

Chapter 500 Receipt and Handling of Mail and Papers

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- 501 **>Filing Papers With the U.S. Patent and Trademark Office< [R-2]**

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

(a) *In general.* Except as provided in paragraphs (a)(3)(i), (a)(3)(ii) and (d)(1) of this section, all correspondence intended for the United States Patent and Trademark Office must be addressed to either “Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450” or to specific areas within the Office as set out in para-

graphs (a)(1) and (a)(3)(iii) of this section. When appropriate, correspondence should also be marked for the attention of a particular office or individual.

(1) *Patent correspondence.*

(i) *In general.* All correspondence concerning patent matters processed by organizations reporting to the Commissioner for Patents should be addressed to: Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450.

(ii) *Board of Patent Appeals and Interferences: Appeals.* All correspondence in an application involved in an appeal to the Board of Patent Appeals and Interferences during the period beginning when an appeal docketing notice is issued and ending when a decision has been rendered by the Board of Patent Appeals and Interferences, as well as any request for rehearing of a decision by the Board of Patent Appeals and Interferences, should be mailed to: Board of Patent Appeals and Interferences, United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450. Notices of appeal, appeal briefs, reply briefs, requests for oral hearing, as well as all other correspondence in an application involved in an appeal to the Board of Patent Appeals and Interferences for which an address is not otherwise specified, should be addressed as set out in paragraph (a)(1)(i) of this section.

(iii) *Board of Patent Appeals and Interferences: Interferences.* Except as an administrative patent judge or the Board may otherwise direct, all correspondence relating to patent interferences, or relating to patent applications or patents involved in an interference, should be mailed to: Mail Stop INTERFERENCE, Board of Patent Appeals and Interferences, United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450.

(2) [Reserved]

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

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

(ii) *Disciplinary proceedings.* Correspondence to counsel for the Director of the Office of Enrollment and Discipline relating to disciplinary proceedings pending before an Administrative Law Judge or the Director shall be mailed to: Office of the Solicitor, PO Box 16116, Arlington, Virginia 22215.

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

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

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

(4) *Office of Public Records correspondence.*—

(i) *Assignments.* All patent-related documents to be recorded by the Assignment Services Division, except for documents filed together with a new application or under § 3.81 of this chapter, should be addressed to: Mail Stop Assignment Recordation Services, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450. See § 3.27.

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

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

(c) *For reexamination proceedings.*

(1) Requests for *ex parte* reexamination (*original* request papers only) should be additionally marked “Mail Stop *Ex parte* Reexam.”

(2) Requests for *inter partes* reexamination (*original* request papers) and all subsequent *inter partes* reexamination correspondence filed in the Office, other than correspondence to the Office of the General Counsel pursuant to § 1.1(a)(3) and § 1.302(c), should be additionally marked “Mail Stop *Inter partes* Reexam.”

(d) *Maintenance fee correspondence.*—

(1) *Payments.* Payments of maintenance fees in patents not submitted electronically should be mailed to: United States Patent and Trademark Office, P.O. Box 371611, Pittsburgh, Pennsylvania 15250-1611.

(2) *Other correspondence.* Correspondence related to maintenance fees other than payments of maintenance fees in patents is not to be mailed to P.O. Box 371611, Pittsburgh, Pennsylvania 15250-1611, but must be mailed to: Mail Stop M Correspondence, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450.

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

(f) *Provisional applications.* The filing of all provisional applications and any communications relating thereto should be additionally marked “Mail Stop Provisional Patent Application.”<

37 CFR 1.4. *Nature of correspondence and signature requirements.*

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

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

(2) Correspondence in and relating to a particular application or other proceeding in the Office. See particularly the rules relating to the filing, processing, or other proceedings of national applications in subpart B, §§ 1.31 to 1.378; of international applications in subpart C, §§ 1.401 to 1.499; of *ex parte* reexaminations of patents in subpart D, §§ 1.501 to 1.570; of interferences in subpart E, §§ 1.601 to 1.690; of extension of patent term in subpart F, §§ 1.710 to 1.785; and of *inter partes* reexaminations of patents in subpart H, §§ 1.902 to 1.997.

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

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

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

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

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

(iii) [Reserved]

(2) The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any paper by a party, whether a practitioner or non-practitioner, constitutes a certification under § 10.18(b) of this chapter. Violations of § 10.18(b)(2) of this chapter by a party, whether a practitioner or non-practitioner, may result in the imposition of sanctions under § 10.18(c) of this chapter. Any practitioner violating § 10.18(b) may also be subject to disciplinary action. See §§ 10.18(d) and 10.23(c)(15).<

(e) Correspondence requiring person's signature and relating to registration practice before the Patent and Trademark Office in patent cases, enrollment and disciplinary investigations, or disciplinary proceedings must be submitted with an original signature personally signed in permanent ink by that person.

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

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

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I. GENERAL MAILING ADDRESSES

The U.S. Patent and Trademark Office (Office) has three separate general mailing addresses. The addresses are as follows:

A. *For Patent Applications and Patent-Related Papers*<

Correspondence in patent-related matters under the direction of the * Commissioner for Patents should be addressed to:

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

Such correspondence includes: patent applications, replies to notices of informality, requests for extension of time, notices of appeal to the Board of Patent Appeals and Interferences (the Board), briefs in support of an appeal to the Board, requests for oral hearing before the Board, extensions of term of patent, requests for publication of Statutory Invention Registration (SIR), requests for reexamination, statutory disclaimers, certificates of correction, petitions to the * Commissioner for Patents, submission of information disclosure statements, petitions to institute a public use proceeding, petitions to revive abandoned patent applications, and other correspondence related to patent applications and patents which is processed by organizations reporting to the * Commissioner for Patents.

>Certain patent-related correspondence requires immediate Office attention. Examples are:

(A) Petitions for express abandonment to avoid publication under 37 CFR 1.138(c);

(B) Petitions to withdraw an application from issue under 37 CFR 1.313(c);

(C) Request for expedited examination of a design application (rocket docket); and

(D) Papers required by the Office of Patent Publication to be hand-carried or faxed to the Office of Patent Publication.

Applicants are encouraged to transmit these types of correspondence by facsimile transmission or hand-carry them to the appropriate area of the Office for processing. See MPEP § 502.

B. *For Trademark Applications and Trademark-Related Papers*<

Correspondence in trademark-related matters under the direction of the * Commissioner for Trademarks >or the Trademark Trial and Appeal Board< should be addressed to:

**>Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514<

Such correspondence includes all trademark applications and other trademark-related mail, except for trademark documents sent to the Assignment Division for recordation, requests for certified and uncertified copies of trademark documents, and filings submitted electronically. See 37 CFR *> 2.190<.

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C. *For Other Correspondence*

Patent and trademark documents sent to the Assignment Division for recordation, requests for certified or uncertified copies of patent and trademark documents, and for correspondence for which an address is not otherwise specified in 37 CFR 1.1, should be addressed to:

Director of the United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

II. SEPARATE MAILING ADDRESSES FOR CERTAIN CORRESPONDENCE

The Office has separate mailing addresses for certain correspondence:

(A) Certain court-related correspondence (e.g., summons and complaint) being delivered to the Office via the U.S. Postal Service (USPS) must be addressed:

General Counsel
United States Patent and Trademark Office
P.O. Box 15667
Arlington, VA 22215

(B) Correspondence directed to the Office of Enrollment and Discipline (OED) Director relating to disciplinary proceedings pending before an Administrative Law Judge or the Director must be addressed:

Office of the Solicitor
P.O. Box 16116
Arlington, Virginia 22215

(C) Payments of maintenance fees in patents being delivered to the Office via the USPS should be addressed:

United States Patent and Trademark Office
P.O. Box 371611
Pittsburgh, Pennsylvania 15250-1611

(D) A deposit account replenishment being delivered to the Office via the USPS should be addressed:

Director of the United States Patent and Trademark Office
P.O. Box 70541
Chicago, Illinois 60673

Persons filing correspondence with the Office should check the rules of practice, the *Official Gazette*, or the Office's Internet Web site (<http://www.uspto.gov>) to determine the appropriate mailing address for such correspondence.

III. HAND-DELIVERY OF PAPERS

Patent-related papers, other than those that require immediate Office attention, may be hand-carried to the Office. If the correspondence is hand-carried to the Office, it must be delivered to the Customer Window located at:

U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window
Crystal Plaza Two, Lobby, Room 1B03
Arlington, Virginia 22202

See MPEP § 502.<

Trademark-related papers may also be filed at the "walk-up" window located on the third floor of the South Tower Building, 2900 Crystal Drive, Arlington, VA >22202<. Hand delivery of trademark papers and fees directly to the South Tower Building will expedite processing.

As provided in 37 CFR 1.4(c), matters that are to be considered by different branches or sections of the USPTO must be contained in separate papers. The following form paragraph may be used to notify the applicant of this requirement when the applicant has filed a single paper containing distinct subjects, inquiries, or orders.

¶ 5.01.01 Separate Paper Required

The [1] submitted [2] should have been submitted as a separate paper as required by 37 CFR 1.4(c). The paper has been entered. However, all future correspondence must comply with 37 CFR 1.4.

Examiner Note:

1. In bracket 1, indicate the item required to be separately submitted, such as an affidavit, petition, or other appropriate document.
2. If the applicant is a *pro se* inventor, include a copy of the rule.

Those who correspond with the USPTO are strongly encouraged not to include correspondence which will have to be directed to different areas (e.g., Patents and Trademarks) of the Office in a single envelope. Including multiple papers in a single envelope increases the likelihood that one or more of the papers will be delayed before reaching the appropriate area. Placing the papers in separately addressed envelopes will reduce the number of actions being performed by the USPTO unnecessarily or inappropriately. At the present time, use of the wrong mailing address will not affect the filing date assigned to any application or correspondence received in the USPTO, except as specified in ****>37 CFR 1.1(a)(3)(v).<**

Except for certain mail addressed incorrectly to the Office of the Solicitor, there will be no penalty for addressing a document to the wrong area within the

Office, as long as one of the approved addresses is used. Use of the specific addresses listed within 37 CFR 1.1 is strongly encouraged because it will facilitate the process both for the Office and the filer. Accordingly, a new application incorrectly addressed to the *>Director< will be treated the same as if the application was addressed to the specific * Commissioner.

All mailed communications are received by the Incoming-Mail Section of the Office of Initial Patent Examination (OIPE), which opens and distributes all official mail.

Special *>mail stops< have been established to allow the forwarding of particular types of mail to appropriate areas of the Office as quickly as possible. A list of these *>mail stops< is published weekly in the *Official Gazette*. Only the specified type of document for a particular *>mail stop< should be placed in an envelope addressed to that *>mail stop<.

If any documents other than the specified type identified for each department are addressed to that department, they will be significantly delayed in reaching the appropriate area for which they were intended.

502 Depositing Correspondence [R-2]

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37 CFR 1.5. Identification of patent, patent application, or patent-related proceeding.<

(a) No correspondence relating to an application should be filed prior to receipt of the application number from the Patent and Trademark Office. When a letter directed to the Patent and Trademark Office concerns a previously filed application for a patent, it must identify on the top page in a conspicuous location, the application number (consisting of the series code and the serial number; e.g., 07/123,456), or the serial number and filing date assigned to that application by the Patent and Trademark Office, or the international application number of the international application. Any correspondence not containing such identification will be returned to the sender where a return address is available. The returned correspondence will be accompanied with a cover letter which will indicate to the sender that if the returned correspondence is resubmitted to the Patent and Trademark Office within two weeks of the mail date on the cover letter, the original date of receipt of the correspondence will be considered by the Patent and Trademark Office as the date of receipt of the correspondence. Applicants may use either the Certificate of Mailing or Transmission procedure under § 1.8 or the Express Mail procedure under § 1.10 for resubmissions of returned correspondence if they desire to have the benefit of the date of deposit in the United States Postal Service. If the returned correspondence is not resub-

mitted within the two-week period, the date of receipt of the resubmission will be considered to be the date of receipt of the correspondence. The two-week period to resubmit the returned correspondence will not be extended. In addition to the application number, all letters directed to the Patent and Trademark Office concerning applications for patent should also state the name of the applicant, the title of the invention, the date of filing the same, and, if known, the group art unit or other unit within the Patent and Trademark Office responsible for considering the letter and the name of the examiner or other person to which it has been assigned.

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

(c) **>[Reserved]<

(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.

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

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37 CFR 1.6. Receipt of correspondence.

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

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

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

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

(4) [Reserved]

(b) [Reserved]

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

(d) *Facsimile transmission.* Except in the cases enumerated below, correspondence, including authorizations to charge a deposit account, may be transmitted by facsimile. The receipt date accorded to the correspondence will be the date on which the complete transmission is received in the United States Patent and Trademark Office, unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. See § 1.6(a)(3). To facilitate proper processing, each transmission session should be limited to correspondence to be filed in a single application or other proceeding before the United States Patent and Trademark Office. The application number of a patent application, the control number of a reexamination proceeding, the interference number of an interference proceeding, or the patent number of a patent should be entered as a part of the sender's identification on a facsimile cover sheet. Facsimile transmissions are not permitted and, if submitted, will not be accorded a date of receipt in the following situations:

- (1) Correspondence as specified in § 1.4(e), requiring an original signature;
- (2) Certified documents as specified in § 1.4(f);
- (3) Correspondence which cannot receive the benefit of the certificate of mailing or transmission as specified in § 1.8(a)(2)(i)(A) through (D) and (F), and § 1.8(a)(2)(iii)(A), except that a continued prosecution application under § 1.53(d) may be transmitted to the Office by facsimile;
- (4) Drawings submitted under §§ 1.81, 1.83 through 1.85, 1.152, 1.165, 1.174, or 1.437;
- (5) A request for reexamination under § 1.510 or § 1.913;
- (6) Correspondence to be filed in a patent application subject to a secrecy order under §§ 5.1 through 5.5 of this chapter and directly related to the secrecy order content of the application;
- (7) [Reserved]
- (8) [Reserved]
- (9) Correspondence to be filed in an interference proceeding which consists of a preliminary statement under § 1.621; a transcript of a deposition under § 1.676 or of interrogatories, or cross-interrogatories; or an evidentiary record and exhibits under § 1.653.

(e) *Interruptions in U.S. Postal Service.* If interruptions or emergencies in the United States Postal Service which have been so designated by the Director occur, the Patent and Trademark Office will consider as filed on a particular date in the Office any correspondence which is:

- (1) Promptly filed after the ending of the designated interruption or emergency; and
- (2) Accompanied by a statement indicating that such correspondence would have been filed on that particular date if it were not for the designated interruption or emergency in the United States Postal Service.

(f) *Facsimile transmission of a patent application under § 1.53(d).* In the event that the Office has no evidence of receipt of an application under § 1.53(d) (a continued prosecution application) transmitted to the Office by facsimile transmission, the party

who transmitted the application under § 1.53(d) may petition the Director to accord the application under § 1.53(d) a filing date as of the date the application under § 1.53(d) is shown to have been transmitted to and received in the Office.

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

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

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

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

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

All applications (provisional and nonprovisional) may be sent to the U.S. Patent and Trademark Office by mail (see MPEP § 501), or they may be **>hand-carried to the Customer Window<. A continued prosecution application (CPA) filed under 37 CFR 1.53(d) >(available for design applications only)<, amendments, and other papers may be sent to the U.S. Patent and Trademark Office by mail (see MPEP § 501), by facsimile (see MPEP § 502.01) or **>hand-carried to the Customer Window<. Any correspondence sent to the U.S. Patent and Trademark Office should include the sender's return address and ZIP Code designation.**>For correspondence hand-delivered to the Office, see subsection II. below.<

Trademark-related papers may also be filed or delivered by private courier to the "walk-up" window located on the third floor of the South Tower Building, 2900 Crystal Drive, Arlington, VA >22202<. Hand delivery of trademark papers and fees directly to the South Tower Building is recommended, to expedite processing.

All correspondence related to a national patent application already filed with the U.S. Patent and Trademark Office must include the identification of the application number or the serial number and the filing date assigned to the application by the Office. Any correspondence not containing the proper identification set forth in 37 CFR 1.5(a) **>will be returned

to the sender by OIPE<. Each paper should be inspected to assure that the papers being returned contain either an "Office Date" stamp or a TC date stamp. A minor error in the identification of the application can be corrected by the *>Office< provided the correct identification can be quickly discovered. Examples of minor errors are transposed numbers, typographical errors, and listing the parent application number. The failure to give any application number is not a minor error. The Office often experiences difficulty in matching incoming papers with the application file to which they pertain because insufficient or erroneous information is given. This applies especially to amendments, powers of attorney, changes of address, status letters, petitions for extension of time, and other petitions.

Frequently, there are errors in the application number or in the art unit number, or the incoming paper uses the old art unit number where an application has been transferred and acted on by a different art unit.

Where the art unit number is entirely omitted, the routine operations of OIPE must be interrupted solely for the purpose of determining the location of the application so that the communication can be properly routed. Under these circumstances, the efficiency of OIPE is impaired and the incoming paper is delayed in reaching its proper destination. Where such papers are not essential to compliance with a statutory period or time limit for reply, they may be returned for completion to identify the location of the files. >For Image File Wrapper (IFW) processing, see IFW Manual.<

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

- (A) Application number (checked for accuracy, including series code and serial no.).
- (B) Art Unit number (copied from most recent Office communication).
- (C) Filing date.
- (D) Name of the examiner who prepared the most recent Office action.
- (E) Title of invention.
- (F) Confirmation number (see MPEP § 503).

Applicants may be reminded of this provision by including form paragraph 5.01.

¶ 5.01 *Proper Heading for Incoming Papers*

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

- 1. Application number (checked for accuracy, including series code and serial no.).
- 2. Art Unit number (copied from most recent Office communication).
- 3. Filing date.
- 4. Name of the examiner who prepared the most recent Office action.
- 5. Title of invention.
- 6. Confirmation number (see MPEP § 503).

The Office prefers identifying indicia to be provided on the drawings. If such identifying indicia is provided, it must be placed on the front of each sheet of drawings and centered within the top margin. See 37 CFR 1.84(c). The identifying indicia should include the title of the invention, inventor's name, application number, and confirmation number (see MPEP § 503). If the Office has not yet assigned an application number and confirmation number to the application, the docket number (if any) used by the applicant to track the application should be provided.

When the Office receives **>replacement sheets of< drawings for patent applications after the application has been filed, a cover letter identifying the drawings by application number should accompany them. The application number and other identifying indicia should be placed on each sheet of drawings in accordance with 37 CFR 1.84(c).

It is requested that the submission of additional or supplemental papers on a newly filed application be deferred until an application number has been received. **

Documents which have no particular time or sequence requirements should be filed in the Office with materials submitted in reply to the statutory or regulatory requirements. Examples are certified copies of foreign documents to support priority in patent applications, changes of power of attorney, or changes in mailing address following first action.

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

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I. < POST ALLOWANCE CORRESPONDENCE

All post allowance correspondence, except for petitions under 37 CFR 1.313(c), should be ** addressed “**>Mail Stop< Issue Fee.” Any petition filed under 37 CFR 1.313(c) to withdraw an application from issue after payment of the issue fee should be clearly marked “Petition under 37 CFR 1.313(c)” and be either hand-carried >to the Office of Petitions, Crystal Plaza 4, 2201 South Clark Place, Room 3C23, Arlington, Virginia 22202< or submitted by facsimile to the **>Central Facsimile Number (703) 872-9306<.

Any paper filed after receiving the Issue *>notification< should include the indicated patent number.

Since an allowed application *>may< be issued as a patent within about *>four< weeks of payment of the issue fee, all post allowance correspondence should be filed prior to the date of issue fee payment to ensure the papers reach the appropriate USPTO official for consideration before the date the application issues as a patent. >See MPEP § 2732 for a discussion of the patent term adjustment impact of submitting amendments or other papers after a notice of allowance has been mailed.<

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

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II. < HAND-DELIVERY OF PAPERS

**>No official paper which relates to a pending application may be personally delivered to a TC except papers that are directed to an application subject to a secrecy order pursuant to 35 U.S.C. 181, or are national security classified and that are directed to Licensing and Review. Effective December 1, 2003, all official patent application related correspondence for organizations reporting to the Commissioner for Patents (e.g., TCs, the Office of Patent Publication, and the Office of Petitions) that is hand-carried (or delivered by other delivery services) must be delivered to the Customer Window, with a few exceptions.

