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AUTHORITY: 35 U.S.C. 2(b)(2), unless otherwise noted.

SOURCE: 24 FR 10332, Dec. 22, 1959, unless otherwise noted.

EDITORIAL NOTES: 1. In Patent and Trademark Office publications and usage the part number is omitted from the numbers of §§1.1 to 1.352 and the numbers to the right of the decimal point correspond with the respective rule numbers.

2. For nomenclature changes to part 1, see 68 FR 14335, Mar. 25, 2003; 87 FR 68904, Nov. 17, 2022.

Subpart A—General Provisions

GENERAL INFORMATION AND CORRESPONDENCE

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

(a) *In general.* Except for correspondence submitted via the U.S. Patent and Trademark Office (USPTO) patent electronic filing system in accordance with §1.6(a)(4), all correspondence intended for the USPTO must be addressed to either ''Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313–1450'' or to specific areas within the Office as provided in this section. When appropriate, correspondence should also be marked for the attention of a particular office or individual.

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

(ii) *Patent Trial and Appeal Board.* See §41.10 or §42.6 of this title. Notices of appeal, appeal briefs, reply briefs, requests for oral hearing, as well as all other correspondence in an application or a patent involved in an appeal to the Board for which an address is not otherwise specified, should be addressed as set out in paragraph (a)(1)(i) of this section.

(2) [Reserved]

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

(ii) *Disciplinary proceedings.* Correspondence to counsel for the Director of the Office of Enrollment and Discipline relating to disciplinary proceedings pending before a Hearing Officer or the Director shall be mailed to: Mail Stop 8, Office of the Solicitor, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313–1450.

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

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

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

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

(5) *Office of Enrollment and Discipline correspondence.* All correspondence directed to the Office of Enrollment and Discipline concerning enrollment, registration, and investigation matters should be addressed to Mail Stop OED, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313–1450.

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

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

(c) *For reexamination or supplemental examination proceedings.* (1) All correspondence concerning *ex parte* reexamination, other than correspondence to the Office of the General Counsel pursuant to §1.1(a)(3) and §102.4 of this chapter, should be additionally marked ''Mail Stop *Ex Parte* Reexam.''

(2) All correspondence concerning *inter partes* reexamination, other than correspondence to the Office of the General Counsel pursuant to §1.1(a)(3) and §102.4 of this chapter, should be additionally marked ''Mail Stop *Inter Partes* Reexam.''

(3) Requests for supplemental examination (original and corrected request papers) and any other paper filed in a supplemental examination proceeding, should be additionally marked ''Mail Stop Supplemental Examination.''

(4) All correspondence concerning a reexamination proceeding ordered as a result of a supplemental reexamination proceeding, other than correspondence to the Office of the General Counsel pursuant to §1.1(a)(3) and §102.4 of this chapter should be additionally marked ''Mail Stop *Ex Parte* Reexam.''

(d) *Payments of patent maintenance fees.* Payments of patent maintenance fees that are not submitted electronically and correspondence related to maintenance fees may be addressed to: Mail Stop Maintenance Fee, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313–1450.

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

(f) [Reserved]

[68 FR 14335, Mar. 25, 2003; 68 FR 19371, Apr. 21, 2003, as amended at 68 FR 48287, Aug. 13, 2003; 68 FR 71006, Dec. 22, 2003; 69 FR 29877, May 26, 2004; 69 FR 35451, June 24, 2004; 69 FR 49997, Aug. 12, 2004; 72 FR 18904, Apr. 16, 2007; 73 FR 47540, Aug. 14, 2008; 75 FR 36295, June 25, 2010; 77 FR 46624, Aug. 6, 2012; 77 FR 48811, Aug. 14, 2012; 78 FR 62393, Oct. 21, 2013; 86 FR 35230, July 2, 2021; 87 FR 68904, Nov. 17, 2022]

§ 1.2 Business to be transacted in writing.

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

§ 1.3 Business to be conducted with decorum and courtesy.

Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided. Complaints against examiners and other employees must be made in correspondence separate from other papers.

[68 FR 38624, June 30, 2003]

§ 1.4 Nature of correspondence and signature requirements.

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

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

(2) *Correspondence in and relating to a particular application or other proceeding in the Office.* See particularly the rules relating to the filing, processing, or other proceedings of national applications in subpart B of this part; of international applications in subpart C of this part; of *ex parte* reexaminations of patents in subpart D of this part; of supplemental examination of patents in subpart E of this part; of extension of patent term in subpart F of this part; of *inter partes* reexaminations of patents in subpart H of this part; of international design applications in

subpart I of this part; and of the Patent Trial and Appeal Board in parts 41 and 42 of this chapter.

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

(c) Since different matters may be considered by different branches or sections of the Office, each distinct subject, inquiry, or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects. Subjects provided for on a single Office or World Intellectual Property Organization form may be contained in a single paper.

(d)(1) *Handwritten signature.* A design patent practitioner must indicate their design patent practitioner status by placing the word ''design'' (in any format) adjacent to their handwritten signature. Each piece of correspondence, except as provided in paragraphs (d)(2) through (5) and (f) of this section, filed in an application, patent file, or other proceeding in the Office that requires a person's signature, must:

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

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

(2) *S-signature.* An S-signature is a signature inserted between forward slash marks, but not a handwritten signature as defined by paragraph (d)(1) of this section. An S-signature includes any signature made by electronic or mechanical means, and any other mode of making or applying a signature other than a handwritten signature as provided for in paragraph (d)(1) of this section. Correspondence being filed in the Office in paper, by facsimile transmission as provided in §1.6(d), or via the USPTO patent electronic filing system as an attachment as provided in §1.6(a)(4), for a patent application, patent, or a reexamination or supplemental examination proceeding may be S-signature signed instead of being personally signed (*i.e.,* with a handwritten signature) as provided for in paragraph (d)(1) of this section. The requirements for an S-signature under this paragraph (d)(2) of this section are as follows.

(i) The S-signature must consist only of letters, or Arabic numerals, or both, with appropriate spaces and commas, periods, apostrophes, or hyphens for punctuation, and the person signing the correspondence must insert his or her own S-signature with a first single forward slash mark before, and a second single forward slash mark after, the S-signature (*e.g.,*/Dr. James T. Jones, Jr./); and

(ii) A patent practitioner (§1.32(a)(1)), signing pursuant to §1.33(b)(1) or (2), must supply their registration number either as part of the S-signature or immediately below or adjacent to the S-signature. The hash (#) character may only be used as part of the S-signature when appearing before a practitioner's registration number; otherwise, the hash character may not be used in an S-signature. A design patent practitioner must additionally indicate their design patent practitioner status by placing the word ''design'' (in any format) adjacent to the last forward slash of their S-signature.

(iii) The signer's name must be:

(A) Presented in printed or typed form preferably immediately below or adjacent the S-signature, and

(B) Reasonably specific enough so that the identity of the signer can be readily recognized.

(3) *Electronically submitted correspondence.* Correspondence permitted via the USPTO patent electronic filing system

may be signed by a graphic representation of a handwritten signature as provided for in paragraph (d)(1) of this section or a graphic representation of an S-signature as provided for in paragraph (d)(2) of this section when it is submitted via the USPTO patent electronic filing system.

(4) *Additional electronic signatures.* Correspondence being filed in the USPTO for a patent application, patent, or other patent proceeding at the USPTO which requires a signature may be signed using an electronic signature that is personally entered by the person named as the signer and of a form specified by the Director.

(i) A patent practitioner (§1.32(a)(1)), signing pursuant to §1.33(b)(1) or (2), must supply their registration number either as part of the electronic signature or immediately below or adjacent to the electronic signature. A design patent practitioner must additionally indicate their design patent practitioner status by placing the word ''design'' (in any format) adjacent to the electronic signature.

(ii) The signer's name must be:

(A) Presented in printed or typed form preferably immediately below or adjacent to the electronic signature; and

(B) Reasonably specific enough so that the identity of the signer can be readily recognized.

(5) *Certifications*—(i) *Certification as to the paper presented.* The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any paper by a party, whether a practitioner or non-practitioner, constitutes a certification under §11.18(b) of this subchapter. Violations of §11.18(b)(2) of this subchapter by a party, whether a practitioner or non-practitioner, may result in the imposition of sanctions under §11.18(c) of this subchapter. Any practitioner violating §11.18(b) of this subchapter may also be subject to disciplinary action. See §11.18(d) of this subchapter.

(ii) *Certification as to the signature.* The person inserting a signature under paragraph (d)(2), (3), or (4) of this section in a document submitted to the Office certifies that the inserted signature appearing in the document is the person's own signature. A person submitting a document signed by another under paragraph (d)(2), (3), or (4) is obligated to have a reasonable basis to believe that the person whose signature is present on the document was actually inserted by that person, and should retain evidence of authenticity of the signature. Violations of the certification as to the signature of another or a person's own signature as set forth in this paragraph (d)(5)(ii) may result in the imposition of sanctions under §11.18(c) and (d) of this chapter.

(6) *Forms.* The Office provides forms for the public to use in certain situations to assist in the filing of correspondence for a certain purpose and to meet certain requirements for patent applications and proceedings. Use of the forms for purposes for which they were not designed is prohibited. No changes to certification statements on the Office forms (*e.g.*, oath or declaration forms, terminal disclaimer forms, petition forms, and nonpublication request forms) may be made. The existing text of a form, other than a certification statement, may be modified, deleted, or added to, if all text identifying the form as an Office form is removed. The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any Office form with text identifying the form as an Office form by a party, whether a practitioner or non-practitioner, constitutes a certification under §11.18(b) of this chapter that the existing text and any certification statements on the form have not been altered other than permitted by EFS-Web customization.

(e) [Reserved]

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

(g) An applicant who has not made of record a registered attorney or agent may be required to state whether assistance was received in the preparation or prosecution of the patent application, for which any compensation or consideration was given or charged, and if so, to disclose the name or

names of the person or persons providing such assistance. Assistance includes the preparation for the applicant of the specification and amendments or other papers to be filed in the Patent and Trademark Office, as well as other assistance in such matters, but does not include merely making drawings by draftsmen or stenographic services in typing papers.

(h) *Ratification/confirmation/evidence of authenticity:* The Office may require ratification, confirmation (which includes submission of a duplicate document but with a proper signature), or evidence of authenticity of a signature, such as when the Office has reasonable doubt as to the authenticity (veracity) of the signature, e.g., where there are variations of a signature, or where the signature and the typed or printed name, do not clearly identify the person signing.

[24 FR 10332, Dec. 22, 1959]

EDITORIAL NOTE: For FEDERAL REGISTER citations affecting §1.4, see the List of CFR Sections Affected, which appears in the Finding Aids section of the printed volume and at *www.govinfo.gov*.

§ 1.5 Identification of patent, patent application, or patent-related proceeding.

(a) No correspondence relating to an application should be filed prior to receipt of the assigned application number (*i.e.*, U.S. application number, international application number, or international registration number as appropriate). When correspondence directed to the Patent and Trademark Office concerns a previously filed application for a patent, it must identify on the top page in a conspicuous location, the application number (consisting of the series code and the serial number; e.g., 07/123,456), or the serial number and filing date assigned to that application by the Patent and Trademark Office, or the international application number of the international application, or the international registration number of an international design application. Any correspondence not containing such identification will be returned to the sender where a return address is available. The returned correspondence will be accompanied with a cover letter, which will indicate to the sender that if the returned correspondence is resubmitted to the Patent and Trademark Office within two weeks of the mail date on the cover letter, the original date of receipt of the correspondence will be considered by the Patent and Trademark Office as the date of receipt of the correspondence. Applicants may use either the Certificate of Mailing or Transmission procedure under §1.8 or the Priority Mail Express® procedure under §1.10 for resubmissions of returned correspondence if they desire to have the benefit of the date of deposit in the United States Postal Service. If the returned correspondence is not resubmitted within the two-week period, the date of receipt of the resubmission will be considered to be the date of receipt of the correspondence. The two-week period to resubmit the returned correspondence will not be extended. In addition to the application number, all correspondence directed to the Patent and Trademark Office concerning applications for patent should also state the name of the first listed inventor, the title of the invention, the date of filing the same, and if known, the group art unit or other unit within the Patent and Trademark Office responsible for considering the correspondence and the name of the examiner or other person to which it has been assigned.

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

(c) Correspondence relating to a trial proceeding before the Patent Trial and Appeal Board (part 42 of this title) are governed by §42.6 of this title.

(d) A letter relating to a reexamination or supplemental examination proceeding should identify it as such by the number of the patent undergoing reexamination or supplemental examination, the request control number assigned to such proceeding, and, if known, the group art unit and name of the examiner to which it been assigned.

(e) [Reserved]

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

(Pub. L. 94–131, 89 Stat. 685; 35 U.S.C. 6, Pub. L. 97–247)

[24 FR 10332, Dec. 22, 1959, as amended at 46 FR 29181, May 29, 1981; 49 FR 552, Jan. 4, 1984; 49 FR 48451, Dec. 12, 1984; 53 FR 47807, Nov. 28, 1988; 58 FR 54501, Oct. 22, 1993; 61 FR 42802, Aug. 19, 1996; 61 FR 56446, Nov. 1, 1996; 64 FR 48917, Sept. 8, 1999; 68 FR 48288, Aug. 13, 2003; 69 FR 49997, Aug. 12, 2004; 77 FR 46624, Aug. 6, 2012; 77 FR 48812, Aug. 14, 2012; 78 FR 62394, Oct. 21, 2013; 79 FR 63039, Oct. 22, 2014; 80 FR 17952, Apr. 2, 2015]

§ 1.6 Receipt of correspondence.

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

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

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

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

(4) Correspondence may be submitted using the USPTO patent electronic filing system only in accordance with the USPTO patent electronic filing system requirements. Correspondence officially submitted to the Office by way of the USPTO patent electronic filing system will be accorded a receipt date, which is the date in Eastern Time when the correspondence is received in the Office, regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia.

(b) [Reserved]

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

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

(1) [Reserved]

(2) Certified documents as specified in §1.4(f);

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

(4) Color drawings submitted under §§1.81, 1.83 through 1.85, 1.152, 1.165, 1.173, 1.437, or 1.1026;

(5) A request for reexamination under §1.510 or §1.913, or a request for supplemental examination under §1.610;

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

(7) In contested cases and trials before the Patent Trial and Appeal Board, except as the Board may expressly authorize.

(e) [Reserved]

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

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

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

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

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

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

(g) *Submission of the national stage correspondence required by §1.495 via the USPTO patent electronic filing system* . In the event that the Office has no evidence of receipt of the national stage correspondence required by §1.495, which was submitted to the Office by the USPTO patent electronic filing system, the party who submitted the correspondence may petition the Director to accord the national stage correspondence a receipt date as of the date the correspondence is shown to have been officially submitted to the Office.

(1) The petition of this paragraph (g) requires that the party who submitted such national stage correspondence:

(i) Informs the Office of the previous submission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence under §1.495;

(ii) Supplies an additional copy of the previously submitted correspondence;

(iii) Includes a statement that attests on a personal knowledge basis, or to the satisfaction of the Director, that the correspondence was previously officially submitted; and

(iv) Supplies a copy of an acknowledgment receipt generated by the USPTO patent electronic filing system, or equivalent evidence, confirming the submission to support the statement of paragraph (g)(1)(iii) of this section.

(2) The Office may require additional evidence to determine if the national stage correspondence was submitted to the Office on the date in question.

[58 FR 54501, Oct. 22, 1993; 58 FR 64154, Dec. 6, 1993; 61 FR 56447, Nov. 1, 1996; 62 FR 53180, Oct. 10, 1997; 64 FR 48917, Sept. 8, 1999; 65 FR 54657, Sept. 8, 2000; 65 FR 76772, Dec. 7, 2000; 68 FR 14336, Mar. 25, 2003; 68 FR 48288, Aug. 13, 2003; 69 FR 49997, Aug. 12, 2004; 69 FR 56536, Sept. 21, 2004; 72 FR 2775, Jan. 23, 2007; 77 FR 42173, July 17, 2012; 77 FR 46624, Aug. 6, 2012; 78 FR 62394, Oct. 21, 2013; 79 FR 63039, Oct. 22, 2014; 80 FR 17952, Apr. 2, 2015; 86 FR 35229, July 2, 2021; 87 FR 68904, Nov. 17, 2022]

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

(a) Whenever periods of time are specified in this part in days, calendar days are intended. When the day, or the last day fixed by statute or by or under this part for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or on a Federal holiday within the District of Columbia,

the action may be taken, or the fee paid, on the next succeeding business day which is not a Saturday, Sunday, or a Federal holiday. See §90.3 of this chapter for time for appeal or for commencing civil action.

(b) If the day that is twelve months after the filing date of a provisional application under 35 U.S.C. 111(b) and §1.53(c) falls on Saturday, Sunday, or on a Federal holiday within the District of Columbia, the period of pendency shall be extended to the next succeeding secular or business day which is not a Saturday, Sunday, or a Federal holiday.

[65 FR 14871, Mar. 20, 2000, as amended at 78 FR 62395, Oct. 21, 2013]

§1.8 Certificate of mailing or transmission.

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

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

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

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

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

(C) Transmitted via the USPTO patent electronic filing system in accordance with §1.6(a)(4); and

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

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

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

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

(B) Papers filed in trials before the Patent Trial and Appeal Board, which are governed by §42.6(b) of this title;

(C) Papers filed in contested cases before the Patent Trial and Appeal Board, which are governed by §41.106 (f) of this title;

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

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

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

(G) The filing of a written declaration of abandonment under §1.138;

(H) The filing of a submission under §1.217 for publication of a redacted copy of an application;

(I) The filing of a third-party submission under §1.290;

(J) The calculation of any period of adjustment, as specified in §1.703(f); and

(K) The filing of an international design application.

(ii) [Reserved]

(iii) *Relative to Disciplinary Proceedings—*

(A) Correspondence filed in connection with a disciplinary proceeding under part 11 of this chapter.

(B) [Reserved]

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence, or after the application is held to be abandoned, or after the proceeding is dismissed or decided

with prejudice, or the prosecution of a reexamination proceeding is terminated pursuant to §1.550(d) or §1.957(b) or limited pursuant to §1.957(c), or a requester paper is refused consideration pursuant to §1.957(a), the correspondence will be considered timely if the party who forwarded such correspondence:

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

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

(3) Includes a statement that attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing, transmission or submission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement. If the correspondence was transmitted via the USPTO patent electronic filing system , a copy of an acknowledgment receipt generated by the USPTO patent electronic filing system confirming submission may be used to support this statement.

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

[58 FR 54502, Oct. 22, 1993; 58 FR 64154, Dec. 6, 1993, as amended at 61 FR 56447, Nov. 1, 1996; 62 FR 53181, Oct. 10, 1997; 67 FR 523, Jan. 4, 2002; 68 FR 48288, Aug. 13, 2003; 69 FR 49997, Aug. 12, 2004; 69 FR 56536, Sept. 21, 2004; 72 FR 2775, Jan. 23, 2007; 72 FR 18904, Apr. 16, 2007; 73 FR 47684, Aug. 14, 2008; 77 FR 42173, July 17, 2012; 80 FR 17953, Apr. 2, 2015]

§1.9 Definitions.

(a)(1) A national application as used in this chapter means either a U.S. application for patent which was filed in the Office under 35 U.S.C. 111, an international application filed under the Patent Cooperation Treaty in which the basic national fee under 35 U.S.C. 41(a)(1)(F) has been paid, or an international design application filed under the Hague Agreement in which the Office has received a copy of the international registration pursuant to Hague Agreement Article 10.

(2) A provisional application as used in this chapter means a U.S. national application for patent filed in the Office under 35 U.S.C. 111(b).

(3) A nonprovisional application as used in this chapter means either a U.S. national application for patent which was filed in the Office under 35 U.S.C. 111(a), an international application filed under the Patent Cooperation Treaty in which the basic national fee under 35 U.S.C. 41(a)(1)(F) has been paid, or an international design application filed under the Hague Agreement in which the Office has received a copy of the international registration pursuant to Hague Agreement Article 10.

(b) An international application as used in this chapter means an international application for patent filed under the Patent Cooperation Treaty prior to entering national processing at the Designated Office stage.

(c) A published application as used in this chapter means an application for patent which has been published under 35 U.S.C. 122(b).

(d)(1) The term inventor or inventorship as used in this chapter means the individual or, if a joint invention, the individuals collectively who invented or discovered the subject matter of the invention.

(2) The term joint inventor or coinventor as used in this chapter means any one of the individuals who invented or discovered the subject matter of a joint invention.

(e) The term joint research agreement as used in this chapter means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.

(f) The term claimed invention as used in this chapter means the subject matter defined by a claim in a patent or an application for a patent.

(g) For definitions in Patent Trial and Appeal Board proceedings, see parts 41 and 42 of this title.

(h) A *Federal holiday within the District of Columbia* as used in this chapter means any day, except Saturdays and

Sundays, when the Patent and Trademark Office is officially closed for business for the entire day.

(i) National security classified as used in this chapter means specifically authorized under criteria established by an Act of Congress or Executive Order to be kept secret in the interest of national defense or foreign policy and, in fact, properly classified pursuant to such Act of Congress or Executive Order.

(j) Director as used in this chapter, except for part 11 of this chapter, means the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

(k) Paper as used in this chapter means a document that may exist in electronic form, or in physical form, and therefore does not necessarily imply physical sheets of paper.

(l) Hague Agreement as used in this chapter means the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs adopted at Geneva, Switzerland, on July 2, 1999, and Hague Agreement Article as used in this chapter means an Article under the Hague Agreement.

(m) Hague Agreement Regulations as used in this chapter means the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement, and Hague Agreement Rule as used in this chapter means one of the Hague Agreement Regulations.

(n) An international design application as used in this chapter means an application for international registration of a design filed under the Hague Agreement. Unless otherwise clear from the wording, reference to ''design application'' or ''application for a design patent'' in this chapter includes an international design application that designates the United States.

(o) *Eastern Time* as used in this chapter means Eastern Standard Time or Eastern Daylight Time in the United States, as appropriate.

[43 FR 20461, May 11, 1978, as amended at 47 FR 40139, Sept. 10, 1982; 47 FR 43275, Sept. 30, 1982; 49 FR 48451, Dec. 12, 1984; 60 FR 20220, Apr. 25, 1995; 61 FR 56447, Nov. 1, 1996; 62 FR 53181, Oct. 10, 1997; 65 FR 54657, Sept. 8, 2000; 65 FR 57051, Sept. 20, 2000; 68 FR 14336, Mar. 25, 2003; 68 FR 38624, June 30, 2003; 69 FR 49997, Aug. 12, 2004; 73 FR 47685, Aug. 14, 2008; 77 FR 46624, Aug. 6, 2012; 77 FR 48812, Aug. 14, 2012; 78 FR 11052, Feb. 14, 2013; 80 FR 17953, Apr. 2, 2015; 87 FR 68904, Nov. 17, 2022]

§ 1.10 Filing of correspondence by Priority Mail Express®.

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

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

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

(c) Any person filing correspondence under this section that was received by the Office and delivered by the Priority Mail Express® Post Office to Addressee service of the USPS, who can show that there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the ''date accepted''

on the Priority Mail Express® mailing label or other official USPS notation, may petition the Director to accord the correspondence a filing date as of the ''date accepted'' on the Priority Mail Express® mailing label or other official USPS notation, provided that:

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

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

(3) The petition includes a true copy of the Priority Mail Express® mailing label showing the ''date accepted,'' and of any other official notation by the USPS relied upon to show the date of deposit.

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

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

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

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

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

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

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

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

(4) The petition includes a statement which establishes, to the satisfaction of the Director, the original deposit of the correspondence and that the copies of the correspondence, the copy of the Priority Mail Express® mailing label, the copy of any returned postcard receipt, and any official notation entered by the USPS are true copies of the originally mailed correspondence, original Priority Mail Express® mailing label, returned postcard receipt, and official notation entered by the USPS.

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

(g) Any person who mails correspondence addressed as set out in §1.1(a) to the Office with sufficient postage utilizing the Priority Mail Express® Post Office to Addressee service of the USPS, but has the correspondence returned by the USPS due to an interruption or emergency in Priority Mail Express® service, may petition the Director to consider such correspondence as filed on a particular date in the Office, provided that:

(1) The petition is filed promptly after the person becomes aware of the return of the correspondence;

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

(3) The petition includes the original correspondence or a copy of the original correspondence showing the number of the Priority Mail Express® mailing label thereon and a copy of the Priority Mail Express® mailing label showing the ''date accepted''; and

(4) The petition includes a statement which establishes, to the satisfaction of the Director, the original deposit of the correspondence and that the correspondence or copy of the correspondence is the original correspondence or a true copy of the correspondence originally deposited with the USPS on the requested filing date. The Office may require additional evidence to determine if the correspondence was returned by the USPS due to an interruption or emergency in Priority Mail Express® service.

(h) Any person who attempts to mail correspondence addressed as set out in §1.1(a) to the Office with sufficient postage utilizing the Priority Mail Express® Post Office to Addressee service of the USPS, but has the correspondence refused by an employee of the USPS due to an interruption or emergency in Priority Mail Express® service, may petition the Director to consider such correspondence as filed on a particular date in the Office, provided that:

(1) The petition is filed promptly after the person becomes aware of the refusal of the correspondence;

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

(3) The petition includes the original correspondence or a copy of the original correspondence showing the number of the Priority Mail Express® mailing label thereon; and

(4) The petition includes a statement by the person who originally attempted to deposit the correspondence with the USPS which establishes, to the satisfaction of the Director, the original attempt to deposit the correspondence and that the correspondence or copy of the correspondence is the original correspondence or a true copy of the correspondence originally attempted to be deposited with the USPS on the requested filing date. The Office may require additional evidence to determine if the correspondence was refused by an employee of the USPS due to an interruption or emergency in Priority Mail Express® service.

(i) Any person attempting to file correspondence under this section that was unable to be deposited with the USPS due to an interruption or emergency in Priority Mail Express® service which has been so designated by the Director, may petition the Director to consider such correspondence as filed on a particular date in the Office, provided that:

(1) The petition is filed in a manner designated by the Director promptly after the person becomes aware of the designated interruption or emergency in Priority Mail Express® service;

(2) The petition includes the original correspondence or a copy of the original correspondence; and

(3) The petition includes a statement which establishes, to the satisfaction of the Director, that the correspondence would have been deposited with the USPS but for the designated interruption or emergency in Priority Mail Express® service, and that the correspondence or copy of the correspondence is the original correspondence or a

true copy of the correspondence originally attempted to be deposited with the USPS on the requested filing date.

[79 FR 63039, Oct. 22, 2014]

RECORDS AND FILES OF THE PATENT AND TRADEMARK OFFICE

§ 1.11 Files open to the public.

(a) The specification, drawings, and all papers relating to the file of: A published application; a patent; or a statutory invention registration are open to inspection by the public, and copies may be obtained upon the payment of the fee set forth in §1.19(b)(2). If an application was published in redacted form pursuant to §1.217, the complete file wrapper and contents of the patent application will not be available if: The requirements of paragraphs (d)(1), (d)(2), and (d)(3) of §1.217 have been met in the application; and the application is still pending. See §2.27 of this title for trademark files.

(b) All reissue applications, all applications in which the Office has accepted a request to open the complete application to inspection by the public, and related papers in the application file, are open to inspection by the public, and copies may be furnished upon paying the fee therefor. The filing of reissue applications, other than continued prosecution applications under §1.53(d) of reissue applications, will be announced in the *Official Gazette*. The announcement shall include at least the filing date, reissue application and original patent numbers, title, class and subclass, name of the inventor, name of the owner of record, name of the attorney or agent of record, and examining group to which the reissue application is assigned.

(c) All requests for reexamination for which all the requirements of §1.510 or §1.915 have been satisfied will be announced in the *Official Gazette*. Any reexaminations at the initiative of the Director pursuant to §1.520 will also be announced in the *Official Gazette*. The announcement shall include at least the date of the request, if any, the reexamination request control number or the Director initiated order control number, patent number, title, class and subclass, name of the inventor, name of the patent owner of record, and the examining group to which the reexamination is assigned.

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

(e) Except as prohibited in §41.6(b), §42.14 or §42.410(b), the file of any interference or trial before the Patent Trial and Appeal Board is open to public inspection and copies of the file may be obtained upon payment of the fee therefor.

(35 U.S.C. 6; 15 U.S.C. 1113, 1123)

[46 FR 29181, May 29, 1981, as amended at 47 FR 41272, Sept. 17, 1982; 50 FR 9378, Mar. 7, 1985; 60 FR 14518, Mar. 17, 1995; 62 FR 53181, Oct. 10, 1997; 65 FR 57051, Sept. 20, 2000; 69 FR 49997, Aug. 12, 2004; 70 FR 56126, Sept. 26, 2005; 71 FR 44223, Aug. 4, 2006; 77 FR 46624, Aug. 6, 2012]

§ 1.12 Assignment records open to public inspection.

(a)(1) Separate assignment records are maintained in the United States Patent and Trademark Office for patents and trademarks. The assignment records, relating to original or reissue patents, including digests and indexes (for assignments recorded on or after May 1, 1957), and published patent applications, are open to public inspection at the United States Patent and Trademark Office, and copies of patent assignment records may be obtained upon request and payment of the fee set forth in §1.19 of this chapter. See §2.200 of this chapter regarding trademark assignment records.

(2) All records of assignments of patents recorded before May 1, 1957, are maintained by the National Archives and Records Administration (NARA). The records are open to public inspection. Certified and uncertified copies of those assignment records are provided by NARA upon request and payment of the fees required by NARA.

(b) Assignment records, digests, and indexes relating to any pending or abandoned patent application, which is open to the public pursuant to §1.11 or for which copies or access may be supplied pursuant to §1.14, are available to the public. Copies of any assignment

records, digests, and indexes that are not available to the public shall be obtainable only upon written authority of an inventor, the applicant, the assignee or an assignee of an undivided part interest, or a patent practitioner of record, or upon a showing that the person seeking such information is a bona fide prospective or actual purchaser, mortgagee, or licensee of such application, unless it shall be necessary to the proper conduct of business before the Office or as provided in this part.

(c) Any request by a member of the public seeking copies of any assignment records of any pending or abandoned patent application preserved in confidence under §1.14, or any information with respect thereto, must:

(1) Be in the form of a petition including the fee set forth in §1.17(g); or

(2) Include written authority granting access to the member of the public to the particular assignment records from an inventor, the applicant, the assignee or an assignee of an undivided part interest, or a patent practitioner of record.

(d) An order for a copy of an assignment or other document should identify the reel and frame number where the assignment or document is recorded. If a document is identified without specifying its correct reel and frame, an extra charge as set forth in §1.21(j) will be made for the time consumed in making a search for such assignment.

(35 U.S.C. 6; 15 U.S.C. 1113, 1123)

[47 FR 41272, Sept. 17, 1982, as amended at 54 FR 6900, Feb. 15, 1989; 56 FR 65151, Dec. 13, 1991; 56 FR 66670, Dec. 24, 1991; 57 FR 29641, July 6, 1992; 60 FR 20221, Apr. 25, 1995; 61 FR 42802, Aug. 19, 1996; 65 FR 54657, Sept. 8, 2000; 65 FR 57051, Sept. 20, 2000; 68 FR 48288, Aug. 13, 2003; 69 FR 29877, May 26, 2004; 69 FR 56536, Sept. 21, 2004; 77 FR 48812, Aug. 14, 2012]

§ 1.13 Copies and certified copies.

(a) Non-certified copies of patents, and patent application publications and of any records, books, papers, or drawings within the jurisdiction of the United States Patent and Trademark Office and open to the public, will be furnished by the United States Patent and Trademark Office to any person, and copies of other records or papers will be furnished to persons entitled thereto, upon payment of the appropriate fee. See §2.201 of this chapter regarding copies of trademark records.

(b) Certified copies of patents, patent application publications, and trademark registrations and of any records, books, papers, or drawings within the jurisdiction of the United States Patent and Trademark Office and open to the public or persons entitled thereto will be authenticated by the seal of the United States Patent and Trademark Office and certified by the Director, or in his or her name, upon payment of the fee for the certified copy.

[68 FR 48288, Aug. 13, 2003, as amended at 68 FR 71006, Dec. 22, 2003]

§ 1.14 Patent applications preserved in confidence.

(a) *Confidentiality of patent application information.* Patent applications that have not been published under 35 U.S.C. 122(b) are generally preserved in confidence pursuant to 35 U.S.C. 122(a). Information concerning the filing, pendency, or subject matter of an application for patent, including status information, and access to the application, will only be given to the public as set forth in §1.11 or in this section.

(1) Records associated with patent applications (see paragraph (g) of this section for international applications and paragraph (j) of this section for international design applications) may be available in the following situations:

(i) *Patented applications and statutory invention registrations.* The file of an application that has issued as a patent or published as a statutory invention registration is available to the public as set forth in §1.11(a). A copy of the patent application-as-filed, the file contents of the application, or a specific document in the file of such an application may be provided upon request and payment of the appropriate fee set forth in §1.19(b).

(ii) *Published abandoned applications.* The file of an abandoned published application is available to the public as set forth in §1.11(a). A copy of the application-as-filed, the file contents of the published application, or a specific document in the file of the published application may be provided to any

person upon request and payment of the appropriate fee set forth in §1.19(b).

(iii) *Published pending applications.* A copy of the application-as-filed, the file contents of the application, or a specific document in the file of a pending published application may be provided to any person upon request and payment of the appropriate fee set forth in §1.19(b). If a redacted copy of the application was used for the patent application publication, the copy of the specification, drawings, and papers may be limited to a redacted copy. The Office will not provide access to the paper file of a pending application that has been published, except as provided in paragraph (c) or (i) of this section.

(iv) *Unpublished abandoned applications (including provisional applications) that are identified or relied upon.* The file contents of an unpublished, abandoned application may be made available to the public if the application is identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, an international publication of an international application under PCT Article 21(2), or a publication of an international registration under Hague Agreement Article 10(3) of an international design application designating the United States. An application is considered to have been identified in a document, such as a patent, when the application number or serial number and filing date, first named inventor, title, and filing date or other application specific information are provided in the text of the patent, but not when the same identification is made in a paper in the file contents of the patent and is not included in the printed patent. Also, the file contents may be made available to the public, upon a written request, if benefit of the abandoned application is claimed under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c) in an application that has issued as a U.S. patent, or has published as a statutory invention registration, a U.S. patent application publication, an international publication of an international application under PCT Article 21(2), or a publication of an international registration under Hague Agreement Article 10(3). A copy of the application-as-filed, the file contents of the application, or a specific document in the file of the application may be provided to any person upon written request and payment of the appropriate fee (§1.19(b)).

(v) *Unpublished pending applications (including provisional applications) whose benefit is claimed.* A copy of the file contents of an unpublished pending application may be provided to any person, upon written request and payment of the appropriate fee (§1.19(b)), if the benefit of the application is claimed under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c) in an application that has issued as a U.S. patent, or in an application that has published as a statutory invention registration, a U.S. patent application publication, an international publication of an international application under PCT Article 21(2), or a publication of an international registration under Hague Agreement Article 10(3). A copy of the application-as-filed or a specific document in the file of the pending application may also be provided to any person upon written request and payment of the appropriate fee (§1.19(b)). The Office will not provide access to the paper file of a pending application, except as provided in paragraph (c) or (i) of this section.

(vi) *Unpublished pending applications (including provisional applications) that are incorporated by reference or otherwise identified.* A copy of the application as originally filed of an unpublished pending application may be provided to any person, upon written request and payment of the appropriate fee (§1.19(b)), if the application is incorporated by reference or otherwise identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, an international publication of an international application under PCT Article 21(2), or a publication of an international registration under Hague Agreement Article 10(3) of an international design application designating the United States. The Office will not provide access to the paper file of a pending application, except as provided in paragraph (c) or (i) of this section.

(vii) *When a petition for access or a power to inspect is required.* Applications that were not published or patented, that are not the subject of a benefit claim under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c) in an application that

has issued as a U.S. patent, an application that has published as a statutory invention registration, a U.S. patent application publication, an international publication of an international application under PCT Article 21(2), or a publication of an international registration under Hague Agreement Article 10(3), or are not identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, an international publication of an international application under PCT Article 21(2), or a publication of an international registration under Hague Agreement Article 10(3) of an international design application designating the United States, are not available to the public. If an application is identified in the file contents of another application, but not the published patent application or patent itself, a granted petition for access (see paragraph (i)) or a power to inspect (see paragraph (c) of this section) is necessary to obtain the application, or a copy of the application.

(2) Information concerning a patent application may be communicated to the public if the patent application is identified in a published patent document or in an application as set forth in paragraphs (a)(1)(i) through (a)(1)(vi) of this section. The information that may be communicated to the public (*i.e.*, status information) includes:

(i) Whether the application is pending, abandoned, or patented;

(ii) Whether the application has been published under 35 U.S.C. 122(b);

(iii) The application ''numerical identifier'' which may be:

(A) The eight-digit application number (the two-digit series code plus the six-digit serial number); or

(B) The six-digit serial number plus any one of the filing date of the national application, the international filing date, or date of entry into the national stage; and

(iv) Whether another application claims the benefit of the application (*i.e.*, whether there are any applications that claim the benefit of the filing date under 35 U.S.C. 119(e), 120, 121, 365, or 386 of the application), and if there are any such applications, the numerical identifier of the application, the specified relationship between the applications (e.g., continuation), whether the application is pending, abandoned or patented, and whether the application has been published under 35 U.S.C. 122(b).

(b) *Electronic access to an application.* Where a copy of the application file or access to the application may be made available pursuant to this section, the Office may at its discretion provide access to only an electronic copy of the specification, drawings, and file contents of the application.

(c) *Power to inspect a pending or abandoned application.* Access to an application may be provided to any person if the application file is available, and the application contains written authority (*e.g.*, a power to inspect) granting access to such person. The written authority must be signed by:

(1) The applicant;

(2) A patent practitioner of record;

(3) The assignee or an assignee of an undivided part interest;

(4) The inventor or a joint inventor; or

(5) A registered attorney or agent named in the papers accompanying the application papers filed under §1.53 or the national stage documents filed under §1.495, if a power of attorney has not been appointed under §1.32.

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

(e) *Decisions by the Director.* Any decision by the Director that would not otherwise be open to public inspection may be published or made available for public inspection if:

(1) The Director believes the decision involves an interpretation of patent laws or regulations that would be of precedential value; and

(2) The applicant is given notice and an opportunity to object in writing within two months on the ground that the decision discloses a trade secret or other confidential information. Any objection must identify the deletions in the text of the decision considered necessary to protect the information, or explain why the entire decision must be withheld from the public to protect such information. An applicant or party will be given time, not less than twenty days, to request reconsideration and seek court review before any portions of a decision are made public under this paragraph over his or her objection.

(f) *Notice to inventor of the filing of an application.* The Office may publish notice in the *Official Gazette* as to the filing of an application on behalf of an inventor by a person who otherwise shows sufficient proprietary interest in the matter.

(g) *International applications.* (1) Copies of international application files for international applications which designate the U.S. and which have been published in accordance with PCT Article 21(2), or copies of a document in such application files, will be furnished in accordance with PCT Articles 30 and 38 and PCT Rules 94.2 and 94.3, upon written request including a showing that the publication of the application has occurred and that the U.S. was designated, and upon payment of the appropriate fee (see §1.19(b)), if:

(i) With respect to the Home Copy (the copy of the international application kept by the Office in its capacity as the Receiving Office, see PCT Article 12(1)), the international application was filed with the U.S. Receiving Office;

(ii) With respect to the Search Copy (the copy of an international application kept by the Office in its capacity as the International Searching Authority, see PCT Article 12(1)), the U.S. acted as the International Searching Authority, except for the written opinion of the International Searching Authority which shall not be available until the expiration of thirty months from the priority date; or

(iii) With respect to the Examination Copy (the copy of an international application kept by the Office in its capacity as the International Preliminary Examining Authority), the United States acted as the International Preliminary Examining Authority, an International Preliminary Examination Report has issued, and the United States was elected.

(2) A copy of an English language translation of a publication of an international application which has been filed in the United States Patent and Trademark Office pursuant to 35 U.S.C. 154(d)(4) will be furnished upon written request including a showing that the publication of the application in accordance with PCT Article 21(2) has occurred and that the U.S. was designated, and upon payment of the appropriate fee (§1.19(b)(4)).

(3) Access to international application files for international applications which designate the U.S. and which have been published in accordance with PCT Article 21(2), or copies of a document in such application files, will be permitted in accordance with PCT Articles 30 and 38 and PCT Rules 44*ter*.1, 94.2 and 94.3, upon written request including a showing that the publication of the application has occurred and that the U.S. was designated.

(4) In accordance with PCT Article 30, copies of an international application-as-filed under paragraph (a) of this section will not be provided prior to the international publication of the application pursuant to PCT Article 21(2).

(5) Access to international application files under paragraphs (a)(1)(i) through (a)(1)(vi) and (g)(3) of this section will not be permitted with respect to the Examination Copy in accordance with PCT Article 38.

(h) *Access by a Foreign Intellectual Property Office.* (1) Access to an application-as-filed may be provided to any foreign intellectual property office participating with the Office in a bilateral or multilateral priority document exchange agreement (participating foreign intellectual property office), if the application contains written authority granting such access. Written authority provided under this paragraph (h)(1) will be treated as authorizing the Office to provide the following to all participating foreign intellectual property offices in accordance with their respective agreements with the Office:

(i) A copy of the application-as-filed and its related bibliographic data;

(ii) A copy of the application-as-filed of any application the filing date of which is claimed by the application in which written authority under this paragraph (h)(1) is filed and its related bibliographic data; and

(iii) The date of filing of the written authorization under this paragraph (h)(1).

(2) Access to the file contents of an application may be provided to a foreign intellectual property office that has imposed a requirement for information on a counterpart application filed with the foreign intellectual property office where the foreign intellectual property office is a party to a bilateral or multilateral agreement with the Office to provide the required information from the application filed with the Office and the application contains written authority granting such access. Written authority provided under this paragraph (h)(2) will be treated as authorizing the Office to provide the following to all foreign intellectual property offices in accordance with their respective agreements with the Office:

(i) Bibliographic data related to the application; and

(ii) Any content of the application file necessary to satisfy the foreign intellectual property office requirement for information imposed on the counterpart application as indicated in the respective agreement.

(3) Written authority provided under paragraphs (h)(1) and (h)(2) of this section must include the title of the invention (§1.72(a)), comply with the requirements of paragraph (c) of this section, and be submitted on an application data sheet (§1.76) or on a separate document (§1.4(c)). The written authority provided under these paragraphs should be submitted before filing any subsequent foreign application in which priority is claimed to the application.

(i) *Access or copies in other circumstances.* The Office, either *sua sponte* or on petition, may also provide access or copies of all or part of an application if necessary to carry out an Act of Congress or if warranted by other special circumstances. Any petition by a member of the public seeking access to, or copies of, all or part of any pending or abandoned application preserved in confidence pursuant to paragraph (a) of this section, or any related papers, must include:

(1) The fee set forth in §1.17(g); and

(2) A showing that access to the application is necessary to carry out an Act of Congress or that special circumstances exist which warrant petitioner being granted access to all or part of the application.

(j) *International design applications.* (1) With respect to an international design application maintained by the Office in its capacity as a designated office (§1.1003) for national processing, the records associated with the international design application may be made available as provided under paragraphs (a) through (i) of this section.

(2) With respect to an international design application maintained by the Office in its capacity as an office of indirect filing (§1.1002), the records of the international design application may be made available under paragraph (j)(1) of this section where contained in the file of the international design application maintained by the Office for national processing. Also, if benefit of the international design application is claimed under 35 U.S.C. 386(c) in a U.S. patent or published application, the file contents of the application may be made available to the public, or the file contents of the application, a copy of the application-as-filed, or a specific document in the file of the application may be provided to any person upon written request and payment of the appropriate fee (§1.19(b)).

[68 FR 38624, June 30, 2003, as amended at 68 FR 59886, Oct. 20, 2003; 68 FR 67805, Dec. 4, 2003; 68 FR 71006, Dec. 22, 2003; 69 FR 49997, Aug. 12, 2004; 69 FR 56536, Sept. 21, 2004; 72 FR 1667, Jan. 16, 2007; 77 FR 48812, Aug. 14, 2012; 78 FR 11052, Feb. 14, 2013; 80 FR 17953, Apr. 2, 2015; 80 FR 65655, Oct. 27, 2015]

§ 1.15 [Reserved]

FEES AND PAYMENT OF MONEY

AUTHORITY: Sections 1.16 through 1.22 also issued under 35 U.S.C. 41, 111, 119, 120, 132(b), 156, 157, 255, 302, and 311, Public Laws 103–465, 106–113, and 112–29.

§ 1.16 National application filing, search, and examination fees.

(a) Basic fee for filing each application under 35 U.S.C. 111 for an original patent, except design, plant, or provisional applications:

TABLE 1 TO PARAGRAPH (a)

By a micro entity (§ 1.29)	$64.00
By a small entity (§ 1.27(a))	128.00
By a small entity (§ 1.27(a)) if the application is submitted in compliance with the USPTO patent electronic filing system (§ 1.27(b)(2))	64.00
By other than a small or micro entity	320.00

(b) Basic fee for filing each application under 35 U.S.C. 111 for an original design patent:

TABLE 2 TO PARAGRAPH (b)

By a micro entity (§ 1.29)	$44.00
By a small entity (§ 1.27(a))	88.00
By other than a small or micro entity	220.00

(c) Basic fee for filing each application for an original plant patent:

TABLE 3 TO PARAGRAPH (c)

By a micro entity (§ 1.29)	$44.00
By a small entity (§ 1.27(a))	88.00
By other than a small or micro entity	220.00

(d) Basic fee for filing each provisional application:

TABLE 4 TO PARAGRAPH (d)

By a micro entity (§ 1.29)	$60.00
By a small entity (§ 1.27(a))	120.00
By other than a small or micro entity	300.00

(e) Basic fee for filing each application for the reissue of a patent:

TABLE 5 TO PARAGRAPH (e)

By a micro entity (§ 1.29)	$64.00
By a small entity (§ 1.27(a))	128.00
By other than a small or micro entity	320.00

(f) Surcharge for filing the basic filing fee, search fee, examination fee, or the inventor's oath or declaration on a date later than the filing date of the application, an application that does not contain at least one claim on the filing date of the application, or an application filed by reference to a previously filed application under § 1.57(a), except provisional applications:

TABLE 6 TO PARAGRAPH (f)

By a micro entity (§ 1.29)	$32.00
By a small entity (§ 1.27(a))	64.00
By other than a small or micro entity	160.00

(g) Surcharge for filing the basic filing fee or cover sheet (§ 1.51(c)(1)) on a date later than the filing date of the provisional application:

TABLE 7 TO PARAGRAPH (g)

By a micro entity (§ 1.29)	$12.00
By a small entity (§ 1.27(a))	24.00
By other than a small or micro entity	60.00

(h) In addition to the basic filing fee in an application, other than a provisional application, for filing or later presentation at any other time of each claim in independent form in excess of three:

TABLE 8 TO PARAGRAPH (h)

By a micro entity (§ 1.29)	$96.00
By a small entity (§ 1.27(a))	192.00
By other than a small or micro entity	480.00

(i) In addition to the basic filing fee in an application, other than a provisional application, for filing or later presentation at any other time of each claim (whether dependent or independent) in excess of 20 (note that § 1.75(c) indicates how multiple dependent claims are considered for fee calculation purposes):

TABLE 9 TO PARAGRAPH (i)

By a micro entity (§ 1.29)	$20.00
By a small entity (§ 1.27(a))	40.00
By other than a small or micro entity	100.00

(j) In addition to the basic filing fee in an application, other than a provisional application, that contains, or is amended to contain, a multiple dependent claim, per application:

TABLE 10 TO PARAGRAPH (j)

By a micro entity (§ 1.29)	$172.00
By a small entity (§ 1.27(a))	344.00
By other than a small or micro entity	860.00

(k) Search fee for each application filed under 35 U.S.C. 111 for an original patent, except design, plant, or provisional applications:

TABLE 11 TO PARAGRAPH (k)

By a micro entity (§ 1.29)	$140.00
By a small entity (§ 1.27(a))	280.00
By other than a small or micro entity	700.00

(l) Search fee for each application under 35 U.S.C. 111 for an original design patent:

TABLE 12 TO PARAGRAPH (l)

By a micro entity (§ 1.29)	$32.00
By a small entity (§ 1.27(a))	64.00
By other than a small or micro entity	160.00

(m) Search fee for each application for an original plant patent:

TABLE 13 TO PARAGRAPH (m)

By a micro entity (§ 1.29)	$88.00
By a small entity (§ 1.27(a))	176.00
By other than a small or micro entity	440.00

(n) Search fee for each application for the reissue of a patent:

TABLE 14 TO PARAGRAPH (n)

By a micro entity (§ 1.29)	$140.00
By a small entity (§ 1.27(a))	280.00
By other than a small or micro entity	700.00

(o) Examination fee for each application filed under 35 U.S.C. 111 for an original patent, except design, plant, or provisional applications:

TABLE 15 TO PARAGRAPH (o)

By a micro entity (§ 1.29)	$160.00
By a small entity (§ 1.27(a))	320.00
By other than a small or micro entity	800.00

(p) Examination fee for each application under 35 U.S.C. 111 for an original design patent:

TABLE 16 TO PARAGRAPH (p)

By a micro entity (§ 1.29)	$128.00
By a small entity (§ 1.27(a))	256.00
By other than a small or micro entity	640.00

(q) Examination fee for each application for an original plant patent:

TABLE 17 TO PARAGRAPH (q)

By a micro entity (§ 1.29)	$132.00
By a small entity (§ 1.27(a))	264.00
By other than a small or micro entity	660.00

(r) Examination fee for each application for the reissue of a patent:

TABLE 18 TO PARAGRAPH (r)

By a micro entity (§ 1.29)	$464.00
By a small entity (§ 1.27(a))	928.00
By other than a small or micro entity	2,320.00

(s) Application size fee for any application filed under 35 U.S.C.111 for the specification and drawings which exceed 100 sheets of paper, for each additional 50 sheets or fraction thereof:

TABLE 19 TO PARAGRAPH (s)

By a micro entity (§ 1.29)	$84.00
By a small entity (§ 1.27(a))	168.00
By other than a small or micro entity	420.00

(t) Non-electronic filing fee for any application under 35 U.S.C. 111(a) that is filed on or after November 15, 2011, other than by the USPTO patent electronic filing system, except for a reissue, design, or plant application:

TABLE 20 TO PARAGRAPH (t)

By a small entity (§ 1.27(a))	$200.00
By other than a small entity	$400.00

(u) Additional fee for any application filed on or after January 17, 2024, under 35 U.S.C.111 for an original patent, except design, plant, or provisional applications, where the specification, claims, and/or abstract does not conform to the USPTO requirements for submission in DOCX format:

TABLE 21 TO PARAGRAPH (u)

By a micro entity (§ 1.29)	$80.00
By a small entity (§ 1.27(a))	160.00
By a small entity (§ 1.27(a)) if the application is submitted in compliance with the USPTO patent electronic filing system (§ 1.27(b)(2))	160.00
By other than a small or micro entity	400.00

NOTE TO §1.16: See §§1.445, 1.482 and 1.492 for international application filing and processing fees.

