdrawn.

[OMB Control No. 0651-0011]

FEES

**§ 1.445 International application filing, processing and search fees.**

(a) The following fees and charges for international applications are established by the Commissioner under the authority of 35 U.S.C. 376:

(1) A transmittal fee (see 35 U.S.C. 361(d) and PCT Rule 14) ..... \$170.00

(2) A search fee (see 35 U.S.C. 361(d) and PCT Rule 16) where:

(i) No corresponding prior United States national application with basic filing fee has been filed ..... \$520.00

(ii) A corresponding prior United States national application with basic filing fee has been filed ..... \$350.00

(3) A supplemental search fee when required, per additional invention ..... \$140.00

(b) The basic fee and designation fee portion of the international fee shall be as prescribed in PCT Rule 15.

[OMB Control No. 0651-0011]

[43 FR 20466, May 11, 1978; para. (a), 47 FR 41282, Sept. 17, 1982, effective Oct. 1, 1982; para (a)(4)-(6), 50 FR 9384, Mar. 7, 1985, effective May 8, 1985; 50 FR 31826, Aug. 6, 1985, effective Oct. 5, 1985; 52 FR 20047, May 28, 1987, effective July 1, 1987]

**§ 1.446 Refund of international application filing and processing fees.**

(a) Money paid for international application fees, where paid by actual mistake or in excess, such as a payment not required by law or Treaty and its Regulations, will be refunded.

(b) [Reserved]

(c) Refund of the supplemental search fees will be made if such refund is determined to be warranted by the Commissioner or the Commissioner's designee acting under PCT Rule 40.2(c).

(d) The international and search fees will be refunded if no international filing date is accorded (PCT Rules 15.6 and 16.2).

[OMB Control No. 0651-0011]

[43 FR 20466, May 11, 1978; para. (b), 47 FR 41282, Sept. 17, 1982, effective Oct. 1, 1982; para (b), 50 FR 9384, Mar. 7, 1985, effective May 8, 1985; 50 FR 31826, Aug. 6, 1985, effective Oct. 5, 1985]

PRIORITY

**§ 1.451 The priority claim and priority document in an international application.**

(a) The claim for priority must be made on the Request (PCT Rule 4.10) in a manner complying with Sections 110 and 201 of the Administrative Instructions.

(b) Whenever the priority of an earlier United States national application is claimed in an international application, the applicant may request in a letter of transmittal accompanying the international application upon filing with the United States Receiving Office, or in a separate letter filed in the Receiving Office not later than 16 months after the priority date, that the Patent and Trademark Office prepare a certified copy of the national application for transmittal to the International Bureau (PCT Art. 8 and PCT Rule 17). The fee for preparing a certified copy is stated in § 1.19(a)(3) and (b)(1).

(c) If a certified copy of the priority document is not submitted together with the international application on filing, or, if the priority application was filed in the United States and a request and appropriate payment for preparation of such a certified copy do not accompany the international application on filing or are not filed within 16 months of the priority date, the certified copy of the priority document must be furnished by the applicant to the International Bureau or to the United States Receiving Office within the time limit specified in PCT Rule 17.1(a).

[43 FR 20466, May 11, 1978; 47 FR 40140, Sept. 10, 1982, effective Oct. 1, 1982; para (b), 47 FR 41282, Sept. 17, 1982, effective Oct. 1, 1982; paras. (b) & (c), 50 FR 9384, Mar. 7, 1985, effective May 8, 1985; 50 FR 11366, Mar. 21, 1985]

## REPRESENTATION

### § 1.455 Representation in international applications.

(a) Applicants of international applications may be represented by attorneys or agents licensed to practice before the Patent and Trademark Office or by a common representative (PCT Art. 49, Rules 4.8 and 90 and § 10.10).

(b) Appointment of an agent, attorney or common representative (PCT Rule 4.8) must be effected either in the Request form, signed by all applicants, or in a separate power of attorney submitted either to the United States Receiving Office or to the International Bureau.

(c) Powers of attorney and revocations thereof should be submitted to the United States Receiving Office until the issuance of the international search report.

(d) The addressee for correspondence will be as indicated in Section 108 of the Administrative Instructions.

[OMB Control No. 0651-0011]

[43 FR 20466, May 11, 1978; 50 FR 5171, Mar. 7, 1985, effective May 8, 1985]

## TRANSMITTAL OF RECORD COPY

### § 1.461 Procedures for transmittal of record copy to the International Bureau.

(a) Transmittal of the record copy of the international application to the International Bureau shall be made by the United States Receiving Office.

(b) [Reserved]

(c) No copy of an international application may be transmitted to the International Bureau, a foreign Designated Office, or other foreign authority by the United States Receiving Office or the applicant, unless the applicable requirements of Part 5 of this chapter have been satisfied.

[OMB Control No. 0651-0011]

[43 FR 20466, May 11, 1978; paras. (a) & (b), 50 FR 9384, Mar. 7, 1985, effective May 8, 1985]

## TIMING

### § 1.465 Timing of application processing based on the priority date.

(a) For the purpose of computing time limits under the

Treaty, the priority date shall be defined as in PCT Art. 2(xi).

(b) When a claimed priority date is cancelled under PCT Rule 4.10(d), or considered not to have been made under PCT Rule 4.10(b), the priority date for the purposes of computing time limits will be the date of the earliest valid remaining priority claim of the international application, or if none, the international filing date.

(c) When corrections under PCT Art. 11(2), Art. 14(2) or PCT Rule 20.2(a) (i) or (iii) are timely submitted, and the date of receipt of such corrections falls later than one year from the claimed priority date or dates, the Receiving Office shall proceed under PCT Rule 4.10(d).

[OMB Control No. 0651-0011]

### § 1.468 Delays in meeting time limits.

Delays in meeting time limits during international processing of international applications may only be excused as provided in PCT Rule 82. For delays in meeting time limits in a national application, see § 1.137.

[OMB Control No. 0651-0011]

## AMENDMENTS

### § 1.471 Corrections and amendments during international processing.

(a) All corrections submitted to the United States Receiving Office must be in the form of replacement sheets and be accompanied by a letter that draws attention to the differences between the replaced sheets and the replacement sheets, except that the deletion of lines of text, the correction of simple typographical errors, and one addition or change of not more than five words per sheet may be stated in a letter and the United States Receiving Office will make the deletion or transfer the correction to the international application, provided that such corrections do not adversely affect the clarity and direct reproducibility of the application (PCT Rule 26.4).

(b) Amendments of claims submitted to the International Bureau shall be as prescribed by PCT Rule 46.

[OMB Control No. 0651-0011]

### § 1.472 Changes in person, name, or address of applicants and inventors.

All requests for a change in person, name or address of applicants and inventor should be sent to the United States Receiving Office until the time of issuance of the international search report. Thereafter requests for such changes should be submitted to the International Bureau.

[OMB Control No. 0651-0011]

[43 FR 20466, May 11, 1978; redesignated at 52 FR 20047, May 28, 1987, effective July 1, 1987]

## UNITY OF INVENTION

### § 1.475 Unity of invention before the International Searching Authority.

(a) An international application before the International Searching Authority will be considered to have unity of invention if the claims are in accordance with PCT Rule 13 (see

paragraph (f) of this section).

(b) An international application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the combinations of categories as set forth in PCT Rule 13.2 (see paragraph (f) of this section) or to the combination of -

(1) A product and a process for the manufacture of said product or

(2) A product and a process of use of said product.

If an application contains claims to more or less than one of the combinations of categories set forth in PCT Rule 13.2 (see paragraph (f) of this section) or a combination set forth in paragraphs (b)(1) or (2) of this section, unity of invention may not be present.

(c) If an international application contains claims to a category of invention in addition to those categories included in any one of the combinations specified in paragraph (b) of this section, lack of unity of invention may be held between the categories included in the combination and the claims to the additional category of invention.

(d) Unity of invention will exist where the claims are limited to one of the combinations of categories set forth in PCT Rule 13.2 (see paragraph (f) of this section) or in a combination set forth in paragraphs (b)(1) or (2) of this section. If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the inventions to be searched. Any such holding by the examiner will be made of record as a holding of lack of unity of invention.

(e) The inventions recited by the claims of different categories must be related rather than independent inventions.

(f) The wording of PCT Rule 13 is as follows:

**"PCT Rule 13 - Unity of Invention**

**13.1 Requirement**

The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention").

**13.2 Claims of Different Categories**

Rule 13.1 shall be construed as permitting, in particular, one of the following three possibilities:

(i) in addition to an independent claim for a given product, the inclusion in the same international application of an independent claim for a process specially adapted for the manufacture of the said product, and the inclusion in the same international application of an independent claim for a use of the said product, or

(ii) in addition to an independent claim for a given process, the inclusion in the same international application of an independent claim for an apparatus or means specifically designed for carrying out the said process, or

(iii) in addition to an independent claim for a given product, the inclusion in the same international application of an independent claim for a process specially adapted for the manufacture of the product, and the inclusion in the same international application of an independent claim for an apparatus

or means specifically designed for carrying out the process.

**13.3 Claims of One and the Same Category**

Subject to Rule 13.1, it shall be permitted to include in the same international application two or more independent claims of the same category (i.e., product, process, apparatus, or use) which cannot readily be covered by a single generic claim.

**13.4 Dependent Claims**

Subject to Rule 13.1, it shall be permitted to include in the same international application a reasonable number of dependent claims, claiming specific forms of the invention claimed in an independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention.

**13.5 Utility Models**

Any designated State in which the grant of a utility model is sought on the basis of an international application may, instead of Rules 13.1 to 13.4, apply in respect of the matters regulated in those Rules the provisions of its national law concerning utility models once the processing of the international application has started in that State, provided that the applicant shall be allowed at least two months from the expiration of the time limit applicable under Article 22 to adapt his application to the requirements of the said provisions of the national law.

[OMB Control No. 0651-0011]

[52 FR 20047, May 28, 1987, effective July 1, 1987]

**§ 1.476 Determination of unity of invention before the International Searching Authority.**

(a) Before establishing the international search report, the International Searching Authority will determine whether the international application complies with the requirement of unity of invention as set forth in PCT Rule 13 (see § 1.475(f)) and § 1.475.

(b) If the International Searching Authority considers that the international application does not comply with the requirement of unity of invention, it shall inform the applicant accordingly and invite the payment of additional fees (note § 1.445 and PCT Art. 17(3)(a) and PCT Rule 40). The applicant will be given a time period in accordance with PCT Rule 40.3 to pay the additional fees due.

(c) In the case of non-compliance with unity of invention and where no additional fees are paid, the international search will be performed on the invention first mentioned ("main invention") in the claims.

(d) Lack of unity of invention may be directly evident before considering the claims in relation to any prior art, or after taking the prior art into consideration, as where a document discovered during the search shows the invention claimed in a generic or linking claim lacks novelty or is clearly obvious, leaving two or more claims joined thereby without a common inventive concept. In such a case the International Searching Authority may raise the objection of lack of unity of invention.

[43 FR 20466, May 11, 1978; redesignated and amended at 52 FR 20048, May 28, 1987, effective July 1, 1987]

§ 1.477 Protest to lack of unity of invention before the International Searching Authority.

(a) If the applicant disagrees with the holding of lack of unity of invention by the International Searching Authority, additional fees may be paid under protest, accompanied by a request for refund and a statement setting forth reasons for disagreement or why the required additional fees are considered excessive, or both (PCT Rule 40.2(c)).

(b) Protest under paragraph (a) of this section will be examined by the Commissioner or the Commissioner's designee. In the event that the applicant's protest is determined to be justified, the additional fees or a portion thereof will be refunded.

(c) An applicant who desires that a copy of the protest and the decision thereon accompany the international search report when forwarded to the Designated Offices, may notify the International Searching Authority to that effect any time prior to the issuance of the international search report. Thereafter, such notification should be directed to the International Bureau (PCT Rule 40.2(c)).

[43 FR 20466, May 11, 1978; redesignated and amended at 52 FR 20048, May 28, 1987, effective July 1, 1987]

INTERNATIONAL PRELIMINARY EXAMINATION

§ 1.480 Demand for international preliminary examination.

(a) On the filing of a Demand and payment of the fees for international preliminary examination (§ 1.482), the international application shall be the subject of an international preliminary examination. The preliminary examination fee (§ 1.482(a)(1)) and the handling fee (§ 1.482(b)) shall be due at the time of filing of the Demand.

(b) The Demand shall be made on a standardized printed form. Copies of the printed Demand forms are available from the Patent and Trademark Office. Letters requesting printed forms should be marked "Box PCT".

(c) If the Demand is made prior to the expiration of the 19th month from the priority date and the United States of America is elected, the provisions of § 1.495 shall apply rather than § 1.494.

(d) Withdrawal of a proper Demand will not entitle applicant to a refund of the preliminary examination fee or handling fee. [52 FR 20048, May 28, 1987, effective July 1, 1987]

§ 1.482 International preliminary examination fees.

(a) The following fees and charges for international preliminary examination are established by the Commissioner under the authority of 35 U.S.C. 376:

(1) A preliminary examination fee is due on filing the Demand:

(i) Where an international search fee as set forth in § 1.445(a)(2) has been paid on the international application to the United States Patent and Trademark Office as an International Searching Authority, a preliminary examination fee of .....\$370.00

(ii) Where the International Searching Authority for the international application was an authority other than the United

States Patent and Trademark Office, a preliminary examination fee of .....\$570.00

(2) An additional preliminary examination fee when required, per additional invention: .....

(i) Where a supplemental search fee as set forth in § 1.445(a)(3) has been paid on the international application to the United States Patent and Trademark Office as an International Searching Authority .....\$125.00

(ii) Where the International Searching Authority for the international application was an authority other than the United States Patent and Trademark Office .....\$190.00

(b) The handling fee is due on filing the Demand. Any necessary supplement to the handling fee shall be paid directly to the International Bureau.

(35 U.S.C. 6, 376)

[OMB Control No. 0651-0011]

[52 FR 20048, May 28, 1987, effective July 1, 1987]

§ 1.484 Conduct of international preliminary examination.

(a) An international preliminary examination will be conducted to formulate a non-binding opinion as to whether the claimed invention has novelty, involves inventive step (is non-obvious) and is industrially applicable.

(b) No international preliminary examination report will be established prior to issuance of an international search report.

(c) No international preliminary examination report will be conducted on inventions not previously searched by an International Searching Authority.

(d) The International Preliminary Examining Authority will establish a written opinion if any defect exists or if the claimed invention lacks novelty, inventive step or industrial applicability and will set a non-extendable time limit in the written opinion for the applicant to respond.

(e) If no written opinion under paragraph (d) of this section is necessary, or after any written opinion and the response thereto or the expiration of the time limit for response to such written opinion, an international preliminary examination report will be established by the International Preliminary Examining Authority. One copy will be submitted to the International Bureau and one copy will be submitted to the applicant.

(f) An applicant will be permitted a personal or telephone interview with the examiner, which must be conducted during the non-extendable time limit for response by the applicant to a written opinion. Additional interviews may be conducted where the examiner determines that such additional interviews may be helpful to advancing the international preliminary examination procedure. A summary of any such personal or telephone interview must be filed by the applicant as a part of the response to the written opinion or, if applicant files no response, be made of record in the file by the examiner.

[52 FR 20049, May 28, 1987, effective July 1, 1987]

§ 1.485 Amendments by applicant during international preliminary examination.

The applicant may make amendments at the time of filing of



the Demand and within the time limit set by the International Preliminary Examining Authority for response to any written opinion. Any such amendments must-

(1) be made by submitting a replacement sheet for every sheet of the application which differs from the sheet it replaces unless an entire sheet is cancelled and

(2) include a description of how the replacement sheet differs from the replaced sheet.

If an amendment cancels an entire sheet of the international application, that amendment shall be communicated in a letter.

[52 FR 20049, May 28, 1987, effective July 1, 1987]

**§ 1.487 Unity of Invention before the International Preliminary Examining Authority.**

(a) An international application before the International Preliminary Examining Authority will be considered to have unity of invention if the claims are in accordance with PCT Rule 13 (see § 1.475(f)).

(b) An international application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the combinations of categories as set forth in PCT Rule 13.2 (see § 1.475(f)) or to the combination of -

(1) a product and a process for the manufacture of said product or

(2) a product and a process of use of said product.

If an application contains claims to more or less than one of the combinations of categories of invention set forth in PCT Rule 13.2 (see § 1.475(f)) or combination set forth in paragraphs (b)(1) or (2) of this section, unity of invention may not be present.

(c) If an international application contains claims to a category of invention in addition to those categories included in any one of the combinations specified in paragraph (b) of this section, lack of unity of invention may be held between the categories included in the combination and the claims to the additional category of invention.

(d) Unity of invention will exist where the claims are limited to one of the combinations of categories set forth in PCT Rule 13.2 (see § 1.475(f)) or a combination set forth in paragraphs (b)(1) or (2) of this section. If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the inventions to be examined. Any such holding by the examiner will be made of record as a holding of lack of unity of invention.

(e) The inventions recited by the claims of different categories must be related rather than independent inventions.

[52 FR 20049, May 28, 1987, effective July 1, 1987]

**§ 1.488 Determination of unity of invention before the International Preliminary Examining Authority.**

(a) Before establishing any written opinion or the international preliminary examination report, the International Preliminary Examining Authority will determine whether the inter-

national application complies with the requirement of unity of invention as set forth in § 1.487.

(b) If the International Preliminary Examining Authority considers that the international application does not comply with the requirement of unity of invention, it may:

(1) Issue a written opinion and/or an international preliminary examination report, in respect of the entire international application and indicate that unity of invention is lacking and specify the reasons therefor without extending an invitation to restrict or pay additional fees. No international preliminary examination will be conducted on inventions not previously searched by an International Searching Authority.

(2) Invite the applicant to restrict the claims or pay additional fees, pointing out the categories of the invention found, within a set time limit which will not be extended. No international preliminary examination will be conducted on inventions not previously searched by an International Preliminary Examining Authority, or

(3) If applicant fails to restrict the claims or pay additional fees within the time limit set for response, the International Preliminary Examining Authority will issue a written opinion and/or establish an international preliminary examination report on the main invention and shall indicate the relevant facts in the said report. In case of any doubt as to which invention is the main invention, the invention first mentioned in the claims and previously searched by an International Searching Authority shall be considered the main invention.

(c) Lack of unity of invention may be directly evident before considering the claims in relation to any prior art, or after taking the prior art into consideration, as where a document discovered during the search shows the invention claimed in a generic or linking claim lacks novelty or is clearly obvious, leaving two or more claims joined thereby without a common inventive concept. In such a case the International Preliminary Examining Authority may raise the objection of lack of unity of invention.

[52 FR 20049, May 28, 1987, effective July 1, 1987]

**§ 1.489 Protest to lack of unity of invention before the International Preliminary Examining Authority.**

(a) If the applicant disagrees with the holding of lack of unity of invention by the International Preliminary Examining Authority, additional fees may be paid under protest, accompanied by a request for refund and a statement setting forth reasons for disagreement or why the required additional fees are considered excessive, or both.

(b) Protest under paragraph (a) of this section will be examined by the Commissioner or the Commissioner's designee. In the event that the applicant's protest is determined to be justified, the additional fees or a portion thereof will be refunded.

(c) An applicant who desires that a copy of the protest and the decision thereon accompany the international preliminary examination report when forwarded to the Elected Offices, may notify the International Preliminary Examining Authority to that effect any time prior to the issuance of the international preliminary examination report. Thereafter, such notification should be directed to the International Bureau.

[52 FR 20050, May 28, 1987, effective July 1, 1987]

**NATIONAL STAGE**

**§ 1.491 Entry into the national stage.**

An international application enters the national stage when the applicant has filed the documents and fees required by 35 U.S.C. 371(c) within the periods set in § 1.494 or § 1.495.

[52 FR 20050, May 28, 1987, effective July 1, 1987]

**§ 1.492 National stage fees.**

The following fees and charges for international applications entering the national stage under 35 U.S.C. 371 are established by the Commissioner under 35 U.S.C. 376:

(a) The basic national fee:

(1) Where an international preliminary examination fee as set forth in § 1.482 has been paid on the international application to the United States Patent and Trademark Office:

By a small entity (§ 1.9(f)) .....\$150.00  
By other than a small entity .....\$300.00

(2) Where no international preliminary examination fee as set forth in § 1.482 has been paid to the United States Patent and Trademark Office, but an international search fee as set forth in § 1.445(a)(2) has been paid on the international application to the United States Patent and Trademark Office as an International Searching Authority:

By a small entity (§ 1.9(f)) .....\$170.00  
By other than a small entity .....\$340.00

(3) Where no international preliminary examination fee as set forth in § 1.482 has been paid and no international search fee as set forth in § 1.445(a)(2) has been paid on the international application to the United States Patent and Trademark Office:

By a small entity (§ 1.9(f)) .....\$225.00  
By other than a small entity .....\$450.00

(4) Where the international preliminary examination fee as set forth in § 1.482 has been paid to the United States Patent and Trademark Office and the international preliminary examination report states that the criteria of novelty, inventive step (non-obviousness), and industrial applicability, as defined in PCT Article 33(1) to (4) have been satisfied for all the claims presented in the application entering the national stage (see § 1.496(b)):

By a small entity (§ 1.9(f)) .....\$25.00  
By other than a small entity .....\$50.00

(b) In addition to the basic national fee, for filing or later presentation of each independent claim in excess of 3:

By a small entity (§ 1.9(f)) .....\$17.00  
By other than a small entity .....\$34.00

(c) In addition to the basic national fee, for filing or later

presentation of each claim (whether independent or dependent) in excess of 20 (Note that § 1.75(c) indicates how multiple dependent claims are considered for fee calculation purposes.);

By a small entity (§ 1.9(f)) ..... \$6.00  
By other than a small entity .....\$12.00

(d) In addition to the basic national fee, if the application contains, or is amended to contain, a multiple dependent claim(s), per application:

By a small entity (§ 1.9(f)) ..... \$55.00  
By other than a small entity .....\$110.00

(If the additional fees required by paragraphs (b), (c) and (d) are not paid on presentation of the claims for which the additional fees are due, they must be paid or the claims cancelled by amendment, prior to the expiration of the time period set for response by the Office in any notice of fee deficiency.)

(e) Surcharge for filing the basic national fee or oath or declaration later than 20 months from the priority date pursuant to § 1.494(c) or later than 30 months from the priority date pursuant to § 1.495(c):

By a small entity (§ 1.9(f)) ..... \$55.00  
By other than a small entity .....\$110.00

(f) For filing an English translation of an international application later than 20 months after the priority date (§ 1.494(c)) or for filing an English translation of the international application or of any annexes to the international preliminary examination report later than 30 months after the priority date (§ 1.495(c) and (e) ..... \$26.00  
(35 U.S.C. 6, 376)

[52 FR 20050, May 28, 1987, effective July 1, 1987]

**§ 1.494 Entering the national stage in the United States of America as a Designated Office.**

(a) Where no Demand has been filed with an appropriate International Preliminary Examining Authority by the expiration of 19 months from the priority date (see § 1.495), the applicant must fulfill the requirements of PCT Article 22 and 35 U.S.C. 371 within the time periods set forth in paragraphs (b) and (c) of this section in order to prevent the abandonment of the international application as to the United States of America. International applications for which those requirements are timely fulfilled will enter the national stage and obtain an examination as to the patentability of the invention in the United States of America.

(b) The applicant shall furnish to the United States Patent and Trademark Office not later than the expiration of 20 months from the priority date -

(1) a copy of the international application, unless it has been previously communicated by the International Bureau or unless it was originally filed in the United States Patent and Trademark Office;

(2) a translation of the international application into the English language, if it was originally filed in another language;

(3) the basic national fee (see § 1.492(a)); and

(4) an oath or declaration of the inventor (see § 1.497).

(c) The applicant may furnish any required English translation of the international application, the basic national fee and the oath or declaration of the inventor after 20 months but not later than the expiration of 22 months from the priority date. The payment of the processing fee set forth in § 1.492(f) is required for acceptance of an English translation later than the expiration of 20 months after the priority date. The payment of the surcharge set forth in § 1.492(e) is required for acceptance of the basic national fee or the oath or declaration of the inventor later than the expiration of 20 months after the priority date.

(d) A copy of any amendments to the claims made under PCT Article 19, and a translation of those amendments into English, if they were made in another language, must be furnished not later than the expiration of 20 months from the priority date. Amendments under PCT Article 19 which are not received by the expiration of 20 months from the priority date will be considered to be cancelled.

(e) Verification of the translation of the international application or any other document pertaining to an international application may be required where it is considered necessary, if the international application or other document was filed in a language other than English.

(f) The documents and fees submitted under paragraphs (b) and (c) of this section must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371, otherwise the submission will be considered as being made under 35 U.S.C. 111.

(g) The time limits set out in paragraphs (b), (c) and (d) of this section may not be extended pursuant to § 1.136 or otherwise.

(h) An international application becomes abandoned as to the United States 20 months from the priority date if a copy of the international application is not communicated to the Patent and Trademark Office prior to 20 months from the priority date where the United States has been designated but not elected prior to 19 months from the priority date. If a copy of the international application is communicated within 20 months to the Patent and Trademark Office, an international application will become abandoned as to the United States 22 months from the priority date if the required English translation(s), fees and oath or declaration under 35 U.S.C. 371(c) are not filed within 22 months from the priority date.

[52 FR 20050, May 28, 1987, effective July 1, 1987]

#### § 1.495 Entering the national stage in the United States of America as an Elected Office

(a) Where a Demand has been filed with an appropriate International Preliminary Examining Authority and not withdrawn by the expiration of 19 months from the priority date, the applicant must fulfill the requirements of 35 U.S.C. 371 within the time periods set forth in paragraphs (b) and (c) of this section in order to prevent the abandonment of the international application as to the United States of America. International applica-

tions for which those requirements are timely fulfilled will enter the national stage and obtain an examination as to the patentability of the invention in the United States of America.

(b) The applicant shall furnish to the United States Patent and Trademark Office not later than the expiration of 30 months from the priority date-

(1) a copy of the international application, unless it has been previously communicated by the International Bureau or unless it was originally filed in the United States Patent and Trademark Office;

(2) a translation of the international application into the English language, if it was originally filed in another language;

(3) the basic national fee (see § 1.492(a)); and

(4) an oath or declaration of the inventor (see § 1.497).

(c) The applicant may furnish any required English translation of the international application, the basic national fee and the oath or declaration of the inventor after 30 months but not later than the expiration of 32 months from the priority date. The payment of the processing fee set forth in § 1.492(f) is required for acceptance of an English translation later than the expiration of 30 months after the priority date. The payment of the surcharge set forth in § 1.492(e) is required for acceptance of the basic national fee or the oath or declaration of the inventor later than the expiration of 30 months after the priority date.

(d) A copy of any amendments to the claims made under PCT Article 19, and a translation of those amendments into English, if they were made in another language, must be furnished not later than the expiration of 30 months from the priority date. Amendments under PCT Article 19 which are not received by the expiration of 30 months from the priority date will be considered to be cancelled.

(e) A translation into English of any annexes to an international preliminary examination report, if the annexes were made in another language, must be furnished not later than the expiration of 30 months from the priority date. Translations of the annexes which are not received by the expiration of 30 months from the priority date may be submitted within 32 months from the priority date accompanied by the processing fee set forth in § 1.492(f). Translations of the annexes which are not timely received will be considered to be cancelled.

(f) Verification of the translation of the international application or any other document pertaining to an international application may be required where it is considered necessary, if the international application or other document was filed in a language other than English.

(g) The documents submitted under paragraphs (b) and (c) of this section must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371, otherwise the submission will be considered as being made under 35 U.S.C. 111.

(h) The time limits set out in paragraphs (b), (c), (d) and (e) of this section may not be extended pursuant to § 1.136 or otherwise.

(i) An international application becomes abandoned as to the United States 30 months from the priority date if a copy of the international application is not communicated to the Patent and Trademark Office prior to 30 months from the priority date and a Demand for International Preliminary Examination which

elected the United States of America has been filed prior to the expiration of 19 months from the priority date. If a copy of the international application is communicated within 30 months to the Patent and Trademark Office, an international application will become abandoned as to the United States 32 months from the priority date if the required English translation(s), fees and oath or declaration under 35 U.S.C. 371(c) are not filed within 32 months from the priority date.