Correspondence for Which Centralized Delivery of Hand-Carried Papers is Not Required

The following types of patent application related correspondence may be delivered to the specific location where they are processed instead of the Customer Window. Any such correspondence carried by error to the Customer Window will be accepted but then re-routed to the appropriate office, thereby incurring a delay before being processed. Non-patent application related papers (e.g., correspondence for the Office of Enrollment and Discipline (OED), questions on employment, correspondence for the Office of General Counsel, correspondence relating to PCT international applications prior to national stage entry) may continue to be hand-carried to the current designated locations depending on the substance of the correspondence.

(A) Petitions for express abandonment under 37 CFR 1.138(c) to avoid publication may be hand-carried to the Pre-Grant Publication Division, 2231 Crystal Drive, Room 905, Arlington, VA 22202.

(B) Petitions to withdraw from issue under 37 CFR 1.313(c) may be hand-carried to the Office of Petitions, Crystal Plaza 4, 2201 South Clark Place, Room 3C23, Arlington, VA 22202.

(C) Requests for expedited examination of a design application may be hand-carried to the Design TC Director’s Office (TC 2900). Applicants should check the USPTO web site at www.uspto.gov for the current telephone and room number of the Design TC Director.

(D) Papers required by the Office of Patent Publication may be hand-carried to the Office of Patent Publication, 2231 Crystal Drive, Room 907, Arlington, VA 22202.

(E) Applications subject to a secrecy order pursuant to 35 U.S.C. 181, or are national security classified, and correspondence to be filed in such an application, may be hand-carried to Licensing and Review, Office of TC 3600 Director, Crystal Park 5, 2451 Crystal Drive, Room 3D07, Arlington, VA 22202.

III. < “EXPRESS MAIL” SERVICE

There are two types of “Express Mail” delivery offered by the U.S. Postal Service — “Post Office to Addressee” and “Post Office to Post Office.” The only

type of service which can be used for “Express Mail” directed to the U.S. Patent and Trademark Office is the “Post Office to Addressee” service of the U.S. Postal Service. 37 CFR 1.10. This service provides for the use of a mailing label which clearly indicates the date on which a particular paper or fee was deposited.

The addresses that should be used for “Express Mail” sent to the U.S. Patent and Trademark Office are set forth in 37 CFR 1.1 (see MPEP § 501).

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

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

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

502.01 Correspondence Transmitted by Facsimile [R-2]

37 CFR 1.6. Receipt of correspondence.

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(d) *Facsimile transmission.* Except in the cases enumerated below, correspondence, including authorizations to charge a deposit account, may be transmitted by facsimile. The receipt date accorded to the correspondence will be the date on which the complete transmission is received in the United States Patent and Trademark Office, unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. See § 1.6(a)(3). To facilitate proper processing, each transmission session should be limited to correspondence to be filed in a single application or other proceeding before the United States Patent and Trademark Office. The application number of a patent application, the control number of a reexamination proceeding, the interference number of an interference proceeding, or the patent number of a patent should be entered as a part of the sender’s identification on a facsimile cover sheet. Facsimile transmissions are not permitted and, if submitted, will not be accorded a date of receipt in the following situations:

- (1) Correspondence as specified in § 1.4(e), requiring an original signature;
- (2) Certified documents as specified in § 1.4(f);

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

(4) Drawings submitted under §§ 1.81, 1.83 through 1.85, 1.152, 1.165, 1.174, or 1.437;

(5) A request for reexamination under § 1.510 or § 1.913;

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

(7) [Reserved]

(8) [Reserved]

(9) Correspondence to be filed in an interference proceeding which consists of a preliminary statement under § 1.621; a transcript of a deposition under § 1.676 or of interrogatories, or cross-interrogatories; or an evidentiary record and exhibits under § 1.653.<

The date of receipt accorded to any correspondence permitted to be sent by facsimile transmission, including a continued prosecution application (CPA) filed under 37 CFR 1.53(d) >(for design applications only)<, is the date the complete transmission is received by an Office facsimile unit, unless the transmission is completed on a Saturday, Sunday, or Federal holiday within the District of Columbia. Correspondence for which transmission was completed on a Saturday, Sunday, or Federal holiday within the District of Columbia, will be accorded a receipt date of the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia. For example, a facsimile transmission to the Office from California starting on a Friday at 8:45 p.m. Pacific time and taking 20 minutes, would be completed at 9:05 p.m. Pacific time. The complete transmission would be received in the Office around 12:05 a.m. Eastern time on Saturday. The receipt date accorded to the correspondence is the date of the following business day, which in this case, would be Monday (assuming that Monday was not a Federal holiday within the District of Columbia). Note however, that if the Certificate of Transmission is available (for documents not proscribed by 37 CFR 1.8(a)(2)), then the above facsimile may be considered timely filed on Friday if it contains a Certificate of Transmission and is in compliance with 37 CFR 1.8(a)(1)(i)(B) and (ii).

37 CFR 1.6(d) specifies the types of correspondence which may be transmitted by facsimile. These would include CPAs filed under 37 CFR 1.53(d) >(available for design applications only)<, amendments, declarations, petitions, >information disclosure statements (IDS), terminal disclaimers, notices of appeal and appeal briefs, requests for continued examination (RCEs) under 37 CFR 1.114, assignment documents,< issue fee transmittals and authorizations to charge deposit accounts. The situations where transmissions by facsimile are prohibited are identified in 37 CFR 1.6(d)(1)-(9). Prohibitions cover situations where originals are required as specified in 37 CFR 1.4(e) and (f), and situations where accepting a facsimile transmission would be unduly burdensome on the Office. As a courtesy, the Office will attempt to notify senders whenever correspondence is sent to the Office by facsimile transmission that falls within one of these prohibitions. Senders are cautioned against submitting correspondence by facsimile transmission which is not permitted under 37 CFR 1.6(d) since such correspondence will not be accorded a receipt date.

An applicant filing a CPA >for a design application only< by facsimile transmission must include an authorization to charge the basic filing fee to a deposit account or to a credit card, or the application will be treated under 37 CFR 1.53(f) as having been filed without the basic filing fee (as fees cannot otherwise be transmitted by facsimile).

There is a special receipt procedure for filing a CPA by fax, whereby the Office will fax back a receipt of the CPA filing if applicant submits the Office receipt form along with the CPA filing.

37 CFR 1.6. Receipt of correspondence.

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

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

(i) Informs the Office of the previous transmission of the application under § 1.53(d) promptly after becoming aware

that the Office has no evidence of receipt of the application under § 1.53(d);

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

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

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

37 CFR 1.6(f) provides for the situation in which the Office has no evidence of receipt of a CPA transmitted to the Office by facsimile transmission. 37 CFR 1.6(f) requires a petition be filed requesting that the CPA be accorded a filing date as of the date the CPA is shown to have been transmitted to and received in the Office. The showing must include, *inter alia*, a copy of the sending unit's report confirming transmission of the application or evidence that came into being after the complete transmission of the application and within one business day of the complete transmission of the application.

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I. CENTRALIZED FACSIMILE NUMBER FOR OFFICIAL PATENT APPLICATION RELATED CORRESPONDENCE

A. *Central Number*

Effective December 1, 2003, all patent application related correspondence transmitted by facsimile must be directed to the central facsimile number, (703) 872-9306, with a few exceptions below. Replies to Office actions including after-final amendments that are transmitted by facsimile must be directed to the central facsimile number. Unofficial correspondence such as draft proposed amendments for interviews may continue to be transmitted by facsimile to the Technology Centers (TCs). Office personnel should not use their personal facsimile numbers for official application related correspondence. Office personnel that inadvertently receive official application related correspondence on a personal facsimile number must either route (do not forward) the correspondence to the official central number or they may, with appli-

cant's (or applicant's representative) permission, make the facsimile amendment part of an examiner's amendment.

B. Correspondence Which May Be Sent by Facsimile to Other Than the Central Facsimile Number

The correspondence items below may be sent by facsimile to specific facsimile numbers as indicated (they are exceptions to facsimile transmission to the central facsimile number).

(1) Facsimile transmissions of Assignment Documents.

Facsimile transmission to record an assignment or other documents affecting title is permitted. This process allows customers to submit their documents directly into the Automated Patent and Trademark Assignment System and receive the resulting recordation notice at their facsimile machine. Credit card payments to record assignment documents are now accepted, and use of the Credit Card form (PTO-2038) is required for the credit card information to be separated from the assignment records. Only documents with an identified patent application or patent number, a single cover sheet to record a single type of transaction, and the fee paid by an authorization to charge a USPTO deposit account or credit card may be submitted via facsimile. Consult the USPTO web site at <http://www.uspto.gov/web/offices/ac/ido/oprptas-fax.pdf> for more information regarding the submission of assignment documents via facsimile. The facsimile number for the Automated Patent and Trademark Assignment System is (703) 306-5995.

(2) Petitions for a foreign filing license pursuant to 37 CFR 5.12(b) and 5.13 may be transmitted by facsimile to Licensing and Review at (703) 305-7658.

(3) Petitions for express abandonment to avoid publication under 37 CFR 1.138(c) may be transmitted by facsimile directly to the Pre-Grant Publication Division at (703) 305-8568.

(4) Papers required by the Office of Patent Publication may be transmitted by facsimile directly to (703) 746-4000.

II. < CORRESPONDENCE RELATIVE TO PATENTS AND PATENT APPLICATIONS WHERE FILING BY FACSIMILE TRANSMISSION IS NOT PERMITTED

(A) A document that is required by statute to be certified;

(B) A national patent application specification and drawing (provisional or nonprovisional) or other correspondence for the purpose of obtaining an application filing date, other than a continued prosecution application filed under 37 CFR 1.53(d);

(C) Drawings submitted under 37 CFR 1.81, 1.83-1.85, 1.152, 1.165, * or 1.437 >except when submitted with the issue fee<;

(D) Correspondence in an interference which an Administrative Patent Judge orders to be filed by hand or "Express Mail";

(E) Agreements between parties to an interference under 35 U.S.C. 135(c);

(F) Correspondence to be filed in an interference proceeding which consists of a preliminary statement under 37 CFR 1.621; a transcript of a deposition under 37 CFR 1.676; or of interrogatories, or cross-interrogatories, or an evidentiary record and exhibits under 37 CFR 1.653;

(G) Correspondence to be filed in a patent application subject to a secrecy order under 37 CFR 5.1-5.5 and directly related to the secrecy order content of the application;

(H) An international application for patent;

(I) A copy of the international application and the basic national fee necessary to enter the national stage, as specified in ** 37 CFR 1.495(b);

(J) A request for reexamination under 37 CFR 1.510 or 37 CFR 1.913.

Under 37 CFR 1.6(d)(4), drawings submitted under ** 37 CFR 1.81, 1.83-1.85, 1.152, 1.165, * or 1.437 may not be filed by facsimile transmission in patent applications. However, **>the Office has waived the prohibition in 37 CFR 1.6(d)(4) against the submission of drawings by facsimile when drawings are facsimile transmitted with the issue fee. See Payment of the Issue Fee and Filing Related Correspondence by Facsimile, 1254 *Off. Gaz. Pat. Office* (January 15, 2002). Applicants are reminded that the facsimile process may reduce the quality of the drawings, and the Office will generally print the drawings as received<.

See MPEP § 1834.01 for a discussion concerning facsimile transmissions in PCT applications.

502.02 Correspondence Signature Requirements [R-2]

37 CFR 1.4. *Nature of correspondence and signature requirements.*

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

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

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

(iii) [Reserved]<

(2) The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any paper by a party, whether a practitioner or non-practitioner, constitutes a certification under § 10.18(b) of this chapter. Violations of § 10.18(b)(2) of this chapter by a party, whether a practitioner or non-practitioner, may result in the imposition of sanctions under § 10.18(c) of this chapter. Any practitioner violating § 10.18(b) may also be subject to disciplinary action. See §§ 10.18(d) and 10.23(c)(15).

(e) Correspondence requiring person's signature and relating to registration practice before the Patent and Trademark Office in patent cases, enrollment and disciplinary investigations, or disciplinary proceedings must be submitted with an original signature personally signed in permanent ink by that person.

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

Correspondence filed in the Office, which requires a person's signature, may be an original, or a copy thereof. The word original, as used herein, is defined as correspondence which is personally signed in permanent ink by the person whose signature appears thereon. Where copies of correspondence are acceptable, photocopies or facsimile transmissions may be filed. For example, a photocopy or facsimile transmission of an original of an amendment, declaration (e.g., under 37 CFR 1.63 or 1.67), petition, issue fee transmittal form, authorization to charge a deposit account or a credit card, may be submitted in a patent application. Where copies are permitted, second and further

generation copies (i.e., copy of a copy) are acceptable. For example, a client may fax a paper to an attorney and the attorney may then fax the paper to the Office, provided the paper is eligible to be faxed (see MPEP § 502.01). The original, if not submitted to the Office, should be retained as evidence of proper execution in the event that questions arise as to the authenticity of the signature reproduced on the photocopy or facsimile-transmitted correspondence. If a question of authenticity arises, the Office may require submission of the original.

When a document that is required by statute to be certified must be filed (such as a certified copy of a foreign patent application pursuant to 35 U.S.C. 119 or a certified copy of an international application pursuant to 35 U.S.C. 365) a copy of the certification, including a photocopy or facsimile transmission, will not be acceptable. The requirement for an original certification does not apply to certifications such as required under 37 CFR 1.8 since these certifications are not required by statute.

502.03 Communications via the Internet [R-2]

The Office published a Patent Internet Usage Policy to

(A) establish a policy for use of the Internet by the Patent Examining Corps and other organizations within the USPTO,

(B) address use of the Internet to conduct interview-like communications and other forms of formal and informal communications,

(C) publish guidelines for locating, retrieving, citing, and properly documenting scientific and technical information sources on the Internet,

(D) inform the public how the USPTO intends to use the Internet, and

(E) establish a flexible Internet policy framework which can be modified, enhanced, and corrected as the USPTO, the public, and customers learn to use, and subsequently integrate, new and emerging Internet technology into existing business infrastructures and everyday activities to improve the patent application, examining, and granting functions.

See *Internet Usage Policy*, 64 *>FR< 33056 (June 21, 1999). The Articles of the Patent Internet Usage Policy pertinent to communications via electronic

mail are summarized below. See MPEP § 904.02(c) for information pertinent to Internet searching, and MPEP § 707.05(e) for information pertaining to the citation of electronic documents. See also MPEP § 713.04 for recordation of e-mail interviews.

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I. < CONFIDENTIALITY OF PROPRIETARY INFORMATION (ARTICLE 4)

If security and confidentiality cannot be attained for a specific use, transaction, or activity, then that specific use, transaction, or activity shall NOT be undertaken/conducted.

All use of the Internet by Patent Organization employees, contractors, and consultants shall be conducted in a manner that ensures compliance with confidentiality requirements in statutes, including 35 U.S.C. 122, and regulations. Where a written authorization is given by the applicant for the USPTO to communicate with the applicant via Internet e-mail, communications via Internet e-mail may be used.

Backup, archiving, and recovery of information sent or received via the Internet is the responsibility of individual users. The OCIO does not, and will not, as a normal practice, provide backup and recovery services for information produced, retrieved, stored, or transmitted to/from the Internet.

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II. < COMMUNICATIONS VIA THE INTERNET AND AUTHORIZATION (ARTICLE 5)

Communications via Internet e-mail are at the discretion of the applicant.

Without a written authorization by applicant in place, the USPTO will not respond via Internet e-mail to any Internet correspondence which contains information subject to the confidentiality requirement as set forth in 35 U.S.C. 122. A paper copy of such correspondence will be placed in the appropriate patent application.

The following is a sample authorization form which may be used by applicant:

“Recognizing that Internet communications are not secure, I hereby authorize the USPTO to communicate with me concerning any subject matter of this application by electronic mail. I understand that a copy of these communications will be made of record in the application file.”

A written authorization may be withdrawn by filing a signed paper clearly identifying the original authorization. The following is a sample form which may be used by applicant to withdraw the authorization:

“The authorization given on_____, to the USPTO to communicate with me via the Internet is hereby withdrawn. I understand that the withdrawal is effective when approved rather than when received.”

Where a written authorization is given by the applicant, communications via Internet e-mail, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used. In such case, a printed copy of the Internet e-mail communications MUST be given a paper number, entered into the Patent Application Locating and Monitoring System (PALM) and entered in the patent application file. A reply to an Office action may NOT be communicated by applicant to the USPTO via Internet e-mail. If such a reply is submitted by applicant via Internet e-mail, a paper copy will be placed in the appropriate patent application file with an indication that the reply is NOT ENTERED. >For Image File Wrapper (IFW) processing, see IFW Manual.<

USPTO employees are NOT permitted to initiate communications with applicants via Internet e-mail unless there is a written authorization of record in the patent application by the applicant.

All reissue applications are open to public inspection under 37 CFR 1.11(a) and all papers relating to a reexamination proceeding which have been entered of record in the patent or reexamination file are open to public inspection under 37 CFR 1.11(d). USPTO employees are NOT permitted to initiate communications with applicant in a reissue application or a patentee of a reexamination proceeding via Internet e-mail unless written authorization is given by the applicant or patentee.

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III. < AUTHENTICATION OF SENDER BY A PATENT ORGANIZATION RECIPIENT (ARTICLE 6)

The misrepresentation of a sender's identity (i.e., spoofing) is a known risk when using electronic communications. Therefore, Patent Organization users have an obligation to be aware of this risk and conduct their Internet activities in compliance with established procedures.

Internet e-mail must be initiated by a registered practitioner, or an applicant in a pro se application, and sufficient information must be provided to show representative capacity in compliance with 37 CFR 1.34. Examples of such information include the attorney registration number, attorney docket number, and patent application number.

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IV. < USE OF ELECTRONIC MAIL SERVICES (ARTICLE 7)

Once e-mail correspondence has been received from the applicant, as set forth in Patent Internet Usage Policy Article 4, such correspondence must be responded to appropriately. The Patent Examiner may respond to an applicant's e-mail correspondence by telephone, fax, or other appropriate means.

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V. < INTERVIEWS (ARTICLE 8)

Internet e-mail shall NOT be used to conduct an exchange of communications similar to those exchanged during telephone or personal interviews unless a written authorization has been given under Patent Internet Usage Policy Article 5 to use Internet e-mail. In such cases, a paper copy of the Internet e-mail contents MUST be made and placed in the patent application file, as required by the Federal Records Act, in the same manner as an Examiner Interview Summary Form is entered.

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VI. < POLICY GUIDANCE AND CLARIFICATIONS (ARTICLE 13)

Within the Patent Organization, any questions regarding Internet usage policy should be directed to

the user's immediate supervisor. Non-USPTO personnel should direct their questions to the Office of the Deputy Commissioner for Patent Examination Policy.

502.04 Duplicate Copies of Correspondence [R-2]

37 CFR 1.4. Nature of correspondence and signature requirements.

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

When the Office does not require duplicate copies of a paper, the filing of multiple copies may cause a delay in processing by the Office. Accordingly, the Office may discard duplicate copies of correspondence filed in an application or patent file.

503 Application Number and Filing Receipt [R-2]

37 CFR 1.54. Parts of application to be filed together; filing receipt.

(a) It is desirable that all parts of the complete application be deposited in the Office together; otherwise, a letter must accompany each part, accurately and clearly connecting it with the other parts of the application. See § 1.53(f) and (g) with regard to completion of an application.

(b) Applicant will be informed of the application number and filing date by a filing receipt, unless the application is an application filed under § 1.53(d).

Application numbers consisting of a series code and a serial number are assigned by the Office of Initial Patent Examination (OIPE) immediately after mail has been opened.

The following series codes are assigned to the applications identified below:

(A) 01/ - *>10</ - for nonprovisional applications (utility, plant, and reissue),

- The 01 series code was used from year 1925 to 1934,

- 02 – 1935 to 1947,
- 03 – 1948 to 1959,
- 04 – 1960 to 1969,
- 05 – 1970 to 1978,
- 06 – 1979 to 1986,
- 07 – 1987 to 1992,
- 08 – 1993 to 1997, *
- 09 – 1998 to *>Nov. 2001, and<

>10 – Dec. 2001 to present.<

(B) 29/ - for design applications;

(C) 60/ - for provisional applications; *

(D) 90/ - for >*ex parte* reexamination proceedings; and

(E) 95/ - for *inter partes*< reexamination proceedings.

If a self-addressed postcard is submitted with a patent application, that postcard will be provided with both the receipt date and application number prior to returning it to the addressee. The application number identified on such a postcard receipt is merely the preliminary assignment of an application number to the application, and should not be relied upon (e.g., with respect to foreign filings) as necessarily representing the application number assigned to such application. See 37 CFR 1.53(b).