[70 FR 3887, Jan. 27, 2005, as amended at 70 FR 30365, May 26, 2005; 72 FR 46901, Aug. 22, 2007; 73 FR 47540, Aug. 14, 2008; 76 FR 70653, Nov. 15, 2011; 77 FR 48812, Aug. 14, 2012; 77 FR 54365, Sept. 5, 2012; 78 FR 4284, Jan. 18, 2013; 78 FR 62395, Oct. 21, 2013; 80 FR 17954, Apr. 2, 2015; 82 FR 52813, Nov. 14, 2017; 85 FR 46985, Aug. 3, 2020; 86 FR 66193, Nov. 22, 2021; 87 FR 80073, Dec. 29, 2022; 88 FR 17154, Mar. 22, 2023; 88 FR 18053, Mar. 27, 2023; 88 FR 36957, June 6, 2023]

§ 1.17 Patent application and reexamination processing fees.

(a) Extension fees pursuant to §1.136(a):

(1) For reply within first month:

TABLE 1 TO PARAGRAPH (a)(1)

By a micro entity (§1.29)	$44.00
By a small entity (§1.27(a))	88.00
By other than a small or micro entity	220.00

(2) For reply within second month:

TABLE 2 TO PARAGRAPH (a)(2)

By a micro entity (§1.29)	$128.00
By a small entity (§1.27(a))	256.00
By other than a small or micro entity	640.00

(3) For reply within third month:

TABLE 3 TO PARAGRAPH (a)(3)

By a micro entity (§1.29)	$296.00
By a small entity (§1.27(a))	592.00
By other than a small or micro entity	1,480.00

(4) For reply within fourth month:

TABLE 4 TO PARAGRAPH (a)(4)

By a micro entity (§1.29)	$464.00
By a small entity (§1.27(a))	928.00
By other than a small or micro entity	2,320.00

(5) For reply within fifth month:

TABLE 5 TO PARAGRAPH (a)(5)

By a micro entity (§1.29)	$632.00
By a small entity (§1.27(a))	1,264.00
By other than a small or micro entity	3,160.00

(b) For fees in proceedings before the Patent Trial and Appeal Board, *see* §41.20 and §42.15 of this title.

(c) For filing a request for prioritized examination under §1.102(e):

TABLE 6 TO PARAGRAPH (c)

By a micro entity (§1.29)	$840.00
By a small entity (§1.27(a))	1,680.00
By other than a small or micro entity	4,200.00

(d) For correction of inventorship in an application after the first action on the merits:

TABLE 7 TO PARAGRAPH (d)

By a micro entity (§1.29)	$128.00
By a small entity (§1.27(a))	256.00
By other than a small or micro entity	640.00

(e) To request continued examination pursuant to §1.114:

(1) For filing a first request for continued examination pursuant to §1.114 in an application:

TABLE 8 TO PARAGRAPH (e)(1)

By a micro entity (§1.29)	$272.00
By a small entity (§1.27(a))	544.00
By other than a small or micro entity	1,360.00

(2) For filing a second or subsequent request for continued examination pursuant to §1.114 in an application:

TABLE 9 TO PARAGRAPH (e)(2)

By a micro entity (§1.29)	$400.00
By a small entity (§1.27(a))	800.00
By other than a small or micro entity	2,000.00

(f) For filing a petition under one of the following sections that refers to this paragraph (f):

TABLE 10 TO PARAGRAPH (f)

By a micro entity (§1.29)	$84.00
By a small entity (§1.27(a))	168.00
By other than a small or micro entity	420.00

§1.36(a)—for revocation of a power of attorney by fewer than all of the applicants.

§1.53(e)—to accord a filing date.

§1.182—for a decision on a question not specifically provided for in an application for a patent.

§1.183—to suspend the rules in an application for a patent.

§1.741(b)—to accord a filing date to an application under §1.740 for an extension of a patent term.

§ 1.1023—to review the filing date of an international design application.

(g) For filing a petition under one of the following sections that refers to this paragraph (g):

TABLE 11 TO PARAGRAPH (g)

By a micro entity (§ 1.29)	$44.00
By a small entity (§ 1.27(a))	88.00
By other than a small or micro entity	220.00

§ 1.12—for access to an assignment record.
§ 1.14—for access to an application.
§ 1.46—for filing an application on behalf of an inventor by a person who otherwise shows sufficient proprietary interest in the matter.
§ 1.55(f)—for filing a belated certified copy of a foreign application.
§ 1.55(g)—for filing a belated certified copy of a foreign application.
§ 1.57(a)—for filing a belated certified copy of a foreign application.
§ 1.59—for expungement of information.
§ 1.103(a)—to suspend action in an application.
§ 1.136(b)—for review of a request for an extension of time when the provisions of § 1.136(a) are not available.
§ 1.377—for review of a decision refusing to accept and record payment of a maintenance fee filed prior to the expiration of a patent.
§ 1.550(c)—for patent owner requests for an extension of time in ex parte reexamination proceedings.
§ 1.956—for patent owner requests for an extension of time in inter partes reexamination proceedings.
§ 5.12 of this chapter—for expedited handling of a foreign filing license.
§ 5.15 of this chapter—for changing the scope of a license.
§ 5.25 of this chapter—for a retroactive license.

(h) For filing a petition under one of the following sections that refers to this paragraph (h):

TABLE 12 TO PARAGRAPH (h)

By a micro entity (§ 1.29)	$28.00
By a small entity (§ 1.27(a))	56.00
By other than a small or micro entity	140.00

§ 1.84—for accepting color drawings or photographs.
§ 1.91—for entry of a model or exhibit.
§ 1.102(d)—to make an application special.
§ 1.138(c)—to expressly abandon an application to avoid publication.
§ 1.313—to withdraw an application from issue.
§ 1.314—to defer issuance of a patent.

(i) *Processing fees.* (1) For taking action under one of the following sections that refers to this paragraph (i)(1):

TABLE 13 TO PARAGRAPH (i)(1)

By a micro entity (§ 1.29)	$28.00
By a small entity (§ 1.27(a))	56.00
By other than a small or micro entity	140.00

§ 1.28(c)(3)—for processing a non-itemized fee deficiency based on an error in small entity status.
§ 1.29(k)(3)—for processing a non-itemized fee deficiency based on an error in micro entity status.
§ 1.41(b)—for supplying the name or names of the inventor or joint inventors in an application without either an application data sheet or the inventor's oath or declaration, except in provisional applications.
§ 1.48—for correcting inventorship, except in provisional applications.
§ 1.52(d)—for processing a nonprovisional application filed with a specification in a language other than English.
§ 1.53(c)(3)—to convert a provisional application filed under § 1.53(c) into a nonprovisional application under § 1.53(b).
§ 1.71(g)(2)—for processing a belated amendment under § 1.71(g).
§ 1.102(e)—for requesting prioritized examination of an application.
§ 1.103(b)—for requesting limited suspension of action, continued prosecution application for a design patent (§ 1.53(d)).
§ 1.103(c)—for requesting limited suspension of action, request for continued examination (§ 1.114).
§ 1.103(d)—for requesting deferred examination of an application.
§ 1.291(c)(5)—for processing a second or subsequent protest by the same real party in interest.
§ 3.81—for a patent to issue to assignee, assignment submitted after payment of the issue fee.

(2) For taking action under one of the following sections that refers to this paragraph (i)(2):

TABLE 14 TO PARAGRAPH (i)(2)

By a micro entity (§ 1.29)	$140.00
By a small entity (§ 1.27(a))	140.00
By other than a small or micro entity	140.00

§ 1.217—for processing a redacted copy of a paper submitted in the file of an application in which a redacted copy was submitted for the patent application publication.
§ 1.221—for requesting voluntary publication or republication of an application.

(j) [Reserved]

(k) For filing a request for expedited examination under § 1.155(a):

TABLE 15 TO PARAGRAPH (k)

By a micro entity (§ 1.29)	$320.00
By a small entity (§ 1.27(a))	640.00
By other than a small or micro entity	1,600.00

(l) [Reserved]

(m) For filing a petition for the revival of an abandoned application for a patent, for the delayed payment of the fee for issuing each patent, for the delayed response by the patent owner in any reexamination proceeding, for the delayed payment of the fee for maintaining a patent in force, for the delayed submission of a priority or benefit claim, for the extension of the 12-month (six-month for designs) period for filing a subsequent application (§§ 1.55(c) and (e); 1.78(b), (c), and (e); 1.137; 1.378; and 1.452), or for filing a petition to excuse an applicant's failure to act within prescribed time limits in an international design application (§ 1.1051):

TABLE 16 TO PARAGRAPH (m)

By a micro entity (§ 1.29)	$420.00
By a small entity (§ 1.27(a))	840.00
By other than a small or micro entity	2,100.00

(n) [Reserved]

(o) For every ten items or fraction thereof in a third-party submission under § 1.290:

TABLE 17 TO PARAGRAPH (o)

By a small entity (§ 1.27(a)) or micro entity (§ 1.29)	$72.00
By other than a small or micro entity	180.00

(p) For an information disclosure statement under § 1.97(c) or (d):

TABLE 18 TO PARAGRAPH (p)

By a micro entity (§ 1.29)	$52.00
By a small entity (§ 1.27(a))	104.00
By other than a small or micro entity	260.00

(q) Processing fee for taking action under one of the following sections that refers to this paragraph (q): $50.00

§ 1.41—to supply the name or names of the inventor or inventors after the filing date without a cover sheet as prescribed by § 1.51(c)(1) in a provisional application.

§ 1.48—for correction of inventorship in a provisional application.

§ 1.53(c)(2)—to convert a nonprovisional application filed under § 1.53(b) to a provisional application under § 1.53(c).

(r) For entry of a submission after final rejection under § 1.129(a):

TABLE 19 TO PARAGRAPH (r)

By a micro entity (§ 1.29)	$176.00
By a small entity (§ 1.27(a))	352.00
By other than a small or micro entity	880.00

(s) For each additional invention requested to be examined under § 1.129(b):

TABLE 20 TO PARAGRAPH (s)

By a micro entity (§ 1.29)	$176.00
By a small entity (§ 1.27(a))	352.00
By other than a small or micro entity	880.00

(t) For filing a petition to convert an international design application to a design application under 35 U.S.C. chapter 16 (§ 1.1052):

TABLE 21 TO PARAGRAPH (t)

By a micro entity (§ 1.29)	$36.00
By a small entity (§ 1.27(a))	72.00
By other than a small or micro entity	180.00

[78 FR 17105, Mar. 20, 2013, as amended at 78 FR 62395, Oct. 21, 2013; 78 FR 75252, Dec. 11, 2013; 80 FR 17954, Apr. 2, 2015; 82 FR 52814, Nov. 14, 2017; 85 FR 46986, Aug. 3, 2020; 85 FR 58283, Sept. 18, 2020; 88 FR 17154, Mar. 22, 2023]

§ 1.18 Patent post allowance (including issue) fees.

(a) Issue fee for issuing each original patent, except a design or plant patent, or for issuing each reissue patent:

TABLE 1 TO PARAGRAPH (a)

By a micro entity (§ 1.29)	$240.00
By a small entity (§ 1.27(a))	480.00
By other than a small or micro entity	1,200.00

(b)(1) Issue fee for issuing an original design patent:

TABLE 2 TO PARAGRAPH (b)(1)

By a micro entity (§ 1.29)	$148.00
By a small entity (§ 1.27(a))	296.00
By other than a small or micro entity	740.00

(2) [Reserved]

(3) Issue fee for issuing an international design application designating the United States, where the issue fee is paid through the International Bureau (Hague Agreement Rule 12(3)(c)) as an alternative to paying the issue fee under paragraph (b)(1) of this section: The amount established in Swiss currency pursuant to Hague Agreement Rule 28 as of the date of mailing of the notice of allowance (§ 1.311).

(c) Issue fee for issuing an original plant patent:

TABLE 3 TO PARAGRAPH (c)

By a micro entity (§ 1.29)	$168.00
By a small entity (§ 1.27(a))	336.00
By other than a small or micro entity	840.00

(d)(1) Publication fee on or after January 1, 2014	$0.00
(2) Publication fee before January 1, 2014	300.00
(3) Republication fee (§ 1.221(a))	320.00
(e) For filing an application for patent term adjustment under § 1.705	210.00
(f) For filing a request for reinstatement of all or part of the term reduced pursuant to § 1.704(b) in an application for a patent term adjustment under § 1.705	420.00

[78 FR 4286, Jan. 18, 2013, as amended at 80 FR 17955, Apr. 2, 2015; 82 FR 52814, Nov. 14, 2017; 85 FR 46988, Aug. 3, 2020; 85 FR 58283, Sept. 18, 2020; 88 FR 17156, Mar. 22, 2023]

§ 1.19 Document supply fees.

The United States Patent and Trademark Office will supply copies of the following patent-related documents upon payment of the fees indicated. Paper copies will be in black and white unless the original document is in color, a color copy is requested and the fee for a color copy is paid.

(a) Uncertified copies of patent application publications and patents:

(1) Printed copy of the paper portion of a patent application publication or patent including a design patent, statutory invention registration, or defensive publication document. Service includes preparation of copies by the Office within two to three business days and delivery by United States Postal Service; and preparation of copies by the Office within one business day of receipt and delivery to an Office Box or by electronic means (e.g., facsimile, electronic mail): $3.00

(2) Printed copy of a plant patent in color: $15.00

(3) Color copy of a patent (other than a plant patent) or statutory invention registration containing a color drawing: $25.00

(b) Copies of Office documents to be provided in paper, or in electronic form, as determined by the Director (for other patent-related materials *see* § 1.21(k)):

(1) Copy of a patent application as filed, or a patent-related file wrapper and contents, stored in paper in a paper file wrapper, in an image format in an image file wrapper, or if color documents, stored in paper in an Artifact Folder:

(i) If provided on paper:

(A) Application as filed: $35.00

(B) Copy Patent File Wrapper, Any Number of Sheets: $290.00

(C) [Reserved]

(D) Individual application documents, other than application as filed, per document: $25.00

(ii) If provided on compact disc or other physical electronic medium in single order or if provided electronically (*e.g.,* by electronic transmission) other than on a physical electronic medium:

(A) Application as filed: $35.00

(B) Copy Patent File Wrapper, Electronic, Any Size: $60.00

(C) [Reserved]

(iii) [Reserved]

(iv) If provided to a foreign intellectual property office pursuant to a bilateral or multilateral agreement (*see* § 1.14(h)): $0.00

(2) [Reserved]

(3) Copy of Office records, except copies available under paragraph (b)(1) or (2) of this section: $25.00

(4) For assignment records, abstract of title and certification, per patent: $35.00

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

(d)–(e) [Reserved]

(f) Uncertified copy of a non-United States patent document, per document: $25.00

(g) [Reserved]

(h) Copy of Patent Grant Single-Page TIFF Images (52 week subscription): $10,400.00

(i) Copy of Patent Grant Full-Text W/Embedded Images, Patent Application Publication Single-Page TIFF Images, or Patent Application Publication Full-Text W/Embedded Images (52 week subscription): $5,200.00

[78 FR 4287, Jan. 18, 2013, as amended at 80 FR 65655, Oct. 27, 2015; 82 FR 52814, Nov. 14, 2017; 85 FR 46988, Aug. 3, 2020]

§ 1.20 Post-issuance fees.

(a) For providing a certificate of correction for an applicant's mistake (§ 1.323): $160.00

(b) Processing fee for correcting inventorship in a patent (§ 1.324): $160.00

(c) In reexamination proceedings:

(1)(i) For filing a request for *ex parte* reexamination (§ 1.510(a)) having:

(A) 40 or fewer pages;

(B) Lines that are double-spaced or one-and-a-half spaced;

(C) Text written in a non-script type font such as Arial, Times New Roman, or Courier;

(D) A font size no smaller than 12 point;

(E) Margins that conform to the requirements of § 1.52(a)(1)(ii); and

(F) Sufficient clarity and contrast to permit direct reproduction and electronic capture by use of digital imaging and optical character recognition.

TABLE 1 TO PARAGRAPH (c)(1)(i)

By a micro entity (§ 1.29)	$1,260.00
By a small entity (§ 1.27(a))	2,520.00
By other than a small or micro entity	6,300.00

(ii) The following parts of an *ex parte* reexamination request are excluded from paragraphs (c)(1)(i)(A) through (F) of this section:

(A) The copies of every patent or printed publication relied upon in the request pursuant to § 1.510(b)(3)

(B) The copy of the entire patent for which reexamination is requested pursuant to § 1.510(b)(4); and

(C) The certifications required pursuant to § 1.510(b)(5) and (6).

(2) For filing a request for *ex parte* reexamination (§ 1.510(b)) that has sufficient clarity and contrast to permit direct reproduction and electronic capture by use of digital imaging and optical character recognition, and which otherwise does not comply with the provisions of paragraph (c)(1) of this section:

TABLE 2 TO PARAGRAPH (c)(2)

By a micro entity (§ 1.29)	$2,520.00
By a small entity (§ 1.27(a))	5,040.00
By other than a small or micro entity	12,600.00

(3) For filing with a request for reexamination or later presentation at any other time of each claim in independent form in excess of three and also in excess of the number of claims in independent form in the patent under reexamination:

TABLE 3 TO PARAGRAPH (c)(3)

By a micro entity (§ 1.29)	$96.00
By a small entity (§ 1.27(a))	192.00
By other than a small or micro entity	480.00

(4) For filing with a request for reexamination or later presentation at any other time of each claim (whether dependent or independent) in excess of 20 and also in excess of the number of claims in the patent under reexamination (note that § 1.75(c) indicates how multiple dependent claims are considered for fee calculation purposes):

TABLE 4 TO PARAGRAPH (c)(4)

By a micro entity (§ 1.29)	$20.00
By a small entity (§ 1.27(a))	40.00
By other than a small or micro entity	100.00

(5) If the excess claims fees required by paragraphs (c)(3) and (4) of this section are not paid with the request for reexamination or on later presentation of the claims for which the excess claims fees are due, the fees required by paragraphs (c)(3) and (4) must be paid or the claims canceled by amendment prior to the expiration of the time period set for reply by the Office in any notice of fee deficiency in order to avoid abandonment.

(6) For filing a petition in a reexamination proceeding, except for those

specifically enumerated in §§1.550(i) and 1.937(d):

TABLE 5 TO PARAGRAPH (c)(6)

By a micro entity (§ 1.29)	$408.00
By a small entity (§ 1.27(a))	816.00
By other than a small or micro entity	2,040.00

(7) For a refused request for *ex parte* reexamination under § 1.510 (included in the request for *ex parte* reexamination fee at § 1.20(c)(1) or (2)):

TABLE 6 TO PARAGRAPH (c)(7)

By a micro entity (§ 1.29)	$756.00
By a small entity (§ 1.27(a))	1,512.00
By other than a small or micro entity	3,780.00

(d) For filing each statutory disclaimer (§ 1.321): $170.00

(e) For maintaining an original or any reissue patent, except a design or plant patent, based on an application filed on or after December 12, 1980, in force beyond four years, the fee being due by three years and six months after the original grant:

TABLE 7 TO PARAGRAPH (e)

By a micro entity (§ 1.29)	$400.00
By a small entity (§ 1.27(a))	800.00
By other than a small or micro entity	2,000.00

(f) For maintaining an original or any reissue patent, except a design or plant patent, based on an application filed on or after December 12, 1980, in force beyond eight years, the fee being due by seven years and six months after the original grant:

TABLE 8 TO PARAGRAPH (f)

By a micro entity (§ 1.29)	$752.00
By a small entity (§ 1.27(a))	1,504.00
By other than a small or micro entity	3,760.00

(g) For maintaining an original or any reissue patent, except a design or plant patent, based on an application filed on or after December 12, 1980, in force beyond twelve years, the fee being due by eleven years and six months after the original grant:

TABLE 9 TO PARAGRAPH (g)

By a micro entity (§ 1.29)	$1,540.00
By a small entity (§ 1.27(a))	3,080.00
By other than a small or micro entity	7,700.00

(h) Surcharge for paying a maintenance fee during the six-month grace period following the expiration of three years and six months, seven years and six months, and eleven years and six months after the date of the original grant of a patent based on an application filed on or after December 12, 1980:

TABLE 10 TO PARAGRAPH (h)

By a micro entity (§ 1.29)	$100.00
By a small entity (§ 1.27(a))	200.00
By other than a small or micro entity	$500.00

(i) [Reserved]

(j) For filing an application for extension of the term of a patent:

TABLE 11 TO PARAGRAPH (j)

(1) Application for extension under § 1.740	$1,180.00
(2) Initial application for interim extension under § 1.790	440.00
(3) Subsequent application for interim extension under § 1.790	230.00

(k) In supplemental examination proceedings:

(1) For processing and treating a request for supplemental examination:

TABLE 12 TO PARAGRAPH (k)(1)

By a micro entity (§ 1.29)	$924.00
By a small entity (§ 1.27(a))	1,848.00
By other than a small or micro entity	4,620.00

(2) For *ex parte* reexamination ordered as a result of a supplemental examination proceeding:

TABLE 13 TO PARAGRAPH (k)(2)

By a micro entity (§ 1.29)	$2,540.00
By a small entity (§ 1.27(a))	5,080.00
By other than a small or micro entity	12,700.00

(3) For processing and treating, in a supplemental examination proceeding, a non-patent document over 20 sheets in length, per document:

(i) Between 21 and 50 sheets:

TABLE 14 TO PARAGRAPH (k)(3)(i)

By a micro entity (§ 1.29)	$36.00
By a small entity (§ 1.27(a))	72.00
By other than a small or micro entity	180.00

(ii) For each additional 50 sheets or a fraction thereof:

TABLE 15 TO PARAGRAPH (k)(3)(ii)

By a micro entity (§ 1.29)	$60.00
By a small entity (§ 1.27(a))	120.00
By other than a small or micro entity	300.00

[85 FR 46988, Aug. 3, 2020, as amended at 85 FR 58283, Sept. 18, 2020; 88 FR 17156, Mar. 22, 2023]

§ 1.21 Miscellaneous fees and charges.

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

(a) Registration of attorneys and agents:

(1) For admission to examination for registration to practice:

(i) Application fee (non-refundable): $110.00

(ii) Registration examination fee

(A) For test administration by commercial entity: $210.00

(B) [Reserved]

(iii) For USPTO-administered review of registration examination: $470.00

(iv) Request for extension of time in which to schedule examination for registration to practice (non-refundable): $115.00

(2) On registration to practice or grant of limited recognition:

(i) On registration to practice under § 11.6 of this chapter: $210.00

(ii) On grant of limited recognition under § 11.9(b) of this chapter: $210.00

(3) [Reserved]

(4) For certificate of good standing as an attorney or agent:

(i) Standard: $40.00

(ii) Suitable for framing: $50.00

(5) For review of decision:

(i) By the Director of Enrollment and Discipline under § 11.2(c) of this chapter: $420.00

(ii) Of the Director of Enrollment and Discipline under § 11.2(d) of this chapter: $420.00

(6) Recovery/Retrieval of OED Information System Customer Interface account by USPTO:

(i) [Reserved]

(ii) For USPTO-assisted change of address: $70.00

(7)–(8) [Reserved]

(9) Administrative reinstatement fees:

(i) Delinquency fee: $50.00

(ii) Administrative reinstatement fee: $210.00

(10) On application by a person for recognition or registration after disbarment or suspension on ethical grounds, or resignation pending disciplinary proceedings in any other jurisdiction; on application by a person for recognition or registration who is asserting rehabilitation from prior conduct that resulted in an adverse decision in the Office regarding the person's moral character; on application by a person for recognition or registration after being convicted of a felony or crime involving moral turpitude or breach of fiduciary duty; and on petition for reinstatement by a person excluded or suspended on ethical grounds, or excluded on consent from practice before the Office: $1,680.00

(b) Deposit accounts:

(1) [Reserved]

(2) Service charge for each month when the balance at the end of the month is below $1,000: $25.00

(3) Service charge for each month when the balance at the end of the month is below $300 for restricted subscription deposit accounts used exclusively for subscription order of patent copies as issued: $25.00

(c)–(d) [Reserved]

(e) International type search reports: For preparing an international type search report of an international type search made at the time of the first action on the merits in a national patent application: $40.00

(f)–(g) [Reserved]

(h) For recording each assignment, agreement, or other paper relating to the property in a patent or application, per property:

(1) If submitted electronically, on or after January 1, 2014: $0.00

(2) If not submitted electronically: $50.00

(i) Publication in Official Gazette: For publication in the Official Gazette

of a notice of the availability of an application or a patent for licensing or sale: Each application or patent: $25.00

(j) [Reserved]

(k) For items and services that the director finds may be supplied, for which fees are not specified by statute or by this part, such charges as may be determined by the director with respect to each such item or service: Actual cost

(l) [Reserved]

(m) For processing each payment refused (including a check returned ''unpaid'') or charged back by a financial institution: $50.00

(n) For handling an application in which proceedings are terminated pursuant to § 1.53(e): $140.00

(o) The receipt of a very lengthy sequence listing (mega-sequence listing) in an application under 35 U.S.C. 111 or 371 is subject to the following fee:

(1) First receipt by the Office of a sequence listing in electronic form ranging in size from 300MB to 800MB (without file compression):

TABLE 1 TO PARAGRAPH (o)(1)

By a micro entity (§ 1.29)	$212.00
By a small entity (§ 1.27(a))	424.00
By other than a small or micro entity	1,060.00

(2) First receipt by the Office of a sequence listing in electronic form exceeding 800MB in size (without file compression):

TABLE 2 TO PARAGRAPH (o)(2)

By a micro entity (§ 1.29)	$2,100.00
By a small entity (§ 1.27(a))	4,200.00
By other than a small or micro entity	10,500.00

(p) Additional Fee for Overnight Delivery: $40.00

(q) Additional fee for expedited service: $170.00

[82 FR 52815, Nov. 14, 2017, as amended at 85 FR 46989, Aug. 3, 2020, 85 FR 58283, Sept. 18, 2020; 86 FR 28451, May 26, 2021; 88 FR 17157, Mar. 22, 2023; 88 FR 45086, July 14, 2023]

§ 1.22 Fees payable in advance.

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

(b) All fees paid to the United States Patent and Trademark Office must be itemized in each individual application, patent, or other proceeding in such a manner that it is clear for which purpose the fees are paid. The Office may return fees that are not itemized as required by this paragraph. The provisions of § 1.5(a) do not apply to the resubmission of fees returned pursuant to this paragraph.

[68 FR 48288, Aug. 13, 2003]

§ 1.23 Methods of payment.

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

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

fees by credit card, the Office will not be liable if the credit card number becomes public knowledge.

(c) A fee transmittal letter may be signed by a juristic applicant or patent owner.

[65 FR 33455, May 24, 2000, as amended at 69 FR 43752, July 22, 2004; 78 FR 62395, Oct. 21, 2013]

§ 1.24 [Reserved]

§ 1.25 Deposit accounts.

(a) For the convenience of attorneys, and the general public in paying any fees due, in ordering services offered by the Office, copies of records, etc., deposit accounts may be established in the Patent and Trademark Office upon payment of the fee for establishing a deposit account (§1.21(b)(1)). A minimum deposit of $1,000 is required for paying any fees due or in ordering any services offered by the Office. However, a minimum deposit of $300 may be paid to establish a restricted subscription deposit account used exclusively for subscription order of patent copies as issued. At the end of each month, a deposit account statement will be rendered. A remittance must be made promptly upon receipt of the statement to cover the value of items or services charged to the account and thus restore the account to its established normal deposit. An amount sufficient to cover all fees, services, copies, etc., requested must always be on deposit. Charges to accounts with insufficient funds will not be accepted. A service charge (§1.21(b)(2)) will be assessed for each month that the balance at the end of the month is below $1,000. For restricted subscription deposit accounts, a service charge (§1.21(b)(3)) will be assessed for each month that the balance at the end of the month is below $300.

(b) Filing, issue, appeal, international-type search report, international application processing, international design application fees, petition, and post-issuance fees may be charged against these accounts if sufficient funds are on deposit to cover such fees. A general authorization to charge all fees, or only certain fees, set forth in §§1.16 through 1.18 to a deposit account containing sufficient funds may be filed in an individual application, either for the entire pendency of the application or with a particular paper filed. A general authorization to charge fees in an international design application set forth in §1.1031 will only be effective for the transmittal fee (§1.1031(a)). An authorization to charge fees under §1.16 in an international application entering the national stage under 35 U.S.C. 371 will be treated as an authorization to charge fees under §1.492. An authorization to charge fees set forth in §1.18 to a deposit account is subject to the provisions of §1.311(b). An authorization to charge to a deposit account the fee for a request for reexamination pursuant to §1.510 or 1.913 and any other fees required in a reexamination proceeding in a patent may also be filed with the request for reexamination, and an authorization to charge to a deposit account the fee for a request for supplemental examination pursuant to §1.610 and any other fees required in a supplemental examination proceeding in a patent may also be filed with the request for supplemental examination. An authorization to charge a fee to a deposit account will not be considered payment of the fee on the date the authorization to charge the fee is effective unless sufficient funds are present in the account to cover the fee.

(c) A deposit account holder may replenish the deposit account by submitting a payment to the United States Patent and Trademark Office. A payment to replenish a deposit account must be submitted by one of the methods set forth in paragraphs (c)(1), (c)(2), or (c)(3) of this section.

(1) A payment to replenish a deposit account may be submitted by electronic funds transfer through the Federal Reserve Fedwire System, which requires that the following information be provided to the deposit account holder's bank or financial institution:

(i) Name of the Bank, which is Treas NYC (Treasury New York City);

(ii) Bank Routing Code, which is 021030004;

(iii) United States Patent and Trademark Office account number with the Department of the Treasury, which is 13100001; and

(iv) The deposit account holder's company name and deposit account number.

(2) A payment to replenish a deposit account may be submitted by electronic funds transfer over the Office's Internet Web site (*www.uspto.gov*).

(3) A payment to replenish a deposit account may be addressed to: Mail Stop Deposit Accounts, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313–1450.

(35 U.S.C. 6, Pub. L. 97–247)

[49 FR 553, Jan. 4, 1984, as amended at 50 FR 31826, Aug. 6, 1985; 65 FR 76772, Dec. 7, 2000; 67 FR 523, Jan. 4, 2002; 68 FR 14336, Mar. 25, 2003; 69 FR 43752, July 22, 2004; 70 FR 56127, Sept. 26, 2005; 73 FR 47541, Aug. 14, 2008; 78 FR 62395, Oct. 21, 2013; 80 FR 17955, Apr. 2, 2015; 86 FR 35231, July 2, 2021]

§ 1.26 Refunds.

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

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

(c) If the Director decides not to institute a reexamination proceeding in response to a request for reexamination or supplemental examination, fees paid with the request for reexamination or supplemental examination will be refunded or returned in accordance with paragraphs (c)(1) through (c)(3) of this section. The reexamination requester or the patent owner who requested a supplemental examination proceeding, as appropriate, should indicate the form in which any refund should be made (*e.g.*, by check, electronic funds transfer, credit to a deposit account). Generally, refunds will be issued in the form that the original payment was provided.

(1) For an *ex parte* reexamination request, the *ex parte* reexamination filing fee paid by the reexamination requester, less the fee set forth in § 1.20(c)(7), will be refunded to the requester if the Director decides not to institute an *ex parte* reexamination proceeding.

(2) For an *inter partes* reexamination request, a refund of $7,970 will be made to the reexamination requester if the Director decides not to institute an *inter partes* reexamination proceeding.

(3) For a supplemental examination request, the fee for reexamination ordered as a result of supplemental examination, as set forth in § 1.20(k)(2), will be returned to the patent owner who requested the supplemental examination proceeding if the Director decides not to institute a reexamination proceeding.

(35 U.S.C. 6; 15 U.S.C. 1113, 1123)

[47 FR 41274, Sept. 17, 1982, as amended at 50 FR 31826, Aug. 6, 1985; 54 FR 6902, Feb. 15, 1989; 56 FR 65153, Dec. 13, 1991; 57 FR 38195, Aug. 21, 1992; 62 FR 53183, Oct. 10, 1997; 65 FR 54659, Sept. 8, 2000; 65 FR 76773, Dec. 7, 2000; 68 FR 48289, Aug. 13, 2003; 72 FR 46836, Aug. 21, 2007; 74 FR 52688, Oct. 14, 2009; 77 FR 48851, Aug. 14, 2012]

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

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

(1) *Person.* A person, as used in paragraph (c) of this section, means any inventor or other individual (e.g., an individual to whom an inventor has transferred some rights in the invention) who has not assigned, granted, conveyed, or licensed, and is under no obligation under contract or law to assign, grant, convey, or license, any rights in the invention. An inventor or other individual who has transferred some rights in the invention to one or more parties, or is under an obligation to transfer some rights in the invention to one or more parties, can also qualify for small entity status if all the parties who have had rights in the invention transferred to them also qualify for small entity status either as a person, small business concern, or nonprofit organization under this section.

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

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

(ii) Meets the size standards set forth in 13 CFR 121.801 through 121.805 to be eligible for reduced patent fees. Questions related to standards for a small business concern may be directed to: Small Business Administration, Size Standards Staff, 409 Third Street, SW., Washington, DC 20416.

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

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

(ii) Is either:

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

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

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

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

(4) *Federal Government Use License Exceptions.* In a patent application filed, prosecuted, and if patented, maintained at no expense to the Government, with the exception of any expense taken to deliver the application and fees to the Office on behalf of the applicant:

(i) For persons under paragraph (a)(1) of this section, claiming small entity status is not prohibited by:

(A) A use license to the Government resulting from a rights determination under Executive Order 10096 made in accordance with § 501.6 of this title;

(B) A use license to the Government resulting from Federal agency action pursuant to 15 U.S.C. 3710d(a) allowing the Federal employee-inventor to obtain or retain title to the invention; or

(C) A use license to a Federal agency resulting from retention of rights under 35 U.S.C. 202(d) by an inventor employed by a small business concern or nonprofit organization contractor, provided the license is equivalent to the license under 35 U.S.C. 202(c)(4) the Federal agency would have received had the contractor elected to retain title, and all the conditions applicable

under §401.9 of this title to an employee/inventor are met.

(ii) For small business concerns and nonprofit organizations under paragraphs (a)(2) and (3) of this section, a use license to a Federal agency resulting from a funding agreement with that agency pursuant to 35 U.S.C. 202(c)(4) does not preclude claiming small entity status, provided that:

(A) The subject invention was made solely by employees of the small business concern or nonprofit organization; or

(B) In the case of a Federal employee co-inventor, the Federal agency employing such co-inventor took action pursuant to 35 U.S.C. 202(e)(1) to exclusively license or assign whatever rights currently held or that it may acquire in the subject invention to the small business concern or nonprofit organization, subject to the license under 35 U.S.C. 202(c)(4).

(iii) For small business concerns and nonprofit organizations under paragraphs (a)(2) and (3) of this section that have collaborated with a Federal agency laboratory pursuant to a cooperative research and development agreement (CRADA) under 15 U.S.C. 3710a(a)(1), claiming small entity status is not prohibited by a use license to the Government pursuant to:

(A) 15 U.S.C. 3710a(b)(2) that results from retaining title to an invention made solely by the employee of the small business concern or nonprofit organization; or

(B) 15 U.S.C. 3710a(b)(3)(D), provided the laboratory has waived in whole any right of ownership the Government may have to the subject invention made by the small business concern or nonprofit organization, or has exclusively licensed whatever ownership rights the Government may acquire in the subject invention to the small business concern or nonprofit organization.

(iv) Regardless of whether an exception under this paragraph (a)(4) applies, no refund under §1.28(a) is available for any patent fee paid by the Government.

(5) *Security Interest.* A security interest does not involve an obligation to transfer rights in the invention for the purposes of paragraphs (a)(1) through (a)(3) of this section unless the security interest is defaulted upon.

(b) *Establishment of small entity status permits payment of reduced fees.* (1) A small entity, as defined in paragraph (a) of this section, who has properly asserted entitlement to small entity status pursuant to paragraph (c) of this section will be accorded small entity status by the Office in the particular application or patent in which entitlement to small entity status was asserted. Establishment of small entity status allows the payment of certain reduced patent fees pursuant to 35 U.S.C. 41(h)(1).

(2) Submission of an original utility application in compliance with the USPTO patent electronic filing system by an applicant who has properly asserted entitlement to small entity status pursuant to paragraph (c) of this section in that application allows the payment of a reduced filing fee pursuant to 35 U.S.C. 41(h)(3).

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

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

(i) Be clearly identifiable;

(ii) Be signed (see paragraph (c)(2) of this section); and

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

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

(i) The applicant (§ 1.42 or § 1.421);

(ii) A patent practitioner of record or a practitioner acting in a representative capacity under § 1.34;

(iii) The inventor or a joint inventor, if the inventor is the applicant; or

(iv) The assignee.

(3) *Assertion by payment of the small entity basic filing, basic transmittal, basic national fee, international search fee, or individual designation fee in an international design application.* The payment, by any party, of the exact amount of one of the small entity basic filing fees set forth in § 1.16(a), (b), (c), (d), or (e), the small entity transmittal fee set forth in § 1.445(a)(1) or § 1.1031(a), the small entity international search fee set forth in § 1.445(a)(2) to a Receiving Office other than the United States Receiving Office in the exact amount established for that Receiving Office pursuant to PCT Rule 16, or the small entity basic national fee set forth in § 1.492(a), will be treated as a written assertion of entitlement to small entity status even if the type of basic filing, basic transmittal, or basic national fee is inadvertently selected in error. The payment, by any party, of the small entity first part of the individual designation fee for the United States to the International Bureau (§ 1.1031) will be treated as a written assertion of entitlement to small entity status.

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

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

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

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

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

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

(f) *Assertion requires a determination of entitlement to pay small entity fees.* Prior to submitting an assertion of entitlement to small entity status in an application, including a related, continuing, or reissue application, a determination of such entitlement should be made pursuant to the requirements of paragraph (a) of this section. It should be determined that all parties holding rights in the invention qualify for small entity status. The Office will

generally not question any assertion of small entity status that is made in accordance with the requirements of this section, but note paragraph (h) of this section.

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

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

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

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

[65 FR 54659, Sept. 8, 2000, as amended at 69 FR 56538, Sept. 21, 2004; 70 FR 3889, Jan. 27, 2005; 77 FR 48813, Aug. 14, 2012; 78 FR 4289, Jan. 18, 2013; 80 FR 17955, Apr. 2, 2015; 85 FR 46990, Aug. 3, 2020; 85 FR 82923, Dec. 21, 2020]

§ 1.28 Refunds when small entity status is later established; how errors in small entity status are excused.

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

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

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

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

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

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

(i) *Calculation of the deficiency owed.* The deficiency owed for each previous fee erroneously paid as a small entity is the difference between the current

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

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

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

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

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

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

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

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

[65 FR 54661, Sept. 8, 2000]

§1.29 Micro entity status.

(a) To establish micro entity status under this paragraph, the applicant must certify that:

(1) The applicant qualifies as a small entity as defined in §1.27 without relying on a government use license exception under §1.27(a)(4);

(2) Neither the applicant nor the inventor nor a joint inventor has been named as the inventor or a joint inventor on more than four previously filed patent applications, other than applications filed in another country, provisional applications under 35 U.S.C. 111(b), or international applications for which the basic national fee under 35 U.S.C. 41(a) was not paid;

(3) Neither the applicant nor the inventor nor a joint inventor, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986 (26 U.S.C. 61(a)), exceeding three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census; and

(4) Neither the applicant nor the inventor nor a joint inventor has assigned, granted, or conveyed, nor is under an obligation by contract or law to assign, grant, or convey, a license or other ownership interest in the application concerned to an entity that, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986, exceeding three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census.

(b) An applicant, inventor, or joint inventor is not considered to be named on a previously filed application for purposes of paragraph (a)(2) of this section if the applicant, inventor, or joint inventor has assigned, or is under an obligation by contract or law to assign, all ownership rights in the application

as the result of the applicant's, inventor's, or joint inventor's previous employment.

(c) If an applicant's, inventor's, joint inventor's, or entity's gross income in the preceding calendar year is not in United States dollars, the average currency exchange rate, as reported by the Internal Revenue Service, during that calendar year shall be used to determine whether the applicant's, inventor's, joint inventor's, or entity's gross income exceeds the threshold specified in paragraph (a)(3) or (4) of this section.

(d) To establish micro entity status under this paragraph, the applicant must certify that:

(1) The applicant qualifies as a small entity as defined in §1.27 without relying on a government use license exception under §1.27(a)(4);

(2)(i) The applicant's employer, from which the applicant obtains the majority of the applicant's income, is an institution of higher education as defined in section 101(a) of the Higher Education Act of 1965 (20 U.S.C. 1001(a)); or

(ii) The applicant has assigned, granted, conveyed, or is under an obligation by contract or law, to assign, grant, or convey, a license or other ownership interest in the particular application to such an institution of higher education.

(e) Micro entity status is established in an application by filing a micro entity certification in writing complying with the requirements of either paragraph (a) or (d) of this section and signed either in compliance with §1.33(b), in an international application filed in a Receiving Office other than the United States Receiving Office by a person authorized to represent the applicant under §1.455, or in an international design application by a person authorized to represent the applicant under §1.1041 before the International Bureau where the micro entity certification is filed with the International Bureau. Status as a micro entity must be specifically established in each related, continuing and reissue application in which status is appropriate and desired. Status as a micro entity in one application or patent does not affect the status of any other application or patent, regardless of the relationship of the applications or patents. The refiling of an application under §1.53 as a continuation, divisional, or continuation-in-part application (including a continued prosecution application under §1.53(d)), or the filing of a reissue application, requires a new certification of entitlement to micro entity status for the continuing or reissue application.

(f) A fee may be paid in the micro entity amount only if it is submitted with, or subsequent to, the submission of a certification of entitlement to micro entity status.

(g) A certification of entitlement to micro entity status need only be filed once in an application or patent. Micro entity status, once established, remains in effect until changed pursuant to paragraph (i) of this section. However, a fee may be paid in the micro entity amount only if status as a micro entity as defined in paragraph (a) or (d) of this section is appropriate on the date the fee is being paid. Where an assignment of rights or an obligation to assign rights to other parties who are micro entities occurs subsequent to the filing of a certification of entitlement to micro entity status, a second certification of entitlement to micro entity status is not required.

(h) Prior to submitting a certification of entitlement to micro entity status in an application, including a related, continuing, or reissue application, a determination of such entitlement should be made pursuant to the requirements of this section. It should be determined that each applicant qualifies for micro entity status under paragraph (a) or (d) of this section, and that any other party holding rights in the invention qualifies for small entity status under §1.27. The Office will generally not question certification of entitlement to micro entity status that is made in accordance with the requirements of this section.

(i) Notification of a loss of entitlement to micro entity status must be filed in the application or patent prior to paying, or at the time of paying, any fee after the date on which status as a micro entity as defined in paragraph (a) or (d) of this section is no longer appropriate. The notification that micro entity status is no longer appropriate

must be signed by a party identified in §1.33(b). Payment of a fee in other than the micro entity amount is not sufficient notification that micro entity status is no longer appropriate. A notification that micro entity status is no longer appropriate will not be treated as a notification that small entity status is also no longer appropriate unless it also contains a notification of loss of entitlement to small entity status under §1.27(f)(2). Once a notification of a loss of entitlement to micro entity status is filed in the application or patent, a new certification of entitlement to micro entity status is required to again obtain micro entity status.

(j) Any attempt to fraudulently establish status as a micro entity, or pay fees as a micro entity, shall be considered as a fraud practiced or attempted on the Office. Improperly, and with intent to deceive, establishing status as a micro entity, or paying fees as a micro entity, shall be considered as a fraud practiced or attempted on the Office.

(k) If status as a micro entity is established in good faith in an application or patent, and fees as a micro entity are paid in good faith in the application or patent, and it is later discovered that such micro entity status either was established in error, or that the Office was not notified of a loss of entitlement to micro entity status as required by paragraph (i) of this section through error, the error will be excused upon compliance with the separate submission and itemization requirements of paragraph (k)(1) of this section and the deficiency payment requirement of paragraph (k)(2) of this section.

(1) Any paper submitted under this paragraph must be limited to the deficiency payment (all fees paid in error) required for a single application or patent. Where more than one application or patent is involved, separate submissions of deficiency payments are required for each application or patent (see §1.4(b)). The paper must contain an itemization of the total deficiency payment for the single application or patent and include the following information:

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

(ii) The micro entity fee actually paid, and the date on which it was paid;

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

(iv) The total deficiency payment owed, which is the sum or total of the individual deficiency owed amounts as set forth in paragraph (k)(2) of this section.

(2) The deficiency owed, resulting from the previous erroneous payment of micro entity fees, must be paid. The deficiency owed for each previous fee erroneously paid as a micro entity is the difference between the current fee amount for a small entity or non-small entity, as applicable, on the date the deficiency is paid in full and the amount of the previous erroneous micro entity fee payment. The total deficiency payment owed is the sum of the individual deficiency owed amounts for each fee amount previously and erroneously paid as a micro entity.

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

(4) Any deficiency payment (based on a previous erroneous payment of a micro entity fee) submitted under this paragraph will be treated as a notification of a loss of entitlement to micro entity status under paragraph (i) of this section.

[77 FR 75033, Dec. 19, 2012, as amended at 78 FR 62396, Oct. 21, 2013; 80 FR 17955, Apr. 2, 2015; 85 FR 82923, Dec. 21, 2020]

Subpart B—National Processing Provisions

PROSECUTION OF APPLICATION AND APPOINTMENT OF ATTORNEY OR AGENT

§ 1.31 Applicant may be represented by one or more patent practitioners or joint inventors.

An applicant for patent may file and prosecute the applicant's own case, or the applicant may give power of attorney so as to be represented by one or more patent practitioners or joint inventors, except that a juristic entity (*e.g.*, organizational assignee) must be represented by a patent practitioner even if the juristic entity is the applicant. The Office cannot aid in the selection of a patent practitioner.

[77 FR 48813, Aug. 14, 2012]

§ 1.32 Power of attorney.

(a) *Definitions.* (1) *Patent practitioner* means a registered patent attorney or registered patent agent under § 11.6. An attorney or agent registered under § 11.6(d) may only act as a practitioner in design patent applications or other design patent matters or design patent proceedings.

(2) *Power of attorney* means a written document by which a principal authorizes one or more patent practitioners or joint inventors to act on the principal's behalf.

(3) *Principal* means the applicant (§ 1.42) for an application for patent and the patent owner for a patent, including a patent in a supplemental examination or reexamination proceeding. The principal executes a power of attorney designating one or more patent practitioners or joint inventors to act on the principal's behalf.

(4) *Revocation* means the cancellation by the principal of the authority previously given to a patent practitioner or joint inventor to act on the principal's behalf.

(5) *Customer Number* means a number that may be used to:

(i) Designate the correspondence address of a patent application or patent such that the correspondence address for the patent application, patent or other patent proceeding would be the address associated with the Customer Number;

(ii) Designate the fee address (§ 1.363) of a patent such that the fee address for the patent would be the address associated with the Customer Number; and

(iii) Submit a list of patent practitioners such that those patent practitioners associated with the Customer Number would have power of attorney.

(6) *Patent practitioner of record* means a patent practitioner who has been granted a power of attorney in an application, patent, or other proceeding in compliance with paragraph (b) of this section. The phrases practitioner of record and attorney or agent of record also mean a patent practitioner who has been granted a power of attorney in an application, patent, or other proceeding in compliance with paragraph (b) of this section.

(b) A power of attorney must:

(1) Be in writing;

(2) Name one or more representatives in compliance with paragraph (c) of this section;

(3) Give the representative power to act on behalf of the principal; and

(4) Be signed by the applicant for patent (§ 1.42) or the patent owner. A patent owner who was not the applicant under § 1.46 must appoint any power of attorney in compliance with §§ 3.71 and 3.73 of this chapter.

