Chapter 1300 Allowance and Issue

[***Editor Note****: This chapter was not substantively revised for the Ninth Edition of the MPEP. Each section has a revision indicator of "[R-08.2012]," meaning that the section as reproduced in this Edition is the version in force in August 2012 with the following exceptions: 1) As a result of the publication process, form paragraphs reproduced in this chapter reflect the text used by examiners effective November 2013 rather than those in force in August 2012; 2) The marks indicating added or deleted text from prior revisions have been removed; and 3) The notation "[Reserved]" has been added for section numbers previously missing in the hierarchy (i.e., section numbers that were never used or no longer have text). See the ninth revision of the Eighth Edition of the MPEP published August 2012 as posted on the USPTO Web site on the MPEP Archives page (****http://www.uspto.gov/web/offices/pac/mpep/old/index.htm****) for the text of form paragraphs in force in August 2012 and the prior revision marks.***]**

1301 Substantially Allowable Application, Special [R-08.2012]

When an application is in condition for allowance, except as to matters of form, the application will be considered special and prompt action taken to require correction of formal matters. See **MPEP § 710.02(b)**.

1302 [Reserved]

1302.01 General Review of Disclosure [R-08.2012]

When an application is apparently ready for allowance, it should be reviewed by the examiner to make certain that the whole application meets all formal and substantive (i.e., statutory) requirements and that the language of the claims is enabled by,

and finds adequate descriptive support in, the application disclosure as originally filed. Neglect to give due attention to these matters may lead to confusion as to the scope of the patent.

Frequently, the invention as originally described and claimed was of much greater scope than that defined in the claims as allowed. Some or much of the subject matter disclosed may be entirely outside the bounds of the claims accepted by the applicant. In such case, the examiner should require the applicant to modify the brief summary of the invention and restrict the descriptive matter so as to be in harmony with the claims. However valuable for reference purposes the examiner may consider the matter which is extraneous to the claimed invention, patents should be confined in their disclosures to the respective inventions patented (see **37 CFR 1.71** and 1.73). Of course, enough background should be included to make the invention clearly understandable. See **MPEP § 608.01(c)** and **§ 608.01(d)**. Form paragraphs 13.07 and 13.08 may be used.

¶ *13.07 Disclosure To Be Limited to Claimed Invention*

Applicant is required to modify the brief summary of the invention and to restrict the descriptive matter so that they are confined to and in harmony with the invention to which the allowed claims are directed. See **MPEP § 1302.01**. For example, **[1]**.

Examiner Note:

An example should be given as to the specific sheets or drawing figures and portions of the specification which should be cancelled. If drawing figures are to be cancelled, applicant should be reminded that subsequent figures must be renumbered.

¶ *13.08 Disclosed Subject Matter Outside the Bounds of the Claims*

The application contains disclosure entirely outside the bounds of the allowed claims. Applicant is required to modify the brief summary of the invention and restrict the descriptive matter so as to be in harmony with the claims (**MPEP § 1302.01**).

There should be clear support or antecedent basis in the specification for the terminology used in the claims. Usually, the original claims follow the nomenclature of the specification; but sometimes in amending the claims or in adding new claims, applicant employs terms that do not appear in the specification. This may result in uncertainty as to the interpretation to be given such terms. See **MPEP § 608.01(o)**. It should be noted, however, that exact terms need not be used *in haec verba* to satisfy the written description requirement of the first paragraph of **35 U.S.C. 112**. *Eiselstein v. Frank* , 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995); *In re Wertheim* , 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976). See also **37 CFR 1.121(e)** which merely requires *substantial* correspondence between the language of the claims and the language of the specification.

The claims should be renumbered as required by **37 CFR 1.126**, and particular attention should be given to claims dependent on previous claims to see that the numbering is consistent. An examiner's amendment should be prepared if the order of the claims is changed. See **MPEP § 608.01(j)**, **§ 608.01(n)**, and **§ 1302.04(g)**.

The abstract should be checked for an adequate and clear statement of the disclosed invention. See **MPEP § 608.01(b)**. The length of the abstract should be limited to 150 words. For changes to the abstract by examiner's amendment, see MPEP § **1302.04**.

The title should also be checked. It should be as short and specific as possible. However, the title should be descriptive of the invention claimed, even though a longer title may result. If a satisfactory title is not supplied by the applicant, the examiner may change the title on or after allowance. See **MPEP § 606** and **§ 606.01**.

No pencil notes should be made in the application file (that is maintained in paper) by the examiner. Any notes in the file must be erased when the application is passed to issue.

All amendments should be reviewed to assure that they were timely filed.

1302.02 Requirement for a Rewritten Specification [R-08.2012]

Whenever interlineations or cancellations have been made in the specification or amendments which would lead to confusion and mistake, the examiner should require the entire portion of specification affected to be rewritten before passing the application to issue. See **37 CFR 1.125** and **MPEP § 608.01(q)**.

Form paragraph 13.01 should be used when making such a requirement.

¶ *13.01 Requirement for Rewritten Specification*

The interlineations or cancellations made in the specification or amendments to the claims could lead to confusion and mistake during the issue and printing processes. Accordingly, the portion of the specification or claims as identified below is required to be rewritten before passing the case to issue. See **37 CFR 1.125** and **MPEP § 608.01(q)**.

Examiner Note:

1. Specific discussion of the sections of the specification or claims required to be rewritten must be set forth.

2. See form paragraph 6.28.01 for a substitute specification.

1302.03 Notice of Allowability [R-08.2012]

A Notice of Allowability form PTOL-37 is used whenever an application has been placed in condition for allowance. The date of any communication and/or interview which resulted in the allowance should be included in the notice.

In *all* instances, both before and after final rejection, in which an application is placed in condition for allowance, applicant should be notified promptly of allowability of the claims by a Notice of Allowability PTOL-37. Prompt notice to applicant is important because it may avoid an unnecessary appeal and act as a safeguard against a holding of abandonment.

Notice of Allowability	Application No.	Applicant(s)	
	Examiner	Art Unit	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☐ This communication is responsive to _____.

2. ☐ The allowed claim(s) is/are _____.

3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a) ☐ All b) ☐ Some* c) ☐ None of the:
      1. ☐ Certified copies of the priority documents have been received.
      2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
      3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

   * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.

5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
   (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
   (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

   Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).

6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____ .
7. ☐ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

U.S. Patent and Trademark Office
PTOL-37 (Rev. 07-05) **Notice of Allowability** Part of Paper No./Mail Date

1302.04 Examiner's Amendments and Changes [R-08.2012]

Except by formal examiner's amendment duly signed or as hereinafter provided, no corrections, erasures, or interlineations may be made in the body of written portions of the specification or any other paper filed in the application for patent. (See **37 CFR 1.121**.)

If the application file is a paper file, an informal examiner's amendment may be used for the correction of the following obvious errors and omissions only in the body of the written portions of the specification and may only be made with pen by the examiner of the application who will then initial in the margin and assume full responsibility for the change:

(A) Misspelled words.
(B) Disagreement of a noun with its verb.
(C) Inconsistent "case" of a pronoun.
(D) Disagreement between a reference character as used in the description and on the drawing. The character may be corrected in the description but only when the examiner is certain of the propriety of the change.

(E) Correction of reversed figure numbers. *Garrett v. Cox*, 233 F.2d 343, 345, 110 USPQ 52, 54 (CCPA 1956).
(F) Other obvious minor grammatical errors such as misplaced or omitted commas, improper parentheses, quotation marks, etc.
(G) Obvious informalities in the application, other than the ones noted above, or of purely grammatical nature.

Informal examiner's amendments are not permitted if the application is an Image File Wrapper (IFW) application. Any amendment of an IFW application must be by way of a formal examiner's amendment or be an amendment made by the applicant.

For continuing applications filed under 37 CFR **1.53(b)**, where a reference to the parent application has been inadvertently omitted by the applicant, an examiner should not add a reference to the prior application without the approval of the applicant and a formal examiner's amendment since applicant may decide to delete the priority claim in the application filed under 37 CFR **1.53(b)**. Furthermore, a petition under 37 CFR **1.78** to accept an unintentionally delayed benefit claim may be required if the application is a utility or plant application filed on or after November 29, 2000. See MPEP § **201.11**.

When correcting *originally filed* papers in applications with a paper application file wrapper, clean red ink *must* be used (not blue or black ink).

A formal examiner's amendment may be used to correct all other informalities in the body of the written portions of the specification as well as all errors and omissions in the claims. The formal examiner's amendmentmust be signed by the primary examiner, placed in the file and a copy sent to applicant. The changes specified in the amendment are entered by the technical support staff in the regular way. A formal examiner's amendment should include form paragraph 13.02 and form paragraph 13.02.01. Form paragraph 13.02.02 should be used if an extension of time is required.

¶ *13.02 Formal Examiner's Amendment*

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by **37 CFR 1.312**. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Examiner Note:

This form paragraph is NOT to be used in a reexamination proceeding (use form paragraph 22.06 instead).

¶ *13.02.01 Examiner's Amendment Authorized*

Authorization for this examiner"s amendment was given in a telephone interview with **[1]** on **[2]**.

¶ *13.02.02 Extension of Time and Examiner's Amendment Authorized by Telephone*

An extension of time under **37 CFR 1.136(a)** is required in order to make an examiner's amendment which places this application in condition for allowance. During a telephone conversation conducted on **[1]**, **[2]** requested an extension of time for **[3]** MONTH(S) and authorized the Director to charge Deposit Account No. **[4]** the required fee of $ **[5]** for this extension and authorized the following examiner's amendment. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by **37 CFR 1.312**. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Examiner Note:

See **MPEP § 706.07(f)** which explains when an extension of time is needed in order to make amendments to place the application in condition for allowance.

Although 37 CFR 1.121 has been amended to require amendments to the specification/claims to be made in compliance with 37 CFR 1.121(b)(1), (b)(2), or (c), where appropriate, 37 CFR 1.121(g) permits the Office to make amendments to the specification, including the claims, by examiner's amendments without the need to comply with the requirements of 37 CFR 1.121(b)(1), (b)(2), or (c) in the interest of expediting prosecution and reducing cycle time. Examiners may continue to make additions or deletions of subject matter in the specification, including the claims, in examiner's amendments by instructions to make the change at a precise location in the specification and/or the claims. Examiners may use an examiner's amendment to correct a non-compliant amendment filed by the applicant if the amendment would otherwise place the application in condition for allowance (e.g., a reply to a non-final Office action or an after-final amendment includes an incorrect status identifier). See MPEP § 714, subsection II.E. Examiner's Amendments.

