

Chapter 1000. Matters Decided by Various Patent and Trademark Office Officials

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1001 Statutory Authority of Commissioner [R-13]

35 U.S.C. 3 Officers and employees.

(a) There shall be in the Patent and Trademark Office a Commissioner of Patents and Trademarks, a Deputy Commissioner, two Assistant Commissioners and examiners-in-chief appointed under section 7 of this title. The Deputy Commissioner, or, in the event of a vacancy in that office, the Assistant Commissioner senior in date of appointment, shall fill the office of Commissioner during a vacancy in that office until the Commissioner is appointed and takes office. The Commissioner of Patents and Trademarks, the Deputy Commissioner, and the Assistant Commissioners shall be appointed by the President, by and with the advice and consent of the Senate. The Secretary of Commerce, upon the nomination of the Commissioner, in accordance with law, shall appoint all other officers and employees.

(b) The Secretary of Commerce may vest in himself the functions of the Patent and Trademark Office and its officers and employees specified in this title and may from time to time authorize their

performance by any other officer or employee.

(c) The Secretary of Commerce is authorized to fix the per annum rate of basic compensation of each examiner-in-chief in the Patent and Trademark Office at not in excess of the maximum scheduled rate provided for positions in grade 17 of the General Schedule of the Classification Act of 1949, as amended.

(d) The Commissioner of Patents and Trademarks shall be an Assistant Secretary of Commerce and shall receive compensation at the rate prescribed by law for Assistant Secretaries of Commerce.

(e) The members of the Trademark Trial and Appeal Board of the Patent and Trademark Office shall each be paid at a rate not to exceed the maximum rate of basic pay payable for GS-16 of the General Schedule under section 5322 of title 5.

35 U.S.C. 6 Duties of Commissioner.

(a) The Commissioner, under the direction of the Secretary of Commerce, shall superintend or perform all duties required by law respecting the granting and issuing of patents and the registration of trademarks; shall have the authority to carry on studies, programs or exchanges of items or services regarding domestic and international patent and trademark law or the administration of the Patent and Trademark Office; and shall have charge of property belonging to the Patent and Trademark Office. He may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office.

(b) The Commissioner, under the direction of the Secretary of Commerce, may, in coordination with the Department of State, carry on programs and studies cooperatively with foreign patent offices and international intergovernmental organizations, or may authorize such programs and studies to be carried on, in connection with the performance of duties stated in subsection (a) of this section.

(c) The Commissioner, under the direction of the Secretary of Commerce, may, with the concurrence of the Secretary of State, transfer funds appropriated to the Patent and Trademark Office, not to exceed \$100,000 in any year, to the Department of State for the purpose of making special payments to international intergovernmental organizations for studies and programs for advancing international cooperation concerning patents, trademarks, and related matters. These special payments may be in addition to any other payments or contributions to the international organization and shall not be subject to any limitations imposed by law on the amounts of such other payments or contributions by the Government of the United States.

37 CFR 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*.

37 CFR 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.

1001.01 Modes of Exercising Authority [R-13]

The Commissioner's authority to review and supervise the work of the Office is exercised by the promulgation of the Rules of Practice; issuance of orders, notices and memoranda stating Office policies and modes for effectuating these policies; decisions on petitions by applicants, and by the designation of particular cases which must be submitted to the Commissioner or other officials authorized by the Commissioner. The present chapter deals with the latter two items.

>37 CFR<* 1.181(g), states "The Commissioner may delegate to appropriate Patent and Trademark Office officials the determination of petitions."

>The various delegations to various Office officials are set forth in this Chapter.<

1002 Petitions to the Commissioner [R-13]**37 CFR 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 specified 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 hearings 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.

37 CFR 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).

37 CFR 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, *rua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h).

37 CFR 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.

Petitions on appealable matters ordinarily are not entertained. See >MPEP< § 1201.

The mere filing of a petition will not stay the period for replying to an examiner's action which may be running against an application, nor act as a stay of other proceedings (>37 CFR< 1.181(f)). For example, if a petition to vacate a final rejection as premature is filed within two months from the date of the final rejection, the period for response to the final rejection is not extended even if the petition is not reached for decision within that period. However, if the petition is granted and the applicant has filed an otherwise full response to the rejection *within the period for response*, the case is not abandoned.