(c) A power of attorney may only name as representative:

(1) One or more joint inventors (§ 1.45);

(2) Those registered patent practitioners associated with a Customer Number;

(3) Ten or fewer patent practitioners, stating the name and registration number of each patent practitioner. Except as provided in paragraph (c)(1) or (c)(2) of this section, the Office will not recognize more than ten patent practitioners as being of record in an application or patent. If a power of attorney names more than ten patent practitioners, such power of attorney must be accompanied by a separate paper indicating which ten patent practitioners named in the power of attorney are to be recognized by the Office as being of record in the application or patent to which the power of attorney is directed.

(d) A power of attorney from a prior national application for which benefit is claimed under 35 U.S.C. 120, 121, 365(c), or 386(c) in a continuing application may have effect in the continuing application if a copy of the power of attorney from the prior application is filed in the continuing application unless:

(1) The power of attorney was granted by the inventor; and

(2) The continuing application names an inventor who was not named as an inventor in the prior application.

(e) If the power of attorney was granted by the originally named inventive entity, and an added inventor pursuant to §1.48 does not provide a power of attorney consistent with the power of attorney granted by the originally named inventive entity, the addition of the inventor results in the loss of that power of attorney upon grant of the §1.48 request. This provision does not preclude a practitioner from acting pursuant to §1.34, if applicable.

[69 FR 29877, May 26, 2004, as amended at 70 FR 56127, Sept. 26, 2005; 77 FR 48813, Aug. 14, 2012; 80 FR 17956, Apr. 2, 2015; 88 FR 78649, Nov. 16, 2023]

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

(a) *Correspondence address and daytime telephone number.* When filing an application, a correspondence address must be set forth in either an application data sheet (§1.76), or elsewhere, in a clearly identifiable manner, in any paper submitted with an application filing. If no correspondence address is specified, the Office may treat the mailing address of the first named inventor (if provided, *see* §§1.76(b)(1) and 1.63(b)(2)) as the correspondence address. The Office will direct, or otherwise make available, all notices, official letters, and other communications relating to the application to the person associated with the correspondence address. For correspondence submitted via the USPTO patent electronic filing system, however, an electronic acknowledgment receipt will be sent to the submitter. The Office will generally not engage in double correspondence with an applicant and a patent practitioner, or with more than one patent practitioner except as deemed necessary by the Director. If more than one correspondence address is specified, the Office will select one of the specified addresses for use as the correspondence address and, if given, may select the address associated with a Customer Number over a typed correspondence address. For the party to whom correspondence is to be addressed, a daytime telephone number should be supplied in a clearly identifiable manner and may be changed by any party who may change the correspondence address. The correspondence address may be changed by the parties set forth in paragraph (b)(1) or (b)(3) of this section. Prior to the appointment of any power of attorney under §1.32(b), the correspondence address may also be changed by any patent practitioner named in the application transmittal papers who acts in a representative capacity under the provisions of §1.34.

(b) *Amendments and other papers.* Amendments and other papers, except for written assertions pursuant to §1.27(c)(2)(iii) or (c)(2)(iv), filed in the application must be signed by:

(1) A patent practitioner of record;

(2) A patent practitioner not of record who acts in a representative capacity under the provisions of §1.34; or

(3) The applicant (§1.42). Unless otherwise specified, all papers submitted on behalf of a juristic entity must be signed by a patent practitioner.

(c) All notices, official letters, and other communications for the patent owner or owners in a reexamination or supplemental examination proceeding will be directed to the correspondence address in the patent file. Amendments filed in a reexamination proceeding, and other papers filed in a reexamination or supplemental examination proceeding, on behalf of the patent owner must be signed by the patent owner, or if there is more than one owner by all the owners, or by an attorney or agent of record in the patent file, or by a registered attorney or agent not of record who acts in a representative capacity under the provisions of §1.34. Double correspondence with the patent owner

or owners and the patent owner's attorney or agent, or with more than one attorney or agent, will not be undertaken.

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

(e) A change of address filed in a patent application or patent does not change the address for a patent practitioner in the roster of patent attorneys and agents. See §11.11 of this title.

(f) Where application papers from a prior application are used in a continuing application and the correspondence address was changed during the prosecution of the prior application, an application data sheet or separate paper identifying the correspondence address to be used for the continuing application must be submitted. Otherwise, the Office may not recognize the change of correspondence address effected during the prosecution of the prior application.

(g) A patent practitioner acting in a representative capacity whose correspondence address is the correspondence address of record in an application may change the correspondence address after the patent has issued, provided that the change of correspondence address is accompanied by a statement that notice has been given to the patentee or owner.

[36 FR 12617, July 2, 1971, as amended at 46 FR 29181, May 29, 1981; 49 FR 34724, Aug. 31, 1984; 50 FR 5171, Feb. 6, 1985; 62 FR 53184, Oct. 10, 1997; 65 FR 54661, Sept. 8, 2000; 69 FR 29877, May 26, 2004; 69 FR 35452, June 24, 2004; 70 FR 3889, Jan. 27, 2005; 70 FR 56127, Sept. 26, 2005; 72 FR 2776, Jan. 23, 2007; 72 FR 18904, Apr. 16, 2007; 77 FR 48814, Aug. 14, 2012; 78 FR 62396, Oct. 21, 2013]

§ 1.34 Acting in a representative capacity.

When a patent practitioner acting in a representative capacity appears in person or signs a paper in practice before the United States Patent and Trademark Office in a patent case, his or her personal appearance or signature shall constitute a representation to the United States Patent and Trademark Office that under the provisions of this subchapter and the law, he or she is authorized to represent the particular party on whose behalf he or she acts. In filing such a paper, the patent practitioner must set forth his or her registration number, his or her name and signature. Further proof of authority to act in a representative capacity may be required.

[70 FR 56127, Sept. 26, 2005]

§ 1.36 Revocation of power of attorney; withdrawal of patent attorney or agent.

(a) A power of attorney, pursuant to §1.32(b), may be revoked at any stage in the proceedings of a case by the applicant or patent owner. A power of attorney to the patent practitioners associated with a Customer Number will be treated as a request to revoke any powers of attorney previously given. Fewer than all of the applicants (or fewer than all patent owners in a supplemental examination or reexamination proceeding) may revoke the power of attorney only upon a showing of sufficient cause, and payment of the petition fee set forth in §1.17(f). A patent practitioner will be notified of the revocation of the power of attorney. Where power of attorney is given to the patent practitioners associated with a Customer Number (§1.32(c)(2)), the practitioners so appointed will also be notified of the revocation of the power of attorney when the power of attorney to all of the practitioners associated with the Customer Number is revoked. The notice of revocation will be mailed to the correspondence address for the application (§1.33) in effect before the revocation. An assignment will not of itself operate as a revocation of a power previously given, but the assignee may become the applicant under §1.46(c) and revoke any previous power of attorney and grant a power of attorney as provided in §1.32(b).

(b) A registered patent attorney or patent agent who has been given a power of attorney pursuant to §1.32(b) may withdraw as attorney or agent of record upon application to and approval by the Director. The applicant or patent owner will be notified of the

withdrawal of the registered patent attorney or patent agent. Where power of attorney is given to the patent practitioners associated with a Customer Number, a request to delete all of the patent practitioners associated with the Customer Number may not be granted if an applicant has given power of attorney to the patent practitioners associated with the Customer Number in an application that has an Office action to which a reply is due, but insufficient time remains for the applicant to file a reply. See §41.5 of this title for withdrawal during proceedings before the Patent Trial and Appeal Board.

[69 FR 49997, Aug. 12, 2004, as amended at 70 FR 56128, Sept. 26, 2005; 77 FR 46624, Aug. 6, 2012; 77 FR 48814, Aug. 14, 2012]

WHO MAY APPLY FOR A PATENT

§1.41 Inventorship.

(a) An application must include, or be amended to include, the name of the inventor for any invention claimed in the application.

(b) The inventorship of a nonprovisional application under 35 U.S.C. 111(a) is the inventor or joint inventors set forth in the application data sheet in accordance with §1.76 filed before or concurrently with the inventor's oath or declaration. If an application data sheet is not filed before or concurrently with the inventor's oath or declaration, the inventorship is the inventor or joint inventors set forth in the inventor's oath or declaration, except as provided for in §§1.53(d)(4) and 1.63(d). Once an application data sheet or the inventor's oath or declaration is filed in a nonprovisional application, any correction of inventorship must be pursuant to §1.48. If neither an application data sheet nor the inventor's oath or declaration is filed during the pendency of a nonprovisional application, the inventorship is the inventor or joint inventors set forth in the application papers filed pursuant to §1.53(b), unless the applicant files a paper, including the processing fee set forth in §1.17(i), supplying the name or names of the inventor or joint inventors.

(c) The inventorship of a provisional application is the inventor or joint inventors set forth in the cover sheet as prescribed by §1.51(c)(1). Once a cover sheet as prescribed by §1.51(c)(1) is filed in a provisional application, any correction of inventorship must be pursuant to §1.48. If a cover sheet as prescribed by §1.51(c)(1) is not filed during the pendency of a provisional application, the inventorship is the inventor or joint inventors set forth in the application papers filed pursuant to §1.53(c), unless applicant files a paper including the processing fee set forth in §1.17(q), supplying the name or names of the inventor or joint inventors.

(d) In a nonprovisional application under 35 U.S.C. 111(a) filed without an application data sheet or the inventor's oath or declaration, or in a provisional application filed without a cover sheet as prescribed by §1.51(c)(1), the name and residence of each person believed to be an actual inventor should be provided when the application papers pursuant to §1.53(b) or §1.53(c) are filed.

(e) The inventorship of an international application entering the national stage under 35 U.S.C. 371 is the inventor or joint inventors set forth in the application data sheet in accordance with §1.76 filed with the initial submission under 35 U.S.C. 371. Unless the initial submission under 35 U.S.C. 371 is accompanied by an application data sheet in accordance with §1.76 setting forth the inventor or joint inventors, the inventorship is the inventor or joint inventors set forth in the international application, which includes any change effected under PCT Rule 92 *bis*.

(f) The inventorship of an international design application designating the United States is the creator or creators set forth in the publication of the international registration under Hague Agreement Article 10(3). Any correction of inventorship must be pursuant to §1.48.

[77 FR 48814, Aug. 14, 2012, as amended at 80 FR 17956, Apr. 2, 2015]

§1.42 Applicant for patent.

(a) The word ''applicant'' when used in this title refers to the inventor or all of the joint inventors, or to the person applying for a patent as provided in §§1.43, 1.45, or 1.46.

(b) If a person is applying for a patent as provided in §1.46, the word ''applicant'' refers to the assignee, the person to whom the inventor is under an obligation to assign the invention, or the person who otherwise shows sufficient proprietary interest in the matter, who is applying for a patent under §1.46 and not the inventor.

(c) If fewer than all joint inventors are applying for a patent as provided in §1.45, the phrase ''the applicant'' means the joint inventors who are applying for the patent without the omitted inventor(s).

(d) Any person having authority may deliver an application and fees to the Office on behalf of the applicant. However, an oath or declaration, or substitute statement in lieu of an oath or declaration, may be executed only in accordance with §1.63 or 1.64, a correspondence address may be provided only in accordance with §1.33(a), and amendments and other papers must be signed in accordance with §1.33(b).

(e) The Office may require additional information where there is a question concerning ownership or interest in an application, and a showing may be required from the person filing the application that the filing was authorized where such authorization comes into question.

[77 FR 48815, Aug. 14, 2012]

§ 1.43 Application for patent by a legal representative of a deceased or legally incapacitated inventor.

If an inventor is deceased or under legal incapacity, the legal representative of the inventor may make an application for patent on behalf of the inventor. If an inventor dies during the time intervening between the filing of the application and the granting of a patent thereon, the letters patent may be issued to the legal representative upon proper intervention. *See* §1.64 concerning the execution of a substitute statement by a legal representative in lieu of an oath or declaration.

[77 FR 48815, Aug. 14, 2012]

§ 1.44 [Reserved]

§ 1.45 Application for patent by joint inventors.

(a) Joint inventors must apply for a patent jointly, and each must make an inventor's oath or declaration as required by §1.63, except as provided for in §1.64. If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the other joint inventor or inventors may make the application for patent on behalf of themselves and the omitted inventor. *See* §1.64 concerning the execution of a substitute statement by the other joint inventor or inventors in lieu of an oath or declaration.

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

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

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

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

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

[77 FR 48815, Aug. 14, 2012]

§ 1.46 Application for patent by an assignee, obligated assignee, or a person who otherwise shows sufficient proprietary interest in the matter.

(a) A person to whom the inventor has assigned or is under an obligation to assign the invention may make an application for patent. A person who otherwise shows sufficient proprietary interest in the matter may make an application for patent on behalf of and as agent for the inventor on proof of

the pertinent facts and a showing that such action is appropriate to preserve the rights of the parties.

(b) If an application under 35 U.S.C. 111 is made by a person other than the inventor under paragraph (a) of this section, the application must contain an application data sheet under §1.76 specifying in the applicant information section (§1.76(b)(7)) the assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter. If an application entering the national stage under 35 U.S.C. 371, or a nonprovisional international design application, is applied for by a person other than the inventor under paragraph (a) of this section, the assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter must have been identified as the applicant for the United States in the international stage of the international application or as the applicant in the publication of the international registration under Hague Agreement Article 10(3).

(1) If the applicant is the assignee or a person to whom the inventor is under an obligation to assign the invention, documentary evidence of ownership (*e.g.*, assignment for an assignee, employment agreement for a person to whom the inventor is under an obligation to assign the invention) should be recorded as provided for in part 3 of this chapter no later than the date the issue fee is paid in the application.

(2) If the applicant is a person who otherwise shows sufficient proprietary interest in the matter, such applicant must submit a petition including:

(i) The fee set forth in §1.17(g);

(ii) A showing that such person has sufficient proprietary interest in the matter; and

(iii) A statement that making the application for patent by a person who otherwise shows sufficient proprietary interest in the matter on behalf of and as agent for the inventor is appropriate to preserve the rights of the parties.

(c)(1) *Correction or update in the name of the applicant.* Any request to correct or update the name of the applicant under this section must include an application data sheet under §1.76 specifying the correct or updated name of the applicant in the applicant information section (§1.76(b)(7)) in accordance with §1.76(c)(2). A change in the name of the applicant recorded pursuant to Hague Agreement Article 16(1)(ii) will be effective to change the name of the applicant in a nonprovisional international design application.

(2) *Change in the applicant.* Any request to change the applicant under this section after an original applicant has been specified must include an application data sheet under §1.76 specifying the applicant in the applicant information section (§1.76(b)(7)) in accordance with §1.76(c)(2) and comply with §§3.71 and 3.73 of this title.

(d) Even if the whole or a part interest in the invention or in the patent to be issued is assigned or obligated to be assigned, an oath or declaration must be executed by the actual inventor or each actual joint inventor, except as provided for in §1.64. *See* §1.64 concerning the execution of a substitute statement by an assignee, person to whom the inventor is under an obligation to assign the invention, or a person who otherwise shows sufficient proprietary interest in the matter.

(e) If a patent is granted on an application filed under this section by a person other than the inventor, the patent shall be granted to the real party in interest. Otherwise, the patent may be issued to the assignee or jointly to the inventor and the assignee as provided in §3.81. Where a real party in interest has filed an application under §1.46, the applicant shall notify the Office of any change in the real party in interest no later than payment of the issue fee. The Office will treat the absence of such a notice as an indication that there has been no change in the real party in interest.

(f) The Office may publish notice of the filing of the application by a person who otherwise shows sufficient proprietary interest in the *Official Gazette.*

[77 FR 48815, Aug. 14, 2012, as amended at 80 FR 17956, Apr. 2, 2015]

§ 1.47 [Reserved]

§ 1.48 Correction of inventorship pursuant to 35 U.S.C. 116 or correction of the name or order of names in a patent application, other than a reissue application.

(a) *Nonprovisional application:* Any request to correct or change the inventorship once the inventorship has been established under § 1.41 must include:

(1) An application data sheet in accordance with § 1.76 that identifies each inventor by his or her legal name; and

(2) The processing fee set forth in § 1.17(i).

(b) *Inventor's oath or declaration for added inventor:* An oath or declaration as required by § 1.63, or a substitute statement in compliance with § 1.64, will be required for any actual inventor who has not yet executed such an oath or declaration.

(c) Any request to correct or change the inventorship under paragraph (a) of this section filed after the Office action on the merits has been given or mailed in the application must also be accompanied by the fee set forth in § 1.17(d), unless the request is accompanied by a statement that the request to correct or change the inventorship is due solely to the cancelation of claims in the application.

(d) *Provisional application.* Once a cover sheet as prescribed by § 1.51(c)(1) is filed in a provisional application, any request to correct or change the inventorship must include:

(1) A request, signed by a party set forth in § 1.33(b), to correct the inventorship that identifies each inventor by his or her legal name; and

(2) The processing fee set forth in § 1.17(q).

(e) *Additional information may be required.* The Office may require such other information as may be deemed appropriate under the particular circumstances surrounding the correction of inventorship.

(f) *Correcting or updating the name of an inventor:* Any request to correct or update the name of the inventor or a joint inventor, or the order of the names of joint inventors, in a nonprovisional application must include:

(1) An application data sheet in accordance with § 1.76 that identifies each inventor by his or her legal name in the desired order; and

(2) The processing fee set forth in § 1.17(i).

(g) *Reissue applications not covered.* The provisions of this section do not apply to reissue applications. *See* §§ 1.171 and 1.175 for correction of inventorship in a patent via a reissue application.

(h) *Correction of inventorship in patent. See* § 1.324 for correction of inventorship in a patent.

(i) *Correction of inventorship in an interference or contested case before the Patent Trial and Appeal Board.* In an interference under part 41, subpart D, of this title, a request for correction of inventorship in an application must be in the form of a motion under § 41.121(a)(2) of this title. In a contested case under part 42, subpart D, of this title, a request for correction of inventorship in an application must be in the form of a motion under § 42.22 of this title. The motion under § 41.121(a)(2) or 42.22 of this title must comply with the requirements of paragraph (a) of this section.

[77 FR 48816, Aug. 14, 2012, as amended at 78 FR 4289, Jan. 18, 2013]

THE APPLICATION

§ 1.51 General requisites of an application.

(a) Applications for patents must be made to the Director of the United States Patent and Trademark Office. An application transmittal letter limited to the transmittal of the documents and fees comprising a patent application under this section may be signed by a juristic applicant or patent owner.

(b) A complete application filed under § 1.53(b) or § 1.53(d) comprises:

(1) A specification as prescribed by 35 U.S.C. 112, including a claim or claims, see §§ 1.71 to 1.77;

(2) The inventor's oath or declaration, *see* §§ 1.63 and 1.64;

(3) Drawings, when necessary, see §§ 1.81 to 1.85; and

(4) The prescribed filing fee, search fee, examination fee, and application size fee, see § 1.16.

(c) A complete provisional application filed under § 1.53(c) comprises:

(1) A cover sheet identifying:

(i) The application as a provisional application,

(ii) The name or names of the inventor or inventors, (see §1.41(a)(2)),

(iii) The residence of each named inventor,

(iv) The title of the invention,

(v) The name and registration number of the attorney or agent (if applicable),

(vi) The docket number used by the person filing the application to identify the application (if applicable),

(vii) The correspondence address, and

(viii) The name of the U.S. Government agency and Government contract number (if the invention was made by an agency of the U.S. Government or under a contract with an agency of the U.S. Government);

(2) A specification as prescribed by 35 U.S.C. 112(a), see §1.71;

(3) Drawings, when necessary, see §§1.81 to 1.85; and

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

(d) Applicants are encouraged to file an information disclosure statement in nonprovisional applications. See §1.97 and §1.98. No information disclosure statement may be filed in a provisional application.

[62 FR 53185, Oct. 10, 1997, as amended at 65 FR 54664, Sept. 8, 2000; 68 FR 14336, Mar. 25, 2003; 70 FR 3889, Jan. 27, 2005; 77 FR 46624, Aug. 6, 2012; 77 FR 48816, Aug. 14, 2012; 78 FR 62396, Oct. 21, 2013]

§ 1.52 Language, paper, writing, margins, read-only optical disc specifications.

(a) *Papers that are to become a part of the permanent United States Patent and Trademark Office records in the file of a patent application, or a reexamination or supplemental examination proceeding.* (1) All papers, other than drawings, that are submitted on paper or by facsimile transmission, and are to become a part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination or supplemental examination proceeding, must be on sheets of paper that are the same size, not permanently bound together, and:

(i) Flexible, strong, smooth, nonshiny, durable, and white;

(ii) Either 21.0 cm by 29.7 cm (DIN size A4) or 21.6 cm by 27.9 cm (8½ by 11 inches), with each sheet including a top margin of at least 2.0 cm (¾ inch), a left side margin of at least 2.5 cm (1 inch), a right side margin of at least 2.0 cm (¾ inch), and a bottom margin of at least 2.0 cm (¾ inch);

(iii) Written on only one side in portrait orientation;

(iv) Plainly and legibly written either by a typewriter or machine printer in permanent dark ink or its equivalent; and

(v) Presented in a form having sufficient clarity and contrast between the paper and the writing thereon to permit the direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by use of digital imaging and optical character recognition.

(2) All papers that are submitted on paper or by facsimile transmission and are to become a part of the permanent records of the United States Patent and Trademark Office should have no holes in the sheets as submitted.

(3) The provisions of this paragraph and paragraph (b) of this section do not apply to the pre-printed information on paper forms provided by the Office, or to the copy of the patent submitted on paper in double column format as the specification in a reissue application or request for reexamination.

(4) See §1.58 for chemical and mathematical formulae and tables, and §1.84 for drawings.

(5) Papers that are submitted electronically to the Office must be formatted and transmitted in compliance with the USPTO patent electronic filing system requirements.

(b) *The application (specification, including the claims, drawings, and the inventor's oath or declaration) or reexamination or supplemental examination proceeding, any amendments to the application or reexamination proceeding, or any corrections to the application, or reexamination or supplemental examination proceeding.* (1) The application or proceeding and any amendments or corrections to the application (including any translation submitted pursuant to

paragraph (d) of this section) or proceeding, except as provided for in §1.69 and paragraph (d) of this section, must:

(i) Comply with the requirements of paragraph (a) of this section; and

(ii) Be in the English language or be accompanied by a translation of the application and a translation of any corrections or amendments into the English language together with a statement that the translation is accurate.

(2) The specification (including the abstract and claims) for other than reissue applications and reexamination or supplemental examination proceedings, and any amendments for applications (including reissue applications) and reexamination proceedings to the specification, except as provided for in §§1.821 through 1.825, must have:

(i) Lines that are 1½ or double spaced;

(ii) Text written in a nonscript type font (*e.g.*, Arial, Times Roman, or Courier, preferably a font size of 12) lettering style having capital letters which should be at least 0.3175 cm. (0.125 inch) high, but may be no smaller than 0.21 cm. (0.08 inch) high (*e.g.*, a font size of 6); and

(iii) Only a single column of text.

(3) The claim or claims must commence on a separate physical sheet or electronic page (§1.75(h)).

(4) The abstract must commence on a separate physical sheet or electronic page or be submitted as the first page of the patent in a reissue application or reexamination or supplemental examination proceeding (§1.72(b)).

(5) Other than in a reissue application or a reexamination or supplemental examination proceeding, the pages of the specification including claims and abstract must be numbered consecutively, starting with 1, the numbers being centrally located above or preferably, below, the text.

(6) Other than in a reissue application or reexamination or supplemental examination proceeding, the paragraphs of the specification, other than in the claims or abstract, may be numbered at the time the application is filed, and should be individually and consecutively numbered using Arabic numerals, so as to unambiguously identify each paragraph. The number should consist of at least four numerals enclosed in square brackets, including leading zeros (*e.g.*, [0001]). The numbers and enclosing brackets should appear to the right of the left margin as the first item in each paragraph, before the first word of the paragraph, and should be highlighted in bold. A gap, equivalent to approximately four spaces, should follow the number. Nontext elements (*e.g.*, tables, mathematical or chemical formulae, chemical structures, and sequence data) are considered part of the numbered paragraph around or above the elements, and should not be independently numbered. If a nontext element extends to the left margin, it should not be numbered as a separate and independent paragraph. A list is also treated as part of the paragraph around or above the list, and should not be independently numbered. Paragraph or section headers (titles), whether abutting the left margin or centered on the page, are not considered paragraphs and should not be numbered.

(c) Interlineation, erasure, cancellation, or other alteration of the application papers may be made before or after the signing of the inventor's oath or declaration referring to those application papers, provided that the statements in the inventor's oath or declaration pursuant to §1.63 remain applicable to those application papers. A substitute specification (§1.125) may be required if the application papers do not comply with paragraphs (a) and (b) of this section.

(d) A nonprovisional or provisional application under 35 U.S.C. 111 may be in a language other than English.

(1) *Nonprovisional application.* If a nonprovisional application under 35 U.S.C. 111(a) is filed in a language other than English, an English language translation of the non-English language application, a statement that the translation is accurate, and the processing fee set forth in §1.17(i) are required. If these items are not filed with the application, the applicant will be notified and given a period of time within which they must be filed in order to avoid abandonment.

(2) *Provisional application.* If a provisional application under 35 U.S.C. 111(b) is filed in a language other than

English, an English language translation of the non-English language provisional application will not be required in the provisional application. *See* §1.78(a) for the requirements for claiming the benefit of such provisional application in a nonprovisional application.

(e) *Electronic documents submitted on a read-only optical disc that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application, reexamination, or supplemental examination proceeding.* (1) The following documents may be submitted to the Office on a read-only optical disc in compliance with this paragraph (e):

(i) A ''Computer Program Listing Appendix'' (*see* §1.96(c));

(ii) A ''Sequence Listing'' (submitted under §1.821(c) in compliance with §§1.822 through 1.824) or a ''Sequence Listing XML'' (submitted under §1.831(a) in compliance with §§1.832 through 1.834); or

(iii) ''Large Tables'' (*see* §1.58(c)).

(2) Read-only optical disc as used in this part means a finalized disc, in conformance with International Organization for Standardization (ISO) 9660, on which the data is recorded so it is permanent and cannot be changed or erased, and is one of:

(i) Compact Disc-Read-Only Memory (CD–ROM) or a Compact Disc-Recordable (CD–R); or

(ii) Digital Video Disc-Recordable (DVD–R or DVD+R);

(3) Each read-only optical disc must conform to the following requirements:

(i) Computer compatibility: PC or Mac®;

(ii) Operating system compatibility: MS–DOS®, MS-Windows®, MacOS®, or Unix®/Linux®;

(iii) The contents of each read-only optical disc must be in American Standard Code for Information Interchange (ASCII) plain text and if compressed, must be compressed in accordance with §1.58 for ''Large Tables,'' with §1.96 for a ''Computer Program Listing Appendix,'' or §1.824 for a ''Sequence Listing'' or Computer Readable Form (CRF) of the ''Sequence Listing,'' as applicable; and

(iv) The contents of each read-only optical disc for a ''Sequence Listing XML'' must be in eXtensible Markup Language (XML) file format, and if compressed, must be compressed in accordance with §1.834.

(4) Each read-only optical disc must be enclosed in a hard case within an unsealed, padded, and protective mailing envelope, and must be accompanied by a transmittal letter in accordance with paragraph (a) of this section, including the following information:

(i) First-named inventor (if known);

(ii) Title of the invention;

(iii) Attorney docket or file reference number (if applicable);

(iv) Application number and filing date (if known);

(v) The operating system (MS–DOS®, MS-Windows®, Mac OS®, or Unix®/Linux®) used to produce the disc; and

(vi) The file(s) contained on the read-only optical disc, including the name of the file, the size of the file in bytes, and the date of creation.

(5) Each read-only optical disc must have a label permanently affixed thereto on which the following information has been hand-printed or typed:

(i) First-named inventor (if known);

(ii) Title of the invention;

(iii) Attorney docket or file reference number (if applicable);

(iv) Application number and filing date (if known);

(v) Date on which the data were recorded on the read-only optical disc; and

(vi) Disc order (*e.g.*, ''1 of X''), if multiple read-only optical discs are submitted.

(6) Read-only optical discs will not be returned to the applicant and may not be retained as part of the patent application file.

(7) Any amendment to the information on a read-only optical disc must be by way of a replacement read-only optical disc, in compliance with §1.58(g) for ''Large Tables,'' §1.96(c)(5) for a ''Computer Program Listing Appendix,'' §1.825(b) for a ''Sequence Listing'' or CRF of a ''Sequence Listing,'' and §1.835(b) for a ''Sequence Listing XML.''

(8) The specification must contain an incorporation by reference of the material on each read-only optical disc in a separate paragraph (§1.77(b)(5)), identifying the name of each file, their date

of creation, and their size in bytes, except for an international application in the international stage. The Office may require the applicant to amend the specification to include the material incorporated by reference.

(9) If a file is unreadable, it will be treated as not having been submitted, and a notice will be issued to require a compliant submission.

(f) *Determining application size fees for applications containing electronic documents submitted on a read-only optical disc or via the USPTO patent electronic filing system*—(1) *Submission on read-only optical discs.* The application size fee required by §1.16(s) or §1.492(j), for an application component submitted in part on a read-only optical disc in compliance with paragraph (e) of this section, shall be determined such that each three kilobytes of content submitted on a read-only optical disc shall be counted as a sheet of paper. Excluded from this determination is any ASCII plain text file or any XML file (as applicable) submitted on a read-only optical disc under paragraph (e) of this section containing:

(i) Any ''Sequence Listing'' or CRF of a ''Sequence Listing'' in compliance with §1.821(c) or (e), or any ''Sequence Listing XML'' in compliance with §1.831(a); or

(ii) Any ''Computer Program Listing Appendix'' in compliance with §1.96(c).

(2) *Submission via the USPTO patent electronic filing system.* The application size fee required by §1.16(s) or §1.492(j), for an application submitted in whole or in part via the USPTO patent electronic filing system, shall be determined such that the paper size equivalent will be considered to be 75% of the number of sheets of paper present in the specification and drawings for the application when entered into the Office records after being rendered by the USPTO patent electronic filing system. Excluded from this determination is any ASCII plain text file or any XML file (as applicable) submitted via the USPTO patent electronic filing system containing:

(i) Any ''Sequence Listing'' or CRF of a ''Sequence Listing'' in compliance with §1.821(c)(1) or (e), or any ''Sequence Listing XML'' in compliance with §1.831(a); or

(ii) Any ''Computer Program Listing Appendix'' in compliance with §1.96(c).

(3) *Oversized submission.* Any submission of a ''Sequence Listing'' in electronic form or a ''Sequence Listing XML'' of 300 MB–800 MB filed in an application under 35 U.S.C. 111 or 371 will be subject to the fee set forth in §1.21(o)(1). Any submission of a ''Sequence Listing'' in electronic form or a ''Sequence Listing XML'' that exceeds 800 MB filed in an application under 35 U.S.C. 111 or 371 will be subject to the fee set forth in §1.21(o)(2).

(Pub. L. 94–131, 89 Stat. 685; 35 U.S.C. 6, Pub. L. 97–247; 15 U.S.C. 1113, 1123)

[43 FR 20462, May 11, 1978]

EDITORIAL NOTE: For FEDERAL REGISTER citations affecting §1.52, see the List of CFR Sections Affected, which appears in the Finding Aids section of the printed volume and at *www.govinfo.gov*.

§ 1.53 Application number, filing date, and completion of application.

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

(b) *Application filing requirements—Nonprovisional application.* The filing date of an application for patent filed under this section, other than an application for a design patent or a provisional application under paragraph (c) of this section, is the date on which a specification, with or without claims, is received in the Office. The filing date of an application for a design patent filed under this section, except for a continued prosecution application under paragraph (d) of this section, is the date on which the specification as prescribed by 35 U.S.C. 112, including at least one claim, and any required drawings are received in the Office. No new matter may be introduced into an application after its filing date. A continuing application, which may be a continuation, divisional, or continuation-in-part application, may be filed under the conditions specified in 35 U.S.C. 120, 121, 365(c), or 386(c) and §1.78.

(1) A continuation or divisional application that names as inventors the same or fewer than all of the inventors

named in the prior application may be filed under this paragraph or paragraph (d) of this section.

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

(c) *Application filing requirements—Provisional application.* The filing date of a provisional application is the date on which a specification, with or without claims, is received in the Office. No amendment, other than to make the provisional application comply with the patent statute and all applicable regulations, may be made to the provisional application after the filing date of the provisional application.

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

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

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

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

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

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

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

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

(4) A provisional application is not entitled to the right of priority under 35 U.S.C. 119, 365(a), or 386(a) or §1.55,

or to the benefit of an earlier filing date under 35 U.S.C. 120, 121, 365(c), or 386(c) or §1.78 of any other application. No claim for priority under 35 U.S.C. 119(e) or §1.78(a) may be made in a design application based on a provisional application. A provisional application disclosing nucleotide and/or amino acid sequences is not required to include a separate sequence listing; however, if submitted in a provisional application filed on or after July 1, 2022, any submission of nucleotide and/or amino acid sequence data must be by way of a ''Sequence Listing XML'' in compliance with §§1.831 through 1.834.

(d) *Application filing requirements—Continued prosecution (nonprovisional) application.* (1) A continuation or divisional application (but not a continuation-in-part) of a prior nonprovisional application may be filed as a continued prosecution application under this paragraph, provided that:

(i) The application is for a design patent;

(ii) The prior nonprovisional application is a design application, but not an international design application, that is complete as defined by §1.51(b), except for the inventor's oath or declaration if the application is filed on or after September 16, 2012, and the prior nonprovisional application contains an application data sheet meeting the conditions specified in §1.53(f)(3)(i); and

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

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

(B) Abandonment of the prior application; or

(C) Termination of proceedings on the prior application.

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

(i) Must identify the prior application;

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

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

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

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

(3) The filing fee, search fee, and examination fee for a continued prosecution application filed under this paragraph are the basic filing fee as set forth in §1.16(b), the search fee as set forth in §1.16(l), and the examination fee as set forth in §1.16(p).

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

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

(6) The filing of a continued prosecution application under this paragraph will be construed to include a waiver of

confidentiality by the applicant under 35 U.S.C. 122 to the extent that any member of the public, who is entitled under the provisions of §1.14 to access to, copies of, or information concerning either the prior application or any continuing application filed under the provisions of this paragraph, may be given similar access to, copies of, or similar information concerning the other application or applications in the file jacket.

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

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

(i) Title of invention;

(ii) Name of applicant(s); and

(iii) Correspondence address.

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

(e) *Failure to meet filing date requirements.* (1) If an application deposited under paragraph (b), (c), or (d) of this section does not meet the requirements of such paragraph to be entitled to a filing date, applicant will be so notified, if a correspondence address has been provided, and given a period of time within which to correct the filing error. If, however, a request for an application under paragraph (d) of this section does not meet the requirements of that paragraph because the application in which the request was filed is not a design application, and if the application in which the request was filed was itself filed on or after June 8, 1995, the request for an application under paragraph (d) of this section will be treated as a request for continued examination under §1.114.

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

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

(f) *Completion of application subsequent to filing—Nonprovisional (including continued prosecution or reissue) application.* (1) If an application which has been accorded a filing date pursuant to paragraph (b) or (d) of this section does not include the basic filing fee, search fee, or examination fee, or if an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include at least one claim or the inventor's oath or declaration (§§1.63, 1.64, 1.162, or 1.175), and the applicant has provided a correspondence address (§1.33(a)), the applicant will be notified and given a period of time within which to file a claim or claims, pay the basic filing fee, search fee, and examination fee, and pay the surcharge if required by §1.16(f), to avoid abandonment.

(2) If an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include the basic filing fee, search fee, examination fee, at least one claim, or the inventor's oath or declaration, and the applicant has not provided a correspondence address (§1.33(a)), the applicant has three months from the filing date of the application within which to file a claim or claims, pay the basic filing fee, search fee, and examination fee, and pay the surcharge required by §1.16(f), to avoid abandonment.

(3) The inventor's oath or declaration in an application under §1.53(b) must also be filed within the period specified in paragraph (f)(1) or (f)(2) of this section, except that the filing of the inventor's oath or declaration may be postponed until the application is otherwise in condition for allowance under the conditions specified in paragraphs (f)(3)(i) and (f)(3)(ii) of this section.

(i) The application must be an original (non-reissue) application that contains an application data sheet in accordance with §1.76 identifying:

(A) Each inventor by his or her legal name;

(B) A mailing address where the inventor customarily receives mail, and residence, if an inventor lives at a location which is different from where the inventor customarily receives mail, for each inventor.

(ii) The applicant must file each required oath or declaration in compliance with §1.63, or substitute statement in compliance with §1.64, no later than the date on which the issue fee for the patent is paid. If the applicant is notified in a notice of allowability that an oath or declaration in compliance with §1.63, or substitute statement in compliance with §1.64, executed by or with respect to each named inventor has not been filed, the applicant must file each required oath or declaration in compliance with §1.63, or substitute statement in compliance with §1.64, no later than the date on which the issue fee is paid to avoid abandonment. This time period is not extendable under §1.136 (*see* §1.136(c)). The Office may dispense with the notice provided for in paragraph (f)(1) of this section if each required oath or declaration in compliance with §1.63, or substitute statement in compliance with §1.64, has been filed before the application is in condition for allowance.

(4) If the excess claims fees required by §1.16(h) and (i) and multiple dependent claim fee required by §1.16(j) are not paid on filing or on later presentation of the claims for which the excess claims or multiple dependent claim fees are due, the fees required by §1.16(h), (i), and (j) must be paid or the claims canceled by amendment prior to the expiration of the time period set for reply by the Office in any notice of fee deficiency. If the application size fee required by §1.16(s) (if any) is not paid on filing or on later presentation of the amendment necessitating a fee or additional fee under §1.16(s), the fee required by §1.16(s) must be paid prior to the expiration of the time period set for reply by the Office in any notice of fee deficiency in order to avoid abandonment.

(5) This paragraph applies to continuation or divisional applications under paragraphs (b) or (d) of this section and to continuation-in-part applications under paragraph (b) of this section. See §1.63(d) concerning the submission of a copy of the inventor's oath or declaration from the prior application for a continuing application under paragraph (b) of this section.

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

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

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

(3) If the application size fee required by §1.16(s) (if any) is not paid on filing, the fee required by §1.16(s) must be paid prior to the expiration of the time period set for reply by the Office in any notice of fee deficiency in order to avoid abandonment.

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

(h) *Subsequent treatment of application—Nonprovisional (including continued prosecution) application.* An application for a patent filed under paragraphs (b) or (d) of this section will not be placed on the files for examination until all its required parts, complying with the rules relating thereto, are received, except that the inventor's oath or declaration may be filed when the application is otherwise in condition for allowance pursuant to paragraph (f)(3) of this section and minor informalities may be waived subject to subsequent correction whenever required.

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

[62 FR 53186, Oct. 10, 1997, as amended at 63 FR 5734, Feb. 4, 1998; 65 FR 14871, Mar. 20, 2000; 65 FR 50104, Aug. 16, 2000; 65 FR 54665, Sept. 8, 2000; 65 FR 78960, Dec. 18, 2000; 68 FR 14336, Mar. 25, 2003; 68 FR 32380, May 30, 2003; 69 FR 29878, May 26, 2004; 69 FR 56539, Sept. 21, 2004; 70 FR 3890, Jan. 27, 2005; 70 FR 30365, May 26, 2005; 72 FR 46836, Aug. 21, 2007; 74 FR 52688, Oct. 14, 2009; 77 FR 48817, Aug. 14, 2012; 78 FR 11053, Feb. 14, 2013; 78 FR 62398, Oct. 21, 2013; 79 FR 12386, Mar. 5, 2014; 80 FR 17956, Apr. 2, 2015; 87 FR 30817, May 20, 2022]

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

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

(b) Applicant will be informed of the application number and filing date by a filing receipt, unless the application is an application filed under § 1.53(d). A letter limited to a request for a filing receipt may be signed by a juristic applicant or patent owner.

[62 FR 53188, Oct. 10, 1997, as amended at 78 FR 62399, Oct. 21, 2013]

§ 1.55 Claim for foreign priority.

(a) *In general.* An applicant in a nonprovisional application may claim priority to one or more prior foreign applications under the conditions specified in 35 U.S.C. 119(a) through (d) and (f), 172, 365(a) and (b), and 386(a) and (b) and this section.

(b) *Time for filing subsequent application.* The nonprovisional application must be:

(1) Filed not later than twelve months (six months in the case of a design application) after the date on which the foreign application was filed, subject to paragraph (c) of this section (a subsequent application); or

(2) Entitled to claim the benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) of a subsequent application that was filed within the period set forth in paragraph (b)(1) of this section.

(c) *Delayed filing of subsequent application.* If the subsequent application has a filing date which is after the expiration of the period set forth in paragraph (b)(1) of this section, but within two months from the expiration of the period set forth in paragraph (b)(1) of this section, the right of priority in the subsequent application may be restored under PCT Rule 26*bis*.3 for an international application, or upon petition pursuant to this paragraph, if the delay in filing the subsequent application within the period set forth in paragraph (b)(1) of this section was unintentional. A petition to restore the right of priority under this paragraph filed on or after May 13, 2015, must be filed in the subsequent application, or in the earliest nonprovisional application claiming benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) to the subsequent application, if such subsequent application is not a nonprovisional application. Any petition to restore the right of priority under this paragraph must include:

(1) The priority claim under 35 U.S.C. 119(a) through (d) or (f), 365(a) or (b), or 386(a) or (b) in an application data sheet (§ 1.76(b)(6)), identifying the foreign application to which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, unless previously submitted;

(2) The petition fee as set forth in §1.17(m); and

(3) A statement that the delay in filing the subsequent application within the period set forth in paragraph (b)(1) of this section was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(d) *Time for filing priority claim*—(1) *Application under 35 U.S.C. 111(a).* The claim for priority must be filed within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application in an original application filed under 35 U.S.C. 111(a), except as provided in paragraph (e) of this section. The claim for priority must be presented in an application data sheet (§1.76(b)(6)) and must identify the foreign application to which priority is claimed by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. The time periods in this paragraph do not apply if the later-filed application is:

(i) An application for a design patent; or

(ii) An application filed under 35 U.S.C. 111(a) before November 29, 2000.

(2) *Application under 35 U.S.C. 371.* The claim for priority must be made within the time limit set forth in the PCT and the Regulations under the PCT in an international application entering the national stage under 35 U.S.C. 371, except as provided in paragraph (e) of this section.

(e) *Delayed priority claim.* Unless such claim is accepted in accordance with the provisions of this paragraph, any claim for priority under 35 U.S.C. 119(a) through (d) or (f), 365(a) or (b), or 386(a) or 386(b) not presented in the manner required by paragraph (d) or (m) of this section during pendency and within the time period provided by paragraph (d) of this section (if applicable) is considered to have been waived. If a claim for priority is considered to have been waived under this section, the claim may be accepted if the priority claim was unintentionally delayed. A petition to accept a delayed claim for priority under 35 U.S.C. 119(a) through (d) or (f), 365(a) or (b), or 386(a) or 386(b) must be accompanied by:

(1) The priority claim under 35 U.S.C. 119(a) through (d) or (f), 365(a) or (b), or 386(a) or 386(b) in an application data sheet (§1.76(b)(6)), identifying the foreign application to which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, unless previously submitted;

(2) A certified copy of the foreign application, unless previously submitted or an exception in paragraph (h), (i), or (j) of this section applies;

(3) The petition fee as set forth in §1.17(m); and

(4) A statement that the entire delay between the date the priority claim was due under this section and the date the priority claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(f) *Time for filing certified copy of foreign application*—(1) *Application under 35 U.S.C. 111(a).* A certified copy of the foreign application must be filed within the later of four months from the actual filing date of the application, or sixteen months from the filing date of the prior foreign application, in an original application under 35 U.S.C. 111(a) filed on or after March 16, 2013, except as provided in paragraphs (h), (i), and (j) of this section. The time period in this paragraph does not apply in a design application.

(2) *Application under 35 U.S.C. 371.* A certified copy of the foreign application must be filed within the time limit set forth in the PCT and the Regulations under the PCT in an international application entering the national stage under 35 U.S.C. 371. If a certified copy of the foreign application is not filed during the international stage in an international application in which the national stage commenced on or after December 18, 2013, a certified copy of the foreign application must be filed within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) (§1.491(a)), four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or sixteen months from the filing date of the prior foreign

application, except as provided in paragraphs (h), (i), and (j) of this section.

(3) If a certified copy of the foreign application is not filed within the time period specified paragraph (f)(1) of this section in an application under 35 U.S.C. 111(a) or within the period specified in paragraph (f)(2) of this section in an international application entering the national stage under 35 U.S.C. 371, and an exception in paragraph (h), (i), or (j) of this section is not applicable, the certified copy of the foreign application must be accompanied by a petition including a showing of good and sufficient cause for the delay and the petition fee set forth in §1.17(g).

(g) *Requirement for filing priority claim, certified copy of foreign application, and translation in any application.* (1) The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed within the pendency of the application, unless filed with a petition under paragraph (e) or (f) of this section, or with a petition accompanied by the fee set forth in §1.17(g) which includes a showing of good and sufficient cause for the delay in filing the certified copy of the foreign application in a design application. If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and §1.323.

(2) The Office may require that the claim for priority and the certified copy of the foreign application be filed earlier than otherwise provided in this section:

(i) When the application is involved in an interference (see §41.202 of this chapter) or derivation (see part 42 of this chapter) proceeding;

(ii) When necessary to overcome the date of a reference relied upon by the examiner; or

(iii) When deemed necessary by the examiner.

(3) An English language translation of a non-English language foreign application is not required except:

(i) When the application is involved in an interference (see §41.202 of this chapter) or derivation (see part 42 of this chapter) proceeding;

(ii) When necessary to overcome the date of a reference relied upon by the examiner; or

(iii) When specifically required by the examiner.

(4) If an English language translation of a non-English language foreign application is required, it must be filed together with a statement that the translation of the certified copy is accurate.

(h) *Certified copy in another U.S. patent or application.* The requirement in paragraphs (f) and (g) of this section for a certified copy of the foreign application will be considered satisfied in a reissue application if the patent for which reissue is sought satisfies the requirement of this section for a certified copy of the foreign application and such patent is identified as containing a certified copy of the foreign application. The requirement in paragraphs (f) and (g) of this section for a certified copy of the foreign application will also be considered satisfied in an application if a prior-filed nonprovisional application for which a benefit is claimed under 35 U.S.C. 120, 121, 365(c), or 386(c) contains a certified copy of the foreign application and such prior-filed nonprovisional application is identified as containing a certified copy of the foreign application.

(i) *Foreign intellectual property office participating in a priority document exchange agreement.* The requirement in paragraphs (f) and (g) of this section for a certified copy of the foreign application to be filed within the time limit set forth therein will be considered satisfied if:

(1) The foreign application was filed in a foreign intellectual property office participating with the Office in a bilateral or multilateral priority document exchange agreement (participating foreign intellectual property office), or a copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office that permits the Office to obtain such a copy;

(2) The claim for priority is presented in an application data sheet (§1.76(b)(6)), identifying the foreign application for which priority is claimed,

by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, and the applicant provides the information necessary for the participating foreign intellectual property office to provide the Office with access to the foreign application;

(3) The copy of the foreign application is received by the Office from the participating foreign intellectual property office, or a certified copy of the foreign application is filed, within the period specified in paragraph (g)(1) of this section; and

(4) The applicant files in a separate document a request that the Office obtain a copy of the foreign application from a participating intellectual property office that permits the Office to obtain such a copy where, although the foreign application was not filed in a participating foreign intellectual property office, a copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office that permits the Office to obtain such a copy. The request must identify the participating intellectual property office and the subsequent application by the application number, day, month, and year of its filing in which a copy of the foreign application was filed. The request must be filed within the later of sixteen months from the filing date of the prior foreign application, four months from the actual filing date of an application under 35 U.S.C. 111(a), four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) (§1.491(a)), or four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or the request must be accompanied by a petition under paragraph (e) or (f) of this section.

(j) *Interim copy*. The requirement in paragraph (f) of this section for a certified copy of the foreign application to be filed within the time limit set forth therein will be considered satisfied if:

(1) A copy of the original foreign application clearly labeled as ''Interim Copy,'' including the specification, and any drawings or claims upon which it is based, is filed in the Office together with a separate cover sheet identifying the foreign application by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, and stating that the copy filed in the Office is a true copy of the original application as filed in the foreign country (or intellectual property authority);

(2) The copy of the foreign application and separate cover sheet are filed within the later of sixteen months from the filing date of the prior foreign application, four months from the actual filing date of an application under 35 U.S.C. 111(a), four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) (§1.491(a)), four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or with a petition under paragraph (e) or (f) of this section; and

(3) A certified copy of the foreign application is filed within the period specified in paragraph (g)(1) of this section.

(k) *Requirements for certain applications filed on or after March 16, 2013.* If a nonprovisional application filed on or after March 16, 2013, other than a nonprovisional international design application, claims priority to a foreign application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date as defined in §1.109 that is on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the nonprovisional application, four months from the date of entry into the national stage as set forth in §1.491 in an international application, sixteen months from the filing date of the prior foreign application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the nonprovisional application. An applicant is not required to provide such a statement if the applicant reasonably believes on the basis of information already known to the individuals designated in §1.56(c) that the nonprovisional application does not, and did not at any time, contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

(l) *Inventor's certificates.* An applicant in a nonprovisional application may under certain circumstances claim priority on the basis of one or more applications for an inventor's certificate in a country granting both inventor's certificates and patents. To claim the right of priority on the basis of an application for an inventor's certificate in such a country under 35 U.S.C. 119(d), the applicant, when submitting a claim for such right as specified in this section, must include an affidavit or declaration. The affidavit or declaration must include a specific statement that, upon an investigation, he or she is satisfied that to the best of his or her knowledge, the applicant, when filing the application for the inventor's certificate, had the option to file an application for either a patent or an inventor's certificate as to the subject matter of the identified claim or claims forming the basis for the claim of priority.