[52 FR 20051, May 28, 1987, effective July 1, 1987]

#### § 1.496 Examination of international applications in the national stage.

(a) International applications which have complied with the requirements of 35 U.S.C. 371(c) will be taken up for action based on the date on which such requirements were met. However, unless an express request for early processing has been filed under 35 U.S.C. 371(f), no action may be taken prior to one month after entry into the national stage.

(b) A national stage application filed under 35 U.S.C. 371 may have paid therein the basic national fee as set forth in § 1.492(a)(4) if it contains, or is amended to contain, at the time of entry into the national stage, only claims which have been indicated in an international preliminary examination report prepared by the United States Patent and Trademark Office as satisfying the criteria of PCT Article 33(1)-(4) as to novelty, inventive step and industrial applicability. Such national stage applications in which the basic national fee as set forth in § 1.492(a)(4) has been paid may be amended subsequent to the date of entry into the national stage only to the extent necessary to eliminate objections as to form or to cancel rejected claims. Such national stage applications in which the basic national fee as set forth in § 1.492(a)(4) has been paid will be taken up out of order.

[52 FR 20051, May 28, 1987, effective July 1, 1987]

#### § 1.497 Oath or declaration under 35 U.S.C. 371(c)(4).

(a) When an applicant of an international application, if the inventor, desires to enter the national stage under 35 U.S.C. 371 pursuant to § 1.494 or § 1.495, he or she must file an oath or declaration in accordance with § 1.63.

(b) If the international application was made as provided in § 1.422, 1.423 or 1.425, the applicant shall state his or her relationship to the inventor and, upon information and belief, the facts which the inventor is required by § 1.63 to state.

[52 FR 20052, May 28, 1987, effective July 1, 1987]

#### § 1.499 Unity of invention during the national stage.

(a) An international application which has entered the national stage by meeting the requirements of 35 U.S.C. 371 will be considered to have unity of invention if the claims are in accordance with PCT Rule 13 (see § 1.475(f)).

(b) An application in the national stage containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the combinations of categories as set forth in PCT Rule 13.2 (see §

1.475(f)) or to the combination of -

(1) a product and a process for the manufacture of said product or

(2) a product and a process of use of said product.

If an application contains claims to more or less than one of the combinations of categories of invention set forth in PCT Rule 13.2 (see § 1.475(f)) or combination set forth in paragraphs (b)(1) and (2) of this section, unity of invention may not be present.

(c) If an application in the national stage contains claims to a category of invention in addition to those categories included in any one of the combinations specified in paragraph (b) of this section, lack of unity of invention may be held between the categories included in the combination and the claims to the additional category of invention.

(d) Unity of invention will exist in an application in the national stage where the claims are limited to one of the combinations of categories set forth in PCT Rule 13.2 (see § 1.475(f)) or a combination set forth in paragraphs (b)(1) or (2) of this section. If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the elected invention to be examined. Any such holding of an election by the examiner will be made in the form of a restriction requirement which confirms the election made by the presentation of claims. Such a restriction requirement would be made on the basis of whether the inventions are independent and distinct. Applicant has the right to traverse such a restriction requirement in the response to the Office action in which the election is indicated.

(e) The inventions recited by the claims of different categories must be related rather than independent inventions.

(f) If the examiner finds that a national stage application lacks unity of invention, the examiner may in an Office action require the applicant in the response to that Office action to elect the invention to which the claims shall be restricted, this official action being called a requirement for restriction. Such requirement may be made before any action on the merits but may be made at any time before the final action at the discretion of the examiner. Review of any such requirement is provided under §§ 1.143 and 1.144.

[52 FR 20052, May 28, 1987, effective July 1, 1987]

### Subpart D - Reexamination of Patents

#### CITATION OF PRIOR ART

#### § 1.501 Citation of prior art in patent files.

(a) At any time during the period of enforceability of a patent, any person may cite to the Patent and Trademark Office in writing prior art consisting of patents or printed publications which that person states to be pertinent and applicable to the patent and believes to have a bearing on the patentability of any claim of a particular patent. If the citation is made by the patent owner, the explanation of pertinency and applicability may include an explanation of how the claims differ from the prior

art. Citations by the patent owner under § 1.555 and by a reexamination requester under either § 1.510 or § 1.535 will be entered in the patent file during a reexamination proceeding. The entry in the patent file of citations submitted after the date of an order to reexamine pursuant to § 1.525 by persons other than the patent owner, or a reexamination requester under either § 1.510 or § 1.535, will be delayed until the reexamination proceedings have been terminated.

(b) If the person making the citation wishes his or her identity to be excluded from the patent file and kept confidential, the citation papers must be submitted without any identification of the person making the submission.

(c) Citations of patent or printed publications by the public in patent files should either: (1) Reflect that a copy of the same has been mailed to the patent owner at the address as provided for in § 1.33(c); or in the event service is not possible (2) be filed with the Office in duplicate.

[46 FR 29185, May 29, 1981]

**REQUEST FOR REEXAMINATION**

**§ 1.510 Request for reexamination.**

(a) Any person may, at any time during the period of enforceability of a patent, file a request for reexamination by the Patent and Trademark Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501. The request must be accompanied by the fee for requesting reexamination set in § 1.20(c).

(b) Any request for reexamination must include the following parts:

(1) A statement pointing out each substantial new question of patentability based on prior patents and printed publications.

(2) An identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested. If appropriate the party requesting reexamination may also point out how claims distinguish over cited prior art.

(3) A copy of every patent or printed publication relied upon or referred to in paragraph (b)(1) and (2) of this section accompanied by an English language translation of all the necessary and pertinent parts of any non-English language patent or printed publication.

(4) The entire specification (including claims) and drawings of the patent for which reexamination is requested must be furnished in the form of cut-up copies of the original patent with only a single column of the printed patent securely mounted or reproduced in permanent form on one side of a separate paper. A copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent must also be included.

(5) A certification that a copy of the request filed by a person other than the patent owner has been served in its entirety on the patent owner at the address as provided for in § 1.33(c). The name and address of the party served must be indicated. If service was not possible, a duplicate copy must be supplied to the Office.

(c) If the request does not include the fee for requesting

reexamination or all of the parts required by paragraph (b) of this section, the person identified as requesting reexamination will be so notified and given an opportunity to complete the request within a specified time. If the fee for requesting reexamination has been paid but the defect in the request is not corrected within the specified time, the determination whether or not to institute reexamination will be made on the request as it then exists. If the fee for requesting reexamination has not been paid, no determination will be made and the request will be placed in the patent file as a citation if it complies with the requirements of § 1.501(a).

(d) The filing of the request is: (1) The date on which the request including the entire fee for requesting reexamination is received in the Patent and Trademark Office; or (2) the date on which the last portion of the fee for requesting reexamination is received.

(e) A request filed by the patent owner, may include a proposed amendment in accordance with § 1.121(f).

(f) If a request is filed by an attorney or agent identifying another party on whose behalf the request is being filed, the attorney or agent must have a power of attorney from that party or be acting in a representative capacity pursuant to § 1.34(a).

OMB Control N. 0651-0011]

[46 FR 29185, May 29, 1981; para. (a), 47 FR 41282, Sept. 17, 1982, effective Oct. 1, 1982]

**§ 1.515 Determination of the request for reexamination.**

(a) Within three months following the filing date of a request for reexamination, an examiner will consider the request and determine whether or not a substantial new question of patentability affecting any claim of the patent is raised by the request and the prior art cited therein, with or without consideration of other patents or printed publications. The examiner's determination will be based on the claims in effect at the time of the determination and will become a part of the official file of the patent and will be given or mailed to the patent owner at the address as provided for in § 1.33(c) and to the person requesting reexamination.

(b) Where no substantial new question of patentability has been found, a refund of a portion of the fee for requesting reexamination will be made to the requester in accordance with § 1.26(c).

(c) The requester may seek review by a petition to the Commissioner under § 1.181 within one month of the mailing date of the examiner's determination refusing reexamination. Any such petition must comply with § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable.

**§ 1.520 Reexamination at the initiative of the Commissioner.**

The Commissioner, at any time during the period of enforceability of a patent, may determine whether or not a substantial new question of patentability is raised by patents or printed publications which have been discovered by the Commissioner

or which have been brought to the Commissioner's attention even though no request for reexamination has been filed in accordance with § 1.510. The Commissioner may initiate reexamination without a request for reexamination pursuant to § 1.510. Normally requests from outside the Patent and Trademark Office that the Commissioner undertake reexamination on his own initiative will not be considered. Any determination to initiate reexamination under this section will become a part of the official file of the patent and will be given or mailed to the patent owner at the address as provided for in § 1.33(c).

### REEXAMINATION

#### § 1.525 Order to reexamine.

(a) If a substantial new question of patentability is found pursuant to § 1.515 or § 1.520, the determination will include an order for reexamination of the patent for resolution of the question. If the order for reexamination resulted from a petition pursuant to § 1.515(c), the reexamination will ordinarily be conducted by an examiner other than the examiner responsible for the initial determination under § 1.515(a).

(b) If the order for reexamination of the patent mailed to the patent owner at the address as provided for in § 1.33(c) is returned to the Office undelivered, the notice published in the *Official Gazette* under § 1.11(c) will be considered to be constructive notice and reexamination will proceed.

#### § 1.530 Statement and amendment by patent owner.

(a) Except as provided in § 1.510(e), no statement or other response by the patent owner shall be filed prior to the determinations made in accordance with §§ 1.515 or 1.520. If a premature statement or other response is filed by the patent owner it will not be acknowledged or considered in making the determination.

(b) The order for reexamination will set a period of not less than two months from the date of the order within which the patent owner may file a statement on the new question of patentability including any proposed amendments the patent owner wishes to make.

(c) Any statement filed by the patent owner shall clearly point out why the subject matter as claimed is not anticipated or rendered obvious by the prior art patents or printed publications, either alone or in any reasonable combinations. Any statement filed must be served upon the reexamination requester in accordance with § 1.248.

(d) Any proposed amendments to the description and claims must be made in accordance with § 1.121(f). No amendment may enlarge the scope of the claims of the patent or introduce new matter. No amended or new claims may be proposed for entry in an expired patent. Moreover, no amended or new claims will be incorporated into the patent by certificate issued after the expiration of the patent.

(e) Although the Office actions will treat proposed amendments as though they have been entered, the proposed amendments will not be effective until the reexamination certificate is issued.

#### § 1.535 Reply by requester.

A reply to the patent owner's statement under § 1.530 may be filed by the reexamination requester within two months from the date of service of the patent owner's statement. Any reply by the requester must be served upon the patent owner in accordance with § 1.248. If the patent owner does not file a statement under § 1.530, no reply or other submission from the reexamination requester will be considered.

#### § 1.540 Consideration of responses.

The failure to timely file or serve the documents set forth in § 1.530 or in § 1.535 may result in their being refused consideration. No submissions other than the statement pursuant to § 1.530 and the reply by the requester pursuant to § 1.535 will be considered prior to examination.

#### § 1.550 Conduct of reexamination proceedings.

(a) All reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office. After issuance of the reexamination order and expiration of the time for submitting any responses thereto, the examination will be conducted in accordance with §§ 1.104-1.119 and will result in the issuance of a reexamination certificate under § 1.570.

(b) The patent owner will be given at least 30 days to respond to any Office action. Such response may include further statements in response to any rejections and/or proposed amendments or new claims to place the patent in a condition where all claims, if amended as proposed, would be patentable.

(c) The time for taking any action by a patent owner in a reexamination proceeding will be extended only for sufficient cause, and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of the request effect any extension.

(d) If the patent owner fails to file a timely and appropriate response to any Office action, the reexamination proceeding will be terminated and the Commissioner will proceed to issue a certificate under § 1.570 in accordance with the last action of the Office.

(e) The reexamination requester will be sent copies of Office actions issued during the reexamination proceeding. Any document filed by the patent owner must be served on the requester in the manner provided in § 1.248. The document must reflect service or the document may be refused consideration by the Office. The active participation of the reexamination requester ends with the reply pursuant to § 1.535, and no further submissions on behalf of the reexamination requester will be acknowledged or considered. Further, no submissions on behalf of any third parties will be acknowledged or considered unless such submissions are (1) in accordance with § 1.510 or (2) entered in the patent file prior to the date of the order to reexamine pursuant to § 1.525. Submissions by third parties, filed after the date of the order to reexamine pursuant to § 1.525, must meet the requirements of and will be treated in accordance with § 1.501(a).

[46 FR 29185, May 29, 1981; para. (c), 49 FR 556, Jan. 4, 1984,

effective Apr. 1, 1984; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985]

### § 1.552 Scope of reexamination in reexamination proceedings.

(a) Patent claims will be reexamined on the basis of patents or printed publications.

(b) Amended or new claims presented during a reexamination proceeding must not enlarge the scope of the claims of the patent and will be examined on the basis of patents or printed publications and also for compliance with the requirements of 35 U.S.C. 112 and the new matter prohibition of 35 U.S.C. 132.

(c) Questions other than those indicated in paragraphs (a) and (b) of this section will not be resolved in a reexamination proceeding. If such questions are discovered during a reexamination proceeding, the existence of such questions will be noted by the examiner in an Office action, in which case the patent owner may desire to consider the advisability of filing a reissue application to have such questions considered and resolved.

### § 1.555 Duty of disclosure in reexamination proceedings.

(a) A duty of candor and good faith toward the Patent and Trademark Office rests on the patent owner, on each attorney or agent who represents the patent owner, and on every other individual who is substantively involved on behalf of the patent owner in a reexamination proceeding. All such individuals who are aware, or become aware, of patents or printed publications material to the reexamination which have not been previously made of record in the patent file must bring such patents or printed publications to the attention of the Office. An information disclosure statement, preferably in accordance with § 1.98, should be filed within two months of the date of the order for reexamination, or as soon thereafter as possible in order to bring such patents or printed publications to the attention of the Office.

(b) Disclosures pursuant to this section must be accompanied by a copy of each foreign patent document or non-patent printed publication which is being disclosed or by a statement that the copy is not in the possession of the person making the disclosure and may be made to the Office through an attorney or agent having responsibility on behalf of the patent owner for the reexamination proceeding or through a patent owner acting in his or her own behalf. Disclosure to such an attorney, agent or patent owner shall satisfy the duty of any other individual. Such an attorney, agent or patent owner has no duty to transmit information which is not material to the reexamination.

(c) The duties of candor, good faith, and disclosure required in paragraph (a) of this section have not been complied with if any fraud was practiced or attempted on the Office or there was any violation of the duty of disclosure through bad faith or gross negligence by, or on behalf of, the patent owner in the reexamination proceeding.

(d) The responsibility for compliance with this section rests upon the individuals identified in paragraph (a) of this section and no evaluation will be made in the reexamination proceeding by the Office as to compliance with this section. If questions of

compliance with this section are discovered during a reexamination proceeding, they will be noted as unresolved questions in accordance with § 1.552(c).

[47 FR 21752, May 19, 1982, effective July 1, 1982; paras. (a) & (b), 49 FR 556, Jan. 4, 1984, effective Apr. 1, 1984]

### § 1.560 Interviews in reexamination proceedings.

(a) Interviews in reexamination proceedings pending before the Office between examiners and the owners of such patents or their attorneys or agents of record must be had in the Office at such times, within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Commissioner. Interviews for the discussion of the patentability of claims in patents involved in reexamination proceedings will not be had prior to the first official action thereon. Interviews should be arranged for in advance. Requests that reexamination requesters participate in interviews with examiners will not be granted.

(b) In every instance of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner. An interview does not remove the necessity for response to Office actions as specified in § 1.111.

### § 1.565 Concurrent office proceedings.

(a) In any reexamination proceeding before the Office, the patent owner shall call the attention of the Office to any prior or concurrent proceedings in which the patent is or was involved such as interferences, reissue, reexaminations, or litigation and the results of such proceedings.

(b) If a patent in the process of reexamination is or becomes involved in litigation or a reissue application for the patent is filed or pending, the Commissioner shall determine whether or not to stay the reexamination or reissue proceeding.

(c) If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

(d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings. Where merger of a reissue application and a reexamination proceeding is ordered, the merged examination will be conducted in accordance with §§ 1.171 through 1.179 and the patent owner will be required to place and maintain the same claims in the reissue application and the reexamination proceeding during the pendency of the merged proceeding. The examiner's actions and any responses by the patent owner in a merged proceeding will apply to both the reissue application and the reexamination proceeding and be physically entered into both files. Any reexamination proceeding merged with a reissue application shall be terminated by the grant of the reissued patent.

(e) If a patent in the process of reexamination is or becomes involved in an interference, the Commissioner may stay reexamination or the interference. The Commissioner will not

consider a request to stay an interference unless a motion (§ 1.635) to stay the interference has been presented to, and denied by, an examiner-in-chief and the request is filed within ten (10) days of a decision by an examiner-in-chief denying the motion for a stay or such other time as the examiner-in-chief may set.

[46 FR 29185, May 29, 1981; paras. (b) & (d), 47 FR 21753, May 19, 1982, effective July 1, 1982; paras. (b) & (e), 49 FR 48416, Dec. 12, 1984, 50 FR 23123, May 31, 1985]

### CERTIFICATE

#### § 1.570 Issuance of reexamination certificate after reexamination proceedings.

(a) Upon the conclusion of reexamination proceedings, the Commissioner will issue a certificate in accordance with 35 U.S.C. 307 setting forth the results of the reexamination proceeding and the content of the patent following the reexamination proceeding.

(b) A certificate will be issued in each patent in which a reexamination proceeding has been ordered under § 1.525. Any statutory disclaimer filed by the patent owner will be made part of the certificate.

(c) The certificate will be mailed on the day of its date to the patent owner at the address as provided for in § 1.33(c). A copy of the certificate will also be mailed to the requester of the reexamination proceeding.

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

(e) If the reexamination proceeding is terminated by the grant of a reissued patent as provided in § 1.565(d) the reissued patent will constitute the reexamination certificate required by this section and 35 U.S.C. 307.

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

[46 FR 29185, May 29, 1981; para. (e), 47 FR 21753, May 19, 1982, effective date July 1, 1982]

### Subpart E - Interferences

#### § 1.601 Scope of rules, definitions.

This subpart governs the procedure in patent interferences in the Patent and Trademark Office. This subpart shall be construed to secure the just, speedy, and inexpensive determination of every interference. For the meaning of terms in the Federal Rules of Evidence as applied to interferences, see § 1.671(c). Unless otherwise clear from the context, the following definitions apply to this subpart:

(a) "Additional discovery" is discovery to which a party may be entitled under § 1.687 in addition to discovery to which the party is entitled as a matter of right under § 1.673(a) and (b).

(b) "Affidavit" means affidavit, declaration under § 1.68, or statutory declaration under 28 U.S.C. 1746. A transcript of an *ex parte* deposition may be used as an affidavit.

(c) "Board" means the Board of Patent Appeals and Interferences.

(d) "Case-in-chief" means that portion of a party's case where the party has the burden of going forward with evidence.

(e) "Case-in-rebuttal" means that portion of a party's case where the party presents evidence in rebuttal to the case-in-chief of another party.

(f) A "count" defines the interfering subject matter between (1) two or more applications or (2) one or more applications and one or more patents. When there is more than one count, each count shall define a separate patentable invention. Any claim of an application or patent which corresponds to a count is a claim involved in the interference within the meaning of 35 U.S.C. 135(a). A claim of a patent or application which is identical to a count is said to "correspond exactly" to the count. A claim of a patent or application which is not identical to a count, but which defines the same patentable invention as the count, is said to "correspond substantially" to the count. When a count is broader in scope than all claims which correspond to the count, the count is a "phantom count." A phantom count is not patentable to any party.

(g) The "effective filing date" of an application or a patent is the filing date of an earlier application accorded to the application or patent under 35 U.S.C. 119, 120, or 365.

(h) In the case of an application, "filing date" means the filing date assigned to the application. In the case of a patent, "filing date" means the filing date assigned to the application which issued as the patent.

(i) An "interference" is a proceeding instituted in the Patent and Trademark Office before the Board to determine any question of patentability and priority of invention between two or more parties claiming the same patentable invention. An interference may be declared between two or more pending applications naming different inventors when, in the opinion of an examiner, the applications contain claims for the same patentable invention. An interference may be declared between one or more pending applications and one or more unexpired patents naming different inventors when, in the opinion of an examiner, any application and any unexpired patent contain claims for the same patentable invention.

(j) An "interference-in-fact" exists when at least one claim of a party which corresponds to a count and at least one claim of an opponent which corresponds to the count define the same patentable invention.

(k) A "lead" attorney or agent is a registered attorney or agent of record who is primarily responsible for prosecuting an interference on behalf of a party and is the attorney or agent whom an examiner-in-chief may contact to set times and take other action in the interference.

(l) A "party" is (1) an applicant or patentee involved in the interference or (2) a legal representative or an assignee of an applicant or patentee involved in an interference. Where acts of a party are normally performed by an attorney or agent, "party" may be construed to mean the attorney or agent. An "inventor" is the individual named as inventor in an application involved in an interference or the individual named as inventor in a patent involved in an interference.

(m) A "senior party" is the party with earliest effective filing date as to all counts or, if there is no party with the earliest



effective filing date as to all counts, the party with the earliest filing date. A "junior party" is any other party.

(n) Invention "A" is the "same patentable invention" as an invention "B" when invention "A" is the same as (35 U.S.C. 102) or is obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A". Invention "A" is a "separate patentable invention" with respect to invention "B" when invention "A" is new (35 U.S.C. 102) and non-obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A".

(o) "Sworn" means sworn or affirmed.

(p) "United States" means the United States of America, its territories and possessions.

[49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; 50 FR 23123, May 31, 1985, ]

**§ 1.602 Interest in applications and patents involved in an interference.**

(a) Unless good cause is shown, an interference shall not be declared or continued between (1) applications owned by a single party or (2) applications and an unexpired patent owned by a single party.

(b) The parties, within 20 days after an interference is declared, shall notify the Board of any and all right, title, and interest in any application or patent involved or relied upon in the interference unless the right, title, and interest is set forth in the notice declaring the interference.

(c) If a change of any right, title, and interest in any application or patent involved or relied upon in the interference occurs after notice is given declaring the interference and before the time expires for seeking judicial review of a final decision of the Board, the parties shall notify the Board of the change within 20 days of the change.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985]

**§ 1.603 Interference between applications; subject matter of the interference.**

Before an interference is declared between two or more applications, the examiner must be of the opinion that there is interfering subject matter claimed in the applications which is patentable to each applicant subject to a judgment in the interference. The interfering subject matter shall be defined by one or more counts. Each count shall define a separate patentable invention. Each application must contain, or be amended to contain, at least one claim which corresponds to each count. All claims in the applications which define the same patentable invention as a count shall be designated to correspond to the count.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985]

**§ 1.604 Request for interference between applications by an applicant.**

(a) An applicant may seek to have an interference declared with an application of another by (1) suggesting a proposed count and presenting a claim corresponding to the proposed

count, (2) identifying the other application and, if known, a claim in the other application which corresponds to the proposed count, and (3) explaining why an interference should be declared.

(b) When an applicant presents a claim known to the applicant to define the same patentable invention claimed in a pending application of another, the applicant shall identify that pending application, unless the claim is presented in response to a suggestion by the examiner. The examiner shall notify the Commissioner of any instance where it appears an applicant may have failed to comply with the provisions of this paragraph.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985]

**§ 1.605 Suggestion of claim to applicant by examiner.**

(a) The examiner may suggest that an applicant present a claim in an application for the purpose of an interference with another application or a patent. The applicant to whom the claim is suggested shall amend the application by presenting the suggested claim within a time specified by the examiner, not less than one month. Failure or refusal of an applicant to timely present the suggested claim shall be taken without further action as a disclaimer by the applicant of the invention defined by the suggested claim. At the time the suggested claim is presented, the applicant may also (1) call the examiner's attention to other claims already in the application or which are presented with the suggested claim and (2) explain why the other claims would be more appropriate to be included in any interference which may be declared.

(b) The suggestion of a claim by the examiner for the purpose of an interference will not stay the period for response to any outstanding Office action. When a suggested claim is timely presented, *ex parte* proceedings in the application will be stayed pending a determination of whether an interference will be declared.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985]

**§ 1.606 Interference between an application and a patent; subject matter of the interference.**

Before an interference is declared between an application and an unexpired patent, an examiner must determine that there is interfering subject matter claimed in the application and the patent which is patentable to the applicant subject to a judgment in the interference. The interfering subject matter will be defined by one or more counts. Each count shall define a separate patentable invention. Any application must contain, or be amended to contain, at least one claim which corresponds to each count. All claims in the application and patent which define the same patentable invention as a count shall be designated to correspond to the count. At the time an interference is initially declared (§ 1.611), a count shall not be narrower in scope than any patent claim which corresponds to the count and any single patent claim will be presumed, subject to a motion under § 1.633(c), not to contain separate patentable inventions.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985]

**§ 1.607 Request by applicant for interference with patent.**

(a) An applicant may seek to have an interference declared between an application and an unexpired patent by (1) presenting a proposed count and a claim corresponding to the proposed count and, if any claim of the patent or application does not correspond exactly to the proposed count, explaining why an interference should be declared, (2) identifying the patent and indicating which claim in the application and which claim or claims of the patent correspond to the proposed count, and (3) applying the terms of the application claim corresponding to the count to the disclosure of the application.

(b) When an applicant seeks an interference with a patent, examination of the application, including any appeal to the Board, shall be conducted with special dispatch within the Patent and Trademark Office. The examiner shall determine whether there is interfering subject matter claimed in the application and the patent which is patentable to the applicant subject to a judgment in an interference. If the examiner determines that there is any interfering subject matter, an interference will be declared. If the examiner determines that there is no interfering subject matter, the examiner shall state the reasons why an interference is not being declared and otherwise act on the application.

(c) When an applicant presents a claim which corresponds exactly or substantially to a claim of a patent, the applicant shall identify the patent and the number of the patent claim, unless the claim is presented in response to a suggestion by the examiner. The examiner shall notify the Commissioner of any instance where an applicant fails to identify the patent.

(d) A notice that an applicant is seeking to provoke an interference with a patent will be placed in the file of the patent and a copy of the notice will be sent to the patentee. The identity of the applicant will not be disclosed unless an interference is declared. If a final decision is made not to declare an interference, a notice to that effect will be placed in the patent file and will be sent to the patentee.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985]

**§ 1.608 Interference between an application and a patent; prima facie showing by applicant.**

(a) When the earlier of the filing date or effective filing date of an application is three months or less after the earlier of the filing date or effective filing date of a patent, the applicant, before an interference will be declared, shall file an affidavit alleging that there is a basis upon which applicant is entitled to a judgment relative to the patentee.

(b) When the earlier of the filing date or the effective filing date of an application is more than three months after the earlier of the filing date or the effective filing date under 35 U.S.C. 120 of a patent, the applicant, before an interference will be declared, shall file (1) evidence which may consist of patents or printed publications, other documents, and one or more affidavits which demonstrate that applicant is *prima facie* entitled to a judgment relative to the patentee and (2) an explanation stating with particularity the basis upon which the applicant is *prima facie* entitled to the judgment. Where the basis upon which an

applicant is entitled to judgment relative to a patentee is priority of invention, the evidence shall include affidavits by the applicant, if possible, and one or more corroborating witnesses, supported by documentary evidence, if available, each setting out a factual description of acts and circumstances performed or observed by the affiant, which collectively would *prima facie* entitle the applicant to judgment on priority with respect to the earlier of the filing date or effective filing date of the patent. To facilitate preparation of a record (§ 1.653 (g) and (h)) for final hearing, an applicant should file affidavits on paper which is 8 1/2 x 11 inches (21.8 by 27.9 cm.). The significance of any printed publication or other document which is self-authenticating within the meaning of Rule 902 of the Federal Rules of Evidence or § 1.671(d) and any patent shall be discussed in an affidavit or the explanation. Any printed publication or other document which is not self-authenticating shall be authenticated and discussed with particularity in an affidavit. Upon a showing of sufficient cause, an affidavit may be based on information and belief. If an examiner finds an application to be in condition for declaration of an interference, the examiner will consider the evidence and explanation only to the extent of determining whether a basis upon which the application would be entitled to a judgment relative to the patentee is alleged and, if a basis is alleged, an interference may be declared.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985]

**§ 1.609 Preparation of interference papers by examiner.**

When the examiner determines that an interference should be declared, the examiner shall forward to the Board:

- (a) All relevant application and patent files and
- (b) A statement identifying:

- (1) The proposed count or counts;
- (2) The claims of any application or patent which correspond to each count, stating whether the claims correspond exactly or substantially to each count;
- (3) The claims in any application which are deemed by the examiner to be patentable over any count; and
- (4) Whether an applicant or patentee is entitled to the benefit of the filing date of an earlier application and, if so, sufficient information to identify the earlier application.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985]

**§ 1.610 Assignment of interference to examiner-in-chief, time period for completing interference.**

(a) Each interference will be declared by an examiner-in-chief who may enter all interlocutory orders in the interference, except that only a panel consisting of at least three members of the Board shall (1) hear oral argument at final hearing, (2) enter a decision under §§ 1.617, 1.640(c) or (e), 1.652, 1.656(i) or 1.658 or (3) enter any other order which terminates the interference.