The identifying data on the postcard should include:

(A) applicant's name(s);

(B) title of invention;

(C) number of pages of specification, claims (for nonprovisional applications), and sheets of drawing;

(D) whether oath or declaration is included;

(E) a list of any additional forms included with the application (e.g., application transmittal form, application data sheet, fee transmittal form, and/or provisional application cover sheet); and

(F) amount and manner of paying the fee.

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

It is important that the return postcard itemize all of the components of the application. If the postcard does not itemize each of the components of the application, it will not serve as evidence that any component which was not itemized was received by the United States Patent and Trademark Office (USPTO).

It should be recognized that the identification of an application by application number does not necessar-

ily signify that the USPTO has accepted the application as complete (37 CFR 1.53(a)).

OIPE mails a filing receipt to the attorney or agent, if any, otherwise to the applicant, for each application filed which meets the minimum requirements to receive a filing date. The filing receipt includes the application number, filing date, a confirmation number, a suggested class in the U.S. Patent Classification System (see MPEP § 902.01), and the number of an art unit where the application is likely to be examined. The filing receipt also includes other information about the application as applicable, such as continuing data, national stage data, foreign priority data, foreign filing license data, entity status information, and the date the Office anticipates publishing the application under 35 U.S.C. 122(b). The filing receipt represents the official assignment by the USPTO of a specific application number and confirmation number to a particular application. See 37 CFR 1.54(b). The application number officially assigned to an application on the filing receipt may differ from the application number identified on a postcard receipt submitted with such application, and, as between inconsistent filing receipts and postcard receipts, the application number on the filing receipt is controlling.

The confirmation number is a four-digit number that is assigned to each newly filed application. The confirmation number, in combination with the application number, is used to verify the accuracy of the application number placed on correspondence filed with the Office to avoid misidentification of an application due to a transposition error in the application number. The confirmation number may be found in the upper left-hand corner of the filing receipt. The confirmation number will also be available through the Patent Application Information Retrieval (PAIR) system (<http://pair.uspto.gov>). The Office eventually plans to include the application's confirmation number (in addition to the application number) on all Office actions and notices concerning the application. The confirmation number must be used when submitting an electronic filing system (EFS) copy of the application for publication to verify that the application number correctly identifies the application for which a copy is being submitted for publication. The Office also recommends that applicants include the application's confirmation number (in addition to the application number) on all

correspondence submitted to the Office concerning the application.

A continued prosecution application (CPA) filed under 37 CFR 1.53(d) >(design applications only)< will be assigned the application number of the prior application for identification purposes.

A nonprovisional application, other than a CPA filed under 37 CFR 1.53(d), is entitled to a filing date as of the date of receipt of the specification, including claims, and any required drawing. See 37 CFR 1.53(b). The filing receipt will be mailed at the time a determination is made that the application meets the minimum requirements to receive a filing date. The oath or declaration and filing fee may be filed later than the remaining application papers, but if so, they must be accompanied by the required surcharge. See 37 CFR 1.53(f). If the oath or declaration, and/or filing fee, and appropriate surcharge are not timely filed, the application will be abandoned.

A provisional application is entitled to a filing date as of the date of receipt of the specification and any required drawing(s). See 37 CFR 1.53(c). A cover sheet (37 CFR 1.51(c)(1)), which may be an application data sheet (37 CFR 1.76) or a cover letter, identifying the application as a provisional application is required to prevent the provisional application from being treated as a nonprovisional application. 37 CFR 1.53(c)(1).

Each application which meets the minimum requirements to receive a filing date is given a filing date. It is important, when referring to application files, to identify them by their filing dates and confirmation numbers as well as by application numbers.

Attorney docket numbers must be limited to a maximum of 12 characters to prevent truncation. The Patent Application Locating and Monitoring (PALM) system data base allows a maximum of 12 characters for the attorney docket numbers. Spaces, slashes, and hyphens will no longer be included in the entered docket number on the official filing receipt. In an application where CASE or NAVY-CASE appears before the first character in the docket number, only the characters after CASE or NAVY-CASE will be entered on the official filing receipt.

The application papers are placed in a file wrapper and certain data placed thereon by OIPE. >For Image File Wrapper (IFW) processing, see IFW Manual.<

Applications which are entitled to a filing date and are filed, whether by regular mail or “Express Mail” under 37 CFR 1.10, by hand-delivery or otherwise, will not be returned to applicant even if requested. See 37 CFR 1.59. Accordingly, applicants must be careful not to file applications which are not intended to be filed, e.g., duplicates of applications already filed. >Note that 37 CFR 1.26(a) provides that a change of purpose after the payment of a fee, as when a party desires to withdraw the filing of a patent application for which the fee was paid, will not entitle the party to a refund of such fee. See MPEP § 607.02.<

RETURN POSTCARD

If a receipt >for< any item (e.g., paper or fee) filed in the USPTO is desired, it may be obtained by enclosing with the paper a self-addressed postcard specifically identifying the item. >To ensure the receipt of return receipt postcards, users must either: (A) purchase already stamped postcards from the United States Postal Service (USPS) or affix postage stamps to their postcards; or (B) if a postage meter is used, ensure that the meter postmark does not show the date. Any return receipt postcard containing a dated meter postmark may not be delivered by the USPS to the address provided on the postcard.< The USPTO will stamp the receipt date on the postcard and place it in the outgoing mail. A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

The identifying data on the postcard should be so complete as to clearly identify the item for which >a< receipt is requested. For example, the postcard should identify the applicant’s name, application number (if known), confirmation number (if known), filing date, interference number, title of the invention, etc. The postcard should also identify the type of paper being filed, e.g., new application, affidavit, amendment, notice of appeal, appeal brief, drawings, fees, motions, supplemental oath or declaration, petition, etc., and the number of pages being submitted. If a new application is being filed, all parts of the application being submitted should be separately listed on the postcard, e.g., the number of pages of specification (including written description, claims and abstract), number of claims, number of sheets of drawings,

number of pages of oath/declaration, number of pages of cover sheet (provisional application).

The postcard receipt will not serve as *prima facie* evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard “a complete application” or “patent application” will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as *prima facie* evidence of receipt of those items.

The person receiving the item(s) in the USPTO will check the listing on the postcard against the item(s) being filed to be sure they are properly identified and that all the items listed on the postcard are presently being submitted to the USPTO. If any of the items listed on the postcard are not being submitted to the USPTO, those items will be crossed off and the postcard initialed by the person receiving the items.

Upon return of a postcard receipt from the USPTO, the postcard receipt should be promptly reviewed by the person who filed the items to ensure that every item specifically denoted on the postcard was received by the USPTO. If the postcard receipt has been annotated to indicate that a particular item denoted on the postcard was not received by the USPTO, the postcard receipt will not serve as *prima facie* evidence of receipt of that item in the USPTO.

504 Assignment of Application for Examination

The Office of Initial Patent Examination assigns a nonprovisional application to the art unit to which it appears to belong. Provisional applications will not be examined.

505 “Office Date” Stamp of Receipt [R-2]

37 CFR 1.6. Receipt of correspondence.

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

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

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

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

(4) **>[Reserved]<

The United States Patent and Trademark Office (Office) stamps papers and fees with the date of their receipt in the Office. The stamp is referred to as the “Office Date” stamp.

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

Effective November 29, 1999, Public Law 106-113 amended 35 U.S.C. 119(e)(3) to extend the period of pendency of a provisional application to the next succeeding business day if the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia. See also 37 CFR 1.7(b). 35 U.S.C. 119(e)(3) as amended by Public Law 106-113 applies to any provisional application filed on or after June 8, 1995 but has no effect on any patent which is the subject of litigation in an action commenced before November 29, 1999.

New patent applications filed in accordance with 37 CFR 1.10 will be stamped by the Office with the

date of deposit as “Express Mail” with the United States Postal Service. For example, if a new patent application is deposited in “Express Mail” in accordance with 37 CFR 1.10 on a Saturday and the United States Postal Service gives it a date of deposit of Saturday, the Office will accord and stamp the correspondence with the Saturday date. 37 CFR 1.6(a)(2).

If an application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP § 506), the “Office Date” stamp establishes the “filing date.” Applications will not be accepted and stamped in the Technology Centers. They must be date stamped at the Customer Window. See MPEP § 502<.

506 Completeness of Original Application [R-2]

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

(a) *Application number.* Any papers received in the Patent and Trademark Office which purport to be an application for a patent will be assigned an application number for identification purposes.

(b) *Application filing requirements - Nonprovisional application.* The filing date of an application for patent filed under this section, except for a provisional application under paragraph (c) of this section or a continued prosecution application under paragraph (d) of this section, is the date on which a specification as prescribed by 35 U.S.C. 112 containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office. No new matter may be introduced into an application after its filing date. A continuing application, which may be a continuation, divisional, or continuation-in-part application, may be filed under the conditions specified in 35 U.S.C. 120, 121 or 365(c) and § 1.78(a).

(1) A continuation or divisional application that names as inventors the same or fewer than all of the inventors named in the prior application may be filed under this paragraph or paragraph (d) of this section.

(2) A continuation-in-part application (which may disclose and claim subject matter not disclosed in the prior application) or a continuation or divisional application naming an inventor not named in the prior application must be filed under this paragraph.

(c) *Application filing requirements - Provisional application.* The filing date of a provisional application is the date on which a specification as prescribed by the first paragraph of 35 U.S.C. 112, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office. No amendment, other than to make the provisional application comply with the patent statute and all applicable regulations, may be made to the provisional application after the filing date of the provisional application.

(1) A provisional application must also include the cover sheet required by § 1.51(c)(1), which may be an application data sheet (§ 1.76), or a cover letter identifying the application as a provisional application. Otherwise, the application will be treated as an application filed under paragraph (b) of this section.

(2) An application for patent filed under paragraph (b) of this section may be converted to a provisional application and be accorded the original filing date of the application filed under paragraph (b) of this section. The grant of such a request for conversion will not entitle applicant to a refund of the fees that were properly paid in the application filed under paragraph (b) of this section. Such a request for conversion must be accompanied by the processing fee set forth in § 1.17(q) and be filed prior to the earliest of:

(i) Abandonment of the application filed under paragraph (b) of this section;

(ii) Payment of the issue fee on the application filed under paragraph (b) of this section;

(iii) Expiration of twelve months after the filing date of the application filed under paragraph (b) of this section; or

(iv) The filing of a request for a statutory invention registration under § 1.293 in the application filed under paragraph (b) of this section.

(3) A provisional application filed under paragraph (c) of this section may be converted to a nonprovisional application filed under paragraph (b) of this section and accorded the original filing date of the provisional application. The conversion of a provisional application to a nonprovisional application will not result in either the refund of any fee properly paid in the provisional application or the application of any such fee to the filing fee, or any other fee, for the nonprovisional application. Conversion of a provisional application to a nonprovisional application under this paragraph will result in the term of any patent to issue from the application being measured from at least the filing date of the provisional application for which conversion is requested. Thus, applicants should consider avoiding this adverse patent term impact by filing a nonprovisional application claiming the benefit of the provisional application under 35 U.S.C. 119(e) (rather than converting the provisional application into a nonprovisional application pursuant to this paragraph). A request to convert a provisional application to a nonprovisional application must be accompanied by the fee set forth in § 1.17(i) and an amendment including at least one claim as prescribed by the second paragraph of 35 U.S.C. 112, unless the provisional application under paragraph (c) of this section otherwise contains at least one claim as prescribed by the second paragraph of 35 U.S.C.112. The nonprovisional application resulting from conversion of a provisional application must also include the filing fee for a nonprovisional application, an oath or declaration by the applicant pursuant to §§ 1.63, 1.162, or 1.175, and the surcharge required by § 1.16(e) if either the basic filing fee for a nonprovisional application or the oath or declaration was not present on the filing date accorded the resulting nonprovisional application (*i.e.*, the filing date of the original provisional application). A request to convert a provisional application to a nonprovisional application must also be filed prior to the earliest of:

(i) Abandonment of the provisional application filed under paragraph (c) of this section; or

(ii) Expiration of twelve months after the filing date of the provisional application filed under this paragraph (c).

(4) A provisional application is not entitled to the right of priority under 35 U.S.C. 119 or 365(a) or § 1.55, or to the benefit of an earlier filing date under 35 U.S.C. 120, 121 or 365(c) or § 1.78 of any other application. No claim for priority under 35 U.S.C. 119(e) or § 1.78(a)(4) may be made in a design application based on a provisional application. No request under § 1.293 for a statutory invention registration may be filed in a provisional application. The requirements of §§ 1.821 through 1.825 regarding application disclosures containing nucleotide and/or amino acid sequences are not mandatory for provisional applications.

(d) *Application filing requirements - Continued prosecution (nonprovisional) application.*

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(1) A continuation or divisional application (but not a continuation-in-part) of a prior nonprovisional application may be filed as a continued prosecution application under this paragraph, provided that:

(i) The application is for a design patent:

(ii) The prior nonprovisional application is a design application that is complete as defined by § 1.51(b); and

(iii) The application under this paragraph is filed before the earliest of:

(A) Payment of the issue fee on the prior application, unless a petition under § 1.313(c) is granted in the prior application;

(B) Abandonment of the prior application; or

(C) Termination of proceedings on the prior application.<

(2) The filing date of a continued prosecution application is the date on which a request on a separate paper for an application under this paragraph is filed. An application filed under this paragraph:

(i) Must identify the prior application;

(ii) Discloses and claims only subject matter disclosed in the prior application;

(iii) Names as inventors the same inventors named in the prior application on the date the application under this paragraph was filed, except as provided in paragraph (d)(4) of this section;

(iv) Includes the request for an application under this paragraph, will utilize the file jacket and contents of the prior application, including the specification, drawings and oath or declaration from the prior application, to constitute the new application, and will be assigned the application number of the prior application for identification purposes; and

(v) Is a request to expressly abandon the prior application as of the filing date of the request for an application under this paragraph.

**>

(3) The filing fee for a continued prosecution application filed under this paragraph is the basic filing fee as set forth in § 1.16(f).<

(4) An application filed under this paragraph may be filed by fewer than all the inventors named in the prior application, provided that the request for an application under this paragraph when filed is accompanied by a statement requesting deletion of the name or names of the person or persons who are not inventors of the invention being claimed in the new application. No person may be named as an inventor in an application filed under this paragraph who was not named as an inventor in the prior application on the date the application under this paragraph was filed, except by way of correction of inventorship under § 1.48.

(5) Any new change must be made in the form of an amendment to the prior application as it existed prior to the filing of an application under this paragraph. No amendment in an application under this paragraph (a continued prosecution application) may introduce new matter or matter that would have been new matter in the prior application. Any new specification filed with the request for an application under this paragraph will not be considered part of the original application papers, but will be treated as a substitute specification in accordance with § 1.125.

(6) The filing of a continued prosecution application under this paragraph will be construed to include a waiver of confidentiality by the applicant under 35 U.S.C. 122 to the extent that any member of the public, who is entitled under the provisions of § 1.14 to access to, copies of, or information concerning either the prior application or any continuing application filed under the provisions of this paragraph, may be given similar access to, copies of, or similar information concerning the other application or applications in the file jacket.

(7) A request for an application under this paragraph is the specific reference required by 35 U.S.C. 120 to every application assigned the application number identified in such request. No amendment in an application under this paragraph may delete this specific reference to any prior application.

(8) In addition to identifying the application number of the prior application, applicant should furnish in the request for an application under this paragraph the following information relating to the prior application to the best of his or her ability:

(i) Title of invention;

(ii) Name of applicant(s); and

(iii) Correspondence address.

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(9) Envelopes containing only requests and fees for filing an application under this paragraph should be marked "Mail Stop CPA." Requests for an application under this paragraph filed by facsimile transmission should be clearly marked "Mail Stop CPA."<

(10) See § 1.103(b) for requesting a limited suspension of action in an application filed under this paragraph.

(e) *Failure to meet filing date requirements.*

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(1) If an application deposited under paragraph (b), (c), or (d) of this section does not meet the requirements of such paragraph to be entitled to a filing date, applicant will be so notified, if

a correspondence address has been provided, and given a period of time within which to correct the filing error. If, however, a request for an application under paragraph (d) of this section does not meet the requirements of that paragraph because the application in which the request was filed is not a design application, and if the application in which the request was filed was itself filed on or after June 8, 1995, the request for an application under paragraph (d) of this section will be treated as a request for continued examination under § 1.114.<

(2) Any request for review of a notification pursuant to paragraph (e)(1) of this section, or a notification that the original application papers lack a portion of the specification or drawing(s), must be by way of a petition pursuant to this paragraph accompanied by the fee set forth in § 1.17(h). In the absence of a timely (§ 1.181(f)) petition pursuant to this paragraph, the filing date of an application in which the applicant was notified of a filing error pursuant to paragraph (e)(1) of this section will be the date the filing error is corrected.

(3) If an applicant is notified of a filing error pursuant to paragraph (e)(1) of this section, but fails to correct the filing error within the given time period or otherwise timely (§ 1.181(f)) take action pursuant to this paragraph, proceedings in the application will be considered terminated. Where proceedings in an application are terminated pursuant to this paragraph, the application may be disposed of, and any filing fees, less the handling fee set forth in § 1.21(n), will be refunded.

(f) *Completion of application subsequent to filing—nonprovisional (including continued prosecution or reissue) application.*

(1) If an application which has been accorded a filing date pursuant to paragraph (b) or (d) of this section does not include the basic filing fee, or if an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include an oath or declaration by the applicant pursuant to §§ 1.63, 1.162 or § 1.175, and applicant has provided a correspondence address (§ 1.33(a)), applicant will be notified and given a period of time within which to pay the filing fee, file an oath or declaration in an application under paragraph (b) of this section, and pay the surcharge required by § 1.16(e) to avoid abandonment.

(2) If an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include the basic filing fee or an oath or declaration by the applicant pursuant to §§ 1.63, 1.162 or § 1.175, and applicant has not provided a correspondence address (§ 1.33(a)), applicant has two months from the filing date of the application within which to pay the basic filing fee, file an oath or declaration, and pay the surcharge required by § 1.16(e) to avoid abandonment.

(3) This paragraph applies to continuation or divisional applications under paragraphs (b) or (d) of this section and to continuation-in-part applications under paragraph (b) of this section.

(4) See § 1.63(d) concerning the submission of a copy of the oath or declaration from the prior application for a continuation or divisional application under paragraph (b) of this section.

(5) If applicant does not pay one of the basic filing or the processing and retention fees (§ 1.21(l)) during the pendency of the application, the Office may dispose of the application.

(g) *Completion of application subsequent to filing—provisional application.*

(1) If a provisional application which has been accorded a filing date pursuant to paragraph (c) of this section does not include the cover sheet required by § 1.51(c)(1) or the basic filing fee (§ 1.16(k)), and applicant has provided a correspondence address (§ 1.33(a)), applicant will be notified and given a period of time within which to pay the basic filing fee, file a cover sheet (§ 1.51(c)(1)), and pay the surcharge required by § 1.16(l) to avoid abandonment.

(2) If a provisional application which has been accorded a filing date pursuant to paragraph (c) of this section does not include the cover sheet required by § 1.51(c)(1) or the basic filing fee (§ 1.16(k)), and applicant has not provided a correspondence address (§ 1.33(a)), applicant has two months from the filing date of the application within which to pay the basic filing fee, file a cover sheet (§ 1.51(c)(1)), and pay the surcharge required by § 1.16(l) to avoid abandonment.

(3) If applicant does not pay the basic filing fee during the pendency of the application, the Office may dispose of the application.

(h) *Subsequent treatment of application - Nonprovisional (including continued prosecution) application.* An application for a patent filed under paragraphs (b) or (d) of this section will not be placed on the files for examination until all its required parts, complying with the rules relating thereto, are received, except that certain minor informalities may be waived subject to subsequent correction whenever required.

(i) *Subsequent treatment of application - Provisional application.* A provisional application for a patent filed under paragraph (c) of this section will not be placed on the files for examination and will become abandoned no later than twelve months after its filing date pursuant to 35 U.S.C. 111(b)(1).

(j) *Filing date of international application.* The filing date of an international application designating the United States of America is 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).

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I. < INCOMPLETE NONPROVISIONAL APPLICATIONS FILED UNDER 37 CFR 1.53(b)

If the nonprovisional application papers filed under 37 CFR 1.53(b) do not include at least a specification containing a description and at least one claim and a drawing, if necessary under 35 U.S.C. 113 (first sentence), or if the submitted application papers are too informal to be given a filing date, the case is held in the Office of Initial Patent Examination (OIPE) as an incomplete application and the applicant is informed of the shortcomings of the papers. No filing date is granted until the incompleteness is corrected.

A Notice of Incomplete Application is prepared and mailed by OIPE when nonprovisional application papers filed under 37 CFR 1.53(b) are deemed incomplete under 35 U.S.C. 111(a).