As an alternative, the examiner's amendment utilizing paragraph/claim replacement can be created by the examiner with authorization from the applicant. The examiner's amendment can also be created from a facsimile transmission or e-mailed amendment received by the examiner and referenced in the examiner's amendment and attached thereto. Any subject matter, in clean version form (containing no brackets or underlining), to be added to the specification/claims should be set forth separately by applicant in the e-mail or facsimile submission apart from the remainder of the submission. A clean version of a paragraph/claim, or portion of a paragraph/claim, submitted by applicant in a fax or e-mail, should be printed and attached to the examiner's amendment and may be relied on as part of the examiner's amendment. The examiner should mark "requested" on the entire attachment to indicate that the fax or e-mail was requested by the examiner, so as to not lead to a reduction in patent term adjustment (37 CFR 1.704(c)(8)). As the attachment is made part of the examiner's amendment, it does not get a separate PALM code and will not trigger any reduction in patent term adjustment. A paper copy of the entire e-mail or facsimile submission should be entered in the application file. Examiners are not required to electronically save any e-mails once any e-mails or attachments thereto are printed and become part of an application file record. The e-mail practice that is an exception for examiner's amendments is restricted to e-mails to the examiner from the applicant and should not be generated by the examiner to the applicant unless such e-mails are in compliance with all of the requirements set out in MPEP § 502.03.

The amendment or cancellation of claims by formal examiner's amendment is permitted when passing an application to issue where these changes have been authorized by applicant (or his/her attorney or agent) in a telephone or personal interview. The examiner's amendment should indicate that the changes were authorized, the date and type (personal or telephone) of interview, and with whom it was held.

The examiner's amendment practice may be used to make charges against deposit accounts or credit cards under special conditions.

An examiner's amendment can be used to make a charge against a deposit account, provided prior approval is obtained from the applicant, attorney or agent, in order to expedite the issuance of a patent on an application otherwise ready for allowance. When such an examiner's amendment is prepared, the prior approval is indicated by identification of the name of the authorizing party, the date and type (personal or telephone) of authorization, the purpose for which the charge is made (additional claims, etc.), and the deposit account number.

Charges can also be made against a credit card in an examiner's amendment. Once the examiner has informed applicant of the required charges, applicant must submit by facsimile, a properly completed and signed PTO-2038, authorizing the necessary charges. After completion of processing in the Office of Finance, form PTO-2038 will be removed from the record. Office employees may 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. Further identifying data, if deemed necessary and requested by the applicant, should also be included in the examiner's amendment.

Form paragraph 13.06 may be used to charge an extension of time fee in an examiner's amendment.

¶ *13.06 Extension of Time by Examiner's Amendment*

An extension of time under **37 CFR 1.136(a)** is required to place this application in condition for allowance. During a telephone conversation conducted on **[1]**, **[2]** requested an extension of time for **[3]** MONTH(S) and authorized the Director to charge Deposit Account No. **[4]** the required fee of $ **[5]** for this extension.

Examiner Note:

1. See **MPEP § 706.07(f)**, item J which explains when an extension of time is needed in order to make amendments to place the application in condition for allowance.

2. When an examiner's amendment is also authorized, use form paragraph 13.02.02 instead.

At the time of allowance, substantive changes made by the examiner to the abstract must be done by a formal examiner's amendment after first obtaining approval from the applicant. As noted by the court in recent decisions, the abstract may be used to determine the meaning of claims. See *Pandrol USA, LP v. Airboss Railway Products, Inc.*, 320 F.3d 1354, 1363 n.1, 65 USPQ2d 1985, 1996 n.1 (Fed. Cir. 2003), *Hill-Rom Co. v. Kinetic Concepts, Inc.*, 209 F.3d 1337, 1341 n.1, 54 USPQ2d 1437, 1443 n.1 (Fed. Cir. 2000). Since the abstract may be relied upon to determine the scope of the claimed invention, examiners should review the abstract for compliance with 37 CFR 1.72(b) and point out defects noted to the applicant in the first Office action, or at the earliest point in the prosecution that the defect is noted, so that applicant may make the necessary changes to the abstract.

No examiner's amendment, whether formal or informal, may make substantive changes to the written portions of the specification, including the abstract, without first obtaining applicant's approval.

The fact that applicant is entitled to an earlier U.S. effective filing date under **35 U.S.C. 120**, **121**, or 365(c) or **35 U.S.C. 119(e)** is sometimes overlooked. To minimize this possibility, and for the claim to the benefit of the earlier filing date to be proper, the statement that, "This is a division (continuation, continuation-in-part) of Application Number -/---, filed ---" should appear as the first sentence(s) of the specification, or in an application data sheet of applications other than CPAs claiming priority under **35 U.S.C. 120**, except in the case of design applications where it should appear as set forth in **MPEP § 1504.20**. The request for a CPA (note that effective July 14, 2003, CPA practice has been eliminated as to utility and plant applications) filed under 37 CFR **1.53**(d) is itself the specific reference, as required by 35 U.S.C. **120** and 37 CFR **1.78**(a)(2), to every application assigned the same application number identified in the request. In the case of an application filed under 37 CFR **1.53**(b) as a division, continuation or continuation-in-part of a CPA, there would be only one reference to the series of applications assigned the same application number with the filing date cited being that of the original non-continued application. In applications claiming priority under **35 U.S.C. 119(e)**, a statement such as "This application claims the benefit of U.S. Provisional Application No. 60/ - --, filed - --" should appear as the first sentence(s) of the specification or in an application data sheet. In addition, for an application which is claiming the benefit under **35 U.S.C. 120** of a prior application which in turn claims the benefit of a provisional application under **35 U.S.C. 119(e)**, a suitable reference would read, "This application is a continuation of U.S. Application No. 08/ - --, filed - --, now abandoned, which claims the benefit of U.S. Provisional Application No. 60/ - --, filed - --." Any such statements appearing elsewhere in the specification should be relocated or made in an application data sheet.

References cited as being of interest by examiners when passing an application to issue will not be supplied to applicant, but foreign patent documents and non-patent literature will be scanned and added to the IFW for viewing and downloading by the applicant, if desired. The references will be cited as usual on form PTO-892, a copy of which will be attached to the Notice of Allowability, form PTOL-37.

Where an application is ready for issue except for a slight defect in the drawing not involving a change in structure, the examiner will prepare a letter indicating the change to be made and, if necessary, including a marked-up copy of the drawing showing the addition or alteration to be made. See **MPEP § 608.02(w)**.

No other changes may be made by any person in any record of the U.S. Patent and Trademark office without the written approval of the Director of the United States Patent and Trademark Office.

In reviewing the application, all errors should be carefully noted. It is not necessary that the language be the best; it is, however, essential that it be clear in meaning, and free from errors in syntax. Any necessary examiner's amendment is usually made at the time an application is being prepared for issue by the examiner and a copy of any formal examiner's amendment is sent to the applicant as an attachment to the Notice of Allowability, PTOL-37.

Examiners will not cancel claims on the basis of an amendment which argues for certain claims and, alternatively, purports to authorize their cancellation by the examiner if other claims are allowed . See generally *In re Willingham*, 282 F.2d 353, 356, 127 USPQ 211, 215 (CCPA 1960).

In all instances, both before and after final rejection, in which an application is placed in condition for allowance as by an interview or amendment, applicant should be notified promptly of this fact by means of a Notice of Allowability (PTOL-37). See **MPEP § 714.13** and **§ 1302.03**.

If after reviewing, screening, or surveying an allowed application in the Office of Patent Quality Assurance, an error or omission of the type noted in items (A) through (G) under the second paragraph of this section is noted, the error or omission may be corrected by the Review Quality Assurance Specialist in the same manner as set forth in the second paragraph. Since all other obvious informalities may only be corrected by a formal examiner's amendment, if the Office of Patent Quality Assurance discovers any such informality, the Review Quality Assurance Specialist will return the application to the Technology Center (TC) personnel via the TC Director suggesting, as appropriate, specific changes for approval and correction by the examiner through the use of an examiner's amendment.

1302.04(a) Title of Invention [R-08.2012]

Where the title of the invention is not specific to the invention as claimed, see **MPEP § 606.01**.

1302.04(b) Cancellation of Nonstatutory Claim [R-08.2012]

When a case is otherwise in condition for allowance the examiner may cancel an obviously nonstatutory claim such as one to "A device substantially as shown and described." Applicant should be notified of the cancellation of the claim by an examiner's amendment.

1302.04(c) Cancellation of Claims to Nonelected Invention [R-08.2012]

See **MPEP § 821.01** and **§ 821.02**.

1302.04(d) Cancellation of Claim Lost in Interference [R-08.2012]

See MPEP **Chapter 2300** .

1302.04(e) Cancellation of Rejected Claims Following Appeal [R-08.2012]

See **MPEP § 1214.06**, **§ 1215.03**, and **§ 1215.04**.

1302.04(f) [Reserved]

1302.04(g) Identification of Claims [R-08.2012]

To identify a claim, a formal examiner's amendment should refer to it by the original number and, if renumbered in the allowed application, also by the new number.

1302.04(h) Rejoinder of Claims [R-08.2012]

Any previously withdrawn claims that are being rejoined and allowed must be listed in the index of

claims and on the Notice of Allowability to avoid a printer query. The examiner should notify the applicant of the rejoinder. See MPEP § 821.04.

1302.05 Correction of Drawing [R-08.2012]

Where an application otherwise ready for issue requires correction of the drawing, the application is processed for allowance in the Technology Center and then forwarded to the Publishing Division. Any papers subsequently filed by the applicant, including replacement drawings, are forwarded to the Publishing Division in order to be matched with the application file. If the drawings that are received are still not acceptable for publishing, the Publishing Division will mail a "Notice to File Corrected Application Papers," giving the applicant a non-extendable period in which to file the corrected drawings.

1302.05(a) Original Drawings Cannot Be Located [R-08.2012]

When the original drawings cannot be located and the application is otherwise in condition for allowance, no "Official Search" need be undertaken. A replacement drawing should be obtained from the Office of Initial Patent Examination's records of the application as originally filed. If the reproduced drawings are not acceptable for publishing, applicant should be required to submit corrected drawings. An attachment to the Notice of Allowability should explain the problem and require the corrected drawings. If such an attachment is not included with the Notice of Allowability, the Publishing Division will mail a "Notice Regarding Drawings," giving the applicant a non-extendable period in which to file the corrected drawings.

1302.06 Prior Foreign Application [R-08.2012]

See MPEP § 201.14(c) and § 202.03.

1302.07 [Reserved]

1302.08 Interference Search [R-08.2012]

When an application is in condition for allowance, an interference search must be made by performing a text search of the "US-PGPUB" database in EAST or WEST directed to the comprehensive inventive features in the broadest claim. If the application contains a claim directed to a nucleotide or peptide sequence, the examiner must submit a request to STIC to perform an interference search of the sequence. The text search may make use of the ".CLM." search symbol in order to limit the text search to the claims of the database references. If the search results identify any potential interfering subject matter, the examiner will review the application(s) with the potential interfering subject matter to determine whether interfering subject matter exists. If interfering subject matter does exist, the examiner will follow the guidance set forth in MPEP Chapter 2300. If there is no interfering subject matter then the examiner should prepare the application for issuance. A printout of only the database(s) searched, the query(ies) used in the interference search, and the date the interference search was performed must be made of record in the application file. The results of the interference search must not be placed in the application file. Completion of the interference search should be recorded in the "Interference Searched" section of the OACS "Search Notes" page with notation such as "PGPUB text search – March 1, 2005, see interference search printout" coupled with the examiner's initials.