(b) As necessary, another examiner-in-chief may act in place of the one who declared the interference. Unless otherwise provided in this section, at the discretion of the examiner-in-chief assigned to the interference, a panel consisting of two or more members of the Board may enter interlocutory orders.

(c) Unless otherwise provided in this subpart, times for taking action by a party in the interference will be set on a case-by-case basis by the examiner-in-chief assigned to the interference. Times for taking action shall be set and the examiner-in-chief shall exercise control over the interference such that the pendency of the interference before the Board does not normally exceed two years.

(d) An examiner-in-chief may hold a conference with the parties to consider: (1) Simplification of any issues, (2) the necessity or desirability of amendments to counts, (3) the possibility of obtaining admissions of fact and genuineness of documents which will avoid unnecessary proof, (4) any limitations on the number of expert witnesses, (5) the time and place for conducting a deposition (§ 1.673(g)), and (6) any other matter as may aid in the disposition of the interference. After a conference, the examiner-in-chief may enter any order which may be appropriate.

(e) The examiner-in-chief may determine a proper course of conduct in an interference for any situation not specifically covered by this part.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985]

#### § 1.611 Declaration of interference.

(a) Notice of declaration of an interference will be sent to each party.

(b) When a notice of declaration is returned to the Patent and Trademark Office undelivered, or in any other circumstance where appropriate, an examiner-in-chief may (1) send a copy of the notice to a patentee named in a patent involved in an interference or the patentee's assignee of record in the Patent and Trademark Office or (2) order publication of an appropriate notice in the *Official Gazette*.

(c) The notice of declaration shall specify:

(1) The name and residence of each party involved in the interference.

(2) The name and address of record of any attorney or agent of record in any application or patent involved in the interference;

(3) The name of any assignee of record in the Patent and Trademark Office;

(4) The identity of any application or patent involved in the interference;

(5) Where a party is accorded the benefit of the filing date of an earlier application, the identity of the earlier application;

(6) The count or counts;

(7) The claim or claims of any application or any patent which correspond to each count; and

(8) The order of the parties.

(d) The notice of declaration may also specify the time for: (1) Filing a preliminary statement as provided in § 1.621(a); (2) serving notice that a preliminary statement has been filed as provided in § 1.621(b); and (3) filing preliminary motions authorized by § 1.633, oppositions to the motions, and replies to the oppositions.

(e) Notice may be given in the *Official Gazette* that an interference has been declared involving a patent.

[49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; 50 FR 23123, May 31, 1985, ]

#### § 1.612 Access to applications.

(a) After an interference is declared, each party shall have access to and may obtain copies of the files of any application set out in the notice declaring the interference, except for affidavits filed under § 1.131 and any evidence and explanation under § 1.608 filed separate from an amendment.

(b) After preliminary motions under § 1.633 are decided (§ 1.640(b)), each party shall have access to and may obtain copies of any affidavit filed under § 1.131 and any evidence and explanation filed under § 1.608 in any application set out in the notice declaring the interference.

(c) Any evidence and explanation filed under § 1.608 in the file of any application identified in the notice declaring the interference shall be served when required by § 1.617(b).

(d) The parties at any time may agree to exchange copies of papers in the files of any application identified in the notice identifying the interference.

[49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; 50 FR 23124, May 31, 1985]

#### § 1.613 Lead attorney, same attorney representing different parties in an interference, withdrawal of attorney or agent.

(a) Each party may be required to designate one attorney or agent of record as the lead attorney or agent.

(b) The same attorney or agent or members of the same firm of attorneys or agents may not represent two or more parties in an interference except as may be permitted under this Chapter.

(c) An examiner-in-chief may make necessary inquiry to determine whether an attorney or agent should be disqualified from representing a party in an interference. If an examiner-in-chief is of the opinion that an attorney or agent should be disqualified, the examiner-in-chief shall refer the matter to the Commissioner. The Commissioner will make a final decision as to whether any attorney or agent should be disqualified.

(d) No attorney or agent of record in an interference may withdraw as attorney or agent of record except with the approval of an examiner-in-chief and after reasonable notice to the party on whose behalf the attorney or agent has appeared. A request to withdraw as attorney or agent of record in an interference shall be made by motion (§ 1.635).

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985]

#### § 1.614 Jurisdiction over interference.

(a) The Board shall assume jurisdiction over an interference when the interference is declared under § 1.611.

(b) When the interference is declared the interference is a contested case within the meaning of 35 U.S.C. 24.

(c) The examiner shall have jurisdiction over any pending application until the interference is declared. An examiner-in-chief, where appropriate, may for a limited purpose restore jurisdiction to the examiner over any application involved in the interference.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985]

#### § 1.615 Suspension of ex parte prosecution.

(a) When an interference is declared, *ex parte* prosecution

of an application involved in the interference is suspended. Amendments and other papers related to the application received during pendency of the interference will not be entered or considered in the interference without the consent of an examiner-in-chief.

(b) *Ex parte* prosecution as to specified matters may be continued concurrently with the interference with the consent of the examiner-in-chief.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985]

### § 1.616 Sanctions for failure to comply with rules or order.

An examiner-in-chief or the Board may impose an appropriate sanction against a party who fails to comply with the regulations of this part or any order entered by an examiner-in-chief or the Board. An appropriate sanction may include among others entry of an order:

(a) Holding certain facts to have been established in the interference;

(b) Precluding a party from filing a motion or a preliminary statement;

(c) Precluding a party from presenting or contesting a particular issue;

(d) Precluding a party from requesting, obtaining, or opposing discovery; or

(e) Granting judgment in the interference.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985, 50 FR 23124, May 31, 1985]

### § 1.617 Summary judgment against applicant.

(a) An examiner-in-chief shall review any evidence filed by an applicant under § 1.608(b) to determine if the applicant is *prima facie* entitled to a judgment relative to the patentee. If the examiner-in-chief determines that the evidence shows the applicant is *prima facie* entitled to a judgment relative to the patentee, the interference shall proceed in the normal manner under the regulations of this part. If in the opinion of the examiner-in-chief the evidence fails to show that the applicant is *prima facie* entitled to a judgment relative to the patentee, the examiner-in-chief shall, concurrently with the notice declaring the interference, enter an order stating the reasons for the opinion and directing the applicant, within a time set in the order, to show cause why summary judgment should not be entered against the applicant.

(b) The applicant may file a response to the order and state any reasons why summary judgment should not be entered. Any request by the applicant for a hearing before the Board shall be made in the response. Additional evidence shall not be presented by the applicant or considered by the Board unless the applicant shows good cause why any additional evidence was not initially presented with the evidence filed under § 1.608(b). At the time an applicant files a response, the applicant shall serve on each opponent a copy of any evidence filed under § 1.608(b) and this paragraph.

(c) If a response is not timely filed by the applicant, the Board shall enter a final decision granting summary judgment

against the applicant.

(d) If a response is timely filed by the applicant, all opponents may file a statement within a time set by the examiner-in-chief. The statement may set forth views as to why summary judgment should be granted against the applicant, but the statement shall be limited to discussing why all the evidence presented by the applicant does not overcome the reasons given by the examiner-in-chief for issuing the order to show cause. Evidence shall not be filed by any opponent. An opponent may not request a hearing.

(e) Within a time authorized by the examiner-in-chief, an applicant may file a reply to any statement filed by any opponent.

(f) When more than two parties are involved in an interference, all parties may participate in summary judgment proceedings under this section.

(g) If a response by the applicant is timely filed, the examiner-in-chief or the Board shall decide whether the evidence submitted under § 1.608(b) and any additional evidence properly submitted under paragraph (b) of this section shows that the applicant is *prima facie* entitled to a judgment relative to the patentee. If the applicant is not *prima facie* entitled to a judgment relative to the patentee, the Board shall enter a final decision granting summary judgment against the applicant. Otherwise, an interlocutory order shall be entered authorizing the interference to proceed in the normal manner under the regulations of this subpart.

(h) Only an applicant who filed evidence under § 1.608(b) may request a hearing. If that applicant requests a hearing, the Board may hold a hearing prior to entry of a decision under paragraph (g) of this section. The examiner-in-chief shall set a date and time for the hearing. Unless otherwise ordered by the examiner-in-chief or the Board, the applicant and any opponent will each be entitled to no more than 30 minutes of oral argument at the hearing.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985]

### § 1.618 Return of unauthorized papers.

(a) The Patent and Trademark Office shall return to a party any paper presented by the party when the filing of the paper is not authorized by, or is not in compliance with the requirements of, this subpart. Any paper returned will not thereafter be considered by the Patent and Trademark Office in the interference. A party may be permitted to file a corrected paper under such conditions as may be deemed appropriate by an examiner-in-chief.

(b) When presenting a paper in an interference, a party shall not submit with the paper a copy of a paper previously filed in the interference.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985]

### § 1.621 Preliminary statement, time for filing, notice of filing.

(a) Within the time set for filing preliminary motions under § 1.633, each party may file a preliminary statement. The preliminary statement may be signed by any individual having

knowledge of the facts recited therein or by an attorney or agent of record.

(b) When a party files a preliminary statement, the party shall also simultaneously file and serve on all opponents in the interference a notice stating that a preliminary statement has been filed. A copy of the preliminary statement need not be served until ordered by the examiner-in-chief.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985]

#### § 1.622 Preliminary statement, who made invention, where invention made.

(a) A party's preliminary statement must identify the inventor who made the invention defined by each count and must state on behalf of the inventor the facts required by paragraph (a) of §§ 1.623, 1.624, and 1.625 as may be appropriate. When an inventor identified in the preliminary statement is not an inventor named in the party's application or patent, the party shall file a motion under § 1.634 to correct inventorship.

(b) The preliminary statement shall state whether the invention was made in the United States or abroad. If made abroad, the preliminary statement shall state whether the party is entitled to the benefit of the second sentence of 35 U.S.C. 104.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985]

#### § 1.623 Preliminary statement; invention made in United States.

(a) When the invention was made in the United States or a party is entitled to the benefit of the second sentence of 35 U.S.C. 104, the preliminary statement must state the following facts as to the invention defined by each count:

(1) The date on which the first drawing of the invention was made.

(2) The date on which the first written description of the invention was made.

(3) The date on which the invention was first disclosed by the inventor to another person.

(4) The date on which the invention was first conceived by the inventor.

(5) The date on which the invention was first actually reduced to practice. If the invention was not actually reduced to practice by or on behalf of the inventor prior to the party's filing date, the preliminary statement shall so state.

(6) The date after the inventor's conception of the invention when active exercise of reasonable diligence toward reducing the invention to practice began.

(b) If a party intends to prove derivation, the preliminary statement must also comply with § 1.625.

(c) When a party alleges under paragraph (a)(1) of this section that a drawing was made, a copy of the first drawing shall be filed with and identified in the preliminary statement. When a party alleges under paragraph (a)(2) of this section that a written description of the invention was made, a copy of the first written description shall be filed with and identified in the preliminary statement. See § 1.628(b) when a copy of the first drawing or written description cannot be filed with the preliminary statement.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985]

#### § 1.624 Preliminary statement; invention made abroad.

(a) When the invention was made abroad and a party intends to rely on introduction of the invention into the United States, the preliminary statement must state the following facts as to the invention defined by each count.

(1) The date on which a drawing of the invention was first introduced into the United States.

(2) The date on which a written description of the invention was first introduced into the United States.

(3) The date on which the invention was first disclosed to another person in the United States.

(4) The date on which the inventor's conception of the invention was first introduced into the United States.

(5) The date on which an actual reduction to practice of the invention was first introduced into the United States. If an actual reduction to practice of the invention was not introduced into the United States, the preliminary amendment shall so state.

(6) The date after introduction of the inventor's conception into the United States when active exercise of reasonable diligence in the United States toward reducing the invention to practice began.

(b) If a party intends to prove derivation, the preliminary statement must also comply with § 1.625.

(c) When a party alleges under paragraph (a)(1) of this section that a drawing was introduced into the United States a copy of that drawing shall be filed with and identified in the preliminary statement. When a party alleges under paragraph (a)(2) of this section that a written description of the invention was introduced into the United States a copy of that written description shall be filed with and identified in the preliminary statement. See § 1.628(b) when a copy of the first drawing or first written description introduced in the United States cannot be filed with the preliminary statement.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985]

#### § 1.625 Preliminary statement; derivation by an opponent.

(a) When the invention was made in the United States or abroad and a party intends to prove derivation by an opponent from the party, the preliminary statement must state the following as to the invention defined by each count:

(1) The name of the opponent.

(2) The date on which the first drawing of the invention was made.

(3) The date on which the first written description of the invention was made.

(4) The date on which the invention was first disclosed by the inventor to another person.

(5) The date on which the invention was first conceived by the inventor.

(6) The date on which the invention was first communicated to the opponent.

(b) If a party intends to prove priority, the preliminary

statement must also comply with § 1.623 or § 1.624.

(c) When a party alleges under paragraph (a)(2) of this section that a drawing was made, a copy of the first drawing shall be filed with and identified in the preliminary statement. When a party alleges under paragraph (a)(3) of this section that a written description of the invention was made, a copy of the first written description shall be filed with and identified in the preliminary statement. See § 1.628(b) when a first drawing or first written description cannot be filed with the preliminary statement.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985]

#### § 1.626 Preliminary statement; earlier application.

When a party does not intend to present evidence to prove a conception or an actual reduction to practice and the party intends to rely solely on the filing date of an earlier application filed in the United States or abroad to prove a constructive reduction to practice, the preliminary statement may so state and identify the earlier application with particularity.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985]

#### § 1.627 Preliminary statement, sealing before filing, opening of statement.

(a) The preliminary statement and copies of any drawing or written description shall be filed in a sealed envelope bearing only the name of the party filing the statement and the style (e.g., Jones v. Smith) and number of the interference. The sealed envelope should contain only the preliminary statement and copies of any drawing or written description. If the preliminary statement is filed through the mail, the sealed envelope should be enclosed in an outer envelope addressed to the Commissioner of Patents and Trademarks in accordance with § 1.1(e).

(b) A preliminary statement may be opened only at the direction of an examiner-in-chief.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985]

#### § 1.628 Preliminary statement, correction of error.

(a) A material error arising through inadvertence or mistake in connection with (1) a preliminary statement or (2) drawings or a written description submitted therewith or omitted therefrom, may be corrected by a motion (§ 1.635) for leave to file a corrected statement. The motion shall be supported by an affidavit and shall show that the correction is essential to the ends of justice and shall be accompanied by the corrected statement. The motion shall be filed as soon as practical after discovery of the error.

(b) When a party cannot attach a copy of a drawing or a written description to the party's preliminary statement as required by §§ 1.623(c), 1.624(c), or 1.625(c), the party (1) shall show good cause and explain in the preliminary statement why a copy of the drawing or written description cannot be attached to the preliminary statement and (2) shall attach to the preliminary statement the earliest drawing or written description made in or introduced into the United States which is available. The party shall file a motion (§ 1.635) to amend its preliminary statement promptly after the first drawing, first written description, or drawing or written description first introduced into the

United States becomes available. A copy of the drawing or written description may be obtained, where appropriate, by a motion (§ 1.635) for additional discovery under § 1.687 or during a testimony period.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985]

#### § 1.629 Effect of preliminary statement.

(a) A party shall be strictly held to any date alleged in the preliminary statement. Doubts as to (1) definiteness or sufficiency of any allegation in a preliminary statement or (2) compliance with formal requirements will be resolved against the party filing the statement by restricting the party to the earlier of its filing date or effective filing date or to the latest date of a period alleged in the preliminary statement as may be appropriate. A party may not correct a preliminary statement except as provided in § 1.628.

(b) Evidence which shows that an act alleged in the preliminary statement occurred prior to the date alleged in the statement shall establish only that the act occurred as early as the date alleged in the statement.

(c) If a party does not file a preliminary statement, the party:

(1) Shall be restricted to the earlier of the party's filing date or effective filing date and

(2) Will not be permitted to prove that:

(i) The party made the invention prior to the party's filing date or

(ii) Any opponent derived the invention from the party.

(d) If a party files a preliminary statement which contains an allegation of a date of first drawing or first written description and the party does not file a copy of the first drawing or written description with the preliminary statement as required by § 1.623(c), § 1.624(c), or § 1.625(c), the party will be restricted to the earlier of the party's filing date or effective filing date as to that allegation unless the party complies with § 1.628(b). The content of any drawing or written description submitted with a preliminary statement will not normally be evaluated or considered by the Board.

(e) A preliminary statement shall not be used as evidence on behalf of the party filing the statement.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985]

#### § 1.630 Reliance on earlier application.

A party shall not be entitled to rely on the filing date of an earlier application filed in the United States or abroad unless (a) the earlier application is identified (§ 1.611(c)(5)) in the notice declaring the interference or (b) the party files a preliminary motion under § 1.633 seeking the benefit of the filing date of the earlier application.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985]

#### § 1.631 Access to preliminary statement, service of preliminary statement.

(a) Unless otherwise ordered by an examiner-in-chief, concurrently with entry of a decision by the examiner-in-chief on preliminary motions filed under § 1.633, any preliminary statement filed under § 1.621(a) shall be opened to inspection by the senior party and any junior party who filed a preliminary

statement. Within a time set by the examiner-in-chief, a party shall serve a copy of its preliminary statement on each opponent who served a notice under § 1.621(b).

(b) A junior party who does not file a preliminary statement shall not have access to the preliminary statement of any other party.

(c) If an interference is terminated before the preliminary statements have been opened, the preliminary statements will remain sealed and will be returned to the respective parties who submitted the statements.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985]

**§ 1.632 Notice of intent to argue abandonment, suppression or concealment by opponent.**

A notice shall be filed by a party who intends to argue that an opponent has abandoned, suppressed or concealed an actual reduction to practice (35 U.S.C. 102(g)). A party will not be permitted to argue abandonment, suppression, or concealment by an opponent unless the notice is timely filed. Unless authorized otherwise by an examiner-in-chief, a notice is timely when filed within ten (10) days of the close of the testimony-in-chief of the opponent.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985]

**§ 1.633 Preliminary motions.**

A party may file the following preliminary motions:

(a) A motion for judgment on the ground that an opponent's claim corresponding to a count is not patentable to the opponent. In determining a motion filed under this paragraph, a claim may be construed by reference to the prior art of record. A motion under this paragraph shall not be based on: (1) Priority of invention of the subject matter of a count by the moving party as against any opponent or (2) derivation of the subject matter of a count by an opponent from the moving party. See § 1.637(a).

(b) A motion for judgment on the ground that there is no interference-in-fact. A motion under this paragraph is proper only if: (1) The interference involves a design application or patent or a plant application or patent or (2) no claim of a party which corresponds to a count is identical to any claim of an opponent which corresponds to that count. See § 1.637(a).

(c) A motion to redefine the interfering subject matter by (1) adding or substituting a count, (2) amending an application claim corresponding to a count or adding a claim in the moving party's application to be designated to correspond to a count, (3) designating an application or patent claim to correspond to a count, (4) designating an application or patent claim as not corresponding to a count, or (5) requiring an opponent who is an applicant to add a claim and to designate the claim to correspond to a count. See § 1.637(a) and (c).

(d) A motion to substitute a different application owned by a party for an application involved in the interference. See § 1.637(a) and (d).

(e) A motion to declare an additional interference (1) between an additional application not involved in the interference and owned by a party and an opponent's application or patent involved in the interference or (2) when an interference

involves three or more parties, between less than all applications and any patent involved in the interference. See § 1.637 (a) and (e).

(f) A motion to be accorded the benefit of the filing date of an earlier application filed in the United States or abroad. See § 1.637 (a) and (f).

(g) A motion to attack the benefit accorded an opponent in the notice declaring the interference of the filing date of an earlier application filed in the United States or abroad. See § 1.637 (a) and (g).

(h) When a patent is involved in an interference and the patentee has on file or files an application for reissue under § 1.171, a motion to add the application for reissue to the interference. See § 1.637(a) and (h).

(i) When a motion is filed under paragraph (a), (b), or (g) of this section, an opponent, in addition to opposing the motion, may file a motion to redefine the interfering subject matter under paragraph (c) of this section or a motion to substitute a different application under paragraph (d) of this section.

(j) When a motion is filed under paragraph (c)(1) of this section an opponent, in addition to opposing the motion, may file a motion for benefit under paragraph (f) of this section as to the count to be added or substituted.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985]

**§ 1.634 Motion to correct inventorship.**

A party may file a motion to (a) amend its application involved in an interference to correct inventorship as provided by § 1.48 or (b) correct inventorship of its patent involved in an interference as provided in § 1.324. See § 1.637(a).

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985]

**§ 1.635 Miscellaneous motions.**

A party seeking entry of an order relating to any matter other than a matter which may be raised under § 1.633 or § 1.634 may file a motion requesting entry of the order. See § 1.637 (a) and (b).

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985]

**§ 1.636 Motions, time for filing.**

(a) A preliminary motion under § 1.633 (a) through (h) shall be filed within a time period set by an examiner-in-chief.

(b) A preliminary motion under § 1.633 (i) or (j) shall be filed within 20 days of the service of the preliminary motion under § 1.633 (a), (b), (c)(1), or (g) unless otherwise ordered by an examiner-in-chief.

(c) A motion under § 1.634 shall be diligently filed after an error is discovered in the inventorship of an application or patent involved in an interference unless otherwise ordered by an examiner-in-chief.

(d) A motion under § 1.635 shall be filed as specified in this subpart or when appropriate unless otherwise ordered by an examiner-in-chief.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985 ]

**§ 1.637 Content of motions.**

(a) Every motion shall include (1) a statement of the precise relief requested, (2) a statement of the material facts in support of the motion, and (3) a full statement of the reasons why the relief requested should be granted.

(b) A motion under § 1.635 shall contain a certificate by the moving party stating that the moving party has conferred with all opposing parties in an effort in good faith to resolve by agreement the issues raised by the motion. A moving party shall indicate in the motion whether an other party plans to oppose the motion. The provisions of this paragraph do not apply to a motion to suppress evidence (§ 1.656(h)).

(c) A preliminary motion under § 1.633(c) shall explain why the interfering subject matter should be redefined.

(1) A preliminary motion seeking to add or substitute a count shall:

(i) Propose each count to be added or substituted.

(ii) When the moving party is an applicant, show the patentability to the applicant of all claims in, or proposed to be added to, the party's application which correspond to each proposed count and apply the terms of the claims to the disclosure of the party's application; when necessary a moving party applicant shall file with the motion an amendment adding any proposed claim to the application.

(iii) Identify all claims in an opponent's application which should be designated to correspond to each proposed count; if an opponent's application does not contain such a claim, the moving party shall propose a claim to be added to the opponent's application. The moving party shall show the patentability of any proposed claims to the opponent and apply the terms of the claims to the disclosure of the opponent's application.

(iv) Designate the claims of any patent involved in the interference which define the same patentable invention as each proposed count.

(v) Show that each proposed count defines a separate patentable invention from every other count in the interference.

(vi) Be accompanied by a motion under § 1.633(f) requesting the benefit of the filing date of any earlier application filed in the United States or abroad.

(2) A preliminary motion seeking to amend an application claim corresponding to a count or adding a claim to be designated to correspond to a count shall:

(i) Propose an amended or added claim.

(ii) Show that the proposed or added claim defines the same patentable invention as the count.

(iii) Show the patentability to the applicant of each amended or added claim and apply the terms of the amended or added claim to the disclosure of the application; when necessary a moving party applicant shall file with the motion an amendment making the amended or added claim to the application.

(iv) Be accompanied by a motion under § 1.633(f) requesting the benefit of the filing date of any earlier application filed in the United States or abroad.

(3) A preliminary motion seeking to designate an application or patent claim to correspond to a count shall:

(i) Identify the claim and the count.

(ii) Show the claim defines the same patentable invention as the count.

(iii) Be accompanied by a motion under § 1.633(f) requesting the benefit of the filing date of any earlier application filed in the United States or abroad.

(4) A preliminary motion seeking to designate an application or patent claim as not corresponding to a count shall:

(i) Identify the claim and the count.

(ii) Show the claim does not define the same patentable invention as any other claim designated in the notice declaring the interference as corresponding to the count.

(5) A preliminary motion seeking to require an opponent who is an applicant to add a claim and designate the claim as corresponding to a count shall:

(i) Propose a claim to be added by the opponent.

(ii) Show the patentability to the opponent of the claim and apply the terms of the claim to the disclosure of the opponent's application.

(iii) Identify the count to which the claim shall be designated to correspond.

(iv) Show the claim defines the same patentable invention as the count to which it will be designated to correspond.

(d) A preliminary motion under § 1.633(d) to substitute a different application shall:

(1) Identify the different application.

(2) Certify that a complete copy of the file of the different application, except for documents filed under § 1.131 or § 1.608, has been served on all opponents.

(3) Show the patentability to the applicant of all claims in, or proposed to be added to, the different application which correspond to each count and apply the terms of the claims to the disclosure of the different application; when necessary the applicant shall file with the motion an amendment adding a claim to the different application.

(4) Be accompanied by a motion under § 1.633(f) requesting the benefit of the filing date of an earlier application filed in the United States or abroad.

(e) A preliminary motion to declare an additional interference under § 1.633(e) shall explain why an additional interference is necessary.

(1) When the preliminary motion seeks an additional interference under § 1.633(e)(1), the motion shall:

(i) Identify the additional application.

(ii) Certify that a complete copy of the file of the additional application, except for documents filed under § 1.131 or § 1.608, has been served on all opponents.

(iii) Propose a count for the additional interference.

(iv) Show the patentability to the applicant of all claims in, or proposed to be added to, the additional application which correspond to each proposed count for the additional interference and apply the terms of the claims to the disclosure of the additional application; when necessary the applicant shall file with the motion an amendment adding any claim to the additional application.

(v) When the opponent is an applicant, show the patentability to the opponent of any claims in, or proposed to be added to, the opponent's application which correspond to the proposed



count and apply the terms of the claims to the disclosure of the opponent's application.

(vi) When the opponent is a patentee, designate the claims of the patent which define the same patentable invention defined by the proposed count.

(vii) Show that each proposed count for the additional interference defines a separate patentable invention from all counts of the interference in which the motion is filed.

(viii) Be accompanied by a motion under § 1.633(f) requesting the benefit of the filing date of an earlier application filed in the United States or abroad.

(2) When the preliminary motion seeks an additional interference under § 1.633(e)(2), the motion shall:

(i) Identify any application or patent to be involved in the additional interference.

(ii) Propose a count for the additional interference.

(iii) When the moving party is an applicant, show the patentability to the applicant of all claims in, or proposed to be added to, the party's application which correspond to each proposed count and apply the terms of the claims to the disclosure of the party's application; when necessary a moving party applicant shall file with the motion an amendment adding any proposed claim to the application.

(iv) Identify all claims in any opponent's application which should be designated to correspond to each proposed count; if an opponent's application does not contain such a claim, the moving party shall propose a claim to be added to the opponent's application. The moving party shall show the patentability of any proposed claim to the opponent and apply the terms of the claim to the disclosure of the opponent's application.

(v) Designate the claims of any patent involved in the interference which define the same patentable invention as each proposed count.

(vi) Show that each proposed count for the additional interference defines a separate patentable invention from all counts in the interference in which the motion is filed.

(vii) Be accompanied by a motion under § 1.633(f) requesting the benefit of the filing date of an earlier application filed in the United States or abroad.

(f) A preliminary motion for benefit under § 1.633(f) shall:

(1) Identify the earlier application.

(2) When the earlier application is an application filed in the United States, certify that a complete copy of the file of the earlier application, except for documents filed under § 1.131 or § 1.608, has been served on all opponents. When the earlier application is an application filed abroad, certify that a copy of the application filed abroad has been served on all opponents. If the earlier application filed abroad is not in English, the requirements of § 1.647 must also be met.