Such incompleteness may consist of the omission of any one of the following parts of an application. The component parts of a nonprovisional application filed under 37 CFR 1.53(b) necessary to obtain a filing date are:

A specification as prescribed by 35 U.S.C. 112 and 37 CFR 1.71.

A claim as prescribed by 35 U.S.C. 112 and 37 CFR 1.75.

A drawing, if necessary under 35 U.S.C. 113 (first sentence) and 37 CFR 1.81(a).

See 37 CFR 1.53(b).

Even though an application purports to include the component parts necessary to obtain a filing date, the application will still be held to be incomplete and a filing date will be refused if the component parts fail to satisfy the requirements set forth above.

For example, if the documents purporting to be a specification are so obviously informal and incoherent that they clearly do not constitute a specification as required by 35 U.S.C. 112 and 37 CFR 1.71, the application is not acceptable for examination and it will not be accorded a filing date until corrections are made. The filing date of the application will be the date the corrections are made.

Filing dates are accorded to nonprovisional applications filed under 37 CFR 1.53(b) submitted without the names of all the inventors, the basic filing fee and/or the oath or declaration. In such cases, a notice is mailed by OIPE requiring that at least the basic filing fee and the oath or declaration (which must include the names of all the inventors) be filed, accompanied by a surcharge (37 CFR 1.16(e)). In addition to the basic filing fee required under 37 CFR 1.16(a), the prescribed filing fee (37 CFR 1.51(b)(4)) may include additional fees for filing more than 3 independent claims (37 CFR 1.16(b)), for filing a total of more than 20 claims (37 CFR 1.16(c)), or for filing a multiple dependent claim (37 CFR 1.16(d)). In those cases where the basic filing fee is paid, but additional fees are required, under 37 CFR 1.16, a notice is mailed by OIPE or the Technology Center (TC), requiring that the balance of the prescribed fee be paid.

Occasionally, nonprovisional applications filed under 37 CFR 1.53(b) which have already been signed by the inventors contain informal claims that the attorney or agent feels should not be present in the application upon filing. However, since alteration after execution by the inventor and before filing is prohibited, such applications must be filed by the attorney or agent in the form in which they were executed by the inventors. A nonprovisional application filed under 37 CFR 1.53(b) may be filed with a preliminary amendment which is limited to the cancellation of claims. Any preliminary amendment, regardless of when it is filed, must be in compliance with 37 CFR 1.121, e.g., it must include a complete listing of all of the claims. Therefore, the Office strongly recommends that applicants file their applications with a specification containing only the desired set of claims, rather than filing the application with a preliminary amendment canceling claims. If such a preliminary amendment canceling claims is filed, it will diminish the number of claims to be considered for calculation of the filing fee. Any other changes to the application should be the subject of a separate amendment which may be entered after the filing fee has been calculated and the filing date granted. If a preliminary amendment which cancels claims does not accompany the application at the time the application is filed, the notification of insufficient fee will inform the inventor, attorney, or agent of the possibility of correcting the insufficient payment by either (1) paying the additional required fee amount, or (2) filing an amendment which cancels claims so that the remaining claims are covered by the fee submitted upon filing. However, no refund will be made once the fee for claims is properly paid, even though claims are later canceled.

In the past, OIPE has reviewed the claimed subject matter of newly filed nonprovisional applications to determine whether a filing date should be granted. Such applications included those drawn to perpetual motion devices and methods of doing business and applications for reissue signed by assignees or filed more than 2 years after the grant of the patent which appear to contain broadened reissue claims.

Under the current practice, a filing date is normally granted in such cases if the nonprovisional application filed under 37 CFR 1.53(b) is otherwise sufficient and

then forwarded to the examiner for consideration and decision during the regular course of examination.

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II. < INCOMPLETE PROVISIONAL APPLICATIONS

If the provisional application papers do not include at least a specification containing a description and a drawing, if necessary under 35 U.S.C. 113 (first sentence) or if the submitted application papers are too informal to be given a filing date, the case is held in OIPE as an incomplete application and the applicant is informed of the shortcomings of the papers. No filing date is granted until the incompleteness is corrected.

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

A specification as prescribed by 35 U.S.C. 112, first paragraph, and 37 CFR 1.71.

A drawing, if necessary under 35 U.S.C. 113 (first sentence) and 37 CFR 1.81(a).

Even though an application purports to include the component parts necessary to obtain a filing date, the application will still be held to be incomplete and a filing date will be refused if the component parts fail to satisfy the requirements set forth above. For example, if the documents purporting to be a specification are so obviously informal and incoherent that they would clearly not constitute a specification as required by 35 U.S.C. 112, first paragraph, and 37 CFR 1.71, the application would not be acceptable and would not be accorded a filing date until corrections are made. The filing date of the application would be the date the corrections were made. A provisional application will not be examined. However, a provisional application which does not include a cover sheet (37 CFR 1.51(c)(1)), which may be an application data sheet (37 CFR 1.76) or a cover letter, identifying the application as a provisional application, will be treated as a nonprovisional application filed under 37 CFR 1.53(b). See 37 CFR 1.53(c)(1).

NOTE: No amendment, other than to make the provisional application comply with the patent statute and all applicable regulations, may be made to the

provisional application after the filing date of the provisional application. See 37 CFR 1.53(c).

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III. < INFORMAL APPLICATIONS

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

OIPE accords a filing date, as of the date indicated by the "Office Date" stamp (see MPEP § 505), to application papers which include a specification containing a description and at least one claim (nonprovisional applications filed under 37 CFR 1.53(b)), and a drawing, if necessary under 35 U.S.C. 113 (first sentence) but are informal because they do not comply with the rules or notices. In such applications, OIPE prepares a Notice of Informal Application indicating the informality and places it in the file wrapper. The TC mails the letter to applicant. Failure to correct the informality within the specified time results in abandonment of the application.

The letter of transmittal accompanying the filing of continuing applications should include such additional information as the identification by application number of a provisional or parent application, its status, and location (if known) in the U.S. Patent and Trademark Office. The supplying of this information will simplify the processing of these applications.

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506.02 Review of Refusal To Accord Filing Date

The filing date of the provisional or nonprovisional application is the date of receipt in the Office of the application which includes a specification containing description pursuant to 37 CFR 1.71 and at least one claim (required for nonprovisional applications only) pursuant to 37 CFR 1.75, and any drawings required by 37 CFR 1.81(a). See 37 CFR 1.53(b) and (c).

If any of these items are missing, applicant will be notified to file them and the filing date will be the date of receipt of the missing part(s). If the oath or declaration for a nonprovisional application was executed and filed with the application, a supplemental oath or declaration by the inventor is required in some circumstances, e.g., where the missing item is the claim,

specification, or a drawing. The supplemental declaration must identify the missing item and indicate, as appropriate, that it accurately claims, describes, or illustrates applicant's invention. See MPEP § 601.01(d)-(g) where the application is filed without all the pages of the specification, without at least one claim (nonprovisional application), without drawings, or without all the figures of the drawings. An error in or failure to identify inventorship does not raise a filing date issue.

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

For applications properly filed under 37 CFR 1.10, the filing date is the date that the application was deposited as "Express Mail" in the U.S. Postal Service. For example, if a new patent application is deposited in "Express Mail" in accordance with 37 CFR 1.10 on a Saturday and the United States Postal Service gives it a date of deposit of Saturday, the Office will accord and stamp the correspondence with the Saturday date. 37 CFR 1.6(a)(2). If the proper procedures were not followed, the application will receive a filing date as of the date it was received in the Office. Any review of these matters would be by way of petition, accompanied by the petition fee (37 CFR 1.17(h)), providing whatever arguments and evidence petitioner has that the application is entitled to a filing date as of the date it was deposited as "Express Mail."

Petitions relating to the filing date accorded to patent applications under 37 CFR 1.53 are decided in the Office of the Deputy Commissioner for Patent Examination Policy (See MPEP § 1002.02(b)), with the exception of petitions relating to the filing date accorded to a design application, which are decided by the Director of Technology Center 2900. See MPEP § 1002.02(c)(3).

Any petition under this section should be marked to the attention of the Office of Patent Legal Administration.

507 Drawing Review in the Office of Initial Patent Examination [R-2]

The Office has revised the drawing review process to implement the eighteen-month publication of patent applications. Under the revised drawing review process, the Office of Initial Patent Examination (OIPE) performs an initial review of drawings in new utility and plant patent applications filed on or after November 29, 2000 to see if the drawings can be effectively scanned for publication purposes. Design applications are not published. Therefore, drawings filed in design patent applications (whether filed before, on or after November 29, 2000) will be reviewed but not for publication purposes. The standard of review employed by OIPE is such that most drawings, including those that have been indicated by applicant to be informal drawings, will be accepted.

OIPE inspects the drawings to see if they can be effectively scanned and adequately reproduced. If the drawings are not acceptable, OIPE will object to the drawings and notify applicant that a timely submission of acceptable drawings (e.g., drawings which can be scanned) is required. This initial review process in OIPE is necessary in order to ensure that applications can be timely published.

Under the OIPE review process, OIPE may object to and require corrected drawings within a set time period, if the drawings:

(A) have a line quality that is too light to be reproduced (weight of all lines and letters must be heavy enough to permit adequate reproduction) or text that is illegible (reference characters, sheet numbers, and view numbers must be plain and legible). See 37 CFR 1.84(l) and (p)(1);

(B) have missing lead lines. See 37 CFR 1.84(q). Lead lines are those lines between the reference characters and the details referred to;

(C) contain excessive text or text that is not in English (including, for example, a flow chart that was originally not in English that has been marked up to include the English text). See 37 CFR 1.84(o) and (p)(2) and 37 CFR 1.52(d)(1);

(D) do not have the appropriate margin or are not on the correct size paper. See 37 CFR 1.84(f) and (g). Each sheet must include a top margin of at least 2.5 cm. (1 inch), a left size margin of at least 2.5 cm. (1 inch), a right size margin of at least 1.5 cm. (5/8 inch),

and a bottom margin of at least 1.0 cm. (3/8 inch). The size of the sheets on which drawings are made must be either 21.0 cm. by 29.7 cm. (DIN size A4) or 21.6 cm. by 27.9 cm. (8-1/2 by 11 inches);

(E) have more than one figure and each figure is not labeled “Fig.” With a consecutive Arabic numeral (1, 2, etc.) or an Arabic numeral and capital letter in the English alphabet (A, B, etc.). See 37 CFR 1.84(u)(1);

(F) include photographs of the claimed invention which are capable of illustration by other medium such as ink drawings, and which are illegible after scanning. See 37 CFR 1.84(b); and

(G) contain color drawings or color photographs, but not a petition to accept color drawings/photographs. Note that the requirement under 37 CFR 1.84(a)(2)(iii) and 37 CFR 1.165(b) for a black and white photocopy of any color drawings/photographs has been waived. See 1246 O.G. 106 (May 22, 2001).

If OIPE objects to the drawings and sends applicant a Notice requiring submission of corrected drawings within a set time period (usually two months), corrected drawings must be filed, in paper, to the mailing address set forth in the Notice, along with any other items required by OIPE, to avoid abandonment of the application. No fee will be necessary for filing corrected drawings which are required by OIPE. Otherwise, in most situations, patent application publications and patents will reflect the quality of the drawings that are included with a patent application on filing unless applicant voluntarily submits better quality drawings as set forth below.

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I. < VOLUNTARY SUBMISSION OF REPLACEMENT DRAWINGS FOR PURPOSES OF PATENT APPLICATION PUBLICATION

As noted above, for the vast majority of applications, corrected or new drawings will not be required, and the application will be published with the originally filed drawings. Although the initial submission of high quality drawings is certainly encouraged, the USPTO will not require applicant to submit “formal drawings” for purposes of publication of the application.

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II. < REPLACEMENT DRAWINGS SUBMITTED ON PAPER

Applicant may submit replacement drawings within the later of one month from the filing date of the application, or fourteen months from the earliest filing date for which a benefit is sought under Title 35, United States Code. The replacement paper drawings must be filed in an envelope addressed to **>Mail Stop PGPUB Drawings, Commissioner for Patents, P.O. BOX 1450, Alexandria, Virginia 22313-1450<, with a petition under 37 CFR 1.182 requesting entry of the drawings, and the petition fee set forth in 37 CFR 1.17(h). If such replacement drawings are properly and timely submitted, the patent application publication shall include the replacement drawings. Replacement drawings that are received later than this date may still be included in the patent application publication, where practicable, if the USPTO has not started the patent application publication process when the paper drawings and the appropriate fee are received.

**>Mail Stop PGPUB Drawings< should only be used for filing replacement drawings for inclusion in a patent application publication. The replacement drawings should be accompanied by a transmittal letter identifying the application to which the replacement drawings are directed and either an authorization to charge the petition fee or other payment of the petition fee. Replacement drawings received in this special *>mail stop< will be scanned and included in the electronic document which will be used for the patent application publication. After the replacement drawings are scanned for the patent application publication, they will be made of record in the application file. Replacement drawings that are not mailed to the special *>mail stop<, or are filed without the appropriate petition fee, or are untimely submitted, will be routed to, and made of record in the application file ** and will not be included in the patent application publication. Other papers, such as amendments to the application, amended titles or status inquiries should not be included with the replacement drawings addressed to **>Mail Stop PGPUB Drawings<. By including any such other items with the replacement drawings may result in the replacement drawings not being scanned for purposes of the patent application

publication. Replacement drawings for unrelated applications must be submitted in separate envelopes to ensure that the replacement drawings are associated with the proper application file prior to publication.

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III. < REPLACEMENT DRAWINGS SUBMITTED WITH A SPECIFICATION THROUGH THE ELECTRONIC FILING SYSTEM

Applicant may also submit replacement drawings in electronic form by submitting the drawings with a copy of the application, as amended during prosecution, for publication via the Electronic Filing System (EFS). Pursuant to 37 CFR 1.215(c), the EFS submission must be filed within the later of one month from the filing date of the application, or fourteen months from the earliest filing date for which a benefit is sought under Title 35, United States Code. A paper copy of the replacement drawings must also be filed in the application within the time period noted above. The paper replacement drawings must be placed in an envelope addressed to **>Mail Stop PGPUB Drawings, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450<. Since the replacement drawings was also submitted via EFS, a petition under 37 CFR 1.182 requesting entry of the drawings, and the petition fee set forth in 37 CFR 1.17(h) will not be required with the submission of the paper copy of the replacement drawings. The replacement drawings submitted via EFS should be submitted in accordance with the instructions for EFS submissions. Information on EFS submissions can be obtained at <http://www.uspto.gov/ebc/efs/>. If such paper or EFS replacement drawings are properly and timely submitted, the patent application publication shall include the replacement drawings. Replacement drawings that are received later than this date may be included in the patent application publication, where practicable, if the USPTO has not started the patent application publication process when the EFS replacement drawings are received. See 37 CFR 1.215(c).

508 Distribution [R-2]

**>All applications filed on or after June 30, 2003, are electronically scanned and loaded into the Image File Wrapper (IFW) system. Once documents are

loaded into the IFW system, examiners, technical support staff, and other Office personnel will perform further processing and examination using the IFW system.

For handling of models, exhibits, and specimen,< see MPEP § 608.03 and § 608.03(a).

508.01 Papers Sent to Wrong Technology Center (TC) [R-2]

If drawings, amendments, or other papers are delivered to the wrong TC, the TC to which this application is assigned should be obtained from PALM and be placed on the paper and then forwarded to the appropriate TC. The TC to which the application is assigned as indicated by PALM may be verified by calling the TC as indicated before forwarding the paper. >For Image File Wrapper (IFW) processing, see IFW Manual.<

508.02 Papers Received After Patenting or Abandonment [R-2]

After an application is patented or abandoned, any incoming communication which is not to become part of the record will be returned to the sender by the Technology Center. >For Image File Wrapper (IFW) processing, see IFW Manual.<

508.03 Unmatched Papers [R-2]

>For Image File Wrapper (IFW) processing, see IFW Manual. Effective December 1, 2003, no official paper which relates to a pending application may be personally delivered to a Technology Center (TC) except papers that are directed to an application subject to a secrecy order pursuant to 35 U.S.C. 181, or are national security classified and that are directed to Licensing and Review. See MPEP § 502.< Unmatched papers for nonprovisional applications >(maintained in paper application files)< within a **>TC< should be frequently reviewed to determine which should be sent to the Paper Correlating Office (PCO).

Item I below treats the papers in the “Application number too high” category. Items II-VI below are directed to all other unmatched papers not in the “Application number too high” category.

I. UNMATCHED PAPERS IN THE “APPLICATION NUMBER TOO HIGH” CATEGORY

This collection of papers being held by the TC should be reviewed *at least* once a week. Any paper having an application number which clearly should have already been received by the TC should be removed from this collection. Where the TC does not have a corresponding application for any of these papers, inquiry should be made of the Office of Initial Patent Examination (OIPE) to determine the TC of record. If another TC number is indicated, the paper should be forwarded to that TC. If OIPE does not yield a new TC number for the indicated application number, the paper should be sent to the PCO.

II. UNMATCHED PAPERS HAVING AN APPLICATION NUMBER

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

III. UNMATCHED PAPERS RELATING TO APPLICATIONS ABANDONED FROM TC

The application file should be ordered from Files Repository. If the file is not received therefrom, the paper should be forwarded to the PCO.

IV. PAPERS FOR APPLICATIONS WHICH HAVE BEEN SENT TO PUBLISHING DIVISION

All papers for applications which PALM indicates to be located in any of the locations 7400 through 7650 should be forwarded to the Publishing Division.

The instructions of this paragraph (IV) apply to all files in issue including those which have been assigned a patent number and issue date. Papers

requiring examiner review and action will be returned to the TC after Publishing Division personnel have matched the paper to the appropriate file.

V. PAPERS FOR APPLICATIONS WHICH HAVE BEEN SENT TO THE FILE INFORMATION UNIT (RECORD ROOM)

If PALM indicates that the application to which a paper relates is in the File Information Unit (Record Room) (location code 9210), the paper should be forwarded to the PCO for response.

VI. UNMATCHED PAPERS FOR APPLICATIONS WHICH ARE KNOWN TO BE PENDING IN THE TC BUT CANNOT BE LOCATED

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

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

508.04 Unlocatable Patent or Application Files [R-2]

37 CFR 1.251. Unlocatable file.

(a) In the event that the Office cannot locate the file of an application, patent, or other patent-related proceeding after a reasonable search, the Office will notify the applicant or patentee and set a time period within which the applicant or patentee must comply with the notice in accordance with one of paragraphs (a)(1), (a)(2), or (a)(3) of this section.

(1) Applicant or patentee may comply with a notice under this section by providing:

(i) A copy of the applicant's or patentee's record (if any) of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding (except for U.S. patent documents);

(ii) A list of such correspondence; and

(iii) A statement that the copy is a complete and accurate copy of the applicant's or patentee's record of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding (except for U.S. patent documents), and whether applicant or patentee is aware of any correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding that is not among applicant's or patentee's records.

(2) Applicant or patentee may comply with a notice under this section by:

(i) Producing the applicant's or patentee's record (if any) of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding for the Office to copy (except for U.S. patent documents); and

(ii) Providing a statement that the papers produced by applicant or patentee are applicant's or patentee's complete record of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding (except for U.S. patent documents), and whether applicant or patentee is aware of any correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding that is not among applicant's or patentee's records.

(3) If applicant or patentee does not possess any record of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding, applicant or patentee must comply with a notice under this section by providing a statement that applicant or patentee does not possess any record of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding.

(b) With regard to a pending application, failure to comply with one of paragraphs (a)(1), (a)(2), or (a)(3) of this section within the time period set in the notice will result in abandonment of the application.

37 CFR 1.251 sets forth a procedure for the reconstruction of the file of a patent application, patent, or any other patent-related proceeding that cannot be located after a reasonable search. The phrase "an application" in 37 CFR 1.251 applies to any type of application (national or international), and regardless of the status (pending or abandoned) of the application

37 CFR 1.251(a) provides that in the event the Office cannot locate the file of an application, patent, or any other patent-related proceeding after a reasonable search, the Office will notify the applicant or patentee and set a time period within which the applicant or patentee must comply with the notice. The applicant or patentee may comply with a notice under 37 CFR 1.251 by providing: (1) a copy of his or her record (if any) of all of the correspondence between the Office and the applicant or patentee for such appli-

cation, patent, or other proceeding (except for U.S. patent documents); (2) a list of such correspondence; and (3) a statement that the copy is a complete and accurate copy of the applicant's or patentee's record of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding (except for U.S. patent documents), and whether applicant or patentee is aware of any correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding that is not among applicant's or patentee's records (37 CFR 1.251(a)(1)). The applicant or patentee may also comply with a notice under 37 CFR 1.251 by: (1) producing his or her record (if any) of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding for the Office to copy (except for U.S. patent documents); and (2) providing a statement that the papers produced by applicant or patentee are applicant's or patentee's complete record of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding (except for U.S. patent documents), and whether applicant or patentee is aware of any correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding that is not among applicant's or patentee's records (37 CFR 1.251(a)(2)). If applicant or patentee does not possess any record of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding, the applicant or patentee must comply with a notice under 37 CFR 1.251 by providing a statement that applicant or patentee does not possess any record of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding (37 CFR 1.251(a)(3)).