(m) *Time for filing priority claim and certified copy of foreign application in an international design application designating the United States.* In an international design application designating the United States, the claim for priority may be made in accordance with the Hague Agreement and the Hague Agreement Regulations. In a nonprovisional international design application, the priority claim, unless made in accordance with the Hague Agreement and the Hague Agreement Regulations, must be presented in an application data sheet (§1.76(b)(6)), identifying the foreign application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. In a nonprovisional international design application, the priority claim and certified copy must be furnished in accordance with the time period and other conditions set forth in paragraph (g) of this section.

(n) *Applications filed before September 16, 2012.* Notwithstanding the requirement in paragraphs (d)(1), (e)(1), and (i)(2) of this section that any priority claim be presented in an application data sheet (§1.76), this requirement in paragraphs (d)(1), (e)(1), and (i)(2) of this section will be satisfied by the presentation of such priority claim in the oath or declaration under §1.63 in a nonprovisional application filed under 35 U.S.C. 111(a) before September 16, 2012, or resulting from an international application filed under 35 U.S.C. 363 before September 16, 2012. The provisions of this paragraph do not apply to any priority claim submitted for a petition under paragraph (c) of this section to restore the right of priority to a foreign application.

(o) *Priority under 35 U.S.C. 386(a) or (b).* The right of priority under 35 U.S.C. 386(a) or (b) with respect to an international design application is applicable only to nonprovisional applications, international applications, and international design applications filed on or after May 13, 2015, and patents issuing thereon.

(p) *Time periods in this section.* The time periods set forth in this section are not extendable, but are subject to 35 U.S.C. 21(b) (and §1.7(a)), PCT Rule 80.5, and Hague Agreement Rule 4(4).

[80 FR 17956, Apr. 2, 2015]

§ 1.56 Duty to disclose information material to patentability.

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty

to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§1.97(b)–(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

(1) Prior art cited in search reports of a foreign patent office in a counterpart application, and

(2) The closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

(1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the applicant takes in:

(i) Opposing an argument of unpatentability relied on by the Office, or

(ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

(c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

(1) Each inventor named in the application;

(2) Each attorney or agent who prepares or prosecutes the application; and

(3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, the applicant, an assignee, or anyone to whom there is an obligation to assign the application.

(d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent, or inventor.

(e) In any continuation-in-part application, the duty under this section includes the duty to disclose to the Office all information known to the person to be material to patentability, as defined in paragraph (b) of this section, which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

[57 FR 2034, Jan. 17, 1992, as amended at 65 FR 54666, Sept. 8, 2000; 77 FR 48818, Aug. 14, 2012]

§ 1.57 Incorporation by reference.

(a) Subject to the conditions and requirements of this paragraph, a reference made in the English language in an application data sheet in accordance with §1.76 upon the filing of an application under 35 U.S.C. 111(a) to a previously filed application, indicating that the specification and any drawings of the application under 35 U.S.C. 111(a) are replaced by the reference to the previously filed application, and specifying the previously filed application by application number, filing date, and the intellectual property authority or country in which the previously filed application was filed, shall constitute the specification and any drawings of the application under 35 U.S.C. 111(a) for purposes of a filing date under §1.53(b).

(1) If the applicant has provided a correspondence address (§1.33(a)), the applicant will be notified and given a period of time within which to file a copy of the specification and drawings from the previously filed application, an English language translation of the previously filed application, and the

fee required by §1.17(i) if it is in a language other than English, and pay the surcharge required by §1.16(f), to avoid abandonment. Such a notice may be combined with a notice under §1.53(f).

(2) If the applicant has not provided a correspondence address (§1.33(a)), the applicant has three months from the filing date of the application to file a copy of the specification and drawings from the previously filed application, an English language translation of the previously filed application, and the fee required by §1.17(i) if it is in a language other than English, and pay the surcharge required by §1.16(f), to avoid abandonment.

(3) An application abandoned under paragraph (a)(1) or (a)(2) of this section shall be treated as having never been filed, unless:

(i) The application is revived under §1.137; and

(ii) A copy of the specification and any drawings of the previously filed application are filed in the Office.

(4) A certified copy of the previously filed application must be filed in the Office, unless the previously filed application is an application filed under 35 U.S.C. 111 or 363, or the previously filed application is a foreign priority application and the conditions set forth in §1.55(i) are satisfied with respect to such foreign priority application. The certified copy of the previously filed application, if required by this paragraph, must be filed within the later of four months from the filing date of the application or sixteen months from the filing date of the previously filed application, or be accompanied by a petition including a showing of good and sufficient cause for the delay and the petition fee set forth in §1.17(g).

(b) Subject to the conditions and requirements of this paragraph, if all or a portion of the specification or drawing(s) is inadvertently omitted from an application, but the application contains a claim under §1.55 for priority of a prior-filed foreign application or a claim under §1.78 for the benefit of a prior-filed provisional, nonprovisional, international application, or international design application, that was present on the filing date of the application, and the inadvertently omitted portion of the specification or drawing(s) is completely contained in the prior-filed application, the claim under §1.55 or 1.78 shall also be considered an incorporation by reference of the prior-filed application as to the inadvertently omitted portion of the specification or drawing(s).

(1) The application must be amended to include the inadvertently omitted portion of the specification or drawing(s) within any time period set by the Office, but in no case later than the close of prosecution as defined by §1.114(b), or abandonment of the application, whichever occurs earlier. The applicant is also required to:

(i) Supply a copy of the prior-filed application, except where the prior-filed application is an application filed under 35 U.S.C. 111;

(ii) Supply an English language translation of any prior-filed application that is in a language other than English; and

(iii) Identify where the inadvertently omitted portion of the specification or drawings can be found in the prior-filed application.

(2) Any amendment to an international application pursuant to paragraph (b)(1) of this section shall be effective only as to the United States, and shall have no effect on the international filing date of the application. In addition, no request under this section to add the inadvertently omitted portion of the specification or drawings in an international application designating the United States will be acted upon by the Office prior to the entry and commencement of the national stage (§1.491) or the filing of an application under 35 U.S.C. 111(a) which claims benefit of the international application. Any omitted portion of the international application which applicant desires to be effective as to all designated States, subject to PCT Rule 20.8(b), must be submitted in accordance with PCT Rule 20.

(3) If an application is not otherwise entitled to a filing date under §1.53(b), the amendment must be by way of a petition pursuant to §1.53(e) accompanied by the fee set forth in §1.17(f).

(4) Any amendment to an international design application pursuant to paragraph (b)(1) of this section shall be

effective only as to the United States and shall have no effect on the filing date of the application. In addition, no request under this section to add the inadvertently omitted portion of the specification or drawings in an international design application will be acted upon by the Office prior to the international design application becoming a nonprovisional application.

(c) Except as provided in paragraph (a) or (b) of this section, an incorporation by reference must be set forth in the specification and must:

(1) Express a clear intent to incorporate by reference by using the root words ''incorporat(e)'' and ''reference'' (*e.g.*, ''incorporate by reference''); and

(2) Clearly identify the referenced patent, application, or publication.

(d) ''Essential material'' may be incorporated by reference, but only by way of an incorporation by reference to a U.S. patent or U.S. patent application publication, which patent or patent application publication does not itself incorporate such essential material by reference. ''Essential material'' is material that is necessary to:

(1) Provide a written description of the claimed invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and set forth the best mode contemplated by the inventor of carrying out the invention as required by 35 U.S.C. 112(a);

(2) Describe the claimed invention in terms that particularly point out and distinctly claim the invention as required by 35 U.S.C. 112(b); or

(3) Describe the structure, material, or acts that correspond to a claimed means or step for performing a specified function as required by 35 U.S.C. 112(f).

(e) Other material (''Nonessential material'') may be incorporated by reference to U.S. patents, U.S. patent application publications, foreign patents, foreign published applications, prior and concurrently filed commonly owned U.S. applications, or non-patent publications. An incorporation by reference by hyperlink or other form of browser executable code is not permitted.

(f) The examiner may require the applicant to supply a copy of the material incorporated by reference. If the Office requires the applicant to supply a copy of material incorporated by reference, the material must be accompanied by a statement that the copy supplied consists of the same material incorporated by reference in the referencing application.

(g) Any insertion of material incorporated by reference into the specification or drawings of an application must be by way of an amendment to the specification or drawings. Such an amendment must be accompanied by a statement that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter.

(h) An incorporation of material by reference that does not comply with paragraphs (c), (d), or (e) of this section is not effective to incorporate such material unless corrected within any time period set by the Office, but in no case later than the close of prosecution as defined by § 1.114(b), or abandonment of the application, whichever occurs earlier. In addition:

(1) A correction to comply with paragraph (c)(1) of this section is permitted only if the application as filed clearly conveys an intent to incorporate the material by reference. A mere reference to material does not convey an intent to incorporate the material by reference.

(2) A correction to comply with paragraph (c)(2) of this section is only permitted for material that was sufficiently described to uniquely identify the document.

(i) An application transmittal letter limited to the transmittal of a copy of the specification and drawings from a previously filed application submitted under paragraph (a) or (b) of this section may be signed by a juristic applicant or patent owner.

[78 FR 62401, Oct. 21, 2013, as amended at 80 FR 17959, Apr. 2, 2015]

§ 1.58 Chemical and mathematical formulae and tables.

(a) The specification, including the claims, may contain chemical and

mathematical formulae, but shall not contain drawings or flow diagrams. The description portion of the specification may contain tables, but the same tables should not be included in both the drawings and description portion of the specification. Claims may contain tables either if necessary to conform to 35 U.S.C. 112 or if otherwise found to be desirable.

(b) Chemical and mathematical formulas and tables must be presented in compliance with §1.52(a) and (b), except that chemical and mathematical formulas or tables may be placed in a landscape orientation if they cannot be presented satisfactorily in a portrait orientation. Typewritten characters used in such formulas and tables must be chosen from a block (nonscript) type font or lettering style having capital letters that should be at least 0.422 cm (0.166 inches) high (e.g.,≤ preferably Arial, Times Roman, or Courier, with a font size of 12 points), but may be no smaller than 0.21cm (0.08 inches) high (e.g., a font size of 6 points). A space at least 0.64 cm (0.25 inches) high should be provided between complex formulas and tables and the text. Chemical and mathematical formulas must be configured to maintain the proper positioning of their characters when displayed in order to preserve their intended meaning. Tables should have the lines and columns of data closely spaced to conserve space, consistent with a high degree of legibility.

(c) The following ''Large Tables'' may be submitted in electronic form in ASCII plain text via the USPTO patent electronic filing system or on a read-only optical disc, in compliance with §1.52(e), excluding an international application during the international stage:

(1) Any individual table that is more than 50 pages in length; or

(2) Multiple tables, if the total number of pages of all the tables in an application exceeds 100 pages in length, where a table page is a page printed on paper, in conformance with paragraph (b) of this section.

(d) ''Large Tables'' submitted in electronic form in ASCII plain text must conform to the following requirements:

(1) Must maintain the spatial relationships (e.g., alignment of columns and rows) of the table elements when displayed to visually preserve the relational information they convey;

(2) Must have the following compatibilities:

(i) Computer compatibility: PC or Mac®;

(ii) Operating system compatibility: MS–DOS®, MS-Windows®, Mac OS®, or Unix®/Linux®.

(3) Must be in ASCII plain text, where:

(i) All printable characters (including the space character) are permitted;

(ii) No nonprintable (ASCII control) characters are permitted, except ASCII Carriage Return plus ASCII Line Feed (CRLF) or Line Feed (LF) as line terminators.

(4) Must be named as *.txt, where ''*'' is one character or a combination of characters limited to upper- or lowercase letters, numbers, hyphens, and underscores and does not exceed 60 characters in total, excluding the extension. No spaces or other types of characters are permitted in the file name; and

(5) Must be incorporated by reference in a separate paragraph of the specification, in accordance with §1.77(b)(5).

(e) ''Large Tables'' submitted via the USPTO patent electronic filing system must not exceed 25 MB, and file compression is not permitted.

(f) ''Large Tables'' submitted in compliance with §1.52(e) via read-only optical disc must meet the following requirements:

(1) The ASCII plain text file may be compressed using WinZip®, 7-Zip, or Unix®/Linux® Zip;

(2) A compressed file must not be self-extracting; and

(3) A compressed ASCII plain text file that does not fit on a single read-only optical disc may be split into multiple file parts in accordance with the target read-only optical disc size and labeled in compliance with §1.52(e)(5)(vi).

(g) Any amendments to ''Large Tables'' in electronic form in ASCII plain text format must include:

(1) A replacement ASCII plain text file, in accordance with the requirements of paragraphs (d) through (f) of this section, submitted via the USPTO patent electronic filing system or on a read-only optical disc, in compliance

with §1.52(e), labeled as ''REPLACEMENT MM/DD/YYYY'' (with the month, day, and year of creation indicated);

(2) A request that the amendment be made by incorporation by reference of the material in the replacement ASCII plain text file, in a separate paragraph of the specification (replacing any prior such paragraph, as applicable) identifying the name of the file, the date of creation, and the size of the file in bytes (*see* §1.77(b)(5));

(3) A statement that identifies the location of all deletions, replacements, or additions to the ASCII plain text file; and

(4) A statement that the replacement ASCII plain text file contains no new matter.

(h) The specification of an application with ''Large Tables'' as an ASCII plain text file, present on the application filing date, without an incorporation by reference of the material contained in the ASCII plain text file, must be amended to contain a separate paragraph incorporating by reference the material contained in the ASCII plain text file, in accordance with §1.77(b)(5).

(i) Any read-only optical disc for ''Large Tables'' must be submitted in duplicate. The read-only optical disc and duplicate copy must be labeled ''Copy 1'' and ''Copy 2,'' respectively. The transmittal letter that accompanies the read-only optical discs must include a statement that the two read-only optical discs are identical. In the event that the two read-only optical disc copies are not identical, the Office will use the read-only optical disc labeled ''Copy 1'' for further processing.

(j) Any amendment to the information on a read-only optical disc must be by way of a replacement read-only optical disc, in compliance with paragraph (g) of this section, where the replacement read-only optical disc and copy must be labeled ''COPY 1 REPLACEMENT MM/DD/YYYY'' (with the month, day, and year of creation indicated), and ''COPY 2 REPLACEMENT MM/DD/YYYY,'' respectively.

[69 FR 56540, Sept. 21, 2004, as amended at 78 FR 62401, Oct. 21, 2013; 86 FR 57046, Oct. 14, 2021]

§ 1.59 Expungement of information or copy of papers in application file.

(a) (1) Information in an application will not be expunged, except as provided in paragraph (b) of this section or §41.7(a) or §42.7(a) of this title.

(2) Information forming part of the original disclosure (*i.e.*, written specification including the claims, drawings, and any preliminary amendment present on the filing date of the application) will not be expunged from the application file.

(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in §1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

(c) Upon request by an applicant and payment of the fee specified in §1.19(b), the Office will furnish copies of an application, unless the application has been disposed of (*see* §§1.53(e), (f) and (g)). The Office cannot provide or certify copies of an application that has been disposed of.

[68 FR 38628, June 30, 2003, as amended at 69 FR 49999, Aug. 12, 2004; 69 FR 56540, Sept. 21, 2004; 77 FR 46624, Aug. 6, 2012; 77 FR 48818, Aug. 14, 2012]

§§ 1.60–1.62 [Reserved]

OATH OR DECLARATION

§ 1.63 Inventor's oath or declaration.

(a) The inventor, or each individual who is a joint inventor of a claimed invention, in an application for patent must execute an oath or declaration directed to the application, except as provided for in §1.64. An oath or declaration under this section must:

(1) Identify the inventor or joint inventor executing the oath or declaration by his or her legal name;

(2) Identify the application to which it is directed;

(3) Include a statement that the person executing the oath or declaration believes the named inventor or joint

inventor to be the original inventor or an original joint inventor of a claimed invention in the application for which the oath or declaration is being submitted; and

(4) State that the application was made or was authorized to be made by the person executing the oath or declaration.

(b) Unless the following information is supplied in an application data sheet in accordance with §1.76, the oath or declaration must also identify:

(1) Each inventor by his or her legal name; and

(2) A mailing address where the inventor customarily receives mail, and residence, if an inventor lives at a location which is different from where the inventor customarily receives mail, for each inventor.

(c) A person may not execute an oath or declaration for an application unless that person has reviewed and understands the contents of the application, including the claims, and is aware of the duty to disclose to the Office all information known to the person to be material to patentability as defined in §1.56. There is no minimum age for a person to be qualified to execute an oath or declaration, but the person must be competent to execute, *i.e.*, understand, the document that the person is executing.

(d)(1) A newly executed oath or declaration under §1.63, or substitute statement under §1.64, is not required under §§1.51(b)(2) and 1.53(f), or under §§1.497 and 1.1021(d), for an inventor in a continuing application that claims the benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) in compliance with §1.78 of an earlier-filed application, provided that an oath or declaration in compliance with this section, or substitute statement under §1.64, was executed by or with respect to such inventor and was filed in the earlier-filed application, and a copy of such oath, declaration, or substitute statement showing the signature or an indication thereon that it was executed, is submitted in the continuing application.

(2) The inventorship of a continuing application filed under 35 U.S.C. 111(a) is the inventor or joint inventors specified in the application data sheet filed before or concurrently with the copy of the inventor's oath or declaration from the earlier-filed application. If an application data sheet is not filed before or concurrently with the copy of the inventor's oath or declaration from the earlier-filed application, the inventorship is the inventorship set forth in the copy of the inventor's oath or declaration from the earlier-filed application, unless it is accompanied by a statement signed pursuant to §1.33(b) stating the name of each inventor in the continuing application.

(3) Any new joint inventor named in the continuing application must provide an oath or declaration in compliance with this section, except as provided for in §1.64.

(e)(1) An assignment may also serve as an oath or declaration required by this section if the assignment as executed:

(i) Includes the information and statements required under paragraphs (a) and (b) of this section; and

(ii) A copy of the assignment is recorded as provided for in part 3 of this chapter.

(2) Any reference to an oath or declaration under this section includes an assignment as provided for in this paragraph.

(f) With respect to an application naming only one inventor, any reference to the inventor's oath or declaration in this chapter includes a substitute statement executed under §1.64. With respect to an application naming more than one inventor, any reference to the inventor's oath or declaration in this chapter means the oaths, declarations, or substitute statements that have been collectively executed by or with respect to all of the joint inventors, unless otherwise clear from the context.

(g) An oath or declaration under this section, including the statement provided for in paragraph (e) of this section, must be executed (*i.e.*, signed) in accordance either with §1.66 or with an acknowledgment that any willful false statement made in such declaration or statement is punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.

(h) An oath or declaration filed at any time pursuant to 35 U.S.C. 115(h)(1) will be placed in the file record of the

application or patent, but may not necessarily be reviewed by the Office. Any request for correction of the named inventorship must comply with §1.48 in an application and §1.324 in a patent.

[77 FR 48818, Aug. 14, 2012, as amended at 80 FR 17959, Apr. 2, 2015]

§ 1.64 Substitute statement in lieu of an oath or declaration.

(a) An applicant under §1.43, 1.45 or 1.46 may execute a substitute statement in lieu of an oath or declaration under §1.63 if the inventor is deceased, is under a legal incapacity, has refused to execute the oath or declaration under §1.63, or cannot be found or reached after diligent effort.

(b) A substitute statement under this section must:

(1) Comply with the requirements of §1.63(a), identifying the inventor or joint inventor with respect to whom a substitute statement in lieu of an oath or declaration is executed, and stating upon information and belief the facts which such inventor is required to state;

(2) Identify the person executing the substitute statement and the relationship of such person to the inventor or joint inventor with respect to whom the substitute statement is executed, and unless such information is supplied in an application data sheet in accordance with §1.76, the residence and mailing address of the person signing the substitute statement;

(3) Identify the circumstances permitting the person to execute the substitute statement in lieu of an oath or declaration under §1.63, namely whether the inventor is deceased, is under a legal incapacity, cannot be found or reached after a diligent effort was made, or has refused to execute the oath or declaration under §1.63; and

(4) Unless the following information is supplied in an application data sheet in accordance with §1.76, also identify:

(i) Each inventor by his or her legal name; and

(ii) The last known mailing address where the inventor customarily receives mail, and last known residence, if an inventor lives at a location which is different from where the inventor customarily receives mail, for each inventor who is not deceased or under a legal incapacity.

(c) A person may not execute a substitute statement provided for in this section for an application unless that person has reviewed and understands the contents of the application, including the claims, and is aware of the duty to disclose to the Office all information known to the person to be material to patentability as defined in §1.56.

(d) Any reference to an inventor's oath or declaration includes a substitute statement provided for in this section.

(e) A substitute statement under this section must contain an acknowledgment that any willful false statement made in such statement is punishable under section 1001 of title 18 by fine or imprisonment of not more than 5 years, or both.

(f) A nonsigning inventor or legal representative may subsequently join in the application by submitting an oath or declaration under §1.63. The submission of an oath or declaration by a nonsigning inventor or legal representative in an application filed under §1.43, 1.45 or 1.46 will not permit the nonsigning inventor or legal representative to revoke or grant a power of attorney.

[77 FR 48819, Aug. 14, 2012]

§ 1.66 Statements under oath.

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

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

[77 FR 48819, Aug. 14, 2012]

§ 1.67 Supplemental oath or declaration.

(a) The applicant may submit an inventor's oath or declaration meeting the requirements of §1.63, §1.64, or §1.162 to correct any deficiencies or inaccuracies present in an earlier-filed inventor's oath or declaration. Deficiencies or inaccuracies due to the failure to meet the requirements of §1.63(b) in an oath or declaration may be corrected with an application data sheet in accordance with §1.76, except that any correction of inventorship must be pursuant to §1.48.

(b) A supplemental inventor's oath or declaration under this section must be executed by the person whose inventor's oath or declaration is being withdrawn, replaced, or otherwise corrected.

(c) The Office will not require a person who has executed an oath or declaration in compliance with 35 U.S.C. 115 and §1.63 or 1.162 for an application to provide an additional inventor's oath or declaration for the application.

(d) No new matter may be introduced into a nonprovisional application after its filing date even if an inventor's oath or declaration is filed to correct deficiencies or inaccuracies present in the earlier-filed inventor's oath or declaration.

[77 FR 48819, Aug. 14, 2012]

§ 1.68 Declaration in lieu of oath.

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

[49 FR 48452, Dec. 12, 1984]

§ 1.69 Foreign language oaths and declarations.

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

(b) Unless the text of any oath or declaration in a language other than English is in a form provided by the Patent and Trademark Office or in accordance with PCT Rule 4.17(iv), it must be accompanied by an English translation together with a statement that the translation is accurate, except that in the case of an oath or declaration filed under §1.63, the translation may be filed in the Office no later than two months from the date applicant is notified to file the translation.

(35 U.S.C. 6, Pub. L. 97–247)

[42 FR 5594, Jan. 28, 1977, as amended at 48 FR 2711, Jan. 20, 1983; 62 FR 53189, Oct. 10, 1997; 69 FR 56540, Sept. 21, 2004; 70 FR 3890, Jan. 27, 2005]

§ 1.70 [Reserved]

SPECIFICATION

AUTHORITY: Secs. 1.71 to 1.79 also issued under 35 U.S.C. 112.

§ 1.71 Detailed description and specification of the invention.

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science

to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

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

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

(d) A copyright or mask work notice may be placed in a design or utility patent application adjacent to copyright and mask work material contained therein. The notice may appear at any appropriate portion of the patent application disclosure. For notices in drawings, see §1.84(s). The content of the notice must be limited to only those elements provided for by law. For example, ''© 1983 John Doe'' (17 U.S.C. 401) and '' *M* John Doe'' (17 U.S.C. 909) would be properly limited and, under current statutes, legally sufficient notices of copyright and mask work, respectively. Inclusion of a copyright or mask work notice will be permitted only if the authorization language set forth in paragraph (e) of this section is included at the beginning (preferably as the first paragraph) of the specification.

(e) The authorization shall read as follows:

A portion of the disclosure of this patent document contains material which is subject to (copyright or mask work) protection. The (copyright or mask work) owner has no objection to the facsimile reproduction by anyone of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent file or records, but otherwise reserves all (copyright or mask work) rights whatsoever.

(f) The specification must commence on a separate sheet. Each sheet including part of the specification may not include other parts of the application or other information. The claim(s), abstract, and ''Sequence Listing'' (if required or submitted under §1.821(c)) should not be included on a sheet including any other part of the application.

(g)(1) The specification may disclose or be amended to disclose the names of the parties to a joint research agreement as defined in §1.9(e).

(2) An amendment under paragraph (g)(1) of this section must be accompanied by the processing fee set forth in §1.17(i) if not filed within one of the following time periods:

(i) Within three months of the filing date of a national application;

(ii) Within three months of the date of entry of the national stage as set forth in §1.491 in an international application;

(iii) Before the mailing of a first Office action on the merits; or

(iv) Before the mailing of a first Office action after the filing of a request for continued examination under §1.114.

(3) If an amendment under paragraph (g)(1) of this section is filed after the date the issue fee is paid, the patent as issued may not necessarily include the names of the parties to the joint research agreement. If the patent as issued does not include the names of the parties to the joint research agreement, the patent must be corrected to include the names of the parties to the joint research agreement by a certificate of correction under 35 U.S.C. 255 and §1.323 for the amendment to be effective.

[24 FR 10332, Dec. 22, 1959, as amended at 53 FR 47808, Nov. 28, 1988; 58 FR 38723, July 20, 1993; 68 FR 38628, June 30, 2003; 70 FR 1823, Jan. 11, 2005; 70 FR 54266, Sept. 14, 2005; 78 FR 11055, Feb. 14, 2013; 86 FR 57047, Oct. 14, 2021]

§1.72 Title and abstract.

(a) The title of the invention may not exceed 500 characters in length and

must be as short and specific as possible. Characters that cannot be captured and recorded in the Office's automated information systems may not be reflected in the Office's records in such systems or in documents created by the Office. Unless the title is supplied in an application data sheet (§1.76), the title of the invention should appear as a heading on the first page of the specification.

(b) A brief abstract of the technical disclosure in the specification must commence on a separate sheet, preferably following the claims, under the heading ''Abstract'' or ''Abstract of the Disclosure.'' The sheet or sheets presenting the abstract may not include other parts of the application or other material. The abstract must be as concise as the disclosure permits, preferably not exceeding 150 words in length. The purpose of the abstract is to enable the Office and the public generally to determine quickly from a cursory inspection the nature and gist of the technical disclosure.

[65 FR 54667, Sept. 8, 2000, as amended at 65 FR 57054, Sept. 20, 2000; 68 FR 38628, June 30, 2003; 78 FR 62402, Oct. 21, 2013]

§ 1.73 Summary of the invention.

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

§ 1.74 Reference to drawings.

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

§ 1.75 Claim(s).

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

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

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

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

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

(e) Where the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order:

(1) A preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known,

(2) A phrase such as ''wherein the improvement comprises,'' and

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

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

(g) The least restrictive claim should be presented as claim number 1, and all dependent claims should be grouped together with the claim or claims to which they refer to the extent practicable.

(h) The claim or claims must commence on a separate physical sheet or electronic page. Any sheet including a claim or portion of a claim may not contain any other parts of the application or other material.

(i) Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation.

(35 U.S.C. 6; 15 U.S.C. 1113, 1126)

[31 FR 12922, Oct. 4, 1966, as amended at 36 FR 12690, July 3, 1971; 37 FR 21995, Oct. 18, 1972; 43 FR 4015, Jan. 31, 1978; 47 FR 41276, Sept. 17, 1982; 61 FR 42803, Aug. 19, 1996; 68 FR 38628, June 30, 2003; 70 FR 3891, Jan. 27, 2005; 72 FR 46836, Aug. 21, 2007; 74 FR 52688, Oct. 14, 2009]

§ 1.76 Application data sheet.

(a) *Application data sheet.* An application data sheet is a sheet or sheets that may be submitted in a provisional application under 35 U.S.C. 111(b), a nonprovisional application under 35 U.S.C. 111(a), a nonprovisional international design application, or a national stage application under 35 U.S.C. 371 and must be submitted when required by §1.55 or 1.78 to claim priority to or the benefit of a prior-filed application under 35 U.S.C. 119, 120, 121, 365, or 386. An application data sheet must be titled ''Application Data Sheet.'' An application data sheet must contain all of the section headings listed in paragraph (b) of this section, except as provided in paragraph (c)(2) of this section, with any appropriate data for each section heading. If an application data sheet is provided, the application data sheet is part of the application for which it has been submitted.

(b) *Bibliographic data.* Bibliographic data as used in paragraph (a) of this section includes:

(1) *Inventor information.* This information includes the legal name, residence, and mailing address of the inventor or each joint inventor.

(2) *Correspondence information.* This information includes the correspondence address, which may be indicated by reference to a customer number, to which correspondence is to be directed (*see* §1.33(a)).

(3) *Application information.* This information includes the title of the invention, the total number of drawing sheets, a suggested drawing figure for publication (in a nonprovisional application), any docket number assigned to the application, the type of application (*e.g.*, utility, plant, design, reissue, provisional), whether the application discloses any significant part of the subject matter of an application under a secrecy order pursuant to §5.2 of this chapter (*see* §5.2(c)), and, for plant applications, the Latin name of the genus and species of the plant claimed, as well as the variety denomination. When information concerning the previously filed application is required under §1.57(a), application information also includes the reference to the previously filed application, indicating that the specification and any drawings of the application are replaced by the reference to the previously filed application, and specifying the previously filed application by application number, filing date, and the intellectual property authority or country in which the previously filed application was filed.

(4) *Representative information.* This information includes the registration number of each practitioner having a power of attorney in the application (preferably by reference to a customer number). Providing this information in the application data sheet does not constitute a power of attorney in the application (see §1.32).

(5) *Domestic benefit information.* This information includes the application number, the filing date, the status (including patent number if available), and relationship of each application for which a benefit is claimed under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c). Providing this information in the application data sheet constitutes the

specific reference required by 35 U.S.C. 119(e) or 120 and §1.78.

(6) *Foreign priority information.* This information includes the application number, country (or intellectual property authority), and filing date of each foreign application for which priority is claimed. Providing this information in the application data sheet constitutes the claim for priority as required by 35 U.S.C. 119(b) and §1.55.

(7) *Applicant information:* This information includes the name (either natural person or juristic entity) and address of the legal representative, assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter who is the applicant under §1.43 or §1.46. Providing assignment information in the application data sheet does not substitute for compliance with any requirement of part 3 of this chapter to have an assignment recorded by the Office.

(c) *Correcting and updating an application data sheet.* (1) Information in a previously submitted application data sheet, inventor's oath or declaration under §1.63, §1.64 or §1.67, or otherwise of record, may be corrected or updated until payment of the issue fee by a new application data sheet providing corrected or updated information, except that inventorship changes must comply with the requirements of §1.48, foreign priority and domestic benefit information changes must comply with §§1.55 and 1.78, and correspondence address changes are governed by §1.33(a).

(2) An application data sheet providing corrected or updated information may include all of the sections listed in paragraph (b) of this section or only those sections containing changed or updated information. The application data sheet must include the section headings listed in paragraph (b) of this section for each section included in the application data sheet, and must identify the information that is being changed, with underlining for insertions, and strikethrough or brackets for text removed, except that identification of information being changed is not required for an application data sheet included with an initial submission under 35 U.S.C. 371.

(d) *Inconsistencies between application data sheet and other documents.* For inconsistencies between information that is supplied by both an application data sheet under this section and other documents:

(1) The most recent submission will govern with respect to inconsistencies as between the information provided in an application data sheet, a designation of a correspondence address, or by the inventor's oath or declaration, except that:

(i) The most recent application data sheet will govern with respect to foreign priority (§1.55) or domestic benefit (§1.78) claims; and

(ii) The naming of the inventorship is governed by §1.41 and changes to inventorship or the names of the inventors is governed by §1.48.

(2) The information in the application data sheet will govern when inconsistent with the information supplied at the same time by a designation of correspondence address or the inventor's oath or declaration. The information in the application data sheet will govern when inconsistent with the information supplied at any time in a Patent Cooperation Treaty Request Form, Patent Law Treaty Model International Request Form, Patent Law Treaty Model International Request for Recordation of Change in Name or Address Form, or Patent Law Treaty Model International Request for Recordation of Change in Applicant or Owner Form.

(3) The Office will capture bibliographic information from the application data sheet. The Office will generally not review the inventor's oath or declaration to determine if the bibliographic information contained therein is consistent with the bibliographic information provided in an application data sheet. Incorrect bibliographic information contained in an application data sheet may be corrected as provided in paragraph (c)(1) of this section.

(e) *Signature requirement.* An application data sheet must be signed in compliance with §1.33(b). An unsigned application data sheet will be treated only as a transmittal letter.

(f) *Patent Law Treaty Model International Forms.* The requirement in §1.55 or §1.78 for the presentation of a priority or benefit claim under 35 U.S.C. 119, 120, 121, or 365 in an application data sheet will be satisfied by the presentation of such priority or benefit claim in the Patent Law Treaty Model International Request Form, and the requirement in §1.57(a) for a reference to the previously filed application in an application data sheet will be satisfied by the presentation of such reference to the previously filed application in the Patent Law Treaty Model International Request Form. The requirement in §1.46 for the presentation of the name of the applicant under 35 U.S.C. 118 in an application data sheet will be satisfied by the presentation of the name of the applicant in the Patent Law Treaty Model International Request Form, Patent Law Treaty Model International Request for Recordation of Change in Name or Address Form, or Patent Law Treaty Model International Request for Recordation of Change in Applicant or Owner Form, as applicable.

(g) *Patent Cooperation Treaty Request Form.* The requirement in §1.78 for the presentation of a benefit claim under 35 U.S.C. 119, 120, 121, or 365 in an application data sheet will be satisfied in a national stage application under 35 U.S.C. 371 by the presentation of such benefit claim in the Patent Cooperation Treaty Request Form contained in the international application or the presence of such benefit claim on the front page of the publication of the international application under PCT Article 21(2). The requirement in §1.55 or §1.78 for the presentation of a priority or benefit claim under 35 U.S.C. 119, 120, 121, or 365 in an application data sheet and the requirement in §1.46 for the presentation of the name of the applicant under 35 U.S.C. 118 in an application data sheet will be satisfied in an application under 35 U.S.C. 111 by the presentation of such priority or benefit claim and presentation of the name of the applicant in a Patent Cooperation Treaty Request Form. If a Patent Cooperation Treaty Request Form is submitted in an application under 35 U.S.C. 111, the Patent Cooperation Treaty Request Form must be accompanied by a clear indication that treatment of the application as an application under 35 U.S.C. 111 is desired.

[65 FR 54668, Sept. 8, 2000, as amended at 65 FR 57054, Sept. 20, 2000; 69 FR 56540, Sept. 21, 2004; 70 FR 54266, Sept. 14, 2005;; 72 FR 46837, Aug. 21, 2007; 74 FR 52689, Oct. 14, 2009; 77 FR 48820, Aug. 14, 2012; 78 FR 11055, Feb. 14, 2013; 78 FR 62402, Oct. 21, 2013; 80 FR 17959, Apr. 2, 2015]

§1.77 Arrangement of application elements.

(a) The elements of the application, if applicable, should appear in the following order:

(1) Utility application transmittal form.

(2) Fee transmittal form.

(3) Application data sheet (see §1.76).

(4) Specification.

(5) Drawings.

(6) The inventor's oath or declaration.

(b) The specification should include the following sections in order:

(1) Title of the invention, which may be accompanied by an introductory portion stating the name, citizenship, and residence of the applicant (unless included in the application data sheet).

(2) Cross-reference to related applications.

(3) Statement regarding federally sponsored research or development.

(4) The names of the parties to a joint research agreement.

(5) An incorporation by reference statement regarding the material in:

(i) One or more ASCII plain text files, submitted via the USPTO patent electronic filing system or on one or more read-only optical discs (*see* §1.52(e)(8)), identifying the names of each file, the date of creation of each file, and the size of each file in bytes, for the following document types:

(A) A ''Computer Program Listing Appendix'' (*see* §1.96(c));

(B) A ''Sequence Listing'' (*see* §1.821(c)); or

(C) ''Large Tables'' (*see* §1.58(c)).

(ii) An XML file for a ''Sequence Listing XML'' (*see* §1.831(a)), submitted via the USPTO patent electronic filing system or on one or more read-only optical discs (*see* §1.52(e)(8)), identifying the names of each file, the date of creation of each file, and the size of each file in bytes.

(6) Statement regarding prior disclosures by the inventor or a joint inventor.

(7) Background of the invention.

(8) Brief summary of the invention.

(9) Brief description of the several views of the drawing.

(10) Detailed description of the invention.

(11) A claim or claims.

(12) Abstract of the disclosure.

(13) ''Sequence Listing,'' required by §1.821(c), that is submitted as a Portable Document Format (PDF) file (as set forth in §1.821(c)(2)) via the USPTO patent electronic filing system or on physical sheets of paper (as set forth in §1.821(c)(3)).

(c) The text of the specification sections defined in paragraphs (b)(1) through (b)(12) of this section, if applicable, should be preceded by a section heading in uppercase and without underlining or bold type.

[65 FR 54668, Sept. 8, 2000, as amended at 70 FR 1823, Jan. 11, 2005; 77 FR 48820, Aug. 14, 2012; 78 FR 11055, Feb. 14, 2013; 86 FR 57047, Oct. 14, 2021; 86 FR 73985, Dec. 29, 2021; 87 FR 30817, May 20, 2022]

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

(a) *Claims under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application.* An applicant in a nonprovisional application, other than for a design patent, or an international application designating the United States may claim the benefit of one or more prior-filed provisional applications under the conditions set forth in 35 U.S.C. 119(e) and this section.

(1) The nonprovisional application or international application designating the United States must be:

(i) Filed not later than twelve months after the date on which the provisional application was filed, subject to paragraph (b) of this section (a subsequent application); or

(ii) Entitled to claim the benefit under 35 U.S.C. 120, 121, or 365(c) of a subsequent application that was filed within the period set forth in paragraph (a)(1)(i) of this section.

(2) Each prior-filed provisional application must name the inventor or a joint inventor named in the later-filed application as the inventor or a joint inventor. In addition, each prior-filed provisional application must be entitled to a filing date as set forth in §1.53(c), and the basic filing fee set forth in §1.16(d) must have been paid for such provisional application within the time period set forth in §1.53(g).

(3) Any nonprovisional application or international application designating the United States that claims the benefit of one or more prior-filed provisional applications must contain, or be amended to contain, a reference to each such prior-filed provisional application, identifying it by the provisional application number (consisting of series code and serial number). If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§1.76(b)(5)).

(4) The reference required by paragraph (a)(3) of this section must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed provisional application. If the later-filed application is a nonprovisional application entering the national stage from an international application under 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) (§1.491(a)), four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or sixteen months from the filing date of the prior-filed provisional application. Except as provided in paragraph (c) of this section, failure to timely submit the reference is considered a waiver of any benefit under 35 U.S.C. 119(e) of the prior-filed provisional application. The time periods in this paragraph do not apply if the later-filed application is:

(i) An application filed under 35 U.S.C. 111(a) before November 29, 2000; or

(ii) An international application filed under 35 U.S.C. 363 before November 29, 2000.

(5) If the prior-filed provisional application was filed in a language other than English and both an English-language translation of the prior-filed provisional application and a statement that the translation is accurate were not previously filed in the prior-filed provisional application, the applicant will be notified and given a period of time within which to file, in the prior-filed provisional application, the translation and the statement. If the notice is mailed in a pending nonprovisional application, a timely reply to such a notice must include the filing in the nonprovisional application of either a confirmation that the translation and statement were filed in the provisional application, or an application data sheet (§1.76(b)(5)) eliminating the reference under paragraph (a)(3) of this section to the prior-filed provisional application, or the nonprovisional application will be abandoned. The translation and statement may be filed in the provisional application, even if the provisional application has become abandoned.

(6) If a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a provisional application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date as defined in §1.109 that is on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the nonprovisional application, four months from the date of entry into the national stage as set forth in §1.491 in an international application, sixteen months from the filing date of the prior-filed provisional application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the nonprovisional application. An applicant is not required to provide such a statement if the applicant reasonably believes on the basis of information already known to the individuals designated in §1.56(c) that the nonprovisional application does not, and did not at any time, contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

(b) *Delayed filing of the subsequent nonprovisional application or international application designating the United States.* If the subsequent nonprovisional application or international application designating the United States has a filing date which is after the expiration of the twelve-month period set forth in paragraph (a)(1)(i) of this section but within two months from the expiration of the period set forth in paragraph (a)(1)(i) of this section, the benefit of the provisional application may be restored under PCT Rule 26*bis*.3 for an international application, or upon petition pursuant to this paragraph, if the delay in filing the subsequent nonprovisional application or international application designating the United States within the period set forth in paragraph (a)(1)(i) of this section was unintentional.

(1) A petition to restore the benefit of a provisional application under this paragraph filed on or after May 13, 2015, must be filed in the subsequent application, and any petition to restore the benefit of a provisional application under this paragraph must include:

(i) The reference required by 35 U.S.C. 119(e) to the prior-filed provisional application in an application data sheet (§1.76(b)(5)) identifying it by provisional application number (consisting of series code and serial number), unless previously submitted;

(ii) The petition fee as set forth in §1.17(m); and

(iii) A statement that the delay in filing the subsequent nonprovisional application or international application designating the United States within the twelve-month period set forth in paragraph (a)(1)(i) of this section was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(2) The restoration of the right of priority under PCT Rule 26*bis*.3 to a provisional application does not affect the requirement to include the reference required by paragraph (a)(3) of this section to the provisional application in a national stage application under 35

U.S.C. 371 within the time period provided by paragraph (a)(4) of this section to avoid the benefit claim being considered waived.

(c) *Delayed claims under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application.* If the reference required by 35 U.S.C. 119(e) and paragraph (a)(3) of this section is presented in an application after the time period provided by paragraph (a)(4) of this section, the claim under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application may be accepted if the reference identifying the prior-filed application by provisional application number was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application must be accompanied by:

(1) The reference required by 35 U.S.C. 119(e) and paragraph (a)(3) of this section to the prior-filed provisional application, unless previously submitted;

(2) The petition fee as set forth in §1.17(m); and

(3) A statement that the entire delay between the date the benefit claim was due under paragraph (a)(4) of this section and the date the benefit claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(d) *Claims under 35 U.S.C. 120, 121, 365(c), or 386(c) for the benefit of a prior-filed nonprovisional application, international application, or international design application.* An applicant in a nonprovisional application (including a nonprovisional application resulting from an international application or international design application), an international application designating the United States, or an international design application designating the United States may claim the benefit of one or more prior-filed copending nonprovisional applications, international applications designating the United States, or international design applications designating the United States under the conditions set forth in 35 U.S.C. 120, 121, 365(c), or 386(c) and this section.

(1) Each prior-filed application must name the inventor or a joint inventor named in the later-filed application as the inventor or a joint inventor. In addition, each prior-filed application must either be:

(i) An international application entitled to a filing date in accordance with PCT Article 11 and designating the United States;

(ii) An international design application entitled to a filing date in accordance with §1.1023 and designating the United States; or

(iii) A nonprovisional application under 35 U.S.C. 111(a) that is entitled to a filing date as set forth in §1.53(b) or (d) for which the basic filing fee set forth in §1.16 has been paid within the pendency of the application.

(2) Except for a continued prosecution application filed under §1.53(d), any nonprovisional application, international application designating the United States, or international design application designating the United States that claims the benefit of one or more prior-filed nonprovisional applications, international applications designating the United States, or international design applications designating the United States must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number), international application number and international filing date, or international registration number and filing date under §1.1023. If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§1.76(b)(5)). The reference also must identify the relationship of the applications, namely, whether the later-filed application is a continuation, divisional, or continuation-in-part of the prior-filed nonprovisional application, international application, or international design application.

(3)(i) The reference required by 35 U.S.C. 120 and paragraph (d)(2) of this section must be submitted during the pendency of the later-filed application.

(ii) If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed

application or sixteen months from the filing date of the prior-filed application. If the later-filed application is a nonprovisional application entering the national stage from an international application under 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) (§1.491(a)), four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or sixteen months from the filing date of the prior-filed application. The time periods in this paragraph do not apply if the later-filed application is:

(A) An application for a design patent;

(B) An application filed under 35 U.S.C. 111(a) before November 29, 2000; or

(C) An international application filed under 35 U.S.C. 363 before November 29, 2000.

(iii) Except as provided in paragraph (e) of this section, failure to timely submit the reference required by 35 U.S.C. 120 and paragraph (d)(2) of this section is considered a waiver of any benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) to the prior-filed application.

(4) The request for a continued prosecution application under §1.53(d) is the specific reference required by 35 U.S.C. 120 to the prior-filed application. The identification of an application by application number under this section is the identification of every application assigned that application number necessary for a specific reference required by 35 U.S.C. 120 to every such application assigned that application number.

(5) Cross-references to other related applications may be made when appropriate (see §1.14), but cross-references to applications for which a benefit is not claimed under title 35, United States Code, must not be included in an application data sheet (§1.76(b)(5)).

(6) If a nonprovisional application filed on or after March 16, 2013, other than a nonprovisional international design application, claims the benefit of the filing date of a nonprovisional application or an international application designating the United States filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date as defined in §1.109 that is on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the later-filed application, four months from the date of entry into the national stage as set forth in §1.491 in an international application, sixteen months from the filing date of the prior-filed application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the later-filed application. An applicant is not required to provide such a statement if either:

(i) The application claims the benefit of a nonprovisional application in which a statement under §1.55(k), paragraph (a)(6) of this section, or this paragraph that the application contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013 has been filed; or

(ii) The applicant reasonably believes on the basis of information already known to the individuals designated in §1.56(c) that the later filed application does not, and did not at any time, contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

(7) Where benefit is claimed under 35 U.S.C. 120, 121, 365(c), or 386(c) to an international application or an international design application which designates but did not originate in the United States, the Office may require a certified copy of such application together with an English translation thereof if filed in another language.

(e) *Delayed claims under 35 U.S.C. 120, 121, 365(c), or 386(c) for the benefit of a prior-filed nonprovisional application, international application, or international design application.* If the reference required by 35 U.S.C. 120 and paragraph (d)(2) of this section is presented after the time period provided by paragraph (d)(3) of this section, the claim under 35 U.S.C. 120, 121, 365(c), or 386(c) for the benefit of a prior-filed copending nonprovisional application, international application designating the United

States, or international design application designating the United States may be accepted if the reference required by paragraph (d)(2) of this section was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121, 365(c), or 386(c) for the benefit of a prior-filed application must be accompanied by:

(1) The reference required by 35 U.S.C. 120 and paragraph (d)(2) of this section to the prior-filed application, unless previously submitted;

(2) The petition fee as set forth in §1.17(m); and

(3) A statement that the entire delay between the date the benefit claim was due under paragraph (d)(3) of this section and the date the benefit claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

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

(g) *Applications or patents under reexamination naming different inventors and containing patentably indistinct claims.* If an application or a patent under reexamination and at least one other application naming different inventors are owned by the same person and contain patentably indistinct claims, and there is no statement of record indicating that the claimed inventions were commonly owned or subject to an obligation of assignment to the same person on the effective filing date (as defined in §1.109), or on the date of the invention, as applicable, of the later claimed invention, the Office may require the applicant or assignee to state whether the claimed inventions were commonly owned or subject to an obligation of assignment to the same person on such date, and if not, indicate which named inventor is the prior inventor, as applicable. Even if the claimed inventions were commonly owned, or subject to an obligation of assignment to the same person on the effective filing date (as defined in §1.109), or on the date of the invention, as applicable, of the later claimed invention, the patentably indistinct claims may be rejected under the doctrine of double patenting in view of such commonly owned or assigned applications or patents under reexamination.

(h) *Applications filed before September 16, 2012.* Notwithstanding the requirement in paragraphs (a)(3) and (d)(2) of this section that any specific reference to a prior-filed application be presented in an application data sheet (§1.76), this requirement in paragraph (a)(3) and (d)(2) of this section will be satisfied by the presentation of such specific reference in the first sentence(s) of the specification following the title in a nonprovisional application filed under 35 U.S.C. 111(a) before September 16, 2012, or resulting from an international application filed under 35 U.S.C. 363 before September 16, 2012. The provisions of this paragraph do not apply to any specific reference submitted for a petition under paragraph (b) of this section to restore the benefit of a provisional application.

(i) *Petitions required in international applications.* If a petition under paragraph (b), (c), or (e) of this section is required in an international application that was not filed with the United States Receiving Office and is not a nonprovisional application, then such petition may be filed in the earliest nonprovisional application that claims benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) to the international application and will be treated as having been filed in the international application.

(j) *Benefit under 35 U.S.C. 386(c).* Benefit under 35 U.S.C. 386(c) with respect to an international design application is applicable only to nonprovisional applications, international applications, and international design applications filed on or after May 13, 2015, and patents issuing thereon.

(k) *Time periods in this section.* The time periods set forth in this section are not extendable, but are subject to 35 U.S.C. 21(b) (and §1.7(a)), PCT Rule 80.5, and Hague Agreement Rule 4(4).