(3) Show that the earlier application constitutes a constructive reduction to practice of each count.

(g) A preliminary motion to attack benefit under § 1.633(g) shall explain, as to each count, why an opponent should not be accorded the benefit of the filing date of the earlier application.

(h) A preliminary motion to add an application for reissue under § 1.633(h) shall:

(1) Identify the application for reissue.

(2) Certify that a complete copy of the file of the application for reissue has been served on all opponents.

(3) Show the patentability of all claims in, or proposed to be added to, the application for reissue which correspond to each count and apply the terms of the claims to the disclosure of the application for reissue; when necessary a moving applicant for reissue shall file with the motion an amendment adding any proposed claim to the application for reissue.

(4) Be accompanied by a motion under § 1.633(f) requesting the benefit of the filing date of an earlier application filed in the United States or abroad.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985]

#### § 1.638 Opposition and reply, time for filing opposition and reply.

(a) Unless otherwise ordered by the examiner-in-chief, any opposition to any motion shall be filed within 20 days after service of the motion. An opposition shall (1) identify any material fact set forth in the motion which is in dispute and (2) include an argument why the relief requested in the motion should be denied.

(b) Unless otherwise ordered by an examiner-in-chief, a reply shall be filed within 15 days after service of the opposition. A reply shall be directed only to new points raised in the opposition.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985]

#### § 1.639 Evidence in support of motion, opposition, or reply.

(a) Proof of any material fact alleged in a motion, opposition, or reply must be filed and served with the motion, opposition, or reply unless the proof relied upon is part of the interference file or the file of any patent or application involved in the interference or any earlier application filed in the United States of which a party has been accorded or seeks to be accorded benefit.

(b) Proof may be in the form of patents, printed publications, and affidavits.

(c) When a party believes the testimony is necessary to support or oppose a preliminary motion under § 1.633 or a motion to correct inventorship under § 1.634, the party shall describe the nature of the testimony needed. If the examiner-in-chief finds that testimony is needed to decide the motion, the examiner-in-chief may grant appropriate interlocutory relief and enter an order authorizing the taking of testimony and deferring a decision on the motion to final hearing.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985]

#### § 1.640 Motions, hearing and decision, redeclaration of interference, order to show cause.

(a) A hearing on a motion may be held in the discretion of the examiner-in-chief. The examiner-in-chief shall set the date and time for any hearing. The length of oral argument at a hearing on a motion is a matter within the discretion of the examiner-in-chief. An examiner-in-chief may direct that a hearing take place by telephone.

(b) Motions will be decided by an examiner-in-chief. An examiner-in-chief may consult with an examiner in deciding motions involving a question of patentability. An examiner-in-chief may grant or deny any motion or take such other action which will secure the just, speedy, and inexpensive determination of the interference.

(1) When preliminary motions under § 1.633 are decided, the examiner-in-chief will, when necessary, set a time for filing any amendment to an application involved in the interference and for filing a supplemental preliminary statement as to any new counts involved in the interference. Failure or refusal of a party to timely present an amendment required by an examiner-in-chief shall be taken without further action as a disclaimer by that party of the invention involved. A supplemental preliminary statement shall meet the requirements specified in § 1.623, § 1.624, § 1.625, or § 1.626, but need not be filed if a party states that it intends to rely on a preliminary statement previously filed under § 1.621(a). After the time expires for filing any amendment and supplemental preliminary statement, the examiner-in-chief will, if necessary, redeclare the interference.

(2) After a decision is entered on preliminary motions filed under § 1.633, a further motion under § 1.633 will not be considered except as provided by § 1.655(b).

(c) When a decision on any motion under § 1.633, § 1.634, or § 1.635 is entered which does not result in the issuance of an order to show cause under paragraph (d) of this section, a party may file a request for reconsideration within 14 days after the date of the decision. The filing of a request for reconsideration will not stay any time period set by the decision. The request for reconsideration shall specify with particularity the points believed to have been misapprehended or overlooked in rendering the decision. No opposition to a request for reconsideration shall be filed unless requested by an examiner-in-chief or the Board. A decision of a single examiner-in-chief will not ordinarily be modified unless an opposition has been requested by an examiner-in-chief or the Board. The request for reconsideration shall be acted on by a panel of the Board consisting of at least three examiners-in-chief, one of whom will normally be the examiner-in-chief who decided the motion.

(d) An examiner-in-chief may issue an order to show cause why judgment should not be entered against a party when:

(1) A decision on a motion is entered which is dispositive of the interference against the party as to any count;

(2) The party is a junior party who fails to file a preliminary statement; or

(3) The party is a junior party whose preliminary statement fails to overcome the earlier of the filing date or effective filing date of another party.

(e) When an order to show cause is issued under paragraph (d) of this section, the Board shall enter a judgment in accordance with the order unless, within 20 days after the date of the order, the party against whom the order issued files a paper which shows good cause why judgment should not be entered in accordance with the order. Any other party may file a response to the paper within 20 days of the date of service of the paper. If the party against whom the order was issued fails to show good cause, the Board shall enter judgment against the party. If

a party wishes to take testimony in response to an order to show cause, the party's response should be accompanied by a motion (§ 1.635) requesting the testimony period. See § 1.651(c)(4). [49 FR 48416, Dec. 12, 1984; added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985]

#### § 1.641 Unpatentability discovered by examiner-in-chief.

During the pendency of an interference, if the examiner-in-chief becomes aware of a reason why a claim corresponding to a count may not be patentable, the examiner-in-chief may notify the parties of the reason and set a time within which each party may present its views. After considering any timely filed views, the examiner-in-chief shall decide how the interference shall proceed.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985]

#### § 1.642 Addition of application or patent to interference.

During the pendency of an interference, if the examiner-in-chief becomes aware of an application or a patent not involved in the interference which claims the same patentable invention as a count in the interference, the examiner-in-chief may add the application or patent to the interference on such terms as may be fair to all parties.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985]

#### § 1.643 Prosecution of interference by assignee.

(a) An assignee of record in the Patent and Trademark Office of the entire interest in an application or patent involved in an interference is entitled to conduct prosecution of the interference to the exclusion of the inventor.

(b) An assignee of a part interest in an application or patent involved in an interference may file a motion (§ 1.635) for entry of an order authorizing it to prosecute the interference. The motion shall show (1) the inability or refusal of the inventor to prosecute the interference or (2) other cause why the ends of justice require that the assignee of a part interest be permitted to prosecute the interference. The examiner-in-chief may allow the assignee of a part interest to prosecute the interference upon such terms as may be appropriate.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985]

#### § 1.644 Petitions in interferences.

(a) There is no appeal to the Commissioner in an interference from a decision of an examiner-in-chief or a panel consisting of more than one examiner-in-chief. The Commissioner will not consider a petition in an interference unless:

(1) The petition is from a decision of an examiner-in-chief or a panel and the examiner-in-chief or the panel shall be of the opinion (i) that the decision involves a controlling question of procedure or an interpretation of a rule to which there is a substantial ground for a difference of opinion and (ii) that an immediate decision on petition by the Commissioner may materially advance the ultimate termination of the interference;

(2) The petition seeks to invoke the supervisory authority of the Commissioner and is not filed prior to the decision of the Board awarding judgment and does not relate to (i) the merits of

priority of invention or patentability or (ii) the admissibility of evidence under the Federal Rules of Evidence; or

(3) The petition seeks relief under § 1.183.

(b) A petition under paragraph (a)(1) of this section filed more than 15 days after the date of the decision of the examiner-in-chief or the panel may be dismissed as untimely. A petition under paragraph (a)(2) of this section shall not be filed prior to decision by the Board awarding judgment. Any petition under paragraph (a)(3) of this section shall be timely if it is made as part of, or simultaneously with, a proper motion under § 1.633, § 1.634, or § 1.635. Any opposition to a petition shall be filed within 15 days of the date of service of the petition.

(c) The filing of a petition shall not stay the proceeding unless a stay is granted in the discretion of the examiner-in-chief, the panel, or the Commissioner.

(d) Any petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support of the petition or opposition shall accompany or be embodied therein. The petition will be decided on the basis of the record made before the examiner-in-chief or the panel and no new evidence will be considered by the Commissioner in deciding the petition. Copies of documents already of record in the interference shall not be submitted with the petition or opposition.

(e) Any petition under paragraph (a) of this section shall be accompanied by the petition fee set forth in § 1.17(h).

(f) Any request for reconsideration of a decision by the Commissioner shall be filed within 15 days of the decision of the Commissioner and must be accompanied by the fee set forth in § 1.17(h). No opposition to a request for reconsideration shall be filed unless requested by the Commissioner. The decision will not ordinarily be modified unless such an opposition has been requested by the Commissioner.

(g) Where reasonably possible, service of any petition, opposition, or request for reconsideration shall be such that delivery is accomplished within one working day. Service by hand or "Express Mail" complies with this paragraph.

(h) An oral hearing on the petition will not be granted except when considered necessary by the Commissioner.

(i) The Commissioner may delegate to appropriate Patent and Trademark Office employees the determination of petitions under this section.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985]

#### § 1.645 Extension of time, late papers, stay of proceedings.

(a) A party may file a motion (§ 1.635) seeking an extension of time to take action in an interference, to file a notice of appeal (§ 1.302, or § 1.304), or to commence a civil action (§ 1.303, or § 1.304). The motion shall be filed within sufficient time to actually reach the examiner-in-chief before expiration of the time for taking action, filing the notice, or commencing the civil action. A moving party should not assume that the motion will be granted even if there is no objection by any other party. The motion will be denied unless the moving party shows good cause why an extension should be granted. The press of other

business arising after an examiner-in-chief sets a time for taking action will not normally constitute good cause. A motion seeking additional time to take testimony because a party has not been able to procure the testimony of a witness shall set forth the name of the witness, any steps taken to procure the testimony of the witness, the dates on which the steps were taken, and the facts expected to be proved through the witness.

(b) Any paper belatedly filed will not be considered except upon motion (§ 1.635) which shows sufficient cause why the paper was not timely filed.

(c) The provisions of § 1.136 do not apply to time periods in interferences.

(d) In an appropriate circumstance, an examiner-in-chief may stay proceedings in an interference.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985]

#### § 1.646 Service of papers, proof of service.

(a) A copy of every paper filed in the Patent and Trademark Office in an interference or an application or patent involved in the interference shall be served upon all other parties except:

(1) Preliminary statements when filed under § 1.621; preliminary statements shall be served when service is ordered by an examiner-in-chief.

(2) Certified transcripts and exhibits which accompany the transcripts filed under §§ 1.676 or 1.684; copies of transcripts shall be served as part of a party's record under § 1.653(c).

(b) Service shall be on an attorney or agent for a party. If there is no attorney or agent for the party, service shall be on the party. An examiner-in-chief may order additional service or waive service where appropriate.

(c) Unless otherwise ordered by an examiner-in-chief, or except as otherwise provided by this subpart, service of a paper shall be made as follows:

(1) By handing a copy of the paper to the person served.

(2) By leaving a copy of the paper with someone employed by the person at the person's usual place of business.

(3) When the person served has no usual place of business, by leaving a copy of the paper at the person's residence with someone of suitable age and discretion then residing therein.

(4) By mailing a copy of the paper by first class mail; when service is by mail the date of mailing is regarded as the date of service.

(5) When it is shown to the satisfaction of an examiner-in-chief that none of the above methods of obtaining or serving the copy of the paper was successful, the examiner-in-chief may order service by publication of an appropriate notice in the *Official Gazette*.

(d) An examiner-in-chief may order that a paper be served by hand or "Express Mail".

(e) Proof of service must be made before a paper will be considered in an interference. Proof of service may appear on or be affixed to the paper. Proof of service shall include the date and manner of service. In the case of personal service under paragraphs (c)(1) through (c)(3) of this section, proof of service shall include the names of any person served and the person who made the service. Proof of service may be made by an acknowl-

edgment of service by or on behalf of the person served or a statement signed by the party or the party's attorney or agent containing the information required by this section. A statement of an attorney or agent attached to, or appearing in, the paper stating the date and manner of service will be accepted as *prima facie* proof of service.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985]

#### § 1.647 Translation of document in foreign language.

When a party relies on a document in a language other than English, a translation of the document into English and an affidavit attesting to the accuracy of the translation shall be filed with the document.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985]

#### § 1.651 Setting times for discovery and taking testimony, parties entitled to take testimony.

(a) At an appropriate stage in an interference, an examiner-in-chief shall set (1) a time for filing motions (§ 1.635) for additional discovery under § 1.687(c) and (2) testimony periods for taking any necessary testimony.

(b) Where appropriate, testimony periods will be set to permit a party to:

- (1) Present its case-in-chief and/or case-in-rebuttal and/or
- (2) Cross-examine an opponent's case-in-chief and/or a case-in-rebuttal.

(c) A party is not entitled to take testimony to present a case-in-chief unless:

- (1) The examiner-in-chief orders the taking of testimony under § 1.639(c);
- (2) The party alleges in its preliminary statement a date of invention prior to the earlier of the filing date or effective filing date of the senior party;
- (3) A testimony period has been set to permit an opponent to prove a date of invention prior to the earlier of the filing date or effective filing date of the party and the party has filed a preliminary statement alleging a date of invention prior to that date; or
- (4) A motion (§ 1.635) is filed showing good cause why a testimony period should be set.

(d) Testimony shall be taken during the testimony periods set under paragraph (a) of this section.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985]

#### § 1.652 Judgment for failure to take testimony or file record.

If a junior party fails to timely take testimony authorized under § 1.651, or file a record under § 1.653(c), an examiner-in-chief, with or without a motion (§ 1.635) by another party, may issue an order to show cause why judgment should not be entered against the junior party. When an order is issued under this section, the Board shall enter judgment in accordance with the order unless, within 15 days after the date of the order, the junior party files a paper which shows good cause why judgment should not be entered in accordance with the order. Any other party may file a response to the paper within 15 days of the date of service of the paper. If the party against whom the order was

issued fails to show good cause, the Board shall enter judgment against the party.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985]

#### § 1.653 Record and exhibits.

(a) Testimony shall consist of affidavits under § 1.672 (b) and (e), transcripts of depositions under §§ 1.672 (b) and (c), agreed statements of fact under § 1.672(f), and transcripts of interrogatories, cross-interrogatories, and recorded answers under § 1.684(c).

(b) An affidavit shall be filed as set forth in § 1.672 (b) or (e). A certified transcript of a deposition including a deposition cross-examining an affiant, shall be filed as set forth in § 1.676. An original agreed statement shall be filed as set forth in § 1.672(f). A transcript of interrogatories, cross-interrogatories, and recorded answers shall be filed as set forth under § 1.684(c).

(c) In addition to the items specified in paragraph (b) of this section and within a time set by an examiner-in-chief each party shall file three copies and serve one copy of a record consisting of:

(1) An index of the names of each witness giving the pages of the record where the direct testimony and cross-examination of each witness begins.

(2) An index of exhibits briefly describing the nature of each exhibit and giving the page of the record where each exhibit is first identified and offered into evidence.

(3) The count or counts.

(4) Each (i) affidavit, (ii) transcript, including transcripts of cross-examination of any affiant, (iii) agreed statement relied upon by the party, and (iv) transcript of interrogatories, cross-interrogatories, and recorded answers filed under paragraph (b) of this section.

(5) Each notice, official record, and publication relied upon by the party and filed under § 1.682(a).

(6) Any evidence from another interference, proceeding, or action relied upon by the party under § 1.683.

(7) Each request for an admission and the admission and each written interrogatory and the answer upon which a party intends to rely under § 1.688.

(d) The pages of the record shall be consecutively numbered.

(e) The name of each witness shall appear at the top of each page of each affidavit or transcript.

(f) The record may be typewritten or printed.

(g) When the record is printed, it may be produced by standard typographical printing or by any process capable of producing a clear black permanent image. All printed matter except on covers must appear in at least 11 point type on opaque, unglazed paper. Margins must be justified. Footnotes may not be printed in type smaller than 9 point. The pages size shall be 8 1/2 by 11 inches (21.8 by 27.9 cm.) with type matter 6 1/2 by 9 1/2 inches (16.5 by 24.1 cm.). The record shall be bound to lie flat when open.

(h) When the record is typewritten, it must be clearly legible on opaque, unglazed, durable paper approximately 8 1/2 by 11 inches (21.8 by 27.9 cm.) in size (letter size). Typing shall be double-spaced on one side of the paper in not smaller than pica-

type with a margin of 1 1/2 (3.8 cm.) on the left-hand side of the page. The pages of the record shall be bound with covers at their left edges in such manner to lie flat when open in one or more volumes of convenient size (approximately 100 pages per volume is suggested). Multigraphed or otherwise reproduced copies conforming to the standards specified in this paragraph may be accepted.

(i) Each party shall file its exhibits with the record specified in paragraph (c) of this section. One copy of each documentary exhibit shall be served. Documentary exhibits shall be filed in an envelope or folder and shall not be bound as part of the record. Physical exhibits, if not filed by an officer under § 1.676(d), shall be filed with the record. Each exhibit shall contain a label which identifies the party submitting the exhibit and an exhibit number, the style of the interference (e.g., Jones v. Smith), and the interference number. Where possible, the label should appear at the bottom right-hand corner of each documentary exhibit. Upon termination of an interference, an examiner-in-chief may return an exhibit to the party filing the exhibit. When any exhibit is returned, the examiner-in-chief shall enter an appropriate order indicating that the exhibit has been returned.

(j) Any testimony, record, or exhibit which does not comply with this section may be returned under § 1.618(a).

[49 FR 48465, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985]

**§ 1.654 Final hearing.**

(a) At an appropriate stage of the interference, the parties will be given an opportunity to appear before the Board to present oral argument at a final hearing. An examiner-in-chief shall set a date and time for final hearing. Unless otherwise ordered by an examiner-in-chief or the Board, each party will be entitled to no more than 60 minutes of oral argument at final hearing.

(b) The opening argument of a junior party shall include a fair statement of the junior party's case and the junior party's position with respect to the case presented on behalf of any other party. A junior party may reserve a portion of its time for rebuttal.

(c) A party shall not be entitled to argue that an opponent abandoned, suppressed, or concealed an actual reduction to practice unless a notice under § 1.632 was timely filed.

(d) After final hearing, the interference shall be taken under advisement by the Board. No further paper shall be filed except under § 1.658(b) or as authorized by an examiner-in-chief or the Board. No additional oral argument shall be had unless ordered by the Board.

[49 FR 48466, Dec. 12, 1984, added effective Feb. 11, 1985]

**§ 1.655 Matters considered in rendering a final decision.**

(a) In rendering a final decision, the Board may consider any properly raised issue including (1) priority of invention, (2) derivation by an opponent from a party who filed a preliminary statement under § 1.625, (3) patentability of the invention, (4) admissibility of evidence, (5) any interlocutory matter deferred to final hearing, and (6) any other matter necessary to resolve the

interference. The Board may also consider whether any interlocutory order was manifestly erroneous or an abuse of discretion. All interlocutory orders shall be presumed to have been correct and the burden of showing manifest error or an abuse of discretion shall be on the party attacking the order.

(b) A party shall not be entitled to raise for consideration at final hearing a matter which properly could have been raised by a motion under §§ 1.633 or 1.634 unless (1) the motion was properly filed, (2) the matter was properly raised by a party in an opposition to a motion under §§ 1.633 or 1.634 and the motion was granted over the opposition, or (3) the party shows good cause why the issue was not timely raised by motion or opposition.

(c) To prevent manifest injustice, the Board may consider an issue even though it would not otherwise be entitled to consideration under this section.

[49 FR 48466, Dec. 12, 1984, added effective Feb. 11, 1985]

**§ 1.656 Briefs for final hearing.**

(a) Each party shall be entitled to file briefs for final hearing. The examiner-in-chief shall determine the briefs needed and shall set the time and order for filing briefs.

(b) The opening brief of a junior party shall contain under appropriate headings and in the order indicated:

(1) A table of contents, with page references, and a table of cases (alphabetically arranged), statutes, and other authorities cited, with references to the pages of the brief where they are cited.

(2) A statement of the issues presented for decision in the interference.

(3) A statement of the facts relevant to the issues presented for decision with appropriate references to the record.

(4) An argument, which may be preceded by a summary, which shall contain the contentions of the party with respect to the issues to be decided, and the reasons therefor, with citations to the cases, statutes, other authorities, and parts of the record relied on.

(5) A short conclusion stating the precise relief requested.

(6) An appendix containing a copy of the counts.

(c) The opening brief of the senior party shall conform to the requirements of paragraph (b) of this section except:

(1) A statement of the issues and of the facts need not be made unless the party is dissatisfied with the statement in the opening brief of the junior party and

(2) An appendix containing a copy of the counts need not be included if the copy of the counts in the opening brief of the junior party is correct.

(d) Briefs may be printed or typewritten. If typewritten, legal-size paper may be used. The opening brief of each party in excess of 50 legal-size double-spaced typewritten pages or any other brief in excess of 25 legal-size double-spaced typewritten pages shall be printed unless a satisfactory reason be given why the brief should not be printed. Any printed brief shall comply with the requirements of § 1.653(g). Any typewritten brief shall comply with the requirements of § 1.653(h), except legal-size paper may be used and the binding and covers specified are not required.

(e) An original and three copies of each brief must be filed.

(f) Any brief which does not comply with the requirements of this section may be returned under § 1.618(a).

(g) Any party, separate from its opening brief, but filed concurrently therewith, may file an original and three copies of concise proposed findings of fact and conclusions of law. Any proposed findings of fact shall be supported by specific references to the record. Any proposed conclusions of law shall be supported by citation of cases, statutes, or other authority. Any opposing party, separate from its opening or reply brief, but filed concurrently therewith, may file a paper accepting or objecting to any proposed findings of fact or conclusions of law; when objecting, a reason must be given. The Board may adopt the proposed findings of fact and conclusions of law in whole or in part.

(h) If a party wants the Board in rendering its final decision to rule on the admissibility of any evidence, the party shall file with its opening brief an original and three copies of a motion (§ 1.635) to suppress the evidence. The provisions of § 1.637(b) do not apply to a motion to suppress under this paragraph. Any objection previously made to the admissibility of an opponent's evidence is waived unless the motion required by this paragraph is filed. An original and three copies of an opposition to the motion may be filed with an opponent's opening brief or reply brief as may be appropriate.

(i) When a junior party fails to timely file an opening brief, an order may issue requiring the junior party to show cause why the Board should not treat failure to file the brief as a concession of priority. If the junior party fails to respond within a time period set in the order, judgment may be entered against the junior party.

[49 FR 48466, Dec. 12, 1984, added effective Feb. 11, 1985]

#### § 1.657 Burden of proof as to date of invention.

A rebuttable presumption shall exist that, as to each count, the inventors made their invention in the chronological order of the earlier of their filing dates or effective filing dates. The burden of proof shall be upon a party who contends otherwise.

[49 FR 48466, Dec. 12, 1984, added effective Feb. 11, 1985]

#### § 1.658 Final decision.

(a) After final hearing, the Board shall enter a decision resolving the issues raised at final hearing. The decision may (1) enter judgment, in whole or in part, (2) remand the interference to an examiner-in-chief for further proceedings, or (3) take further action not inconsistent with law. A judgment as to a count shall state whether or not each party is entitled to a patent containing the claims in the party's patent or application which correspond to the count. When the Board enters a decision awarding judgment as to all counts, the decision shall be regarded as a final decision.

(b) Any request for reconsideration of a decision under paragraph (a) of this section shall be filed within 14 days after the date of the decision. The request for reconsideration shall specify with particularity the points believed to have been misapprehended or overlooked in rendering the decision. Any reply to a request for reconsideration shall be filed within 14

days of the date of service of the request for reconsideration. Where reasonably possible, service of the request for reconsideration shall be such that delivery is accomplished by hand or "Express Mail." The Board shall enter a decision on the request for reconsideration. If the Board shall be of the opinion that the decision on the request for reconsideration significantly modifies its original decision under paragraph (a) of this section, the Board may designate the decision on the request for reconsideration as a new decision.

(c) A judgment in an interference settles all issues which (1) were raised and decided in the interference, (2) could have been properly raised and decided in the interference by a motion under § 1.633 (a) through (d) and (f) through (j) or § 1.634 and (3) could have been properly raised and decided in an additional interference with a motion under § 1.633(e). A losing party who could have properly moved, but failed to move, under §§ 1.633 or 1.634, shall be estopped to take *ex parte* or *inter partes* action in the Patent and Trademark Office after the interference which is inconsistent with that party's failure to properly move, except that a losing party shall not be estopped with respect to any claims which correspond, or properly could have corresponded, to a count as to which that party was awarded a favorable judgment.

[49 FR 48467, Dec. 12, 1984, added effective Feb. 11, 1985]

#### § 1.659 Recommendation.

(a) Should the Board have knowledge of any ground for rejecting any application claim not involved in the judgment of the interference, it may include in its decision a recommended rejection of the claim. Upon resumption of *ex parte* prosecution of the application, the examiner shall be bound by the recommendation and shall enter and maintain the recommended rejection unless an amendment or showing of facts not previously of record is filed which, in the opinion of the examiner, overcomes the recommended rejection.

(b) Should the Board have knowledge of any ground for reexamination of a patent involved in the interference as to a patent claim not involved in the judgment of the interference, it may include in its decision a recommendation to the Commissioner that the patent be reexamined. The Commissioner will determine whether reexamination will be ordered.

(c) The Board may make any other recommendation to the examiner or the Commissioner as may be appropriate.

[49 FR 48467, Dec. 12, 1984, added effective Feb. 11, 1985]

#### § 1.660 Notice of reexamination, reissue, protest or litigation.

(a) When a request for reexamination of a patent involved in an interference is filed, the patent owner shall notify the Board within 10 days of receiving notice that the request was filed.

(b) When an application for reissue is filed by a patentee involved in an interference, the patentee shall notify the Board within 10 days of the day the application for reissue is filed.

(c) When a protest under § 1.291 is filed against an application involved in an interference, the applicant shall notify the Board within 10 days of receiving notice that the protest was filed.

(d) A party in an interference shall notify the Board promptly of any litigation related to any patent or application involved in an interference, including any civil action commenced under 35 U.S.C. 146.

[49 FR 48467, Dec. 12, 1984, added effective Feb. 11, 1985]

#### § 1.661 Termination of interference after judgment.

After a final decision is entered by the Board, an interference is considered terminated when no appeal (35 U.S.C. 141) or other review (35 U.S.C. 146) has been or can be taken or had.

[49 FR 48467, Dec. 12, 1984, added effective Feb. 11, 1985]

#### § 1.662 Request for entry of adverse judgement; reissue filed by patentee.

(a) A party may, at any time during an interference, request and agree to entry of an adverse judgment. The filing by an applicant or patentee of a written disclaimer of the invention defined by a count, concession of priority or unpatentability of the subject matter of a count, abandonment of the invention defined by a count, or abandonment of the contest as to a count will be treated as a request for entry of an adverse judgment against the applicant or patentee as to all claims which correspond to the count. Abandonment of an application by an applicant, other than an applicant for reissue having a claim of the patent sought to be reissued involved in the interference, will be treated as a request for entry of an adverse judgment against the applicant as to all claims corresponding to all counts. Upon the filing by a party of a request for entry of an adverse judgment, the Board may enter judgment against the party.

(b) If a patentee involved in an interference files an application for reissue during the interference and omits all claims of the patent corresponding to the counts of the interference for the purpose of avoiding the interference, judgment may be entered against the patentee. A patentee who files an application for reissue other than for the purpose of avoiding the interference shall timely file a preliminary motion under § 1.633 (h) or show good cause why the motion could not have been timely filed.

(c) The filing of a statutory disclaimer under 35 U.S.C. 253 by a patentee will delete any statutorily disclaimed claims from being involved in the interference. A statutory disclaimer will not be treated as a request for entry of an adverse judgment against the patentee unless it results in the deletion of all patent claims corresponding to a count.

[49 FR 48467, Dec. 12, 1984, added effective Feb. 11, 1985]

#### § 1.663 Status of claim of defeated applicant after interference.

Whenever an adverse judgment is entered as to a count against an applicant from which no appeal (35 U.S.C. 141) or other review (35 U.S.C. 146) has been or can be taken or had, the claims of the application corresponding to the count stand finally disposed of without further action by the examiner. Such claims are not open to further *ex parte* prosecution.