An interference search may be required in TC Working Group 3640. Inspection of pertinent prints, drawings, brief cards, and applications in TC

Working Group 3640 will be done on request by an examiner in TC Working Group 3640.

1302.09 Classification, Print Figure, and Other Notations [R-08.2012]

The examiner preparing the application for issue completes the Issue Classification sheet.

Issue Classification	Application No.	Applicant(s)	
	09/117,190	FETIH ET AL	
	Examiner	Art Unit	
	Heather R Herndon	2176	

ISSUE CLASSIFICATION

ORIGINAL		CROSS REFERENCE(S)	
CLASS	SUBCLASS	CLASS	SUBCLASS (ONE SUBCLASS PER BLOCK)

INTERNATIONAL CLASSIFICATION

(Assistant Examiner) (Date)		Total Claims Allowed:	
(Legal Instruments Examiner) (Date)	(Primary Examiner) (Date)	O.G. Print Claim(s)	O.G. Print Fig.

☐ Claims renumbered in the same order as presented by applicant ☐ CPA ☐ T.D. ☐ R.1.47

Final	Original	Final	Original	Final	Original	Final	Original	Final	Original	Final	Original	Final	Original
	211		241		271		301		331		361		391
	212		242		272		302		332		362		392
	213		243		273		303		333		363		393
	214		244		274		304		334		364		394
	215		245		275		305		335		365		395
	216		246		276		306		336		366		396
	217		247		277		307		337		367		397
	218		248		278		308		338		368		398
	219		249		279		309		339		369		399
	220		250		280		310		340		370		400
	221		251		281		311		341		371		401
	222		252		282		312		342		372		402
	223		253		283		313		343		373		403
	224		254		284		314		344		374		404
	225		255		285		315		345		375		405
	226		256		286		316		346		376		406
	227		257		287		317		347		377		407
	228		258		288		318		348		378		408
	229		259		289		319		349		379		409
	230		260		290		320		350		380		410
	231		261		291		321		351		381		411
	232		262		292		322		352		382		412
	233		263		293		323		353		383		413
	234		264		294		324		354		384		414
	235		265		295		325		355		385		415
	236		266		296		326		356		386		416
	237		267		297		327		357		387		417
	238		268		298		328		358		388		418
	239		269		299		329		359		389		419
	240		270		300		330		360		390		420

U.S. Patent and Trademark Office Part of Paper No. 3

Examiners must review the data regarding prior U.S. applications to make sure that the information is correct when preparing the application for issue. If any claim to domestic priority under 35 U.S.C. 119(e), 120, 121, or 365(c) is added, deleted, and/or modified during prosecution of the application and such addition, deletion, and/or modification has been approved, the examiner must make sure that the information in the PALM database is current and up to date. If the PALM system has not been updated, the application must be forwarded to the Technology Center (TC) Legal Instrument Examiner, with an explanation of the correction to be made . Examiners should also review the data regarding prior provisional and foreign applications for accuracy.

See MPEP § 202.02 for notation as to parent or prior U.S. application, including provisional application, to be placed in the file history.

See MPEP § 202.03 for notation as to foreign patent application to be placed in the file history.

See MPEP § 1302.13 for name of examiner.

Examiners, when preparing an application for issue, are to record the number of the claim selected for printing in the *Official Gazette* in the box labeled "PRINT CLAIM" on the Issue Classification Sheet.

The claim or claims should be selected in accordance with the following instructions:

(A) The broadest claim should be selected.

(B) Examiners should ordinarily designate but one claim on each invention, although when a plurality of inventions are claimed in an application, additional claims up to a maximum of five may be designated for publication.

(C) A dependent claim should not be selected unless the independent claim on which it depends is also printed. In the case where a multiple dependent claim is selected, the entire chain of claims for one embodiment should be listed.

(D) In reissue applications, the broadest claim with changes or the broadest additional reissue claim should be selected for printing.

When recording this information in the box provided, the following items should be kept in mind:

(A) Write the claim number clearly in black ink.

(B) If multiple claims are selected, the claim numbers should be separated by commas.

(C) The claim designated must be referred to by using the renumbered patent claim number rather than the original application claim number

Examiners, when preparing an application for issue, are to record the figure selected for printing in the *Official Gazette* in the box labeled "**Print Fig**." on the Issue Classification sheet. It is no longer necessary for drawings to be stamped approved or for the examiner to write this information in the space provided by the Draftsperson's stamp on the margin of the sheet of drawing.

Ordinarily a single figure is selected for printing. This figure should be consistent with the claim to be printed in the *Official Gazette*. The figure to be printed in the *Official Gazette* must not be one that is labeled "prior art." If there is no figure illustrative of or helpful in understanding the claimed invention, no figure need be selected. "None" may be written in the box labeled "**Print Fig**."on the Issue Classification Sheet.

1302.10 Issue Classification Notations [R-08.2012]

See MPEP § 903.07, § 903.07(b) and § 903.09 for notations to be applied on the Issue Classification sheet.

In all reissue applications, the number of the original patent which is being reissued should be placed in the box provided therefor below the box for the applicant's name.

1302.11 Reference to Assignment Division [R-08.2012]

The practice of referring certain applications to the Assignment Division when passing them to issue is no longer followed. See MPEP § 303.

1302.12 Listing of References [R-08.2012]

All references which have been cited by the examiner during the prosecution, including those

appearing in Board of Patent Appeals and Interferences decisions or listed in the reissue oath, must be listed on either a form PTO-892 or on an Information Disclosure Statement (PTO/SB/08) and initialed. All such reference citations will be printed in the patent. References listed by a patent examiner on a "Notice of References Cited," form PTO-892, will be indicated with an asterisk in the "References Cited" section of the front page of a patent document. An example of how the "References Cited" section of the patent will appear is as follows:

[56] **References Cited**

U.S. PATENT DOCUMENTS

2,234,192 ***** 7/1955 Greene..... 75/507

4,991,048 8/1990 Larkin.....206/207

5,000,186 12/1991 Amis.....267/340

5,000,993 ***** 12/1991 Thomas et al.....75/507

FOREIGN PATENT DOCUMENTS

9500000 ***** 6/1995 Belgium.....…75/507

200000 ***** 6/1990 Japan ……. 75/507

9400000 9/1994 United Kingdom.

OTHER PUBLICATIONS

Hill, "Ferrous Precipitation," *Journal of the American Defenestration Association*, Jan. 1989, Pages 34– 46.***** Clymerhill-Irons, "Ferrous Ascension for the Eighties," *Proceedings of the International Ferrous Ascension Society*, Jan.– Mar. 1979, Pages 1111– 1163.

***** cited by examiner

Indication of whether a reference was listed by the examiner will be helpful in compiling statistical data related to prior art submissions so that the USPTO can better consider whether changes are required to the rules governing prior art statements.

Indication of a reference with an asterisk should not be considered to reflect any significance other than that the reference was listed on a "Notice of References Cited," form PTO-892. When an examiner lists references on a form PTO-892, the examiner lists references that are relied upon in a prior art rejection or mentioned as pertinent. See MPEP § **707.05(c)**. The examiner does not list references which were previously cited by the applicant (and initialed by an examiner) on an Information Disclosure Statement, for example, on a PTO/SB/08. See MPEP § **609** and § **707.05(b)**, (c) and (d). No distinction will be made in the "References Cited" section for other sources of references. Thus, references cited in a protest, by an attorney or agent not acting in a representative capacity but on behalf of a single inventor, and by the applicant will not be distinguished.

At time of allowance, the examiner may cite pertinent art in an examiner's amendment or statement of reasons for allowance. Such pertinent art should be listed as usual on form PTO-892, a copy of which is attached to the Notice of Allowability form PTOL-37. Such pertinent art is not sent to the applicant, but foreign patent documents and non-patent literature will be scanned and added to the Image File Wrapper (IFW) for viewing and downloading by the applicant, if desired. Such citation of art is important in the case of continuing applications where significant prior art is often of record in the parent case. In the rare instance where no art is cited in a continuation application, all the references cited during the prosecution of the parent application will be listed at allowance for printing in the patent. See **MPEP § 707.05** and **§ 707.05(a)**.

When preparing an application for allowance, the technical support staff will verify that there is at least one list of references (PTO-892 or PTO/SB/08) in the application. The technical support staff will also verify that each reference on the Information Disclosure Statement has either been initialed by the examiner or lined-through by the examiner. All lists of references are maintained in the application file.

In the first action after termination of an interference, the examiner should make of record in each application all references not already of record which

were pertinent to any preliminary motions and which were discussed in the decision on motion.

In any application, otherwise ready for issue, in which an erroneous citation has not been formally corrected in an official paper, the examiner is directed to correct the citation by an examiner's amendment. See **MPEP § 707.05(g)**.

Any new reference cited when the application is in issue, under the practice of **MPEP § 1308.01**, should be added by way of a PTO-892 or PTO/SB/08.

All copies of references placed in the file wrapper during prosecution should be retained therein when the allowed application is forwarded to the Publishing Division.

1302.13 Signing [R-08.2012]

The primary examiner and the assistant examiner involved in the allowance of an application will type their names on the Issue Classification sheet. The assistant examiner shall place his or her initials after his or her typed name. The primary examiner will place his or her signature in the appropriate box on the Issue Classification sheet so that the typed name can still be easily read. A primary examiner who prepares an application for issue types his or her name and signs the file wrapper *only* in the "Primary Examiner" box on the Issue Classification sheet. A line should be drawn through the "Assistant Examiner" box to make it clear that the absence of a name in the box was not an oversight.

Only the names of the primary examiner and the assistant examiner appearing on the Issue Classification Sheet will be listed in the printed patent.

1302.14 Reasons for Allowance [R-08.2012]

37 CFR 1.104 Nature of examination.

*****

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

I. REASONS FOR ALLOWANCE

One of the primary purposes of **37 CFR 1.104(e)** is to improve the quality and reliability of issued patents by providing a complete file history which should clearly reflect, as much as is reasonably possible, the reasons why the application was allowed. Such information facilitates evaluation of the scope and strength of a patent by the patentee and the public and may help avoid or simplify litigation of a patent.

The practice of stating the reasons for allowance is not new, and the rule merely formalizes the examiner's existing authority to do so and provides applicants or patent owners an opportunity to comment upon any such statement of the examiner.

It should be noted that the setting forth of reasons for allowance is not mandatory on the examiner's part. However, in meeting the need for the application file history to speak for itself, it is incumbent upon the examiner in exercising his or her responsibility to the public, to see that the file history is as complete as is reasonably possible.

When an application is finally acted upon and allowed, the examiner is expected to determine, at the same time, whether the reasons why the application is being allowed are evident from the record.