[80 FR 17959, Apr. 2, 2015]

§ 1.79 [Reserved]

THE DRAWINGS

AUTHORITY: Secs. 1.81 to 1.88 also issued under 35 U.S.C. 113.

§ 1.81 Drawings required in patent application.

(a) The applicant for a patent is required to furnish a drawing of the invention where necessary for the understanding of the subject matter sought to be patented. Since corrections are the responsibility of the applicant, the original drawing(s) should be retained by the applicant for any necessary future correction.

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

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

(d) Drawings submitted after the filing date of the application may not be used to overcome any insufficiency of the specification due to lack of an enabling disclosure or otherwise inadequate disclosure therein, or to supplement the original disclosure thereof for the purpose of interpretation of the scope of any claim.

[43 FR 4015, Jan. 31, 1978, as amended at 53 FR 47808, Nov. 28, 1988; 77 FR 48821, Aug. 14, 2012; 78 FR 62404, Oct. 21, 2013]

§ 1.83 Content of drawing.

(a) The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (*e.g.*, a labeled rectangular box). In addition, tables that are included in the specification and sequences that are included in sequence listings should not be duplicated in the drawings.

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

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

[31 FR 12923, Oct. 4, 1966, as amended at 43 FR 4015, Jan. 31, 1978; 60 FR 20226, Apr. 25, 1995; 69 FR 56541, Sept. 21, 2004; 78 FR 62405, Oct. 21, 2013]

§ 1.84 Standards for drawings.

(a) *Drawings.* There are two acceptable categories for presenting drawings in utility and design patent applications.

(1) *Black ink.* Black and white drawings are normally required. India ink, or its equivalent that secures solid black lines, must be used for drawings; or

(2) *Color.* Color drawings are permitted in design applications. Where a design application contains color drawings, the application must include the number of sets of color drawings required by paragraph (a)(2)(ii) of this section and the specification must contain the reference required by paragraph (a)(2)(iii) of this section. On rare occasions, color drawings may be necessary as the only practical medium by which to disclose the subject matter sought to be patented in a utility patent application. The color drawings must be of sufficient quality such that all details in the drawings are reproducible in black and white in the printed patent. Color drawings are not permitted in international applications (see PCT Rule 11.13). The Office will accept color drawings in utility patent

applications only after granting a petition filed under this paragraph explaining why the color drawings are necessary. Any such petition must include the following:

(i) The fee set forth in §1.17(h);

(ii) One (1) set of color drawings if submitted via the USPTO patent electronic filing system or three (3) sets of color drawings if not submitted via the USPTO patent electronic filing system; and

(iii) An amendment to the specification to insert (unless the specification contains or has been previously amended to contain) the following language as the first paragraph of the brief description of the drawings:

The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee.

(b) *Photographs*—(1) *Black and white.* Photographs, including photocopies of photographs, are not ordinarily permitted in utility and design patent applications. The Office will accept photographs in utility and design patent applications, however, if photographs are the only practicable medium for illustrating the claimed invention. For example, photographs or photomicrographs of: electrophoresis gels, blots (*e.g.*, immunological, western, Southern, and northern), autoradiographs, cell cultures (stained and unstained), histological tissue cross sections (stained and unstained), animals, plants, in vivo imaging, thin layer chromatography plates, crystalline structures, and, in a design patent application, ornamental effects, are acceptable. If the subject matter of the application admits of illustration by a drawing, the examiner may require a drawing in place of the photograph. The photographs must be of sufficient quality so that all details in the photographs are reproducible in the printed patent.

(2) *Color photographs.* Color photographs will be accepted in utility and design patent applications if the conditions for accepting color drawings and black and white photographs have been satisfied. See paragraphs (a)(2) and (b)(1) of this section.

(c) *Identification of drawings.* Identifying indicia should be provided, and if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet within the top margin. Each drawing sheet submitted after the filing date of an application must be identified as either ''Replacement Sheet'' or ''New Sheet'' pursuant to §1.121(d). If a marked-up copy of any amended drawing figure including annotations indicating the changes made is filed, such marked-up copy must be clearly labeled as ''Annotated Sheet'' pursuant to §1.121(d)(1).

(d) *Graphic forms in drawings.* Chemical or mathematical formulae, tables, and waveforms may be submitted as drawings, and are subject to the same requirements as drawings. Each chemical or mathematical formula must be labeled as a separate figure, using brackets when necessary, to show that information is properly integrated. Each group of waveforms must be presented as a single figure, using a common vertical axis with time extending along the horizontal axis. Each individual waveform discussed in the specification must be identified with a separate letter designation adjacent to the vertical axis.

(e) *Type of paper.* Drawings submitted to the Office must be made on paper which is flexible, strong, white, smooth, non-shiny, and durable. All sheets must be reasonably free from cracks, creases, and folds. Only one side of the sheet may be used for the drawing. Each sheet must be reasonably free from erasures and must be free from alterations, overwritings, and interlineations. Photographs must be developed on paper meeting the sheet-size requirements of paragraph (f) of this section and the margin requirements of paragraph (g) of this section. See paragraph (b) of this section for other requirements for photographs.

(f) *Size of paper.* All drawing sheets in an application must be the same size. One of the shorter sides of the sheet is regarded as its top. The size of the sheets on which drawings are made must be:

(1) 21.0 cm. by 29.7 cm. (DIN size A4), or

(2) 21.6 cm. by 27.9 cm. (8½ by 11 inches).

(g) *Margins.* The sheets must not contain frames around the sight (*i.e.*, the usable surface), but should have scan target points (*i.e.*, cross-hairs) printed on two catercorner margin corners. Each sheet must include a top margin of at least 2.5 cm. (1 inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 1.5 cm. (⅝ inch), and a bottom margin of at least 1.0 cm. (⅜ inch), thereby leaving a sight no greater than 17.0 cm. by 26.2 cm. on 21.0 cm. by 29.7 cm. (DIN size A4) drawing sheets, and a sight no greater than 17.6 cm. by 24.4 cm. (6 15/16 by 9⅝ inches) on 21.6 cm. by 27.9 cm. (8½ by 11 inch) drawing sheets.

(h) *Views.* The drawing must contain as many views as necessary to show the invention. The views may be plan, elevation, section, or perspective views. Detail views of portions of elements, on a larger scale if necessary, may also be used. All views of the drawing must be grouped together and arranged on the sheet(s) without wasting space, preferably in an upright position, clearly separated from one another, and must not be included in the sheets containing the specifications, claims, or abstract. Views must not be connected by projection lines and must not contain center lines. Waveforms of electrical signals may be connected by dashed lines to show the relative timing of the waveforms.

(1) *Exploded views.* Exploded views, with the separated parts embraced by a bracket, to show the relationship or order of assembly of various parts are permissible. When an exploded view is shown in a figure which is on the same sheet as another figure, the exploded view should be placed in brackets.

(2) *Partial views.* When necessary, a view of a large machine or device in its entirety may be broken into partial views on a single sheet, or extended over several sheets if there is no loss in facility of understanding the view. Partial views drawn on separate sheets must always be capable of being linked edge to edge so that no partial view contains parts of another partial view. A smaller scale view should be included showing the whole formed by the partial views and indicating the positions of the parts shown. When a portion of a view is enlarged for magnification purposes, the view and the enlarged view must each be labeled as separate views.

(i) Where views on two or more sheets form, in effect, a single complete view, the views on the several sheets must be so arranged that the complete figure can be assembled without concealing any part of any of the views appearing on the various sheets.

(ii) A very long view may be divided into several parts placed one above the other on a single sheet. However, the relationship between the different parts must be clear and unambiguous.

(3) *Sectional views.* The plane upon which a sectional view is taken should be indicated on the view from which the section is cut by a broken line. The ends of the broken line should be designated by Arabic or Roman numerals corresponding to the view number of the sectional view, and should have arrows to indicate the direction of sight. Hatching must be used to indicate section portions of an object, and must be made by regularly spaced oblique parallel lines spaced sufficiently apart to enable the lines to be distinguished without difficulty. Hatching should not impede the clear reading of the reference characters and lead lines. If it is not possible to place reference characters outside the hatched area, the hatching may be broken off wherever reference characters are inserted. Hatching must be at a substantial angle to the surrounding axes or principal lines, preferably 45°. A cross section must be set out and drawn to show all of the materials as they are shown in the view from which the cross section was taken. The parts in cross section must show proper material(s) by hatching with regularly spaced parallel oblique strokes, the space between strokes being chosen on the basis of the total area to be hatched. The various parts of a cross section of the same item should be hatched in the same manner and should accurately and graphically indicate the nature of the material(s) that is illustrated in cross section. The hatching of juxtaposed different elements must be angled in a different way. In the case of

large areas, hatching may be confined to an edging drawn around the entire inside of the outline of the area to be hatched. Different types of hatching should have different conventional meanings as regards the nature of a material seen in cross section.

(4) *Alternate position.* A moved position may be shown by a broken line superimposed upon a suitable view if this can be done without crowding; otherwise, a separate view must be used for this purpose.

(5) *Modified forms.* Modified forms of construction must be shown in separate views.

(i) *Arrangement of views.* One view must not be placed upon another or within the outline of another. All views on the same sheet should stand in the same direction and, if possible, stand so that they can be read with the sheet held in an upright position. If views wider than the width of the sheet are necessary for the clearest illustration of the invention, the sheet may be turned on its side so that the top of the sheet, with the appropriate top margin to be used as the heading space, is on the right-hand side. Words must appear in a horizontal, left-to-right fashion when the page is either upright or turned so that the top becomes the right side, except for graphs utilizing standard scientific convention to denote the axis of abscissas (of X) and the axis of ordinates (of Y).

(j) *Front page view.* The drawing must contain as many views as necessary to show the invention. One of the views should be suitable for inclusion on the front page of the patent application publication and patent as the illustration of the invention. Views must not be connected by projection lines and must not contain center lines. Applicant may suggest a single view (by figure number) for inclusion on the front page of the patent application publication and patent.

(k) *Scale.* The scale to which a drawing is made must be large enough to show the mechanism without crowding when the drawing is reduced in size to two-thirds in reproduction. Indications such as ''actual size'' or ''scale ½'' on the drawings are not permitted since these lose their meaning with reproduction in a different format.

(l) *Character of lines, numbers, and letters.* All drawings must be made by a process which will give them satisfactory reproduction characteristics. Every line, number, and letter must be durable, clean, black (except for color drawings), sufficiently dense and dark, and uniformly thick and well-defined. The weight of all lines and letters must be heavy enough to permit adequate reproduction. This requirement applies to all lines however fine, to shading, and to lines representing cut surfaces in sectional views. Lines and strokes of different thicknesses may be used in the same drawing where different thicknesses have a different meaning.

(m) *Shading.* The use of shading in views is encouraged if it aids in understanding the invention and if it does not reduce legibility. Shading is used to indicate the surface or shape of spherical, cylindrical, and conical elements of an object. Flat parts may also be lightly shaded. Such shading is preferred in the case of parts shown in perspective, but not for cross sections. See paragraph (h)(3) of this section. Spaced lines for shading are preferred. These lines must be thin, as few in number as practicable, and they must contrast with the rest of the drawings. As a substitute for shading, heavy lines on the shade side of objects can be used except where they superimpose on each other or obscure reference characters. Light should come from the upper left corner at an angle of 45°. Surface delineations should preferably be shown by proper shading. Solid black shading areas are not permitted, except when used to represent bar graphs or color.

(n) *Symbols.* Graphical drawing symbols may be used for conventional elements when appropriate. The elements for which such symbols and labeled representations are used must be adequately identified in the specification. Known devices should be illustrated by symbols which have a universally recognized conventional meaning and are generally accepted in the art. Other symbols which are not universally recognized may be used, subject to approval by the Office, if they are not likely to be confused with existing conventional symbols, and if they are readily identifiable.

(o) *Legends.* Suitable descriptive legends may be used subject to approval by the Office, or may be required by the examiner where necessary for understanding of the drawing. They should contain as few words as possible.

(p) *Numbers, letters, and reference characters.* (1) Reference characters (numerals are preferred), sheet numbers, and view numbers must be plain and legible, and must not be used in association with brackets or inverted commas, or enclosed within outlines, e.g., encircled. They must be oriented in the same direction as the view so as to avoid having to rotate the sheet. Reference characters should be arranged to follow the profile of the object depicted.

(2) The English alphabet must be used for letters, except where another alphabet is customarily used, such as the Greek alphabet to indicate angles, wavelengths, and mathematical formulas.

(3) Numbers, letters, and reference characters must measure at least .32 cm. (⅛ inch) in height. They should not be placed in the drawing so as to interfere with its comprehension. Therefore, they should not cross or mingle with the lines. They should not be placed upon hatched or shaded surfaces. When necessary, such as indicating a surface or cross section, a reference character may be underlined and a blank space may be left in the hatching or shading where the character occurs so that it appears distinct.

(4) The same part of an invention appearing in more than one view of the drawing must always be designated by the same reference character, and the same reference character must never be used to designate different parts.

(5) Reference characters not mentioned in the description shall not appear in the drawings. Reference characters mentioned in the description must appear in the drawings.

(q) *Lead lines.* Lead lines are those lines between the reference characters and the details referred to. Such lines may be straight or curved and should be as short as possible. They must originate in the immediate proximity of the reference character and extend to the feature indicated. Lead lines must not cross each other. Lead lines are required for each reference character except for those which indicate the surface or cross section on which they are placed. Such a reference character must be underlined to make it clear that a lead line has not been left out by mistake. Lead lines must be executed in the same way as lines in the drawing. See paragraph (l) of this section.

(r) *Arrows.* Arrows may be used at the ends of the lines, provided that their meaning is clear, as follows:

(1) On a lead line, a freestanding arrow to indicate the entire section towards which it points;

(2) On a lead line, an arrow touching a line to indicate the surface shown by the line looking along the direction of the arrow; or

(3) To show the direction of movement.

(s) *Copyright or Mask Work Notice.* A copyright or mask work notice may appear in the drawing, but must be placed within the sight of the drawing immediately below the figure representing the copyright or mask work material and be limited to letters having a print size of .32 cm. to .64 cm. (⅛ to ¼ inches) high. The content of the notice must be limited to only those elements provided for by law. For example, ''© 1983 John Doe'' (17 U.S.C. 401) and ''*M* John Doe'' (17 U.S.C. 909) would be properly limited and, under current statutes, legally sufficient notices of copyright and mask work, respectively. Inclusion of a copyright or mask work notice will be permitted only if the authorization language set forth in §1.71(e) is included at the beginning (preferably as the first paragraph) of the specification.

(t) *Numbering of sheets of drawings.* The sheets of drawings should be numbered in consecutive Arabic numerals, starting with 1, within the sight as defined in paragraph (g) of this section. These numbers, if present, must be placed in the middle of the top of the sheet, but not in the margin. The numbers can be placed on the right-hand side if the drawing extends too close to the middle of the top edge of the usable surface. The drawing sheet numbering must be clear and larger than the numbers used as reference characters to

avoid confusion. The number of each sheet should be shown by two Arabic numerals placed on either side of an oblique line, with the first being the sheet number, and the second being the total number of sheets of drawings, with no other marking.

(u) *Numbering of views.* (1) The different views must be numbered in consecutive Arabic numerals, starting with 1, independent of the numbering of the sheets and, if possible, in the order in which they appear on the drawing sheet(s). Partial views intended to form one complete view, on one or several sheets, must be identified by the same number followed by a capital letter. View numbers must be preceded by the abbreviation ''FIG.'' Where only a single view is used in an application to illustrate the claimed invention, it must not be numbered and the abbreviation ''FIG.'' must not appear.

(2) Numbers and letters identifying the views must be simple and clear and must not be used in association with brackets, circles, or inverted commas. The view numbers must be larger than the numbers used for reference characters.

(v) *Security markings.* Authorized security markings may be placed on the drawings provided they are outside the sight, preferably centered in the top margin.

(w) *Corrections.* Any corrections on drawings submitted to the Office must be durable and permanent.

(x) *Holes.* No holes should be made by applicant in the drawing sheets.

(y) *Types of drawings.* See §1.152 for design drawings, §1.1026 for international design reproductions, §1.165 for plant drawings, and §1.173(a)(2) for reissue drawings.

[58 FR 38723, July 20, 1993; 58 FR 45841, 45842, Aug. 31, 1993, as amended at 61 FR 42804, Aug. 19, 1996; 62 FR 53190, Oct. 10, 1997; 65 FR 54669, Sept. 8, 2000; 65 FR 57055, Sept. 20, 2000; 69 FR 56541, Sept. 21, 2004; 70 FR 3891, Jan. 27, 2005; 78 FR 11057, Feb. 14, 2013; 80 FR 17962, Apr. 2, 2015]

§ 1.85 Corrections to drawings.

(a) A utility or plant application will not be placed on the files for examination until objections to the drawings have been corrected. Except as provided in §1.215(c), any patent application publication will not include drawings filed after the application has been placed on the files for examination. Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a *bona fide* attempt to advance the application to final action (§1.135(c)). If a drawing in a design application meets the requirements of §1.84(e), (f), and (g) and is suitable for reproduction, but is not otherwise in compliance with §1.84, the drawing may be admitted for examination.

(b) The Office will not release drawings for purposes of correction. If corrections are necessary, new corrected drawings must be submitted within the time set by the Office.

(c) If a corrected drawing is required or if a drawing does not comply with §1.84 or an amended drawing submitted under §1.121(d) in a nonprovisional international design application does not comply with §1.1026 at the time an application is allowed, the Office may notify the applicant in a notice of allowability and set a three-month period of time from the mail date of the notice of allowability within which the applicant must file a corrected drawing in compliance with §1.84 or 1.1026, as applicable, to avoid abandonment. This time period is not extendable under §1.136 (see §1.136(c)).

[65 FR 54670, Sept. 8, 2000, as amended at 65 FR 57055, Sept. 20, 2000; 69 FR 56541, Sept. 21, 2004; 78 FR 62405, Oct. 21, 2013; 80 FR 17962, Apr. 2, 2015]

§ 1.88 [Reserved]

MODELS, EXHIBITS, SPECIMENS

AUTHORITY: Secs. 1.91 to 1.95 also issued under 35 U.S.C. 114.

§ 1.91 Models or exhibits not generally admitted as part of application or patent.

(a) A model or exhibit will not be admitted as part of the record of an application unless it:

(1) Substantially conforms to the requirements of §1.52 or §1.84;

(2) Is specifically required by the Office; or

(3) Is filed with a petition under this section including:

(i) The fee set forth in § 1.17(h); and

(ii) An explanation of why entry of the model or exhibit in the file record is necessary to demonstrate patentability.

(b) Notwithstanding the provisions of paragraph (a) of this section, a model, working model, or other physical exhibit may be required by the Office if deemed necessary for any purpose in examination of the application.

(c) Unless the model or exhibit substantially conforms to the requirements of § 1.52 or § 1.84 under paragraph (a)(1) of this section, it must be accompanied by photographs that show multiple views of the material features of the model or exhibit and that substantially conform to the requirements of § 1.84.

[62 FR 53190, Oct. 10, 1997, as amended at 65 FR 54670, Sept. 8, 2000; 69 FR 56541, Sept. 21, 2004]

§ 1.92 [Reserved]

§ 1.93 Specimens.

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

§ 1.94 Return of models, exhibits or specimens.

(a) Models, exhibits, or specimens may be returned to the applicant if no longer necessary for the conduct of business before the Office. When applicant is notified that a model, exhibit, or specimen is no longer necessary for the conduct of business before the Office and will be returned, applicant must arrange for the return of the model, exhibit, or specimen at the applicant's expense. The Office will dispose of perishables without notice to applicant unless applicant notifies the Office upon submission of the model, exhibit or specimen that a return is desired and makes arrangements for its return promptly upon notification by the Office that the model, exhibit or specimen is no longer necessary for the conduct of business before the Office.

(b) Applicant is responsible for retaining the actual model, exhibit, or specimen for the enforceable life of any patent resulting from the application. The provisions of this paragraph do not apply to a model or exhibit that substantially conforms to the requirements of § 1.52 or § 1.84, where the model or exhibit has been described by photographs that substantially conform to § 1.84, or where the model, exhibit or specimen is perishable.

(c) Where applicant is notified, pursuant to paragraph (a) of this section, of the need to arrange for return of a model, exhibit or specimen, applicant must arrange for the return within the period set in such notice, to avoid disposal of the model, exhibit or specimen by the Office. Extensions of time are available under § 1.136, except in the case of perishables. Failure to establish that the return of the item has been arranged for within the period set or failure to have the item removed from Office storage within a reasonable amount of time notwithstanding any arrangement for return, will permit the Office to dispose of the model, exhibit or specimen.

[69 FR 56542, Sept. 21, 2004]

§ 1.95 Copies of exhibits.

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

§ 1.96 Submission of computer program listings.

(a) *General.* Descriptions of the operation and general content of computer program listings should appear in the description portion of the specification. A computer program listing for the purpose of this section is defined as a document that lists, in appropriate sequence, the instructions, routines, and other contents of a program for a computer. The program listing may be either in machine or machine-independent (object or source) language that will cause a computer to perform

a desired procedure or task such as solving a problem, regulating the flow of work in a computer, or controlling or monitoring events. Computer program listings may be submitted in patent applications, as set forth in paragraphs (b) and (c) of this section.

(b) *Material which will be printed in the patent*: If the computer program listing is contained in 300 lines or fewer, with each line of 72 characters or fewer, it may be submitted either as drawings or as part of the specification.

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

(2) *Specification.* (i) If the listing is submitted as part of the specification, it must be submitted in accordance with the provisions of §1.52.

(ii) Any listing having more than 60 lines of code that is submitted as part of the specification must be positioned at the end of the description but before the claims. Any amendment must be made by way of submission of a substitute sheet.

(c) *As an appendix that will not be printed:* Any computer program listing may, and any computer program listing having over 300 lines (up to 72 characters per line) must, be submitted as an electronic document in ASCII plain text, whether submitted via the USPTO patent electronic filing system or on a read-only optical disc, in compliance with §1.52(e). An electronic document containing such a computer program listing is to be referred to as a ''Computer Program Listing Appendix.'' The ''Computer Program Listing Appendix'' will not be part of the printed patent. The specification must include an incorporation by reference of the ''Computer Program Listing Appendix,'' in accordance with §1.77(b)(5).

(1) A ''Computer Program Listing Appendix'' must conform to the following requirements:

(i) Computer compatibility: PC or Mac®;

(ii) Operating system compatibility: MS–DOS®, MS-Windows®, Mac OS®, or Unix®/Linux®;

(iii) Line terminator: ASCII CRLF or LF only; and

(iv) Control codes: The data must not be dependent on control characters or codes that are not defined in the ASCII character set.

(2) Each file must be named as *.txt, where ''*'' is one character or a combination of characters limited to upper- or lowercase letters, numbers, hyphens, and underscores and does not exceed 60 characters in total, excluding the extension. No spaces or other types of characters are permitted in the file name.

(3) Each file containing a ''Computer Program Listing Appendix'' submitted via the USPTO patent electronic filing system must not exceed 25 MB, and file compression is not permitted.

(4) A ''Computer Program Listing Appendix'' submitted in compliance with §1.52(e) must conform to the following requirements:

(i) A separate read-only optical disc containing a ''Computer Program Listing Appendix'' must be submitted for each applicable application;

(ii) Multiple computer program listings for a single application may be placed on a single read-only optical disc;

(iii) Multiple read-only optical discs, containing one or more computer program listings, may be submitted for a single application, if necessary;

(iv) Any computer program listing may, and a computer program listing having a nested file structure must, when submitted in compliance with §1.52(e), be compressed into a single file using WinZip®, 7-Zip, or Unix®/Linux® Zip;

(v) Any compressed file must not be self-extracting; and

(vi) A compressed ASCII plain text file that does not fit on a single read-only optical disc may be split into multiple file parts, in accordance with the target read-only optical disc size and labeled in compliance with §1.52(e)(5)(vi).

(5) Any amendments to a ''Computer Program Listing Appendix'' in electronic form in ASCII plain text format must include:

(i) A replacement ASCII plain text file, in accordance with the requirements of this paragraph (c), submitted

via the USPTO patent electronic filing system, or on a read-only optical disc, in compliance with §1.52(e), where the replacement read-only optical disc must be submitted in duplicate, and the read-only optical discs must be labeled ''COPY 1 REPLACEMENT MM/DD/YYYY'' (with the month, day, and year of creation indicated) and ''COPY 2 REPLACEMENT MM/DD/YYYY'';

(ii) A request that the amendment be made by incorporation by reference of the material in the replacement ASCII plain text file, in a separate paragraph of the specification (replacing any prior such paragraph) identifying the name of the file, the date of creation, and the size of the file in bytes (*see* §1.77(b)(5));

(iii) A statement that identifies the location of all deletions, replacements, or additions to the ASCII plain text file; and

(iv) A statement that the replacement ASCII plain text file contains no new matter.

(6) The specification of a complete application with a ''Computer Program Listing Appendix'' as an ASCII plain text file, filed on the application filing date, without an incorporation by reference of the material contained in the ASCII plain text file, must be amended to contain a separate paragraph incorporating by reference the material contained in the ASCII plain text file, in accordance with §1.77(b)(5).

(7) Any read-only optical disc for a ''Computer Program Listing Appendix'' must be submitted in duplicate. The read-only optical disc and duplicate copy must be labeled ''Copy 1'' and ''Copy 2,'' respectively. The transmittal letter that accompanies the read-only optical discs must include a statement that the two read-only optical discs are identical. In the event that the two read-only optical discs are not identical, the Office will use the read-only optical disc labeled ''Copy 1'' for further processing. Any amendment to the information on a read-only optical disc must be by way of a replacement read-only optical disc, in compliance with §1.96(c)(5).

[61 FR 42804, Aug. 19, 1996, as amended at 65 FR 54670, Sept. 8, 2000; 70 FR 54266, Sept. 14, 2005; 86 FR 57047, Oct. 14, 2021]

INFORMATION DISCLOSURE STATEMENT

§ 1.97 Filing of information disclosure statement.

(a) In order for an applicant for a patent or for a reissue of a patent to have an information disclosure statement in compliance with §1.98 considered by the Office during the pendency of the application, the information disclosure statement must satisfy one of paragraphs (b), (c), or (d) of this section.

(b) An information disclosure statement shall be considered by the Office if filed by the applicant within any one of the following time periods:

(1) Within three months of the filing date of a national application other than a continued prosecution application under §1.53(d);

(2) Within three months of the date of entry of the national stage as set forth in §1.491 in an international application;

(3) Before the mailing of a first Office action on the merits;

(4) Before the mailing of a first Office action after the filing of a request for continued examination under §1.114; or

(5) Within three months of the date of publication of the international registration under Hague Agreement Article 10(3) in an international design application.

(c) An information disclosure statement shall be considered by the Office if filed after the period specified in paragraph (b) of this section, provided that the information disclosure statement is filed before the mailing date of any of a final action under §1.113, a notice of allowance under §1.311, or an action that otherwise closes prosecution in the application, and it is accompanied by one of:

(1) The statement specified in paragraph (e) of this section; or

(2) The fee set forth in §1.17(p).

(d) An information disclosure statement shall be considered by the Office if filed by the applicant after the period specified in paragraph (c) of this section, provided that the information disclosure statement is filed on or before payment of the issue fee and is accompanied by:

(1) The statement specified in paragraph (e) of this section; and

(2) The fee set forth in §1.17(p).

(e) A statement under this section must state either:

(1) That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement; or

(2) That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in §1.56(c) more than three months prior to the filing of the information disclosure statement.

(f) No extensions of time for filing an information disclosure statement are permitted under §1.136. If a bona fide attempt is made to comply with §1.98, but part of the required content is inadvertently omitted, additional time may be given to enable full compliance.

(g) An information disclosure statement filed in accordance with this section shall not be construed as a representation that a search has been made.

(h) The filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in §1.56(b).

(i) If an information disclosure statement does not comply with either this section or §1.98, it will be placed in the file but will not be considered by the Office.

[57 FR 2034, Jan. 17, 1992, as amended at 59 FR 32658, June 24, 1994; 60 FR 20226, Apr. 25, 1995; 61 FR 42805, Aug. 19, 1996; 62 FR 53190, Oct. 10, 1997; 65 FR 14872, Mar. 20, 2000; 65 FR 54670, Sept. 8, 2000; 80 FR 17963, Apr. 2, 2015]

§1.98 Content of information disclosure statement.

(a) Any information disclosure statement filed under §1.97 shall include the items listed in paragraphs (a)(1), (a)(2) and (a)(3) of this section.

(1) A list of all patents, publications, applications, or other information submitted for consideration by the Office. U.S. patents and U.S. patent application publications must be listed in a section separately from citations of other documents. Each page of the list must include:

(i) The application number of the application in which the information disclosure statement is being submitted;

(ii) A column that provides a space, next to each document to be considered, for the examiner's initials; and

(iii) A heading that clearly indicates that the list is an information disclosure statement.

(2) A legible copy of:

(i) Each foreign patent;

(ii) Each publication or that portion which caused it to be listed, other than U.S. patents and U.S. patent application publications unless required by the Office;

(iii) For each cited pending unpublished U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and

(iv) All other information or that portion which caused it to be listed.

(3)(i) A concise explanation of the relevance, as it is presently understood by the individual designated in §1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from applicant's specification or incorporated therein.

(ii) A copy of the translation if a written English-language translation of a non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in §1.56(c).

(b)(1) Each U.S. patent listed in an information disclosure statement must be identified by inventor, patent number, and issue date.

(2) Each U.S. patent application publication listed in an information disclosure statement shall be identified by applicant, patent application publication number, and publication date.

(3) Each U.S. application listed in an information disclosure statement must be identified by the inventor, application number, and filing date.

(4) Each foreign patent or published foreign patent application listed in an information disclosure statement must be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application.

(5) Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.

(c) When the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications as specified in paragraph (a) of this section may be submitted without copies of the other patents or publications, provided that it is stated that these other patents or publications are cumulative.

(d) A copy of any patent, publication, pending U.S. application or other information, as specified in paragraph (a) of this section, listed in an information disclosure statement is required to be provided, even if the patent, publication, pending U.S. application or other information was previously submitted to, or cited by, the Office in an earlier application, unless:

(1) The earlier application is properly identified in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. 120; and

(2) The information disclosure statement submitted in the earlier application complies with paragraphs (a) through (c) of this section.

[65 FR 54671, Sept. 8, 2000, as amended at 65 FR 57055, Sept. 20, 2000; 68 FR 38628, June 30, 2003; 69 FR 56542, Sept. 21, 2004]

§ 1.99 [Reserved]

EXAMINATION OF APPLICATIONS

AUTHORITY: Secs. 1.101 to 1.108 also issued under 35 U.S.C. 131, 132.

§ 1.101 [Reserved]

§ 1.102 Advancement of examination.

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

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

(c) A petition to make an application special may be filed without a fee if the basis for the petition is:

(1) The applicant's age or health; or

(2) That the invention will materially:

(i) Enhance the quality of the environment;

(ii) Contribute to the development or conservation of energy resources; or

(iii) Contribute to countering terrorism.

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

(e) A request for prioritized examination under this paragraph (e) must comply with the requirements of this paragraph (e) and be accompanied by the prioritized examination fee set forth in § 1.17(c), the processing fee set forth in § 1.17(i), and if not already paid, the publication fee set forth in § 1.18(d). An application for which prioritized examination has been requested may not contain or be amended to contain more than four independent claims, more than thirty total claims, or any multiple dependent claim. Prioritized examination under this paragraph (e) will not be accorded to international applications that have not entered the national stage under 35 U.S.C. 371, design applications, reissue applications, provisional applications,

or reexamination proceedings. A request for prioritized examination must also comply with the requirements of paragraph (e)(1) or (2) of this section. No more than 15,000 requests for such prioritized examination will be accepted in any fiscal year.

(1) A request for prioritized examination may be filed with an original utility or plant nonprovisional application under 35 U.S.C. 111(a). The application must include a specification as prescribed by 35 U.S.C. 112 including at least one claim, a drawing when necessary, and the inventor's oath or declaration on filing, except that the filing of an inventor's oath or declaration may be postponed in accordance with §1.53(f)(3) if an application data sheet meeting the conditions specified in §1.53(f)(3)(i) is present upon filing. If the application is a utility application, it must be filed via the USPTO patent electronic filing system and include the filing fee under §1.16(a), search fee under §1.16(k), and examination fee under §1.16(o) upon filing. If the application is a plant application, it must include the filing fee under §1.16(c), search fee under §1.16(m), and examination fee under §1.16(q) upon filing. The request for prioritized examination in compliance with this paragraph must be present upon filing of the application, except that the applicant may file an amendment to cancel any independent claims in excess of four, any total claims in excess of thirty, and any multiple dependent claim not later than one month from a first decision on the request for prioritized examination. This one-month time period is not extendable.

(2) A request for prioritized examination may be filed with or after a request for continued examination in compliance with §1.114. If the application is a utility application, the request must be filed via the USPTO patent electronic filing system. The request must be filed before the mailing of the first Office action after the filing of the request for continued examination under §1.114. Only a single such request for prioritized examination under this paragraph may be granted in an application.

(36 U.S.C. 6; 15 U.S.C. 1113, 1123)

[24 FR 10332, Dec. 22, 1959, as amended at 47 FR 41276, Sept. 17, 1982; 54 FR 6903, Feb. 15, 1989; 60 FR 20226, Apr. 25, 1995; 62 FR 53191, Oct. 10, 1997; 65 FR 54671, Sept. 8, 2000; 69 FR 56542, Sept. 21, 2004; 76 FR 59054, Sept. 23, 2011; 76 FR 78569, Dec. 19, 2011; 79 FR 12390, Mar. 5, 2014; 84 FR 45910, Sept. 3, 2019; 86 FR 52991, Sept. 24, 2021]

§ 1.103 Suspension of action by the Office.

(a) *Suspension for cause.* On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months. Any petition for suspension of action under this paragraph must also include:

(1) A showing of good and sufficient cause for suspension of action; and

(2) The fee set forth in §1.17(g), unless such cause is the fault of the Office.

(b) *Limited suspension of action in a continued prosecution application (CPA) filed under §1.53(d).* On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph in a continued prosecution application filed under §1.53(d) for a period not exceeding three months. Any request for suspension of action under this paragraph must be filed with the request for an application filed under §1.53(d), specify the period of suspension, and include the processing fee set forth in §1.17(i).

(c) *Limited suspension of action after a request for continued examination (RCE) under §1.114.* On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph after the filing of a request for continued examination in compliance with §1.114 for a period not exceeding three months. Any request for suspension of action under this paragraph must be filed with the request for continued examination under §1.114, specify the period of suspension, and include the processing fee set forth in §1.17(i).

(d) *Deferral of examination.* On request of the applicant, the Office may grant a deferral of examination under the conditions specified in this paragraph for a period not extending beyond three years from the earliest filing date for which a benefit is claimed under title 35, United States Code. A request for deferral of examination under this paragraph must include the publication fee set forth in §1.18(d) and the processing fee set forth in §1.17(i). A request for deferral of examination under this paragraph will not be granted unless:

(1) The application is an original utility or plant application filed under §1.53(b) or resulting from entry of an international application into the national stage after compliance with §1.495;

(2) The applicant has not filed a nonpublication request under §1.213(a), or has filed a request under §1.213(b) to rescind a previously filed nonpublication request;

(3) The application is in condition for publication as provided in §1.211(c); and

(4) The Office has not issued either an Office action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151.

(e) *Notice of suspension on initiative of the Office.* The Office will notify applicant if the Office suspends action by the Office on an application on its own initiative.

(f) *Suspension of action for public safety or defense.* The Office may suspend action by the Office by order of the Director if the following conditions are met:

(1) The application is owned by the United States;

(2) Publication of the invention may be detrimental to the public safety or defense; and

(3) The appropriate department or agency requests such suspension.

[65 FR 50104, Aug. 16, 2000, as amended at 65 FR 57056, Sept. 20, 2000; 67 FR 523, Jan. 4, 2002; 69 FR 49999, Aug. 12, 2004; 69 FR 56542, Sept. 21, 2004; 78 FR 11057, Feb. 14, 2013]

§ 1.104 Nature of examination.

(a) *Examiner's action.* (1) On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.

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

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

(4) Any national application may also have an international-type search report prepared thereon at the time of the national examination on the merits, upon specific written request therefor and payment of the international-type search report fee set forth in §1.21(e). The Patent and Trademark Office does not require that a formal report of an international-type search be prepared in order to obtain a search fee refund in a later filed international application.

(b) *Completeness of examiner's action.* The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.

(c) *Rejection of claims.* (1) If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable will be rejected.

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference

is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

(3) In rejecting claims the examiner may rely upon admissions by the applicant, or the patent owner in a reexamination proceeding, as to any matter affecting patentability and, insofar as rejections in applications are concerned, may also rely upon facts within his or her knowledge pursuant to paragraph (d)(2) of this section.

(4)(i) Subject matter which would otherwise qualify as prior art under 35 U.S.C. 102(a)(2) and a claimed invention will be treated as commonly owned for purposes of 35 U.S.C. 102(b)(2)(C) if the applicant or patent owner provides a statement to the effect that the subject matter and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

(ii) Subject matter which would otherwise qualify as prior art under 35 U.S.C. 102(a)(2) and a claimed invention will be treated as commonly owned for purposes of 35 U.S.C. 102(b)(2)(C) on the basis of a joint research agreement under 35 U.S.C. 102(c) if:

(A) The applicant or patent owner provides a statement to the effect that the subject matter was developed and the claimed invention was made by or on behalf of one or more parties to a joint research agreement, within the meaning of 35 U.S.C. 100(h) and §1.9(e), that was in effect on or before the effective filing date of the claimed invention, and the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(B) The application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(5)(i) Subject matter which qualifies as prior art under 35 U.S.C. 102(e), (f), or (g) in effect prior to March 16, 2013, and a claimed invention in an application filed on or after November 29, 1999, or any patent issuing thereon, in an application filed before November 29, 1999, but pending on December 10, 2004, or any patent issuing thereon, or in any patent granted on or after December 10, 2004, will be treated as commonly owned for purposes of 35 U.S.C. 103(c) in effect prior to March 16, 2013, if the applicant or patent owner provides a statement to the effect that the subject matter and the claimed invention, at the time the claimed invention was made, were owned by the same person or subject to an obligation of assignment to the same person.

(ii) Subject matter which qualifies as prior art under 35 U.S.C. 102(e), (f), or (g) in effect prior to March 16, 2013, and a claimed invention in an application pending on or after December 10, 2004, or in any patent granted on or after December 10, 2004, will be treated as commonly owned for purposes of 35 U.S.C. 103(c) in effect prior to March 16, 2013, on the basis of a joint research agreement under 35 U.S.C. 103(c)(2) in effect prior to March 16, 2013, if:

(A) The applicant or patent owner provides a statement to the effect that the subject matter and the claimed invention were made by or on behalf of the parties to a joint research agreement, within the meaning of 35 U.S.C. 100(h) and §1.9(e), which was in effect on or before the date the claimed invention was made, and that the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(B) The application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(6) Patents issued prior to December 10, 2004, from applications filed prior to November 29, 1999, are subject to 35 U.S.C. 103(c) in effect on November 28, 1999.

(d) *Citation of references.* (1) If domestic patents are cited by the examiner, their numbers and dates, and the names of the patentees will be stated. If domestic patent application publications are cited by the examiner, their publication number, publication date, and the names of the applicants will be

stated. If foreign published applications or patents are cited, their nationality or country, numbers and dates, and the names of the patentees will be stated, and such other data will be furnished as may be necessary to enable the applicant, or in the case of a reexamination proceeding, the patent owner, to identify the published applications or patents cited. In citing foreign published applications or patents, in case only a part of the document is involved, the particular pages and sheets containing the parts relied upon will be identified. If printed publications are cited, the author (if any), title, date, pages or plates, and place of publication, or place where a copy can be found, will be given.

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

(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.

[62 FR 53191, Oct. 10, 1997, as amended at 65 FR 14872, Mar. 20, 2000; 65 FR 54671, Sept. 8, 2000; 65 FR 57056, Sept. 20, 2000; 70 FR 1823, Jan. 11, 2005; 70 FR 54266, Sept. 14, 2005; 72 FR 46841, Aug. 21, 2007; 74 FR 52690, Oct. 14, 2009; 78 FR 11057, Feb. 14, 2013]

§ 1.105 Requirements for information.

(a)(1) In the course of examining or treating a matter in a pending or abandoned application, in a patent, or in a reexamination proceeding, including a reexamination proceeding ordered as a result of a supplemental examination proceeding, the examiner or other Office employee may require the submission, from individuals identified under §1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

(i) *Commercial databases:* The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.

(ii) *Search:* Whether a search of the prior art was made, and if so, what was searched.

(iii) *Related information:* A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

(iv) *Information used to draft application:* A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

(v) *Information used in invention process:* A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) *Improvements:* Where the claimed invention is an improvement, identification of what is being improved.

(vii) *In use:* Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(viii) *Technical information known to applicant.* Technical information known to applicant concerning the related art, the disclosure, the claimed subject matter, other factual information pertinent to patentability, or concerning the accuracy of the examiner's stated interpretation of such items.

(2) Requirements for factual information known to applicant may be presented in any appropriate manner, for example:

(i) A requirement for factual information;

(ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or

(iii) Stipulations as to facts with which the applicant may agree or disagree.

(3) Any reply to a requirement for information pursuant to this section that states either that the information required to be submitted is unknown to or is not readily available to the party or parties from which it was requested may be accepted as a complete reply.

(b) The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section will be governed by §§1.135 and 1.136.

[65 FR 54671, Sept. 8, 2000, as amended at 69 FR 56542, Sept. 21, 2004; 72 FR 46841, Aug. 21, 2007; 74 FR 52690, Oct. 14, 2009; 77 FR 48821, Aug. 14, 2012; 80 FR 17963, Apr. 2, 2015]

§§ 1.106–1.108 [Reserved]

§ 1.109 Effective filing date of a claimed invention under the Leahy-Smith America Invents Act.

(a) The effective filing date for a claimed invention in a patent or application for patent, other than in a reissue application or reissued patent, is the earliest of:

(1) The actual filing date of the patent or the application for the patent containing a claim to the invention; or

(2) The filing date of the earliest application for which the patent or application is entitled, as to such invention, to a right of priority or the benefit of an earlier filing date under 35 U.S.C. 119, 120, 121, 365, or 386.

(b) The effective filing date for a claimed invention in a reissue application or a reissued patent is determined by deeming the claim to the invention to have been contained in the patent for which reissue was sought.

[80 FR 17963, Apr. 2, 2015]

§ 1.110 Inventorship and ownership of the subject matter of individual claims.

When one or more joint inventors are named in an application or patent, the Office may require an applicant or patentee to identify the inventorship and ownership or obligation to assign ownership, of each claimed invention on its effective filing date (as defined in §1.109) or on its date of invention, as applicable, when necessary for purposes of an Office proceeding. The Office may also require an applicant or patentee to identify the invention dates of the subject matter of each claim when necessary for purposes of an Office proceeding.

[78 FR 11058, Feb. 14, 2013]

ACTION BY APPLICANT AND FURTHER CONSIDERATION

AUTHORITY: Secs. 1.111 to 1.113 also issued under 35 U.S.C. 132.

§ 1.111 Reply by applicant or patent owner to a non-final Office action.

(a)(1) If the Office action after the first examination (§1.104) is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment. See §§1.135 and 1.136 for time for reply to avoid abandonment.

(2) *Supplemental replies.* (i) A reply that is supplemental to a reply that is in compliance with §1.111(b) will not be entered as a matter of right except as provided in paragraph (a)(2)(ii) of this section. The Office may enter a supplemental reply if the supplemental reply is clearly limited to:

(A) Cancellation of a claim(s);

(B) Adoption of the examiner suggestion(s);

(C) Placement of the application in condition for allowance;

(D) Reply to an Office requirement made after the first reply was filed;

(E) Correction of informalities (*e.g.*, typographical errors); or

(F) Simplification of issues for appeal.

(ii) A supplemental reply will be entered if the supplemental reply is filed within the period during which action by the Office is suspended under §1.103(a) or (c).

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply

to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a *bona fide* attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

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

[46 FR 29182, May 29, 1981, as amended at 62 FR 53192, Oct. 10, 1997; 65 FR 54672, Sept. 8, 2000; 69 FR 56542, Sept. 21, 2004; 70 FR 3891, Jan. 27, 2005]

§ 1.112 Reconsideration before final action.

After reply by applicant or patent owner (§ 1.111 or § 1.945) to a non-final action and any comments by an *inter partes* reexamination requester (§ 1.947), the application or the patent under reexamination will be reconsidered and again examined. The applicant, or in the case of a reexamination proceeding the patent owner and any third party requester, will be notified if claims are rejected, objections or requirements made, or decisions favorable to patentability are made, in the same manner as after the first examination (§ 1.104). Applicant or patent owner may reply to such Office action in the same manner provided in § 1.111 or § 1.945, with or without amendment, unless such Office action indicates that it is made final (§ 1.113) or an appeal (§ 41.31 of this title) has been taken (§ 1.116), or in an *inter partes* reexamination, that it is an action closing prosecution (§ 1.949) or a right of appeal notice (§ 1.953).

[69 FR 49999, Aug. 12, 2004]

§ 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 include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

[65 FR 14872, Mar. 20, 2000, as amended at 65 FR 76773, Dec. 7, 2000; 69 FR 49999, Aug. 12, 2004]

§ 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) prior to the earliest of:

(1) Payment of the issue fee, unless a petition under §1.313 is granted;

(2) Abandonment of the application; or

(3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.

(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, or an international application that does not comply with 35 U.S.C. 371;

(4) An application for a design patent;

(5) An international design application; or

(6) A patent under reexamination.

[65 FR 50104, Aug. 16, 2000, as amended at 69 FR 49999, Aug. 12, 2004; 72 FR 46841, Aug. 21, 2007; 74 FR 52691, Oct. 14, 2009; 80 FR 17963, Apr. 2, 2015]

AMENDMENTS

AUTHORITY: Secs. 1.115 to 1.127 also issued under 35 U.S.C. 132.

§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 the first Office action under §1.104. The patent application publication may include preliminary amendments (§1.215(a)).

(1) A preliminary amendment that is present on the filing date of an application is part of the original disclosure of the application.

(2) A preliminary amendment filed after the filing date of the application is not part of the original disclosure of the application.

(b) A preliminary amendment in compliance with §1.121 will be entered unless disapproved by the Director.

(1) A preliminary amendment seeking cancellation of all the claims without presenting any new or substitute claims will be disapproved.

(2) A preliminary amendment may be disapproved if the preliminary amendment unduly interferes with the preparation of a first Office action in an application. Factors that will be considered in disapproving a preliminary amendment include:

(i) The state of preparation of a first Office action as of the date of receipt (§1.6) of the preliminary amendment by the Office; and

(ii) The nature of any changes to the specification or claims that would result from entry of the preliminary amendment.

(3) A preliminary amendment will not be disapproved under (b)(2) of this section if it is filed no later than:

(i) Three months from the filing date of an application under §1.53(b);

(ii) The filing date of a continued prosecution application under §1.53(d); or

(iii) Three months from the date the national stage is entered as set forth in §1.491 in an international application.

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

[69 FR 56543, Sept. 21, 2004]

§ 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), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

(f) Notwithstanding the provisions of paragraph (e) of this section, no affidavit or other evidence 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.

(g) After decision on appeal, amendments, affidavits and other evidence can only be made as provided in §§1.198 and 1.981, or to carry into effect a recommendation under §41.50(c) of this title.

[69 FR 49999, Aug. 12, 2004]

§§ 1.117–1.119 [Reserved]

§ 1.121 Manner of making amendments in applications.

(a) *Amendments in applications, other than reissue applications.* Amendments in applications, other than reissue applications, are made by filing a paper, in compliance with §1.52, directing that specified amendments be made.

(b) *Specification.* Amendments to the specification, other than the claims, ''Large Tables'' (§1.58(c)), a ''Computer Program Listing Appendix'' (§1.96(c)(5) and (7)), a ''Sequence Listing'' (§1.825), or a ''Sequence Listing XML'' (§1.835), must be made by adding, deleting, or

replacing a paragraph; by replacing a section; or by providing a substitute specification, in the manner specified in this section.

(1) *Amendment to delete, replace, or add a paragraph.* Amendments to the specification, including amendment to a section heading or the title of the invention which are considered for amendment purposes to be an amendment of a paragraph, must be made by submitting:

(i) An instruction, which unambiguously identifies the location, to delete one or more paragraphs of the specification, replace a paragraph with one or more replacement paragraphs, or add one or more paragraphs;

(ii) The full text of any replacement paragraph with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived;

(iii) The full text of any added paragraphs without any underlining; and

(iv) The text of a paragraph to be deleted must not be presented with strike-through or placed within double brackets. The instruction to delete may identify a paragraph by its paragraph number or include a few words from the beginning, and end, of the paragraph, if needed for paragraph identification purposes.

(2) *Amendment by replacement section.* If the sections of the specification contain section headings as provided in §1.77(b), §1.154(b), or §1.163(c), amendments to the specification, other than the claims, may be made by submitting:

(i) A reference to the section heading along with an instruction, which unambiguously identifies the location, to delete that section of the specification and to replace such deleted section with a replacement section; and

(ii) A replacement section with markings to show all changes relative to the previous version of the section. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived.

(3) *Amendment by substitute specification.* The specification, other than the claims, may also be amended by submitting:

(i) An instruction to replace the specification; and

(ii) A substitute specification in compliance with §§1.125(b) and (c).