>37 CFR<* 1.181(f) * provides that any petition under that rule which is not filed "within 2 months from the action complained of may be dismissed as untimely." Often, the "action complained of", for example, a requirement for a new drawing, is included in the same letter as an action on the merits of the claims, the latter having a three month period for response. Under such circumstances, if applicant requests reconsideration, under >37 CFR< 1.111(b), of the requirement for a new drawing, the examiner's action on this request, if adverse, establishes the beginning of the two month period for filing the petition. The petition must be filed within this period even though the period for response to the rejection of the claims may extend beyond the two month period. The two month period is not extendible under 37 CFR 1.136(a) since the time is within the discretion of the Commissioner.

Form Paragraph 7.99 may be used where an insufficient fee was filed with a petition.

§ 7.99 Petition Dismissed, Proper Fee Not Submitted

Applicant's petition under 37 CFR [1] filed [2] is DISMISSED because the proper petition fee of [3] required under 37 CFR 1.17 has not been submitted.

Examiner Note:

(1) Petitions under 37 CFR 1.48 for correcting inventorship require a fee as set forth in 37 CFR 1.17(h).

(2) Petitions to suspend action under 37 CFR 1.103, to withdraw an application from issue under 37 CFR 1.313, and for consideration of an amendment under 37 CFR 1.312 after payment of the issue fee, require a fee as set forth in 37 CFR 1.17(i)(1).

(3) Petitions for an extension of time under 37 CFR 1.136(a) require varying fees. See 37 CFR 1.17(a) - (d).

1002.01 Procedure [R-13]

Petitions, together with the respective application files, are sent to the official having the delegated authority to decide the petition. The petition may be referred to the examiner for a formal statement under >37 CFR< 1.181(c) or for an informal memorandum. >MPEP § 711.03(d)<.

Where a formal statement under >37 CFR< 1.181(c) is made, a copy thereof is mailed to the petitioner by the examiner unless the latter is otherwise directed, and the file and petition, accompanied by the original copy of his statement, are returned to the official handling the petition. If an informal memorandum is requested, no copy thereof is mailed to the petitioner by the examiner.

After the decision has been rendered, the decision is entered on the "Contents" of the file wrapper which is then returned to the primary examiner, who will act in accordance with the decision.

1002.02 Delegation of Authority To Decide Petitions [R-13]

Petitions to the Commissioner are decided in accordance with the following delegation of authority.

In any case in which the authority to decide the petition has been delegated as indicated in >MPEP< §§ 1002.02(a)-(o), the decision may be viewed as a final agency decision for the purposes of court review where such review is proper.

The authority to decide certain types of petitions for suspension of rules of practice under 37 CFR 1.183 of the Rules of Practice in Patent Cases and >37 CFR< 2.148 of the Trademark Rules of Practice has been delegated to the Assistant Commissioner for Patents,* the Assistant Commissioner for Trademarks >, and the Deputy Commissioner of Patents and Trademarks<. The petitions falling within each of these delegations are set forth in the listings in >MPEP< §§ 1002.02 (a), (i) and (o). Certain types of such petitions have been assigned to the Deputy Assistant Commissioner for Patents and this assignment is reflected in the listings in >MPEP< § 1002.02(b).

In accordance with 37 CFR 1.181(g) the authority to decide petitions to the Commissioner, not otherwise delegated, has been delegated to various Office officials. Generally, these officials will decide petitions as specified in the following sections for the effective operation of the Office. Also listed are certain petitions which are not, strictly speaking, to the Commissioner but have been committed by statute or rule to the designated officials.

Authority not herein delegated has been reserved to the Commissioner and may be delegated to appropriate officials on an ad hoc basis.

1002.02(a) Petitions Decided by the Assistant Commissioner for Patents [R-13]

1. Petitions relating to public use proceedings, 37 CFR 1.292.

2. Petitions to make a patent application special >under 37 CFR 1.102< on the ground of:

- (a) prospective manufacture >MPEP § 708.02, item I<;
- (b) infringement >MPEP § 708.02, item II<**.

3. Petitions under 37 CFR 1.183 for >waiver or< suspension of rules >under 37 CFR 1.181< relating to patent examining not otherwise covered.

4. Petitions to expunge papers from patent application files or patent files >, 37 CFR 1.182<.

5. ** > Petitions for access to patent applications under 37 CFR 1.14 with the exception of applications involved in or related to a proceeding before the Board of Patent Appeals and Interferences. MPEP §§ 103 and 104 and MPEP § 1901.05.

6. Petitions to decide questions not specifically provided for in matters concerning the Office of the Assistant Commissioner for Patents under 37 CFR 1.182.

7. Petitions relating to reexamination proceedings, 37 CFR 1.137, 1.181, 1.182, 1.183 and 1.510 - 1.570.

8. Petitions relating to international applications filed under the Patent Cooperation Treaty.

9. Petitions under 37 CFR 1.183 to waive requirements of 37 CFR 1.48 in situations decided by the Special Program Examiners.