Prior to allowance, the examiner may also specify allowable subject matter and provide reasons for indicating such allowable subject matter in an Office communication.

In determining whether reasons for allowance should be recorded, the primary consideration lies in the first sentence of **37 CFR 1.104(e)** which states:

> If the examiner believes that the record of the prosecution *as a whole* does not make clear his or her reasons for allowing a claim or claims, the examiner may set forth such reasoning. (Emphasis added).

In most cases, the examiner's actions and the applicant's replies make evident the reasons for allowance, satisfying the "record as a whole" proviso of the rule. This is particularly true when applicant fully complies with 37 CFR 1.111 (b) and (c) and 37 CFR 1.133(b). Thus, where the examiner's actions clearly point out the reasons for rejection and the applicant's reply explicitly presents reasons why claims are patentable over the reference, the reasons for allowance are in all probability evident from the record and **no** statement should be necessary. Conversely, where the record is not explicit as to reasons, but allowance is in order, then a logical extension of 37 CFR 1.111 and 1.133 would dictate that the examiner should make reasons of record and such reasons should be specific.

Where specific reasons are recorded by the examiner, care must be taken to ensure that statements of reasons for allowance (or indication of allowable subject matter) are accurate, precise, and do not place unwarranted interpretations, whether broad or narrow, upon the claims. The examiner should keep in mind the possible misinterpretations of his or her statement that may be made and its possible effects. Each statement should include at least (1) the major difference in the claims not found in the prior art of record, and (2) the reasons why that difference is considered to define patentably over the prior art if either of these reasons for allowance is not clear in the record. The statement is not intended to necessarily state all the reasons for allowance or all the details why claims are allowed and should not be written to specifically or impliedly state that all the reasons for allowance are set forth. Where the examiner has a large number of reasons for allowing a claim, it may suffice to state only the major or important reasons, being careful to so couch the statement. For example, a statement might start: "The primary reason for the allowance of the claims is the inclusion of the limitationin all the claims which is not found in the prior art references," with further amplification as necessary.

Stock paragraphs with meaningless or uninformative statements of the reasons for the allowance should not be used. It is improper to use a statement of reasons for allowance to attempt to narrow a claim by providing a special definition to a claim limitation which is argued by applicant, but not supported by a special definition in the description in cases where the ordinary meaning of the term in the prior art demonstrates that the claim remains unpatentable for the reasons of record, and where such claim narrowing is only tangential to patentability. Cf. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 741, 62 USPQ2d 1705, 1714 (2002). The statement of reasons for allowance by the examiner is intended to provide information equivalent to that contained in a file in which the examiner's Office actions and the applicant's replies make evident the examiner's reasons for allowing claims.

Examiners are urged to carefully carry out their responsibilities to see that the application file contains a complete and accurate picture of the Office's consideration of the patentability of the application.

Under the rule, the examiner must make a judgment of the individual record to determine whether or not reasons for allowance should be set out in that record. These guidelines, then, are intended to aid the examiner in making that judgment. They comprise illustrative examples as to applicability and appropriate content. They are not intended to be exhaustive.

II. EXAMPLES OF WHEN IT IS LIKELY THAT A STATEMENT SHOULD BE ADDED TO THE RECORD

(A) Claims are allowed on the basis of one (or some) of a number of arguments and/or affidavits presented, and a statement is necessary to identify which of these were persuasive, for example:(1) When the arguments are presented in an appeal brief.

(2) When the arguments are presented in an ordinary reply, with or without amendment of claims.

(3) When both an affidavit under 37 CFR 1.131 and arguments concerning rejections under 35 U.S.C. 102 and 103 are presented.

(B) First action issue:(1) Of a noncontinuing application, wherein the claims are very close to the cited prior art and the differences have not been discussed elsewhere.

(2) Of a continuing application, wherein reasons for allowance are not apparent from the record in the parent case or clear from preliminary filed matters.

(C) Withdrawal of a rejection for reasons not suggested by applicant, for example:(1) As a result of an appeal conference.

(2) When applicant's arguments have been misdirected or are not persuasive alone and the examiner comes to realize that a more cogent argument is available.

(3) When claims are amended to avoid a rejection under **35 U.S.C. 102**, but arguments (if any) fail to address the question of obviousness.

(D) Allowance after remand from the Board of Patent Appeals and Interferences.

(E) Allowance coincident with the citation of newly found references that are very close to the claims, but claims are considered patentable thereover:(1) When reference is found and cited (but not argued) by applicant.

(2) When reference is found and cited by examiner.

(F) Where the reasons for allowance *are* of record but, in the examiner's judgment, are unclear (e.g., spread throughout the file history) so that an unreasonable effort would be required to collect them.

(G) Allowance based on a claim interpretation which might not be readily apparent, for example:(1) Article claims in which method limitations impart patentability.

(2) Method claims in which article limitations impart patentability.

(3) Claim is so drafted that "nonanalogous" art is not applicable.

(4) Preamble or functional language "breathes life" into claim.

(H) Allowance following decision by the United States Court of Appeals for the Federal Circuit or District Court of the District of Columbia.The reasons for allowance should refer to and incorporate the briefs and the court decision.

(I) Where the claims are considered patentable over the X and/or Y references cited in a search report of a corresponding PCT application and the reasons for allowance are not apparent from the record.

III. EXAMPLES OF STATEMENTS OF SUITABLE CONTENT

(A) The primary reason for allowance of the claims is the inclusion of .03 to .05 percent nickel in all of the claims. Applicant's second affidavit in example 5 shows unexpected results from this restricted range.

(B) During two telephonic interviews with applicant's attorney, Mr..... on 5/6 and 5/10/77, the examiner stated that applicant's remarks about the placement of the primary teaching's grid member were persuasive, but he pointed out that applicant did not claim the member as being within the reactor. Thus, an amendment doing such was agreed to.

(C) The claims in the application are deemed to be directed to an nonobvious improvement over the invention patented in Pat. No. 3,953,224. The claims comprise baffle means 12 whose effective length in the extraction tower may be varied so as to optimize and to control the extraction process.

(D) Upon reconsideration, this application has been awarded the effective filing date of application number -/---. Thus the rejection under **35 U.S.C. 102(d)** and 103 over Belgium Patent No. 757,246 is withdrawn.

(E) The specific limitation as to the pressure used during compression was agreed to during the telephone interview with applicants' attorney. During said interview, it was noted that applicants contended in their amendment that a process of the combined applied teachings could not result in a successful article within a particular pressure range (see page 3, bottom, of applicant's amendment). The examiner agreed and allowed the application after incorporating the pressure range into the claim.

(F) In the examiner's opinion, it would not have been obvious to a person of ordinary skill in the art first to eliminate one of top members 4, second to eliminate plate 3, third to attach remaining member 4 directly to tube 2 and finally to substitute this modified handle for the handle 20 of Nania (see Fig. 1) especially in view of applicant's use of term "consisting."

(G) The application is allowable for the reasons set forth on page -- of the decision of the Court of Appeals for the Federal Circuit, which is hereby incorporated by reference. As noted therein, and as argued on page -- of Appellant's brief, the claimed invention requires a one piece tubular member whereas the closest prior art requires a multiple piece assembly which does not teach or suggest the claimed invention.

IV. EXAMPLES OF STATEMENTS THAT ARE NOT SUITABLE AS TO CONTENT

(A) The 3-roll press couple has an upper roll 36 which is swingably adjustable to vary the pressure selectively against either of the two lower rolls. (NOTE: The significance of this statement may not be clear if no further explanation is given.)

(B) The main reasons for allowance of these claims are applicant's remarks in the appeal brief and an agreement reached in the appeal conference.

(C) The instant composition is a precursor in the manufacture of melamine resins. A thorough search of the prior art did not bring forth any composition which corresponds to the instant composition. The examiner in the art also did not know of any art which could be used against the instant composition.

(D) Claims 1-6 have been allowed because they are believed to be both novel and nonobvious.

"" The examiner should *not* include in his or her statement any matter which does not relate directly to the reasons for allowance. For example:

(E) Claims 1 and 2 are allowed because they are patentable over the prior art. If applicants are aware of better art than that which has been cited, they are required to call such to the attention of the examiner.

(F) The reference Jones discloses and claims an invention similar to applicant's. However, a comparison of the claims, as set forth below, demonstrates the conclusion that the inventions are noninterfering.

Most instances when the examiner finds a need to place in the file a statement of the reasons for allowing a claim or claims will come at the time of allowance. In such cases, the examiner should (a) check the appropriate box on the form PTOL-37 and (b) attach thereto a paper containing the examiner's statement of reasons for allowance. Such a statement should be typewritten. The paper should identify the application number and be clearly labeled "Statement of Reasons for Allowance." It should also specify that comments may be filed by the applicant on the statement and should preferably be submitted with the payment of the issue fee so as not to delay processing of the application and in any event no later than payment of the issue fee.

Form paragraph 13.03 may be used for this purpose.

¶ *13.03 Reasons for Allowance*

The following is an examiner's statement of reasons for allowance: **[1]**

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Examiner Note:

1. Do not use this form paragraph in reexamination proceedings, see form paragraph 22.16.

2. In bracket 1, provide a detailed statement of the reason(s) certain claim(s) have been indicated as being allowable or as containing allowable subject matter.

A statement may be sent to applicant with other communications, where appropriate, but should be clearly labeled as a "Statement of Reasons for Allowance" and contain the data indicated above.

Form paragraph 13.13.01 may be used to specify the reasons for indicating allowable subject matter in a communication prior to allowance.

¶ *13.03.01 Reasons for Indication of Allowable Subject Matter*

The following is a statement of reasons for the indication of allowable subject matter: **[1]**

Examiner Note:

1. This form paragraph is for use in an Office action prior to allowance of the application. Use form paragraph 13.03 in the Notice of Allowability.

2. In bracket 1, provide a detailed statement of the reason(s) certain claim(s) have been indicated as being allowable or as containing allowable subject matter.

V. APPLICANT'S COMMENTS ON THE REASONS FOR ALLOWANCE

The examiner's statement of reasons for allowance is an important source of prosecution file history. See *Zenith Labs., Inc. v. Bristol-Myers Squibb Co.*, 19 F.3d 1418, 30 USPQ2d 1285 (Fed. Cir. 1996). The examiner's statement of reasons for allowance is the personal opinion of the examiner as to why the claims are allowable. The examiner's statement should not create an *estoppel*. Only applicant's statements should create an *estoppel*. The failure of applicant to comment on the examiner's statement of reasons for allowance should not be treated as acquiescence to the examiner's statement. See *Salazar v. Procter & Gamble Co.*, 414 F.3d 1342, 1347, 75 USPQ2d 1369, 1373 (Fed. Cir. 2005). Any inferences or presumption are to be determined on

a case-by-case basis by a court reviewing the patent, the USPTO examining the patent in a reissue application or a reexamination proceeding, the Board of Patent Appeals and Interferences reviewing the patent in an interference proceeding, etc. Applicant may set forth his or her position if he or she disagrees with the examiner's reasons for allowance.