(4) *Reinstatement of previously deleted paragraph or section.* A previously deleted paragraph or section may be reinstated only by a subsequent amendment adding the previously deleted paragraph or section.

(5) *Presentation in subsequent amendment document.* Once a paragraph or section is amended in a first amendment document, the paragraph or section shall not be re-presented in a subsequent amendment document unless it is amended again or a substitute specification is provided.

(6) *Amendments to ''Large Tables,'' a ''Computer Program Listing Appendix,'' a ''Sequence Listing,'' or a ''Sequence Listing XML.''* Changes to ''Large Tables,'' a ''Computer Program Listing Appendix,'' a ''Sequence Listing,'' or a ''Sequence Listing XML'' must be made in accordance with §1.58(g) for ''Large Tables,'' §1.96(c)(5) for a ''Computer Program Listing Appendix,'' §1.825 for a ''Sequence Listing,'' or §1.835 for a ''Sequence Listing XML.''

(c) *Claims.* Amendments to a claim must be made by rewriting the entire claim with all changes (*e.g.*, additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the

application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) *Claim listing.* All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of ''canceled'' or ''not entered'' may be aggregated into one statement (*e.g.*, Claims 1–5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) *When claim text with markings is required.* All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of ''currently amended,'' and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of ''currently amended,'' or ''withdrawn'' if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as ''withdrawn—currently amended.''

(3) *When claim text in clean version is required.* The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, *i.e.*, without any markings in the presentation of text. The presentation of a clean version of any claim having the status of ''original,'' ''withdrawn'' or ''previously presented'' will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of ''withdrawn'' or ''previously presented.'' Any claim added by amendment must be indicated with the status of ''new'' and presented in clean version, *i.e.*, without any underlining.

(4) *When claim text shall not be presented; canceling a claim.* (i) No claim text shall be presented for any claim in the claim listing with the status of ''canceled'' or ''not entered.''

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as ''canceled'' will constitute an instruction to cancel the claim.

(5) *Reinstatement of previously canceled claim.* A claim which was previously canceled may be reinstated only by adding the claim as a ''new'' claim with a new claim number.

(d) *Drawings.* One or more application drawings shall be amended in the following manner: Any changes to an application drawing must be in compliance with §1.84 or, for a nonprovisional international design application, in compliance with §§1.84(c) and 1.1026 and must be submitted on a replacement sheet of drawings which shall be an attachment to the amendment document and, in the top margin, labeled ''Replacement Sheet.'' Any replacement sheet of drawings shall include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is amended. Any new sheet of drawings containing an additional figure must be labeled in the top margin as ''New Sheet.'' All changes to the drawings shall be explained, in detail, in either the drawing amendment or remarks section of the amendment paper.

(1) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be included. The marked-up copy must be clearly labeled as ''Annotated Sheet'' and must be presented in the amendment or remarks section that explains the change to the drawings.

(2) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.

(e) *Disclosure consistency*. The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(f) *No new matter*. No amendment may introduce new matter into the disclosure of an application.

(g) *Exception for examiner's amendments*. Changes to the specification, including the claims, of an application made by the Office in an examiner's amendment may be made by specific instructions to insert or delete subject matter set forth in the examiner's amendment by identifying the precise point in the specification or the claim(s) where the insertion or deletion is to be made. Compliance with paragraphs (b)(1), (b)(2), or (c) of this section is not required.

(h) *Amendment sections*. Each section of an amendment document (*e.g.*, amendment to the claims, amendment to the specification, replacement drawings, and remarks) must begin on a separate sheet.

(i) *Amendments in reissue applications*. Any amendment to the description and claims in reissue applications must be made in accordance with §1.173.

(j) *Amendments in reexamination proceedings*. Any proposed amendment to the description and claims in patents involved in reexamination proceedings must be made in accordance with §1.530.

(k) *Amendments in provisional applications*. Amendments in provisional applications are not usually made. If an amendment is made to a provisional application, however, it must comply with the provisions of this section. Any amendments to a provisional application shall be placed in the provisional application file but may not be entered.

[68 FR 38628, June 30, 2003, as amended at 69 FR 56543, Sept. 21, 2004; 80 FR 17963, Apr. 2, 2015; 86 FR 57048, Oct. 14, 2021; 87 FR 30817, May 20, 2022]

§§ 1.122–1.224 [Reserved]

§ 1.125 Substitute specification.

(a) If the number or nature of the amendments or the legibility of the application papers renders it difficult to consider the application, or to arrange the papers for printing or copying, the Office may require the entire specification, including the claims, or any part thereof, be rewritten.

(b) Subject to §1.312, a substitute specification, excluding the claims, may be filed at any point up to payment of the issue fee if it is accompanied by a statement that the substitute specification includes no new matter.

(c) A substitute specification submitted under this section must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strikethrough except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strikethrough cannot be easily perceived. An accompanying clean version (without markings) must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown pursuant to this paragraph.

(d) A substitute specification under this section is not permitted in a reissue application or in a reexamination proceeding.

[62 FR 53193, Oct. 10, 1997, as amended at 65 FR 54673, Sept. 8, 2000; 68 FR 38630, June 30, 2003]

§ 1.126 Numbering of claims.

The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled the remaining claims must not be renumbered. When claims are added, they must be numbered by the applicant consecutively beginning with the number next following the highest numbered claim previously presented

(whether entered or not). When the application is ready for allowance, the examiner, if necessary, will renumber the claims consecutively in the order in which they appear or in such order as may have been requested by applicant.

[62 FR 53194, Oct. 10, 1997]

§ 1.127 [Reserved]

TRANSITIONAL PROVISIONS

§ 1.129 Transitional procedures for limited examination after final rejection and restriction practice.

(a) An applicant in an application, other than for reissue or a design patent, that has been pending for at least two years as of June 8, 1995, taking into account any reference made in such application to any earlier filed application under 35 U.S.C. 120, 121 and 365(c), is entitled to have a first submission entered and considered on the merits after final rejection under the following circumstances: The Office will consider such a submission, if the first submission and the fee set forth in §1.17(r) are filed prior to the filing of an appeal brief and prior to abandonment of the application. The finality of the final rejection is automatically withdrawn upon the timely filing of the submission and payment of the fee set forth in §1.17(r). If a subsequent final rejection is made in the application, applicant is entitled to have a second submission entered and considered on the merits after the subsequent final rejection under the following circumstances: The Office will consider such a submission, if the second submission and a second fee set forth in §1.17(r) are filed prior to the filing of an appeal brief and prior to abandonment of the application. The finality of the subsequent final rejection is automatically withdrawn upon the timely filing of the submission and payment of the second fee set forth in §1.17(r). Any submission filed after a final rejection made in an application subsequent to the fee set forth in §1.17(r) having been twice paid will be treated as set forth in §1.116. A submission as used in this paragraph includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims or drawings and a new substantive argument or new evidence in support of patentability.

(b)(1) In an application, other than for reissue or a design patent, that has been pending for at least three years as of June 8, 1995; taking into account any reference made in the application to any earlier filed application under 35 U.S.C. 120, 121, and 365(c), no requirement for restriction or for the filing of divisional applications shall be made or maintained in the application after June 8, 1995, except where:

(i) The requirement was first made in the application or any earlier filed application under 35 U.S.C. 120, 121 and 365(c) prior to April 8, 1995;

(ii) The examiner has not made a requirement for restriction in the present or parent application prior to April 8, 1995, due to actions by the applicant; or

(iii) The required fee for examination of each additional invention was not paid.

(2) If the application contains more than one independent and distinct invention and a requirement for restriction or for the filing of divisional applications cannot be made or maintained pursuant to this paragraph, applicant will be so notified and given a time period to:

(i) Elect the invention or inventions to be searched and examined, if no election has been made prior to the notice, and pay the fee set forth in §1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects;

(ii) Confirm an election made prior to the notice and pay the fee set forth in §1.17(s) for each independent and distinct invention claimed in the application in addition to the one invention which applicant previously elected; or

(iii) File a petition under this section traversing the requirement. If the required petition is filed in a timely manner, the original time period for electing and paying the fee set forth in §1.17(s) will be deferred and any decision on the petition affirming or modifying the requirement will set a new time period to elect the invention or inventions to be searched and examined and to pay the fee set forth in

§1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects.

(3) The additional inventions for which the required fee has not been paid will be withdrawn from consideration under §1.142(b). An applicant who desires examination of an invention so withdrawn from consideration can file a divisional application under 35 U.S.C. 121.

(c) The provisions of this section shall not be applicable to any application filed after June 8, 1995.

[60 FR 20226, Apr. 25, 1995]

AFFIDAVITS OVERCOMING REJECTIONS

§ 1.130 Affidavit or declaration of attribution or prior public disclosure under the Leahy-Smith America Invents Act.

(a) *Affidavit or declaration of attribution.* When any claim of an application or a patent under reexamination is rejected, the applicant or patent owner may submit an appropriate affidavit or declaration to disqualify a disclosure as prior art by establishing that the disclosure was made by the inventor or a joint inventor, or the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor.

(b) *Affidavit or declaration of prior public disclosure.* When any claim of an application or a patent under reexamination is rejected, the applicant or patent owner may submit an appropriate affidavit or declaration to disqualify a disclosure as prior art by establishing that the subject matter disclosed had, before such disclosure was made or before such subject matter was effectively filed, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor. An affidavit or declaration under this paragraph must identify the subject matter publicly disclosed and provide the date such subject matter was publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

(1) If the subject matter publicly disclosed on that date was in a printed publication, the affidavit or declaration must be accompanied by a copy of the printed publication.

(2) If the subject matter publicly disclosed on that date was not in a printed publication, the affidavit or declaration must describe the subject matter with sufficient detail and particularity to determine what subject matter had been publicly disclosed on that date by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

(c) *When this section is not available.* The provisions of this section are not available if the rejection is based upon a disclosure made more than one year before the effective filing date of the claimed invention. The provisions of this section may not be available if the rejection is based upon a U.S. patent or U.S. patent application publication of a patented or pending application naming another inventor, the patent or pending application claims an invention that is the same or substantially the same as the applicant's or patent owner's claimed invention, and the affidavit or declaration contends that an inventor named in the U.S. patent or U.S. patent application publication derived the claimed invention from the inventor or a joint inventor named in the application or patent, in which case an applicant or a patent owner may file a petition for a derivation proceeding pursuant to §42.401 *et seq.* of this title.

(d) *Applications and patents to which this section is applicable.* The provisions of this section apply to any application for patent, and to any patent issuing thereon, that contains, or contained at any time:

(1) A claim to a claimed invention that has an effective filing date as defined in §1.109 that is on or after March 16, 2013; or

(2) A specific reference under 35 U.S.C. 120, 121, 365(c), or 386(c) to any patent or application that contains, or contained at any time, a claim to a claimed invention that has an effective

filing date as defined in §1.109 that is on or after March 16, 2013.

[78 FR 11058, Feb. 14, 2013, as amended at 80 FR 17963, Apr. 2, 2015]

§ 1.131 Affidavit or declaration of prior invention or to disqualify commonly owned patent or published application as prior art.

(a) When any claim of an application or a patent under reexamination is rejected, the applicant or patent owner may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. The effective date of a U.S. patent, U.S. patent application publication, or international application publication under PCT Article 21(2) is the earlier of its publication date or the date that it is effective as a reference under 35 U.S.C. 102(e) as in effect on March 15, 2013. Prior invention may not be established under this section in any country other than the United States, a NAFTA country, or a WTO member country. Prior invention may not be established under this section before December 8, 1993, in a NAFTA country other than the United States, or before January 1, 1996, in a WTO member country other than a NAFTA country. Prior invention may not be established under this section if either:

(1) The rejection is based upon a U.S. patent or U.S. patent application publication of a pending or patented application naming another inventor which claims interfering subject matter as defined in §41.203(a) of this chapter, in which case an applicant may suggest an interference pursuant to §41.202(a) of this chapter; or

(2) The rejection is based upon a statutory bar.

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

(c) When any claim of an application or a patent under reexamination is rejected under 35 U.S.C. 103 as in effect on March 15, 2013, on a U.S. patent or U.S. patent application publication which is not prior art under 35 U.S.C. 102(b) as in effect on March 15, 2013, and the inventions defined by the claims in the application or patent under reexamination and by the claims in the patent or published application are not identical but are not patentably distinct, and the inventions are owned by the same party, the applicant or owner of the patent under reexamination may disqualify the patent or patent application publication as prior art. The patent or patent application publication can be disqualified as prior art by submission of:

(1) A terminal disclaimer in accordance with §1.321(c); and

(2) An oath or declaration stating that the application or patent under reexamination and patent or published application are currently owned by the same party, and that the inventor named in the application or patent under reexamination is the prior inventor under 35 U.S.C. 104 as in effect on March 15, 2013.

(d) The provisions of this section apply to any application for patent and to any patent issuing thereon, that contains, or contained at any time:

(1) A claim to an invention that has an effective filing date as defined in §1.109 that is before March 16, 2013; or

(2) A specific reference under 35 U.S.C. 120, 121, 365(c), or 386(c) to any patent or application that contains, or contained at any time, a claim to an invention that has an effective filing date as defined in §1.109 that is before March 16, 2013.

(e) In an application for patent to which the provisions of §1.130 apply, and to any patent issuing thereon, the provisions of this section are applicable only with respect to a rejection

under 35 U.S.C. 102(g) as in effect on March 15, 2013.

[78 FR 11058, Feb. 14, 2013, as amended at 78 FR 62405, Oct. 21, 2013; 80 FR 17963, Apr. 2, 2015]

§ 1.132 Affidavits or declarations traversing rejections or objections.

When any claim of an application or a patent under reexamination is rejected or objected to, any evidence submitted to traverse the rejection or objection on a basis not otherwise provided for must be by way of an oath or declaration under this section.

[65 FR 57057, Sept. 20, 2000]

INTERVIEWS

§ 1.133 Interviews.

(a)(1) Interviews with examiners concerning applications and other matters pending before the Office must be conducted on Office premises and within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director.

(2) An interview for the discussion of the patentability of a pending application will not occur before the first Office action, unless the application is a continuing or substitute application or the examiner determines that such an interview would advance prosecution of the application.

(3) The examiner may require that an interview be scheduled in advance.

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

(35 U.S.C. 132)

[24 FR 10332, Dec. 22, 1959, as amended at 62 FR 53194, Oct. 10, 1997; 65 FR 54674, Sept. 8, 2000; 70 FR 56128, Sept. 26, 2005]

TIME FOR REPLY BY APPLICANT; ABANDONMENT OF APPLICATION

AUTHORITY: Secs. 1.135 to 1.138 also issued under 35 U.S.C. 133.

§ 1.134 Time period for reply to an Office action.

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

[62 FR 53194, Oct. 10, 1997]

§ 1.135 Abandonment for failure to reply within time period.

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

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

(c) When reply by the applicant is a *bona fide* attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

[62 FR 53194, Oct. 10, 1997]

§ 1.136 Extensions of time.

(a)(1) If an applicant is required to reply within a nonstatutory or shortened statutory time period, applicant may extend the time period for reply up to the earlier of the expiration of any maximum period set by statute or five months after the time period set for reply, if a petition for an extension of time and the fee set in § 1.17(a) are filed, unless:

(i) Applicant is notified otherwise in an Office action;

(ii) The reply is a reply brief submitted pursuant to § 41.41 of this title;

(iii) The reply is a request for an oral hearing submitted pursuant to § 41.47(a) of this title;

(iv) The reply is to a decision by the Patent Trial and Appeal Board pursuant to § 41.50 or § 41.52 of this chapter or to § 90.3 of this chapter; or

(v) The application is involved in a contested case (§ 41.101(a) of this title) or a derivation proceeding (§ 42.4(b) of this title).

(2) The date on which the petition and the fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The expiration of the time period is determined by the amount of the fee paid. A reply must be filed prior to the expiration of the period of extension to avoid abandonment of the application (§ 1.135), but in no situation may an applicant reply later than the maximum time period set by statute, or be granted an extension of time under paragraph (b) of this section when the provisions of paragraph (a) of this section are available.

(3) A written request may be submitted in an application that is an authorization to treat any concurrent or future reply, requiring a petition for an extension of time under this paragraph for its timely submission, as incorporating a petition for extension of time for the appropriate length of time. An authorization to charge all required fees, fees under § 1.17, or all required extension of time fees will be treated as a constructive petition for an extension of time in any concurrent or future reply requiring a petition for an extension of time under this paragraph for its timely submission. Submission of the fee set forth in § 1.17(a) will also be treated as a constructive petition for an extension of time in any concurrent reply requiring a petition for an extension of time under this paragraph for its timely submission.

(b) When a reply cannot be filed within the time period set for such reply and the provisions of paragraph (a) of this section are not available, the period for reply will be extended only for sufficient cause and for a reasonable time specified. Any request for an extension of time under this paragraph must be filed on or before the day on which such reply is due, but the mere filing of such a request will not effect any extension under this paragraph. In no situation can any extension carry the date on which reply is due beyond the maximum time period set by statute. Any request under this paragraph must be accompanied by the petition fee set forth in § 1.17(g).

(c) If an applicant is notified in a ''Notice of Allowability'' that an application is otherwise in condition for allowance, the following time periods are not extendable if set in the ''Notice of Allowability'' or in an Office action having a mail date on or after the mail date of the ''Notice of Allowability'':

(1) The period for submitting the inventor's oath or declaration;

(2) The period for submitting formal drawings set under § 1.85(c); and

(3) The period for making a deposit set under § 1.809(c).

(d) See § 1.550(c) for extensions of time in *ex parte* reexamination proceedings, § 1.956 for extensions of time in *inter partes* reexamination proceedings; §§ 41.4(a) and 41.121(a)(3) of this chapter for extensions of time in contested cases before the Patent Trial and Appeal Board; § 42.5(c) of this chapter for extensions of time in trials before the Patent Trial and Appeal Board; and § 90.3 of this chapter for extensions of time to appeal to the U.S. Court of Appeals for the Federal Circuit or to commence a civil action.

[62 FR 53194, Oct. 10, 1997, as amended at 65 FR 54674, Sept. 8, 2000; 65 FR 76773, Dec. 7, 2000; 66 FR 21092, Apr. 27, 2001; 69 FR 50000, Aug. 12, 2004; 69 FR 56543, Sept. 21, 2004; 70 FR 3891, Jan. 27, 2005; 72 FR 46842, Aug. 21, 2007; 74 FR 52691, Oct. 14, 2009; 77 FR 46625, Aug. 6, 2012; 77 FR 48821, Aug. 14, 2012; 78 FR 62405, Oct. 21, 2013]

§ 1.137 Revival of abandoned application, or terminated or limited reexamination prosecution.

(a) *Revival on the basis of unintentional delay.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this section to revive an abandoned application or a reexamination prosecution terminated under § 1.550(d) or § 1.957(b) or limited under § 1.957(c).

(b) *Petition requirements.* A grantable petition pursuant to this section must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;

(2) The petition fee as set forth in §1.17(m);

(3) Any terminal disclaimer (and fee as set forth in §1.20(d)) required pursuant to paragraph (d) of this section; and

(4) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this section was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(c) *Reply*. In an application abandoned under §1.57(a), the reply must include a copy of the specification and any drawings of the previously filed application. In an application or patent abandoned for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance. In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, abandoned after the close of prosecution as defined in §1.114(b), the required reply may also be met by the filing of a request for continued examination in compliance with §1.114.

(d) *Terminal disclaimer*. (1) Any petition to revive pursuant to this section in a design application must be accompanied by a terminal disclaimer and fee as set forth in §1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application. Any petition to revive pursuant to this section in either a utility or plant application filed before June 8, 1995, must be accompanied by a terminal disclaimer and fee as set forth in §1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the lesser of:

(i) The period of abandonment of the application; or

(ii) The period extending beyond twenty years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application(s) under 35 U.S.C. 120, 121, 365(c), or 386(c) from the date on which the earliest such application was filed.

(2) Any terminal disclaimer pursuant to paragraph (d)(1) of this section must also apply to any patent granted on a continuing utility or plant application filed before June 8, 1995, or a continuing design application, that contains a specific reference under 35 U.S.C. 120, 121, 365(c), or 386(c) to the application for which revival is sought.

(3) The provisions of paragraph (d)(1) of this section do not apply to applications for which revival is sought solely for purposes of copendency with a utility or plant application filed on or after June 8, 1995, to reissue applications, or to reexamination proceedings.

(e) *Request for reconsideration.* Any request for reconsideration or review of a decision refusing to revive an abandoned application, or a terminated or limited reexamination prosecution, upon petition filed pursuant to this section, to be considered timely, must be filed within two months of the decision refusing to revive or within such time as set in the decision. Unless a decision indicates otherwise, this time period may be extended under:

(1) The provisions of §1.136 for an abandoned application;

(2) The provisions of §1.550(c) for a terminated *ex parte* reexamination prosecution, where the *ex parte* reexamination was filed under §1.510; or

(3) The provisions of §1.956 for a terminated *inter partes* reexamination prosecution or an *inter partes* reexamination limited as to further prosecution, where the *inter partes* reexamination was filed under §1.913.

(f) *Abandonment for failure to notify the Office of a foreign filing*. A nonprovisional application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to timely notify the Office of the filing of an application in a foreign country or under a multinational treaty that requires publication of applications eighteen months after filing, may be revived pursuant to this section. The

reply requirement of paragraph (c) of this section is met by the notification of such filing in a foreign country or under a multinational treaty, but the filing of a petition under this section will not operate to stay any period for reply that may be running against the application.

(g) *Provisional applications.* A provisional application, abandoned for failure to timely respond to an Office requirement, may be revived pursuant to this section. Subject to the provisions of 35 U.S.C. 119(e)(3) and §1.7(b), a provisional application will not be regarded as pending after twelve months from its filing date under any circumstances.

[78 FR 62405, Oct. 21, 2013, as amended at 80 FR 17963, Apr. 2, 2015]

§ 1.138 Express abandonment.

(a) An application may be expressly abandoned by filing a written declaration of abandonment identifying the application in the United States Patent and Trademark Office. Express abandonment of the application may not be recognized by the Office before the date of issue or publication unless it is actually received by appropriate officials in time to act.

(b) A written declaration of abandonment must be signed by a party authorized under §1.33(b)(1) or (b)(3) to sign a paper in the application, except as otherwise provided in this paragraph. A registered attorney or agent, not of record, who acts in a representative capacity under the provisions of §1.34 when filing a continuing application, may expressly abandon the prior application as of the filing date granted to the continuing application.

(c) An applicant seeking to abandon an application to avoid publication of the application (see §1.211(a)(1)) must submit a declaration of express abandonment by way of a petition under this paragraph including the fee set forth in §1.17(h) in sufficient time to permit the appropriate officials to recognize the abandonment and remove the application from the publication process. Applicants should expect that the petition will not be granted and the application will be published in regular course unless such declaration of express abandonment and petition are received by the appropriate officials more than four weeks prior to the projected date of publication.

(d) An applicant seeking to abandon an application filed under 35 U.S.C. 111(a) and §1.53(b) on or after December 8, 2004, to obtain a refund of the search fee and excess claims fee paid in the application, must submit a declaration of express abandonment by way of a petition under this paragraph before an examination has been made of the application. The date indicated on any certificate of mailing or transmission under §1.8 will not be taken into account in determining whether a petition under §1.138(d) was filed before an examination has been made of the application. If a request for refund of the search fee and excess claims fee paid in the application is not filed with the declaration of express abandonment under this paragraph or within two months from the date on which the declaration of express abandonment under this paragraph was filed, the Office may retain the entire search fee and excess claims fee paid in the application. This two-month period is not extendable. If a petition and declaration of express abandonment under this paragraph are not filed before an examination has been made of the application, the Office will not refund any part of the search fee and excess claims fee paid in the application except as provided in §1.26.

[65 FR 54674, Sept. 8, 2000, as amended at 65 FR 57058, Sept. 20, 2000; 71 FR 12284, Mar. 10, 2006; 78 FR 62406, Oct. 21, 2013]

§ 1.139 [Reserved]

JOINDER OF INVENTIONS IN ONE APPLICATION; RESTRICTION

AUTHORITY: Secs. 1.141 to 1.147 also issued under 35 U.S.C. 121.

§ 1.141 Different inventions in one national application.

(a) Two or more independent and distinct inventions may not be claimed in one national application, except that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the

claimed species and all the claims to species in excess of one are written in dependent form (§1.75) or otherwise include all the limitations of the generic claim.

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

[52 FR 20046, May 28, 1987]

§ 1.142 Requirement for restriction.

(a) If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division). Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action.

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

[24 FR 10332, Dec. 22, 1959, as amended at 62 FR 53195, Oct. 10, 1997; 72 FR 46842, Aug. 21, 2007; 74 FR 52691, Oct. 14, 2009]

§ 1.143 Reconsideration of requirement.

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

§ 1.144 Petition from requirement for restriction.

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

[62 FR 53195, Oct. 10, 1997]

§ 1.145 Subsequent presentation of claims for different invention.

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

[74 FR 52691, Oct. 14, 2009]

§ 1.146 Election of species.

In the first action on an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be allowable. However, if such application contains claims directed to more than a reasonable number of species, the examiner may require restriction of the claims to not more than a reasonable number of species before taking further action in the application.

[62 FR 53195, Oct. 10, 1997]

DESIGN PATENTS

§ 1.151 Rules applicable.

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

(35 U.S.C. 171)

§ 1.152 Design drawings.

The design must be represented by a drawing that complies with the requirements of § 1.84 and must contain a sufficient number of views to constitute a complete disclosure of the appearance of the design. Appropriate and adequate surface shading should be used to show the character or contour of the surfaces represented. Solid black surface shading is not permitted except when used to represent the color black as well as color contrast. Broken lines may be used to show visible environmental structure, but may not be used to show hidden planes and surfaces that cannot be seen through opaque materials. Alternate positions of a design component, illustrated by full and broken lines in the same view are not permitted in a design drawing. Photographs and ink drawings are not permitted to be combined as formal drawings in one application. Photographs submitted in lieu of ink drawings in design patent applications must not disclose environmental structure but must be limited to the design claimed for the article.

[65 FR 54674, Sept. 8, 2000]

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

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

(b) The inventor's oath or declaration must comply with the requirements of § 1.63, or comply with the requirements of § 1.64 for a substitute statement.

(35 U.S.C. 6, Pub. L. 97–247)

[24 FR 10332, Dec. 22, 1959, as amended at 29 FR 18503, Dec. 29, 1964; 48 FR 2712, Jan. 20, 1983; 77 FR 48821, Aug. 14, 2012]

§ 1.154 Arrangement of application elements in a design application.

(a) The elements of the design application, if applicable, should appear in the following order:

(1) Design application transmittal form.

(2) Fee transmittal form.

(3) Application data sheet (see § 1.76).

(4) Specification.

(5) Drawings or photographs.

(6) The inventor's oath or declaration (*see* § 1.153(b)).

(b) The specification should include the following sections in order:

(1) Preamble, stating the name of the applicant, title of the design, and a brief description of the nature and intended use of the article in which the design is embodied.

(2) Cross-reference to related applications (unless included in the application data sheet).

(3) Statement regarding federally sponsored research or development.

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

(5) Feature description.

(6) A single claim.

(c) The text of the specification sections defined in paragraph (b) of this section, if applicable, should be preceded by a section heading in uppercase letters without underlining or bold type.

[65 FR 54674, Sept. 8, 2000, as amended at 77 FR 48821, Aug. 14, 2012]

§ 1.155 Expedited examination of design applications.

(a) The applicant may request that the Office expedite the examination of a design application. To qualify for expedited examination:

(1) The application must include drawings in compliance with § 1.84, or for an international design application that designates the United States, must have been published pursuant to Hague Agreement Article 10(3);

(2) The applicant must have conducted a preexamination search; and

(3) The applicant must file a request for expedited examination including:

(i) The fee set forth in §1.17(k); and

(ii) A statement that a preexamination search was conducted. The statement must also indicate the field of search and include an information disclosure statement in compliance with §1.98.

(b) The Office will not examine an application that is not in condition for examination (*e.g.*, missing basic filing fee) even if the applicant files a request for expedited examination under this section.

[65 FR 54674, Sept. 8, 2000, as amended at 80 FR 17963, Apr. 2, 2015]

PLANT PATENTS

§ 1.161 Rules applicable.

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

§ 1.162 Applicant, oath or declaration.

The inventor named for a plant patent application must be the person who has invented or discovered and asexually reproduced the new and distinct variety of plant for which a patent is sought. The inventor's oath or declaration, in addition to the averments required by §1.63 or §1.64, must state that the inventor has asexually reproduced the plant. Where the plant is a newly found plant, the inventor's oath or declaration must also state that it was found in a cultivated area.

[77 FR 48821, Aug. 14, 2012]

§ 1.163 Specification and arrangement of application elements in a plant application.

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

(b) The elements of the plant application, if applicable, should appear in the following order:

(1) Plant application transmittal form.

(2) Fee transmittal form.

(3) Application data sheet (see §1.76).

(4) Specification.

(5) Drawings (in duplicate).

(6) The inventor's oath or declaration (§1.162).

(c) The specification should include the following sections in order:

(1) Title of the invention, which may include an introductory portion stating the name, citizenship, and residence of the applicant.

(2) Cross-reference to related applications (unless included in the application data sheet).

(3) Statement regarding federally sponsored research or development.

(4) Latin name of the genus and species of the plant claimed.

(5) Variety denomination.

(6) Background of the invention.

(7) Brief summary of the invention.

(8) Brief description of the drawing.

(9) Detailed botanical description.

(10) A single claim.

(11) Abstract of the disclosure.

(d) The text of the specification or sections defined in paragraph (c) of this section, if applicable, should be preceded by a section heading in upper case, without underlining or bold type.

[65 FR 54675, Sept. 8, 2000, as amended at 77 FR 48821, Aug. 14, 2012]

§ 1.164 Claim.

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

(35 U.S.C. 162)

§ 1.165 Plant drawings.

(a) Plant patent drawings should be artistically and competently executed and must comply with the requirements of §1.84. View numbers and reference characters need not be employed unless required by the examiner. The drawing must disclose all the

distinctive characteristics of the plant capable of visual representation.

(b) The drawings may be in color. The drawing must be in color if color is a distinguishing characteristic of the new variety. Two copies of color drawings or photographs must be submitted.

[58 FR 38726, July 20, 1993, as amended at 65 FR 57058, Sept. 20, 2000; 69 FR 56543, Sept. 21, 2004]

§ 1.166 Specimens.

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

(35 U.S.C. 114, 161)

§ 1.167 Examination.

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

[62 FR 53196, Oct. 10, 1997]

REISSUES

AUTHORITY: Secs. 1.171 to 1.179 also issued under 35 U.S.C. 251.

§ 1.171 Application for reissue.

An application for reissue must contain the same parts required for an application for an original patent, complying with all the rules relating thereto except as otherwise provided, and in addition, must comply with the requirements of the rules relating to reissue applications.

[62 FR 53196, Oct. 10, 1997]

§ 1.172 Reissue applicant.

(a) The reissue applicant is the original patentee, or the current patent owner if there has been an assignment. A reissue application must be accompanied by the written consent of all assignees, if any, currently owning an undivided interest in the patent. All assignees consenting to the reissue must establish their ownership in the patent by filing in the reissue application a submission in accordance with the provisions of § 3.73(c) of this chapter.

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

[77 FR 48821, Aug. 14, 2012]

§ 1.173 Reissue specification, drawings, and amendments.

(a) *Contents of a reissue application.* An application for reissue must contain the entire specification, including the claims, and the drawings of the patent. No new matter shall be introduced into the application. No reissue patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent, pursuant to 35 U.S.C. 251.

(1) *Specification, including claims.* The entire specification, including the claims, of the patent for which reissue is requested must be furnished in the form of a copy of the printed patent, in double column format, each page on only one side of a single sheet of paper. If an amendment of the reissue application is to be included, it must be made pursuant to paragraph (b) of this section. The formal requirements for papers making up the reissue application other than those set forth in this section are set out in § 1.52. Additionally, a copy of any disclaimer (§ 1.321), certificate of correction (§§ 1.322 through 1.324), or reexamination certificate (§ 1.570) issued in the patent must be included. (See also § 1.178).

(2) *Drawings.* Applicant must submit a clean copy of each drawing sheet of the printed patent at the time the reissue application is filed. If such copy complies with § 1.84, no further drawings will be required. Where a drawing of the reissue application is to include any changes relative to the patent being reissued, the changes to the drawing must be made in accordance with paragraph (b)(3) of this section. The Office will not transfer the drawings from the patent file to the reissue application.

(b) *Making amendments in a reissue application.* An amendment in a reissue

application is made either by physically incorporating the changes into the specification when the application is filed, or by a separate amendment paper. If amendment is made by incorporation, markings pursuant to paragraph (d) of this section must be used. If amendment is made by an amendment paper, the paper must direct that specified changes be made, as follows:

(1) *Specification other than the claims, ''Large Tables'' (§1.58(c)), a ''Computer Program Listing Appendix'' (§1.96(c)), a ''Sequence Listing'' (§1.821(c)), or a ''Sequence Listing XML'' (§1.831(a)).* (i) Changes to the specification, other than to the claims, ''Large Tables'' (§1.58(c)), a ''Computer Program Listing Appendix'' (§1.96(c)), a ''Sequence Listing'' (§1.821(c)), or a ''Sequence Listing XML'' (§1.831(a)), must be made by submission of the entire text of an added or rewritten paragraph, including markings pursuant to paragraph (d) of this section, except that an entire paragraph may be deleted by a statement deleting the paragraph, without presentation of the text of the paragraph. The precise point in the specification where any added or rewritten paragraph is located must be identified.

(ii) Changes to ''Large Tables,'' a ''Computer Program Listing Appendix,'' a ''Sequence Listing,'' or a ''Sequence Listing XML'' must be made in accordance with §1.58(g) for ''Large Tables,'' §1.96(c)(5) for a ''Computer Program Listing Appendix,'' §1.825 for a ''Sequence Listing,'' and §1.835 for a ''Sequence Listing XML.''

(2) *Claims.* An amendment paper must include the entire text of each claim being changed by such amendment paper and of each claim being added by such amendment paper. For any claim changed by the amendment paper, a parenthetical expression ''amended,'' ''twice amended,'' etc., should follow the claim number. Each changed patent claim and each added claim must include markings pursuant to paragraph (d) of this section, except that a patent claim or added claim should be canceled by a statement canceling the claim without presentation of the text of the claim.

(3) *Drawings.* One or more patent drawings shall be amended in the following manner: Any changes to a patent drawing must be submitted as a replacement sheet of drawings which shall be an attachment to the amendment document. Any replacement sheet of drawings must be in compliance with §1.84 and shall include all of the figures appearing on the original version of the sheet, even if only one figure is amended. Amended figures must be identified as ''Amended,'' and any added figure must be identified as ''New.'' In the event that a figure is canceled, the figure must be surrounded by brackets and identified as ''Canceled.'' All changes to the drawing(s) shall be explained, in detail, beginning on a separate sheet accompanying the papers including the amendment to the drawings.

(i) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be included. The marked-up copy must be clearly labeled as ''Annotated Marked-up Drawings'' and must be presented in the amendment or remarks section that explains the change to the drawings.

(ii) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.

(c) *Status of claims and support for claim changes.* Whenever there is an amendment to the claims pursuant to paragraph (b) of this section, there must also be supplied, on pages separate from the pages containing the changes, the status (*i.e.*, pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes made to the claims.

(d) *Changes shown by markings.* Any changes relative to the patent being reissued that are made to the specification, including the claims but excluding ''Large Tables'' (§1.58(c)), a ''Computer Program Listing Appendix'' (§1.96(c)), a ''Sequence Listing'' (§1.821(c)), and a ''Sequence Listing XML'' (§1.831(a)) upon filing or by an amendment paper in the reissue application, must include the following markings:

(1) The matter to be omitted by reissue must be enclosed in brackets; and

(2) The matter to be added by reissue must be underlined.

(e) *Numbering of patent claims preserved.* Patent claims may not be renumbered. The numbering of any claim added in the reissue application must follow the number of the highest numbered patent claim.

(f) *Amendment of disclosure may be required.* The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(g) *Amendments made relative to the patent.* All amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing of the reissue application.

[65 FR 54675, Sept. 8, 2000, as amended at 68 FR 38630, June 30, 2003; 69 FR 56543, Sept. 21, 2004; 86 FR 57048, Oct. 14, 2021; 87 FR 30817, May 20, 2022]

§ 1.174 [Reserved]

§ 1.175 Inventor's oath or declaration for a reissue application.

(a) The inventor's oath or declaration for a reissue application, in addition to complying with the requirements of § 1.63, § 1.64, or § 1.67, must also specifically identify at least one error pursuant to 35 U.S.C. 251 being relied upon as the basis for reissue and state that the applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent.

(b) If the reissue application seeks to enlarge the scope of the claims of the patent (a basis for the reissue is the patentee claiming less than the patentee had the right to claim in the patent), the inventor's oath or declaration for a reissue application must identify a claim that the application seeks to broaden. A claim is a broadened claim if the claim is broadened in any respect.

(c) The inventor, or each individual who is a joint inventor of a claimed invention, in a reissue application must execute an oath or declaration for the reissue application, except as provided for in § 1.64, and except that the inventor's oath or declaration for a reissue application may be signed by the assignee of the entire interest if:

(1) The application does not seek to enlarge the scope of the claims of the original patent; or

(2) The application for the original patent was filed under § 1.46 by the assignee of the entire interest.

(d) If errors previously identified in the inventor's oath or declaration for a reissue application pursuant to paragraph (a) of this section are no longer being relied upon as the basis for reissue, the applicant must identify an error being relied upon as the basis for reissue.

(e) The inventor's oath or declaration for a reissue application required by paragraph (a) of this section may be submitted under the provisions of § 1.53(f), except that the provisions of § 1.53(f)(3) do not apply to a reissue application.

(f)(1) The requirement for the inventor's oath or declaration for a continuing reissue application that claims the benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) in compliance with § 1.78 of an earlier-filed reissue application may be satisfied by a copy of the inventor's oath or declaration from the earlier-filed reissue application, provided that:

(i) The inventor, or each individual who is a joint inventor of a claimed invention, in the reissue application executed an inventor's oath or declaration for the earlier-filed reissue application, except as provided for in § 1.64;

(ii) The continuing reissue application does not seek to enlarge the scope of the claims of the original patent; or

(iii) The application for the original patent was filed under § 1.46 by the assignee of the entire interest.

(2) If all errors identified in the inventor's oath or declaration from the earlier-filed reissue application are no longer being relied upon as the basis for reissue, the applicant must identify an error being relied upon as the basis for reissue.

(g) An oath or declaration filed at any time pursuant to 35 U.S.C. 115(h)(1), will be placed in the file record of the reissue application, but may not necessarily be reviewed by the Office.

[77 FR 48821, Aug. 14, 2012, as amended at 80 FR 17964, Apr. 2, 2015]

§ 1.176 Examination of reissue.

(a) A reissue application will be examined in the same manner as a non-reissue, non-provisional application, and will be subject to all the requirements of the rules related to non-reissue applications. Applications for reissue will be acted on by the examiner in advance of other applications.

(b) Restriction between subject matter of the original patent claims and previously unclaimed subject matter may be required (restriction involving only subject matter of the original patent claims will not be required). If restriction is required, the subject matter of the original patent claims will be held to be constructively elected unless a disclaimer of all the patent claims is filed in the reissue application, which disclaimer cannot be withdrawn by applicant.

[65 FR 54676, Sept. 8, 2000]

§ 1.177 Issuance of multiple reissue patents.

(a) The Office may reissue a patent as multiple reissue patents. If applicant files more than one application for the reissue of a single patent, each such application must contain or be amended to contain in the first sentence of the specification a notice stating that more than one reissue application has been filed and identifying each of the reissue applications by relationship, application number and filing date. The Office may correct by certificate of correction under §1.322 any reissue patent resulting from an application to which this paragraph applies that does not contain the required notice.

(b) If applicant files more than one application for the reissue of a single patent, each claim of the patent being reissued must be presented in each of the reissue applications as an amended, unamended, or canceled (shown in brackets) claim, with each such claim bearing the same number as in the patent being reissued. The same claim of the patent being reissued may not be presented in its original unamended form for examination in more than one of such multiple reissue applications. The numbering of any added claims in any of the multiple reissue applications must follow the number of the highest numbered original patent claim.

(c) If any one of the several reissue applications by itself fails to correct an error in the original patent as required by 35 U.S.C. 251 but is otherwise in condition for allowance, the Office may suspend action in the allowable application until all issues are resolved as to at least one of the remaining reissue applications. The Office may also merge two or more of the multiple reissue applications into a single reissue application. No reissue application containing only unamended patent claims and not correcting an error in the original patent will be passed to issue by itself.

[65 FR 54676, Sept. 8, 2000]

§ 1.178 Original patent; continuing duty of applicant.

(a) The application for reissue of a patent shall constitute an offer to surrender that patent, and the surrender shall take effect upon reissue of the patent. Until a reissue application is granted, the original patent shall remain in effect.

(b) In any reissue application before the Office, the applicant must call to the attention of the Office any prior or concurrent proceedings in which the patent (for which reissue is requested) is or was involved, such as interferences or trials before the Patent Trial and Appeal Board, reissues, reexaminations, or litigations and the results of such proceedings (see also §1.173(a)(1)).

[65 FR 54676, Sept. 8, 2000, as amended at 69 FR 56544, Sept. 21, 2004; 77 FR 46625, Aug. 6, 2012]

§ 1.179 [Reserved]

PETITIONS AND ACTION BY THE DIRECTOR

AUTHORITY: 35 U.S.C. 6; 15 U.S.C. 1113, 1123.

§ 1.181 Petition to the Director.

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Patent Trial and Appeal Board or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Patent Trial and Appeal Board, see § 41.3 of this title.

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

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

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

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

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

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

[24 FR 10332, Dec. 22, 1959, as amended at 34 FR 18857, Nov. 26, 1969; 47 FR 41278, Sept. 17, 1982; 49 FR 48452, Dec. 12, 1984; 65 FR 54676, Sept. 8, 2000; 65 FR 76774, Dec. 7, 2000; 69 FR 50000, Aug. 12, 2004; 77 FR 46625, Aug. 6, 2012]

§ 1.182 Questions not specifically provided for.

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

[69 FR 56544, Sept. 21, 2004]

§ 1.183 Suspension of rules.

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

[69 FR 56544, Sept. 21, 2004]

§ 1.184 [Reserved]

APPEAL TO THE PATENT TRIAL AND APPEAL BOARD

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

§ 1.191 Appeal to Patent Trial and Appeal Board.

Appeals to the Patent Trial and Appeal Board under 35 U.S.C. 134(a) and

(b) are conducted according to part 41 of this title.

[77 FR 46625, Aug. 6, 2012]

§§ 1.192–1.196 [Reserved]

§ 1.197 Termination of proceedings.

(a) Proceedings on an application are considered terminated by the dismissal of an appeal or the failure to timely file an appeal to the court or a civil action except:

(1) Where claims stand allowed in an application; or

(2) Where the nature of the decision requires further action by the examiner.

(b) The date of termination of proceedings on an application is the date on which the appeal is dismissed or the date on which the time for appeal to the U.S. Court of Appeals for the Federal Circuit or review by civil action (§90.3 of this chapter) expires in the absence of further appeal or review. If an appeal to the U.S. Court of Appeals for the Federal Circuit or a civil action has been filed, proceedings on an application are considered terminated when the appeal or civil action is terminated. A civil action is terminated when the time to appeal the judgment expires. An appeal to the U.S. Court of Appeals for the Federal Circuit, whether from a decision of the Board or a judgment in a civil action, is terminated when the mandate is issued by the Court.

[78 FR 75252, Dec. 11, 2013]

§ 1.198 Reopening after a final decision of the Patent Trial and Appeal Board.

When a decision by the Patent Trial and Appeal Board on appeal has become final for judicial review, prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner except under the provisions of §1.114 or §41.50 of this title without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

[77 FR 46625, Aug. 6, 2012]

PUBLICATION OF APPLICATIONS

SOURCE: 65 FR 57058, Sept. 20, 2000, unless otherwise noted.

§ 1.211 Publication of applications.

(a) Each U.S. national application for patent filed in the Office under 35 U.S.C. 111(a) and each international application in compliance with 35 U.S.C. 371 will be published promptly after the expiration of a period of eighteen months from the earliest filing date for which a benefit is sought under title 35, United States Code, unless:

(1) The application is recognized by the Office as no longer pending;

(2) The application is national security classified (see §5.2(c)), subject to a secrecy order under 35 U.S.C. 181, or under national security review;

(3) The application has issued as a patent in sufficient time to be removed from the publication process; or

(4) The application was filed with a nonpublication request in compliance with §1.213(a).

(b) Provisional applications under 35 U.S.C. 111(b) shall not be published, and design applications under 35 U.S.C. chapter 16, international design applications under 35 U.S.C. chapter 38, and reissue applications under 35 U.S.C. chapter 25 shall not be published under this section.

(c) An application filed under 35 U.S.C. 111(a) will not be published until it includes the basic filing fee (§1.16(a) or (c)) and any English translation required by §1.52(d). The Office may delay publishing any application until it includes any application size fee required by the Office under §1.16(s) or §1.492(j), a specification having papers in compliance with §1.52 and an abstract (§1.72(b)), drawings in compliance with §1.84, a ''Sequence Listing'' in compliance with §§1.821 through 1.825 (if applicable) for an application filed before July 1, 2022, a ''Sequence Listing XML'' in compliance with §§1.831 through 1.835 (if applicable) for an application filed on or after July 1, 2022, and the inventor's oath or declaration or application data sheet containing the information specified in §1.63(b).

(d) The Office may refuse to publish an application, or to include a portion

of an application in the patent application publication (§1.215), if publication of the application or portion thereof would violate Federal or state law, or if the application or portion thereof contains offensive or disparaging material.

(e) The publication fee set forth in §1.18(d) must be paid in each application published under this section before the patent will be granted. If an application is subject to publication under this section, the sum specified in the notice of allowance under §1.311 will also include the publication fee which must 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. If the application is not published under this section, the publication fee (if paid) will be refunded.

[65 FR 57058, Sept. 20, 2000, as amended at 70 FR 3891, Jan. 27, 2005; 77 FR 48822, Aug. 14, 2012, as amended at 80 FR 17964, Apr. 2, 2015; 87 FR 30817, May 20, 2022]

§ 1.213 Nonpublication request.

(a) If the invention disclosed in an application has not been and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing, the application will not be published under 35 U.S.C. 122(b) and §1.211 provided:

(1) A request (nonpublication request) is submitted with the application upon filing;

(2) The request states in a conspicuous manner that the application is not to be published under 35 U.S.C. 122(b);

(3) The request contains a certification that the invention disclosed in the application has not been and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication at eighteen months after filing; and

(4) The request is signed in compliance with §1.33(b).

(b) The applicant may rescind a nonpublication request at any time. A request to rescind a nonpublication request under paragraph (a) of this section must:

(1) Identify the application to which it is directed;

(2) State in a conspicuous manner that the request that the application is not to be published under 35 U.S.C. 122(b) is rescinded; and

(3) Be signed in compliance with §1.33(b).

(c) If an applicant who has submitted a nonpublication request under paragraph (a) of this section subsequently files an application directed to the invention disclosed in the application in which the nonpublication request was submitted in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing, the applicant must notify the Office of such filing within forty-five days after the date of the filing of such foreign or international application. The failure to timely notify the Office of the filing of such foreign or international application shall result in abandonment of the application in which the nonpublication request was submitted (35 U.S.C. 122(b)(2)(B)(iii)).

§ 1.215 Patent application publication.

(a) The publication of an application under 35 U.S.C. 122(b) shall include a patent application publication. The date of publication shall be indicated on the patent application publication. The patent application publication will be based upon the specification and drawings deposited on the filing date of the application, as well as the application data sheet and/or the inventor's oath or declaration. The patent application publication may also be based upon amendments to the specification (other than the abstract or the claims) that are reflected in a substitute specification under §1.125(b), amendments to the abstract under §1.121(b), amendments to the claims that are reflected in a complete claim listing under §1.121(c), and amendments to the drawings under §1.121(d), provided that such substitute specification or amendment is submitted in sufficient time to be entered into the Office file wrapper of

the application before technical preparations for publication of the application have begun. Technical preparations for publication of an application generally begin four months prior to the projected date of publication. The patent application publication of an application that has entered the national stage under 35 U.S.C. 371 may also include amendments made during the international stage. *See* paragraph (c) of this section for publication of an application based upon a copy of the application submitted via the USPTO patent electronic filing system.

(b) The patent application publication will include the name of the assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter if that information is provided in the application data sheet in an application filed under §1.46. Assignee information may be included on the patent application publication in other applications if the assignee information is provided in an application data sheet submitted in sufficient time to be entered into the Office file wrapper of the application before technical preparations for publication of the application have begun. Providing assignee information in the application data sheet does not substitute for compliance with any requirement of part 3 of this chapter to have an assignment recorded by the Office.

(c) At applicant's option, the patent application publication will be based upon the copy of the application (specification, drawings, and the application data sheet and/or the inventor's oath or declaration) as amended, provided that applicant supplies such a copy in compliance with the USPTO patent electronic filing system requirements within one month of the mailing date of the first Office communication that includes a confirmation number for the application, or fourteen months of the earliest filing date for which a benefit is sought under title 35, United States Code, whichever is later.

(d) If the copy of the application submitted pursuant to paragraph (c) of this section does not comply with the USPTO patent electronic filing system requirements, the Office will publish the application as provided in paragraph (a) of this section. If, however, the Office has not started the publication process, the Office may use an untimely filed copy of the application supplied by the applicant under paragraph (c) of this section in creating the patent application publication.