According to 37 CFR 1.251(a), if the applicant or patentee possesses all or just some of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding, the applicant or patentee is to reply by providing a copy of (or producing) his or her record of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding (37 CFR 1.251(a)(1) or (a)(2)). If applicant or patentee does not possess any record of the correspondence between the Office and the applicant

or patentee for such application, patent, or other proceeding, the applicant or patentee is to reply with a statement to that effect (37 CFR 1.251(a)(3)).

If an applicant or patentee decides to produce his or her record of the correspondence between the Office and the applicant or patentee for the application, patent, or other proceeding for copying by the Office under 37 CFR 1.251(a)(2) (rather than provide a copy under 37 CFR 1.251(a)(1)), the record should be brought to the Customer Service Center in the Office of Initial Patent Examination (Crystal Plaza 2, 2011 South Clark Place, Arlington, VA 22202).

The Office will set a time period of three months for reply in a notice under 37 CFR 1.251 in an application. The time period will be extendable under 37 CFR 1.136(a) (unless the notice indicates otherwise) by three months up to a maximum period for reply of six months in an application. See 35 U.S.C. 133. If, however, an applicant fails to reply to a notice under 37 CFR 1.251 within three months of its mailing date, any patent term adjustment under 35 U.S.C. 154(b) will be reduced by a period equal to the number of days (if any) beginning on the day after the date that is three months after the mailing date of the notice under 37 CFR 1.251 and ending on the date the reply to the notice under 37 CFR 1.251 was filed. See 35 U.S.C. 154(b)(2)(C)(ii) and 37 CFR 1.704(b). The Office will set a time period of six months for reply in a notice under 37 CFR 1.251 in a patent. The time period will **not** be extendable under 37 CFR 1.136(a) in a patent because 35 U.S.C. 41(a)(8) only authorizes the Office to charge fees for extensions of time in proceedings involving an application.

37 CFR 1.251 generally applies only to situations in which the file of an application or patent (not just certain documents) is unlocatable. When a document is missing from an application, Office practice is to call the applicant's representative and request submission (generally by facsimile) of a copy of the missing document. While the Office will generally treat missing documents in this relatively informal manner (rather than issuing a notice under 37 CFR 1.251), the Office may issue a notice under 37 CFR 1.251 to obtain a copy of a missing document if the Office's informal attempts to obtain a copy of the document are unsuccessful. The notice under 37 CFR 1.251 will include a printout of the contents entries from the Office's PALM system.

Any appendix or information disclosure statement submitted with an application is not contained in the Office's PACR database. Therefore, the applicant or patentee must also provide a copy of any appendix or information disclosure statement (except in the limited circumstance discussed below) submitted with the application. Since the Office can obtain copies of U.S. patent documents (U.S. patent application publications and patents) from its internal databases, the Office is not requiring applicants or patentees to provide copies of U.S. patent application publications and patents that are among the applicant's or patentee's record of the correspondence between the Office and the applicant or patentee for the application, patent, or other proceeding.

37 CFR 1.251(b) provides that with regard to a pending application, the **failure** to provide a reply to such a notice within the time period set in the notice will result in **abandonment** of the application. While abandonment (or expiration or lapse) of a patent is not an issue if a patentee fails to timely comply with a notice under 37 CFR 1.251, in such a situation the only certified copy of the patent file that the Office will be able to produce will be a copy of the patent and a copy of the application-as-filed (which may have an adverse impact during attempts to enforce the patent). In addition, if the patent is involved in a proceeding before the Office, the Office may take action under 37 CFR 1.616 or 37 CFR 10.18.

509 Payment of Fees [R-2]

The latest fee schedule is available by contacting the USPTO at 1-800-PTO(786)-9199 or (703) 308-HELP(4357), or on the USPTO webpage at <http://www.uspto.gov>.

37 CFR 1.22. Fees payable in advance.

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

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

§ 1.5(a) do not apply to the resubmission of fees returned pursuant to this paragraph.<

37 CFR 1.23. Method of payment.

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

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

37 CFR 1.26. Refunds.

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(a) The Director may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee. The Office will not refund amounts of twenty-five dollars or less unless a refund is specifically requested, and will not notify the payor of such amounts. If a party paying a fee or requesting a refund does not provide the banking information necessary for making refunds by electronic funds transfer (31 U.S.C. 3332 and 31 CFR part 208), or instruct the Office that refunds are to be credited to a deposit account, the Director may require such information, or use the banking information on the payment instrument to make a refund. Any refund of a fee paid by credit card will be by a credit to the credit card account to which the fee was charged.<

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

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(c) If the Director decides not to institute a reexamination proceeding, for *ex parte* reexaminations filed under § 1.510, a refund of \$1,690 will be made to the reexamination requester. For *inter partes* reexaminations filed under § 1.913, a refund of \$7,970 will be made to the reexamination requester. The reexamination requester should indicate the form in which any refund should be made (*e.g.*, by check, electronic funds transfer, credit to a deposit account, etc.). Generally, reexamination refunds will be issued in the form that the original payment was provided.<

Where the Office has notified an applicant, in writing, that a fee is due and has specified a particular dollar amount for that fee, if the applicant timely submits the specified fee amount in response to the notice, the applicant should be considered to have complied with the notice so as to avoid abandonment of the application. If the fee paid by the applicant is insufficient, either because the notice specified an incorrect dollar amount for the fee or because of a fee increase effective after the mailing of the notice and before payment of the fee by the applicant, the applicant should be notified in writing by the Office of the fee insufficiency and given a new time period in which to submit the remaining balance. The written notification of the fee insufficiency should set forth the reason (*i.e.*, the fee amount indicated by the Office in the earlier notice was incorrect or the fees have increased since the earlier notice was mailed) why applicant is being required to submit an additional fee.

37 CFR 1.22(b) sets forth that fees must be itemized in such a manner that it is clear for which purpose fees are paid. The Office may return fees that are not itemized. The intent of the fee itemization requirement is to encourage a better explanation by applicants of how fees being paid are to be applied by the Office. This will allow Office employees to properly account for the fees being paid by applicants. It should be noted that the language of 37 CFR 1.22 is not intended to create a problem when it is clear what fee is needed. A reference to "filing fee(s)" would be sufficient to cover filing fees of all different types of applications and all types of claims. Further, in a paper submitted on a date later than the actual filing date, the reference to "filing fee(s)" would also be sufficient to cover the surcharge under 37 CFR 1.16, as the surcharge is also required to make the application complete. A reference to "any corresponding fee under 37 CFR 1.16" would be sufficient to cover any fee (*e.g.*, surcharge, excess claims fees) under

37 CFR 1.16. In a petition for an extension of time filed without a specifically itemized fee, but with a general authorization to charge a deposit account, it is clear that a fee for an extension of time is needed and the deposit account should be charged the appropriate extension of time fee.

PAYMENT BY CREDIT CARD

Effective June 5, 2000, 37 CFR 1.23 was amended to permit payment of any patent process fee, trademark process fee, or information product fee by credit card, subject to actual collection of the fee. The Office currently accepts charges to the following credit cards: AMERICAN EXPRESS®, DISCOVER®, MASTER CARD®, and VISA®.

Credit Card Payment Form (PTO-2038) should be used when paying a patent process or trademark process fee (or the fee for an information product) by credit card. >Form PTO-2038 may be downloaded at <http://www.uspto.gov/web/forms/2038.pdf>.< The Office will not include the Credit Card Payment Form (PTO-2038) among the records open to public inspection in the file of a patent, trademark registration, or other proceeding. The Office does **not** require customers to use this form when paying a patent process or trademark process fee by credit card. If a customer provides a credit card charge authorization in another form or document (e.g., a communication relating to the patent or trademark), the credit card information may become part of the record of an Office file that is

open to public inspection. Thus, failure to use the Credit Card Payment Form (PTO-2038) when submitting a credit card payment may result in your credit card information becoming part of the record of an Office file that is open to public inspection.

Credit card payments by facsimile are permitted, except in situations in which facsimile submission of correspondence is not permitted in 37 CFR 1.6(d).

35 U.S.C. 42(d) and 37 CFR 1.26 (which concern refund of patent and trademark fees) also apply to requests for refund of fees paid by credit card. Any refund of a fee paid by credit card will be by a credit to the credit card account to which the fee was charged. See 37 CFR 1.26(a).

Any payment of a patent process or trademark process fee by credit card must be in writing (see 37 CFR 1.2), preferably on the Credit Card Payment Form (PTO-2038). If a Credit Card Payment Form or other document authorizing the Office to charge a patent process or trademark process fee to a credit card does not contain the information necessary to charge the fee to the credit card, the customer must submit a revised Credit Card Payment Form or document containing the necessary information. Office employees will **not** accept oral (telephonic) instructions to complete the Credit Card Payment Form or otherwise charge a patent process or trademark process fee (as opposed to information product or service fees) to a credit card.

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PTO-2038 (02-2003)

Approved for use through 02/28/2006. OMB 0651-0043

United States Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

United States Patent and Trademark Office
Credit Card Payment Form
Please Read Instructions before Completing this Form

Credit Card Information			
Credit Card Type: <input type="checkbox"/> Visa <input type="checkbox"/> MasterCard <input type="checkbox"/> American Express <input type="checkbox"/> Discover			
Credit Card Account #:			
Credit Card Expiration Date:			
Name as it Appears on Credit Card:			
Payment Amount: \$ (US Dollars):			
Cardholder Signature:		Date:	
<small>Refund Policy: The Office may refund a fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee will not entitle a party to a refund of such fee. The office will not refund amounts of \$25.00 or less unless a refund is specifically requested, and will not notify the payor of such amounts (37 CFR § 1.26). Refund of a fee paid by credit card will be issued as a credit to the credit card account to which the fee was charged. Service Charge: There is a \$50.00 service charge for processing each payment refused (including a check returned "unpaid") or charged back by a financial institution (37 CFR § 1.21 (m)).</small>			
Street Address 1:			
Street Address 2:			
City:			
State/Province:		Zip/Postal Code:	
Country:			
Daytime Phone #:		Fax #:	
Request and Payment Information			
Description of Request and Payment Information:			
<input type="checkbox"/> Patent Fee	<input type="checkbox"/> Patent Maintenance Fee	<input type="checkbox"/> Trademark Fee	<input type="checkbox"/> Other Fee
Application No.	Application No.	Application No.	IDON Customer No.
Patent No.	Patent No.	Registration No.	
Attorney Docket No.		Identify or Describe Mark	

If the cardholder includes a credit card number on any form or document other than the Credit Card Payment Form, the United States Patent and Trademark Office will not be liable in the event that the credit card number becomes public knowledge.

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509.01 Deposit Accounts [R-2]

37 CFR 1.25. Deposit accounts.

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

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

(c) If the Director decides not to institute a reexamination proceeding, for *ex parte* reexaminations filed under § 1.510, a refund of \$1,690 will be made to the reexamination requester. For *inter partes* reexaminations filed under § 1.913, a refund of \$7,970 will be made to the reexamination requester. The reexamination requester should indicate the form in which any refund should be made (*e.g.*, by check, electronic funds transfer, credit to a deposit account, etc.). Generally, reexamination refunds will be issued in the form that the original payment was provided.<

An overdrawn account will be immediately suspended and no charges will be accepted against it until a proper balance is restored, together with a payment of \$10 (37 CFR 1.21(b)(1)) to cover the work done by the U.S. Patent and Trademark Office incident to suspending and reinstating the account and dealing with charges which may have been made in the meantime.

If there is an authorization to charge the filing fee to a deposit account which is overdrawn or has insufficient funds, a surcharge (37 CFR 1.16(e)) is required in addition to payment of the filing fee. Failure to

timely pay the filing fee and surcharge will result in abandonment of the application.

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

Similarly, because of the burden placed on the U.S. Patent and Trademark Office incident to the operation of deposit accounts, a charge of \$10 (37 CFR 1.21(b)(1)) will be made for opening each new account.

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I. < DEPOSIT ACCOUNT AUTHORIZATIONS

The rules of practice were amended effective Oct. 1, 1982, at 37 CFR 1.25(b) to state that:

A general authorization to charge all fees, or only certain fees, set forth in §§ 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.

As provided in 37 CFR 1.311(b), an authorization to charge the issue fee (37 CFR 1.18) to a deposit account may be filed in an individual application only after the mailing of the notice of allowance. 37 CFR 1.25(b) also makes clear that a general authorization made prior to the mailing of a notice of allowance does not apply to issue fees under 37 CFR 1.18.

In addition, a general authorization does not apply to document supply fees under 37 CFR 1.19, such as those required for certified copies, to post issuance fees under 37 CFR 1.20, such as those required for maintenance fees, >or< to miscellaneous fees and charges under 37 CFR 1.21, such as assignment recording fees**.

Many applications contain broad language authorizing any additional fees which might have been due to be charged to a deposit account. The U.S. Patent and Trademark Office will interpret such broad authorizations to include authorization to charge to a deposit account fees set forth in 37 CFR 1.16, and 1.17. Fees under 37 CFR 1.19, 1.20, and 1.21 will not be charged as a result of a general authorization under 37 CFR 1.25. Effective November 7, 2000, fees under 37 CFR 1.18 will not be charged as a result of a preauthorization of issue fee payment.

Authorizations to charge fees relating only to a specific paper, the authorization could read “The *>Director< is hereby authorized to charge any fees under 37 CFR 1.16 and 1.17 which may be required by this paper to Deposit Account No.———.” Such authorizations would cover situations in which a check to cover a filing and/or a processing fee under 37 CFR 1.16 and 1.17 was omitted or was for an amount less than the amount required.

It is extremely important that the authorization be clear and unambiguous. If applicants file authorizations which are ambiguous and deviate from the usual forms of authorizations, the Office may not interpret the authorizations in the manner applicants intend and may return the fees. As a result, applicants could be subject to further expenses, petitions, etc. in order to have a particular fee charged to a deposit account (which was not charged as intended) or to resubmit a fee(s) due to an ambiguous authorization.

When statutory fees are to be charged to a deposit account, the processing of the application can be facilitated by submitting the applicant’s transmittal letter or other correspondence specifying the account to be charged in duplicate. Submission of these documents in duplicate will eliminate the need for the Mail Center to photocopy the document and will thereby reduce the processing time of incoming mail.

37 CFR 1.25(b) further provides that an authorization to charge fees under 37 CFR 1.16 (which relates to national application filing fees) in an application filed under 35 U.S.C. 371 will be treated as an authorization to charge fees under 37 CFR 1.492 (which relates to national stage fees). Papers filed for the purpose of entering the national stage under 35 U.S.C. 371 and 37 CFR ** 1.495 that include an authorization to charge fees under 37 CFR 1.16 are treated by the Office as an authorization to charge fees under 37 CFR 1.492 since: (1) timely payment of the appropriate national fee under 37 CFR 1.492 is necessary to avoid abandonment of the application as to the United States; and (2) the basic filing fee under 37 CFR 1.16 is not applicable to such papers or applications.

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II. DEPOSIT ACCOUNT REPLENISHMENTS

37 CFR 1.25(c) specifies how a deposit account holder may submit a payment to the Office to replenish the deposit account. A payment to replenish a deposit account may be submitted by:

(A) making the payment by electronic funds transfer through the Federal Reserve Fedwire System. Deposit account holders who use the Federal Reserve Fedwire System must provide the following information to their bank or financial institution: (1) Name of the Bank, which is Treas NYC (Treasury New York City); (2) Bank Routing Code, which is 021030004; (3) United States Patent and Trademark Office account number with the Department of Treasury, which is 13100001; and (4) the deposit account holder’s company name and deposit account number. The deposit account holder should inform his or her bank or financial institution to use due care to ensure that all pertinent account numbers are listed on the transaction because the failure to include the proper deposit account number will delay the processing of the replenishment;

(B) credit card or electronic funds transfer over the Office’s Internet web site (www.uspto.gov);

(C) mailing the payment with the United States Postal Service (USPS) to: Director of the United States Patent and Trademark Office, P.O. Box 70541, Chicago, Illinois 60673; or

(D) mailing the payment with a private delivery service or hand-carrying the payment to: Director of the United States Patent and Trademark Office, Deposit Accounts, One Crystal Park, 2011 Crystal Drive, Suite 307, Arlington, Virginia 22202.

Further information on deposit account replenishment may be obtained from the Office’s Internet web site or by contacting the Deposit Account Division at (703) 305-4631.<

509.02 Small Entity Status — Definitions [R-2]

**>Under 35 U.S.C. 41(h)(1), fees charged under 35 U.S.C. 41(a) or (b) shall be reduced by 50 percent with respect to their application to any small business concern as defined under section 3 of the

Small Business Act, and to any independent inventor or nonprofit organization as defined in regulations issued by the Director.<

The fees which are reduced include patent application filing fees (37 CFR 1.16), extension of time, revival, and appeal fees (37 CFR 1.17), patent issue fees (37 CFR 1.18), statutory disclaimer fee (37 CFR 1.20(d)), and maintenance fees on patents (37 CFR 1.20). Other fees, established under section 41 (c) or (d) of Title 35, United States Code, are not reduced for small entities since such a reduction is not permitted or authorized by **>35 U.S.C. 41(h)(1)<

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

**>35 U.S.C. 41(h)(1) gives the Director the< authority to establish regulations defining independent inventors and nonprofit organizations. The Small Business Administration was given authority to establish the definition of a small business concern. A small entity for purposes of paying reduced fees is defined in 37 CFR 1.27(a) as a person, a small business concern, or a nonprofit organization. The term “person” rather than “independent inventor” is used since individuals who are not inventors but who have received some rights in the invention are intended to be covered by 37 CFR 1.27.

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

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

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

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

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

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

(ii) Meets the standards set forth in 13 CFR part 121 to be eligible for reduced patent fees. Questions related to standards for a small business concern may be directed to: Small Business Administration, Size Standards Staff, 409 Third Street, S.W., Washington, D.C. 20416.

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

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

(ii) Is either:

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

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

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

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

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

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

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

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I. < PERSON

37 CFR 1.27(a)(1) defines a person as any inventor or other individual (e.g., an individual to whom an inventor has transferred some rights in the invention), who has not assigned, granted, conveyed, or licensed, and is under no obligation under contract or law to assign, grant, convey, or license, any rights in the invention. An inventor or other individual who has transferred some rights, or is under an obligation to transfer some rights in the invention to one or more parties, can also qualify for small entity status if all the parties who have had rights in the invention transferred to them also qualify for small entity status either as a person, small business concern, or non-profit organization.

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II. < SMALL BUSINESS CONCERN

In order to be eligible for reduced patent fees as a “small business concern” under 37 CFR 1.27(a)(2), a business concern must meet the standards set forth in 13 CFR Part 121. Questions relating to standards for a small business concern may be directed to:

Small Business Administration
 **>Office of Size Standards<
 409 Third Street, S.W.
 Washington, DC 20416
 (202)205-6618
 >E-mail: sizestandards@sba.gov

III. < NONPROFIT ORGANIZATIONS

37 CFR 1.27(a)(3) defines a nonprofit organization by utilizing and interpreting the definition contained in 35 U.S.C. 201(i). The term “university or other institution of higher education” as used in 37 CFR 1.27(a)(3)(ii)(A) means an educational institution which

(A) admits as regular students only persons having a certificate of graduation from a school providing secondary education, or the recognized equivalent of such a certificate,

(B) is legally authorized within the jurisdiction in which it operates to provide a program of education beyond secondary education,

(C) provides an educational program for which it awards a bachelor’s degree or provides not less than a 2-year program which is acceptable for full credit toward such a degree,

(D) is a public or other nonprofit institution, and

(E) is accredited by a nationally recognized accrediting agency or association>, or if not so accredited, is an institution that has been granted pre-accreditation status by such agency or association that has been recognized by the Secretary for the granting of preaccreditation status, and the Secretary has determined that there is satisfactory assurance that the institution will meet the accreditation standards of such an agency or association within a reasonable time<.