10. Petitions to revive an international application because of unavoidable delay, 37 CFR 1.137(a).

11. Petitions to revive an international application because of unintentional delay, 37 CFR 1.137(b).<

1002.02(b) Petitions >and Requests< Decided *>in the Office of<the Deputy Assistant Commissioner for Patents [R-13]

>All petitions decided by the Office of the Deputy Assistant Commissioner for Patents, and inquiries relating thereto, should be directed to "Petitions Information, Crystal Park Two, Suite 913."<

1. Petitions to revive an abandoned >national< patent application. 37 CFR 1.137 >(both unavoidable delay and unintentional abandonment), MPEP< § 711.03(c).

2. Petitions under 37 CFR 1.183 for >waiver or< suspension of rules relating to the >examination<* of patent applications.

3. Petitions to invoke the supervisory authority of the Commissioner >under 37 CFR 1.181< in matters within the responsibility of the Patent Examining Operation.

4. Petitions to withdraw patent applications from issue >after payment of the issue fee<. 37 CFR 1.313, >MPEP< § 1308. **

5. Petitions for acceptance of late priority papers in patent applications. 37 CFR 1.55, >MPEP< §§ 201.14 (a) and (c).

6. Petitions for deferment of issuance of patents >, 37 CFR 1.314, MPEP § 1306.01<.

7. Petitions for express abandonment of patent applications after >payment of the issue fee, MPEP § 711.01<.

8. Petitions to accept late payment of issue fees. 37 CFR >1.155 and< 1.316, >MPEP< § 712.

9. Petitions to accept late payment of >balance of<* issue fee >due<, 37 CFR 1.317, >MPEP< § 712.

10. Petitions relating to disclaimers in patents and patent applications under 37 CFR 1.321.

11. Petitions relating to assignments and issuance of patents. >MPEP< § 1308.

12. Petitions to invoke the supervisory authority of the Commissioner >under 37 CFR 1.181< in matters concerning the Office of Administration.

13. Petitions under 37 CFR 1.183 for >waiver or< suspension of rules in patent matters administered by the Office of Administration.

14. **> Petitions for the withdrawal of attorney under 37 CFR 1.36 in patent applications involved in proceedings before the Office of the Deputy Assistant Commissioner for Patents.

15. Petitions under 37 CFR 1.182 in matters not specifically provided for concerning the Office of the Deputy Assistant Commissioner for Patents.

16. Petitions to invoke the supervisory authority of the Commissioner under 37 CFR 1.181 in matters concerning the Office of Finance.

17. Requests by the examiner to the Board of Patent Appeals and Interferences for reconsideration of a decision, MPEP § 1214.04.

18. Petitions to review refusal to accept and record maintenance fee payment filed prior to the expiration of a patent, 37 CFR 1.377.

19. Petitions to accept delayed payment of maintenance fee in an expired patent to reinstate patent based on application filed on or after December 12, 1980, 37 CFR 1.378.

20. Petitions under 37 CFR 1.84(p) to accept color drawings in utility patent applications.

21. Petitions to issue patent in name of the assignee recorded after payment of the issue fee, 37 CFR 1.334(c).

22. Petitions to review decision of group director, 37 CFR 1.181.

23. Petitions to withdraw a holding of abandonment not otherwise delegated, 37 CFR 1.181.

24. Requests to order a Commissioner initiated reexamination proceeding, 37 CFR 1.520.<

1002.02(c) Petitions and Requests Decided by the Group Directors [R-13]

1. Petitions to make patent applications special >under 37 CFR 1.102, MPEP< § 708.02:

(a) on the ground of applicant's age or state of health, >MPEP § 708.02 items III & IV<;

(b) a division, continuation or continuation-in-part of an earlier application;

(c) under the Environmental Quality Program >MPEP § 708.02 V<;

(d) under the Special Examining Procedure for certain new applications — accelerated examination.

(e) under the Energy Program, >MPEP< § 708.02, item VI.

(f) because the application involves safety of research in the field of Recombinant DNA, >MPEP< § 708.02, item VII.

>(g) superconductivity, MPEP § 708.02

(h) for reasons not otherwise provided for.<

2. Petitions or requests to reopen prosecution of patent applications after decision by the Board of >Patent< Appeals >and Interferences under 37 CFR 1.198<, where no court action has been filed. >MPEP< §§ 1214.04, third paragraph and 1214.07.

3. Petitions from a final decision of examiner requiring restriction in patent applications. 37 CFR 1.144, >MPEP< § 818.03(c).