[49 FR 48467, Dec. 12, 1984, added effective Feb. 11, 1985]

#### § 1.664 Action after interference.

(a) After termination of an interference, the examiner will promptly take such action in any application previously in-

involved in the interference as may be necessary. Unless entered by order of an examiner-in-chief, amendments presented during the interference shall not be entered, but may be subsequently presented by the applicant subject to the provisions of this subpart provided prosecution of the application is not otherwise closed.

(b) After judgement, the application of any party may be held subject to further examination, including an interference with another application.

[49 FR 48467, Dec. 12, 1984, 50 FR 23124, May 31, 1985, added effective Feb. 11, 1985]

#### § 1.665 Second interference.

A second interference between the same parties will not be declared upon an application not involved in an earlier interference for an invention defined by a count of the earlier interference. See § 1.658(c).

[49 FR 48468, Dec. 12, 1984, added effective Feb. 11, 1985]

#### § 1.666 Filing of interference settlement agreements.

(a) Any agreement or understanding between parties to an interference, including any collateral agreements referred to therein, made in connection with or in contemplation of the termination of the interference, must be in writing and a true copy thereof must be filed before the termination of the interference (§ 1.661) as between the parties to the agreement or understanding.

(b) If any party filing the agreement or understanding under paragraph (a) of this section so requests, the copy will be kept separate from the file of the interference, and made available only to Government agencies on written request, or to any person upon petition accompanied by the fee set forth in § 1.17(i) and on a showing of good cause.

(c) Failure to file the copy of the agreement or understanding under paragraph (a) of this section will render permanently unenforceable such agreement or understanding and any patent of the parties involved in the interference or any patent subsequently issued on any application of the parties so involved. The Commissioner may, however, upon petition accompanied by the fee set forth in § 1.17(h) and on a showing of good cause for failure to file within the time prescribed, permit the filing of the agreement or understanding during the six month period subsequent to the termination of the interference as between the parties to the agreement or understanding.

[49 FR 48468, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985]

#### § 1.671 Evidence must comply with rules.

(a) Evidence consists of testimony and exhibits, official records and publications filed under § 1.682, evidence from another interference, proceeding, or action filed under § 1.683, and discovery relied upon under § 1.688, and the specification (including claims) and drawings of any application or patent:

(1) Involved in the interference.

(2) To which a party has been accorded benefit in the notice declaring the interference or by a preliminary motion granted under § 1.633.

(3) For which a party has sought, but has been denied, benefit by a preliminary motion under § 1.633.

(4) For which benefit was rescinded by a preliminary motion granted under § 1.633.

(b) Except as otherwise provided in this subpart, the Federal Rules of Evidence shall apply to interference proceedings. Those portions of the Federal Rules of Evidence relating to criminal actions, juries, and other matters not relevant to interferences shall not apply.

(c) Unless the context is otherwise clear, the following terms of the Federal Rules of Evidence shall be construed as follows:

(1) "Courts of the United States," "U.S. Magistrate," "court," "trial court," or "trier of fact" means examiner-in-chief or Board as may be appropriate.

(2) "Judge" means examiner-in-chief.

(3) "Judicial notice" means official notice.

(4) "Civil action," "civil proceeding," "action," or "trial" mean interference.

(5) "Appellate court" means United States Court of Appeals for the Federal Circuit or a United States district court when judicial review is under 35 U.S.C. 146.

(6) "Before the hearing" in Rule 703 means before giving testimony by oral deposition or affidavit.

(7) "The trial or hearing" in Rules 803(24) and 804(5) means the taking of testimony by oral deposition.

(d) Certification is not necessary as a condition to admissibility when the record is a record of the Patent and Trademark Office to which all parties have access.

(e) A party may not rely on an affidavit filed by that party during *ex parte* prosecution of an application, an affidavit under § 1.608, or an affidavit under § 1.639(b) unless: (1) a copy of the affidavit is or has been served and (2) a written notice is filed prior to the close of the party's relevant testimony period stating that the party intends to rely on the affidavit. When proper notice is given under this paragraph, the affidavit shall be deemed filed under § 1.672(b). A copy of the affidavit shall be included in the record (§ 1.653).

(f) The significance of documentary and other exhibits shall be discussed with particularity by a witness during oral deposition or in an affidavit.

(g) A party must file a motion (§ 1.635) seeking permission from an examiner-in-chief prior to taking testimony or seeking documents or things under 35 U.S.C. 24. The motion shall describe the general nature and the relevance of the testimony, document, or thing.

(h) Evidence which is not taken or sought and filed in accordance with this subpart shall not be admissible.

[49 FR 48468, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985]

### § 1.672 Manner of taking testimony.

(a) Testimony of a witness may be taken by oral deposition or affidavit in accordance with this subpart.

(b) A party wishing to take the testimony of a witness whose testimony will not be compelled under 35 U.S.C. 24 may elect to present the testimony of the witness by affidavit or deposi-

tion. A party electing to present testimony of a witness by affidavit shall, prior to the close of the party's relevant testimony period, file and serve an affidavit of the witness or, where appropriate, a notice under § 1.671(e). To facilitate preparation of the record (§ 1.653 (g) and (h)), a party should file an affidavit on paper which is 8 1/2 by 11 inches (21.8 by 27.9 cm). A party shall not be entitled to rely on any document referred to in the affidavit unless a copy of the document is filed with the affidavit. A party shall not be entitled to rely on any thing mentioned in the affidavit unless the opponent is given reasonable access to the thing. A thing is something other than a document. After the affidavit is filed and within a time set by an examiner-in-chief, any opponent may file a request to cross-examine the witness on oral deposition. If any opponent requests cross-examination of an affiant, the party shall notice a deposition under § 1.673(e) for the purpose of cross-examination by any opponent. Any redirect and recross shall take place at the deposition. At any deposition for the purpose of cross-examination of a witness whose testimony is presented by affidavit, the party shall not be entitled to rely on any document or thing not mentioned in one or more of the affidavits filed under this paragraph, except to the extent necessary to conduct proper redirect. A party electing to present testimony of a witness by deposition shall notice a deposition of the witness under § 1.673(a). The party who gives notice of a deposition shall be responsible for obtaining a court reporter and for filing a certified transcript of the deposition as required by § 1.676.

(c) A party wishing to take the testimony of a witness whose testimony will be compelled under 35 U.S.C. 24 must first obtain permission from an examiner-in-chief under § 1.67(g). If permission is granted, the party shall notice a deposition of the witness under § 1.673 and may proceed under 35 U.S.C. 24. The testimony of the witness shall be taken on oral deposition.

(d) Notwithstanding the provisions of this subpart, if the parties agree in writing, a deposition may be taken before any person authorized to administer oaths, at any place, upon any notice, and in any manner, and when so taken may be used like any other depositions.

(e) If the parties agree in writing, the testimony of any witness may be submitted in the form of an affidavit without opportunity for cross-examination. The affidavit of the witness shall be filed in the Patent and Trademark Office.

(f) If the parties agree in writing, testimony may be submitted in the form of an agreed statement setting forth: (1) How a particular witness would testify if called or (2) the facts in the case of one or more of the parties. The agreed statement shall be filed in the Patent and Trademark Office. See § 1.653(a).

[49 FR 48468, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985]

### § 1.673 Notice of examination of witness.

(a) A party electing to take testimony of a witness by deposition shall, after complying with paragraphs (b) and (g) of this section, file and serve a single notice of deposition stating the time and place of each deposition to be taken. Depositions may be noticed for a reasonable time and place in the United States. Unless the parties agree in writing, a deposition may not



be noticed for any other place without approval of an examiner-in-chief (see § 1.684). The notice shall specify the name and address of each witness and the general nature of the testimony to be given by the witness. If the name of a witness is not known, a general description sufficient to identify the witness or a particular class or group to which the witness belongs may be given instead.

(b) Unless the parties agree otherwise, a party shall serve, but not file, at least three days prior to the conference required by paragraph (g) of this section, if service is made by hand or "Express Mail," or at least ten days prior to the conference if service is made by any other means, the following:

(1) A list and copy of each document in the party's possession, custody, or control and upon which the party intends to rely at any deposition and

(2) A list of and a proffer of reasonable access to things in the party's possession, custody, or control and upon which the party intends to rely at the deposition.

(c) A party shall not be permitted to rely at any deposition on any witness not listed in the notice, or any document not served or any thing not listed as required by paragraph (b) of this section: (1) Unless all opponents agree in writing or on the record to permit the party to rely on the witness, document, or thing or (2) except upon a motion (§ 1.635) promptly filed which is accompanied by any proposed notice, additional documents, or lists and which shows sufficient cause why the notice, documents, or lists were not served in accordance with this section.

(d) Each opposing party shall have a full opportunity to attend a deposition and cross-examine. If an opposing party attends a deposition of a witness not named in a notice and cross-examines the witness or fails to object to the taking of the deposition, the opposing party shall be deemed to have waived any right to object to the taking of the deposition for lack of proper notice.

(e) A party electing to present testimony by affidavit and who is required to notice depositions for the purpose of cross-examination under § 1.672(b), shall, after complying with paragraph (g) of this section, file and serve a single notice of deposition stating the time and place of each cross-examination deposition to be taken.

(f) The parties shall not take depositions in more than one place at the same time or so nearly at the same time that reasonable opportunity to travel from one place of deposition to another cannot be had.

(g) Before serving a notice of deposition and after complying with paragraph (b) of this section, a party shall have an oral conference with all opponents to attempt to agree on a mutually acceptable time and place for conducting the deposition. A certificate shall appear in the notice stating that the oral conference took place or explaining why the conference could not be had. If the parties cannot agree to a mutually acceptable place and time for conducting the deposition at the conference, the parties shall contact an examiner-in-chief who shall then designate the time and place for conducting the deposition.

(h) A copy of the notice of deposition shall be attached to the certified transcript of the deposition filed under § 1.676(a).

[49 FR 48469, Dec. 12, 1984; added effective Feb. 11, 1985]

### § 1.674 Persons before whom depositions may be taken.

(a) Within the United States or a territory or insular possession of the United States a deposition shall be taken before an officer authorized to administer oaths by the laws of the United States or of the place where the examination is held.

(b) Unless the parties agree in writing, the following persons shall not be competent to serve as an officer: (1) A relative or employee of a party, (2) a relative or employee of an attorney or agent of a party, or (3) a person interested, directly or indirectly, in the interference either as counsel, attorney, agent, or otherwise.

[49 FR 48469, Dec. 12, 1984, added effective Feb. 11, 1985]

### § 1.675 Examination of witness, reading and signing transcript of deposition.

(a) Each witness before giving an oral deposition shall be duly sworn according to law by the officer before whom the deposition is to be taken.

(b) The testimony shall be taken in answer to interrogatories with any questions and answers recorded in their regular order by the officer or by some other person, who shall be subject to the provisions of § 1.674(b), in the presence of the officer unless the presence of the officer is waived on the record by agreement of all parties.

(c) All objections made at the time of the deposition to the qualifications of the officer taking the deposition, the manner of taking it, the evidence presented, the conduct of any party, or any other objection to the proceeding shall be noted on the record by the officer. Evidence objected to shall be taken subject to any objection.

(d) Unless the parties agree in writing or waive reading and signature by the witness on the record at the deposition, when the testimony has been transcribed a transcript of the deposition shall be read by the witness and then signed by the witness in the form of: (1) An affidavit in the presence of any notary or (2) a declaration.

[49 FR 48469, Dec. 12, 1984, added effective Feb. 11, 1985]

### § 1.676 Certification and filing by officer, marking exhibits.

(a) The officer shall prepare a certified transcript of the deposition by attaching to a transcript of the deposition a copy of the notice of deposition, any exhibits to be annexed to the certified transcript, and a certificate signed and sealed by the officer and showing:

(1) The witness was duly sworn by the officer before commencement of testimony by the witness.

(2) The transcript is a true record of the testimony given by the witness.

(3) The name of the person by whom the testimony was recorded and, if not recorded by the officer, whether the testimony was recorded in the presence of the officer.

(4) The presence or absence of any opposing party.

(5) The place where the deposition was taken and the day

and hour when the deposition began and ended.

(6) The officer is not disqualified under § 1.674.

(b) If the parties waived any of the requirements of paragraph (a) of this section, the certificate shall so state.

(c) The officer shall note on the certificate the circumstances under which a witness refuses to sign a transcript.

(d) Unless the parties agree otherwise in writing or on the record at the deposition, the officer shall securely seal the certified transcript in an envelope endorsed with the style of the interference (e.g., Smith v. Jones), the interference number, the name of the witness, and the date of sealing and shall promptly forward the envelope to BOX INTERFERENCE, Commissioner of Patents and Trademarks, Washington, D.C. 20231. Documents and things produced for inspection during the examination of a witness, shall, upon request of a party, be marked for identification and annexed to the certified transcript, and may be inspected and copied by any party, except that if the person producing the documents and things desires to retain them, the person may: (1) Offer copies to be marked for identification and annexed to the certified transcript and to serve thereafter as originals if the person affords to all parties fair opportunity to verify the copies by comparison with the originals or (2) offer the originals to be marked for identification, after giving each party an opportunity to inspect and copy them, in which event the documents and things may be used in the same manner as if annexed to the certified transcript. The exhibits shall then be filed as specified in § 1.653(i). If the weight or bulk of a document or thing shall reasonably prevent the document or thing from being annexed to the certified transcript, it shall, unless waived on the record at the deposition of all parties, be authenticated by the officer and forwarded to the Commissioner in a separate package marked and addressed as provided in this paragraph.

[49 FR 48469, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985]

#### § 1.677 Form of a transcript of deposition.

(a) A transcript of a deposition must be typewritten on opaque, unglazed, durable paper approximately 8 1/2 by 11 inches (21.8 by 27.9 cm.) in size (letter size). Typing shall be double-spaced on one side of the paper in not smaller than pica-type with a margin of 1 1/2 inches (3.8 cm.) on the left-hand side of the page. The pages must be consecutively numbered throughout the entire record of each party (§ 1.653(d)) and the name of the witness must be typed at the top of each page (§ 1.653(e)). The questions propounded to each witness must be consecutively numbered unless paper with numbered lines is used and each question must be followed by its answer.

(b) Exhibits must be numbered consecutively and each must be marked as required by § 1.653(i).

[49 FR 48470, Dec. 12, 1984, added effective Feb. 11, 1985]

#### § 1.678 Transcript of deposition must be filed.

Unless otherwise ordered by an examiner-in-chief, a certified transcript of a deposition must be filed in the Patent and Trademark Office within 45 days from the date of deposition. If a party refuses to file a certified transcript, the examiner-in-chief

or the Board may take appropriate action under § 1.616. If a party refuses to file a certified transcript, any opponent may move for leave to file the certified transcript and include a copy of the transcript as part of the opponent's record.

[49 FR 48470, Dec. 12, 1984; added effective Feb. 11, 1985]

#### § 1.679 Inspection of transcript.

A certified transcript filed in the Patent and Trademark Office may be inspected by any party. The certified transcript may not be removed from the Patent and Trademark Office for printing (§ 1.653(g)) unless authorized by an examiner-in-chief upon such terms as may be appropriate.

[49 FR 48470, Dec. 12, 1984, added effective Feb. 11, 1985]

#### § 1.682 Official records and printed publications.

(a) A party may introduce into evidence, if otherwise admissible, any official record or printed publication not identified on the record during the taking of testimony of a witness, by filing a notice offering the official record or publication into evidence. If the evidence relates to the party's case-in-chief, the notice shall be filed prior to the testimony of the party's case-in-chief. If the evidence relates to rebuttal, the notice shall be filed prior to the close of testimony of the party's case-in-rebuttal. The notice shall: (1) Identify the official record or printed publication, (2) identify the portion thereof to be introduced in evidence, (3) indicate generally the relevance of the portion sought to be introduced in evidence, and (4) where appropriate, be accompanied by a certified copy of the official record or a copy of the printed publication (§ 1.671(d)).

(b) A copy of the notice, official record, and publication shall be served.

(c) Unless otherwise ordered by an examiner-in-chief, any written objection to the notice or to the admissibility of the official record or printed publication shall be filed within 15 days of service of the notice. See also § 1.656(h).

[49 FR 48470, Dec. 12, 1984, added effective Feb. 11, 1985]

#### § 1.683 Testimony in another interference, proceeding, or action.

(a) Prior to close of a party's appropriate testimony period or within such time as may be set by an examiner-in-chief, a party may file a motion (§ 1.635) for leave to use in an interference testimony of a witness from another interference, proceeding, or action involving the same parties, subject to such conditions as may be deemed appropriate by an examiner-in-chief. The motion shall specify with particularity the exact testimony to be used and shall demonstrate its relevance.

(b) Any objection to the admissibility of the testimony of the witness shall be made in an opposition to the motion. See also § 1.656(h).

[49 FR 48470, Dec. 12, 1984, added effective Feb. 11, 1985]

#### § 1.684 Testimony in a foreign country.

(a) An examiner-in-chief may authorize testimony of a witness to be taken in a foreign country. A party seeking to take testimony in a foreign country shall, prior to the close of the party's appropriate testimony period or within such time as may be set by an examiner-in-chief, file a motion (§ 1.635):

- (1) Naming the witness.
- (2) Describing the particular facts to which it is expected that the witness will testify.
- (3) Stating the grounds on which the moving party believes that the witness will so testify.
- (4) Demonstrating that the expected testimony is relevant.
- (5) Demonstrating that the testimony cannot be taken in this country at all or cannot be taken in this country without hardship to the moving party greatly exceeding the hardship to which all opposing parties will be exposed by the taking of the testimony in a foreign country.
- (6) Accompanied by an affidavit stating that the motion is made in good faith and not for the purpose of delay or harassing any party.
- (7) Accompanied by written interrogatories to be asked of the witness.

(b) Any opposition under § 1.638(a) shall state any objection to the written interrogatories and shall include any cross-interrogatories to be asked of the witness. A reply under § 1.638(b) may be filed and shall be limited to stating any objection to any cross-interrogatories proposed in the opposition.

(c) If the motion is granted, the moving party shall be responsible for obtaining answers to the interrogatories and cross-interrogatories before an officer qualified to administer oaths in the foreign country under the laws of the United States or the foreign country. The officer shall prepare a transcript of the interrogatories, cross-interrogatories, and recorded answers to the interrogatories and cross-interrogatories and shall transmit the transcript to BOX INTERFERENCE, Commissioner of Patents and Trademarks, Washington, D.C. 20231, with a certificate signed and sealed by the officer and showing:

(1) The witness was duly sworn by the officer before answering the interrogatories and cross-interrogatories.

(2) The recorded answers are a true record of the answers given by the witness to the interrogatories and cross-interrogatories.

(3) The name of the person by whom the answers were recorded and, if not recorded by the officer, whether the answers were recorded in the presence of the officer.

(4) The presence or absence of any party.

(5) The place, day, and hour that the answers were recorded.

(6) A copy of the recorded answers was read by or to the witness before the witness signed the recorded answers and that the witness signed the recorded answers in the presence of the officer. The officer shall state the circumstances under which a witness refuses to read or sign recorded answers.

(7) The officer is not disqualified under § 1.674.

(d) If the parties agree in writing, the testimony may be taken before the officer on oral deposition.

(e) A party taking testimony in a foreign country shall have the burden of proving that false swearing in the giving of testimony is punishable as perjury under the laws of the foreign country. Unless false swearing in the giving of testimony before the officer shall be punishable as perjury under the laws of the foreign country where testimony is taken, the testimony shall not be entitled to the same weight as testimony taken in the

United States. The weight of the testimony shall be determined in each case.

[49 FR 48470, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985]

#### § 1.685 Errors and irregularities in depositions.

(a) An error in a notice for taking a deposition is waived unless a motion (§ 1.635) to quash the notice is filed as soon as the error is, or could have been, discovered.

(b) An objection to a qualification of an officer taking a deposition is waived unless:

(1) The objection is made on the record of the deposition before a witness begins to testify.

(2) If discovered after the deposition, a motion (§ 1.635) to suppress the deposition is filed as soon as the objection is, or could have been, discovered.

(c) An error in irregularity in the manner in which testimony is transcribed, a certified transcript is signed by a witness, or a certified transcript is prepared, signed, certified, sealed, endorsed, forwarded, filed, or otherwise handled by the officer is waived unless a motion (§ 1.635) to suppress the deposition is filed as soon as the error of irregularity is, or could have been, discovered.

(d) An objection to the competency of a witness, admissibility of evidence, manner of taking the deposition, the form of questions and answers, any oath or affirmation, or conduct of any party at the deposition is waived unless an objection is made on the record at the deposition stating the specific ground of objection. Any objection which a party wishes considered by the Board at final hearing shall be included in a motion to suppress under § 1.656(h).

(e) Nothing in this section precludes taking notice of plain errors affecting substantial rights although they were not brought to the attention of an examiner-in-chief or the Board.

[49 FR 48471, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985.]

#### § 1.687 Additional discovery.

(a) A party is not entitled to discovery except as authorized in this subpart.

(b) Where appropriate, a party may obtain production of documents and things during cross-examination of an opponent's witness or during the testimony period of the party's case-in-rebuttal.

(c) Upon a motion (§ 1.635) brought by a party within the time set by an examiner-in-chief under § 1.651 or thereafter as authorized by § 1.645 and upon a showing that the interest of justice so requires, an examiner-in-chief may order additional discovery, as to matters under the control of a party within the scope of the Federal Rules of Civil Procedure, specifying the terms and conditions of such additional discovery.

(d) The parties may agree to discovery among themselves at any time. In the absence of an agreement, a motion for additional discovery shall not be filed except as authorized by this subpart.

[49 FR 48471, Dec. 12, 1984, added effective Feb. 11, 1985]

**§ 1.688 Use of discovery.**

(a) If otherwise admissible a party may introduce into evidence, an answer to a written request for an admission or an answer to a written interrogatory obtained by discovery under § 1.687 by filing a copy of the request for admission or the written interrogatory and the answer. If the answer relates to a party's case-in-chief, the answer shall be filed prior to the close of testimony of the party's case-in-chief. If the answer relates to the party's rebuttal, the admission or answer shall be filed prior to the close of testimony of the party's case-in-rebuttal. Unless otherwise ordered by an examiner-in-chief, any written objection to the admissibility of an answer shall be filed within 15 days of service of the answer.

(b) A party may not rely upon any other matter obtained by discovery unless it is introduced into evidence under this subpart.

[49 FR 48471, Dec. 12, 1984, added effective Feb. 11, 1985]

**§ 1.690 Arbitration of interferences.**

(a) Parties to a patent interference may determine the interference or any aspect thereof by arbitration. Such arbitration shall be governed by the provisions of Title 9, United States Code. The parties must notify the Board in writing of their intention to arbitrate. An agreement to arbitrate must be in writing, specify the issues to be arbitrated, the name of the arbitrator or a date not more than thirty (30) days after the execution of the agreement for the selection of the arbitrator, and provide that the arbitrator's award shall be binding on the parties and that judgment thereon can be entered by the Board. A copy of the agreement must be filed within twenty (20) days after its execution. The parties shall be solely responsible for the selection of the arbitrator and the rules for conducting proceedings before the arbitrator. Issues not disposed of by arbitration will be resolved in accordance with the procedures established in 37 CFR, Subpart E of Part 1, as determined by the examiner-in-chief.

(b) An arbitration proceeding under this section shall be conducted within such time as may be authorized on a case-by-case basis by an examiner-in-chief.

(c) An arbitration award will be given no consideration unless it is binding on the parties, is in writing and states in a clear and definite manner (1) the issue or issues arbitrated and (2) the disposition of each issue. The award may include a statement of the grounds and reasoning in support thereof. Unless otherwise ordered by an examiner-in-chief, the parties shall give notice to the Board of an arbitration award by filing within twenty (20) days from the date of the award a copy of the award signed by the arbitrator or arbitrators. When an award is timely filed, the award shall, as to the parties to the arbitration, be dispositive of the issue or issues to which it relates.

(d) An arbitration award shall not preclude the Office from determining patentability of any invention involved in the interference.

[52 FR 13838, Apr. 27, 1987]

**Subpart F - Extension of Patent Term**

Authority: 35 U.S.C. 6 and 156.

**§ 1.710 Patents subject to extension of the patent term.**

(A) A patent is eligible for extension of the patent term if the patent claims a product as defined in paragraph (b) of this section, or a method of using such a product, or a method of manufacturing such a product, and meets all other conditions and requirements of this subpart.

(b) The term "product" referred to in paragraph (a) of this section means—

(1) a human drug product which means the active ingredient of a new drug, antibiotic drug, or human biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Public Health Service Act) including any salt or ester of the active ingredient, as a single entity or in combination with another active ingredient; or

(2) any medical device, food additive, or color additive subject to regulation under the Federal Food, Drug, and Cosmetic Act.

[Added 52 FR 9394, Mar. 24, 1987]

**§ 1.720 Conditions for extension of patent term.**

The term of a patent may be extended if:

(a) the patent claims a product or a method of using or manufacturing a product as defined in 1.710;

(b) the term of the patent has never been previously extended except for any interim extension issued pursuant to 1.760;

(c) an application for extension is submitted in compliance with 1.740;

(d) the product has been subject to a regulatory review period as defined in 35 U.S.C. 156(g) before its commercial marketing or use;

(e) the product has received permission for commercial marketing or use and--

(i) the permission for the commercial marketing or use of the product is the first received permission for commercial marketing or use under the provision of law under which the applicable regulatory review occurred, or

(ii) in the case of a patent claiming a method of manufacturing the product which primarily uses recombinant DNA technology in the manufacture of the product, the permission for the commercial marketing or use is the first received permission for the commercial marketing or use of a product manufactured under the process claimed in the patent;

(f) the application is submitted within the sixty day period beginning on the date the product first received permission for commercial marketing or use under the provisions of law under which the applicable regulatory review period occurred, or in the case of a patent claiming a method of manufacturing the product which primarily uses recombinant DNA technology in the manufacture of the product, the application for extension is submitted within the sixty day period beginning on the date of the first permitted commercial marketing or use of a product manufactured under the process claimed in the patent;

(g) the term of the patent has not expired before the submission of an application in compliance § 1.741; and

(h) no other patent term has been extended for the same regulatory review period for the product.

[Added 52 FR 9394, Mar. 24, 1987]

### § 1.730 Applicant for extension of patent term.

Any application for extension of a patent term must be submitted by the owner of record of the patent or its agent and must comply with the requirements of 1.740.

[Added 52 FR 9394, Mar. 24, 1987]

### § 1.740 Application for extension of patent term.

(a) An application for extension of patent term must be made in writing to the Commissioner of Patents and Trademarks. A formal application for the extension of patent term shall include:

(1) a complete identification of the approved product as by appropriate chemical and generic name, physical structure or characteristics;

(2) a complete identification of the Federal statute including the applicable provision of law under which the regulatory review occurred;

(3) an identification of the date on which the product received permission for commercial marketing or use under the provision of law under which the applicable regulatory review period occurred;

(4) in the case of a human drug product, an identification of each active ingredient in the product and as to each active ingredient, a statement that it has not been previously approved for commercial marketing or use under the Federal Food, Drug and Cosmetic Act, or a statement of when the active ingredient was approved for commercial marketing or use (either alone or in combination with other active ingredients) and the provision of law under which it was approved.

(5) a statement that the application is being submitted within the sixty day period permitted for submission pursuant to § 1.720(f) and an identification of the date of the last day on which the application could be submitted;

(6) a complete identification of the patent for which an extension is being sought by the name of the inventor, the patent number, the date of issue, and the date of expiration;

(7) a copy of the patent for which an extension is being sought, including the entire specification (including claims) and drawings;

(8) a copy of any disclaimer, certificate of correction, receipt of maintenance fee payment, or reexamination certificate issued in the patent;

(9) a statement beginning on a new page that the patent claims the approved product or a method of using or manufacturing the approved product, and a showing which lists each applicable patent claim and demonstrates the manner in which each applicable patent claim reads on the approved product or a method of using or manufacturing the approved product;

(10) a statement beginning on a new page of the relevant dates and information pursuant to 35 U.S.C. 156(g) in order to enable the Secretary of Health and Human Services to determine the applicable regulatory review period as follows:

(i) for a patent that claims a human drug product, the effective date of the investigational new drug (IND) application

and the IND number; the date on which a new drug application (NDA) was initially submitted and the NDA number; and the date on which the NDA was approved;

(ii) for a patent that claims a food or color additive, the date a major health or environmental effects test on the additive was initiated and any available substantiation of that date; the date on which a petition for product approval under the Federal Food, Drug and Cosmetic Act was initially submitted and the petition number; and the date on which the FDA published a Federal Register notice listing the additive for use;

(iii) for a patent that claims a medical device, the effective date of the investigational device exemption (IDE) and the IDE number, if applicable, or the date on which the applicant began the first clinical investigation involving the device if no IDE was submitted and any available substantiation of that date; the date on which an application for product approval under section 515 of the Federal Food, Drug and Cosmetic Act was initially submitted and the number of the application; and the date on which the application was approved.