Comments filed by the applicant on the examiner's statement of reasons for allowance, should preferably be submitted no later than the payment of the issue fee, to avoid processing delays. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance." Comments will be entered in the application file by the Office of Publication with an appropriate notation on the "Contents" list on the file wrapper.

The application file generally will not be returned to the examiner after the entry of such comments made by applicant on the examiner's statement of reasons for allowance. Therefore, the absence of an examiner's response to applicant's comments does not mean that the examiner agrees with or acquiesces in the reasoning of such comments. See 37 CFR 1.104(e). While the examiner may review and comment upon such a submission, the examiner has no obligation to do so.

1303 Notice of Allowance [R-08.2012]

37 CFR 1.311 Notice of Allowance.

(a) If, on examination, it appears that the applicant is entitled to a patent under the law, a notice of allowance will be sent to the applicant at the correspondence address indicated in § 1.33. The notice of allowance shall specify a sum constituting the issue fee which must be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. The sum specified in the notice of allowance may also include the publication fee, in which case the issue fee and publication fee (§ 1.211(e)) must both be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. This three-month period is not extendable.

(b) An authorization to charge the issue fee or other post-allowance fees set forth in § 1.18 to a deposit account may be filed in an individual application only after mailing of the notice of allowance. The submission of either of the following after the mailing of a notice of allowance will operate as a request to charge the correct issue fee or any publication fee due to any deposit account identified in a previously filed authorization to charge such fees:(1) An incorrect issue fee or publication fee; or

(2) A fee transmittal form (or letter) for payment of issue fee or publication fee.

A Notice of Allowance is prepared and mailed, and the mailing date appearing thereon is recorded on the paper or image file wrapper table of contents.

If an application is subject to publication under 37 CFR 1.211, the Notice of Allowance will require both the issue fee and the publication fee. See 37 CFR 1.211(e). The Notice of Allowance and Issue Fee Due form (PTOL-85) has been revised and the revised form is entitled "Notice of Allowance and Fee(s) Due." Revision of the form was necessary to include the amount of any required publication fee, as provided in 37 CFR 1.211(e) and 1.311, and to more clearly communicate the amount of any patent term extension or adjustment earned under 35 U.S.C. 154(b). As revised, the PTOL-85 form is three pages long, with all three pages being mailed to the applicant and a duplicate being retained in the application file. The first two pages of the revised form include an indication that the publication fee is due, if the application was subject to publication and the publication fee has not already been paid. Part B of the revised form (PTOL-85B) must be returned to the Office with the payment of the issue fee. Applicants are reminded to transmit an extra copy of the PTOL-85B when payment of the issue fee is by way of authorization to debit a Deposit Account. See MPEP § 509.01.

There are different versions of page three of the revised PTOL-85 form, depending upon the filing date of the application and the application type:

(A) For applications filed before June 8, 1995, page three will state that "This application was filed prior to June 8, 1995, thus no Patent Term Extension or Adjustment applies." Utility and plant applications filed before June 8, 1995 are eligible for a 17 year term and thus are not eligible for patent term extension or adjustment under 35 U.S.C. 154(b).

(B) For applications filed on or after June 8, 1995 and before May 29, 2000, page three will state that "The Patent Term Extension is _ day(s). Any patent to issue from the above identified application will include an indication of the _ extension on the front page. If a Continued Prosecution Application (CPA) was filed in the above identified application, the filing date that determines Patent Term Extension is the filing date of the most recent CPA." Utility and plant applications filed on or after June 8, 1995 and before May 29, 2000 may be eligible for patent

term extension. See 35 U.S.C. **154**(b), effective June 8, 1995, and 37 CFR **1.701**.

(C) For applications filed on or after May 29, 2000, page three will state that "The Patent Term Adjustment to date is _ day(s). If the issue fee is paid on a date that is three months after the mailing date of this notice, and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be _ day(s). If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA." Utility and plant applications filed on or after May 29, 2000 may be eligible for patent term adjustment. See 35 U.S.C. **154**(b), effective May 29, 2000, and 37 CFR **1.702** - **1.705**, especially 37 CFR **1.705**(a).

(D) For reissue applications, page three will state that "A reissue patent is for 'the unexpired part of the term of the original patent.' See 35 U.S.C. **251**. Accordingly, the above-identified reissue application is not eligible for Patent Term Extension or Adjustment under 35 U.S.C. **154**(b)."

(E) For design applications, page three will state that "Design patents have a term measured from the issue date of the patent and the term remains the same length regardless of the time that the application for the design patent was pending. Since the above-identified application is an application for a design patent, the patent is not eligible for Patent Term Extension or Adjustment under 35 U.S.C. **154**(b)."

For more information about eighteen month publication, publication fees, and patent term adjustment, visit the USPTO Internet web site at www.uspto.gov.

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

NOTICE OF ALLOWANCE AND FEE(S) DUE

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED:

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.

TITLE OF INVENTION:

APPLN. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL, or its equivalent, must be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted. If an equivalent of Part B is filed, a request to reapply a previously paid issue fee must be clearly made, and delays in processing may occur due to the difficulty in recognizing the paper as an equivalent of Part B.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

PTOL-85 (Rev. 07/06) Approved for use through 04/30/2007.

PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), to: Mail **Mail Stop ISSUE FEE**
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450
or Fax (571)-273-2885

INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

Certificate of Mailing or Transmission
I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

(Depositor's name)
(Signature)
(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.

TITLE OF INVENTION:

APPLN. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE

EXAMINER	ART UNIT	CLASS-SUBCLASS

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).
❑ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.
❑ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. **Use of a Customer Number is required.**

2. For printing on the patent front page, list
(1) the names of up to 3 registered patent attorneys or agents OR, alternatively,
(2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.
1 _____
2 _____
3 _____

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE (B) RESIDENCE: (CITY and STATE OR COUNTRY)

Please check the appropriate assignee category or categories (will not be printed on the patent) : ❑ Individual ❑ Corporation or other private group entity ❑ Government

4a. The following fee(s) are submitted:
❑ Issue Fee
❑ Publication Fee (No small entity discount permitted)
❑ Advance Order - # of Copies _____

4b. Payment of Fee(s): **(Please first reapply any previously paid issue fee shown above)**
❑ A check is enclosed.
❑ Payment by credit card. Form PTO-2038 is attached.
❑ The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment, to Deposit Account Number _____ (enclose an extra copy of this form).

5. **Change in Entity Status** (from status indicated above)
❑ a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27.
❑ b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature _____ Date _____

Typed or printed name _____ Registration No. _____

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

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.

PTOL-85 (Rev. 07/06) Approved for use through 04/30/2007. OMB 0651-0033 U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED:

Determination of Patent Term Extension or Adjustment under 35 U.S.C. 154 (b)
(application filed prior to June 8, 1995)

This patent application was filed prior to June 8, 1995, thus no Patent Term Extension or Adjustment applies.

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

PTOL-85 (Rev. 07/06) Approved for use through 04/30/2007.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED:

Determination of Patent Term Extension under 35 U.S.C. 154 (b)
(application filed after June 7, 1995 but prior to May 29, 2000)

The Patent Term Extension is day(s). Any patent to issue from the above-identified application will include an indication of the day extension on the front page.

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Extension is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (http://pair.uspto.gov).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

PTOL-85 (Rev. 07/06) Approved for use through 04/30/2007.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.

EXAMINER	

ART UNIT	PAPER NUMBER

DATE MAILED:

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)
(application filed on or after May 29, 2000)

The Patent Term Adjustment to date is day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (http://pair.uspto.gov).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED:

Determination of Patent Term Extension or Adjustment under 35 U.S.C. 154 (b)

A reissue patent is for "the unexpired part of the term of the original patent." See 35 U.S.C. 251. Accordingly, the above-identified reissue application is not eligible for Patent Term Extension or Adjustment under 35 U.S.C. 154(b).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

PTOL-85 (Rev. 07/06) Approved for use through 04/30/2007.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED:

Determination of Patent Term Extension or Adjustment under 35 U.S.C. 154 (b)

Design patents have a term measured from the issue date of the patent and the term remains the same length regardless of the time that the application for the design patent was pending. Since the above-identified application is an application for a design patent, the patent is not eligible for Patent Term Extension or Adjustment under 35 U.S.C. 154(b).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

PTOL-85 (Rev. 07/06) Approved for use through 04/30/2007.

1303.01 Amendment Received After Allowance [R-08.2012]

If the amendment is filed under 37 CFR 1.312, see MPEP § 714.15 to § 714.16(e). If the amendment contains claims copied from a patent, see MPEP Chapter 2300. Any submissions of replacement drawings filed after allowance should be forwarded to the Office of Patent Publication.

Reference to an Issue Batch Number is no longer necessary because the Office no longer stores and tracks applications according to issue batches.

Any paper filed after receiving the Issue Notification should include the indicated patent number, unless the application has been withdrawn from issue.

1303.02 Undelivered [R-08.2012]

In case a Notice of Allowance is returned, and a new notice is sent (see MPEP § 707.13), the date of sending the notice must be changed in the file to agree with the date of such remailing. If the application is an Image File Wrapper (IFW) application, the original document, a copy of the returned document with any markings, and the remailed document should be retained in the application so that the file history is clear.

1303.03 Not Withheld Due to Death of Inventor [R-08.2012]

The Notice of Allowance will not be withheld due to death of the inventor if the executor or administrator has not intervened. See MPEP § 409.01(f).

1304 Amendments After D-10 Notice [R-08.2012]

For amendments received after D-10 Notice, see MPEP § 130.

1304.01 Withholding From Issue of "Secrecy Order" Applications [R-08.2012]

"Secrecy Order" applications are not sent to issue even when all of the claims have been allowed. Instead of mailing a Notice of Allowance, a D-10 Notice is sent. See MPEP § 130.

If the "Secrecy Order" in an application is withdrawn after the D-10 notice is mailed, the application should then be treated like an ordinary application in condition for allowance.

1305 Jurisdiction [R-08.2012]

Jurisdiction of the application remains with the primary examiner until the Notice of Allowance is mailed. However, the examiner may make examiner's amendments correcting obvious errors, as when brought to the attention of the examiner by the printer, and also may admit amendments under 37 CFR 1.312 which are confined to matters of form in the specification or claims, or to the cancellation of a claim or claims. The examiner's action on other amendments under 37 CFR 1.312 consists of a recommendation to the Director.

To regain jurisdiction over the application, the examiner must write a letter to the Director requesting it. See MPEP § 1308 and § 1308.02.

Once the patent has been granted, the U.S. Patent and Trademark Office can take no action concerning it, except as provided in 35 U.S.C. 135,35 U.S.C.

251 through 256, 35 U.S.C. 302 through 307 and 35 U.S.C. 311 through 316.