4. Petitions invoking the supervisory authority of the Commissioner >under 37 CFR 1.181< involving any ex parte action or requirement in a patent application by the examiner which is not subject to appeal >(37 CFR 1.181) and not otherwise provided for<, as for example:

(a) prematureness of final rejection, >MPEP< § 706.07(c);

(b) refusal to enter an amendment, 37 CFR 1.127, >MPEP< § 714.19;

(c) holding of abandonment, >MPEP< § 711.03 (c)*;

(d) requirement to cancel "new matter" from specification, >MPEP< § 608.04(c);

(e) petitions relative to formal sufficiency and propriety of affidavits under 37 CFR 1.131 >(MPEP § 715.08)< 1.132 >(MPEP § 716) and 1.608, MPEP §§ 2308-2308.03<.*;

(f) >requests<* to institute an interference under 37 CFR >1.601(i), MPEP § 2306<.*;

(g) petitions relating to refusal to enter an amendment >or citations of prior art< under 37 CFR 1.312, >MPEP § 714.16(d)<.

5. **> Petitions under 37 CFR 1.113 relating to objections or requirements made by the examiners.<

6. Petitions for return of original oaths of patent applications. >MPEP< § 604.04(a).

7. Requests for ** extensions of a set shortened statutory period under 37 CFR 1.136(b). >MPEP< § 710.02(e).

8. Requests for interviews with the examiner after a patent application has been sent to issue >(Notice of Allowability mailed), MPEP< § 713.10.

9. **> Petitions under 37 CFR 1.193(a) relating to the form of the appeal.<

10. Petitions concerning appealed patent applications before transfer of jurisdiction to the Board of >Patent< Appeals >and Interferences< (e.g., ** extension of time under 37 CFR 1.136(b) for filing an appeal brief). >MPEP< § 1206.

11. A second or subsequent suspension of action in patent applications under 37 CFR 1.103. >MPEP< § 709.

12. **> Petitions from refusal to issue a Certificate of Correction for a patent not involved in an interference (37 CFR 1.181, MPEP § 1480-1485)<.

13. Petitions to reinstate appeals dismissed by the group appeals clerk.

14. Petitions from the denial of a request for reexamination >, 37 CFR 1.515, MPEP § 2248<.

15. Petitions to enter amendment or prior art citation under 37 CFR 1.312 filed after payment of issue fee, >MPEP< § 714.16.

>16. Requests by the examiner to the Board for reconsideration of a decision before forwarding to Deputy Assistant Commissioner for Patents, MPEP § 1214.04.

17. Petitions for withdrawal of attorney from application pending in examining groups, 37 CFR 1.36.

18. Requests for extension of time in reexamination proceedings, 37 CFR 1.550(c)

19. Petition to merge multiple reexamination proceedings, 37 CFR 1.565(c), MPEP § 2283.

20. Petitions to issue corrected patent, 37 CFR 1.322(b).

21. Petitions to withdraw patent applications from issue before payment of the issue fee, 37 CFR 1.313.

The examining groups should use Form Paragraph 10.02 when preparing a paper to request withdrawal of an application from issue after payment of the issue fee.

§ 10.02 Withdrawal From Issue, Fee Has Been Paid

Date: [1]

From: Director, Group [2]

To: Office of the Deputy Assistant Commissioner for Patents

Subject: Withdrawal from Issue

Applicant: [3]

Issue Fee Paid Date: [4]

Serial No.: [5]

Filed: [6]

Date Sent to Issue: [7]

Title: [8]

It is requested that the above-identified application be withdrawn from issue under 37 CFR 1.313 for the following purpose: [9]

Upon withdrawal from issue, the application should be returned to the jurisdiction of examining Group [10]

The Examiner is authorized and directed to take prompt appropriate action on this case including notifying applicant of the new status of this application. Return this application promptly to the Office of the Director of Group [11].

Director, Group _____.

The following procedure must be followed when the group director decides to withdraw an application from issue before payment of the issue fee:

i. The CRT Screen on PALM is used to determine if the issue fee has been paid.

ii. If the issue fee has been paid, a memo to the Office of the Deputy Assistant Commissioner for Patents is required. (See form paragraph 10.02, MPEP § 1002.02(b).)

iii. If the issue fee has not been paid, and the deadline for payment has not expired, the group director must mail a "Withdrawal from Issue" letter to the applicant to effectuate the withdrawal from issue. A copy of the "Withdrawal from Issue" letter should be sent to the Publishing Division. After a "Withdrawal from Issue" letter is mailed by the examining group, the examining group must:

a. Cross out the batch number on the face of the file;

b. Cross out the date mailed for the "Notice of Allowance" on the face of the file wrapper and write or stamp "WITHDRAWN";

c. Change the status of the application to status code 066 (Previous Action Withdrawn - Awaiting Further Action); and

d. Forward the file to the examiner for prompt action.