(11) a brief description beginning on a new page of the significant activities undertaken by the marketing applicant during the applicable regulatory review period with respect to the approved product and the significant dates applicable to such activities;

(12) a statement beginning on a new page that in the opinion of the applicant the patent is eligible for the extension and a statement as to the length of extension claimed, including how the length of extension was determined;

(13) a statement that applicant acknowledges a duty to disclose to the Commissioner of Patents and Trademarks and the Secretary of Health and Human Services any information which is material to the determination of entitlement to the extension sought (see § 1.765);

(14) the prescribed fee for receiving and acting upon the application for extension (see § 1.20(n));

(15) the name, address, and telephone number of the person to whom inquiries and correspondence relating to the application for patent term extension are to be directed;

(16) a duplicate of the application papers, certified as such; and

(17) an oath or declaration as set forth in paragraph (b) of this section.

(b) Any oath or declaration submitted in compliance with paragraph (a) of this section must be signed by the owner of record of the patent or its agent, specifically identify the papers and the patent for which an extension is sought and aver that the person signing the oath or declaration:

(1) is the owner, an official of a corporate owner authorized to obligate the corporation, or a patent attorney or agent authorized to practice before the Patent and Trademark Office and who has general authority from the owner to act on behalf of the owner in patent matters.

(2) has reviewed and understands the contents of the application being submitted pursuant to this section;

(3) believes the patent is subject to extension pursuant to § 1.710;

(4) believes an extension of the length claimed is justified

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under 35 U.S.C. 156 and the applicable regulations; and

(5) believes the patent for which the extension is being sought meets the conditions for extension of the term of a patent as set forth in § 1.720.

(c) If any application for extension of patent term submitted pursuant to this section is held to be informal, applicant may seek to have that holding reviewed by filing a petition with the required fee, as necessary, pursuant to 1.181, 1.182 or 1.183, as appropriate, within such time as may be set in the notice that the application has been held to be informal, or if no time is set, within one month of the date on which the application was held informal. The time periods set forth herein are subject to the provisions of 37 CFR 1.136.

[Added 52 FR 9394, Mar. 24, 1987]

**§ 1.741 Filing date of application.**

(a) The filing date of an application for extension of patent term is the date on which a complete application is received in the Patent and Trademark Office or filed pursuant to the "Certificate of Mailing" provisions of 37 CFR 1.8 or "Express Mail" provisions of 37 CFR 1.10.

A complete application shall include:

- (1) An identification of the approved product;
- (2) An identification of the Federal statute under which regulatory review occurred;
- (3) An identification of the patent for which an extension is being sought;
- (4) An identification of each claim of the patent which claims the approved product or a method of using or manufacturing the approved product;
- (5) Sufficient information to enable the Commissioner to determine under 35 U.S.C. 156 subsections (a) and (b) the eligibility of a patent for extension and the rights that will be derived from the extension and information to enable the Commissioner and the Secretary of Health and Human Services to determine the period of the extension; and
- (6) A brief description of the activities undertaken by the marketing applicant during the applicable regulatory review period with respect to the approved product and the significant dates applicable to such activities.

(b) If any application submitted pursuant to this section is held to be incomplete, applicant may seek to have this holding reviewed under § 1.181.

[Added 52 FR 9394, Mar. 24, 1987]

**§ 1.750 Determination of eligibility for extension of patent term**

A determination as to whether a patent is eligible for extension may be made by the Commissioner solely on the basis of the representations contained in the application for extension filed in compliance with § 1.740. This determination may be delegated to appropriate Patent and Trademark Office officials and may be made at any time before the certificate of extension is issued. The Commissioner or other appropriate officials may require from applicant further information or make such independent inquiries as desired before a final determination is made on whether a patent is eligible for extension. A notice will be

mailed to applicant containing the determination as to the eligibility of the patent for extension and the period of time of the extension, if any. This notice shall constitute the final determination as to the eligibility and any period of extension of the patent. A single request for reconsideration of a final determination may be made if filed by the applicant within such time as may be set in the notice of final determination or, if no time is set, within one month from the date of the final determination. The time periods set forth herein are subject to the provisions of 37 CFR 1.136.

**§ 1.760 Interim extension of patent term.**

An applicant who has filed a formal application for extension in compliance with § 1.740 may request one or more interim extensions for periods of up to one year each pending a final determination on the application pursuant to § 1.750. Any such request should be filed at least three months prior to the expiration date of the patent. The Commissioner may issue interim extensions, without a request by the applicant, for periods of up to one year each until a final determination is made. The patent owner or agent will be notified when an interim extension is granted and notice of the extension will be published in the Official Gazette of the Patent and Trademark Office. The notice will be recorded in the official file of the patent and will be considered as part of the original patent. In no event will the interim extensions granted under this section be longer than the maximum period for extension to which the applicant would be eligible.

**§ 1.765 Duty of disclosure in patent term extension proceedings.**

(a) A duty of candor and good faith toward the Patent and Trademark Office and the Secretary of Health and Human Services rests on the patent owner or its agent, on each attorney or agent who represents the patent owner and on every other individual who is substantively involved on behalf of the patent owner in a patent term extension proceeding. All such individuals who are aware, or become aware, of material information adverse to a determination of entitlement to the extension sought, which has not been previously made of record in the patent term extension proceeding must bring such information to the attention of the Office or the Secretary, as appropriate, in accordance with paragraph (b) of this section, as soon as it is practical to do so after the individual becomes aware of the information. Information is material where there is a substantial likelihood that the Office or the Secretary would consider it important in determinations to be made in the patent term extension proceeding.

(b) Disclosures pursuant to this section must be accompanied by a copy of each written document which is being disclosed. The disclosure must be made to the Office or the Secretary, as appropriate, unless the disclosure is material to determinations to be made by both the Office and the Secretary, in which case duplicate copies, certified as such, must be filed in the Office and with the Secretary. Disclosures pursuant to this section may be made to the Office or the Secretary, as appropriate, through an attorney or agent having responsibility on behalf

of the patent owner or its agent for the patent term extension proceeding or through a patent owner acting on his or her own behalf. Disclosure to such an attorney, agent or patent owner shall satisfy the duty of any other individual. Such an attorney, agent or patent owner has no duty to transmit information which is not material to the determination of entitlement to the extension sought.

(c) No patent will be determined eligible for extension and no extension will be issued if it is determined that fraud on the Office or the Secretary was practiced or attempted or the duty of disclosure was violated through bad faith or gross negligence in connection with the patent term extension proceeding. If it is established by clear and convincing evidence that any fraud was practiced or attempted on the Office or the Secretary in connection with the patent term extension proceeding or that there was any violation of the duty of disclosure through bad faith or gross negligence in connection with the patent term extension proceeding, a final determination will be made pursuant to § 1.750 that the patent is not eligible for extension.

(d) The duty of disclosure pursuant to this section rests on the individuals identified in paragraph (a) of this section and no submission on behalf of third parties, in the form of protests or otherwise, will be considered by the Office. Any such submissions by third parties to the Office will be returned to the party making the submission, or otherwise disposed of, without consideration by the Office.

**§ 1.770 Express withdrawal of application for extension of patent term.**

An application for extension of patent term may be expressly withdrawn before a determination is made pursuant to § 1.750 by filing in the Office, in duplicate, a written declaration of withdrawal signed by the owner of record of the patent or its agent. An application may not be expressly withdrawn after the date permitted for response to the final determination on the application. An express withdrawal pursuant to this section is effective when acknowledged in writing by the Office. The filing of an express withdrawal pursuant to this section and its acceptance by the Office does not entitle applicant to a refund of the filing fee (§ 1.20(n)) or any portion thereof.

**§ 1.775 Calculation of patent term extension for a human drug product.**

(a) If a determination is made pursuant to § 1.750 that a patent for a human drug product is eligible for extension, the term shall be extended by the time as calculated in days in the manner indicated by this section. The patent term extension will run from the original expiration date of the patent or any earlier date set by terminal disclaimer (§ 1.321).

(b) The term of the patent for a human drug product will be extended by the length of the regulatory review period for the product as determined by the Secretary of Health and Human Services, reduced as appropriate pursuant to paragraphs (d)(1) through (d)(6) of this section.

(c) The length of the regulatory review period for a human drug product will be determined by the Secretary of Health and Human Services. Under 35 U.S.C. 156(g)(1)(B), it is the sum of --

(1) The number of days in the period beginning on the date an exemption under subsection (i) of section 505 or subsection (d) of section 507 of the Federal Food, Drug and Cosmetic Act became effective for the approved human drug product and ending on the date an application was initially submitted for such drug product under those sections or under section 351 of the Public Health Service Act; and

(2) The number of days in the period beginning on the date the application was initially submitted for the approved human drug product under section 351 of the Public Health Service Act, subsection (b) of section 505 or section 507 of the Federal Food, Drug, and Cosmetic Act and ending on the date such application was approved under such section.

(d) The term of the patent as extended for a human drug product will be determined by --

(1) Subtracting from the number of days determined by the Secretary of Health and Human Services to be in the regulatory review period:

(i) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section which were on and before the date on which the patent issued;

(ii) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section during which it is determined under 35 U.S.C. 156(d)(2)(B) by the Secretary of Health and Human Services that applicant did not act with due diligence;

(iii) One-half the number of days remaining in the period defined by paragraph (c)(1) of this section after that period is reduced in accordance with paragraphs (d)(1)(i) and (ii) of this section; half days will be ignored for purposes of subtraction;

(2) By adding the number of days determined in paragraph (d)(1) of this section to the original term of the patent as shortened by any terminal disclaimer;

(3) By adding 14 years to the date of approval of the application under section 351 of the Public Health Service Act, or subsection (b) of section 505 or section 507 of the Federal Food, Drug and Cosmetic Act;

(4) By comparing the dates for the ends of the periods obtained pursuant to paragraphs (d)(2) and (d)(3) of this section with each other and selecting the earlier date;

(5) If the original patent was issued after September 24, 1984,

(i) By adding 5 years to the original expiration date of the patent or any earlier date set by terminal disclaimer; and

(ii) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(5)(i) of this section with each other and selecting the earlier date;

(6) If the original patent was issued before September 24, 1984, and

(i) If no request was submitted for an exemption under subsection (i) of section 505 or subsection (d) of section 507 of the Federal Food, Drug and Cosmetic Act before September 24, 1984, by -

(A) Adding 5 years to the original expiration date of the patent or earlier date set by terminal disclaimer; and

(B) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(i)(A) of this section with each other and selecting the earlier date; or

(ii) If a request was submitted for an exemption under subsection (i) of section 505 or subsection (d) of section 507 of the Federal Food, Drug, or Cosmetic Act before September 24, 1984 and the commercial marketing or use of the product was not approved before September 24, 1984, by:

(A) Adding 2 years to the original expiration date of the patent or earlier date set by terminal disclaimer, and

(B) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(ii)(A) of this section with each other and selecting the earlier filing date.

#### § 1.776 Calculation of patent term extension for a food additive or color additive.

(a) If a determination is made pursuant to § 1.750 that a patent for a food additive or color additive is eligible for extension, the term shall be extended by the time as calculated in days in the manner indicated by this section. The patent term extension will run from the original expiration date of the patent or earlier date set by terminal disclaimer (§ 1.321).

(b) The term of the patent for a food additive or color additive will be extended by the length of the regulatory review period for the product as determined by the Secretary of Health and Human Services, reduced as appropriate pursuant to paragraphs (d)(1) through (d)(6) of this section.

(c) The length of the regulatory review period for a food additive or color additive will be determined by the Secretary of Health and Human Services. Under 35 U.S.C. 156(g)(2)(B), it is the sum of -

(1) The number of days in the period beginning on the date a major health or environmental effects test on the additive was initiated and ending on the date a petition was initially submitted with respect to the approved product under the Federal Food, Drug, and Cosmetic Act requesting the issuance of a regulation for use of the product; and

(2) The number of days in the period beginning on the date a petition was initially submitted with respect to the approved product under the Federal Food, Drug and Cosmetic Act requesting the issuance of a regulation for use of the product, and ending on the date such regulation became effective or, if objections were filed to such regulation, ending on the date such objections were resolved and commercial marketing was permitted or, if commercial marketing was permitted and later revoked pending further proceedings as a result of such objections, ending on the date such proceedings were finally resolved and commercial marketing was permitted.

(d) The term of the patent as extended for a food additive or color additive will be determined by

(1) Subtracting from the number of days determined by the Secretary of Health and Human Services to be in the regulatory review period:

(i) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section which were on and before the date on which the patent issued;

(ii) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section during which it is determined under 35 U.S.C. 156(d)(2)(B) by the Secretary of Health and Human Services that applicant did not act with due diligence;

(iii) The number of days equal to one-half the number of days remaining in the period defined by paragraph (c)(1) of this section after that period is reduced in accordance with paragraphs (d)(1)(i) and (ii) of this section; half days will be ignored for purposes of subtraction;

(2) By adding the number of days determined in paragraph (d)(1) of this section to the original term of the patent as shortened by any terminal disclaimer;

(3) By adding 14 years to the date a regulation for use of the product became effective or, if objections were filed to such regulation, to the date such objections were resolved and commercial marketing was permitted or, if commercial marketing was permitted and later revoked pending further proceedings as a result of such objections, to the date such proceedings were finally resolved and commercial marketing was permitted;

(4) By comparing the dates for the ends of the periods obtained pursuant to paragraphs (d)(2) and (d)(3) of this section with each other and selecting the earlier date;

(5) If the original patent was issued after September 24, 1984,

(i) By adding 5 years to the original expiration date of the patent or earlier date set by terminal disclaimer; and

(ii) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(5)(i) of this section with each other and selecting the earlier date;

(6) If the original patent was issued before September 24, 1984, and

(i) If no major health or environmental effects test was initiated and no petition for a regulation or application for registration was submitted before September 24, 1984, by

(A) Adding 5 years to the original expiration date of the patent or earlier date set by terminal disclaimer, and

(B) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(i)(A) of this section with each other and selecting the earlier date; or

(ii) If a major health or environmental effects test was initiated or a petition for a regulation or application for registration was submitted by September 24, 1984, and the commercial marketing or use of the product was not approved before September 24, 1984, by

(A) Adding 2 years to the original expiration date of the patent or earlier date set by terminal disclaimer, and

(B) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(ii)(A) of this section with each other and selecting the earlier date.

#### § 1.777 Calculation of patent term extension for a medical device.

(a) If a determination is made pursuant to § 1.750 that a patent for a medical device is eligible for extension, the term shall be extended by the time as calculated in days in the manner indicated by this section. The patent term extension will run from the original expiration date of the patent or earlier date as set by terminal disclaimer (§ 1.321).

(b) The term of the patent for a medical device will be extended by the length of the regulatory review period for the product as determined by the Secretary of Health and Human



Services, reduced as appropriate pursuant to paragraphs (d)(1) through (d)(6) of this section.

(c) The length of the regulatory review period for a medical device will be determined by the Secretary of Health and Human Services. Under 35 U.S.C. 156(g)(3)(B), it is the sum of

(1) The number of days in the period beginning on the date a clinical investigation on humans involving the device was begun and ending on the date an application was initially submitted with respect to the device under section 515 of the Federal Food, Drug, and Cosmetic Act; and

(2) The number of days in the period beginning on the date the application was initially submitted with respect to the device under section 515 of the Federal Food, Drug, and Cosmetic Act, and ending on the date such application was approved under such Act or the period beginning on the date a notice of completion of a product development protocol was initially submitted under section 515(f)(5) of the Act and ending on the date the protocol was declared completed under section 515(f)(6) of the Act.

(d) The term of the patent as extended for a medical device will be determined by -

(1) Subtracting from the number of days determined by the Secretary of Health and Human Services to be in the regulatory review period pursuant to paragraph (c) of this section:

(i) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section which were on and before the date on which the patent issued;

(ii) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section during which it is determined under 35 U.S.C. 156(d)(2)(B) by the Secretary of Health and Human Services that applicant did not act with due diligence;

(iii) One-half the number of days remaining in the period defined by paragraph (c)(1) of this section after that period is reduced in accordance with paragraphs (d)(1) (i) and (ii) of this section; half days will be ignored for purposes of subtraction;

(2) By adding the number of days determined in paragraph (d)(1) of this section to the original term of the patent as shortened by any terminal disclaimer;

(3) By adding 14 years to the date of approval of the application under section 515 of the Federal Food, Drug, and Cosmetic Act or the date a product development protocol was declared completed under section 515(f)(6) of the Act;

(4) By comparing the dates for the ends of the periods obtained pursuant to paragraphs (d)(2) and (d)(3) of this section with each other and selecting the earlier date;

(5) If the original patent was issued after September 24, 1984,

(i) By adding 5 years to the original expiration date of the patent or earlier date set by terminal disclaimer; and

(ii) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(5)(i) of this section with each other and selecting the earlier date;

(6) If the original patent was issued before September 24, 1984, and

(i) If no clinical investigation on humans involving the device was begun or no product development protocol was submitted under section 515(f)(5) of the Federal Food, Drug and

Cosmetic Act before September 24, 1984, by

(A) Adding 5 years to the original expiration date of the patent or earlier date set by terminal disclaimer and

(B) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(i)(A) of this section with each other and selecting the earlier date; or

(ii) If a clinical investigation on humans involving the device was begun or a product development protocol was submitted under section 515(f)(5) of the Federal Food, Drug, and Cosmetic Act before September 24, 1984 and the commercial marketing or use of the product was not approved before September 24, 1984, by

(A) Adding 2 years to the original expiration date of the patent or earlier date set by terminal disclaimer, and

(B) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(ii)(A) of this section with each other and selecting the earlier date.

**§ 1.780 Certificate of extension of patent term.**

If a determination is made pursuant to § 1.750 that a patent is eligible for extension and that the term of the patent is to be extended, a certificate of extension, under seal, will be issued to the applicant for the extension of the patent term. Such certificate will be recorded in the official file of the patent and will be considered as part of the original patent. Notification of the issuance of the certificate of extension will be published in the Official Gazette of the Patent and Trademark Office. No certificate of extension will be issued if the term of the patent cannot be extended, even though the patent is otherwise determined to be eligible for extension. In such situations the final determination made pursuant to § 1.750 will indicate that no certificate will issue.

**§ 1.785 Multiple applications for extension of term of the same patent or of different patents for the same regulatory review period for a product.**

(a) Only one patent may be extended for a regulatory review period for any product (§ 1.720(g)). If more than one application for extension of the same patent is filed, the certificate of extension of patent term, if appropriate, will be issued based upon the first filed application for extension.

(b) If more than one application for extension is filed by a single applicant which seeks the extension of the term of two or more patents based upon the same regulatory review period, and the applications are otherwise eligible for extension pursuant to the requirement of this subpart, the certificate of extension of patent term, if appropriate, will be issued upon the application for extension of the patent having the earliest date of issuance of those patents for which extension is sought.

(c) If an application for extension is filed which seeks the extension of the term of a patent based upon the same regulatory review period as that relied upon in one or more applications for extension pursuant to the requirements of this subpart, the certificate of extension of patent term will be issued on the application only if -

(1) The applicant for extension is the holder of the regulatory approval granted with respect to the regulatory review

period, or

(2) The holder of the regulatory approval granted with respect to the regulatory review period is not an applicant and the applicant for extension holds express and exclusive authorization from the holder of the regulatory approval to rely upon the regulatory review period as the basis for the application for extension, or

(3) The holder of the regulatory approval granted with respect to the regulatory review period is not an applicant and no applicant for extension holds an express and exclusive authorization from the holder of the regulatory approval to rely upon the regulatory review period as the basis for the application for extension and the application is for extension of the patent having the earliest date of issuance of those patents for which extension is sought based upon the same regulatory review period.

(d) An application for extension shall be considered complete and formal regardless of whether it contains the identification of the holder of the regulatory approval granted with respect to the regulatory review period or express and exclusive authori-

zation from the holder of the regulatory approval to rely on the regulatory review period for extension. When an application contains such information, or is amended to contain such information, it will be considered in determining whether an application is eligible for an extension under this section. A request may be made of any applicant to supply such information within a non-extendable period of not less than one (1) month whenever multiple applications for extension of more than one patent are received and rely upon the same regulatory review period. Failure to provide such information within the period for response set shall be regarded as conclusively establishing that the applicant is not the holder of the regulatory approval and is not expressly and exclusively authorized by the holder of the regulatory approval to seek the extension being sought.

(e) Determinations made under this section shall be included in the notice of final determination of eligibility for extension of the patent term pursuant to § 1.750 and shall be regarded as part of that determination.

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

**SECRECY ORDERS**

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**SECRECY ORDERS**

**§ 5.1 Defense inspection of certain applications.**

(a) The provisions of this part shall apply to both national and international applications filed in the Patent and Trademark Office and, with respect to inventions made in the United States, to applications filed in any foreign country or any international authority other than the United States Receiving Office. The (1) filing of a national or an international application in a foreign country or with an international authority other than the United States Receiving Office, or (2) transmittal of an international application to a foreign agency or an international authority other than the United States Receiving Office is considered to be a foreign filing within the meaning of Chapter 17 of Title 35, United States Code.

(b) In accordance with the provisions of 35 U.S.C. 181, patent applications containing subject matter the disclosure of which might be detrimental to the national security are made available for inspection by defense agencies as specified in said section. Only applications obviously relating to national security, and applications within fields indicated to the Patent and Trademark

Office by the defense agencies as so related, are made available. The inspection will be made only by responsible representatives authorized by the agency to review applications. Such representatives are required to sign a dated acknowledgment of access accepting the condition that information obtained from the inspection will be used for no purpose other than the administration of 35 U.S.C. 181-188. Copies of applications may be made available to such representatives for inspection outside the Patent and Trademark Office under conditions assuring that the confidentiality of the applications will be maintained, including the conditions that: (1) all copies will be returned to the Patent and Trademark Office promptly if no secrecy order is imposed, or upon rescission of such order if one is imposed, and (2) no additional copies will be made by the defense agencies. A record of the removal and return of copies made available for defense inspection will be maintained by the Patent and Trademark Office. Applications relating to atomic energy are made available to the Department of Energy as specified in section 1.14 of this chapter.

[43 FR 20470, May 11, 1978]

**§ 5.2 Secrecy order.**

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

(b) The secrecy order is directed to the applicant, his successors, any and all assignees, and their legal representatives; hereinafter designated as principals.

(c) A copy of the secrecy order will be forwarded to each principal of record in the application and will be accompanied by a receipt, identifying the particular principal, to be signed and returned.

(d) The secrecy order is directed to the subject matter of the application. Where any other application in which a secrecy order has not been issued discloses a significant part of the subject matter of the application under secrecy order, the other application and the common subject matter should be called to the attention of the Patent and Trademark Office. Such a notice may include any material such as would be urged in a petition to rescind secrecy orders on either of the applications.

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

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

(a) National applications under secrecy order which come to a final rejection must be appealed or otherwise prosecuted to avoid abandonment. Appeals in such cases must be completed by the applicant but unless otherwise specifically ordered by the Commissioner will not be set for hearing until the secrecy order is removed.

(b) An interference will not be declared involving national applications under secrecy order. However, if an applicant whose

application under secrecy order copies claims from an issued patent, a notice of that fact will be placed in the file wrapper of the patent. (See § 1.205(c)).

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

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

[43 FR 20470, May 11, 1978; amended 43 FR 28479, June 30, 1978.]

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

(a) A petition for rescission or removal of a secrecy order may be filed by, or on behalf of, any principal affected thereby. Such petition may be in letter form, and it must be in duplicate. The petition must be accompanied by one copy of the application or an order for the same, unless a showing is made that such a copy has already been furnished to the department or agency which caused the secrecy order to be issued.

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

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

(d) Unless based upon facts of public record, the petition must be verified.

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

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

(b) Petitions for a permit or modification must fully recite the reason or purpose for the proposed disclosure. Where any proposed disclosee is known to be cleared by a defense agency to receive classified information, adequate explanation of such clearance should be made in the petition including the name of the agency or department granting the clearance and the date and degree thereof. The petition must be filed in duplicate and be accompanied by one copy of the application or an order for the same, unless a showing is made that such a copy has already been

furnished to the department or agency which caused the secrecy order to be issued.

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

(d) Consent to the disclosure of subject matter from one application under secrecy order may be deemed to be consent to the disclosure of common subject matter in other applications under secrecy order so long as not taken out of context in a manner disclosing material beyond the modification granted in the first application.

(e) The permit or modification may contain conditions and limitations.

#### § 5.6 General and group permits.

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

(b) Where identical disclosees and circumstances are involved, and consent is desired for the disclosure of each of a specific list of applications, the petitions may be joined.

#### § 5.7 Compensation.

Any request for compensation as provided in 35 U.S.C. 183 must not be made to the Patent and Trademark Office but should be made directly to the department or agency which caused the secrecy order to be issued. Upon written request persons having a right to such information will be informed as to the department or agency which caused the secrecy order to be issued.

#### § 5.8 Appeal to Secretary.

Appeal to the Secretary of Commerce, as provided by 35 U.S.C. 181, from a secrecy order cannot be taken until after a petition for rescission of the secrecy order has been made and denied. Appeal must be taken within 60 days from the date of the denial, and the party appealing, as well as the department or agency which caused the order to be issued will be notified of the time and place of hearing. The appeal will be heard and decided by the Secretary or such officer or officers as he may designate.

### LICENSES FOR FOREIGN EXPORTING AND FILING

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

(a) A license from the Commissioner of Patents and Trademarks under 35 U.S.C. 184 is required before filing any application for patent or for the registration of a utility model, industrial design, or model, in a foreign country or in a foreign patent office or any international agency other than the United States Receiving Office if:

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

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

(b) The license from the Commissioner of Patents and Trademarks referred to in paragraph (a) would also authorize the export of technical data abroad for purposes relating to the preparation, filing or possible filing and prosecution of a foreign patent application without separately complying with the regulations contained in 22 CFR Parts 121 through 130 (International Traffic in Arms Regulations of the Department of State), 15 CFR Part 379 (Regulations of the Office of Export Administration, International Trade Administration, Department of Commerce) and 10 CFR Part 810 (Foreign Atomic Energy Programs of the Department of Energy).

(c) Where technical data in the form of a patent application, or in any form, is being exported for purposes related to the preparation, filing or possible filing and prosecution of a foreign patent application, without the license from the Commissioner of Patents and Trademarks referred to in paragraphs (a) or (b) of this section, or on an invention not made in the United States, the export regulations contained in 22 CFR Parts 121 through 130 ((International Traffic in Arms Regulations of the Department of State), 15 CFR Part 379 (Regulations of the Office of Export Administration, International Trade Administration, Department of Commerce) and 10 CFR Part 810 (Foreign Atomic Energy Programs of the Department of Energy) must be complied with unless a license is not required because a United States application was on file at the time of export for at least six months without a secrecy order under § 5.2 being placed thereon. The term "exported" means export as it is defined in 22 CFR Parts 121 through 130, 15 CFR Parts 379 and 10 CFR Part 810.

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

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

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

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

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

[49 FR 134, Apr. 4, 1984.]

**§ 5.12. Petition for license.**

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

(b) Petitions for license should be presented in letter form and must include the required fee (§ 1.17(h)). If expedited handling of the petition is also sought, the petitioner's address, and full instructions for delivery of the requested license when it is to be delivered to other than the petitioner.

[48 FR 2714, Jan. 20, 1983; amended 49 FR 13462, Apr. 4, 1984.]

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

If no corresponding national or international application has been filed in the United States, the petition for license under § 5.12(b) must be accompanied by the required fee (§ 1.17(h)), if expedited handling of the petition is sought, and a legible copy of the material upon which license is desired. This copy will be retained as a measure of the license granted. For assistance in the identification of the subject matter of each license so issued, it is suggested that the petition be submitted in duplicate and provide a title and other description of the material. The duplicate copy of the petition will be returned with the license or other action on the petition.