1306 Issue Fee [R-08.2012]

The issue fee and any required publication fee are due 3 months from the date of the Notice of Allowance. The amount of the issue fee and any required publication fee are shown on the Notice of Allowance. The Notice of Allowance will also reflect any issue fee previously paid in the application. The issue fee due does not reflect a credit for any previously paid issue fee in the application. If an issue fee has previously been paid in the application as reflected in the Notice of Allowance, the return of Part B (Fee(s) Transmittal form) will be considered a request to reapply the previously paid issue fee toward the issue fee that is now due. For example, if the application was allowed and the issue fee paid, but applicant withdrew the application from issue and filed a Request for Continued Examination (RCE) and the application was later allowed, the Notice of Allowance will reflect an issue fee amount that is due and the issue fee that was previously paid. Had applicant filed a Continued Prosecution Application (CPA) instead of an RCE, the Notice of Allowance would not reflect any issue fee paid before the CPA was filed because the issue fee was paid in a prior application. Note that because the amount of the fees(s) due is determined by the fees set forth in 37 CFR 1.18 which are in effect as of the date of submission of payment of the fees(s), the amount due at the time the fee(s) are paid may differ from the amount indicated on the Notice of Allowance. Accordingly, applicants are encouraged, at the time of submitting payment of the fees(s), to determine whether the amount of the issue fee due or any required publication fee has changed to avoid the patent lapsing for failure to pay the balance of the issue fee due (37 CFR 1.317) or becoming abandoned for failure to pay the publication fee. The amounts due under 35 U.S.C. 41(a) (i.e., the issue fee, but not the publication fee) are reduced by 50 per centum for small entities.

Applicants and their attorneys or agents are urged to use the Fee(s) Transmittal form (PTOL-85B) provided with the Notice of Allowance when submitting their payments. Unless otherwise directed, all post allowance correspondence should be addressed "Mail Stop Issue Fee."

Where it is clear that an applicant actually intends to pay the issue fee and required publication fee, but the proper fee payment is not made, for example, an incorrect issue fee amount is supplied, or a PTOL-85B Fee(s) Transmittal form is filed without payment of the issue fee, a general authorization to pay fees or a specific authorization to pay the issue fee, submitted prior to the mailing of a notice of allowance, will be allowed to act as payment of the correct issue fee. 37 CFR 1.311(b). In addition, where the deposit account information is added to the Fee(s) Transmittal form (PTOL-85B), but the check box authorizing that the deposit account be charged the issue fee is not checked, the deposit account will still be charged the required issue fee and any required publication fee.

Technology Center personnel should forward all post allowance correspondence to the Office of Initial Patent Examination (OIPE). The papers received by the OIPE will be scanned and matched with the appropriate application and the entire application will be forwarded to the appropriate Technology Center for processing.

The payment of the issue fee due may be simplified by using a U.S. Patent and Trademark Office Deposit Account or a credit card payment with form PTO-2038 for such a fee. See MPEP § 509. However, any such payment must be specifically authorized by reference to the "issue fee" or "fees due under 37 CFR 1.18."

The fee(s) due will be accepted from the applicant, assignee, or a registered attorney or agent, either of record or under 37 CFR 1.34.

The Director has no authority to extend the time for paying the issue fee. Intentional failure to pay the issue fee within the 3 months permitted by 35 U.S.C. 151 does not amount to unavoidable or unintentional delay in making payment.

1306.01 Deferring Issuance of a Patent [R-08.2012]

37 CFR 1.314 Issuance of patent.

If applicant timely pays the issue fee, the Office will issue the patent in regular course unless the application is withdrawn from issue (§ 1.313) or the Office defers issuance of the patent. To request that the Office defer issuance of a patent, applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why it is necessary to defer issuance of the patent.

There is a public policy that the patent will issue in regular course once the issue fee is timely paid. 37 CFR 1.314. It has been the policy of the U.S. Patent and Trademark Office to defer issuance of a patent, upon request, for a period of up to 1 month only, in the absence of extraordinary circumstances or requirement of the regulations (e.g., 37 CFR 1.177) which would dictate a longer period. Situations like negotiation of licenses, time for filing in foreign countries, collection of data for filing a continuation-in-part application, or a desire for simultaneous issuance of related applications are not considered to amount to extraordinary circumstances.

A petition to defer issuance of a patent is not appropriate until the issue fee is paid. Issuance of a patent cannot be deferred after an allowed application receives a patent number and issue date unless the application is withdrawn from issue under 37 CFR 1.313(b) or (c). The petition to defer is considered at the time the petition is correlated with the application file before the appropriate deciding official (MPEP § 1002.02(b)). In order to facilitate consideration of a petition for deferment of issue, the petition should be firmly attached to the Fee(s) Transmittal form (PTOL-85B) and clearly labeled as a Petition to Defer Issue; Attention: Office of Petitions.

1306.02 Simultaneous Issuance of Patents [R-08.2012]

Where applications have been allowed and a Notice of Allowance and Fee(s) Due (PTOL-85) has been mailed in each application, a request for simultaneous issuance will be granted. Unless all the applications have reached this stage of processing, or a specific requirement of the regulations is involved (e.g., 37 CFR 1.177), a request for simultaneous issuance generally will not be granted.

Applicants and their attorneys who desire the simultaneous issue of allowed applications must submit the request to: Mail Stop Issue Fee, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, Attention: Office of Patent Publication.

The request must contain the following information about *each* allowed application for which simultaneous issue is requested:

(A) Application number,
(B) Filing date,
(C) Name(s) of inventor(s),
(D) Title of invention, and
(E) Date of allowance.

Separate copies of the request must accompany *each* Fee(s) Transmittal (PTOL-85B).

1306.03 Practice After Payment of Issue Fee; Receipt of Issue Notification [R-08.2012]

Under the current publication process, utility and reissue patents are issued within about four weeks after the issue fee and any required publication fee are received in the Office. A patent number and issue date will be assigned to an application and an Issue Notification will be mailed after the issue fee has been paid and processed by the USPTO. Because the Issue Notification may be mailed less than two weeks before the application is expected to issue as a patent, applicants are advised to file any continuing application before receiving the Issue Notification to avoid loss of copendency.

Since the Office cannot ensure that any paper filed after payment of the issue fee will reach the appropriate USPTO official before the date the application issues as a patent, applicants are also encouraged to file any necessary amendments, assignments, petitions, information disclosure statements, or other papers prior to the date of issue fee payment, preferably within one month after the Notice of Allowance has been mailed. See MPEP § 502 for post allowance correspondence.

In order to minimize disruptions and delays in the printing process, the application is **not** available after the Notice of Allowance has been mailed unless necessary for "Query Printer Waiting", amendments submitted under 37 CFR 1.312, information disclosure statements, and petitions. Corrected filing

receipts will not be mailed after the date of mailing of the Notice of Allowance unless special circumstances exist. Duplicate filing of papers is not recommended (and may be treated as a failure to engage in reasonable efforts to conclude prosecution pursuant to 37 CFR 1.704(c)(10)). The same correspondence should not be mailed and faxed to the Office unless the duplication has been specifically required by the Office. See MPEP § 719.01(a).

ORDERING OF ALLOWED APPLICATIONS MAINTAINED IN PAPER

Examining corps personnel must submit a request to the Office of Patent Publications Image Assistance Center when ordering an allowed application file that is maintained in paper.

1307 Change in Classification of Cases Which Are in Issue [R-08.2012]

See MPEP § 903.07.

1308 Withdrawal From Issue [R-08.2012]

37 CFR 1.313 Withdrawal from issue.

(a) Applications may be withdrawn from issue for further action at the initiative of the Office or upon petition by the applicant. To request that the Office withdraw an application from issue, applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why withdrawal of the application from issue is necessary. A petition under this section is not required if a request for continued examination under § 1.114 is filed prior to payment of the issue fee. If the Office withdraws the application from issue, the Office will issue a new notice of allowance if the Office again allows the application.

(b) Once the issue fee has been paid, the Office will not withdraw the application from issue at its own initiative for any reason except:(1) A mistake on the part of the Office;

(2) A violation of § 1.56 or illegality in the application;

(3) Unpatentability of one or more claims; or

(4) For interference.

(c) Once the issue fee has been paid, the application will not be withdrawn from issue upon petition by the applicant for any reason except:(1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;

(2) Consideration of a request for continued examination in compliance with § 1.114; or

(3) Express abandonment of the application. Such express abandonment may be in favor of a continuing application.

(d) A petition under this section will not be effective to withdraw the application from issue unless it is actually received and granted by the appropriate officials before the date of issue. Withdrawal of an application from issue after payment of the issue fee may not be effective to avoid publication of application information.

I. WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE APPLICANT

A. Prior to the Payment of Issue Fee

If the applicant wishes to have an application withdrawn from issue, he or she must petition the Director under 37 CFR 1.313(a) or file a request for continued examination (RCE) under 37 CFR 1.114 with a submission and the fee set forth in 37 CFR 1.17(e). A submission may be an information disclosure statement (37 CFR 1.97 and 1.98) or an amendment. The RCE practice does not apply to utility or plant applications filed before June 8, 1995 and design applications. See MPEP § 706.07(h), subsections I, II and IX. If an applicant files a RCE (with the fee and a submission), the applicant need not pay the issue fee to avoid abandonment of the application. Applicants are cautioned against filing a RCE prior to payment of the issue fee and subsequently paying the issue fee (before the Office acts on the RCE) because doing so may result in issuance of a patent without consideration of the RCE (if the RCE is not matched with the application before the application is processed into a patent).

Petitions under 37 CFR 1.313(a) to have an application withdrawn from issue should be directed to the Technology Center (TC) Director to which the application is assigned (see MPEP § 1002.02(c)). Unless applicant receives a written communication from the Office that the application has been withdrawn from issue, the issue fee must be timely submitted to avoid abandonment.

Applicant may also file a continuing application on or before the day the issue fee is due and permit the parent application to become abandoned for failure to pay the issue fee (35 U.S.C. 151).

B. After the Payment of Issue Fee

Once the issue fee is paid, withdrawal is permitted only for the reasons stated in 37 CFR 1.313(c). The status of the application at the time the petition is filed is determinative of whether the petition is considered under 37 CFR 1.313(a) or 37 CFR 1.313(c). Petitions under 37 CFR 1.313(c) to have an application withdrawn after payment of the issue

fee should be directed to the Office of Petitions (see MPEP § 1002.02(b)).

In addition to the specific reasons identified in 37 CFR 1.313(c)(1)-(3) applicant should identify some specific and significant defect in the allowed application before the application will be withdrawn from issue. A petition under 37 CFR **1.313(c)** based on the reason specified in 37 CFR **1.313(c)(2)** can only be filed in utility or plant applications filed on or after June 8, 1995 because the request for continued examination (RCE) practice does not apply to these types of applications filed before June 8, 1995 and design applications. See MPEP § **706.07(h)**, subsections I and IX. Such a petition along with the petition fee set forth in 37 CFR **1.17(h)** must include a request for continued examination in compliance with 37 CFR **1.114** (e.g., a submission and the fee set forth in 37 CFR **1.17(e)**). The continued prosecution application (CPA) practice under 37 CFR **1.53(d)** only applies to design applications. See MPEP § **201.06(d)**. To withdraw from issue a utility or plant application, an applicant may wish to file a petition under 37 CFR **1.313(c)(2)** with a RCE or under 37 CFR **1.313(c)(3)** for the express abandonment of the application in favor of a continuing application under 37 CFR **1.53(b)**, but not a CPA under 37 CFR **1.53(d)**.