The processing will be done in the Examining Group without the need to send the application to the Office of Publications.<

>1002.02(c)(1) Petitions and Requests Decided by the Group Director of Group 220 [R-13]

In addition to the items delegated to all Group Directors under MPEP § 1002.02(c), authority to decide the following additional items is delegated to the Group Director of Group 220.

1. All petitions filed under 35 U.S.C. 267, to extend the time for taking action in United States-owned applications wherein the invention is important to the armament or defense of the United States.

2. All petitions under 37 CFR 1.103(c), to suspend action in United States-owned applications wherein the publication of the invention might be detrimental to the public safety or defense.

Any petitions filed under 35 U.S.C. 267 and/or 37 CFR 1.103(c) in any area of the Office must be forwarded to the Director of Group 220 for decision thereon.

3. Petitions under 37 CFR 5.12(a) for foreign license to file patent applications in foreign countries, MPEP § 140.

4. Petitions for rescission of secrecy order, 37 CFR 5.4, MPEP § 120.

5. Petition to permit or modify disclosure requirements, 37 CFR 5.5(b), MPEP § 120.

6. Petition for modification of secrecy order, 37 CFR 5.5(c), MPEP § 120.

7. Petition for retroactive license, 37 CFR 5.25, MPEP § 140.

8. Petitions relating to refusal of request for publication of a Statutory Invention Registration, 37 CFR 1.295.

9. Petitions relating to request for withdrawal of request for publication of a Statutory Invention Registration, 37 CFR 1.296.

10. Petitions under 42 U.S.C. 2182.

11. Petitions under 42 U.S.C. 2457.

12. Petitions under 35 U.S.C. 184..

13. Petitions under 35 U.S.C. 267

14. Petitions under 37 CFR 1.103(c).

15. Petitions concerning review of security or government interest matters not otherwise provided for.<

1002.02(d) Matters Decided by the Supervisory Primary Examiners [R-13]

1. ** >Decisions regarding the changes requested in a Certificate of Correction.<

2. Entry of amendments under 37 CFR 1.312, >MPEP< §§ 714.16, 714.16(d).

3. Approval of any new ground of rejection made after the filing of an appeal brief. This requirement extends to new

1002.02(f)**MANUAL OF PATENT EXAMINING PROCEDURE**

grounds of rejection made either in an examiner's answer or in an Office action reopening prosecution. Evidence of the approval should appear on applicant's copy of the Office action or answer as well as the record copy, >MPEP § 1208.01.

4. Requests for a Certificate of Correction submitted under 37 CFR 1.323 unless the error is clearly minor, clerical or typographical, in which case it is handled by the Certificate of Correction Branch.

5. Requests for a Certificate of Correction to correct a claim even if the request is submitted under 37 CFR 1.322.

6. Petitions under 37 CFR 1.324 to correct errors in joining inventors in a patent that is not involved in an interference. MPEP § 1481.<

1002.02(f) Petitions >and Matters< Decided by the Chairman of the Board of Patent >Appeals and< Interferences [R-13]

>The Chairman is authorized to redelegate authority to decide any of these petitions to the Vice Chairman of the Board of Patent Appeals and Interferences.<

1. Petitions >under former 37 CFR 1.244 to exercise supervisory authority< in "old rule" patent interferences from an action by a primary examiner or from an interlocutory action by **>an examiner-in-chief<.

2. Petitions to accept >belatedly filed<* settlement papers in patent interferences under 35 U.S.C. 135(c)>, 37 CFR 1.666(c)<.

3. Petitions for acceptance of priority papers in patent applications involved in an interference.

>4. Petitions under 37 CFR 1.324 to correct errors in joining inventors in a patent that is involved in an interference proceeding conducted under 37 CFR 1.201—1.288.

5. Petitions for access to copies of interference settlement agreements filed under 35 U.S.C. 135(c), 37 CFR 1.666(b), MPEP § 2366.

6: Petitions for access to patent applications involved in proceedings before the Board of Patent Appeals and Interferences, 37 CFR 1.612, MPEP § 103.

7. Petitions from a refusal to issue a Certificate of Correction for a patent that is involved in an interference proceeding conducted under former 37 CFR 1.201 - 1.288.