[49 FR 13462, Apr. 4, 1984.]

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

(a) Where there is a corresponding United States application on file, a petition for license under § 5.12(b) must include the required fee (§ 1.17(h)), if expedited handling of the petition is also sought, and must identify this application by serial number, filing date, inventor, and title, and a copy of the material upon which the license is desired is not required. The subject matter licensed will be measured by the disclosure of the United States application. Where the title is not descriptive, and the subject matter is clearly of no interest from a security standpoint, time may be saved by a short statement in the petition as to the nature of the invention.

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

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

submitted in detail and the remainder by reference to the pertinent United States application or applications.

[43 FR 20471, May 11, 1978; 49 FR 13462, Apr. 4, 1984]

### § 5.15 Scope of license.

(a) Grant of a license under § 5.12(a) authorizes the export and to filing of an application in a foreign country or the transmitting of an international application to any foreign patent agency or international patent agency when the subject matter of the foreign or international application corresponds to that of the domestic application. This license includes authority

(1) To export and file all duplicate and formal papers to the foreign country or international agencies;

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

(3) To take any action in the prosecution of the foreign or international application; and

(4) To add subject matter or take any action under paragraphs (a) through (3) of this section which does not change the general nature of the subject matter disclosed at the time of filing, unless the subject matter added involves technical data pertaining to:

(i) Defense services or articles designated in the United States Munitions List applicable at the time of foreign filing, the unlicensed exportation of which is prohibited pursuant to the Arms Export Control Act, as amended, and 22 CFR Parts 121 through 130; or

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

(b) Grant of license under § 5.12(b) authorizes the export and filing of an application in a foreign country or the transmitting of an international application to any foreign patent agency or international patent agency. Further this license includes authority to forward all duplicate and formal papers to the foreign patent agency or international patent agency and to make amendments, modifications or supplements to and take any action in the prosecution of the foreign or international application, provided subject matter additional to that covered by the license is not involved.

(c) A license granted under § 5.1(b) pursuant to § 5.13 or § 5.14 shall have the scope indicated in paragraph (a) of this section, if it is so specified in the license. A petition, accompanied by the required fee (§ 1.17(h)), may also be filed to change a license having the scope indicated in paragraph (b) of this section to a license having the scope indicated in paragraph (a) of this section. The change in the scope of a license will be as of the date of the grant of the change in scope.

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

disclosure of additional subject matter.

(e) Any paper filed abroad or transmitted to an international patent agency following the filing of a foreign or international application which changes the general nature of the subject matter disclosed at the time of filing or which involves the disclosure of subject matter listed in paragraphs (a)(4)(i) or (ii) of this section must be separately licensed in the same manner as a foreign or international application. Further, if no license has been granted under § 5.12(a) on filing the corresponding United States application, any paper filed abroad or with an international patent agency which involves the disclosure of additional subject matter must be licensed in the same manner as a foreign or international application.

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

(1) Subject matter which changes the general nature of the subject matter disclosed at the time of filing or which involves subject matter listed in paragraphs (a)(4)(i) or (ii) of this section is not introduced and,

(2) In the case where at least one of the licenses was obtained under § 5.2(b), additional subject matter is not introduced.

(g) A license does not apply to acts done before the license was granted. See § 5.25 for petitions for retroactive licenses, [49 FR 13462, Apr. 4, 1984.]

### § 5.16 Effect of secrecy order.

Any license obtained under 35 U.S.C. 184 is ineffective if the subject matter is under a secrecy order, and a secrecy order prohibits the exercise of or any further action under the license unless separately specifically authorized by a modification of the secrecy order in accordance with § 5.5.

### § 5.17 Who may use license.

Licenses may be used by anyone interested in the export, foreign filing, or international transmittal for or on behalf of the inventor or the inventor's assigns.

[49 FR 13463, Apr. 4, 1984.]

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

(a) The exportation of technical data relating to arms, ammunition, and implements of war generally is subject to the International Traffic in Arms Regulations of the Department of State (22 CFR Parts 121 through 128); the articles designated as arms, ammunition, and implements of war are enumerated in the U.S. Munitions List, 22 CFR 121.01. However, if a patent applicant complies with regulations issued by the Commissioner of Patents and Trademarks under 35 U.S.C. 184, no separate approval from the Department of State is required unless the applicant seeks to export technical data exceeding that used to support a patent application in a foreign country. This exemption from Department of State regulations is applicable regardless of whether a license from the Commissioner is required by the provisions of §§ 5.11 and 5.15 (22 CFR 125.04(b), 125.20(b)).

(b) When a patent application containing subject matter on the Munitions List (22 CFR 121.01) is subject to a secrecy order under § 5.2 and a petition is made under § 5.5 for a modification

of the secrecy order to permit filing abroad, a separate request to the Department of State for authority to export classified information is not required (22 CFR 125.05(d)).

[35 FR 6430, Apr. 22, 1970.]

**§ 5.19 Export of technical data.**

(a) Under regulations (15 CFR 370.10(j)) established by the U.S. Department of Commerce, International Trade Administration, Office of Export Administration, a validated export license is not required in any case to file a patent application or part thereof in a foreign country if the foreign filing is in accordance with the regulations (37 CFR 5.11 through 5.23) of the Patent and Trademark Office.

(b) A validated export license is not required for data contained in a patent application prepared wholly from foreign-origin technical data where such application is being sent to the foreign inventor to be executed and returned to the United States for subsequent filing in the U.S. Patent and Trademark Office (15 CFR 379.3(c)).

(c) Inquiries concerning the export control regulations for the foreign filing of technical data other than patent applications should be made to the Office of Export Administration, International Trade Administration, Department of Commerce, Washington, D.C. 20230.

[45 FR 72654, Nov. 3, 1980.]

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

(a) Under regulations (10 CFR 810.7) established by the United States Department of Energy, an application filed in accordance with the regulations (37 CFR 5.11 through 5.33) of the United States Patent and Trademark Office and eligible for foreign filing under 35 U.S.C. 184, is considered to be information available to the public in published form and a generally authorized activity for the purposes of the Department of Energy regulations.

(b) Inquiries concerning the export of sensitive nuclear technology other than related to the filing or prosecution of a foreign patent application should be made to the Attention: Secretary, United States Department of Energy, Office of International Security Affairs, Washington, D.C. 20858.

[49 FR 13463, Apr. 4, 1984.]

**§ 5.25 Petition for retroactive license**

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

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

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

(3) A verified statement containing:

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

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

(iii) An explanation of why the material was inadvertently

filed abroad without the required license under 5.11 first having been obtained, and

(4) The required fee (§ 1.17(h)).

The above explanation must include a showing of facts rather than a mere allegation of inadvertence. The showing of facts should include statements by those persons having personal knowledge of the acts regarding filing in a foreign country and should be accompanied by copies of any necessary supporting documents such as letters of transmittal or instructions for filing. The acts which are alleged to constitute inadvertence should cover the period from the time of filing until actual filing of the petition under this section.

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

(c) The granting of a retroactive license does not excuse any violation of the export regulations contained in 22 CFR Parts 121 through 130 (International Traffic in Arms Regulations of the Department of State), 15 CFR Part 379 (Regulations of Office of Export Administration, International Trade Administration, Department of Commerce) and 10 CFR Part 810 (Foreign Atomic Energy Programs of the Department of Energy) which may have occurred because of failure to obtain an appropriate license prior to export.

[49 FR 13463, Apr. 4, 1984.]

**GENERAL**

**§5.31 Effect of modification, rescission or license.**

Any consent, rescission or license under the provisions of this part does not lessen the responsibilities of the principals in respect to any Government contract or the requirements of any other Government agency.

[24 FR 10381, Dec. 22, 1959; Redesignated at 49 FR 13463, Apr. 4, 1984.]

**§5.32 Papers in English language.**

All papers submitted in connection with petitions must be in the English language, or be accompanied by an English translation and a translator's certificate as to the true, faithful and exact character of the translation.

[24 FR 10381, Dec. 22, 1959; Redesignated at 49 FR 13463, Apr. 4, 1984.]

**§ 5.33 Correspondence.**

All correspondence in connection with this part, including petitions, should be addressed to "Commissioner of Patents and Trademarks (Attention Licensing and Review), Washington, D.C. 20231."

[49 FR 13463, Apr. 4, 1984.]

# MANUAL OF PATENT EXAMINING PROCEDURE

Section 101 of the Patent Act requires that an invention be a process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, in order to be patentable. This section does not require that an invention be a new discovery or invention. It is sufficient that it be a process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.

Section 102 of the Patent Act requires that an invention be novel. This section does not require that an invention be a new discovery or invention. It is sufficient that it be a process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, in order to be patentable.

Section 103 of the Patent Act requires that an invention be non-obvious. This section does not require that an invention be a new discovery or invention. It is sufficient that it be a process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, in order to be patentable.

Section 104 of the Patent Act requires that an invention be a process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, in order to be patentable. This section does not require that an invention be a new discovery or invention. It is sufficient that it be a process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.

Section 105 of the Patent Act requires that an invention be a process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, in order to be patentable. This section does not require that an invention be a new discovery or invention. It is sufficient that it be a process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.

Section 106 of the Patent Act requires that an invention be a process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, in order to be patentable. This section does not require that an invention be a new discovery or invention. It is sufficient that it be a process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.



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- § 10.76 Canon 6.
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- § 10.84 Representing a client zealously.
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**INVESTIGATIONS AND DISCIPLINARY PROCEEDINGS**

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- § 10.161 Savings clause.
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- § 10.170 Suspension of rules.

§ 10.1 Definitions.

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

- (a) "Affidavit" means affidavit, declaration under 35 U.S.C. 25 (see § 1.68 and § 2.20 of this subchapter), or statutory declaration under 28 U.S.C. 1746.
- (b) "Application" includes an application for a design, plant, or utility patent, an application to reissue any patent, and an application to register a trademark.
- (c) "Attorney" or "lawyer" means an individual who is a member in good standing of the bar of any United States court or the highest court of any State. A "non-lawyer" is a person who is not an attorney or lawyer.
- (d) "Canon" is defined in § 10.20(a).
- (e) "Confidence" is defined in § 10.57(a).
- (f) "Differing interests" include every interest that may adversely affect either the judgment or the loyalty of a practitioner to a client, whether it be a conflicting, inconsistent, diverse, or other interest.
- (g) "Director" means the Director of Enrollment and Discipline.
- (h) "Disciplinary Rule" is defined in § 10.20(b).
- (i) "Employee of a tribunal" includes all employees of courts, the Office, and other adjudicatory bodies.
- (j) "Giving information" within the meaning of § 10.23(c) (2) includes making (1) a written statement or representation or (2) an oral statement or representation.
- (k) "Law firm" includes a professional legal corporation or a partnership.
- (l) "Legal counsel" means practitioner.
- (m) "Legal profession" includes the individuals who are lawfully engaged in practice of patent, trademark, and other law before the Office.
- (n) "Legal service" means any legal service which may lawfully be performed by a practitioner before the Office.
- (o) "Legal System" includes the Office and courts and adjudicatory bodies which review matters on which the Office has acted.

- (p) "Office" means Patent and Trademark Office.
- (q) "Person" includes a corporation, an association, a trust, a partnership, and any other organization or legal entity.
- (r) "Practitioner" means (1) an attorney or agent registered to practice before the Office in patent cases or (2) an individual authorized under 5 U.S.C. 500(b) or otherwise as provided by this Subchapter, to practice before the Office in trademark cases or other non-patent cases. A "suspended or excluded practitioner" is a practitioner who is suspended or excluded under § 10.156. A "non-practitioner" is an individual who is not a practitioner.
- (s) A "proceeding before the Office" includes an application, a reexamination, a protest, a public use proceeding, a patent interference, an *inter partes* trademark proceeding, or any other proceeding which is pending before the Office.
- (t) "Professional legal corporation" means a corporation authorized by law to practice law for profit.
- (u) "Registration" means registration to practice before the Office in patent cases.
- (v) "Respondent" is defined in § 10.134(a)(1).
- (w) "Secret" is defined in § 10.57(a).
- (x) "Solicit" is defined in § 10.33.
- (y) "State" includes the District of Columbia, Puerto Rico, and other federal territories and possessions.
- (z) "Tribunal" includes courts, the Office, and other adjudicatory bodies.
- (aa) "United States" means the United States of America, its territories and possessions.

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

§ 10.2 Director of Enrollment and Discipline.

- (a) *Appointment.* The Commissioner shall appoint a Director of Enrollment and Discipline. In the event of the absence of the Director or a vacancy in the Office of the Director, the Commissioner may designate an employee of the Office to serve as acting Director of Enrollment and Discipline. The Director and any acting Director shall be an active member in good standing of the bar of a State.
- (b) *Duties.* The Director shall:
  - (1) Receive and act upon applications for registration, prepare and grade the examination provided for in § 10.7(b), maintain the register provided for in § 10.5, and perform such other duties in connection with enrollment and recognition of attorneys and agents as may be necessary.
  - (2) Conduct investigations into possible violations by practitioners of Disciplinary Rules, with the consent of the Committee on Discipline initiate disciplinary proceedings under § 10.132(b), and perform such other duties in connection with investigations and disciplinary proceedings as may be necessary.
- (c) *Review of Director's decision.* Any final decision of the Director refusing to register an individual under § 10.6, recognize an individual under § 10.9 or § 10.14(c), or reinstate a suspended or excluded petitioner under § 10.160, may be reviewed by petition to the Commissioner upon payment of the fee set forth in § 1.21(a)(5). A petition filed more than 30 days after the date of the decision of the Director may be dismissed

as untimely. Any petition shall contain (1) a statement of the facts involved and the points to be reviewed and (2) the action requested. Briefs or memoranda, if any, in support of the petition shall accompany or be embodied therein. The petition will be decided on the basis of the record made before the Director and no new evidence will be considered by the Commissioner in deciding the petition. Copies of documents already of record before the Director shall not be submitted with the petition. An oral hearing on the petition will not be granted except when considered necessary by the Commissioner.

[OMB Control No. 0651-0012.]

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

### § 10.3 Committee on Enrollment.

(a) The Commissioner may establish a Committee on Enrollment composed of one or more employees of the Office.

(b) The Committee on Enrollment shall, as necessary, advise the Director in connection with the Director's duties under § 10.2(b)(1).

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

### § 10.4 Committee on Discipline.

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

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

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

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

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

### § 10.5 Register of attorneys and agents in patent cases.

A register of attorneys and agents is kept in the Office on which are entered the names of all individuals recognized as entitled to represent applicants before the Office in the preparation and prosecution of applications for patent. Registration in the Office under the provisions of this part shall only entitle the individuals registered to practice before the Office in patent cases.

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

### § 10.6 Registration of attorneys and agents.

(a) *Attorneys.* Any citizen of the United States who is an

attorney and who fulfills the requirements of this part may be registered as a patent attorney to practice before the Office. When appropriate, any alien who is an attorney, who lawfully resides in the United States, and who fulfills the requirements of this part may be registered as a patent attorney to practice before the Office, *provided:* Registration is not inconsistent with the terms upon which the alien was admitted to, and resides in, the United States and further *provided:* The alien may remain registered only (1) if the alien continues to lawfully reside in the United States and registration does not become inconsistent with the terms upon which the alien continues to lawfully reside in the United States or (2) if the alien ceases to reside in the United States, the alien is qualified to be registered under paragraph (c) of this section. See also § 10.9(b).

(b) *Agents.* Any citizen of the United States who is not an attorney and who fulfills the requirements of this part may be registered as a patent agent to practice before the Office. When appropriate, any alien who is not an attorney, who lawfully resides in the United States, and who fulfills the requirements of this part may be registered as a patent agent to practice before the Office, *provided:* Registration is not inconsistent with the terms upon which the alien was admitted to, and resides in, the United States, and further *provided:* The alien may remain registered only (1) if the alien continues to lawfully reside in the United States and registration does not become inconsistent with the terms upon which the alien continues to lawfully reside in the United States or (2) if the alien ceases to reside in the United States, the alien is qualified to be registered under paragraph (c) of this section. See also § 10.9(b).

NOTE: All individuals registered prior to November 15, 1938, were registered as attorneys, whether they were attorneys or not, and such registrations have not been changed.

(c) *Foreigners.* Any foreigner not a resident of the United States who shall file proof to the satisfaction of the Director that he or she is registered and in good standing before the patent office of the country in which he or she resides and practices and who is possessed of the qualifications stated in § 10.7, may be registered as a patent agent to practice before the Office for the limited purpose of presenting and prosecuting patent applications of applicants located in such country, *provided:* The patent office of such country allows substantially reciprocal privileges to those admitted to practice before the United States Patent and Trademark Office. Registration as a patent agent under this paragraph shall continue only during the period that the conditions specified in this paragraph obtain.

(d) *Government employees.* Any officer or employee of the United States who is disqualified by statute (18 U.S.C. 203, 205) from practicing as an attorney or agent in proceedings or other matters before Government departments or agencies, may not be registered to practice before the Office. If any registered attorney or agent becomes an officer or employee of the United States who is disqualified by statute from practicing as an attorney or agent in proceedings and other matters before Government departments or agencies, his or her name shall be endorsed as inactive on the register during the period of any employment by the United States. An officer or employee of the United States whose official duties require the preparation and

prosecution of applications for patent and who fulfills the requirements of this part may be registered to practice before the Office to the extent necessary to carry out his or her official duties. A written statement describing the official duties of the officer or employee and signed on behalf of the agency employing the officer or employee may be required by the Director.

(e) *Former Office employees.* No individual who has served in the Office will be registered after termination of his or her services, nor if registered before such service, be reinstated, unless he or she signs a written statement indicating that he or she has read 18 U.S.C. 207. No individual who has served in the patent examining corps of the Office will be registered after termination of his or her services, nor if registered before such service, be reinstated, unless he or she signs a written undertaking (1) not to prosecute or aid in any manner in the prosecution of any patent application pending in any patent examining group during his or her period of service therein and (2) not to prepare or prosecute or to assist in any manner in the preparation or prosecution of any patent application of another (i) assigned to such group for examination and (ii) filed within two years after the date he or she left such group, without written authorization of the Director. Associated and related classes in other patent examining groups may be required to be included in the undertaking or designated classes may be excluded from the undertaking. When an application for registration or reinstatement is made after resignation from the Office, the applicant will not be registered or reinstated if he or she has prepared or prosecuted or assisted in the preparation or prosecution of any patent application as indicated in this paragraph.

[OMB Control No. 0651-0012.]

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

### § 10.7 Requirements for registration.

(a) No individual will be registered to practice before the Office unless he or she shall:

(1) Apply to the Commissioner in writing on a form supplied by the Director and furnish all requested information and material and

(2) Establish to the satisfaction of the Director that he or she is:

(i) Of good moral character and repute;

(ii) Possessed of the legal, scientific, and technical qualifications necessary to enable him or her to render applicants valuable service; and

(iii) Is otherwise competent to advise and assist applicants for patents in the presentation and prosecution of their applications before the Office.

(b) In order that the Director may determine whether an individual seeking to have his or her name placed upon the register has the qualifications specified in paragraph (a) of this section, satisfactory proof of good moral character and repute and of sufficient basic training in scientific and technical matters must be submitted to the Director. Except as provided in this paragraph, each applicant for registration must take and pass an examination which is held from time to time. Each application for admission to take the examination for registration must be accompanied by the fee set forth in § 1.21(a)(1) of this subchapter.

ter. The taking of an examination may be waived in the case of any individual who has actively served for at least four years in the patent examining corps of the Office. The examination will not be administered as a mere academic exercise.

(c) Within two months from the date an applicant is notified that he or she failed an examination, the applicant may request regrading of the examination upon payment of the fee set forth in § 1.21(a)(6). Any applicant requesting regrading shall particularly point out the errors which the applicant believed occurred in the grading of his or her examination.

[OMB Control No. 0651-0012.]

[Added 50 FR 5174, Feb. 6, 1985, effective Mar. 8, 1985]

### § 10.8 Oath and registration fee.

Before an individual may have his or her name entered on the register of attorneys and agents, the individual must, after his or her application is approved, subscribe and swear to an oath or make a declaration prescribed by the Commissioner and pay the registration fee set forth in § 1.21(a)(2) of this subchapter.

[OMB Control No. 0651-0012.]

[Added 50 FR 5174, Feb. 6, 1985, effective Mar. 8, 1985]

### § 10.9 Limited recognition in patent cases.

(a) Any individual not registered under § 10.6 may, upon a showing of circumstances which render it necessary or justifiable, be given limited recognition by the Director to prosecute as attorney or agent a specified application or specified applications, but limited recognition under this paragraph shall not extend further than the application or applications specified.

(b) When registration of a resident alien under paragraphs (a) or (b) of § 10.6 is not appropriate, the resident alien may be given limited recognition as may be appropriate under paragraph (a) of this section.

[Added 50 FR 5174, Feb. 6, 1985, effective Mar. 8, 1985]

### § 10.10 Individuals not registered or recognized to practice in patent cases.

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

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

### § 10.11 Removing names from the register.

(a) Registered attorneys and agents shall notify the Director of any change of address. Any notification to the Director of any change of address shall be separate from any notice of change of address filed in individual applications.

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

[OMB Control No. 0651-0012.]  
 [Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985]

§§ 10.12 - 10.13 [Reserved]

§ 10.14 **Individuals who may practice before the Office in trademark and other non-patent cases.**

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

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

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

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

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

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

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

Any practitioner authorized to appear before the Office may be suspended or excluded in accordance with the provisions of this part. Any practitioner who is suspended or excluded under this subpart or removed under § 10.11(b) shall not be entitled to practice before the Office.

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

§§ 10.16 - 10.17 [Reserved]

§ 10.18 **Signature and certificate of practitioner.**

(a) Every paper filed by a practitioner representing an applicant or party to a proceeding in the Office must bear the signature of, and be personally signed by, such practitioner except those papers which are required to be signed by the applicant or party. The signature of practitioner to a paper filed by him or her, constitutes a certificate that:

- (1) The paper has been read by the practitioner;
- (2) The paper's filing is authorized;
- (3) To the best of his or her knowledge, information, and belief, there is good ground to support the paper, including any allegations of improper conduct contained or alleged therein; and
- (4) It is not interposed for delay.

(b) Any practitioner knowingly violating the provisions of this section is subject to disciplinary action. See § 10.23(c)(15).  
 [Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985]

10.19 [Reserved]

**PATENT AND TRADEMARK OFFICE CODE OF PROFESSIONAL RESPONSIBILITY**

10.20 **Canons and Disciplinary Rules.**

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

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

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

§ 10.21 **Canon 1.**

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

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

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

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

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

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

**§ 10.23 Misconduct.**

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

(b) A practitioner shall not:

(1) Violate a Disciplinary Rule.

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

(3) Engage in illegal conduct involving moral turpitude.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

(i) A State,

(ii) The United States, or

(iii) The country in which the practitioner resides.

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

(7) Knowingly withholding from the Office information identifying a patent or patent application of another from which one or more claims have been copied. See §§ 1.604(b) and 1.607(c) of this subchapter.

(8) Failing to inform a client or former client or failing to timely notify the Office of an inability to notify a client or former client of correspondence received from the Office or the client's or former client's opponent in an *inter partes* proceeding before the Office when the correspondence (i) could have a significant

effect on a matter pending before the Office, (ii) is received by the practitioner on behalf of a client or former client and (iii) is correspondence of which a reasonable practitioner would believe under the circumstances the client or former client should be notified.

(9) Knowingly misusing a certificate of mailing under § 1.8 of this subchapter or a certificate of "Express Mail" under § 1.10 of this subchapter.

(10) Violating the duty of candor or good faith requirements of § 1.56(a) of this subchapter.

(11) Knowingly filing, or causing to be filed, an application which is subject to being stricken under § 1.56(c) of this subchapter.

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

(13) Knowingly preparing or prosecuting a patent application in violation of an undertaking signed under § 10.6(e).

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

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

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

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



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

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

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

[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985; amended 50 FR 25073, June 17, 1985; 50 FR 25980, June 24, 1985]

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

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

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

[OMB Control No. 0651-0017.]

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

#### §§ 10.25 - 10.29 [Reserved]

#### § 10.30 Canon 2.

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

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

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

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

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

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

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

(1) To be an attorney or lawyer or

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

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

#### § 10.32 Advertising.

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

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

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

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

#### § 10.33 Direct contact with perspective clients.

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

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

#### § 10.34 Communications of fields of practice.

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

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

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

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

**§ 10.35 Firm names and letterheads.**

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

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

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

**§ 10.36 Fees for legal services.**

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

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

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

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

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

(4) The amount involved and the results obtained.

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

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

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

(8) Whether the fee is fixed or contingent.

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

**§ 10.37 Division of fees among practitioners.**

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

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

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

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

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

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

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

(a) A practitioner shall not be a party to or participate in a partnership or employment agreement with another practitioner that restricts the right of a practitioner to practice before the Office after the termination of a relationship created by the

agreement, except as a condition to payment of retirement benefits.

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

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

**§ 10.39 Acceptance of employment.**

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

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

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

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

**§ 10.40 Withdrawal from employment.**

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

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

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

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

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

(4) The practitioner is discharged by the client.

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

(1) The petitioner's client:

(i) Insists upon presenting a claim or defense that is not warranted under existing law and cannot be supported by good

faith argument for an extension, modification, or reversal of existing law;

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

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

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

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

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

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

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

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

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

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

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

§§ 10.41 - 10.45 [Reserved]

§ 10.46 Canon 3.

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

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

§ 10.47 Aiding unauthorized practice of law.

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

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

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

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

§ 10.48 Sharing legal fees.

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

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

(b) A practitioner who undertakes to complete unfinished legal business of a deceased practitioner may pay to the estate of the deceased practitioner that proportion of the total compen-

sation which fairly represents the services rendered by the deceased practitioner.

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

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

§ 10.49 Forming a partnership with a non-practitioner.

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

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

§§ 10.50 - 10.55 [Reserved]

§ 10.56 Canon 4.

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

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

§ 10.57 Preservation of confidences and secrets of a client.

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

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

(1) Reveal a confidence or secret of a client.

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

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

(c) A practitioner may reveal:

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

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

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

(4) Confidences or secrets necessary to establish or collect the practitioner's fee or to defend the practitioner or the practitioner's employees or associates against an accusation of wrongful conduct.

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

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

§ 10.61

§§ 10.58 - 10.60 [Reserved]

§ 10.61 Canon 5

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

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

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

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

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

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

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

(3) If the testimony will relate solely to the nature and value of legal services rendered in the case by the practitioner or the practitioner's firm to the client.

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

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

§ 10.63 Withdrawal when the practitioner becomes a witness.

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

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

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

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

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

(1) Acquire a lien granted by law to secure the practitioner's fee or expenses; or

(2) Contract with a client for a reasonable contingent fee; or

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

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

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

§ 10.65 Limiting business relations with a client.

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

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

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

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

(b) A practitioner shall not continue multiple employment if the exercise of the practitioner's independent professional judgment in behalf of a client will be or is likely to be adversely affected by the practitioner's representation of another client, or if it would be likely to involve the practitioner in representing differing interests, except to the extent permitted under paragraph (c) of this section.

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

ment on behalf of each.

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

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

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

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

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

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

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

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

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

(b) A practitioner shall not permit a person who recommends, employs, or pays the practitioner to render legal services for another, to direct or regulate the practitioner's professional judgment in rendering such legal services.

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

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

#### §§ 10.69 - 10.75 [Reserved]

#### § 10.76 Canon 6.

A practitioner should represent a client competently.

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

#### § 10.77 Failing to act competently.

A practitioner shall not:

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

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

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

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

#### § 10.78 Limiting liability to client.

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

personal malpractice.

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

#### §§ 10.79 - 10.82 [Reserved]

#### § 10.83 Canon 7.

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

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

#### § 10.84 Representing a client zealously.

(a) A practitioner shall not intentionally:

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

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

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

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

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

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

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

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

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

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

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

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

(4) Knowingly use perjured testimony or false evidence.

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

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

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

(8) Knowingly engage in other illegal conduct or conduct

contrary to a Disciplinary Rule.

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

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

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

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

§ 10.86 [Reserved]

§ 10.87 Communicating with one of adverse interest.

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

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

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

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

§ 10.88 Threatening criminal prosecution.

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

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

§ 10.89 Conduct in proceedings.