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)." Petitions to withdraw an application from issue under 37 CFR **1.313**(c) may be:

(A) mailed to "Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450";

(B) transmitted by facsimile to (571) 273-0025; or

(C) hand-carried to the Office of Petitions (see MPEP § **1730** for the location).

Applicants are strongly advised to transmit by facsimile or hand-carry the petition to the Office of Petitions to allow sufficient time to process the petition and if the petition can be granted, withdraw the application from issue. While a petition to withdraw an application from issue may be granted as late as one day prior to the patent issue date, to avoid publication and dissemination, the petition decision must be granted at least 3 weeks prior to the issue date.

The Office cannot ensure that any petition under 37 CFR **1.313(c)** will be acted upon prior to the date of patent grant. See *Filing of Continuing Applications, Amendments, or Petitions after Payment of Issue Fee* , Notice, 1221 *Off. Gaz. Pat. Office* 14 (April 6, 1999). Since a RCE (unlike a CPA under 37 CFR **1.53(d))** is not any type of new application filing, the Office cannot grant a petition to convert an untimely RCE to a continuing application under 37 CFR **1.53(b)**. Therefore, applicants are strongly cautioned to file any desired RCE prior to payment of issue fee. In addition, applicants considering filing a RCE after payment of the issue fee are strongly cautioned to call the Office of Petitions to determine whether sufficient time remains before the patent issue date to consider (and grant) a petition under 37 CFR **1.313(c)** and what steps are needed to ensure that a grantable petition under 37 CFR **1.313(c)** is before an appropriate official in the Office of Petitions in sufficient time to grant the petition before the patent is issued.

If an application has been withdrawn from issue after the payment of the issue fee and the application is again found allowable, see MPEP § **1306** regarding request to reapply a previously paid issue fee toward the issue fee that is now due in the same application.

II. WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE

The Director may withdraw an application from issue under 37 CFR **1.313** on his or her own initiative. See *BlackLight Power Inc. v. Rogan* , 295 F.3d 1269, 1273, 63 USPQ2d 1534, 1537 (Fed. Cir. 2002) (USPTO may withdraw a patent application from issuance after the issue fee has been paid.) and*Harley v. Lehman* , 981 F. Supp. 9, 12, 44 USPQ2d 1699, 1702 (D.D.C. 1997) (adoption of 37 CFR 1.313(b) permitting applications to be withdrawn from issue under certain narrow circumstances not directly covered by the statute was not unreasonable). **35 U.S.C. 151** provides that upon payment of the issue fee, "the patent shall issue." Thus, an application cannot be withdrawn

from issue after payment of the issue fee consistent with 35 U.S.C. 151 unless there has been a determination that at least one of the conditions specified at 37 CFR 1.313(b)(1) through (4) exist such that the applicant is no longer "entitled to a patent under the law" as provided in 35 U.S.C. 151. See *BlackLight Power Inc. v. Rogan* , 295 F.3d at 1273, 63 USPQ2d at 1537 (Fed. Cir. 2002) (USPTO is not required to make final determination of unpatentability before withdrawing an application from issue pursuant to 37 CFR 1.313(b)(3), which permits the Office to withdraw an application after payment of the issue fee on ground of "unpatentability of one or more claims.");*Harley v. Lehman* , 981 F. Supp. at 11-12, 44 USPQ2d at 1701-02 (D.D.C. 1997)(Commissioner may adopt rules permitting applications to be withdrawn from issue after payment of the issue fee in situations in which the applicant is not entitled to a patent under the law); and see *Sampson v. Dann* , 466 F. Supp. 965, 973-74, 201 USPQ 15, 22 (D.D.C. 1978)(Commissioner not authorized to withdraw an application from issue after payment of the issue fee on an *ad hoc* basis, but only in situations which meet the conditions of 37 CFR 1.313(b)).

The authority to withdraw an application from issue at the initiative of the USPTO after payment of the issue fee under 37 CFR 1.313(b) has been delegated to TC Directors (see MPEP § 1002.02(c)). The Office of Petitions has also been delegated the authority to withdraw an application from issue after payment of the issue fee in those situations in which the request for withdrawal from issue is at the initiative of the USPTO by someone other than a TC Director (see MPEP § 1002.02(b)).

35 U.S.C. 151 and 37 CFR 1.313(b) do not authorize the USPTO to withdraw an application from issue after payment of the issue fee for any reason **except**:

(1) a mistake on the part of the Office:
(2) a violation of 37 CFR 1.56 or illegality in the application;
(3) unpatentability of one or more claims; or
(4) for interference.

See 37 CFR 1.313(b).

Examples of reasons that do **not** warrant withdrawing an application from issue after payment of the issue fee at the initiative of the Office are:

(A) to permit the examiner to consider an information disclosure statement;
(B) to permit the examiner to consider whether one or more claims are unpatentable; or
(C) to permit the applicant to file a continuing application (including a CPA).

An application may be removed from the Office of Patent Publication, without it being withdrawn from issue under 37 CFR 1.313(b), to permit the examiner to consider an information disclosure statement or whether one or more claims are unpatentable. Only if such consideration results in a determination that one or more claims are unpatentable does 37 CFR 1.313(b) authorize the application to be withdrawn from issue. If uncertainty exists as to whether prosecution will in fact be re-opened, the uncertainty must be resolved before the application is withdrawn from issue. If there is a question whether an application must be withdrawn from issue and no TC Director is available to decide whether withdrawal from issue is appropriate and to sign the withdrawal Notice, the application should be hand-carried to the Office of Petitions for decision on whether withdrawal from issue is appropriate and to effect the withdrawal.

Any notice withdrawing an application from issue after payment of the issue fee must specify which of the conditions set forth in 37 CFR 1.313(b)(1) through (4) exists and thus warrants withdrawal of the application from issue. Any petition under 37 CFR 1.181 to review the decision of a TC Director to withdraw an application from issue after payment of the issue fee will be decided by the Deputy Commissioner for Patent Examination Policy.

If an application has been withdrawn from issue after the payment of the issue fee and the application is again found allowable, see MPEP § 1306 regarding request to reapply a previously paid issue fee toward the issue fee that is now due in the same application.

Procedure to be followed when an application is withdrawn from issue

The procedure set forth below is to be followed when a TC Director withdraws an application from issue. This processing is to be done in the Technology Center without the need to send the application to the Office of Patent Publication.

First, determine (via PALM) whether the issue fee has been paid, and whether the application has been assigned a patent number and issue date.

1. Withdrawal From Issue Before Payment of Issue Fee

If the issue fee **has not** been paid and the deadline for payment has not expired:

(A) Prepare, date stamp, and mail a "Withdrawal from Issue" letter signed by the TC Director to the applicant to effectuate the withdrawal from issue, using form paragraph 10.01. A copy of the "Withdrawal from Issue" letter should be sent to the Office of Patent Publication.

(B) Change the status of the application to status code 066 (Previous Action Withdrawn - Awaiting Further Action). Enter the Withdrawal from Issue letter in the application file and make it of record on the application file contents.

(C) Stick an Issue Information Label (Form 2016) on the file wrapper over the filled-in boxes on the file wrapper that contain issue information. If the application is an Image File Wrapper (IFW) application, this step is not done; instead a new Issue Classification sheet will be completed if the application is subsequently allowed.

(D) Forward the application to the examiner for **prompt** appropriate action (*e.g.*, reopen prosecution, initiate interference proceedings).

¶ *10.01 Withdrawal From Issue, Fee Not Paid*

In re Application of **[1]**: Appl. No.: **[2]**:: **WITHDRAWAL FROM ISSUE** Filed: **[3]**: ***37 CFR 1.313*** For: **[4]**:

The purpose of this communication is to inform you that the above identified application is being withdrawn from issue pursuant to **37 CFR 1.313**.

The application is being withdrawn to permit reopening of prosecution. The reasons therefor will be communicated to you by the examiner.

U.S. Patent and Trademark Office records reveal that the issue fee and the publication fee have not been paid. If the issue fee and the publication fee have been submitted, the applicant may request a refund, or may request that the fee be credited to a deposit account. However, applicant may wait until the application is either again found allowable or held abandoned. If the application is allowed, upon receipt of a new Notice of Allowance and Fee(s) Due, applicant may request that the previously submitted issue fee and publication fee be applied toward payment of the issue fee and publication fee in the amount identified on the new Notice of Allowance and Fee(s) Due. If the application is abandoned, applicant may request either a refund or a credit to a specified Deposit Account.

The application is being forwarded to the examiner for action.

_____

[5]

Director,

Technology Center **[6]**

[7]

Examiner Note:

1. This letter is printed with the USPTO letterhead and must be signed by the TC Director.

2. DO NOT use this form letter if the issue fee and publication fee have been paid.

3. In bracket 7, insert the correspondence address of record.

2. Withdrawal From Issue After Payment of Issue Fee

If the issue fee **has** been paid:

(A) Prepare, sign, date stamp, and mail a "Notice of Withdrawal From Issue under 37 CFR 1.313(b)" to the applicant indicating that the application has been withdrawn from issue (using one of the form letters WDR-TCB1, WDR-TCB2, WDR-TCB3, or WDR-TCB4).

(B) If the application has been assigned a patent number and issue date: (1) Prepare a "Withdrawal from Issue of" memorandum using the form memorandum WDR-MEMO. E-mail the memorandum to the Director of the Office of Patent Publication and the persons copied on the memorandum to inform them that the application has been withdrawn from issue.

(2) The "Notice of Withdrawal From Issue under 37 CFR 1.313(b)" letter to applicant must be signed, date stamped, and mailed no later than the Monday before the issue date to be effective to withdraw the application from issue.

(3) Remove the patent number from the file wrapper.

(C) Change the status of the application to status code 066 (Previous Action Withdrawn - Awaiting Further Action) by using PALM transaction code 1040. Enter the "Notice of Withdrawal From Issue under 37 CFR 1.313(b)" and the "Withdrawal from Issue of" memorandum, if applicable, in the application file and make it of record on the application file contents.

(D) Stick an Issue Information Label (Form 2016) on the file wrapper over the filled-in boxes on the file wrapper that contain issue information. If the application is an IFW application, this step is not done; instead a new Issue Classification sheet will be completed if the application is subsequently allowed.

(E) Forward the application to the examiner for prompt appropriate action (*e.g.*, reopen prosecution, initiate interference proceedings).