8. Petitions for extension of time to file a response to a rejection under 37 CFR 1.196(b), 37 CFR 1.136. A petition for extension of time to file an amendment or showing of facts in response to a rejection under 37 CFR 1.196(b) is decided by the group director.

9. The Chairman of the Board decides which particular members of the Board are to be assigned to a hearing, and whether a hearing shall be held before an augmented panel. 35 U.S.C. 7.

10. The Chairman of the Board decides whether to reinstate an appeal.

See MPEP § 1002.02(n) for petitions decided by the clerk of Board.<

1002.02(g) Petitions Decided by the ** > Examiners-in-Chief< [R-13]

>1.< Petitions for access to unopened preliminary statements under 37 CFR >1.631<.*

>2. Petitions under 37 CFR 1.615 for concurrent ex parte and inter parties prosecution of patent applications. MPEP § 2315.

3. Petitions for the withdrawal of attorney under 37 CFR 1.36 in patent applications involved in interference proceedings under 37 CFR 1.601 - 688 before the Board of Patent Appeals and Interferences, 37 CFR 1.613(d).

4. A request for a Certificate of Correction for a patent that is involved in an interference conducted under 37 CFR 1.601—1.688 is presented via a motion under 37 CFR 1.635.

5. Motions to correct errors in joining inventors in proceedings under 37 CFR 1.601 - 1.688, 37 CFR 1.634.

See also MPEP § 1002.02(j).<

1002.02(h) Petitions Decided by the Special Assistant to the Assistant Commissioner for Patents [R-13]

1. Petitions ** >relating to the filing of patent applications. MPEP < § 506.

2. Petitions relating to filing * >and/or< issuance of divisional reissue applications. 37 CFR 1.177. >MPEP § 1451<.*

>3. Petitions relating to filing of an international application without the participation of one or more applicants, 37 CFR 1.425.

4. Petitions on holding of application for patent term extension to be informal, 37 CFR 1.740(c).<

1002.02(i) Petitions Decided by the Assistant Commissioner for Trademarks

Petitions relating to Trademarks are covered in Chapter 1700 of the Trademark Manual of Examining Procedure.

1002.02(j) Petitions Decided by the Board of >Patent< Appeals >and Interferences< [R-13]

** Requests under 37 CFR 1.197(b) for a ** reconsideration or modification of a decision of the Board of >Patent< Appeals >and Interferences<. >MPEP < § 1214.03. **

1002.02(k) Petitions Decided by the Solicitor [R-13]

** >1<. Petitions for extension of time in court matters. 35 U.S.C. 142, 145, 146.**

>2<. Petitions relating to ex parte questions in cases before the Court of Appeals for the Federal Circuit.

>3. Requests filed under the Freedom of Information Act. The Office of the Solicitor is available to render legal advice to any deciding official in connection with any petition.<

1002.02(i) Requests Decided by >Supervisor of the<* Certificates of Correction >Branch<* [R-13]

Requests for Certificates of Correction under 37 CFR 1.322 or 1.323 except for denials on grounds requiring consideration by the * >Chairman of the Board of Patent Appeals and Interferences or the supervisory primary examiners otherwise provided for, MPEP< §§ 1480-1485.

1002.02(m) Petitions Decided by the >Director of< Enrollment >and Discipline< [R-13]

1. Petitions relating to registration **.
2. >Requests for limited< recognition under 37 CFR >10.9<.
3. Petitions for exceptions to undertakings under 37 CFR >10.10(b)(2). MPEP< § 1702.
4. Petitions for >regrading of registration examinations under 37 CFR 10.7(c)<**.
- >5. Petitions for reinstatement under 37 CFR 10.160.< **

1002.02(o) Petitions and Other Matters Decided by the Deputy Commissioner of Patents and Trademarks [R-13]

The authority to take the following actions has been delegated to the Deputy Commissioner of Patents and Trademarks.

1. Review *government >employee<* invention rights determinations under 37 CFR 100.6.
2. Decide appeals from >government employee< invention rights determinations > under 37 CFR 100.7 <.
3. Decide petitions to the Commissioner in patent interference proceedings >under 37 CFR 1.644<.
4. **>Decide petitions to the Commissioner from actions taken by the Board of Patent Appeals and Interferences.<
5. **>Decide petitions (under 37 CFR 1.304 or 37 CFR 2.145(d)) seeking to extend the time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action seeking judicial review of a decision of the Board of Patent Appeals and Interferences or the Trademark Trial and Appeal Board.
6. Decide petitions under 37 CFR 10.2(c) from a final decision of the Director of Enrollment and Discipline.
7. Render final decisions in proceedings under 35 U.S.C. 32 in which the Director of Enrollment and Discipline seeks to exclude or suspend a practitioner from practice before the Patent and Trademark Office.
8. Render final decisions in proceedings under 35 U.S.C. 32 seeking to disqualify a practitioner and/or the practitioner's firm in all cases in the Patent and Trademark Office.