The definition of “university or other institution of higher education” as set forth herein essentially follows the definition of “institution of higher education” contained in 20 U.S.C. *>1000<. Institutions which are strictly research facilities, manufacturing facilities, service organizations, etc., are not intended to be included within the term “other institution of higher education” even though such institutions may perform an educational function or publish the results of their work.

Nonprofit organizations also include organizations of the type described in section 501(c)(3) of the Internal Revenue Code of 1986 (26 U.S.C. 501(c)(3)) and which are exempt from taxation under 26 U.S.C. 501(a). Organizations described in 26 U.S.C. 501(c)(3) include corporations, and any community chest, fund, or foundation, organized and operated exclusively for religious, charitable, scientific, testing for public safety, literary, or educational purposes, or to foster national or international amateur sports competition (but only if no part of its activities involve the provision of athletic facilities or equipment), or for the prevention of cruelty to children or animals, no part of the net earnings of which inures to the benefit of any private shareholder or individual, no substantial part of the activities of which is carrying on propaganda, or otherwise attempting to influence legislation >(limited exceptions may apply under 26 U.S.C. 501(h)< and which does not participate in, or intervene in (including the publishing or distributing of statements), any political campaign on behalf of >(or in opposition to)< any candidate for public office.

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IV. < LOCATION OF SMALL ENTITY

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

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V. < RIGHTS IN THE INVENTION AND TRANSFER OF RIGHTS

The “rights in the invention” under 37 CFR 1.27(a)(1), (a)(2)(i), and (a)(3)(i) are the rights in the United States. Rights in the invention include the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States. Therefore, for example, status as a small entity is lost by an inventor who has transferred or has an obligation to transfer a shop right to an employer who could not qualify as a small entity.

Individual inventors (37 CFR 1.27(a)(1)), small business concerns (37 CFR 1.27(a)(2)), and nonprofit organizations (37 CFR 1.27(a)(3)) can make an assignment, grant, conveyance, or license of partial rights in the invention to another individual(s), small business concern, or nonprofit organization who could qualify as a person (37 CFR 1.27(a)(1)), small business concern, or nonprofit organization. Under the circumstances described, the individual inventor, small business concern, or nonprofit organization could still qualify for small entity status. However, if the individual inventor, small business concern, or nonprofit organization assigned, granted, conveyed, or licensed, or came under an obligation to assign, grant, convey, or license, any rights to the invention to any individual, small business concern, or nonprofit organization which would not qualify as a small entity (37 CFR 1.27(a)), then the inventor, small business concern, or nonprofit organization would no longer qualify for small entity status.

With regard to transfer of rights in the invention, the rights in question are those in the United States to be covered by an application or patent. Transfer of rights to a Japanese patent, for example, would not

affect small entity status if no rights in the United States to a corresponding patent were likewise transferred.

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

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

The term “license” in the definitions includes non-exclusive as well as exclusive licenses and royalty free as well as royalty generating licenses. Implied licenses to use and resell patented articles purchased from a small entity, however, will not preclude the proper claiming of small entity status. Likewise, an order by an applicant to a firm to build a prototype machine or product for the applicant’s own use is not considered to constitute a license for purposes of the definitions. >A grant of a non-exclusive license to a large entity will disqualify applicant from claiming small entity status. See *Ulead Systems, Inc. v. Lex Computer & Management Corp.*, 351 F.3d 1139, 1142, 69 USPQ2d 1097, 1099 (Fed. Cir. 2003).

VI. < RIGHTS HELD BY GOVERNMENT ORGANIZATIONS

Also, although the Federal government agencies do not qualify as nonprofit organizations for paying reduced fees under the rules, a license to a Federal agency resulting from a funding agreement with the agency pursuant to 35 U.S.C. 202(c)(4) will not preclude the proper claiming of small entity status. Furthermore, a license to the Government resulting from a rights determination under Executive Order 10096 does not constitute a license so as to prohibit claiming small entity status by a person under 37 CFR 1.27(a)(1).

Public Law 96-517 added a new chapter 18 of Title 35 of the United States Code entitled “Patent Rights in

Inventions Made With Federal Assistance.” Under the provisions of the statute, each funding agreement between a Federal agency and an individual, small business firm, or nonprofit organization must provide, *inter alia*, that “. . . the Federal agency shall have a nonexclusive, nontransferable, irrevocable, paid-up license to practice or have practiced for or on behalf of the United States any subject invention . . .” See 35 U.S.C. 202(c)(4). The Federal agencies do not qualify as nonprofit organizations for paying reduced patent fees under the rules. Applying this construction to the licensing of an invention to a Federal agency by a person, small business concern, or nonprofit organization pursuant to a funding agreement under 35 U.S.C. 202(c)(4) would preclude their qualifying for paying reduced fees. This, however, would frustrate the intent of Public Law 97-247 and Public Law 96-517 when taken together.

Government organizations as such, whether domestic or foreign, cannot qualify as nonprofit organizations as defined in 37 CFR 1.27(a)(3). Thus, for example, a government research facility or other government-owned corporation could not qualify. 37 CFR 1.27(a)(3) was based upon 35 U.S.C. 201(i), as established by Public Law 96-517. The limitation to “an organization of the type described in section 501(c)(3) of the Internal Revenue Code of 1986 (26 U.S.C. 501(c)(3)) and exempt from taxation under section 501(a) of the Internal Revenue Code (26 U.S.C. 501(a))” would by its nature exclude the U.S. government and its agencies and facilities, including research facilities and government corporations. State and foreign governments and governmental agencies and facilities would be similarly excluded. 37 CFR 1.27(a)(3) is not intended to include within the definition of a nonprofit organization government organizations of any kind located in any country. A university or other institution of higher education located in any country would qualify, however, as a “nonprofit organization” under 37 CFR 1.27(a)(3) even though it has some government affiliation since such institutions are specifically included.

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

509.03 Claiming Small Entity Status [R-2]

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

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

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

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

- (i) Be clearly identifiable;
- (ii) Be signed (see paragraph (c)(2) of this section);

and

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

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

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

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

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

(3) *Assertion by payment of the small entity basic filing or basic national fee.* The payment, by any party, of the exact amount of one of the small entity basic filing fees set forth in §§ 1.16(a), (f), (g), (h), or (k), or one of the small entity basic national fees set forth in §§ 1.492(a)(1), (a)(2), (a)(3), (a)(4), or (a)(5), will be treated as a written assertion of entitlement to small entity status even if the type of basic filing or basic national fee is inadvertently selected in error.

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

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

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

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

(e) *Only one assertion required.*

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

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

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

made in accordance with the requirements of this section, but note paragraph (h) of this section.

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

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

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

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

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

37 CFR 1.4. Nature of correspondence and signature requirements.

(d)(2) The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any paper by a party, whether a practitioner or non-practitioner, constitutes a certification under § 10.18(b) of this chapter. Violations of § 10.18(b)(2) of this chapter by a party, whether a practitioner or non-practitioner, may result in the imposition of sanctions under § 10.18(c) of this chapter. Any practitioner violating § 10.18(b) may also be subject to disciplinary action. See §§ 10.18(d) and 10.23(c)(15).

37 CFR 10.18. Signature and certificate for correspondence filed in the Patent and Trademark Office.

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

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing

or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and

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

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;

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

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

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

In order to establish small entity status for the purpose of paying small entity fees, any party (person, small business concern or nonprofit organization) must make an assertion of entitlement to small entity status in the manner set forth in 37 CFR 1.27(c)(1) or (c)(3), in the application or patent in which such small entity fees are to be paid. Under 37 CFR 1.27, as long as all of the rights remain in small entities, the fees established for a small entity can be paid. This includes circumstances where the rights were divided between a person, a small business concern, and a nonprofit organization, or any combination thereof.

Under 37 CFR 1.4(d)(2), an assertion of entitlement to small entity status, including the mere payment of an exact small entity basic filing fee, inherently contains a certification under 37 CFR 10.18(b). It is not required that an assertion of entitlement to small entity status be filed with each fee paid. Rather, 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. 37 CFR 1.27(g)(1). Notification of a loss of entitlement to small entity status must be filed in the application or patent prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on

which status as a small entity is no longer appropriate. 37 CFR 1.27(g)(2).

Status as a small entity may be established in a provisional application by complying with 37 CFR 1.27.

Status as a small entity must be specifically established in each application or patent in which the status is available and desired. 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. The filing of an application under 37 CFR 1.53 as a continuation-in-part, continuation or division (including a continued prosecution application under 37 CFR 1.53(d)), or the filing of a reissue application requires a new assertion as to continued entitlement to small entity status for the continuing or reissue application. Submission of a request for continued examination (RCE) under 37 CFR 1.114 does not require a new determination or assertion of entitlement to small entity status since it is not a new application.

>Examiners may use the following form paragraph to notify applicant that he or she may qualify for small entity status.

¶ 5.05 *Small Entity Status*

This application may qualify for "Small Entity Status" and, therefore, applicant may be entitled to the payment of reduced fees. In order to establish small entity status for the purpose of paying small entity fees, applicant must make a determination of entitlement to small entity status under 37 CFR 1.27(f) and make an assertion of entitlement to small entity status in the manner set forth in 37 CFR 1.27(c)(1) or 37 CFR 1.27(c)(3). Accordingly, if applicant meets the requirements of 37 CFR 1.27(a), applicant must submit a written assertion of entitlement to small entity status under 37 CFR 1.27(c) before fees can be paid in the small entity amount. See 37 CFR 1.27(d). The assertion must be signed, clearly identifiable, and convey the concept of entitlement to small entity status. See 37 CFR 1.27(c)(1). No particular form is required.

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I. ASSERTION BY WRITING

Small entity status may be established by the submission of a simple written assertion of entitlement to small entity status. The assertion must be signed, clearly identifiable, and convey the concept of entitlement to small entity status. 37 CFR 1.27(c)(1). The written assertion is not required to be presented in any particular form. Written assertions of small entity

status or references to small entity fees will be liberally interpreted to represent the required assertion. The written assertion can be made in any paper filed in or with the application and need be no more than a simple sentence or a box checked on an application transmittal letter.

Practitioners may continue to use former USPTO forms or similar forms if they believe such small entity forms serve an educational purpose for their clients.

II. PARTIES WHO CAN ASSERT AND SIGN AN ENTITLEMENT TO SMALL ENTITY STATUS BY WRITING

The parties who can assert entitlement to small entity status by writing include all parties permitted by 37 CFR 1.33(b) to file a paper in an application, including a registered practitioner. 37 CFR 1.27(c)(2)(i). Additionally, one of the individuals identified as an inventor, or a partial assignee, can also sign the written assertion. 37 CFR 1.27(c)(2)(ii) and (iii). By way of example, in the case of three *pro se* inventors for a particular application, one of the three inventors upon filing the application can submit a written assertion of entitlement to small entity status and thereby establish small entity status for the application, (but see paragraph VI. below). Where rights are divided between a person, small business concern, and nonprofit organization, or any combination thereof, only one party is required to assert small entity status. For example, where one of two inventors has assigned his or her rights in the invention, it is sufficient if either of the two inventors or the assignee asserts entitlement to small entity status.

Any inventor is permitted to submit a written assertion of small entity status, including individuals identified as inventors but who are not officially named of record as an executed oath or declaration under 37 CFR 1.63 has not yet been submitted. See 37 CFR 1.41(a)(1). Where an application is filed without an executed oath or declaration pursuant to 37 CFR 1.53(f), the Office will accept the written assertion of an individual who has merely been identified as an inventor on filing of the application (e.g., application transmittal letter) as opposed to having to be named as an inventor by the filing of an executed oath or declaration under 37 CFR 1.63 (37 CFR 1.41(a)(1)). 37 CFR 1.4(d)(2) and 37 CFR 10.18(b)

are seen as sufficient basis to permit any individual to provide a written assertion so long as the individual identifies himself or herself as an inventor. An actual inventor who has not been identified as an inventor (e.g., by way of application transmittal letter) or named as an inventor (i.e., executed 37 CFR 1.63 oath or declaration) in the file record may not file a written assertion as to small entity entitlement.

Where an oath or declaration under 37 CFR 1.63 is later filed, any original written assertion as to small entity status (which has been previously appropriately submitted to the Office) will remain unless changed by an appropriate party under 37 CFR 1.27(g)(2). Where a later-filed oath or declaration under 37 CFR 1.63 sets forth an inventive entity that does not include the person who initially was identified as an inventor and who asserted small entity status, small entity status will also remain.

An assignee asserting small entity status is not required to submit a 37 CFR 3.73(b) certification whether the assignee is a partial assignee or an assignee of the entire right, title, and interest, (but see paragraph III. below).

III. PARTIES WHO CAN FILE THE WRITTEN ASSERTION ONCE SIGNED

A distinction exists as to who can file a written assertion of entitlement to small entity status once the written assertion is signed. 37 CFR 1.27(c)(2)(ii) and 37 CFR 1.33(b) permit one of several inventors to file as well as to sign a written assertion. The same is not true for a partial assignee. 37 CFR 1.27(c)(2)(iii). While a partial assignee may sign a written assertion, the written assertion must be filed by an appropriate party under 37 CFR 1.33(b).

IV. ASSERTION BY PAYMENT OF SMALL ENTITY BASIC FILING OR BASIC NATIONAL FEE

The payment of an exact small entity basic filing (37 CFR 1.16(a), (f), (g), (h), or (k)) or basic national fee (37 CFR 1.492(a)(1), (a)(2), (a)(3), (a)(4), or (a)(5)) is also considered to be a sufficient assertion of entitlement to small entity status. 37 CFR 1.27(c)(3). An applicant filing a patent application and paying an exact small entity basic filing or basic national fee automatically establishes small entity status for the application even without any other assertion of small

entity status. This is so even if an applicant inadvertently selects the wrong type of small entity basic filing or basic national fee for the application being filed (e.g., the exact small entity basic filing fee for a design application is selected but the application is a utility application). If small entity status was not established when the basic filing or basic national fee was paid, such as by payment of a large entity basic filing or basic national fee, a later claim to small entity status requires a written assertion under 37 CFR 1.27(c)(1). Payment of a small entity fee other than a small entity basic filing or basic national fee (e.g., extension of time fee, or issue fee) without inclusion of a written assertion is not sufficient.

Even though applicants can assert small entity status only by payment of an exact small entity basic filing or basic national fee, the Office encourages applicants to also file a written assertion of small entity status as well as to pay the exact amount of the small entity basic filing or basic national fee. The Office's application transmittal forms include a check box that can be used to submit a written assertion of small entity status. A written assertion will provide small entity status should applicant fail to pay the exact small entity basic filing or basic national fee. The provision providing for small entity status by payment of an exact small entity basic filing or basic national fee is intended to act as a safety net to avoid possible financial loss to inventors or small businesses that qualify for small entity status.

Even though small entity status is accorded where the wrong type of small entity basic filing fee or basic national fee is selected but the exact amount of the fee is paid, applicant still needs to pay the correct small entity amount for the basic filing or basic national fee where selection of the wrong type of fee results in a deficiency. While an accompanying general authorization to charge any additional fees suffices to pay the balance due of the proper small entity basic filing or basic national fee, specific authorizations to charge fees under 37 CFR 1.17 or extension of time fees do not suffice to pay any balance due of the proper small entity basic filing or basic national fee because they do not actually authorize payment of small entity amounts. If payment is attempted of the proper type of basic filing or basic national fee (applicant correctly identifies the type of fee for the type of application being filed), but the amount of the fee paid is not the

exact small entity fee required (an incorrect fee amount is supplied) and a written assertion of small entity status is not present, small entity status will not be accorded. The Office will mail a notice of insufficient basic filing or basic national fee with a surcharge due if an authorization to charge the basic filing or basic national fee is not present. The Office does not consider a basic filing or basic national fee submitted in an amount above the correct fee amount, but below the non-small entity fee amount, as a request to establish small entity status unless an additional written assertion is also present. The submission of a basic filing or basic national fee below the correct fee amount also does not serve to establish small entity status.

Where an application is originally filed by a party, who is in fact a small entity, with an authorization to charge fees (including basic filing or national fees) and there is no indication (assertion) of entitlement to small entity status present, that authorization is not sufficient to establish small entity status unless the authorization is specifically directed to small entity basic filing or basic national fees. The general authorization to charge fees will continue to be acted upon immediately and the full (not small entity) basic filing or basic national fees will be charged. Applicant will have three months under 37 CFR 1.28 to request a refund by asserting entitlement to small entity status. This is so even if the application is a continuing application where small entity status had been established in the prior application.

V. PARTIES WHO CAN ASSERT AND FILE SMALL ENTITY STATUS BY PAYMENT

Where small entity status is sought by way of payment of the basic filing or basic national fee, any party (including a third party), may submit payment, such as by check, and small entity status will be accorded.

VI. CONTINUED OBLIGATIONS FOR THOROUGH INVESTIGATION OF SMALL ENTITY STATUS

While small entity status is not difficult to obtain, it should be clearly understood that applicants need to do a complete and thorough investigation of all facts and circumstances before making a determination of actual entitlement to small entity status. 37 CFR 1.27(f). Where entitlement to small entity status is uncertain, it should not be claimed.

The assertion of small entity status (even by mere payment of the exact small entity basic filing fee) is not appropriate until such an investigation has been completed. For example, where there are three *pro se* inventors, before one of the inventors pays the small entity basic filing or basic national fee to establish small entity status, the single inventor asserting entitlement to small entity status should check with the other two inventors to determine whether small entity status is appropriate.

If small entity status is desired on the basis that the entity is a small business concern, the investigation should include a review of whether the business is a small business concern as defined by section 3 of the Small Business Act (Public Law 85-536 as amended by Public Law 106-50). Review of whether the business concern meets the standards set forth in 13 CFR part 121 to be eligible for reduced patent fees is also appropriate. Additionally, if the business has assigned, granted, conveyed or licensed (or is under an obligation to do so) any rights in the invention to others directly or indirectly, the same review for each other entity would also be appropriate.

Furthermore, once status as a small entity has been established in an application, a new determination of entitlement to small entity status is needed (1) when the issue fee is due and (2) when any maintenance fee is due. It should be appreciated that the costs incurred in appropriately conducting the initial and subsequent investigations may outweigh the benefit of claiming small entity status. For some applicants it may be desirable to file as a large entity (by not filing a written assertion of small entity status and by submitting large entity fees) rather than undertaking the appropriate investigations which may be both difficult and time-consuming and which may be cost effective only where several applications are involved.

The intent of 37 CFR 1.27 is that the person making the assertion of entitlement to small entity status is the person in a position to know the facts about whether or not status as a small entity can be properly established. That person, thus, has a duty to investigate the circumstances surrounding entitlement to small entity status to the fullest extent. It is important to note that small entity status must not be claimed unless the person or persons can unequivocally make the required self-certification.

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

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

Consistent with 37 CFR 1.4(d)(2), the payment of a small entity basic filing or national fee constitutes a certification under 37 CFR 10.18(b). Thus, a simple payment of the small entity basic filing or basic national fee, without a specific written assertion, activates the provisions of 37 CFR 1.4(d)(2) and, by that, invokes the self-certification requirement set forth in 37 CFR 10.18(b), regardless of whether the party is a practitioner or non-practitioner.

VII>.< REMOVAL OF STATUS

Once small entity status is 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. 37 CFR 1.27(g)(1). 37 CFR 1.27(g)(2) requires that notification of any change in status resulting in loss of entitlement to small entity status be filed in the application or patent prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity is no longer appropriate. 37 CFR 1.27(g)(2) also requires that the notification of loss of entitlement to small entity status be in the

form of a specific written assertion to that extent, rather than only payment of a large entity fee. For example, when paying the issue fee in an application that has previously been accorded small entity status and the required new determination of continued entitlement to small entity status reveals that status has been lost, applicant should not just simply pay the large issue fee or cross out the recitation of small entity status on ****>**Part B of the Notice of Allowance and Fee(s) Due (PTOL-85)**<**, but should submit a separate paper requesting removal of small entity status pursuant to 37 CFR 1.27(g)(2).

For correcting errors in small entity status, see paragraph X below.

VIII. IMPROPERLY ESTABLISHING SMALL ENTITY STATUS

37 CFR 1.27(h) indicates that any attempt to fraudulently establish status as a small entity or pay fees as a small entity will be considered as a fraud practiced or attempted on the Office. Applicants should not rely on any oral advice inadvertently given by an Office employee as to entitlement to small entity status. In addition, improperly and with intent to deceive establishing status as a small entity or paying fees as a small entity will be considered as a fraud practiced or attempted on the Office. Normally, the Office will not question a claim to status as a small entity.