[65 FR 57058, Sept. 20, 2000, as amended at 69 FR 56544, Sept. 21, 2004; 77 FR 48822, Aug. 14, 2012]

§1.217 Publication of a redacted copy of an application.

(a) If an applicant has filed applications in one or more foreign countries, directly or through a multilateral international agreement, and such foreign-filed applications or the description of the invention in such foreign-filed applications is less extensive than the application or description of the invention in the application filed in the Office, the applicant may submit a redacted copy of the application filed in the Office for publication, eliminating any part or description of the invention that is not also contained in any of the corresponding applications filed in a foreign country. The Office will publish the application as provided in §1.215(a) unless the applicant files a redacted copy of the application in compliance with this section within sixteen months after the earliest filing date for which a benefit is sought under title 35, United States Code.

(b) The redacted copy of the application must be submitted in compliance with the USPTO patent electronic filing system requirements. The title of the invention in the redacted copy of the application must correspond to the title of the application at the time the redacted copy of the application is submitted to the Office. If the redacted copy of the application does not comply with the USPTO patent electronic filing system requirements, the Office will publish the application as provided in §1.215(a).

(c) The applicant must also concurrently submit in paper (§1.52(a)) to be filed in the application:

(1) A certified copy of each foreign-filed application that corresponds to the application for which a redacted copy is submitted;

(2) A translation of each such foreign-filed application that is in a language other than English, and a statement that the translation is accurate;

(3) A marked-up copy of the application showing the redactions in brackets; and

(4) A certification that the redacted copy of the application eliminates only the part or description of the invention that is not contained in any application filed in a foreign country, directly or through a multilateral international agreement, that corresponds to the application filed in the Office.

(d) The Office will provide a copy of the complete file wrapper and contents of an application for which a redacted copy was submitted under this section to any person upon written request pursuant to §1.14(c)(2), unless applicant complies with the requirements of paragraphs (d)(1), (d)(2), and (d)(3) of this section.

(1) Applicant must accompany the submission required by paragraph (c) of this section with the following:

(i) A copy of any Office correspondence previously received by applicant including any desired redactions, and a second copy of all Office correspondence previously received by applicant showing the redacted material in brackets; and

(ii) A copy of each submission previously filed by the applicant including any desired redactions, and a second copy of each submission previously filed by the applicant showing the redacted material in brackets.

(2) In addition to providing the submission required by paragraphs (c) and (d)(1) of this section, applicant must:

(i) Within one month of the date of mailing of any correspondence from the Office, file a copy of such Office correspondence including any desired redactions, and a second copy of such Office correspondence showing the redacted material in brackets; and

(ii) With each submission by the applicant, include a copy of such submission including any desired redactions, and a second copy of such submission showing the redacted material in brackets.

(3) Each submission under paragraph (d)(1) or (d)(2) of this paragraph must also be accompanied by the processing fee set forth in §1.17(i) and a certification that the redactions are limited to the elimination of material that is relevant only to the part or description of the invention that was not contained in the redacted copy of the application submitted for publication.

(e) The provisions of §1.8 do not apply to the time periods set forth in this section.

§ 1.219 Early publication.

Applications that will be published under §1.211 may be published earlier than as set forth in §1.211(a) at the request of the applicant. Any request for early publication must be accompanied by the publication fee set forth in §1.18(d). If the applicant does not submit a copy of the application in compliance with the USPTO patent electronic filing system requirements pursuant to §1.215(c), the Office will publish the application as provided in §1.215(a). No consideration will be given to requests for publication on a certain date, and such requests will be treated as a request for publication as soon as possible.

§ 1.221 Voluntary publication or republication of patent application publication.

(a) Any request for publication of an application filed before, but pending on, November 29, 2000, and any request for republication of an application previously published under §1.211, must include a copy of the application in compliance with the USPTO patent electronic filing system requirements and be accompanied by the publication fee set forth in §1.18(d) and the processing fee set forth in §1.17(i). If the request does not comply with the requirements of this paragraph or the copy of the application does not comply with the USPTO patent electronic filing system requirements, the Office will not publish the application and will refund the publication fee.

(b) The Office will grant a request for a corrected or revised patent application publication other than as provided in paragraph (a) of this section only when the Office makes a material mistake which is apparent from Office records. Any request for a corrected or revised patent application publication

other than as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable.

MISCELLANEOUS PROVISIONS

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

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

(1) By delivering a copy of the paper to the person served;

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

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

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

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

(b) Papers filed in the Patent and Trademark Office which are required to be served shall contain proof of service. Proof of service may appear on or be affixed to papers filed. Proof of service shall include the date and manner of service. In the case of personal service, proof of service shall also include the name of any person served, certified by the person who made service. Proof of service may be made by:

(1) An acknowledgement of service by or on behalf of the person served or

(2) A statement signed by the attorney or agent containing the information required by this section.

(c) See §41.106(e) or §42.6(e) of this title for service of papers in contested cases or trials before the Patent Trial and Appeal Board.

[46 FR 29184, May 29, 1981, as amended at 49 FR 48454, Dec. 12, 1984; 69 FR 50000, Aug. 12, 2004; 69 FR 58260, Sept. 30, 2004; 77 FR 46626, Aug. 6, 2012]

§ 1.251 Unlocatable file.

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

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

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

(ii) A list of such correspondence; and

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

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

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

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

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

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

[65 FR 69451, Nov. 17, 2000]

PREISSUANCE SUBMISSIONS AND PROTESTS BY THIRD PARTIES

§ 1.290 Submissions by third parties in applications.

(a) A third party may submit, for consideration and entry in the record of a patent application, any patents, published patent applications, or other printed publications of potential relevance to the examination of the application if the submission is made in accordance with 35 U.S.C. 122(e) and this section. A third-party submission may not be entered or considered by the Office if any part of the submission is not in compliance with 35 U.S.C. 122(e) and this section.

(b) Any third-party submission under this section must be filed prior to the earlier of:

(1) The date a notice of allowance under §1.311 is given or mailed in the application; or

(2) The later of:

(i) Six months after the date on which the application is first published by the Office under 35 U.S.C. 122(b) and §1.211, or

(ii) The date the first rejection under §1.104 of any claim by the examiner is given or mailed during the examination of the application.

(c) Any third-party submission under this section must be made in writing.

(d) Any third-party submission under this section must include:

(1) A document list identifying the documents, or portions of documents, being submitted in accordance with paragraph (e) of this section;

(2) A concise description of the asserted relevance of each item identified in the document list;

(3) A legible copy of each item identified in the document list, other than U.S. patents and U.S. patent application publications;

(4) An English language translation of any non-English language item identified in the document list; and

(5) A statement by the party making the submission that:

(i) The party is not an individual who has a duty to disclose information with respect to the application under §1.56; and

(ii) The submission complies with the requirements of 35 U.S.C. 122(e) and this section.

(e) The document list required by paragraph (d)(1) of this section must include a heading that identifies the list as a third-party submission under §1.290, identify on each page of the list the application number of the application in which the submission is being filed, list U.S. patents and U.S. patent application publications in a separate section from other items, and identify each:

(1) U.S. patent by patent number, first named inventor, and issue date;

(2) U.S. patent application publication by patent application publication number, first named inventor, and publication date;

(3) Foreign patent or published foreign patent application by the country or patent office that issued the patent or published the application; the applicant, patentee, or first named inventor; an appropriate document number; and the publication date indicated on the patent or published application; and

(4) Non-patent publication by author (if any), title, pages being submitted, publication date, and, where available, publisher and place of publication. If no publication date is known, the third party must provide evidence of publication.

(f) Any third-party submission under this section must be accompanied by the fee set forth in §1.17(o) for every ten items or fraction thereof identified in the document list.

(g) The fee otherwise required by paragraph (f) of this section is not required for a submission listing three or fewer total items that is accompanied by a statement by the party making the submission that, to the knowledge of the person signing the statement after making reasonable inquiry, the submission is the first and only submission under 35 U.S.C. 122(e) filed in the application by the party or a party in privity with the party.

(h) In the absence of a request by the Office, an applicant need not reply to a submission under this section.

(i) The provisions of §1.8 do not apply to the time periods set forth in this section.

[77 FR 42173, July 17, 2012, as amended at 78 FR 62406, Oct. 21, 2013]

§1.291 Protests by the public against pending applications.

(a) A protest may be filed by a member of the public against a pending application, and it will be matched with the application file if it adequately identifies the patent application. A protest submitted within the time frame of paragraph (b) of this section, which is not matched, or not matched in a timely manner to permit review by the examiner during prosecution, due to inadequate identification, may not be entered and may be returned to the protestor where practical, or, if return is not practical, discarded.

(b) The protest will be entered into the record of the application if, in addition to complying with paragraph (c) of this section, the protest has been served upon the applicant in accordance with §1.248, or filed with the Office in duplicate in the event service is not possible; and, except for paragraph (b)(1) of this section, the protest was filed prior to the date the application was published under §1.211, or the date a notice of allowance under §1.311 was given or mailed, whichever occurs first:

(1) If a protest is accompanied by the written consent of the applicant, the protest will be considered if the protest is filed prior to the date a notice of allowance under §1.311 is given or mailed in the application.

(2) A statement must accompany a protest that it is the first protest submitted in the application by the real party in interest who is submitting the protest; or the protest must comply with paragraph (c)(5) of this section. This section does not apply to the first protest filed in an application.

(c) In addition to compliance with paragraphs (a) and (b) of this section, a protest must include:

(1) An information list of the documents, portions of documents, or other information being submitted, where each:

(i) U.S. patent is identified by patent number, first named inventor, and issue date;

(ii) U.S. patent application publication is identified by patent application publication number, first named inventor, and publication date;

(iii) Foreign patent or published foreign patent application is identified by the country or patent office that issued the patent or published the application; an appropriate document number; the applicant, patentee, or first named inventor; and the publication date indicated on the patent or published application;

(iv) Non-patent publication is identified by author (if any), title, pages being submitted, publication date, and, where available, publisher and place of publication; and

(v) Item of other information is identified by date, if known.

(2) A concise explanation of the relevance of each item identified in the information list pursuant to paragraph (c)(1) of this section;

(3) A legible copy of each item identified in the information list, other than U.S. patents and U.S. patent application publications;

(4) An English language translation of any non-English language item identified in the information list; and

(5) If it is a second or subsequent protest by the same real party in interest, an explanation as to why the issue(s) raised in the second or subsequent protest are significantly different than those raised earlier and why the significantly different issue(s) were not presented earlier, and a processing fee under §1.17(i) must be submitted.

(d) A member of the public filing a protest in an application under this section will not receive any communication from the Office relating to the

protest, other than the return of a self-addressed postcard which the member of the public may include with the protest in order to receive an acknowledgment by the Office that the protest has been received. The limited involvement of the member of the public filing a protest pursuant to this section ends with the filing of the protest, and no further submission on behalf of the protestor will be considered, unless the submission is made pursuant to paragraph (c)(5) of this section.

(e) Where a protest raising inequitable conduct issues satisfies the provisions of this section for entry, it will be entered into the application file, generally without comment on the inequitable conduct issues raised in it.

(f) In the absence of a request by the Office, an applicant need not reply to a protest.

(g) Protests that fail to comply with paragraphs (b) or (c) of this section may not be entered, and if not entered, will be returned to the protestor, or discarded, at the option of the Office.

[69 FR 56544, Sept. 21, 2004, as amended at 77 FR 42173, July 17, 2012]

§§ 1.292–1.297 [Reserved]

Review of Patent and Trademark Office Decisions by Court

§§ 1.301–1.304 [Reserved]

Allowance and Issue of Patent

§ 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 and any required publication fee (§1.211(e)), which issue fee and any required publication fee 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.

[65 FR 57060, Sept. 20, 2000, as amended at 66 FR 67096, Dec. 28, 2001; 69 FR 56545, Sept. 21, 2004; 78 FR 62406, Oct. 21, 2013]

§ 1.312 Amendments after allowance.

No amendment may be made as a matter of right in an application after the mailing of the notice of allowance. Any amendment filed pursuant to this section must be filed before or with the payment of the issue fee, and may be entered on the recommendation of the primary examiner, approved by the Director, without withdrawing the application from issue.

[65 FR 14873, Mar. 20, 2000]

§ 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 an interference or derivation proceeding.

(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.

[65 FR 14873, Mar. 20, 2000, as amended at 65 FR 50105, Aug. 16, 2000; 77 FR 46626, Aug. 6, 2012]

§ 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.

[65 FR 54677, Sept. 8, 2000]

§ 1.315 [Reserved]

§ 1.316 Application abandoned for failure to pay issue fee.

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

[62 FR 53198, Oct. 10, 1997]

§§ 1.317–1.318 [Reserved]

DISCLAIMER

§ 1.321 Statutory disclaimers, including terminal disclaimers.

(a) A patentee owning the whole or any sectional interest in a patent may disclaim any complete claim or claims in a patent. In like manner any patentee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted. Such disclaimer is binding upon the grantee and its successors or assigns. A notice of the disclaimer is published in the *Official Gazette* and attached to the printed copies of the specification. The disclaimer, to be recorded in the Patent and Trademark Office, must:

(1) Be signed by the patentee, or an attorney or agent of record;

(2) Identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term will be refused recordation;

(3) State the present extent of patentee's ownership interest in the patent; and

(4) Be accompanied by the fee set forth in §1.20(d).

(b) An applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of a patent to be granted. Such terminal disclaimer is binding upon the grantee and its successors or assigns. The terminal disclaimer, to be recorded in the Patent and Trademark Office, must:

(1) Be signed by the applicant or an attorney or agent of record;

(2) Specify the portion of the term of the patent being disclaimed;

(3) State the present extent of applicant's ownership interest in the patent to be granted; and

(4) Be accompanied by the fee set forth in §1.20(d).

(c) A terminal disclaimer, when filed to obviate judicially created double patenting in a patent application or in a reexamination proceeding except as

provided for in paragraph (d) of this section, must:

(1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;

(2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding; and

(3) Include a provision that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the judicially created double patenting.

(d) A terminal disclaimer, when filed in a patent application or in a reexamination proceeding to obviate double patenting based upon a patent or application that is not commonly owned but was disqualified as prior art as set forth in either §1.104(c)(4)(ii) or (c)(5)(ii) as the result of activities undertaken within the scope of a joint research agreement, must:

(1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;

(2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or be signed in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding; and

(3) Include a provision waiving the right to separately enforce any patent granted on that application or any patent subject to the reexamination proceeding and the patent or any patent granted on the application which formed the basis for the double patenting, and that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent and the patent, or any patent granted on the application, which formed the basis for the double patenting are not separately enforced.

[58 FR 54510, Oct. 22, 1993, as amended at 61 FR 42807, Aug. 19, 1996; 70 FR 1824, Jan. 11, 2005; 70 FR 54266, Sept. 14, 2005; 77 FR 48822, Aug. 14, 2012; 78 FR 11059, Feb. 14, 2013]

CORRECTION OF ERRORS IN PATENT

§1.322 Certificate of correction of Office mistake.

(a)(1) The Director may issue a certificate of correction pursuant to 35 U.S.C. 254 to correct a mistake in a patent, incurred through the fault of the Office, which mistake is clearly disclosed in the records of the Office:

(i) At the request of the patentee or the patentee's assignee;

(ii) Acting *sua sponte* for mistakes that the Office discovers; or

(iii) Acting on information about a mistake supplied by a third party.

(2)(i) There is no obligation on the Office to act on or respond to a submission of information or request to issue a certificate of correction by a third party under paragraph (a)(1)(iii) of this section.

(ii) Papers submitted by a third party under this section will not be made of record in the file that they relate to nor be retained by the Office.

(3) If the request relates to a patent involved in an interference or trial before the Patent Trial and Appeal Board, the request must comply with the requirements of this section and be accompanied by a motion under §41.121(a)(2), §41.121(a)(3), or §42.20 of this title.

(4) The Office will not issue a certificate of correction under this section without first notifying the patentee (including any assignee of record) at the correspondence address of record as specified in §1.33(a) and affording the patentee or an assignee an opportunity to be heard.

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

(35 U.S.C. 254)

[24 FR 10332, Dec. 22, 1959, as amended at 49 FR 48454, Dec. 12, 1984; 65 FR 54677, Sept. 8, 2000; 69 FR 50001, Aug. 12, 2004; 77 FR 46626, Aug. 6, 2012]

§ 1.323 Certificate of correction of applicant's mistake.

The Office may issue a certificate of correction under the conditions specified in 35 U.S.C. 255 at the request of the patentee or the patentee's assignee, upon payment of the fee set forth in §1.20(a). If the request relates to a patent involved in an interference or trial before the Patent Trial and Appeal Board, the request must comply with the requirements of this section and be accompanied by a motion under §41.121(a)(2), §41.121(a)(3) or §42.20 of this title.

[77 FR 46626, Aug. 6, 2012]

§ 1.324 Correction of inventorship in patent, pursuant to 35 U.S.C. 256.

(a) Whenever through error a person is named in an issued patent as the inventor, or an inventor is not named in an issued patent, the Director, pursuant to 35 U.S.C. 256, may, on application of all the parties and assignees, or on order of a court before which such matter is called in question, issue a certificate naming only the actual inventor or inventors.

(b) Any request to correct inventorship of a patent pursuant to paragraph (a) of this section must be accompanied by:

(1) A statement from each person who is being added as an inventor and each person who is currently named as an inventor either agreeing to the change of inventorship or stating that he or she has no disagreement in regard to the requested change;

(2) A statement from all assignees of the parties submitting a statement under paragraph (b)(1) of this section agreeing to the change of inventorship in the patent, which statement must comply with the requirements of §3.73(c) of this chapter; and

(3) The fee set forth in §1.20(b).

(c) For correction of inventorship in an application, *see* §1.48.

(d) In an interference under part 41, subpart D, of this title, a request for correction of inventorship in a patent must be in the form of a motion under §41.121(a)(2) of this title. In a contested case under part 42, subpart D, of this title, a request for correction of inventorship in a patent must be in the form of a motion under §42.22 of this title. The motion under §41.121(a)(2) or §42.22 of this title must comply with the requirements of this section.

[77 FR 48822, Aug. 14, 2012]

§ 1.325 Other mistakes not corrected.

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

(35 U.S.C. 6, Pub. L. 97–247)

[48 FR 2714, Jan. 20, 1983]

ARBITRATION AWARDS

§§ 1.331–1.334 [Reserved]

§ 1.335 Filing of notice of arbitration awards.

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

(b) If an award by an arbitrator pursuant to 35 U.S.C. 294 is modified by a court, the party requesting the modification must file in the Patent and Trademark Office, a notice of the modification for placement in the file of each patent to which the modification applies. The notice must set forth the patent number, the names of the inventor and patent owner, and the names and addresses of the parties to the arbitration. The notice must also include a copy of the court's order modifying the award.

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

of this section, any party to the arbitration proceeding may file such a notice.

(35 U.S.C. 6, Pub. L. 97–247)

[48 FR 2714, Jan. 20, 1983]

§§ 1.351–1.352 [Reserved]

MAINTENANCE FEES

§ 1.362 Time for payment of maintenance fees.

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

(b) Maintenance fees are not required for any plant patents or for any design patents.

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

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

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

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

(4) For a reissue application, including a continuing reissue application claiming the benefit of a reissue application under 35 U.S.C. 120, United States filing date of the original nonreissue application on which the patent reissued is based.

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

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

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

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

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

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

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

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

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

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

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

(h) The periods specified in §§ 1.362 (d) and (e) with respect to a reissue application, including a continuing reissue application thereof, are counted from the date of grant of the original non-reissue application on which the reissued patent is based.

[49 FR 34724, Aug. 31, 1984, as amended at 56 FR 65154, Dec. 13, 1991; 58 FR 54511, Oct. 22, 1993; 82 FR 52816, Nov. 14, 2017]

§ 1.363 Fee address for maintenance fee purposes.

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

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

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

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

(b) An assignment of a patent application or patent does not result in a change of the ''correspondence address'' or ''fee address'' for maintenance fee purposes.

(c) A fee address must be an address associated with a Customer Number.

[49 FR 34725, Aug. 31, 1984, as amended at 69 FR 29878, May 26, 2004]

§ 1.366 Submission of maintenance fees.

(a) The patentee may pay maintenance fees and any necessary surcharges, or any person or organization may pay maintenance fees and any necessary surcharges on behalf of a patentee. A maintenance fee transmittal letter may be signed by a juristic applicant or patent owner. A patentee need not file authorization to enable any person or organization to pay maintenance fees and any necessary surcharges on behalf of the patentee.

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

(c) In submitting maintenance fees and any necessary surcharges, identification of the patents for which maintenance fees are being paid must include the patent number, and the application number of the United States application for the patent on which the maintenance fee is being paid. If the payment includes identification of only the patent number (*i.e.*, does not identify the application number of the United States application for the patent on which the maintenance fee is being paid), the Office may apply the payment to the patent identified by patent number in the payment or may return the payment.

(d) Payment of maintenance fees and any surcharges should identify the fee being paid for each patent as to whether it is the 3½-, 7½-, or 11½-year fee, whether small entity status is being changed or claimed, the amount of the maintenance fee and any surcharge being paid, and any assigned customer number. If the maintenance fee and any necessary surcharge is being paid on a reissue patent, the payment must identify the reissue patent by reissue patent number and reissue application number as required by paragraph (c) of this section and should also include the original patent number.

(e) Maintenance fee payments and surcharge payments relating thereto

must be submitted separate from any other payments for fees or charges, whether submitted in the manner set forth in §1.23 or by an authorization to charge a deposit account. If maintenance fee and surcharge payments for more than one patent are submitted together, they should be submitted on as few sheets as possible with the patent numbers listed in increasing patent number order. If the payment submitted is insufficient to cover the maintenance fees and surcharges for all the listed patents, the payment will be applied in the order the patents are listed, beginning at the top of the listing.

(f) Notification of any change in status resulting in loss of entitlement to small entity status must be filed in a patent prior to paying, or at the time of paying, the earliest maintenance fee due after the date on which status as a small entity is no longer appropriate. See §1.27(g).

(g) Maintenance fees and surcharges relating thereto will not be refunded except in accordance with §§1.26 and 1.28(a).

[49 FR 34725, Aug. 31, 1984, as amended at 58 FR 54503, Oct. 22, 1993; 62 FR 53199, Oct. 10, 1997; 65 FR 54677, Sept. 8, 2000; 65 FR 78960, Dec. 18, 2000; 78 FR 62406, Oct. 21, 2013]

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

(a) Any patentee who is dissatisfied with the refusal of the Patent and Trademark Office to accept and record a maintenance fee which was filed prior to the expiration of the patent may petition the Director to accept and record the maintenance fee.

(b) Any petition under this section must be filed within two months of the action complained of, or within such other time as may be set in the action complained of, and must be accompanied by the fee set forth in §1.17(g). The petition may include a request that the petition fee be refunded if the refusal to accept and record the maintenance fee is determined to result from an error by the Patent and Trademark Office.

(c) Any petition filed under this section must comply with the requirements of §1.181(b) and must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest.

[49 FR 34725, Aug. 31, 1984, as amended at 62 FR 53199, Oct. 10, 1997; 69 FR 56545, Sept. 21, 2004]

§1.378 Acceptance of delayed payment of maintenance fee in expired patent to reinstate patent.

(a) The Director may accept the payment of any maintenance fee due on a patent after expiration of the patent if, upon petition, the delay in payment of the maintenance fee is shown to the satisfaction of the Director to have been unintentional. If the Director accepts payment of the maintenance fee upon petition, the patent shall be considered as not having expired, but will be subject to the conditions set forth in 35 U.S.C. 41(c)(2).

(b) Any petition to accept an unintentionally delayed payment of a maintenance fee must include:

(1) The required maintenance fee set forth in §1.20(e) through (g);

(2) The petition fee as set forth in §1.17(m); and

(3) A statement that the delay in payment of the maintenance fee was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(c) Any petition under this section must be signed in compliance with §1.33(b).

(d) Reconsideration of a decision refusing to accept a delayed maintenance fee may be obtained by filing a petition for reconsideration within two months of the decision, or such other time as set in the decision refusing to accept the delayed payment of the maintenance fee.

(e) If the delayed payment of the maintenance fee is not accepted, the maintenance fee will be refunded following the decision on the petition for reconsideration, or after the expiration of the time for filing such a petition for reconsideration, if none is filed.

[78 FR 62407, Oct. 21, 2013]

Subpart C—International Processing Provisions

AUTHORITY: Secs. 1.401 to 1.499 also issued under 35 U.S.C. 41 and 351 through 376.

SOURCE: 43 FR 20466, May 11, 1978, unless otherwise noted.

GENERAL INFORMATION

§ 1.401 Definitions of terms under the Patent Cooperation Treaty.

(a) The abbreviation *PCT* and the term *Treaty* mean the Patent Cooperation Treaty.

(b) *International Bureau* means the World Intellectual Property Organization located in Geneva, Switzerland.

(c) *Administrative Instructions* means that body of instructions for operating under the Patent Cooperation Treaty referred to in PCT Rule 89.

(d) *Request*, when capitalized, means that element of the international application described in PCT Rules 3 and 4.

(e) *International application*, as used in this subchapter is defined in §1.9(b).

(f) *Priority date* for the purpose of computing time limits under the Patent Cooperation Treaty is defined in PCT Art. 2 (xi). Note also §1.465.

(g) *Demand*, when capitalized, means that document filed with the International Preliminary Examining Authority which requests an international preliminary examination.

(h) *Annexes* means amendments made to the claims, description or the drawings before the International Preliminary Examining Authority.

(i) Other terms and expressions in this subpart C not defined in this section are to be taken in the sense indicated in PCT Art. 2 and 35 U.S.C. 351.

[43 FR 20466, May 11, 1978, as amended at 52 FR 20047, May 28, 1987]

§ 1.412 The United States Receiving Office.

(a) The United States Patent and Trademark Office is a Receiving Office only for applicants who are residents or nationals of the United States of America.

(b) The Patent and Trademark Office, when acting as a Receiving Office, will be identified by the full title ''United States Receiving Office'' or by the abbreviation ''RO/US.''

(c) The major functions of the Receiving Office include:

(1) According of international filing dates to international applications meeting the requirements of PCT Art. 11(1), and PCT Rule 20;

(2) Assuring that international applications meet the standards for format and content of PCT Art. 14(1), PCT Rule 9, 26, 29.1, 37, 38, 91, and portions of PCT Rules 3 through 11;

(3) Collecting and, when required, transmitting fees due for processing international applications (PCT Rule 14, 15, 16);

(4) Transmitting the record and search copies to the International Bureau and International Searching Authority, respectively (PCT Rules 22 and 23); and

(5) Determining compliance with applicable requirements of part 5 of this chapter.

(6) Reviewing and, unless prescriptions concerning national security prevent the application from being so transmitted (PCT Rule 19.4), transmitting the international application to the International Bureau for processing in its capacity as a Receiving Office:

(i) Where the United States Receiving Office is not the competent Receiving Office under PCT Rule 19.1 or 19.2 and §1.421(a); or

(ii) Where the international application is not in English but is in a language accepted under PCT Rule 12.1(a) by the International Bureau as a Receiving Office; or

(iii) Where there is agreement and authorization in accordance with PCT Rule 19.4(a)(iii).

[43 FR 20466, May 11, 1978, as amended at 60 FR 21439, May 2, 1995; 63 FR 29617, June 1, 1998]

§ 1.413 The United States International Searching Authority.

(a) Pursuant to appointment by the Assembly, the United States Patent and Trademark Office will act as an International Searching Authority for international applications filed in the United States Receiving Office and in other Receiving Offices as may be

agreed upon by the Director, in accordance with the agreement between the Patent and Trademark Office and the International Bureau (PCT Art. 16(3)(b)).

(b) The Patent and Trademark Office, when acting as an International Searching Authority, will be identified by the full title ''United States International Searching Authority'' or by the abbreviation ''ISA/US.''

(c) The major functions of the International Searching Authority include:

(1) Approving or establishing the title and abstract;

(2) Considering the matter of unity of invention;

(3) Conducting international and international-type searches and preparing international and international-type search reports (PCT Art. 15, 17 and 18, and PCT Rules 25, 33 to 45 and 47), and issuing declarations that no international search report will be established (PCT Article 17(2)(a));

(4) Preparing written opinions of the International Searching Authority in accordance with PCT Rule 43*bis* (when necessary); and

(5) Transmitting the international search report and the written opinion of the International Searching Authority to the applicant and the International Bureau.

[43 FR 20466, May 11, 1978, as amended at 68 FR 59886, Oct. 20, 2003]

§ 1.414 The United States Patent and Trademark Office as a Designated Office or Elected Office.

(a) The United States Patent and Trademark Office will act as a Designated Office or Elected Office for international applications in which the United States of America has been designated or elected as a State in which patent protection is desired.

(b) The United States Patent and Trademark Office, when acting as a Designated Office or Elected Office during international processing will be identified by the full title ''United States Designated Office'' or by the abbreviation ''DO/US'' or by the full title ''United States Elected Office'' or by the abbreviation ''EO/US''.

(c) The major functions of the United States Designated Office or Elected Office in respect to international applications in which the United States of America has been designated or elected, include:

(1) Receiving various notifications throughout the international stage and

(2) National stage processing for international applications entering the national stage under 35 U.S.C. 371.

[52 FR 20047, May 28, 1987, as amended at 77 FR 48823, Aug. 14, 2012]

§ 1.415 The International Bureau.

(a) The International Bureau is the World Intellectual Property Organization located at Geneva, Switzerland. It is the international intergovernmental organization which acts as the coordinating body under the Treaty and the Regulations (PCT Art. 2 (xix) and 35 U.S.C. 351 (h)).

(b) The major functions of the International Bureau include:

(1) Publishing of international applications and the International Gazette;

(2) Transmitting copies of international applications to Designated Offices;

(3) Storing and maintaining record copies; and

(4) Transmitting information to authorities pertinent to the processing of specific international applications.

§ 1.416 The United States International Preliminary Examining Authority.

(a) Pursuant to appointment by the Assembly, the United States Patent and Trademark Office will act as an International Preliminary Examining Authority for international applications filed in the United States Receiving Office and in other Receiving Offices as may be agreed upon by the Director, in accordance with agreement between the Patent and Trademark Office and the International Bureau.

(b) The United States Patent and Trademark Office, when acting as an International Preliminary Examining Authority, will be identified by the full title ''United States International Preliminary Examining Authority'' or by the abbreviation ''IPEA/US.''

(c) The major functions of the International Preliminary Examining Authority include:

(1) Receiving and checking for defects in the Demand;

(2) Forwarding Demands in accordance with PCT Rule 59.3;

(3) Collecting the handling fee for the International Bureau and the preliminary examination fee for the United States International Preliminary Examining Authority;

(4) Informing applicant of receipt of the Demand;

(5) Considering the matter of unity of invention;

(6) Providing an international preliminary examination report which is a non-binding opinion on the questions of whether the claimed invention appears: to be novel, to involve an inventive step (to be nonobvious), and to be industrially applicable; and

(7) Transmitting the international preliminary examination report to applicant and the International Bureau.

[52 FR 20047, May 28, 1987, as amended at 63 FR 29617, June 1, 1998]

§ 1.417 Submission of translation of international publication.

The submission of an English language translation of the publication of an international application pursuant to 35 U.S.C. 154(d)(4) must clearly identify the international application to which it pertains (§1.5(a)) and be clearly identified as a submission pursuant to 35 U.S.C. 154(d)(4). Otherwise, the submission will be treated as a filing under 35 U.S.C. 111(a). Such submissions should be marked ''Mail Stop PCT.''

[68 FR 71007, Dec. 22, 2003]

§ 1.419 Display of currently valid control number under the Paperwork Reduction Act.

(a) Pursuant to the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*), the collection of information in this subpart has been reviewed and approved by the Office of Management and Budget under control number 0651–0021.

(b) Notwithstanding any other provision of law, no person is required to respond to nor shall a person be subject to a penalty for failure to comply with a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid Office of Management and Budget control number. This section constitutes the display required by 44 U.S.C. 3512(a) and 5 CFR 1320.5(b)(2)(i) for the collection of information under Office of Management and Budget control number 0651–0021 (see 5 CFR 1320.5(b)(2)(ii)(D)).

[63 FR 29617, June 1, 1998]

WHO MAY FILE AN INTERNATIONAL APPLICATION

§ 1.421 Applicant for international application.

(a) Only residents or nationals of the United States of America may file international applications in the United States Receiving Office. If an international application does not include an applicant who is indicated as being a resident or national of the United States of America, and at least one applicant:

(1) Has indicated a residence or nationality in a PCT Contracting State, or

(2) Has no residence or nationality indicated, applicant will be so notified and, if the international application includes a fee amount equivalent to that required by §1.445(a)(4), the international application will be forwarded for processing to the International Bureau acting as a Receiving Office (*see also* §1.412(c)(6)).

(b) Although the United States Receiving Office will accept international applications filed by any applicant who is a resident or national of the United States of America for international processing, for the purposes of the designation of the United States, an international application will be accepted by the Patent and Trademark Office for the national stage only if the applicant is the inventor or other person as provided in §1.422 or §1.424. Joint inventors must jointly apply for an international application.

(c) A registered attorney or agent of the applicant may sign the international application Request and file the international application for the applicant. A separate power of attorney from each applicant may be required.

(d) Any indication of different applicants for the purpose of different Designated Offices must be shown on the

Request portion of the international application.

(e) Requests for changes in the indications concerning the applicant, agent, or common representative of an international application shall be made in accordance with PCT Rule 92*bis* and may be required to be signed by all applicants.

(f) Requests for withdrawals of the international application, designations, priority claims, the Demand, or elections shall be made in accordance with PCT Rule 90*bis* and must be signed by all applicants. A separate power of attorney from the applicants will be required for the purposes of any request for a withdrawal in accordance with PCT Rule 90*bis* which is not signed by all applicants.

[77 FR 48823, Aug. 14, 2012]

§ 1.422 Legal representative as applicant in an international application.

If an inventor is deceased or under legal incapacity, the legal representative of the inventor may be an applicant in an international application which designates the United States of America.

[77 FR 48823, Aug. 14, 2012]

§ 1.423 [Reserved]

§ 1.424 Assignee, obligated assignee, or person having sufficient proprietary interest as applicant in an international application.

(a) A person to whom the inventor has assigned or is under an obligation to assign the invention may be an applicant in an international application which designates the United States of America. A person who otherwise shows sufficient proprietary interest in the matter may be an applicant in an international application which designates the United States of America on proof of the pertinent facts and a showing that such action is appropriate to preserve the rights of the parties.

(b) Neither any showing required under paragraph (a) of this section nor documentary evidence of ownership or proprietary interest will be required or considered by the Office in the international stage, but will be required in the national stage in accordance with the conditions and requirements of § 1.46.

[77 FR 48823, Aug. 14, 2012]

THE INTERNATIONAL APPLICATION

§ 1.431 International application requirements.

(a) An international application shall contain, as specified in the Treaty and the Regulations, a Request, a description, one or more claims, an abstract, and one or more drawings (where required). (PCT Art. 3(2) and section 207 of the Administrative Instructions.)

(b) An international filing date will be accorded by the United States Receiving Office, at the time to receipt of the international application, provided that:

(1) At least one applicant (§ 1.421) is a United States resident or national and the papers filed at the time of receipt of the international application so indicate (35 U.S.C. 361(a), PCT Art. 11(1)(i)).

(2) The international application is in the English language (35 U.S.C. 361(c), PCT Art. 11(1)(ii)).

(3) The international application contains at least the following elements (PCT Art. 11(1)(iii)):

(i) An indication that it is intended as an international application (PCT Rule 4.2);

(ii) The designation of at least one Contracting State of the International Patent Cooperation Union (§ 1.432);

(iii) The name of the applicant, as prescribed (note §§ 1.421, 1.422, and 1.424);

(iv) A part which on the face of it appears to be a description; and

(v) A part which on the face of it appears to be a claim.

(c) Payment of the international filing fee (PCT Rule 15.2) and the transmittal and search fees (§ 1.445) may be made in full at the time the international application papers required by paragraph (b) of this section are deposited or within one month thereafter. The international filing, transmittal, and search fee payable is the international filing, transmittal, and search fee in effect on the receipt date of the international application. If the international filing, transmittal, and search

fees are not paid within one month from the date of receipt of the international application and prior to the sending of a notice of deficiency, which imposes a late payment fee (§1.445(a)(6)), the applicant will be notified and given a one-month non-extendable time limit within which to pay the deficient fees plus the late payment fee.

(d) If the payment needed to cover the transmittal fee, the international filing fee, the search fee, and the late payment fee pursuant to paragraph (c) of this section is not timely made in accordance with PCT Rule 16*bis*.1(e), the Receiving Office will declare the international application withdrawn under PCT Article 14(3)(a).

[43 FR 20466, May 11, 1978, as amended at 50 FR 9383, Mar. 7, 1985; 52 FR 20047, May 28, 1987; 58 FR 4344, Jan. 14, 1993; 63 FR 29618, June 1, 1998; 68 FR 59887, Oct. 20, 2003; 68 FR 67805, Dec. 4, 2003; 77 FR 48823, Aug. 14, 2012; 85 FR 46990, Aug. 3, 2020]

§ 1.432 Designation of States by filing an international application.

The filing of an international application request shall constitute:

(a) The designation of all Contracting States that are bound by the Treaty on the international filing date;

(b) An indication that the international application is, in respect of each designated State to which PCT Article 43 or 44 applies, for the grant of every kind of protection which is available by way of the designation of that State; and

(c) An indication that the international application is, in respect of each designated State to which PCT Article 45(1) applies, for the grant of a regional patent and also, unless PCT Article 45(2) applies, a national patent.

[68 FR 59887, Oct. 20, 2003]

§ 1.433 Physical requirements of international application.

(a) The international application and each of the documents that may be referred to in the check list of the Request (PCT Rule 3.3(a)(ii)) shall be filed in one copy only.

(b) All sheets of the international application must be on A4 size paper (21.0 × 29.7 cm.).

(c) Other physical requirements for international applications are set forth in PCT Rule 11 and sections 201–207 of the Administrative Instructions.

§ 1.434 The request.

(a) The request shall be made on a standardized form (PCT Rules 3 and 4). Copies of printed Request forms are available from the United States Patent and Trademark Office. Letters requesting printed forms should be marked ''Mail Stop PCT.''

(b) The Check List portion of the Request form should indicate each document accompanying the international application on filing.

(c) All information, for example, addresses, names of States and dates, shall be indicated in the Request as required by PCT Rule 4 and Administrative Instructions 110 and 201.

(d) For the purposes of the designation of the United States of America, an international application shall include:

(1) The name of the inventor; and

(2) A reference to any prior-filed national application or international application designating the United States of America, if the benefit of the filing date for the prior-filed application is to be claimed.

(e) An international application may also include in the Request a declaration of the inventors as provided for in PCT Rule 4.17(iv).

[43 FR 20466, May 11, 1978, as amended at 58 FR 4345, Jan. 14, 1993; 66 FR 16006, Mar. 22, 2001; 66 FR 67096, Dec. 28, 2001; 68 FR 14337, Mar. 25, 2003; 68 FR 59887, Oct. 20, 2003]

§ 1.435 The description.

(a) The application must meet the requirements as to the content and form of the description set forth in PCT Rules 5, 9, 10, and 11 and sections 204 and 208 of the Administrative Instructions.

(b) In international applications designating the United States the description must contain upon filing an indication of the best mode contemplated by the inventor for carrying out the claimed invention.

[43 FR 20466, May 11, 1978, as amended at 63 FR 29618, June 1, 1998]

§ 1.436 The claims.

The requirements as to the content and format of claims are set forth in PCT Art. 6 and PCT Rules 6, 9, 10 and 11 and shall be adhered to. The number of the claims shall be reasonable, considering the nature of the invention claimed.

§ 1.437 The drawings.

(a) Drawings are required when they are necessary for the understanding of the invention (PCT Art. 7).

(b) The physical requirements for drawings are set forth in PCT Rule 11 and shall be adhered to.

[72 FR 51563, Sept. 10, 2007]

§ 1.438 The abstract.

(a) Requirements as to the content and form of the abstract are set forth in PCT Rule 8, and shall be adhered to.

(b) Lack of an abstract upon filing of an international application will not affect the granting of a filing date. However, failure to furnish an abstract within one month from the date of the notification by the Receiving Office will result in the international application being declared withdrawn.

FEES

§ 1.445 International application filing, processing and search fees.

(a) The following fees and charges for international applications are established by law or by the director under the authority of 35 U.S.C. 376:

(1) A transmittal fee (*see* 35 U.S.C. 361(d) and PCT Rule 14) consisting of:

(i) A basic portion:

(A) For an international application having a receipt date that is on or after December 29, 2022:

TABLE 1 TO PARAGRAPH (a)(1)(i)(A)

By a micro entity (§ 1.29)	$52.00
By a small entity (§ 1.27(a))	104.00
By other than a small or micro entity	260.00

(B) For an international application having a receipt date that is on or after October 2, 2020 and before December 29, 2022:

TABLE 2 TO PARAGRAPH (a)(1)(i)(B)

By a micro entity (§ 1.29)	$65.00
By a small entity (§ 1.27(a))	130.00
By other than a small or micro entity ..	260.00

(C) For an international application having a receipt date that is on or after January 1, 2014, and before October 2, 2020:

TABLE 3 TO PARAGRAPH (a)(1)(i)(C)

By a micro entity (§ 1.29)	$60.00
By a small entity (§ 1.27(a))	120.00
By other than a small or micro entity ..	240.00

(D) For an international application having a receipt date that is before January 1, 2014: $240.00

(ii) A non-electronic filing fee portion for any international application designating the United States of America that is filed on or after November 15, 2011, other than by the USPTO patent electronic filing system, except for a plant application:

TABLE 4 TO PARAGRAPH (a)(1)(ii)

By a small entity (§ 1.27(a))	$200.00
By other than a small entity	400.00

(2) A search fee (*see* 35 U.S.C. 361(d) and PCT Rule 16):

(i) For an international application having a receipt date that is on or after April 1, 2023:

TABLE 5 TO PARAGRAPH (a)(2)(i)

By a micro entity (§ 1.29)	$436.00
By a small entity (§ 1.27(a))	872.00
By other than a small or micro entity	2,180.00

(ii) For an international application having a receipt date that is on or after October 2, 2020, and before April 1, 2023:

TABLE 6 TO PARAGRAPH (a)(2)(ii)

By a micro entity (§ 1.29)	$545.00
By a small entity (§ 1.27(a))	1,090.00
By other than a small or micro entity ..	2,180.00

(iii) For an international application having a receipt date that is on or after January 1, 2014, and before October 2, 2020:

TABLE 7 TO PARAGRAPH (a)(2)(iii)

By a micro entity (§ 1.29)	$520.00
By a small entity (§ 1.27(a))	1,040.00
By other than a small or micro entity	2,080.00

(iv) For an international application having a receipt date that is before January 1, 2014: $2,080.00

(3) A supplemental search fee when required, per additional invention:

(i) For an international application having a receipt date that is on or after April 1, 2023:

TABLE 8 TO PARAGRAPH (a)(3)(i)

By a micro entity (§ 1.29)	$436.00
By a small entity (§ 1.27(a))	872.00
By other than a small or micro entity	2,180.00

(ii) For an international application having a receipt date that is on or after October 2, 2020 and before April 1, 2023:

TABLE 9 TO PARAGRAPH (a)(3)(ii)

By a micro entity (§ 1.29)	$545.00
By a small entity (§ 1.27(a))	1,090.00
By other than a small or micro entity	2,180.00

(iii) For an international application having a receipt date that is on or after January 1, 2014, and before October 2, 2020:

TABLE 10 TO PARAGRAPH (a)(3)(iii)

By a micro entity (§ 1.29)	$520.00
By a small entity (§ 1.27(a))	1,040.00
By other than a small or micro entity	2,080.00

(iv) For an international application having a receipt date that is before January 1, 2014: $2,080.00

(4) A fee equivalent to the transmittal fee in paragraph (a)(1) of this section that would apply if the USPTO was the Receiving Office for transmittal of an international application to the International Bureau for processing in its capacity as a Receiving Office (PCT Rule 19.4).

(5) Late furnishing fee for providing a sequence listing in response to an invitation under PCT Rule 13*ter:*

TABLE 11 TO PARAGRAPH (a)(5)

By a micro entity (§ 1.29)	$64.00
By a small entity (§ 1.27(a))	128.00
By other than a small or micro entity	320.00

(6) Late payment fee pursuant to PCT Rule 16*bis*.2.

(b) The international filing fee shall be as prescribed in PCT Rule 15.

[78 FR 17107, Mar. 20, 2013, as amended at 82 FR 52816, Nov. 14, 2017; 85 FR 46990, Aug. 3, 2020; 85 FR 58283, Sept. 18, 2020; 88 FR 17157, Mar. 22, 2023]

§ 1.446 Refund of international application filing and processing fees.

(a) Money paid for international application fees, where paid by actual mistake or in excess, such as a payment not required by law or treaty and its regulations, may be refunded. A mere change of purpose after the payment of a fee will not entitle a party to a refund of such fee. The Office will not refund amounts of twenty-five dollars or less unless a refund is specifically requested and will not notify the payor of such amounts. If the payor or party requesting a refund does not provide the banking information necessary for making refunds by electronic funds transfer, the Office may use the banking information provided on the payment instrument to make any refund by electronic funds transfer.

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

(c) Refund of the supplemental search fees will be made if such refund is determined to be warranted by the Director or the Director's designee acting under PCT Rule 40.2(c).

(d) The international and search fees will be refunded if no international filing date is accorded or if the application is withdrawn before transmittal of the record copy to the International Bureau (PCT Rules 15.6 and 16.2). The

search fee will be refunded if the application is withdrawn before transmittal of the search copy to the International Searching Authority. The transmittal fee will not be refunded.

(e) The handling fee (§1.482(b)) will be refunded (PCT Rule 57.6) only if:

(1) The Demand is withdrawn before the Demand has been sent by the International Preliminary Examining Authority to the International Bureau, or

(2) The Demand is considered not to have been submitted (PCT Rule 54.4(a)).

(35 U.S.C. 6; 15 U.S.C. 1113, 1123)

[43 FR 20466, May 11, 1978, as amended at 50 FR 9384, Mar. 7, 1985; 50 FR 31826, Aug. 6, 1985; 58 FR 4345, Jan. 14, 1993; 65 FR 54677, Sept. 8, 2000]

PRIORITY

§ 1.451 The priority claim and priority document in an international application.

(a) The claim for priority must, subject to paragraph (d) of this section, be made on the Request (PCT Rule 4.10) in a manner complying with sections 110 and 115 of the Administrative Instructions.

(b) Whenever the priority of an earlier United States national application or international application filed with the United States Receiving Office is claimed in an international application, the applicant may request in the Request or in a letter of transmittal accompanying the international application upon filing with the United States Receiving Office or in a separate letter filed in the United States Receiving Office not later than 16 months after the priority date, that the United States Patent and Trademark Office prepare a certified copy of the prior application for transmittal to the International Bureau (PCT Article 8 and PCT Rule 17). The fee for preparing a certified copy is set forth in §1.19(b)(1).

(c) If a certified copy of the priority document is not submitted together with the international application on filing, or, if the priority application was filed in the United States and a request and appropriate payment for preparation of such a certified copy do not accompany the international application on filing or are not filed within 16 months of the priority date, the certified copy of the priority document must be furnished by the applicant to the International Bureau or to the United States Receiving Office within the time limit specified in PCT Rule 17.1(a).

(d) The applicant may correct or add a priority claim in accordance with PCT Rule 26bis.1.

(35 U.S.C. 6; 15 U.S.C. 1113, 1123)

[43 FR 20466, May 11, 1978, as amended at 50 FR 9384, Mar. 7, 1985; 50 FR 11366, Mar. 21, 1985; 54 FR 6903, Feb. 15, 1989; 58 FR 4345, Jan. 14, 1993; 63 FR 29619, June 1, 1998; 66 FR 16006, Mar. 22, 2001]

§ 1.452 Restoration of right of priority.

(a) If the international application has an international filing date which is later than the expiration of the priority period as defined by PCT Rule 2.4 but within two months from the expiration of the priority period, the right of priority in the international application may be restored upon request if the delay in filing the international application within the priority period was unintentional.

(b) A request to restore the right of priority in an international application under paragraph (a) of this section must be filed not later than two months from the expiration of the priority period and must include:

(1) A notice under PCT Rule 26*bis*.1(a) adding the priority claim, if the priority claim in respect of the earlier application is not contained in the international application;

(2) The petition fee as set forth in §1.17(m); and

(3) A statement that the delay in filing the international application within the priority period was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(c) If the applicant makes a request for early publication under PCT Article 21(2)(b), any requirement under paragraph (b) of this section filed after the technical preparations for international publication have been completed by the International Bureau

shall be considered as not having been submitted in time.

[72 FR 51563, Sept. 10, 2007, as amended at 78 FR 62407, Oct. 21, 2013]

§ 1.453 Transmittal of documents relating to earlier search or classification.

(a) Subject to paragraph (c) of this section, where an applicant has requested in an international application filed with the United States Receiving Office pursuant to PCT Rule 4.12 that an International Searching Authority take into account the results of an earlier search, the United States Receiving Office shall prepare and transmit to the International Searching Authority, as applicable, a copy of the results of the earlier search and any earlier classification as provided under PCT Rule 23*bis*.1.