The Deputy Commissioner is also a member of the Committee on Enrollment (37 CFR 10.3) and is designated to serve as the Chairman of the Committee.

If a vacancy in the position of Deputy Commissioner for Patents and Trademarks, decisions on petitions in patent interference cases will be signed by the Commissioner of Patents and Trademarks.

Upon receipt of a petition and without waiting for any opposition, the entire interference file is to be forwarded to the Office of the Solicitor. The Solicitor is directed to promptly cause a review to be made of the petition and to prepare a draft decision for the Deputy Commissioner or Commissioner as may be appropriate. The Solicitor is authorized to take any interlocutory action, i.e., extending times for filing oppositions and seeking judicial review, obtaining agreement on facts from the parties, etc., as may be necessary to promptly dispose of the petition.<

>1002.02(p) Petitions decided by the Special Programs Examiners [R-13]

1. Petitions for access to patent applications except as to applications before the Board of Patent Appeals and Interferences, 37 CFR 1.12, 1.14, MPEP §§ 103 and 104.
2. Petitions for withdrawal of attorney in proceedings before the Office of the Assistant Commissioner for Patents, 37 CFR 1.36. MPEP § 402.06.
3. Petitions for acceptance of patent applications without participation of one or more inventors under 37 CFR 1.47. MPEP § 409.03.
4. Petitions involving deceased inventors, MPEP § 409.01 (a) and (b).
5. Petitions for conversion of inventorship in applications under 37 CFR 1.48 filed prior to issuance of filing receipt, MPEP § 201.01.
6. Applications filed without drawings where there is a doubt as to the need for drawings before granting a filing date, MPEP § 608.02.
7. Petitions for extensions of time under 37 CFR 1.136(b) in cases pending in Application Branch.<

1003 Matters Submitted to Group Directors [R-13]

The following is a list of matters which require the approval of the appropriate group director, together with a reference to *>any< section of this manual where such matters are more fully treated.

- 1.**>Requests for a Certificate of Correction in which the:
 - i. request raises a novel issue or about which there is some question .
 - ii. request is for a patent known to be in litigation.
 - iii. request deals with a legal matter (e.g., the insertion of foreign priority data or cross referencing to prior U.S. patent applications) unless the file reflects that the examiner has already ruled on the matter and that failure to print the material was

clearly an Office error in which case it will be handled by the Certificate of Corrections Branch.<

2. Return of papers entered on the "Contents" of the file wrapper. See >MPEP< §§ 201.14(c)>, 604.04(a)< and 717.01.

3. Return of papers containing discourteous remarks. See >MPEP< § 714.19, item 11 and >MPEP< § 714.25.

4. Certain rejections on double patenting of divisional (or parent) case when restriction or election of species has previously been required. >MPEP< § 804.04.

5. Request for patentability report. § 705.01(e).

6. Letters to an applicant suggesting claims for purposes of interference, or the submission of Form PTO-850, where one or more claims of one application would differ from corresponding claims of another application. See 37 CFR *>1.603< and >MPEP< § 2303<**.

7. Letters to an applicant of an allowed application informing him or her of a proposal to request withdrawal of said application from issue for the purpose of rejecting a claim or claims as fully met by, or obviously unpatentable over a new reference. >MPEP< § 1308.01.

8. Second or subsequent attempts at conversion of an application under 37 CFR 1.48. See >MPEP< § 201.03.

9.**> Petitions for withdrawal of attorney under 37 CFR 1.36 for patent applications pending in their examining group.<

10. Actions which hold unpatentable claims copied from a patent for interference purposes where the grounds relied upon are equally applicable to the patentee. >MPEP< § 2307.02<.*

11. Interferences between applications neither of which is in condition for allowance. >MPEP< § >2303<.*

12. Letters requesting jurisdiction of applications involved in interference. **

13. Letters to an applicant suggesting claims for purposes of interference, the adoption of which by the applicant would result in the withdrawal of an application from issue. >MPEP< § 2305.04<.*

14. Amendments presented after decision >in an appeal< by the Board of >Patent< Appeals >and Interferences< as to which the primary examiner recommends entry as placing the application in condition for allowance. See >MPEP< § 1214.07.