IX. REFUNDS BASED ON LATER ESTABLISHMENT OF SMALL ENTITY STATUS

37 CFR 1.28(a). Refunds when small entity status is later established; how errors in small entity status are excused..

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

(b) *Date of payment.*

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

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

37 CFR 1.28(a) provides a three-month time period for requesting a refund of a portion of a large entity fee based on later establishment of small entity status. The start date of the three-month refund period of 37 CFR 1.28(a) is the date the full fee has been paid. See 37 CFR 1.28(b)(1). Payment by authorization to charge a deposit account is treated for refund purposes the same as payments by other means (e.g., check or credit card authorizations), with each being treated as paid (for refund purposes) on the date of receipt in the Office as defined by 37 CFR 1.6. Thus, the date of receipt of an authorization to charge fees starts the three-month period for refunds under 37 CFR 1.28(a), not the date of debit of the fee to a deposit account. If a payment is mailed with a Certificate of Mailing under 37 CFR 1.8, the three month period for requesting a refund will start on the actual date of receipt of the payment in the Office, and not the Certificate of Mailing date. If a payment is filed by Express Mail under 37 CFR 1.10, the date of deposit with the United States Postal Service (shown by the “date-in” on the Express Mail mailing label or other official USPS notation) is the date of receipt of the payment by the Office under 37 CFR 1.10(a) and the three month period for requesting a refund starts on the date shown by the “date-in” on the Express Mail mailing label rather than the date when the payment actually reaches the Office.

Request for refunds, along with the assertions under 37 CFR 1.27(c), should be addressed to ****>**Mail Stop 16, Director of the U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450**<**.

X. CORRECTING ERRORS IN SMALL ENTITY STATUS

37 CFR 1.28(c). Refunds when small entity status is later established; how errors in small entity status are excused

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

(c)(2) of this section, and the deficiency payment requirement of paragraph (c)(2) of this section:

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

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

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

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

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

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

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

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

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

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

37 CFR 1.28(c) provides that if small entity status is established in good faith and the small entity fees are paid in good faith, and it is later discovered that

such status as a small entity was established in error or through error the Office was not notified of a change of status, the error will be excused upon compliance with the separate submission and itemization requirements of 37 CFR 1.28(c)(1) and (c)(2), and the deficiency payment requirement of 37 CFR 1.28(c)(2). The deficiency amount owed under 37 CFR 1.28(c) is calculated using the date on which the deficiency was paid in full. See 37 CFR 1.28(b)(2).

37 CFR 1.28(c)(1) requires that a deficiency paper be limited to one application or patent file. Where, for example, the same set of facts has caused errors in payment in more than one application and/or patent file, a separate paper must be submitted in each file for which an error is to be excused.

37 CFR 1.28(c)(2) requires that for each fee that was erroneously paid as a small entity, the deficiencies owed must be paid, and the payment of the deficiencies must be itemized. The deficiency owed for each previous fee erroneously paid as a small entity is the difference between the current fee amount (for other than a small entity) on the date the deficiency is paid in full and the amount of the previous erroneous (small entity) fee payment. Where there has been a fee decrease, the deficiency owed is equal to the amount (previously) paid in error, not the difference between the amount (previously) paid in error and the new lower large entity fee. 37 CFR 1.28(c)(2)(ii) requires the following itemizations: (A) the particular fee involved (e.g., basic filing fee, extension of time fee); (B) the small entity fee amount actually paid and when (for example, distinguishing between two one-month extension of time fees erroneously paid on two different dates); (C) the actual deficiency owed for each fee previously paid in error; and (D) the total deficiency owed (i.e., the sum of the individual deficiencies owed).

Under 37 CFR 1.28(c)(3), the failure to comply with the requirements of 37 CFR 1.28(c)(1) and (c)(2) permits the Office at its option to either charge a processing fee (37 CFR 1.17(i)) to process the paper or require compliance within a one-month non-extendable time period to avoid return of the paper.

Any paper submitted under 37 CFR 1.28(c) is treated as a notification of loss of small entity status under 37 CFR 1.27(g)(2). See 37 CFR 1.28(d).

A maintenance fee improperly paid as a small entity where small entity status has been established but is no longer appropriate will be treated as a matter under 37 CFR 1.28(c) and will not be considered to involve expiration of the patent under 37 CFR 1.378. On the other hand, payment of a maintenance fee in the small entity amount where small entity status has not been established would result in the expiration of the patent under 37 CFR 1.378 unless the full maintenance fee due or a written assertion of small entity status is timely filed.

510 U.S. Patent and Trademark Office Business Hours

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

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

During working hours, all applicants, attorneys, and other members of the public should announce their presence to the Office personnel in the area of their visit. In the Technology Centers (TCs), visitors should inform the TC receptionist of their presence before visiting other areas of the TC.

FILING OF PAPERS DURING UNSCHEDULED CLOSINGS OF THE U.S. PATENT AND TRADEMARK OFFICE

37 CFR 1.9(h) provides that the definition of “Federal holiday within the District of Columbia” includes an official closing of the Office. When the entire U.S. Patent and Trademark Office is officially closed for business for an entire day, for reasons due to adverse weather or other causes, the Office will consider each such day a “Federal holiday within the District of Columbia” under 35 U.S.C. 21. Any action or fee due on such a day may be taken, or fee paid, on the next succeeding business day the Office is open. In addition, 37 CFR 1.6(a)(1) provides “[t]he Patent and Trademark Office is not open for the filing of corre-

spondence on any day that is a Saturday, Sunday or Federal holiday within the District of Columbia” to clarify that any day that is a Saturday, Sunday or Federal holiday within the District of Columbia is a day that the U.S. Patent and Trademark Office is not open for the filing of applications within the meaning of Article 4(C)(3) of the Paris Convention. Note further that in accordance with 37 CFR 1.6(a)(2), even when the Office is not open for the filing of correspondence on any day that is a Saturday, Sunday or Federal holiday within the District of Columbia, correspondence deposited as Express Mail with the United States Postal Service in accordance with 37 CFR 1.10 will be considered filed on the date of its deposit, regardless of whether that date is a Saturday, Sunday or Federal holiday within the District of Columbia (under 35 U.S.C. 21(b) or 37 CFR 1.7).

When the U.S. Patent and Trademark Office is open for business during any part of a business day between 8:30 a.m. and 5:00 p.m., papers are due on that day even though the Office may be officially closed for some period of time during the business day because of an unscheduled event. The procedures of 37 CFR 1.10 may be used for filing applications.

Information regarding whether or not the Office is officially closed on any particular day may be obtained by calling (703) 308-4357 which transposes to (703) 308-HELP.

Effective November 29, 1999, Public Law 106-113 amended 35 U.S.C. 119(e)(3) to extend the period of pendency of a provisional application to the next succeeding business day if the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia. 35 U.S.C. 119(e)(3) as amended by Public Law 106-113 applies to any provisional applications filed on or after June 8, 1995 but has no effect on any patent which is the subject of litigation in an action commenced before November 29, 1999. See also 37 CFR 1.7(b).

New patent applications filed in accordance with 37 CFR 1.10 will be stamped by the Office with the date of deposit as “Express Mail” with the United States Postal Service. For example, if a new patent application is deposited in “Express Mail” in accordance with 37 CFR 1.10 on a Saturday and the United States Postal Service gives it a date of deposit of Saturday, the Office will accord and stamp the cor-

respondence with the Saturday date. 37 CFR 1.6(a)(2).

REGULATIONS FOR THE PUBLIC USE OF RECORDS IN THE PATENT SEARCH ROOM OF THE U.S. PATENT AND TRADEMARK OFFICE

The U.S. Patent and Trademark Office has established procedures and regulations for using the facilities of the Patent Search Room. The procedures for the Search Room include the requirement that users obtain and show, prior to entering the Search Room facilities, a User Pass. This pass can be obtained at the receptionist's desk in the lobby of Crystal Plaza Building 3, 2021 South Clark Place, Arlington, VA. User Passes will be issued to persons not under prohibition from using the search facilities who sign an application form and acknowledge receipt of a copy of the noted regulations. User Passes are nontransferable and are valid until reissue or revocation for cause. Office employees must show their building pass in order to enter the Patent Search Room.

Persons exiting the Search Room will automatically pass electronic sensing equipment designed to detect any marked documents or materials being removed from the Search Room. The sensing equipment is capable of detecting marked documents and materials in briefcases and parcels and under clothing. The equipment does not use X-ray or other high energy radiation and is, therefore, completely safe and harmless to persons, photographic film, magnetic tape, and electronic or mechanical devices such as wrist watches.

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

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

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

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

USE OF TECHNOLOGY CENTER FACILITIES

The primary function of the U.S. Patent and Trademark Office is the examination of nonprovisional applications for patents and the issuance of valid patents based upon a search and consideration of the best available prior art. This can be accomplished only through maintaining strict search file integrity within the Technology Center (TC) facilities.

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

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

A copy of the following "Regulations for Users of the Technology Center Search Facilities," is posted in each of the TCs and the Patent Search Room:

REGULATIONS FOR USERS OF THE TECHNOLOGY CENTER SEARCH FACILITIES

(A) TC facilities are defined as those areas in Crystal City (Arlington, VA) where the TCs are located.

(B) The use of the TC facilities for search purposes by members of the public is strictly limited to the search of materials not available in the Patent Search Room or the Scientific and Technical Information Center (STIC) and when it does not conflict with the regular business of U.S. Patent and Trademark personnel and only between the hours of 8:45 a.m. and 4:45 p.m. on regular business days.

(C) Authorized Officials, under these regulations, include Supervisory Patent Examiners and TC Directors.

(D) Under applicable statutes and regulations, including 40 U.S.C. 486(c); 41 CFR Subpart 101-20.3; and appropriate Sections of Department Organization Orders 30-3A and 30-3B of the Department of Commerce, the regulations appearing below are established for those members of the public using the TC Facilities.

(1) All persons using these facilities are subject to the Regulations Governing Conduct on Federal Property, as specified in 41 CFR Subpart 101-20.3.

(2) All posted Official Notices are to be complied with.

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

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

(5) No patents, records, or other documents of the U.S. Patent and Trademark Office shall be removed from the TC Facilities except by express written authorization by an authorized official in the TC where the material resides. Such authorization will not be given for U.S. patents and other material readily available through the Scientific and Technical Information Center.

(6) Smoking is not permitted except in designated areas.

(7) No food or beverages in any form are to be consumed except in designated areas.

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

(9) Children brought into the TC Facilities must not be allowed to disturb others.

(10) The presence or use of equipment such as dictation equipment, reproducing machines, typewriters, and photographic equipment is prohibited without prior permission from an authorized official in the TC where the use is intended and then is permitted where its use does not conflict with regulation (8) above.

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

(12) All patent shoes must be promptly replaced in their proper location in the shoe case.

(13) All textbooks, journals, and the like must be returned to their proper location.

(14) The reserving of seats and/or working areas is prohibited.

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

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

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

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

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

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

511 Postal Service ****>Interruptions and Emergencies<** [R-2]

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

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

37 CFR 1.6. Receipt of letters and papers.

(e) *Interruptions in U.S. Postal Service.*

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 correspondence which is:

- (1) Promptly filed after the ending of the designated interruption or emergency; and
- (2) Accompanied by a statement indicating that such correspondence would have been filed on that particular date if it were not for the designated interruption or emergency in the United States Postal Service.

>In the event of a postal interruption or emergency, an announcement will be placed on the USPTO web site at www.uspto.gov, providing instructions about the filing of patent applications, and other papers related to patent applications and patents.<

37 CFR 1.6(e) provides a procedure under which correspondence (papers and fees) which could not be filed on a particular date because of an interruption or emergency in the United States Postal Service >(USPS)< which is so designated by the ****>Director<**, may be promptly filed after the ending of such a designated interruption or emergency and be considered

as having been filed on that particular date. Authority for such a practice is found in 35 U.S.C. 21(a), as amended by Public Law 97-247.

****>**Applicants are cautioned that the provisions of 35 U.S.C. 21(a) and 37 CFR 1.6(e) only apply to postal interruptions and emergencies. The provisions of 35 U.S.C. 21(a) and 37 CFR 1.6(e) do not provide for granting of a filing date to correspondence as of the date on which it would have been filed but for other exigencies, such as the unavailability of a computer or word processing equipment, or the inaccessibility of an office or building other than a USPS facility. 35 U.S.C. 21(a) requires, in part, that “any paper or fee required to be filed in the Patent and Trademark Office...would have been deposited with the United States Postal Service but for postal service interruptions or emergencies designated by the Director.” The statute requires that the correspondence was complete and ready to be deposited with the USPS on the filing date requested (e.g., complete application papers have been prepared and printed) and that the correspondence could not have been deposited with the USPS on the requested filing date for the sole reason that the postal service was not available due to the interruption or emergency designated by the Office.

In general, applicants should consider filing correspondence by facsimile when permitted. See 37 CFR 1.6(d) and MPEP § 502.01. Applicants should also consider filing correspondence with a Certificate of Mailing or a Certificate of Transmission under 37 CFR 1.8 when permitted. See MPEP § 512. Even if the post office is closed due to an emergency, applicants should ordinarily be able to deposit correspondence in a mailbox for first class mail. New applications **cannot** be transmitted by facsimile and are **not** entitled to the benefit of a Certificate of Transmission under 37 CFR 1.8. A request for a continued prosecution application (CPA) filed under 37 CFR 1.53(d) (available only for design applications) may be transmitted to the Office by facsimile (37 CFR 1.6(d)(3)); however, it is not entitled to the benefit of a Certificate of Transmission (see 37 CFR 1.8(a)(2)(i)(A)). The Office strongly recommends that applicants file new applications by “Express Mail” in accordance with 37 CFR 1.10 since such correspondence will be accorded the date of deposit in “Express Mail” with the USPS as the filing date. See 37 CFR 1.6(a) and MPEP § 513. Applications that are not

filed by “Express Mail” can only be accorded the date of receipt in the Office as the filing date (unless there is a postal interruption or emergency designated by the Office and applicants are instructed to file their applications in a manner other than by “Express Mail”). Any applicant who files an application by first class mail bears the risk of any delay in the delivery of the application to the Office, even if the delay is unusually significant due to some unforeseen event. New patent applications, computer readable format (CRF) biosequence listings, pre-grant publication submissions, and electronic information disclosure statements (e-IDS) may also be submitted to the USPTO via the Internet by using the Electronic Filing System (EFS). Information regarding EFS may be obtained via the USPTO web site at www.uspto.gov/ebs/efs/index.html.

512 Certificate of Mailing or Transmission [R-2]

37 CFR 1.8. Certificate of mailing or transmission.

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

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

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

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

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

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

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

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

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

(B) The filing of correspondence in an interference which an examiner-in-chief orders to be filed by hand or “Express Mail”;

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

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

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

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

(ii) *Reserved*

(iii) *Relative to Disciplinary Proceedings*—

(A) Correspondence filed in connection with a disciplinary proceeding under part 10 of this chapter.

(B) *Reserved*

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

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

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

Reserved

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit’s report confirming transmission may be used to support this statement.

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

A suggested format for a Certificate of Mailing and a Certificate of Transmission under 37 CFR 1.8 to be included with the correspondence is reproduced below.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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

on _____.

(Date)

Typed or printed name of person signing this certificate

Signature _____

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office (Fax No. (703)____-____)

on _____.
(Date)

Typed or printed name of person signing this certificate

Signature _____

**>

¶ 5.02 Format of Certificate of Mailing or Transmission

The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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

on _____.

(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703)____-____ on _____ (Date)

Typed or printed name of person signing this certificate:

Signature: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

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Under 37 CFR 1.8, a person may state on certain papers directed to the Office (exceptions are stated in 37 CFR 1.8), the date on which the paper will be deposited in the United States Postal Service or transmitted by facsimile. If the date stated is within the period for reply, the reply in most instances will be considered to be timely. This is true even if the paper does not actually reach the Office until after the end of the period for reply. The Certificate of Mailing procedure does not apply to papers mailed in a foreign country.

The Certificate of Transmission procedure, however, also applies to papers transmitted to the Office from a foreign country provided that the correspondence being transmitted is not prohibited from being transmitted by facsimile and is not otherwise precluded from receiving the benefits under 37 CFR 1.8.

It should be noted, however, that the Office will continue its normal practice of stamping the date of receipt ("Office Date" Stamp) on all papers received through the mail or by facsimile except those filed under 37 CFR 1.10 (See MPEP § 513). The date stamped will also be the date which is entered on Office records and from which any subsequent periods are calculated. For example, 37 CFR 1.192 gives an appellant 2 months from the date of the appeal to file an appeal brief. For example, if the last day to reply to a final rejection was November 10, 1997, and applicant deposited a Notice of Appeal with fee in the U.S. mail on November 10, 1997, and so certified, that appeal is timely even if it was not received in the U.S. Patent and Trademark Office until November 16, 1997. Since the date of receipt will be used to calculate the time at which the brief is due, the brief was

due on January 16, 1998. This is 2 months after the Mail Center date.

37 CFR 1.8(a)(2)(i)(A) specifically refers to a request for a continued prosecution application (CPA) filed under 37 CFR 1.53(d) >(available only for design applications)< as a correspondence filed for the purposes of obtaining an application filing date and the procedures and benefit set forth in 37 CFR 1.8(a)(1) are not applicable to a request for a CPA. The date on a certificate of mailing or transmission (37 CFR 1.8(a)) of a CPA is not controlling or even relevant. A CPA filed by facsimile transmission will not be accorded a filing date as of the date on the certificate of transmission unless Office records indicate, or applicant otherwise establishes pursuant to 37 CFR 1.6(f), receipt in the Office of the complete CPA on the date on the certificate of transmission and that date is not a Saturday, Sunday, or Federal holiday within the District of Columbia.

>

I. < PROCEDURE BY APPLICANT

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

(B) When possible, the certification should appear on a portion of the paper being submitted. However, if there is insufficient space to make the certification on the same paper, the certification should be on a separate sheet securely attached to the paper.

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

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

concerning the connection between the sheet and the paper filed.

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

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

Although ****>Part B of Form PTOL-85, Notice of Allowance and Fee(s) Due<**, may contain a Certificate of Mailing thereon, a separate Certificate of Mailing is required for all papers included with this form, including formal drawings******. Checks submitted with the papers do not require certification.

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

(F) For the purposes of 37 CFR 1.8(a)(1)(i)(A), first class mail is interpreted as including "Express Mail" and "Priority Mail" deposited with the U.S. Postal Service.

Alternatively, the correspondence may be submitted with a cover or transmittal letter which itemizes the papers and on which is placed the certificate under 37 CFR 1.8.

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II. < USE OF STAMPED CERTIFICATION

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

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III. < OFFICE PROCEDURE**A. Mail Center of the Office of Initial Patent Examination**

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

However, the benefits of 37 CFR 1.8 or 37 CFR 1.10 apply only to documents delivered to the Office by the U.S. Postal Service. A number of instances have been uncovered where individuals are certifying that documents were deposited with the U.S. Postal Service when, in fact, the documents were hand-carried or delivered to the Office via commercial couriers, e.g., "Federal Express," "DHL," "Purolator," "Air Borne," "UPS." In those instances where documents include a Certificate of Mailing under 37 CFR 1.8 or "Express Mail" mailing label (commonly used to comply with 37 CFR 1.10) but were delivered to the Office by other than the U.S. Postal Service, Mail Center personnel are placing a notice indicating that fact on the correspondence involved to alert Office personnel that the benefits of 37 CFR 1.8 or 37 CFR 1.10 do not apply.

B. Processing Areas

When papers are received in a **>specific location of the Office (e.g., Pre-Grant Publication Division, Office of Patent Publication, Office of Petitions - see MPEP § 502 and § 502.01)<, the date of receipt in the *>Office< is stamped on the papers in accordance with 37 CFR 1.6(a).

The date indicated on the Certificate of Mailing or of Transmission will be used by the Office only to determine if the paper was deposited in the United States Postal Service or transmitted by facsimile within the period for reply. If the paper was actually received in the Office within the period for reply, there is no need to refer to the Certificate. Note however, that 37 CFR 1.6(a)(3) provides that "[c]orrespondence transmitted by facsimile to the Patent and Trademark Office will be stamped with the date on which the complete transmission is received in the

Patent and Trademark Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the date stamped will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia."