1308.01 Rejection After Allowance [R-08.2012]

A claim noted as allowable shall thereafter be rejected only with the approval of the primary examiner. Great care should be exercised in authorizing such rejection. See **MPEP § 706.04**.

When a new reference is discovered, which obviously is applicable to one or more of the allowed claims in an application in issue, a memorandum is addressed to the Technology Center (TC) Director, requesting that the application be withdrawn from issue for the purpose of applying the new reference. This memorandum should cite the reference, and, if need be, briefly state its application. The memorandum should be submitted with the reference and the file wrapper, if the application file is in paper. If the examiner's proposed action is not approved, the memorandum requesting withdrawal from issue should not be placed in the file.

If the request to withdraw from issue is approved, the TC Director should withdraw the application from issue as explained in MPEP § **1308**. After the TC Director has withdrawn the application from issue, the examiner will prepare an Office action stating that the application has been withdrawn from issue, citing the new reference, and rejecting the claims met thereby.

The action is given a paper number and placed in the file. For Image File Wrapper (IFW) processing, see IFW Manual.

If the issue fee has already been paid and prosecution is reopened, the applicant may request a refund or request that the fee be credited to a deposit account. However, applicant may wait until the application is either found allowable or held abandoned. If allowed, upon receipt of a new Notice of Allowance, applicant may request that the previously submitted issue fee be applied (the Notice of Allowance will reflect an issue fee amount that is due and the issue fee that was previously paid). See MPEP § **1306** regarding request to reapply a previously paid issue fee toward the issue fee that is now due in the same application. If abandoned, applicant may request refund or credit to a deposit account.

1308.02 For Interference Purposes [R-08.2012]

It may be necessary to withdraw a case from issue for reasons connected with an interference. For the procedure to be followed, see MPEP **Chapter 2300** .

1308.03 Quality Review Program for Examined Patent Applications [R-08.2012]

The Office of Patent Quality Assurance administers a program for reviewing the quality of the examination of patent applications. The general purpose of the program is to improve patent quality and increase the likelihood of patents being found to be valid.

The quality review is conducted by Review Quality Assurance Specialists on a randomly selected sample of allowed applications from each examiner. The sample is computer generated under the office-wide computer system (PALM), which selects a predetermined number of allowed applications from each examiner per year for review . A subsample of the selected allowed applications are both reviewed and independently searched by the reviewers. The only applications excluded from the sample are those in which there has been a decision by the Board of Patent Appeals and Interferences, or by a court.

The Review Quality Assurance Specialist independently reviews each sampled application assigned to his or her docket to determine whether any claims may be unpatentable. The Review Quality Assurance Specialist may consult with, discuss, or review an application with any other reviewer or professional in the examining corps, except the professional who acted on the application. The review will, with or without additional search, provide the examining corps personnel with information which will assist in improving the quality of issued applications. The program shall be used as an educational tool to aid in identifying problem areas in the examining Technology Centers (TCs).

Reviewed applications may be returned to the examining TCs for consideration of the reviewer's question(s) as to adequacy of the search and/or patentability of a claim(s).

If, during the quality review process, it is determined that one or more claims of a reviewed application are unpatentable, the prosecution of the application will be reopened. The Office action should contain, as an opening, form paragraph 13.04.

¶ *13.04 Reopen Prosecution - After Notice of Allowance*

Prosecution on the merits of this application is reopened on claim **[1]** considered unpatentable for the reasons indicated below:

[2]

Examiner Note:

1. This paragraph should be used when a rejection is made on any previously allowed claim(s) which for one reason or another is considered unpatentable after the Notice of Allowance (PTOL-85) has been mailed.

2. Make appropriate rejection(s) as in any other action.

3. In bracket 1, identify claim(s) that are considered unpatentable.

4. In bracket 2, state all appropriate rejections for each claim considered unpatentable.

If the issue fee has already been paid in the application, the application must be withdrawn from issue by the Office of Patent Publication, and the action should contain not only the above quoted paragraph, but also form paragraph 13.05.

¶ *13.05 Reopen Prosecution - Vacate Notice of Allowance*

Applicant is advised that the Notice of Allowance mailed **[1]** is vacated. If the issue fee has already been paid, applicant may request a refund or request that the fee be credited to a deposit account. However, applicant may wait until the application is either found allowable or held abandoned. If allowed, upon receipt of a new Notice of Allowance, applicant may request that the previously submitted issue fee be applied. If abandoned, applicant may request refund or credit to a specified Deposit Account.

Examiner Note:

1. This form paragraph must be used when the prosecution is reopened after the mailing of the Notice of Allowance.

2. In bracket 1, insert date of the Notice of Allowance.

Quality Assurance forms and papers are *not* to be included with Office actions, nor should such forms or papers be retained in the file of any reviewed application whether or not prosecution is to be reopened. The application record should *not* indicate that a review has been conducted by Quality Assurance.

Whenever an application has been returned to the TC under the Quality Assurance Program, the TC should promptly decide what action is to be taken in the application and inform the Office of Patent Quality Assurance of the nature of that action by use of the appropriate form. If prosecution is to be reopened or other corrective action taken, only the forms should be returned to the Office of Patent Quality Assurance initially, with the application being returned to the Office of Patent Quality Assurance when action is completed. In all other instances, both the application and the forms should be returned to the Office of Patent Quality Assurance.

1309 Issue of Patent [R-08.2012]

Under the current publication process, electronic capture of most of the information to be printed in a patent will begin as soon as an allowed application is received in the Office of Patent Publication, immediately after the Notice of Allowance has been mailed. The Office of Patent Publication forwards the allowed applications to the printer for Initial Data Capture (IDC). This IDC process takes approximately five weeks to accomplish and during this time the application, if in a paper file, is **not** available to examiners or for purposes of making copies of the application (copies of the application files that have been published may be ordered from the Office of Public Records, upon payment of the

fee, but the applications will not be removed from the publication process for purposes of making copies). After IDC is completed, the application is returned to the Office of Patent Publication, and the file will be available to examiners and the Office of Public Records.

When the issue fee is paid and all other requirements have been met (e.g., drawings) within the time allowed by law, the application is forwarded to the printer for Final Data Capture (FDC) and final issue preparation. At this point, the application can only be retrieved if it is withdrawn from issue. The application is assigned a patent number and issue date about ten days before the application issues as a patent, and an Issue Notification is mailed to inform the applicant of the patent number and issue date. A bond paper copy of the patent grant is ribboned, sealed, and mailed by the Office of Patent Publication.

All allowed applications ready for printing will be selected by chronological sequence based on the date the issue fee was paid. Special handling will be given to the following applications in these categories:

(A) Allowed cases which were made special by the Director.

(B) Allowed cases that have a U.S. effective filing date more than 5 years old.

(C) Allowed reissue applications.

(D) Allowed applications having an effective filing date earlier than that required for declaring an interference with a copending application claiming the same subject matter.

(E) Allowed application of a party involved in a terminated interference.

To ensure that any application falling within the scope of the categories outlined above and identified by (A) to (E) receives special treatment, the examiner should notify, via e-mail, the Manager of the Publishing Division, Kim Terrell in the Office of Publication that a particular application (identify the application number) should be given special treatment. The examiner should state the special treatment category outlined above.

35 U.S.C. 2 Powers and duties.

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(b) SPECIFIC POWERS.— The Office— (1) shall adopt and use a seal of the Office, which shall be judicially noticed and with which letters patent, certificates of trademark registrations, and papers issued by the Office shall be authenticated;

*****

35 U.S.C. 153 How issued.

Patents shall be issued in the name of the United States of America, under the seal of the Patent and Trademark Office, and shall be signed by the Director or have his signature placed thereon and shall be recorded in the Patent and Trademark Office.

I. PRINTING NAMES OF PRACTITIONERS AND FIRM ON PATENTS

The Fee(s) Transmittal form (PTOL-85B) provides a space (item 2) for the person submitting the base issue fee to indicate, for printing, (1) the names of up to three registered patent attorneys or agents or, alternatively, (2) the name of a single firm, which has as a member at least one registered patent attorney or agent, and the names of up to two registered patent attorneys or agents. If the person submitting the issue fee desires that no name of practitioner or firm be printed on the patent, the space on the Fee(s) Transmittal form should be left blank. If no name is listed on the form, no name will be printed on the patent.

II. ASSIGNMENT PRINTED ON PATENT

The Fee(s) Transmittal form (PTOL -85B) provides a space (item 3) for assignment data which should be completed in order to comply with **37 CFR 3.81**. Unless an assignee's name and address are identified in item 3 of the Fee(s) Transmittal form PTOL-85B, the patent will issue to the applicant. Assignment data printed on the patent will be based solely on the information so supplied. See **MPEP § 307**. Recording of the assignment, or submission of the assignment for recordation as set forth in 37 CFR 3.11 is required for a Patent to issue to an assignee. See 37 CFR 3.81(a).

III. ASSIGNEE NAMES

Only the first appearing name of an assignee will be printed on the patent where multiple names for the *same* party are identified on the Fee(s) Transmittal form, PTOL-85B. Such multiple names may occur when both a legal name and an "also known as" or "doing business as" name is also included. This

printing practice will not, however, affect the practice of recording assignments with the Office in the Assignment Division. The assignee entry on form PTOL-85B should still be completed to indicate the assignment data as recorded in the Office. For example, the assignment filed in the Office and therefore the PTOL-85B assignee entry might read "Smith Company doing business as (d.b.a.) Jones Company." The assignee entry on the printed patent will read "Smith Company."

1309.01 [Reserved]

1309.02 "Query/Printer Waiting" Cases [R-08.2012]

When the printer finds an apparent error in an application, the file is returned to the Office with an attached "Query/Printer Waiting" slip noting the supposed error.

The Publishing Division forwards such "query/printer waiting" applications to the Technology Center (TC) Director's secretary. The secretary acts as a control center in each TC and forwards the applications to the examiner by the appropriate route. The application should be taken up and acted on immediately and returned to the TC Director's secretary within 72 hours (excluding weekends and holidays). Either necessary corrective action should be taken or an indication should be made that the application is considered to be correct as it stands. A copy of the query form is entered into the application file, and the response from the examiner should be clear from the record.

If the examiner concurs in the criticisms, the errors should, if possible, be corrected in clean red ink and initialed or be corrected by examiner's amendment (note that in an Image File Wrapper (IFW) application, an examiner's amendment must be made by way of a formal examiner's amendment). See **MPEP § 1302.04**.

Delays in making corrections may sometimes be avoided if the applicant or his or her representative is telephoned immediately, and the error is corrected by amendment under 37 CFR **1.312**, where appropriate.

Applications with a paper file wrapper are picked up from the TC Director's office by the messenger and returned to the Publishing Division for forwarding to the printer.

THESE APPLICATIONS SHOULD NOT BE MAILED TO THE PUBLISHING DIVISION.

A similar process exists for IFW applications, with the query form being placed into the IFW, and the response from the examiner also made part of the record. For IFW processing, see IFW Manual.