15. >Examiner's answers containing a new interpretation of law. See MPEP § 1208.<**

16. Proposed interferences between applications whose effective filing dates differ by more than six months. See >MPEP< § 2303<.*

17. Withdrawal from appeal of an application remanded by the Board of >Patent< Appeals >and Interferences<. See >MPEP< § 1211<.*

18. Protests filed against issuance of a patent. See **>MPEP< § 1901.06.

19. Letters requesting the application be withdrawn from issue for purposes of interference with a patent. See >MPEP< § >2305.04<.*

The group director should also be consulted in situations such as the one spelled out in >MPEP< § 1208.01, where it must be decided whether to fully reopen the ex parte prosecution after appeal or to proceed by introducing a new ground of rejection in the examiner's answer. Such consultation would ordinarily

be confined to questions of policy as to whether the best interests of the applicant as well as the Office would be served by reopening the prosecution or extending the term to reply to the answer.

All unusual questions of practice may be referred to the group directors.

>1003.05 Matters Submitted to Supervisory Primary Examiners [R-13]

1. Review of third and subsequent actions on the merits of any case (MPEP § 707.02(a)).

2. Review of any action on a case pending 5 or more years (MPEP § 707.02(a)).<

1004 Actions Which Require the Attention of a Primary Examiner [R-13]

There are some questions which existing practice requires the primary examiner to be personally responsible for. The following actions fall in this category:**

Final rejection (>MPEP< § 706.07).

Initiating an interference (>MPEP< § 2309<*)**.

Disposition of an amendment in a case in interference looking to the formation of another interference involving that application (>MPEP< §>2364.01<*)**.

> Calling Examiner-in-chief's attention to a discovered reference which makes a claim corresponding to a count unpatentable (37 CFR 1.641, MPEP § 2341).<

Rejection of a previously allowed claim (>MPEP< § 706.04).**

Classification of allowed cases (>MPEP< § 903.07).

Holding of abandonment for insufficient response (>MPEP< § 711.03(a)).

Suspension of examiner's action (>MPEP< § 709).

Treatment of newly filed application which obviously fails to comply with 35 U.S.C. 112 (>MPEP< § 702.01).

Consideration of the advisability of a patentability report (>MPEP< § 705.01>(a)<).

Final requirements for restriction (>MPEP< § 803.01).

Withdrawal of final rejection (>MPEP< §§ 706.07(d) and 706.07(e)).

All examiner's answers on appeal (>MPEP< § 1208). Note also >MPEP< § 1208.01 where a new ground of rejection or objection is raised, or a new reference is cited, in the answer.

Decision on reissue oath or declaration. (>MPEP< §§ 1414-1414.05).

Decision on affidavits or declarations under 37 CFR 1.131 (>MPEP< § 715.08) and under 37 CFR 1.132 (>MPEP< § 716).

Decision as to acceptance of amendments, statements, and oaths or declarations filed under 37 CFR 1.48, (>MPEP< § 201.03).

For a list of actions that are to be submitted to the group directors, see >MPEP< §§ 1002.02(c) and 1003.

**1005 >Exceptions to< Partial Signatory
Authority [R-13]**

Examiners who are delegated partial signatory authority are expected to sign their own actions with the exception of the following actions which require the signature of the primary examiner:

Allowances (>MPEP § 1302.13<).

Quayle actions (>MPEP § 714.14<).

Final rejections (>MPEP < § 706.07).

Actions on amendments submitted after final rejection (>MPEP < § 714.12).

Examiners' answers on appeal (>MPEP < § 1208).

Interference declarations or modifications (>MPEP § 2309<*)**

Actions suggesting claims for interference purposes (>MPEP < § >2305<*)

Actions involving copied patent claims (>MPEP § 2307<*)

Actions reopening prosecution (>MPEP < § 1214.07).

Requests for withdrawal from issue (>MPEP < § 1303).

37 CFR 1.312 amendments (>MPEP < § 714.16).

Rejection of previously allowed claim (>MPEP < § 706.04).

Final holding of abandonment for insufficient response (>MPEP < § 711.03(a)).

Actions based on affidavit or declaration evidence (37 CFR 1.131 and 1.132 (>MPEP < §§ 715.08 and 716)).

Suspension of examiner's action >MPEP < (§ 709).

Reissue cases (decisions on reissue oath or declaration) (>MPEP < § 1444).

Requests for an extension of time under 37 CFR 1.136(b) (>MPEP < § 710.02(e)).

Examiner's amendments (>MPEP < § 1302.04).

Final restriction requirements (>MPEP < § 803.01).

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MANUAL OF PATENT EXAMINING PROCEDURE