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

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

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

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

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

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

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

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

(4) Assert the practitioner's personal opinion as to the justness of a cause, as to the credibility of a witness, as to the culpability of a civil litigant, or as to the guilt or innocence of an accused; but the practitioner may argue, on the practitioner's analysis of the evidence, for any position or conclusion with respect to the matters stated herein.

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

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

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

§§ 10.90-10.91 [Reserved]

§ 10.92 Contact with witnesses.

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

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

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

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

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

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

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

§ 10.93 Contact with officials.

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

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

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

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

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

(4) As otherwise authorized by law.

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

§§ 10.94 - 10.99 [Reserved]

**§ 10.100 Canon 8.**

A practitioner should assist in improving the legal system.  
 [Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985]

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

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

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

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

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

(b) A practitioner who is an officer or employee of the United States shall not practice before the Office in patent cases except as provided in § 10.6(d).

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

**§ 10.102 Statements concerning officials.**

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

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

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

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

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

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

**§§ 10.104 - 10.109 [Reserved]**

**§ 10.110 Canon 9.**

A practitioner should avoid even the appearance of professional impropriety.

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

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

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

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

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

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

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

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

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

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

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

(c) A practitioner shall:

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

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

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

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

[OMB Control No. 0651-0017.]

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

**§§ 10.113 - 10.129 [Reserved]**

**INVESTIGATIONS AND DISCIPLINARY PROCEEDINGS**

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

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

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

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

**§ 10.131 Investigations.**

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

(b) Practitioners shall report and reveal to the Director any

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

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

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

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

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

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

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

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

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

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

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

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

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

- (1) The resignation is freely and voluntarily proffered;
- (2) The practitioner is not acting under duress or coercion from the Office;
- (3) The practitioner is fully aware of the implications of filing the resignation;

(4) The practitioner is aware (i) of a pending investigation or (ii) of charges arising from the complaint alleging that he or she is guilty of a violation of the Patent and Trademark Office Code of Professional Responsibility, the nature of which shall

be set forth by the practitioner to the satisfaction of the Director;

(5) The practitioner acknowledges that, if and when he or she applies for reinstatement under § 10.160, the Director will conclusively presume, for the limited purpose of determining the application for reinstatement, that:

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

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

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

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

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

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

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

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

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

#### § 10.134 Complaint.

(a) A complaint instituting a disciplinary proceeding shall:

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

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

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

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

(5) Be signed by the Director.

(b) A complaint will be deemed sufficient if it fairly informs



the respondent of any violation of the Disciplinary Rules which form the basis for the disciplinary proceeding so that the respondent is able to adequately prepare a defense.

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

#### § 10.135 Service of complaint.

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

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

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

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

(ii) A non-registered practitioner to the last address for the respondent known to the Director.

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

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

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

(d) If the respondent is represented by an attorney under § 10.140(a), a copy of the complaint shall also be served on the attorney.

[Added 50 FR 5183, Feb. 6, 1985, effective Mar. 8, 1985]

#### § 10.136 Answer to complaint.

(a) *Time for answer.* An answer to a complaint shall be filed within a time set in the complaint which shall be not less than thirty days.

(b) *With whom filed.* The answer shall be filed in writing with the administrative law judge. The time for filing an answer may be extended once for a period of no more than thirty days by the administrative law judge upon a showing of good cause provided a motion requesting an extension of time is filed within thirty days after the date the complaint is filed by the Director. A copy of the answer shall be served on the Director.

(c) *Content.* The respondent shall include in the answer a statement of the facts which constitute the grounds of defense and shall specifically admit or deny each allegation set forth in the complaint. The respondent shall not deny a material allegation

in the complaint which the respondent knows to be true or state that respondent is without sufficient information to form a belief as to the truth of an allegation when in fact the respondent possesses that information. The respondent shall also state affirmatively special matters of defense.

(d) *Failure to deny allegations in complaint.* Every allegation in the complaint which is not denied by a respondent in the answer is deemed to be admitted and may be considered proven. No further evidence in respect of that allegation need be received by the administrative law judge at any hearing. Failure to timely file an answer will constitute an admission of the allegations in the complaint.

(e) *Reply by the Director.* No reply to an answer is required by the Director and any affirmative defense in the answer shall be deemed to be denied. The Director may, however, file a reply if he or she chooses or if ordered by the administrative law judge.

[Added 50 FR 5183, Feb. 6, 1985, effective Mar. 8, 1985; amended 50 FR 25073, June 17, 1985, ]

#### § 10.137 Supplemental complaint.

False statements in an answer may be made the basis of a supplemental complaint.

[Added 50 FR 5183, Feb. 6, 1985, effective Mar. 8, 1985]

#### § 10.138 Contested case.

Upon the filing of an answer by the respondent, a disciplinary proceeding shall be regarded as a contested case within the meaning of 35 U.S.C. 24. Evidence obtained by a subpoena issued under 35 U.S.C. 24 shall not be admitted into the record or considered unless leave to proceed under 35 U.S.C. 24 was previously authorized by the administrative law judge.

[Added 50 FR 5183, Feb. 6, 1985, effective Mar. 8, 1985]

#### § 10.139 Administrative law judge; appointment; responsibilities; review of interlocutory orders; stays.

(a) *Appointment.* An administrative law judge, appointed under 5 U.S.C. 3105, shall conduct disciplinary proceedings as provided by this part.

(b) *Responsibilities.* The administrative law judge shall have authority to:

- (1) Administer oaths and affirmations;
- (2) Make rulings upon motions and other requests;
- (3) Rule upon offers of proof, receive relevant evidence, and examine witnesses;
- (4) Authorize the taking of a deposition of a witness in lieu of personal appearance of the witness before the administrative law judge;
- (5) Determine the time and place of any hearing and regulate its course and conduct;
- (6) Hold or provide for the holding of conferences to settle or simplify the issues.
- (7) Receive and consider oral or written arguments on facts and law;
- (8) Adopt procedures and modify procedures from time to time as occasion requires for the orderly disposition of proceedings;
- (9) Make initial decisions under § 10.154; and

(10) Perform acts and take measures as necessary to promote the efficient and timely conduct of any disciplinary proceeding.

(c) *Time for making initial decision.* The administrative law judge shall set times and exercise control over a disciplinary proceeding such that an initial decision under § 10.154 is normally issued within six months of the date a complaint is filed. The administrative law judge may, however, issue an initial decision more than six months after a complaint is filed if in his or her opinion there exist unusual circumstances which preclude issuance of an initial decision within six months of the filing of the complaint.

(d) *Review of interlocutory orders.* An interlocutory order of an administrative law judge will not be reviewed by the Commissioner except:

(1) when the administrative law judge shall be of the opinion (i) that the interlocutory order involves a controlling question of procedure or law as to which there is a substantial ground for a difference of opinion and (ii) that an immediate decision by the Commissioner may materially advance the ultimate termination of the proceeding; or

(2) in an extraordinary situation where justice requires review.

(e) *Stays pending review of interlocutory order.* If the Director or a respondent seeks review of an interlocutory order of an administrative law judge under paragraph (b)(2) of this section, any time period set for taking action by the administrative law judge shall not be stayed unless ordered by the Commissioner or the administrative law judge.

[Added 50 FR 5183, Feb. 6, 1985, effective Mar. 8, 1985; amended 50 FR 25073, June 17, 1985]

#### § 10.140 Representative for Director or respondent.

(a) A respondent may be represented before the Office in connection with an investigation or disciplinary proceeding by an attorney. The attorney shall file a written declaration that he or she is an attorney within the meaning of § 10.1(c) and shall state:

(1) The address to which the attorney wants correspondence related to the investigation or disciplinary proceeding sent; and

(2) A telephone number where the attorney may be reached during normal business hours.

(b) The Commissioner shall designate at least two associate solicitors in the Office of the Solicitor to act as representatives for the Director in disciplinary proceedings. In prosecuting disciplinary proceedings, the designated associate solicitors shall not involve the Solicitor or the Deputy Solicitor. The Solicitor and the Deputy Solicitor shall remain insulated from the investigation and prosecution of all disciplinary proceedings in order that they shall be available as counsel to the Commissioner in deciding disciplinary proceedings.

[Added 50 FR 5183, Feb. 6, 1985, effective Mar. 8, 1985]

#### § 10.141 Filing of papers.

(a) The provisions of § 1.8 of this subchapter do not apply to disciplinary proceedings.

(b) All papers filed after the complain and prior to entry of an initial decision by the administrative law judge shall be filed with the administrative law judge at an address or place designated by the administrative law judge. All papers filed after entry of an initial decision by the administrative law judge shall be filed with the Director. The Director shall promptly forward to the Commissioner any paper which requires action under this part by the Commissioner.

(c) The administrative law judge or the Director may provide for filing papers and other matters by hand or "Express Mail."

[Added 50 FR 5184, Feb. 6, 1985, effective Mar. 8, 1985]

#### § 10.142 Service of papers.

(a) All papers other than a complaint shall be served on a respondent represented by an attorney by:

(1) Delivering a copy of the paper to the office of the attorney; or

(2) Mailing a copy of the paper by first-class mail or "Express Mail" to the attorney at the address provided by the attorney under § 10.140(a)(1); or

(3) Any other method mutually agreeable to the attorney and a representative for the Director.

(b) All papers other than a complaint shall be served on a respondent who is not represented by an attorney by:

(1) Delivering a copy of the paper to the respondent; or

(2) Mailing a copy of the paper by first-class mail or "Express Mail" to the respondent at the address to which a complaint may be served or such other address as may be designated in writing by the respondent; or

(3) Any other method mutually agreeable to the respondent and a representative of the Director.

(c) A respondent shall serve on the representative for the Director one copy of each paper filed with the administrative law judge or the Director. A paper may be served on the representative of the Director by:

(1) Delivering a copy of the paper to the representative; or

(2) Mailing a copy of the paper by first-class mail or "Express Mail" to an address designated in writing by the representative; or

(3) Any other method mutually agreeable to the respondent and the representative.

(d) Each paper filed in a disciplinary proceeding shall contain therein a certificate of service indicating:

(1) The date of which service was made; and

(2) The method by which service was made.

(e) The administrative law judge or the Commissioner may require that a paper be served by hand or by "Express Mail."

(f) Service by mail is completed when the paper mailed in the United States is placed into the custody of the U.S. Postal Service.

[Added 50 FR 5184, Feb. 6, 1985, effective Mar. 8, 1985]

#### § 10.143 Motions.

Motions may be filed with the administrative law judge. The administrative law judge will determine on a case-by-case basis the time period for response to a motion and whether replies to

responses will be authorized. No motion shall be filed with the administrative law judge unless such motion is supported by a written statement by the moving party that the moving party or attorney for the moving party has conferred with the opposing party or attorney for the opposing party in an effort in good faith to resolve by agreement the issues raised by the motion and has been unable to reach agreement. If issues raised by a motion are resolved by the parties prior to a decision on the motion by the administrative law judge, the parties shall promptly notify the administrative law judge.

[Added 50 FR 5184, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.144 Hearings.**

(a) The administrative law judge shall preside at hearings in disciplinary proceedings. Hearings will be stenographically recorded and transcribed and the testimony of witnesses will be received under oath or affirmation. The administrative law judge shall conduct hearings in accordance with 5 U.S.C. 556. A copy of the transcript of the hearing shall become part of the record. A copy of the transcript shall be provided to the Director and the respondent at the expense of the Office.

(b) If the respondent to a disciplinary proceeding fails to appear at the hearing after a notice of hearing has been given by the administrative law judge, the administrative law judge may deem the respondent to have waived the right to a hearing and may proceed with the hearing in the absence of the respondent.

(c) A hearing under this section will not be open to the public except that the Director may grant a request by a respondent to open his or her hearing to the public and make the record of the disciplinary proceeding available for public inspection, *provided*, Agreement is reached in advance to exclude from public disclosure information which is privileged or confidential under applicable laws or regulations. If a disciplinary proceeding results in disciplinary action against a practitioner, and subject to § 10.159(c), the record of the entire disciplinary proceeding, including any settlement agreement, will be available for public inspection.

[Added 50 FR 5184, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.145 Proof; variance; amendment of pleadings.**

In case of a variance between the evidence and the allegations in a complaint, answer, or reply, if any, the administrative law judge may order or authorize amendment of the complaint, answer, or reply to conform to the evidence. Any party who would otherwise be prejudiced by the amendment will be given reasonable opportunity to meet the allegations in the complaint, answer, or reply, as amended, and the administrative law judge shall make findings on any issue presented by the complaint, answer, or reply as amended.

[Added 50 FR 5184, Feb. 6, 1985, effective Mar. 8, 1985]

**§§ 10.146 - 10.148 [Reserved]**

**§ 10.149 Burden of proof.**

In a disciplinary proceeding, the Director shall have the burden of proving his or her case by clear and convincing evidence and a respondent shall have the burden of providing any affirmative defense by clear and convincing evidence.

[Added 50 FR 5184, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.150 Evidence.**

(a) *Rules of evidence.* The rules of evidence prevailing in courts of law and equity are not controlling in hearings in disciplinary proceedings. However, the administrative law judge shall exclude evidence which is irrelevant, immaterial, or unduly repetitious.

(b) *Depositions.* Depositions of witnesses taken pursuant to § 10.151 may be admitted as evidence.

(c) *Government documents.* Official documents, records, and papers of the Office are admissible without extrinsic evidence of authenticity. These documents, records and papers may be evidenced by a copy certified as correct by an employee of the Office.

(d) *Exhibits.* If any document, record, or other paper is introduced in evidence as an exhibit, the administrative law judge may authorize the withdrawal of the exhibit subject to any conditions the administrative law judge deems appropriate.

(e) *Objections.* Objections to evidence will be in short form, stating the grounds of objection. Objections and rulings on objections will be a part of the record. No exception to the ruling is necessary to preserve the rights of the parties.

[Added 50 FR 5184, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.151 Depositions.**

(a) Depositions for use at the hearing in lieu of personal appearance of a witness before the administrative law judge may be taken by respondent or the Director upon a showing of good cause and with the approval of, and under such conditions as may be deemed appropriate by, the administrative law judge. Depositions may be taken upon oral or written questions, upon not less than ten days written notice to the other party, before any officer authorized to administer an oath or affirmation in the place where the deposition is to be taken. The requirement of ten days notice may be waived by the parties and depositions may then be taken of a witness at a time and place mutually agreed to by the parties. When a deposition is taken upon written questions, copies of the written questions will be served upon the other party with the notice and copies of any written cross-questions will be served by hand or "Express Mail" not less than five days before the date of the taking of the deposition unless the parties mutually agree otherwise. A party on whose behalf a deposition is taken shall file a copy of a transcript of the deposition signed by a court reporter with the administrative law judge and shall serve one copy upon the opposing party. Expenses for a court reporter and preparing, serving, and filing depositions shall be borne by the party at whose instance the deposition is taken.

(b) When the Director and the respondent agree in writing, a deposition of any witness who will appear voluntarily may be taken under such terms and conditions as may be mutually agreeable to the Director and the respondent. The deposition shall not be filed with the administrative law judge and may not be admitted in evidence before the administrative law judge unless he or she orders the deposition admitted in evidence. The admissibility of the deposition shall lie within the discretion of the administrative law judge who may reject the deposition on

any reasonable basis including the fact that demeanor is involved and that the witness should have been called to appear personally before the administrative law judge.

[Added 50 FR 5185, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.152. Discovery.**

Discovery shall not be authorized except as follows:

(a) After an answer is filed under § 10.136 and when a party establishes in a clear and convincing manner that discovery is necessary and relevant, the administrative law judge, under such conditions as he or she deems appropriate, may order an opposing party to:

- (1) Answer a reasonable number of written requests for admission or interrogatories;
- (2) Produce for inspection and copying a reasonable number of documents; and
- (3) Produce for inspection a reasonable number of things other than documents.

(b) Discovery shall not be authorized under paragraph (a) of this section of any matter which:

- (1) Will be used by another party solely for impeachment or cross-examination;
- (2) Is not available to the party under 35 U.S.C. § 122;
- (3) Relates to any disciplinary proceeding commenced in the Patent and Trademark Office prior to March 8, 1985;
- (4) Relates to experts except as the administrative law judge may require under paragraph (e) of this section.
- (5) Is privileged; or
- (6) Relates to mental impressions, conclusions, opinions, or legal theories of any attorney or other representative of a party.

(c) The administrative law judge may deny discovery requested under paragraph (a) of this section if the discovery sought:

- (1) Will unduly delay the disciplinary proceeding;
- (2) Will place an undue burden on the party required to produce the discovery sought; or
- (3) Is available (i) generally to the public, (ii) equally to the parties; or (iii) to the party seeking the discovery through another source.

(d) Prior to authorizing discovery under paragraph (a) of this section, the administrative law judge shall require the party seeking discovery to file a motion (a) 10.143) and explain in detail for each request made how the discovery sought is necessary and relevant to an issue actually raised in the complaint or the answer.

(e) The administrative law judge may require parties to file and serve, prior to any hearing, a pre-hearing statement which contains:

- (1) A list (together with a copy) of all proposed exhibits to be used in connection with a party's case-in-chief,
- (2) A list of proposed expert witness,
- (3) As to each proposed expert witness:
  - (i) An identification of the filed in which the individual will be qualified as an expert;
  - (ii) A statement as to the subject matter on which the expert is expected to testify; and

(iii) A statement of the substance of the facts and opinions to which the expert is expected to testify,

(4) The identity of government employees who have investigated the case, and

(5) Copies of memoranda reflecting respondent's own statements to administrative representatives.

(f) After a witness testifies for a party, if the opposing party requests, the party may be required to produce, prior to cross-examination, any written statement made by the witness.

[Added 50 FR 5185, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.153 Proposed findings and conclusions; post-hearing memorandum.**

Except in cases when the respondent has failed to answer the complaint, the administrative law judge, prior to making an initial decision, shall afford the parties a reasonable opportunity to submit proposed findings and conclusions and a post-hearing memorandum in support of the proposed findings and conclusions.

[Added 50 FR 5185, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.154 Initial decision of administrative law judge.**

(a) The administrative law judge shall make an initial decision in the case. The decision will include (1) a statement of findings and conclusions, as well as the reasons or basis therefore with appropriate references to the record, upon all the material issues of fact, law, or discretion presented on the record, and (2) an order of suspension or exclusion from practice, an order of reprimand, or an order dismissing the complaint. The administrative law judge shall file the decision with the Director and shall transmit a copy to the representative of the Director and to the respondent. In the absence of an appeal to the Commissioner, the decision of the administrative law judge will, without further proceedings, become the decision of the Commissioner of Patents and Trademarks thirty (30) day s from the date of the decision of the administrative law judge.

(b) The initial decision of the administrative law judge shall explain the reason for any penalty or reprimand, suspension or exclusion. In determining any penalty, the following should normally be considered:

- (1) The public interest;
- (2) The seriousness of the violation of the Disciplinary Rule;
- (3) The deterrent effects deemed necessary;
- (4) The integrity of the legal profession; and
- (5) Any extenuating circumstances.

[Added 50 FR 5185, Feb. 6, 1985, effective Mar. 8, 1985; amended 50 FR 25073, June 17, 1985.]

**§ 10.155 Appeal to the Commissioner.**

(a) Within thirty (30) days from the date of the initial decision of the administrative law judge under § 10.154, either party may appeal to the Commissioner. An appeal by the respondent will be filed with the Director in duplicate and will include exceptions to the decisions of the administrative law judge and supporting reasons for those exceptions. If the Director files the appeal, the Director shall serve a copy of the appeal.

Within thirty (30) days after receipt of an appeal or copy thereof, the other party may file a reply brief, in duplicate with the Director. If the Director files the reply brief, the Director shall serve a copy of the reply brief. Upon the filing of an appeal and a reply brief, if any, the Director shall transmit the entire record to the Commissioner.

(b) The appeal will be decided by the Commissioner on the record made before the administrative law judge.

(c) The Commissioner may order reopening of a disciplinary proceeding in accordance with the principles which govern the granting of new trials. Any request to reopen a disciplinary proceeding on the basis of newly discovered evidence must demonstrate that the newly discovered evidence could not have been discovered by due diligence.

[Added 50 FR 5185, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.156 Decision of the Commissioner .**

(a) An appeal from an initial decision of the administrative law judge shall be decided by the Commissioner. The Commissioner may affirm, reverse, or modify the initial decision or remand the matter to the administrative law judge for such further proceedings as the Commissioner may deem appropriate. Entry of a decision by the Commissioner is a final agency action in a disciplinary proceeding. In making a final decision, the Commissioner shall review the record or these portions of the record as may be cited by the parties in order to limit the issues. The Commissioner shall transmit a copy of the final decision to the Director and to the respondent.

(b) A final decision of the Commissioner may dismiss a disciplinary proceeding, reprimand a practitioner, or may suspend or exclude the practitioner from practice before the Office.

[Added 50 FR 5186, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.157 Review of Commissioner's final decision.**

(a) Review of the Commissioner's final decision in a disciplinary case may be had by a petition filed in the United States District Court for the District of Columbia. See 35 U.S.C. 32 and Local Rule 1-26 of the United States District Court for the District of Columbia.

(b) The Commissioner may stay a final decision pending review of the Commissioner's final decision.

[Added 50 FR 5186, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.158 Suspended or excluded practitioner.**

(a) A practitioner who is suspended or excluded from practice before the Office under a)10.156(b) shall not engage in unauthorized practice of patent, trademark and other non-patent law before the Office.

(b) Unless otherwise ordered by the Commissioner, any practitioner who is suspended or excluded from practice before the Office under § 10.156(b) shall:

(1) Within 30 days of entry of the order of suspension or exclusion, notify all bars of which he or she is a member and all clients of the practitioner for whom he or she is handling matter before the Office in separate written communications of the suspension or exclusion and shall file a copy of each written communication with the Director.

(2) Within 30 days of entry of the order of suspension or

exclusion, surrender a client's active Office case files to (i) the client or (ii) another practitioner designated by the client.

(3) Not hold himself or herself out as authorized to practice law before the Office.

(4) Promptly take any necessary and appropriate steps to remove from any telephone, legal, or other directory any advertisement, statement, or representation which would reasonably suggest that the practitioner is authorized to practice patent, trademark or other non)patent law before the Office, and within 30 days of taking those steps, file with the Director an affidavit describing the precise nature of the steps taken.

(5) Not advertise the practitioner's availability or ability to perform or render legal services for any person having immediate, prospective, or pending business before the Office.

(6) Not render legal advice or services to any person having immediate, prospective, or pending business before the Office as to that business.

(7) Promptly take steps to change any sign identifying a practitioner's or the practitioner's firm's office and practitioner's or the practitioner's firm's stationery to delete therefrom any advertisement, statement, or representation which would reasonably suggest that the practitioner is authorized to practice law before the Office.

(8) Within 30 days, return to any client any unearned funds, including any unearned retainer fee, and any securities and property of the client.

(c) A practitioner who is suspended or excluded from practice before the Office and who aids another practitioner in any way in the other practitioner's practice of law before the Office, may, under the direct supervision of the other practitioner, act as a para-legal for the other practitioner or perform other services for the other practitioner which are normally performed by lay-persons, provided:

(1) The practitioner who is suspended or excluded is:

(i) A salaried employee of:

(A) The other practitioner;

(B) The other practitioner's law firm; or

(C) A client)employer who employs the other practitioner as a salaried employee;

(2) The other practitioner assumes full professional responsibility to any client and the Office for any work performed by the suspended or excluded practitioner for the other practitioner;

(3) The suspended or excluded practitioner, in connection with any immediate, prospective, or pending business before the Office, does not:

(i) Communicate directly in writing, orally, or otherwise with a client of the other practitioner;

(ii) Render any legal advice or any legal services to a client of the other practitioner; or

(iii) Meet in person or in the presence of the other practitioner with:

(A) Any Office official in connection with the prosecution of any patent, trademark, or other case;

(B) Any client of the other practitioner, the other practitioner's law firm, or the client)employer of the other practitioner;

(C) Any witness or potential witness which the other practitioner, the other practitioner's law firm, or the other practitioner's client-employer may or intends to call as a witness in any proceeding before the Office. The term "witness" includes individuals who will testify orally in a proceeding before, or sign an affidavit or any other document to be filed in, the Office.

(d) When a suspended or excluded practitioner acts as a para-legal or performs services under paragraph (c) of this section, the suspended or excluded practitioner shall not thereafter be reinstated to practice before the Office unless:

(1) The suspended or excluded practitioner shall have filed with the Director an affidavit which (i) explains in detail the precise nature of all para)legal or other services performed by the suspended or excluded practitioner and (ii) shows by clear and convincing evidence that the suspended or excluded practitioner has complied with the provisions of this section and all Disciplinary Rules, and

(2) The other practitioner shall have filed with the Director a written statement which (i) shows that the other practitioner has read the affidavit required by subparagraph (d)(1) of this section and that the other practitioner believes every statement in the affidavit to be true and (ii) states why the other practitioner believes that the suspended or excluded practitioner has complied with paragraph (c) of this section.

[Added 50 FR 5186, Feb. 6, 1985, effective Mar. 8, 1985]

#### § 10.159 Notice of suspension or exclusion.

(a) Upon issuance of a final decision reprimanding a practitioner or suspending or excluding a practitioner from practice before the Office, the Director shall give notice of the final decision to appropriate employees of the Office and to interested departments, agencies, and courts of the United States. The Director shall also give notice to appropriate authorities of any State in which a practitioner is known to be a member of the bar and any appropriate bar association.

(b) The Director shall cause to be published in the Official Gazette the name of any practitioner suspended or excluded from practice. Unless otherwise ordered by the Commissioner, the Director shall publish in the Official Gazette the name of any practitioner reprimanded by the Commissioner.

(c) The Director shall maintain records, which shall be available for public inspection, of every disciplinary proceeding where practitioner is reprimanded, suspended, or excluded unless the Commissioner orders that the proceeding be kept confidential.

[Added 50 FR 5186, Feb. 6, 1985, effective Mar. 8, 1985]

#### § 10.160 Petitioner for reinstatement.

(a) A petition for reinstatement of a practitioner suspended for a period of less than five years will not be considered until the period of suspension has been passed.

(b) A petition for reinstatement of a practitioner excluded from practice will not be considered until five years after the effective date of the exclusion.

(c) An individual who has resigned under § 10.133 or who has been suspended or excluded may file a petition for reinstatement. The Director may grant a petition for reinstatement when the individual makes a clear and convincing showing that the individual will conduct himself or herself in accordance with the regulations of this part and that granting a petition for reinstatement is not contrary to the public interest. As a condition to reinstatement, the Director may require the individual to:

(1) Meet the requirements of § 10.7, including taking and passing an examination under § 10.7(b) and

(2) Pay all or a portion of the costs and expenses, not to exceed \$1,500, of the disciplinary proceeding which led to suspension or exclusion.

(d) Any suspended or excluded practitioner who has violated the provisions of § 10.158 during his or her period of suspension or exclusion shall not be entitled to reinstatement until such time as the Director is satisfied that a period of suspension equal in time to that ordered by the Commissioner or exclusion for five years has passed during which the suspended or excluded practitioner has complied with the provisions of § 10.158.

(e) Proceedings on any petition for reinstatement shall be open to the public. Before reinstating any suspended or excluded practitioner, the Director shall publish in the Official Gazette a notice of the suspended or excluded practitioner's petition for reinstatement and shall permit the public a reasonable opportunity to comment or submit evidence with respect to the petition for reinstatement.

[Added 50 FR 5186, Feb. 6, 1985, effective Mar. 8, 1985]

#### § 10.161 Savings clause.

(a) A disciplinary proceeding based on conduct engaged in prior to the effective date of these regulations may be instituted subsequent to such effective date, if such conduct would continue to justify suspension or exclusion under the provisions of this part.

(b) No practitioner shall be subject to a disciplinary proceeding under this part based on conduct engaged in before the effective date hereof if such conduct would not have been subject to disciplinary action before such effective date.

[Added 50 FR 5186, Feb. 6, 1985, effective Mar. 8, 1985]

#### §§ 10.162 - 10.169 [Reserved]

#### § 10.170 Suspension of rules.

(a) In an extraordinary situation, when justice requires, any requirement of the regulations of this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, sua sponte, or on petition of any party, including the Director or the Director's representative, subject to such other requirements as may be imposed.

(b) Any petition under this section will not stay a disciplinary proceeding unless ordered by the Commissioner or an administrative law judge.

[Added 50 FR 5186, Feb. 6, 1985, effective Mar. 8, 1985]

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