§ 1.113 Final rejection or action.

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for ex parte reexaminations filed under §1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§41.31 of this title), or to amendment as specified in §1.114 or §1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§1.181). Reply to a final rejection or action must comply with §1.114 or paragraph (c) of this section. For final actions in an inter partes reexamination filed under §1.913, see §1.953.

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

(c) Reply to a final rejection or action must comply with §1.114 or paragraph (c) of this section. For final actions in an inter partes reexamination filed under §1.913, see §1.953.

§ 1.114 Request for continued examination.

(a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in §1.17(e) before June 8, 1995; related papers, will not be considered a submission under this section.

(b) Prosecution in an application is closed as used in this section means that the application is under appeal, or that the last Office action is a final action (§1.113), a notice of allowance (§1.311), or an action that otherwise closes prosecution in the application.

(c) A submission as used in this section includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. If reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of §1.111.

(d) If an applicant timely files a submission and fee set forth in §1.17(e), the Office will withdraw the finality of any Office action and the submission will be entered and considered. If an applicant files a request for continued examination under this section after appeal, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner. An appeal brief (§41.37 of this title) or a reply brief (§41.41 of this title), or related papers, will not be considered a submission under this section.

(e) The provisions of this section do not apply to:

(1) A provisional application;

(2) An application for a utility or plant patent filed under 35 U.S.C. 111(a) before June 8, 1995;

(3) An international application filed under 35 U.S.C. 363 before June 8, 1995;

(4) An application for a design patent; or

(5) A patent under reexamination.

§ 1.115 Preliminary amendments.

(a) A preliminary amendment is an amendment that is received in the Office (§1.6) on or before the mail date of
§ 1.116 Amendments and affidavits or other evidence after final action and prior to appeal.

(a) An amendment after final action must comply with §1.114 or this section.

(b) After a final rejection or other final action (§1.113) in an application or in an ex parte reexamination filed under §1.510, or an action closing prosecution (§1.949) in an inter partes reexamination filed under §1.913, but before or on the same date of filing an appeal (§41.31 or §41.61 of this title):

(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;

(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or

(3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

(c) The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or reexamination proceeding from its condition as subject to appeal or to save the application from abandonment under §1.135, or the reexamination prosecution from termination under §1.550(d) or §1.957(b) or limitation of further prosecution under §1.957(c).

(d)(1) Notwithstanding the provisions of paragraph (b) of this section, no amendment other than canceling claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, can be made in an inter partes reexamination proceeding after the right of appeal notice under §1.953 except as provided in §1.981 or as permitted by §41.77(b)(1) of this title.

(2) Notwithstanding the provisions of paragraph (b) of this section, an amendment made after a final rejection or other final action (§1.113) in an ex parte reexamination filed under §1.510, or an action closing prosecution (§1.949) in an inter partes reexamination filed under §1.913 may not cancel claims where such cancellation affects the scope of any other pending claim in the reexamination proceeding except as provided in §1.981 or as permitted by §41.77(b)(1) of this title.

(e) An affidavit or other evidence submitted after a final rejection or other final action (§1.113) in an application or in an ex parte reexamination filed under §1.510, or an action closing prosecution (§1.949) in an inter partes reexamination filed under §1.913, but before or on the same date of filing an appeal (§41.31 or §41.61 of this title):

(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;

(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or

(3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

(4) The time periods specified in paragraph (b)(3) of this section are not extendable.

[69 FR 56543, Sept. 21, 2004]