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

In those instances where a Certificate of Mailing or of Transmission does appear in the paper or a cover letter thereto, a check should be made to determine whether the indicated date of deposit or transmission is within the period for reply. If the date indicated in the Certificate is after the end of the period for reply, the paper is untimely and no notation of the date need be made. Where the date indicated on the Certificate is within the period for reply, the paper should be considered to be timely filed. A notation should be made adjacent to the Office stamp indicating the date of receipt ("Office Date" Stamp) which notes the date stated on the Certificate. This notation should be "C of Mail" or "C of Fax" followed by the date. A paper with a certificate dated November 10, 1997, would be noted next to the "Office Date" Stamp "(C of Mail. 11/10/97)." This notation should also appear on the "Contents" portion of the file wrapper. >For Image File Wrapper (IFW) processing, see IFW Manual.<

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

It should be noted that the filing of a paper for the purpose of obtaining a continuation or division application under 37 CFR 1.53(d) >(available only for design applications)< and former 37 CFR 1.60 or 1.62 is excluded from the Certificate practice under 37 CFR 1.8(a)(2)(i)(A) since it is considered to be the filing of a national patent application.

Effective November 29, 1999, Public Law 106-113 amended 35 U.S.C. 119(e)(3) to extend the period of pendency of a provisional application to the next succeeding business day if the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia. See also 37 CFR 1.7(b). 35 U.S.C. 119(e)(3) as amended by Public Law 106-113 applies to any provisional applications filed on or after June 8, 1995 but has no effect on any patent which is the subject of litigation in an action commenced before November 29, 1999.

No benefit will be given to a Certificate of Mailing or Transmission relative to the filing of a national patent application specification and drawing or other correspondence for the purpose of obtaining an application filing date. However, note that new patent applications filed in accordance with 37 CFR 1.10 will be stamped by the Office with the date of deposit as "Express Mail" with the United States Postal Service. For example, if a new patent application is deposited as "Express Mail" in accordance with 37 CFR 1.10 on a Saturday and the United States Postal Service gives it a date of deposit of Saturday, the Office will accord and stamp the correspondence with the Saturday date. 37 CFR 1.6(a)(2).

All Certificates of Mailing or Transmission filed in applications should be placed in the file wrappers directly below the papers to which they refer. >For Image File Wrapper (IFW) processing, see IFW Manual.<

*>Office< personnel receiving a hand-delivered paper from other than U.S. Postal Service personnel should inspect the paper to ensure that the benefits of 37 CFR 1.8 or "Express Mail" benefits under 37 CFR 1.10 are not accorded in error. If the paper contains a certificate of mailing under 37 CFR 1.8 or "Express Mail" mailing label (commonly used to comply with 37 CFR 1.10), the words "HAND DELIVERED" should be written adjacent to the * date stamp.

Applicant should be notified in the next Office action when a paper containing a Certificate of Mailing has been denied the benefits under 37 CFR 1.8 or a paper containing an "Express Mail" mailing label (commonly used to comply with 37 CFR 1.10) is denied benefits under 37 CFR 1.10 by including, for example, form paragraph 5.04.

¶ 5.04 Benefit of Certificate of Mailing Denied

The [1] filed [2] is not entitled to the benefits of 37 CFR 1.[3] since it was not deposited with the U. S. Postal Service for delivery to the U.S. Patent and Trademark Office. Therefore, the date of receipt in the U.S. Patent and Trademark Office has been used to determine the timeliness of the paper.

Examiner Note:

1. This form paragraph is to be used in those situations where correspondence contains a Certificate of Mailing under 37 CFR 1.8 or requests the benefit of "Express Mail" under 37 CFR 1.10, but the correspondence was not actually deposited with the U. S. Postal Service.

2. In bracket 3, insert --8-- or --10--, as appropriate.

Misuse of a Certificate of Mailing under 37 CFR 1.8 or improperly claiming the benefit of 37 CFR 1.10 which appears to be more than a one-time, inadvertent error should be brought to the attention of the Office of Enrollment and Discipline.

>

IV. < ORIGINAL MAILED PAPER NOT DELIVERED

Paragraphs (b) and (c) of 37 CFR 1.8 concern the situation where a paper containing a Certificate was timely deposited in the U.S. mail or transmitted by facsimile, but never received by the U.S. Patent and Trademark Office. In the TCs, all submissions under these paragraphs should be considered and the sufficiency thereof determined by the TC Director. The statement required by 37 CFR 1.8(b)(3) is no longer required to be verified.

513 Deposit as Express Mail with U.S. Postal Service [R-2]

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

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

37 CFR 1.6. Receipt of correspondence.

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

(1) The Patent and Trademark Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia. Except for

correspondence transmitted by facsimile under paragraph (a)(3) of this section, or filed electronically under paragraph (a)(4) of this section, no correspondence is received in the Office on Saturdays, Sundays, or Federal holidays within the District of Columbia.

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

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

(4) **>[Reserved]<

37 CFR 1.10. Filing of correspondence by “Express Mail”.

**>

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

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

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

**>

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

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

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

(3) The petition includes a true copy of the “Express Mail” mailing label showing the “date-in,” and of any other official notation by the USPS relied upon to show the date of deposit.

**>

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

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

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

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

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

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

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

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

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(4) The petition includes a statement which establishes, to the satisfaction of the Director, the original deposit of the correspondence and that the copies of the correspondence, the copy of the “Express Mail” mailing label, the copy of any returned

postcard receipt, and any official notation entered by the USPS are true copies of the originally mailed correspondence, original "Express Mail" mailing label, returned postcard receipt, and official notation entered by the USPS.<

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

The statutory authority for the granting of a filing date based on the date of deposit for correspondence sent by "Express Mail" and received by the Office is found in section 21(a) of Title 35 of the United States Code.

The specific rule for obtaining a filing date as of the date of deposit in "Express Mail" (rather than the date of receipt at the Office) is 37 CFR 1.10 **.

>35 U.S.C. 21(a) is limited to correspondence deposited with the United States Postal Service (USPS). The procedure in 37 CFR 1.10 is limited to correspondence deposited in the "Express Mail Post Office to Addressee" service of the USPS. There are no similar provisions and no similar benefit can be obtained for correspondence deposited in International Express Mail.

I. < EFFECTIVE DATE, WEEKENDS & HOLIDAYS

Effective December 2, 1996, 37 CFR 1.6(a)(2) provides that correspondence deposited as "Express Mail" in accordance with 37 CFR 1.10 will be stamped, and, therefore, considered as filed on the date of its deposit, regardless of whether that date is a Saturday, Sunday or Federal holiday within the District of Columbia. 37 CFR 1.10 provides a procedure for assigning the date on which any paper or fee is deposited as "Express Mail" with the **>USPS< as the filing date of the paper or fee in the U.S. Patent and Trademark Office (Office). The date of deposit with the USPS is shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation. This holds true for any day that the correspondence may be accepted as "Express Mail" by the USPS, even when the paper or fee is deposited and accepted on a Saturday, Sunday or Federal holiday within the District of Columbia. For example, if a person files a patent application by "Express Mail" with the USPS on a Saturday in compliance with 37 CFR 1.10, he or she will receive the benefit of the Saturday date, even though the Office is closed on Saturdays and, therefore, the person could not have filed the

application by depositing it directly at the Office on that Saturday. See 37 CFR 1.6(a)(1). In those cases where the procedure of 37 CFR 1.10(a) has not been properly followed, e.g., the "date-in" is illegible, the filing date of the correspondence will be the date of actual receipt in the Office. An applicant may file a petition under the conditions specified in 37 CFR 1.10(c), (d) or (e) (discussed below) presenting whatever arguments and evidence that the paper or fee is entitled to a filing date other than the filing date accorded by the Office.

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II. < DATE-IN, DIRECT DEPOSIT, "EXPRESS MAIL" BOX RECEPTACLES & LOG BOOKS

The procedure in 37 CFR 1.10(a) requires the use of the "Express Mail Post Office to Addressee" service of the USPS. This service provides for the use of a mailing label on which the USPS clearly indicates the date on which it was deposited. Correspondence sent by the "Express Mail Post Office to Addressee" service is considered filed in the Office on the "date-in" entered by the USPS. The "date-in" on the "Express Mail" mailing label must be completed by the USPS, not by the applicant. For correspondence filed in accordance with 37 CFR 1.10, Office personnel will routinely look to the "Express Mail" mailing label, and stamp the "date-in" or other official USPS notation as the filing date of the correspondence. Accordingly, if the USPS enters the deposit date as its "date-in," the correspondence will receive the deposit date as its filing date. If the USPS deposit date cannot be determined, the correspondence will be accorded the date of receipt in the Office as the filing date. An applicant may file a petition under the conditions specified in 37 CFR 1.10(c), (d), or (e) (discussed below) presenting whatever arguments and evidence that the paper or fee is entitled to a filing date other than the filing date accorded by the Office.

37 CFR 1.10(b) further provides that correspondence should be deposited directly with an employee of the USPS to ensure that the person depositing the correspondence receives a legible copy of the "Express Mail" mailing label with the "date-in" clearly marked, and that persons dealing indirectly with the employees of the USPS (such as by deposit-

ing correspondence in an “Express Mail” drop box) do so at the risk of not receiving a copy of the “Express Mail” mailing label with the desired “date-in” clearly marked. On petition, the failure to obtain an “Express Mail” receipt with the “date-in” clearly marked may be considered an omission that could have been avoided by the exercise of due care, as discussed below. While the Office strongly urges direct deposit of “Express Mail” correspondence in order to obtain a legible copy of the “Express Mail” mailing label, parties are not precluded from using “Express Mail” drop boxes, but do so at their own risk.

A paper or fee placed in an “Express Mail” box receptacle after the box has been cleared for the last time on a given day will be considered to be deposited as of the date of receipt (“date-in”) indicated on the “Express Mail” mailing label by the Postal Service “Express Mail” acceptance clerk. 37 CFR 1.10(d) permits the Office to correct a USPS “date-in” error when the correspondence is deposited in an “Express Mail” drop box prior to last scheduled pick up of the day, that is, the time clearly marked on the “Express Mail” drop box indicating when the box will be cleared for the last time on the date of deposit. 37 CFR 1.10(d) sets forth the procedures to be followed to be entitled to such a correction.

Parties who do use drop boxes can protect themselves from uncertainty due to illegible mailing labels by routinely maintaining a log of “Express Mail” deposits in which notations are entered by the person who deposited the correspondence as “Express Mail” within one business day after deposit with the USPS. Such evidence could be useful to later support a petition filed under 37 CFR 1.10(c), (d) or (e). Evidence that came into being after deposit and within one day after the deposit of the correspondence as “Express Mail” may be in the form of a log book which contains information such as the “Express Mail” number; the application number, attorney docket number or other such file identification number; the place, date and time of deposit; the time of the last scheduled pick-up for that date and place of deposit; the depositor’s initials or signature; and the date and time of entry in the log.

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III. < “EXPRESS MAIL” MAILING LABEL NUMBER

Effective December 2, 1996, 37 CFR 1.10(b) no longer requires a certificate of mailing by “Express Mail” or that the “Express Mail” mailing label number be placed on the correspondence prior to mailing. Correspondence deposited with the USPS on or after December 2, 1996, and which is actually received by the Office will not be denied a filing date as of the “date-in” appearing on the “Express Mail” mailing label because the number of the “Express Mail” mailing label was not placed on the correspondence prior to the original mailing. However, if the number of the mailing label did not appear on the correspondence as originally filed, relief will not be granted on petition under 37 CFR 1.10(c) through (e), even if the party who filed the correspondence satisfies the other requirements of 37 CFR 1.10(c), 1.10(d) or 1.10(e). To be effective, the number must be placed on each separate paper and each fee transmittal either directly on the document or by a separate paper firmly and securely attached thereto. In situations wherein the correspondence includes several papers directed to the same application (for example, the specification, drawings, and declaration for a new application), the correspondence may be submitted with a cover or transmittal letter which should itemize the papers. It is not necessary that the number be placed on each page of a particular paper or fee transmittal. Merely placing the number in one prominent location on each separate paper or fee transmittal (or cover sheet or transmittal letter which should itemize the separate papers and fees) will be sufficient.

Since the filing of correspondence under 37 CFR 1.10 without the number of the “Express Mail” mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will not be granted on petition. A party’s inadvertent failure to comply with the requirements of a rule is not deemed to be an extraordinary situation that would warrant waiver of a rule under 37 CFR 1.183, 2.146(a)(5) or 2.148, nor is such an inadvertent omission considered “unavoidable,” within the meaning of 15 U.S.C. 1062(b), 35 U.S.C. 133, 37 CFR 1.137(a) or 37 CFR 2.66(a). See *Honigsbaum v. Lehman*, 903 F. Supp. 8, 37 USPQ2d 1799

(D.D.C. 1995) (Commissioner did not abuse his discretion in refusing to waive requirements of 37 CFR 1.10(c) in order to grant filing date to patent application, where applicant failed to produce “Express Mail” customer receipt or any other evidence that application was actually deposited with USPS as “Express Mail.”), *aff’d without opinion*, 95 F.3d 1166 (Fed. Cir. 1996); *Nitto Chemical Industry Co., Ltd. v. Comer*, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (Commissioner’s refusal to waive requirements of 37 CFR 1.10 in order to grant priority filing date to patent application not arbitrary and capricious, because failure to comply with the requirements of 37 CFR 1.10 is an “avoidable” oversight that could have been prevented by the exercise of ordinary care or diligence, and thus not an extraordinary situation under 37 CFR 1.183.); *Vincent v. Mossinghoff*, 230 USPQ 621 (D.D.C. 1985) (misunderstanding of 37 CFR 1.8 not unavoidable delay in responding to Office Action); *Gustafson v. Strange*, 227 USPQ 174 (Comm’r Pat. 1985) (counsel’s unawareness of 37 CFR 1.8 not extraordinary situation warranting waiver of a rule); *In re Chicago Historical Antique Automobile Museum, Inc.*, 197 USPQ 289 (Comm’r Pat. 1978) (since certificate of mailing procedure under 37 CFR 1.8 was available to petitioner, lateness due to mail delay not deemed to be extraordinary situation).

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IV. < PETITIONS

37 CFR 1.10(c) through 1.10(e) set forth procedures for petitioning the *>Director< to accord a filing date as of the date of deposit as “Express Mail.” Briefly, 37 CFR 1.10(c) applies where there is a discrepancy between the filing date accorded by the Office and the “date-in” entered by the USPS on the “Express Mail” mailing label or other official USPS notation; 37 CFR 1.10(d) applies where the “date-in” is incorrectly entered by the USPS; and 37 CFR 1.10(e) applies where correspondence deposited with the USPS as “Express Mail” is not received by the Office.

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V. < PETITION TO CORRECT FILING DATE AND DATE-IN DISCREPANCY

37 CFR 1.10(c) sets forth procedures for filing a petition to the *>Director< for a filing date as of the date of deposit with the USPS, where there is a discrepancy between the filing date initially accorded by the Office and the “date-in” entered by the USPS or other official USPS notation. Such a petition should:

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

(B) include a showing that the number of the “Express Mail” mailing label was placed on each piece of correspondence prior to the original mailing; and

(C) include a true copy of the “Express Mail” mailing label showing the “date-in” or other official notation by the USPS.

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VI. < PETITION TO CORRECT INCORRECTLY ENTERED DATE-IN

37 CFR 1.10(d) sets forth procedures for filing a petition to the *>Director< to accord a filing date as of the actual date of deposit with the USPS, where the “date-in” or other official notation is incorrectly entered by the USPS. Such a petition should:

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

(B) include a showing that the number of the “Express Mail” mailing label was placed on each piece of correspondence prior to the original mailing; and

(C) include a showing that the correspondence was deposited as “Express Mail” prior to the last scheduled pickup on the requested filing date.

The showing under 37 CFR 1.10(d) must be corroborated by (1) evidence from the USPS, or (2) evidence that came into being after deposit and within one business day of the deposit of the correspondence as “Express Mail.” Evidence from the USPS may be the “Express Mail” Corporate Account Mailing Statement. Evidence that came into being within one day

after the deposit of the correspondence as “Express Mail” may be in the form of a log book which contains information such as the “Express Mail” number; the application number, attorney docket number or other such file identification number; the place, date and time of deposit; the time of the last scheduled pick-up for that date and place of deposit; the depositor’s initials or signature; and the date and time of entry in the log.

The reason the Office considers correspondence to have been filed as of the date of deposit as “Express Mail” is that this date has been verified by a disinterested USPS employee, through the insertion of a “date-in,” or other official USPS notation, on the “Express Mail” mailing label. Due to the questionable reliability of evidence from a party other than the USPS that did not come into being contemporaneously with the deposit of the correspondence with the USPS, 37 CFR 1.10(d) specifically requires that any petition under 37 CFR 1.10(d) be corroborated either by evidence from the USPS, or by evidence that came into being after deposit and within one business day after the deposit of the correspondence as “Express Mail.”

A petition alleging that the USPS erred in entering the “date-in” will be denied if it is supported only by evidence (other than from the USPS) which was:

(A) created prior to the deposit of the correspondence as “Express Mail” with the USPS (e.g., an application transmittal cover letter, or a client letter prepared prior to the deposit of the correspondence); or

(B) created more than one business day after the deposit of the correspondence as “Express Mail” (e.g., an affidavit or declaration prepared more than one business day after the correspondence was deposited with the USPS as “Express Mail”).

On the other hand, a notation in a log book, entered after deposit by the person who deposited the correspondence as “Express Mail” within one business day of such deposit, setting forth the items indicated above, would be deemed on petition to be an adequate showing of the date of deposit under 37 CFR 1.10(d)(3).

37 CFR 1.10(d)(3) further provides that a party must show that correspondence was deposited as “Express Mail” before the last scheduled pickup on

the requested filing date in order to obtain a filing date as of that date.

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VII. < PETITION FOR CORRESPONDENCE NEVER RECEIVED

37 CFR 1.10(e) sets forth procedures for filing a petition to the *>Director< to accord a filing date as of the date of deposit with the USPS, where correspondence deposited as “Express Mail” is never received by the Office. Such a petition should:

(A) be filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence;

(B) include a showing that the number of the “Express Mail” mailing label was placed on each piece of correspondence prior to the original mailing;

(C) include a true copy of the originally deposited correspondence showing the number of the “Express Mail” mailing label thereon, a copy of any returned postcard receipt, a copy of the “Express Mail” mailing label showing the “date-in” or other official notation entered by the USPS; and

(D) include a statement, signed by the person who deposited the documents as “Express Mail” with the USPS, setting forth the date and time of deposit, and declaring that the copies of the correspondence, “Express Mail” mailing label, and returned postcard receipt accompanying the petition are true copies of the correspondence, mailing label and returned postcard receipt originally mailed or received.

37 CFR 1.10(e) provides for the filing of a petition to accord correspondence a filing date as of the date of deposit with the USPS as “Express Mail” only where the correspondence was mailed with sufficient postage and addressed as set out in 37 CFR 1.1(a). There is no corresponding provision that correspondence be properly addressed and mailed with sufficient postage in 37 CFR 1.10(a), (c) and (d), because these sections apply only to correspondence that is actually received by the Office. Correspondence mailed by “Express Mail” that is actually received by the Office will not be denied a filing date as of the date of deposit as “Express Mail” simply because the correspondence was not mailed with sufficient postage or not addressed as set out in 37 CFR 1.1(a).

37 CFR 1.10(e)(3) provides that if the requested filing date is a date other than the “date-in” on the “Express Mail” mailing label, the petition should include a showing under 37 CFR 1.10(d)(3), as discussed above, that the correspondence was deposited as “Express Mail” before the last scheduled pickup on the requested filing date in order to obtain a filing date as of that date. 37 CFR 1.10(e) applies only in those situations in which the correspondence at issue was lost *in toto* (i.e., the entire correspondence was not delivered to the Office). Where there is a dispute as to the contents of correspondence submitted to the Office (e.g., an applicant asserts that three sheets of drawings were submitted under 37 CFR 1.10 with an application, but the Office records indicate receipt of only two sheets of drawings with the application), an applicant may not rely upon the provisions of 37 CFR 1.10(e) to establish what document(s) and/or fee(s) were filed in the Office with such correspondence. Rather, where the records of the Office (e.g., the file of the application) contain any document(s) or fee(s)

corresponding to the contents of the correspondence at issue, the Office will rely upon its official record of the contents of such correspondence in absence of convincing evidence (e.g., a postcard receipt under MPEP § 503 containing specific itemization of the document(s) or fee(s) purported to have been filed with the correspondence at issue) that the Office received and misplaced any document(s) or fee(s) that is not among the official records of the Office.

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VIII. < ADDITIONAL EVIDENCE MAY BE REQUIRED

37 CFR 1.10(f) provides that the Office may require additional evidence to determine whether the correspondence was deposited as “Express Mail” with the USPS on the date in question.



MANUAL OF PATENT EXAMINING PROCEDURE