(b) Subject to paragraph (c) of this section, where an international application filed with the United States Receiving Office claims the priority of an earlier application filed with the USPTO in which the USPTO has carried out an earlier search or has classified such earlier application, the United States Receiving Office shall prepare and transmit to the International Searching Authority a copy of the results of any such earlier search and earlier classification as provided under PCT Rule 23*bis*.2.

(c) The United States Receiving Office will not prepare a copy of the results of an earlier search or earlier classification referred to in paragraphs (a) and (b) of this section for transmittal to an International Searching Authority from an application preserved in confidence (§1.14) unless the international application contains written authority granting the International Searching Authority access to such results. Written authority provided under this paragraph must be signed by:

(1) An applicant in the international application who is also an applicant in the application preserved in confidence; or

(2) A person set forth in §1.14(c) permitted to grant access to the application preserved in confidence.

[82 FR 24252, May 26, 2017]

REPRESENTATION

§ 1.455 Representation in international applications.

(a) Applicants of international applications may be represented by attorneys or agents registered to practice before the United States Patent and Trademark Office or by an applicant appointed as a common representative (PCT Art. 49, Rules 4.8 and 90 and §11.9). If applicants have not appointed an attorney or agent or one of the applicants to represent them, and there is more than one applicant, the applicant first named in the request and who is entitled to file in the U.S. Receiving Office shall be considered to be the common representative of all the applicants. An attorney or agent having the right to practice before a national office with which an international application is filed and for which the United States is an International Searching Authority or International Preliminary Examining Authority may be appointed to represent the applicants in the international application before that authority. An attorney or agent may appoint an associate attorney or agent who shall also then be of record (PCT Rule 90.1(d)). The appointment of an attorney or agent, or of a common representative, revokes any earlier appointment unless otherwise indicated (PCT Rule 90.6 (b) and (c)).

(b) Appointment of an agent, attorney or common representative (PCT Rule 4.8) must be effected either in the Request form, signed by applicant, in the Demand form, signed by applicant, or in a separate power of attorney submitted either to the United States Receiving Office or to the International Bureau.

(c) Powers of attorney and revocations thereof should be submitted to the United States Receiving Office until the issuance of the international search report.

(d) The addressee for correspondence will be as indicated in section 108 of the Administrative Instructions.

[43 FR 20466, May 11, 1978, as amended at 50 FR 5171, Feb. 6, 1985; 58 FR 4345, Jan. 14, 1993; 68 FR 59888, Oct. 20, 2003; 69 FR 35452, June 24, 2004]

TRANSMITTAL OF RECORD COPY

§ 1.461 Procedures for transmittal of record copy to the International Bureau.

(a) Transmittal of the record copy of the international application to the International Bureau shall be made by the United States Receiving Office or as provided by PCT Rule 19.4.

(b) [Reserved]

(c) No copy of an international application may be transmitted to the International Bureau, a foreign Designated Office, or other foreign authority by the United States Receiving Office or the applicant, unless the applicable requirements of part 5 of this chapter have been satisfied.

[43 FR 20466, May 11, 1978, as amended at 50 FR 9384, Mar. 7, 1985; 63 FR 29619, June 1, 1998]

TIMING

§ 1.465 Timing of application processing based on the priority date.

(a) For the purpose of computing time limits under the Treaty, the priority date shall be defined as in PCT Art. 2(xi).

(b) When a claimed priority date is corrected under PCT Rule 26*bis*.1(a), or a priority claim is added under PCT Rule 26*bis*.1(a), withdrawn under PCT Rule 90*bis*.3, or considered not to have been made under PCT Rule 26*bis*.2, the priority date for the purposes of computing any non-expired time limits will be the filing date of the earliest remaining priority claim under PCT Article 8 of the international application, or if none, the international filing date.

(c) When corrections under PCT Art. 11(2), Art. 14(2) or PCT Rule 20.2(a) (i) or (iii) are timely submitted, and the date of receipt of such corrections falls later than one year from the claimed priority date or dates, the Receiving Office shall proceed under PCT Rule 26bis.2.

[43 FR 20466, May 11, 1978, as amended at 63 FR 29619, June 1, 1998; 72 FR 51564, Sept. 10, 2007]

§ 1.468 Delays in meeting time limits.

Delays in meeting time limits during international processing of international applications may only be excused as provided in PCT Rule 82. For delays in meeting time limits in a national application, see § 1.137.

AMENDMENTS

§ 1.471 Corrections and amendments during international processing.

(a) Except as otherwise provided in this paragraph, all corrections submitted to the United States Receiving Office or United States International Searching Authority must be in English, in the form of replacement sheets in compliance with PCT Rules 10 and 11, and accompanied by a letter that draws attention to the differences between the replaced sheets and the replacement sheets. Replacement sheets are not required for the deletion of lines of text, the correction of simple typographical errors, and one addition or change of not more than five words per sheet. These changes may be stated in a letter and, if appropriate, the United States Receiving Office will make the deletion or transfer the correction to the international application, provided that such corrections do not adversely affect the clarity and direct reproducibility of the application (PCT Rule 26.4). Amendments that do not comply with PCT Rules 10 and 11.1 to 11.13 may not be entered.

(b) Amendments of claims submitted to the International Bureau shall be as prescribed by PCT Rule 46.

(c) Corrections or additions to the Request of any declarations under PCT Rule 4.17 should be submitted to the International Bureau as prescribed by PCT Rule 26*ter*.

[43 FR 20466, May 11, 1978, as amended at 63 FR 29619, June 1, 1998; 66 FR 16006, Mar. 22, 2001]

§ 1.472 Changes in person, name, or address of applicants and inventors.

All requests for a change in person, name or address of applicants and inventor be sent to the United States Receiving Office until the time of issuance of the international search report. Thereafter requests for such

changes should be submitted to the International Bureau.

[43 FR 20466, May 11, 1978. Redesignated at 52 FR 20047, May 28, 1987]

UNITY OF INVENTION

§ 1.475 Unity of invention before the International Searching Authority, the International Preliminary Examining Authority and during the national stage.

(a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (''requirement of unity of invention''). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression ''special technical features'' shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

(1) A product and a process specially adapted for the manufacture of said product; or

(2) A product and a process of use of said product; or

(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or

(4) A process and an apparatus or means specifically designed for carrying out the said process; or

(5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

(c) If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.

(d) If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and §1.476(c).

(e) The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

[58 FR 4345, Jan. 14, 1993]

§ 1.476 Determination of unity of invention before the International Searching Authority.

(a) Before establishing the international search report, the International Searching Authority will determine whether the international application complies with the requirement of unity of invention as set forth in §1.475.

(b) If the International Searching Authority considers that the international application does not comply with the requirement of unity of invention, it shall inform the applicant accordingly and invite the payment of additional fees (note §1.445 and PCT Art. 17(3)(a) and PCT Rule 40). The applicant will be given a time period in accordance with PCT Rule 40.3 to pay the additional fees due.

(c) In the case of non-compliance with unity of invention and where no additional fees are paid, the international search will be performed on the invention first mentioned (''main invention'') in the claims.

(d) Lack of unity of invention may be directly evident before considering the claims in relation to any prior art, or after taking the prior art into consideration, as where a document discovered during the search shows the invention claimed in a generic or linking claim lacks novelty or is clearly obvious, leaving two or more claims joined thereby without a common inventive concept. In such a case the International Searching Authority may

raise the objection of lack of unity of invention.

[43 FR 20466, May 11, 1978. Redesignated and amended at 52 FR 20048, May 28, 1987; 58 FR 4346, Jan. 14, 1993]

§ 1.477 Protest to lack of unity of invention before the International Searching Authority.

(a) If the applicant disagrees with the holding of lack of unity of invention by the International Searching Authority, additional fees may be paid under protest, accompanied by a request for refund and a statement setting forth reasons for disagreement or why the required additional fees are considered excessive, or both (PCT Rule 40.2(c)).

(b) Protest under paragraph (a) of this section will be examined by the Director or the Director's designee. In the event that the applicant's protest is determined to be justified, the additional fees or a portion thereof will be refunded.

(c) An applicant who desires that a copy of the protest and the decision thereon accompany the international search report when forwarded to the Designated Offices, may notify the International Searching Authority to that effect any time prior to the issuance of the international search report. Thereafter, such notification should be directed to the International Bureau (PCT Rule 40.2(c)).

[43 FR 20466, May 11, 1978. Redesignated and amended at 52 FR 20048, May 28, 1987]

INTERNATIONAL PRELIMINARY EXAMINATION

§ 1.480 Demand for international preliminary examination.

(a) On the filing of a proper Demand in an application for which the United States International Preliminary Examining Authority is competent and for which the fees have been paid, the international application shall be the subject of an international preliminary examination. The preliminary examination fee (§ 1.482(a)(1)) and the handling fee (§ 1.482(b)) shall be due within the applicable time limit set forth in PCT Rule 57.3.

(b) The Demand shall be made on a standardized form (PCT Rule 53). Copies of the printed Demand forms are available from the United States Patent and Trademark Office. Letters requesting printed Demand forms should be marked ''Mail Stop PCT.''

(c) Withdrawal of a proper Demand prior to the start of the international preliminary examination will entitle applicant to a refund of the preliminary examination fee minus the amount of the transmittal fee set forth in § 1.445(a)(1).

(d) The filing of a Demand shall constitute the election of all Contracting States which are designated and are bound by Chapter II of the Treaty on the international filing date (PCT Rule 53.7).

(e) Any Demand filed after the expiration of the applicable time limit set forth in PCT Rule 54*bis*.1(a) shall be considered as if it had not been submitted (PCT Rule 54*bis*.1(b)).

[52 FR 20048, May 28, 1987, as amended at 53 FR 47810, Nov. 28, 1988; 58 FR 4346, Jan. 14, 1993; 63 FR 29619, June 1, 1998; 67 FR 523, Jan. 4, 2002; 68 FR 14337, Mar. 25, 2003; 68 FR 59888, Oct. 20, 2003]

§ 1.481 Payment of international preliminary examination fees.

(a) The handling and preliminary examination fees shall be paid within the time period set in PCT Rule 57.3. The handling fee or preliminary examination fee payable is the handling fee or preliminary examination fee in effect on the date of payment.

(1) If the handling and preliminary examination fees are not paid within the time period set in PCT Rule 57.3, applicant will be notified and given one month within which to pay the deficient fees plus a late payment fee equal to the greater of:

(i) Fifty percent of the amount of the deficient fees, but not exceeding an amount equal to double the handling fee; or

(ii) An amount equal to the handling fee (PCT Rule 58*bis*.2).

(2) The one-month time limit set in this paragraph to pay deficient fees may not be extended.

(b) If the payment needed to cover the handling and preliminary examination fees, pursuant to paragraph (a) of this section, is not timely made in accordance with PCT Rule 58bis.1(d), the

United States International Preliminary Examination Authority will declare the Demand to be considered as if it had not been submitted.

[63 FR 29619, June 1, 1998, as amended at 68 FR 59888, Oct. 20, 2003]

§ 1.482 International preliminary examination and processing fees.

(a) The following fees and charges for international preliminary examination are established by the director under the authority of 35 U.S.C. 376:

(1) The following preliminary examination fee is due on filing the demand:

(i) If an international search fee as set forth in § 1.445(a)(2) has been paid on the international application to the United States Patent and Trademark Office as an International Searching Authority:

TABLE 1 TO PARAGRAPH (a)(1)(i)

By a micro entity (§ 1.29)	$128.00
By a small entity (§ 1.27(a))	256.00
By other than a small or micro entity	640.00

(ii) If the International Searching Authority for the international application was an authority other than the United States Patent and Trademark Office:

TABLE 2 TO PARAGRAPH (a)(1)(ii)

By a micro entity (§ 1.29)	$160.00
By a small entity (§ 1.27(a))	320.00
By other than a small or micro entity	800.00

(2) An additional preliminary examination fee when required, per additional invention:

TABLE 3 TO PARAGRAPH (a)(2)

By a micro entity (§ 1.29)	$128.00
By a small entity (§ 1.27(a))	256.00
By other than a small or micro entity	640.00

(b) The handling fee is due on filing the demand and shall be as prescribed in PCT Rule 57.

(c) Late furnishing fee for providing a sequence listing in response to an invitation under PCT Rule 13*ter:*

TABLE 4 TO PARAGRAPH (c)

By a micro entity (§ 1.29)	$64.00
By a small entity (§ 1.27(a))	128.00

TABLE 4 TO PARAGRAPH (c)—Continued

By other than a small or micro entity	320.00

[85 FR 46991, Aug. 3, 2020, as amended at 88 FR 17157, Mar. 22, 2023]

§ 1.484 Conduct of international preliminary examination.

(a) An international preliminary examination will be conducted to formulate a non-binding opinion as to whether the claimed invention has novelty, involves an inventive step (is non-obvious) and is industrially applicable.

(b) International preliminary examination will begin in accordance with PCT Rule 69.1.

(c) No international preliminary examination will be conducted on inventions not previously searched by an International Searching Authority.

(d) The International Preliminary Examining Authority will establish a written opinion if any defect exists or if the claimed invention lacks novelty, inventive step or industrial applicability and will set a non-extendable time limit in the written opinion for the applicant to reply.

(e) The written opinion established by the International Searching Authority under PCT Rule 43*bis*.1 shall be considered to be a written opinion of the United States International Preliminary Examining Authority for the purposes of paragraph (d) of this section.

(f) The International Preliminary Examining Authority may establish further written opinions under paragraph (d) of this section.

(g) If no written opinion under paragraph (d) of this section is necessary, or if no further written opinion under paragraph (f) of this section is to be established, or after any written opinion and the reply thereto or the expiration of the time limit for reply to such written opinion, an international preliminary examination report will be established by the International Preliminary Examining Authority. One copy will be submitted to the International Bureau and one copy will be submitted to the applicant.

(h) An applicant will be permitted a personal or telephone interview with the examiner, which may be requested after the filing of a Demand, and must

be conducted during the period between the establishment of the written opinion and the establishment of the international preliminary examination report. Additional interviews may be conducted where the examiner determines that such additional interviews may be helpful to advancing the international preliminary examination procedure. A summary of any such personal or telephone interview must be filed by the applicant or, if not filed by applicant be made of record in the file by the examiner.

(i) If the application whose priority is claimed in the international application is in a language other than English, the United States International Preliminary Examining Authority may, where the validity of the priority claim is relevant for the formulation of the opinion referred to in Article 33(1), invite the applicant to furnish an English translation of the priority document within two months from the date of the invitation. If the translation is not furnished within that time limit, the international preliminary report may be established as if the priority had not been claimed.

[52 FR 20049, May 28, 1987, as amended at 58 FR 4346, Jan. 14, 1993; 62 FR 53199, Oct. 10, 1997; 63 FR 29619, June 1, 1998; 66 FR 16006, Mar. 22, 2001; 68 FR 59888, Oct. 20, 2003]

§ 1.485 Amendments by applicant during international preliminary examination.

The applicant may make amendments at the time of filing the Demand. The applicant may also make amendments within the time limit set by the International Preliminary Examining Authority for reply to any notification under §1.484(b) or to any written opinion. Any such amendments must be made in accordance with PCT Rule 66.8.

[74 FR 31373, July 1, 2009]

§ 1.488 Determination of unity of invention before the International Preliminary Examining Authority.

(a) Before establishing any written opinion or the international preliminary examination report, the International Preliminary Examining Authority will determine whether the international application complies with the requirement of unity of invention as set forth in §1.475.

(b) If the International Preliminary Examining Authority considers that the international application does not comply with the requirement of unity of invention, it may:

(1) Issue a written opinion and/or an international preliminary examination report, in respect of the entire international application and indicate that unity of invention is lacking and specify the reasons therefor without extending an invitation to restrict or pay additional fees. No international preliminary examination will be conducted on inventions not previously searched by an International Searching Authority.

(2) Invite the applicant to restrict the claims or pay additional fees, pointing out the categories of invention found, within a set time limit which will not be extended. No international preliminary examination will be conducted on inventions not previously searched by an International Searching Authority, or

(3) If applicant fails to restrict the claims or pay additional fees within the time limit set for reply, the International Preliminary Examining Authority will issue a written opinion and/or establish an international preliminary examination report on the main invention and shall indicate the relevant facts in the said report. In case of any doubt as to which invention is the main invention, the invention first mentioned in the claims and previously searched by an International Searching Authority shall be considered the main invention.

(c) Lack of unity of invention may be directly evident before considering the claims in relation to any prior art, or after taking the prior art into consideration, as where a document discovered during the search shows the invention claimed in a generic or linking claim lacks novelty or is clearly obvious, leaving two or more claims joined thereby without a common inventive concept. In such a case the International Preliminary Examining Authority may raise the objection of lack of unity of invention.

[52 FR 20049, May 28, 1987, as amended at 58 FR 4346, Jan. 14, 1993; 62 FR 53200, Oct. 10, 1997]

§ 1.489 Protest to lack of unity of invention before the International Preliminary Examining Authority.

(a) If the applicant disagrees with the holding of lack of unity of invention by the International Preliminary Examining Authority, additional fees may be paid under protest, accompanied by a request for refund and a statement setting forth reasons for disagreement or why the required additional fees are considered excessive, or both.

(b) Protest under paragraph (a) of this section will be examined by the Director or the Director's designee. In the event that the applicant's protest is determined to be justified, the additional fees or a portion thereof will be refunded.

(c) An applicant who desires that a copy of the protest and the decision thereon accompany the international preliminary examination report when forwarded to the Elected Offices, may notify the International Preliminary Examining Authority to that effect any time prior to the issuance of the international preliminary examination report. Thereafter, such notification should be directed to the International Bureau.

[52 FR 20050, May 28, 1987]

NATIONAL STAGE

§ 1.491 National stage commencement, entry, and fulfillment.

(a) Subject to 35 U.S.C. 371(f), the national stage shall commence with the expiration of the applicable time limit under PCT Article 22 (1) or (2), or under PCT Article 39(1)(a).

(b) An international application enters the national stage when the applicant has filed the documents and fees required by 35 U.S.C. 371(c)(1) and (c)(2) within the period set in § 1.495.

(c) An international application fulfills the requirements of 35 U.S.C. 371 when the national stage has commenced under 35 U.S.C. 371(b) or (f) and all applicable requirements of 35 U.S.C. 371 have been satisfied.

[67 FR 523, Jan. 4, 2002, as amended at 77 FR 48823, Aug. 14, 2012]

§ 1.492 National stage fees.

The following fees and charges are established for international applications entering the national stage under 35 U.S.C. 371:

(a) The basic national fee for an international application entering the national stage under 35 U.S.C. 371:

TABLE 1 TO PARAGRAPH (a)

By a micro entity (§ 1.29)	$64.00
By a small entity (§ 1.27(a))	128.00
By other than a small or micro entity	320.00

(b) Search fee for an international application entering the national stage under 35 U.S.C. 371:

(1) If an international preliminary examination report on the international application prepared by the United States International Preliminary Examining Authority or a written opinion on the international application prepared by the United States International Searching Authority states that the criteria of novelty, inventive step (non-obviousness), and industrial applicability, as defined in PCT Article 33(1) to (4) have been satisfied for all of the claims presented in the application entering the national stage:

TABLE 2 TO PARAGRAPH (b)(1)

By a micro entity (§ 1.29)	$0.00
By a small entity (§ 1.27(a))	0.00
By other than a small or micro entity	0.00

(2) If the search fee as set forth in § 1.445(a)(2) has been paid on the international application to the United States Patent and Trademark Office as an International Searching Authority:

TABLE 3 TO PARAGRAPH (b)(2)

By a micro entity (§ 1.29)	$28.00
By a small entity (§ 1.27(a))	56.00
By other than a small or micro entity	140.00

(3) If an international search report on the international application has been prepared by an International Searching Authority other than the United States International Searching Authority and is provided, or has been previously communicated by the International Bureau, to the Office:

TABLE 4 TO PARAGRAPH (b)(3)

By a micro entity (§ 1.29)	$108.00
By a small entity (§ 1.27(a))	216.00
By other than a small or micro entity	540.00

(4) In all situations not provided for in paragraph (b)(1), (2), or (3) of this section:

TABLE 5 TO PARAGRAPH (b)(4)

By a micro entity (§ 1.29)	$140.00
By a small entity (§ 1.27(a))	280.00
By other than a small or micro entity	700.00

(c) The examination fee for an international application entering the national stage under 35 U.S.C. 371:

(1) If an international preliminary examination report on the international application prepared by the United States International Preliminary Examining Authority or a written opinion on the international application prepared by the United States International Searching Authority states that the criteria of novelty, inventive step (non-obviousness), and industrial applicability, as defined in PCT Article 33 (1) to (4) have been satisfied for all of the claims presented in the application entering the national stage:

TABLE 6 TO PARAGRAPH (c)(1)

By a micro entity (§ 1.29)	$0.00
By a small entity (§ 1.27(a))	0.00
By other than a small or micro entity	0.00

(2) In all situations not provided for in paragraph (c)(1) of this section:

TABLE 7 TO PARAGRAPH (c)(2)

By a micro entity (§ 1.29)	$160.00
By a small entity (§ 1.27(a))	320.00
By other than a small or micro entity	800.00

(d) In addition to the basic national fee, for filing or on later presentation at any other time of each claim in independent form in excess of three:

TABLE 8 TO PARAGRAPH (d)

By a micro entity (§ 1.29)	$96.00
By a small entity (§ 1.27(a))	192.00
By other than a small or micro entity	480.00

(e) In addition to the basic national fee, for filing or on later presentation at any other time of each claim (whether dependent or independent) in excess of 20 (note that § 1.75(c) indicates how multiple dependent claims are considered for fee calculation purposes):

TABLE 9 TO PARAGRAPH (e)

By a micro entity (§ 1.29)	$20.00
By a small entity (§ 1.27(a))	40.00
By other than a small or micro entity	100.00

(f) In addition to the basic national fee, if the application contains, or is amended to contain, a multiple dependent claim, per application:

TABLE 10 TO PARAGRAPH (f)

By a micro entity (§ 1.29)	$172.00
By a small entity (§ 1.27(a))	344.00
By other than a small or micro entity	860.00

(g) If the excess claims fees required by paragraphs (d) and (e) of this section and multiple dependent claim fee required by paragraph (f) of this section are not paid with the basic national fee or on later presentation of the claims for which excess claims or multiple dependent claim fees are due, the fees required by paragraphs (d), (e), and (f) of this section must be paid or the claims canceled by amendment prior to the expiration of the time period set for reply by the Office in any notice of fee deficiency in order to avoid abandonment.

(h) Surcharge for filing the search fee, the examination fee, or the oath or declaration after the date of the commencement of the national stage (§ 1.491(a)) pursuant to § 1.495(c):

TABLE 11 TO PARAGRAPH (h)

By a micro entity (§ 1.29)	$32.00
By a small entity (§ 1.27(a))	64.00
By other than a small or micro entity	160.00

(i) For filing an English translation of an international application or any annexes to an international preliminary examination report later than thirty months after the priority date (§ 1.495(c) and (e)):

TABLE 12 TO PARAGRAPH (i)

By a micro entity (§ 1.29)	$28.00
By a small entity (§ 1.27(a))	56.00
By other than a small or micro entity	140.00

(j) Application size fee for any international application, the specification and drawings of which exceed 100 sheets of paper, for each additional 50 sheets or fraction thereof:

TABLE 13 TO PARAGRAPH (j)

By a micro entity (§ 1.29)	$84.00
By a small entity (§ 1.27(a))	168.00
By other than a small or micro entity	420.00

[78 FR 4290, Jan. 18, 2013, as amended at 82 FR 52816, Nov. 14, 2017; 85 FR 46991, Aug. 3, 2020; 88 FR 17158, Mar. 22, 2023]

§ 1.495 Entering the national stage in the United States of America.

(a) The applicant in an international application must fulfill the requirements of 35 U.S.C. 371 within the time periods set forth in paragraphs (b) and (c) of this section in order to prevent the abandonment of the international application as to the United States of America. The thirty-month time period set forth in paragraphs (b), (c), (d), (e) and (h) of this section may not be extended.

(b) To avoid abandonment of the application, the applicant shall furnish to the United States Patent and Trademark Office not later than the expiration of thirty months from the priority date:

(1) A copy of the international application, unless it has been previously communicated by the International Bureau or unless it was originally filed in the United States Patent and Trademark Office; and

(2) The basic national fee (see § 1.492(a)).

(c)(1) If applicant complies with paragraph (b) of this section before expiration of thirty months from the priority date, the Office will notify the applicant if he or she has omitted any of:

(i) A translation of the international application, as filed, into the English language, if it was originally filed in another language and if any English language translation of the publication of the international application previously submitted under 35 U.S.C. 154(d) (§ 1.417) is not also a translation of the international application as filed (35 U.S.C. 371(c)(2));

(ii) The inventor's oath or declaration (35 U.S.C. 371(c)(4) and § 1.497), if a declaration of inventorship in compliance with § 1.63 has not been previously submitted in the international application under PCT Rule 4.17(iv) within the time limits provided for in PCT Rule 26*ter*.1;

(iii) The search fee set forth in § 1.492(b);

(iv) The examination fee set forth in § 1.492(c); and

(v) Any application size fee required by § 1.492(j).

(2) A notice under paragraph (c)(1) of this section will set a time period within which applicant must provide any omitted translation, search fee set forth in § 1.492(b), examination fee set forth in § 1.492(c), and any application size fee required by § 1.492(j) in order to avoid abandonment of the application.

(3) The inventor's oath or declaration must also be filed within the period specified in paragraph (c)(2) of this section, except that the filing of the inventor's oath or declaration may be postponed until the application is otherwise in condition for allowance under the conditions specified in paragraphs (c)(3)(i) through (c)(3)(iii) of this section.

(i) The application contains an application data sheet in accordance with § 1.76 filed prior to the expiration of the time period set in any notice under paragraph (c)(1) identifying:

(A) Each inventor by his or her legal name;

(B) A mailing address where the inventor customarily receives mail, and residence, if an inventor lives at a location which is different from where the inventor customarily receives mail, for each inventor.

(ii) The applicant must file each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, no later than the date on which the issue fee for the patent is paid. If the applicant is notified in a notice of allowability that an oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, executed by or

with respect to each named inventor has not been filed, the applicant must file each required oath or declaration in compliance with §1.63, or substitute statement in compliance with §1.64, no later than the date on which the issue fee is paid to avoid abandonment. This time period is not extendable under §1.136 (*see* §1.136(c)). The Office may dispense with the notice provided for in paragraph (c)(1) of this section if each required oath or declaration in compliance with §1.63, or substitute statement in compliance with §1.64, has been filed before the application is in condition for allowance.

(iii) An international application in which the basic national fee under 35 U.S.C. 41(a)(1)(F) has been paid and for which an application data sheet in accordance with §1.76 has been filed may be treated as complying with 35 U.S.C. 371 for purposes of eighteen-month publication under 35 U.S.C. 122(b) and §1.211 *et seq*.

(4) The payment of the processing fee set forth in §1.492(i) is required for acceptance of an English translation later than the expiration of thirty months after the priority date. The payment of the surcharge set forth in §1.492(h) is required for acceptance of any of the search fee, the examination fee, or the inventor's oath or declaration after the date of the commencement of the national stage (§1.491(a)).

(5) For international applications having an international filing date before July 1, 2022, a sequence listing need not be translated if the sequence listing complies with PCT Rule 12.1(d) and the description complies with PCT Rule 5.2(b). For international applications having an international filing date on or after July 1, 2022, for purposes of paragraph (c)(1)(i) of this section, an English translation is required for any sequence listing in XML format (''Sequence Listing XML'') containing non-English language values for any language-dependent free text qualifiers in accordance with §§1.831 through 1.834.

(d) A copy of any amendments to the claims made under PCT Article 19, and a translation of those amendments into English, if they were made in another language, must be furnished not later than the expiration of thirty months from the priority date. Amendments under PCT Article 19 which are not received by the expiration of thirty months from the priority date will be considered to be canceled.

(e) A translation into English of any annexes to an international preliminary examination report (if applicable), if the annexes were made in another language, must be furnished not later than the expiration of thirty months from the priority date. Translations of the annexes which are not received by the expiration of thirty months from the priority date may be submitted within any period set pursuant to paragraph (c) of this section accompanied by the processing fee set forth in §1.492(f). Annexes for which translations are not timely received will be considered canceled.

(f) Verification of the translation of the international application or any other document pertaining to an international application may be required where it is considered necessary, if the international application or other document was filed in a language other than English.

(g) The documents and fees submitted under paragraphs (b) and (c) of this section must be identified as a submission to enter the national stage under 35 U.S.C. 371. If the documents and fees contain conflicting indications as between an application under 35 U.S.C. 111 and a submission to enter the national stage under 35 U.S.C. 371, the documents and fees will be treated as a submission to enter the national stage under 35 U.S.C. 371.

(h) An international application becomes abandoned as to the United States thirty months from the priority date if the requirements of paragraph (b) of this section have not been complied with within thirty months from the priority date.

[52 FR 20051, May 28, 1987, as amended at 58 FR 4347, Jan. 14, 1993; 63 FR 29620, June 1, 1998; 65 FR 57060, Sept. 20, 2000; 67 FR 523, Jan. 4, 2002; 68 FR 71007, Dec. 22, 2003; 70 FR 3892, Jan. 27, 2005; 70 FR 30365, May 26, 2005; 72 FR 46843, Aug. 21, 2007; 74 FR 52691, Oct. 14, 2009; 77 FR 48824, Aug. 14, 2012; 78 FR 62407, Oct. 21, 2013; 87 FR 30818, May 20, 2022]

§ 1.496 Examination of international applications in the national stage.

National stage applications having paid therein the search fee as set forth in §1.492(b)(1) and examination fee as set forth in §1.492(c)(1) may be amended subsequent to the date of commencement of national stage processing only to the extent necessary to eliminate objections as to form or to cancel rejected claims. Such national stage applications will be advanced out of turn for examination.

[77 FR 48824, Aug. 14, 2012]

§ 1.497 Inventor's oath or declaration under 35 U.S.C. 371(c)(4).

(a) When an applicant of an international application desires to enter the national stage under 35 U.S.C. 371 pursuant to §1.495, and a declaration in compliance with §1.63 has not been previously submitted in the international application under PCT Rule 4.17(iv) within the time limits provided for in PCT Rule 26*ter*.1, the applicant must file the inventor's oath or declaration. The inventor, or each individual who is a joint inventor of a claimed invention, in an application for patent must execute an oath or declaration in accordance with the conditions and requirements of §1.63, except as provided for in §1.64.

(b) An oath or declaration under §1.63 will be accepted as complying with 35 U.S.C. 371(c)(4) if it complies with the requirements of §§1.63(a), (c) and (g). A substitute statement under §1.64 will be accepted as complying with 35 U.S.C. 371(c)(4) if it complies with the requirements of §§1.64(b)(1), (c) and (e) and identifies the person executing the substitute statement. If a newly executed inventor's oath or declaration under §1.63 or substitute statement under §1.64 is not required pursuant to §1.63(d), submission of the copy of the previously executed oath, declaration, or substitute statement under §1.63(d)(1) is required to comply with 35 U.S.C. 371(c)(4).

(c) If an oath or declaration under §1.63, or substitute statement under §1.64, meeting the requirements of §1.497(b) does not also meet the requirements of §1.63 or §1.64, an oath, declaration, substitute statement, or application data sheet in accordance with §1.76 to comply with §1.63 or §1.64 will be required.

[77 FR 48824, Aug. 14, 2012]

§ 1.499 Unity of invention during the national stage.

If the examiner finds that a national stage application lacks unity of invention under §1.475, the examiner may in an Office action require the applicant in the response to that action to elect the invention to which the claims shall be restricted. Such requirement may be made before any action on the merits but may be made at any time before the final action at the discretion of the examiner. Review of any such requirement is provided under §§1.143 and 1.144.

[58 FR 4347, Jan. 14, 1993]

Subpart D—*Ex Parte* Reexamination of Patents

SOURCE: 46 FR 29185, May 29, 1981, unless otherwise noted.

CITATION OF PRIOR ART AND WRITTEN STATEMENTS

§ 1.501 Citation of prior art and written statements in patent files.

(a) *Information content of submission:* At any time during the period of enforceability of a patent, any person may file a written submission with the Office under this section, which is directed to the following information:

(1) Prior art consisting of patents or printed publications which the person making the submission believes to have a bearing on the patentability of any claim of the patent; or

(2) Statements of the patent owner filed by the patent owner in a proceeding before a Federal court or the Office in which the patent owner took a position on the scope of any claim of the patent. Any statement submitted under this paragraph must be accompanied by any other documents, pleadings, or evidence from the proceeding in which the statement was filed that address the written statement, and such statement and accompanying information under this paragraph must

be submitted in redacted form to exclude information subject to an applicable protective order.

(3) Submissions under paragraph (a)(2) of this section must identify:

(i) The forum and proceeding in which patent owner filed each statement;

(ii) The specific papers and portions of the papers submitted that contain the statements; and

(iii) How each statement submitted is a statement in which patent owner took a position on the scope of any claim in the patent.

(b) *Explanation:* A submission pursuant to paragraph (a) of this section:

(1) Must include an explanation in writing of the pertinence and manner of applying any prior art submitted under paragraph (a)(1) of this section and any written statement and accompanying information submitted under paragraph (a)(2) of this section to at least one claim of the patent, in order for the submission to become a part of the official file of the patent; and

(2) May, if the submission is made by the patent owner, include an explanation of how the claims differ from any prior art submitted under paragraph (a)(1) of this section or any written statements and accompanying information submitted under paragraph (a)(2) of this section.

(c) *Reexamination pending:* If a reexamination proceeding has been requested and is pending for the patent in which the submission is filed, entry of the submission into the official file of the patent is subject to the provisions of §§ 1.502 and 1.902.

(d) *Identity:* If the person making the submission wishes his or her identity to be excluded from the patent file and kept confidential, the submission papers must be submitted anonymously without any identification of the person making the submission.

(e) *Certificate of Service:* A submission under this section by a person other than the patent owner must include a certification that a copy of the submission was served in its entirety upon patent owner at the address as provided for in § 1.33 (c). A submission by a person other than the patent owner that fails to include proper proof of service as required by § 1.248(b) will not be entered into the patent file.

[77 FR 46626, Aug. 6, 2012]

§ 1.502 Processing of prior art citations during an *ex parte* reexamination proceeding.

Citations by the patent owner under § 1.555 and by an *ex parte* reexamination requester under either § 1.510 or § 1.535 will be entered in the reexamination file during a reexamination proceeding. The entry in the patent file of citations submitted after the date of an order to reexamine pursuant to § 1.525 by persons other than the patent owner, or an *ex parte* reexamination requester under either § 1.510 or § 1.535, will be delayed until the reexamination proceeding has been concluded by the issuance and publication of a reexamination certificate. See § 1.902 for processing of prior art citations in patent and reexamination files during an *inter partes* reexamination proceeding filed under § 1.913.

[72 FR 18905, Apr. 16, 2007]

REQUEST FOR *Ex Parte* REEXAMINATION

§ 1.510 Request for *ex parte* reexamination.

(a) Any person may, at any time during the period of enforceability of a patent, file a request for an *ex parte* reexamination by the Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501, unless prohibited by 35 U.S.C. 315(e)(1) or 35 U.S.C. 325(e)(1). The request must be accompanied by the fee for requesting reexamination set in § 1.20(c)(1).

(b) Any request for reexamination must include the following parts:

(1) A statement pointing out each substantial new question of patentability based on prior patents and printed publications.

(2) An identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested. For each statement of the patent owner and accompanying information submitted pursuant to § 1.501(a)(2) which is relied upon in the detailed explanation, the

request must explain how that statement is being used to determine the proper meaning of a patent claim in connection with the prior art applied to that claim and how each relevant claim is being interpreted. If appropriate, the party requesting reexamination may also point out how claims distinguish over cited prior art.

(3) A copy of every patent or printed publication relied upon or referred to in paragraph (b) (1) and (2) of this section accompanied by an English language translation of all the necessary and pertinent parts of any non-English language patent or printed publication.

(4) A copy of the entire patent including the front face, drawings, and specification/claims (in double column format) for which reexamination is requested, and a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent. All copies must have each page plainly written on only one side of a sheet of paper.

(5) A certification that a copy of the request filed by a person other than the patent owner has been served in its entirety on the patent owner at the address as provided for in §1.33(c). The name and address of the party served must be indicated. If service was not possible, a duplicate copy must be supplied to the Office.

(6) A certification by the third party requester that the statutory estoppel provisions of 35 U.S.C. 315(e)(1) or 35 U.S.C. 325(e)(1) do not prohibit the requester from filing the *ex parte* reexamination request.

(c) If the request does not include the fee for requesting *ex parte* reexamination required by paragraph (a) of this section and meet all the requirements by paragraph (b) of this section, then the person identified as requesting reexamination will be so notified and will generally be given an opportunity to complete the request within a specified time. Failure to comply with the notice will result in the *ex parte* reexamination request not being granted a filing date, and will result in placement of the request in the patent file as a citation if it complies with the requirements of §1.501.

(d) The filing date of the request for *ex parte* reexamination is the date on which the request satisfies all the requirements of this section.

(e) A request filed by the patent owner may include a proposed amendment in accordance with §1.530.

(f) If a request is filed by an attorney or agent identifying another party on whose behalf the request is being filed, the attorney or agent must have a power of attorney from that party or be acting in a representative capacity pursuant to §1.34.

(35 U.S.C. 6; 15 U.S.C. 1113, 1123)

[46 FR 29185, May 29, 1981, as amended at 47 FR 41282, Sept. 17, 1982; 62 FR 53200, Oct. 10, 1997; 65 FR 54678, Sept. 8, 2000; 65 FR 76775, Dec. 7, 2000; 71 FR 9262, Feb. 23, 2006; 71 FR 44223, Aug. 4, 2006; 72 FR 18905, Apr. 16, 2007; 77 FR 46626, Aug. 6, 2012]

§1.515 Determination of the request for *ex parte* reexamination.

(a) Within three months following the filing date of a request for an *ex parte* reexamination, an examiner will consider the request and determine whether or not a substantial new question of patentability affecting any claim of the patent is raised by the request and the prior art cited therein, with or without consideration of other patents or printed publications. A statement and any accompanying information submitted pursuant to §1.501(a)(2) will not be considered by the examiner when making a determination on the request. The examiner's determination will be based on the claims in effect at the time of the determination, will become a part of the official file of the patent, and will be given or mailed to the patent owner at the address provided for in §1.33(c) and to the person requesting reexamination.

(b) Where no substantial new question of patentability has been found, a refund of a portion of the fee for requesting *ex parte* reexamination will be made to the requester in accordance with §1.26(c).

(c) The requester may seek review by a petition to the Director under §1.181 within one month of the mailing date of the examiner's determination refusing *ex parte* reexamination. Any such petition must comply with §1.181(b). If

no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable.

[65 FR 76775, Dec. 7, 2000, as amended at 77 FR 46626, Aug. 6, 2012]

§ 1.520 *Ex parte* reexamination at the initiative of the Director.

The Director, at any time during the period of enforceability of a patent, may determine whether or not a substantial new question of patentability is raised by patents or printed publications which have been discovered by the Director or which have been brought to the Director's attention, even though no request for reexamination has been filed in accordance with §1.510 or §1.913. The Director may initiate *ex parte* reexamination without a request for reexamination pursuant to §1.510 or §1.913. Normally requests from outside the Office that the Director undertake reexamination on his own initiative will not be considered. Any determination to initiate *ex parte* reexamination under this section will become a part of the official file of the patent and will be mailed to the patent owner at the address as provided for in §1.33(c).

[65 FR 76775, Dec. 7, 2000]

Ex Parte REEXAMINATION

§ 1.525 Order for *ex parte* reexamination.

(a) If a substantial new question of patentability is found pursuant to §1.515 or §1.520, the determination will include an order for *ex parte* reexamination of the patent for resolution of the question. If the order for *ex parte* reexamination resulted from a petition pursuant to §1.515(c), the *ex parte* reexamination will ordinarily be conducted by an examiner other than the examiner responsible for the initial determination under §1.515(a).

(b) The notice published in the *Official Gazette* under §1.11(c) will be considered to be constructive notice and *ex parte* reexamination will proceed.

[65 FR 76775, Dec. 7, 2000]

§ 1.530 Statement by patent owner in *ex parte* reexamination; amendment by patent owner in *ex parte* or *inter partes* reexamination; inventorship change in *ex parte* or *inter partes* reexamination.

(a) Except as provided in §1.510(e), no statement or other response by the patent owner in an *ex parte* reexamination proceeding shall be filed prior to the determinations made in accordance with §1.515 or §1.520. If a premature statement or other response is filed by the patent owner, it will not be acknowledged or considered in making the determination, and it will be returned or discarded (at the Office's option).

(b) The order for *ex parte* reexamination will set a period of not less than two months from the date of the order within which the patent owner may file a statement on the new question of patentability, including any proposed amendments the patent owner wishes to make.

(c) Any statement filed by the patent owner shall clearly point out why the subject matter as claimed is not anticipated or rendered obvious by the prior art patents or printed publications, either alone or in any reasonable combinations. Where the reexamination request was filed by a third party requester, any statement filed by the patent owner must be served upon the *ex parte* reexamination requester in accordance with §1.248.

(d) *Making amendments in a reexamination proceeding.* A proposed amendment in an *ex parte* or an *inter partes* reexamination proceeding is made by filing a paper directing that proposed specified changes be made to the patent specification, including the claims, or to the drawings. An amendment paper directing that proposed specified changes be made in a reexamination proceeding may be submitted as an accompaniment to a request filed by the patent owner in accordance with §1.510(e), as part of a patent owner statement in accordance with paragraph (b) of this section, or, where permitted, during the prosecution of the reexamination proceeding pursuant to §1.550(a) or §1.937.

(1) *Specification other than the claims, ''Large Tables'' (§1.58(c)), a ''Computer*

Program Listing Appendix'' (§1.96(c)), a ''Sequence Listing'' (§1.821(c)), or a ''Sequence Listing XML (§1.831(a)). (i) Changes to the specification, other than to the claims, ''Large Tables'' (§1.58(c)), a ''Computer Program Listing Appendix'' (§1.96(c)), a ''Sequence Listing'' (§1.821(c)), or a ''Sequence Listing XML'' (§1.831(a)), must be made by submission of the entire text of an added or rewritten paragraph, including markings pursuant to paragraph (f) of this section, except that an entire paragraph may be deleted by a statement deleting the paragraph, without presentation of the text of the paragraph. The precise point in the specification where any added or rewritten paragraph is located must be identified.

(ii) Changes to ''Large Tables,'' a ''Computer Program Listing Appendix,'' a ''Sequence Listing,'' or a ''Sequence Listing XML'' must be made in accordance with §1.58(g) for ''Large Tables,'' §1.96(c)(5) for a ''Computer Program Listing Appendix,'' §1.825 for a ''Sequence Listing,'' or §1.835 for a ''Sequence Listing XML.''

(2) *Claims*. An amendment paper must include the entire text of each patent claim which is being proposed to be changed by such amendment paper and of each new claim being proposed to be added by such amendment paper. For any claim changed by the amendment paper, a parenthetical expression ''amended,'' ''twice amended,'' etc., should follow the claim number. Each patent claim proposed to be changed and each proposed added claim must include markings pursuant to paragraph (f) of this section, except that a patent claim or proposed added claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

(3) *Drawings*. Any change to the patent drawings must be submitted as a sketch on a separate paper showing the proposed changes in red for approval by the examiner. Upon approval of the changes by the examiner, only new sheets of drawings including the changes and in compliance with §1.84 must be filed. Amended figures must be identified as ''Amended,'' and any added figure must be identified as ''New.'' In the event a figure is canceled, the figure must be surrounded by brackets and identified as ''Canceled.''

(4) The formal requirements for papers making up the reexamination proceeding other than those set forth in this section are set out in §1.52.

(e) *Status of claims and support for claim changes*. Whenever there is an amendment to the claims pursuant to paragraph (d) of this section, there must also be supplied, on pages separate from the pages containing the changes, the status (*i.e.*, pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes to the claims made by the amendment paper.

(f) *Changes shown by markings*. Any changes relative to the patent being reexamined which are made to the specification, including the claims, must include the following markings:

(1) The matter to be omitted by the reexamination proceeding must be enclosed in brackets; and

(2) The matter to be added by the reexamination proceeding must be underlined.

(g) *Numbering of patent claims preserved*. Patent claims may not be renumbered. The numbering of any claims added in the reexamination proceeding must follow the number of the highest numbered patent claim.

(h) *Amendment of disclosure may be required*. The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(i) *Amendments made relative to patent*. All amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination.

(j) *No enlargement of claim scope*. No amendment may enlarge the scope of the claims of the patent or introduce new matter. No amendment may be proposed for entry in an expired patent. Moreover, no amendment, other than the cancellation of claims, will be

incorporated into the patent by a certificate issued after the expiration of the patent.

(k) *Amendments not effective until certificate.* Although the Office actions will treat proposed amendments as though they have been entered, the proposed amendments will not be effective until the reexamination certificate is issued and published.

(l) *Correction of inventorship in an ex parte or inter partes reexamination proceeding.* (1) When it appears in a patent being reexamined that the correct inventor or inventors were not named, the Director may, on petition of all the parties set forth in §1.324(b)(1) and (b)(2), including the assignees, and satisfactory proof of the facts and payment of the fee set forth in §1.20(b), or on order of a court before which such matter is called in question, include in the reexamination certificate to be issued under §1.570 or §1.997 an amendment naming only the actual inventor or inventors. The petition must be submitted as part of the reexamination proceeding and must satisfy the requirements of §1.324.

(2) Notwithstanding paragraph (l)(1) of this section, if a petition to correct inventorship satisfying the requirements of §1.324 is filed in a reexamination proceeding, and the reexamination proceeding is concluded other than by a reexamination certificate under §1.570 or §1.997, a certificate of correction indicating the change of inventorship stated in the petition will be issued upon request by the patentee.

[46 FR 29185, May 29, 1981, as amended at 62 FR 53200, Oct. 10, 1997; 65 FR 54678, Sept. 8, 2000; 65 FR 76775, Dec. 7, 2000; 72 FR 18905, Apr. 16, 2007; 77 FR 48825, Aug. 14, 2012; 86 FR 57048, Oct. 14, 2021; 87 FR 30818, May 20, 2022]

§ 1.535 Reply by third party requester in *ex parte* reexamination.

A reply to the patent owner's statement under §1.530 may be filed by the *ex parte* reexamination requester within two months from the date of service of the patent owner's statement. Any reply by the *ex parte* requester must be served upon the patent owner in accordance with §1.248. If the patent owner does not file a statement under §1.530, no reply or other submission from the *ex parte* reexamination requester will be considered.

[65 FR 76776, Dec. 7, 2000]

§ 1.540 Consideration of responses in *ex parte* reexamination.

The failure to timely file or serve the documents set forth in §1.530 or in §1.535 may result in their being refused consideration. No submissions other than the statement pursuant to §1.530 and the reply by the *ex parte* reexamination requester pursuant to §1.535 will be considered prior to examination.

[65 FR 76776, Dec. 7, 2000]

§ 1.550 Conduct of *ex parte* reexamination proceedings.

(a) All *ex parte* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office. After issuance of the *ex parte* reexamination order and expiration of the time for submitting any responses, the examination will be conducted in accordance with §§1.104 through 1.116 and will result in the issuance of an *ex parte* reexamination certificate under §1.570.

(b) The patent owner in an *ex parte* reexamination proceeding will be given at least thirty days to respond to any Office action. In response to any rejection, such response may include further statements and/or proposed amendments or new claims to place the patent in a condition where all claims, if amended as proposed, would be patentable.

(c) The time for taking any action by a patent owner in an *ex parte* reexamination proceeding may be extended as provided in this paragraph.

(1) Any request for such an extension must specify the requested period of extension and be accompanied by the petition fee set forth in §1.17(g).

(2) Any request for an extension in a third party requested *ex parte* reexamination must be filed on or before the day on which action by the patent owner is due, and the mere filing of such a request for extension will not effect the extension. A request for an extension in a third party requested *ex parte* reexamination will not be granted

in the absence of sufficient cause or for more than a reasonable time.

(3) Any request for an extension in a patent owner requested or Director ordered *ex parte* reexamination for up to two months from the time period set in the Office action must be filed no later than two months from the expiration of the time period set in the Office action. A request for an extension in a patent owner requested or Director ordered *ex parte* reexamination for more than two months from the time period set in the Office action must be filed on or before the day on which action by the patent owner is due, and the mere filing of a request for an extension for more than two months from the time period set in the Office action will not effect the extension. The time for taking action in a patent owner requested or Director ordered *ex parte* reexamination will not be extended for more than two months from the time period set in the Office action in the absence of sufficient cause or for more than a reasonable time.

(4) The reply or other action must in any event be filed prior to the expiration of the period of extension, but in no situation may a reply or other action be filed later than the maximum time period set by statute.

(5) See §90.3(c) of this title for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.

(d) If the patent owner fails to file a timely and appropriate response to any Office action or any written statement of an interview required under §1.560(b), the prosecution in the *ex parte* reexamination proceeding will be a terminated prosecution, and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under §1.570 in accordance with the last action of the Office.

(e) If a response by the patent owner is not timely filed in the Office, a petition may be filed pursuant to §1.137 to revive a reexamination prosecution terminated under paragraph (d) of this section if the delay in response was unintentional.

(f) The reexamination requester will be sent copies of Office actions issued during the *ex parte* reexamination proceeding. After filing of a request for *ex parte* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party in the reexamination proceeding in the manner provided by §1.248. The document must reflect service or the document may be refused consideration by the Office.

(g) The active participation of the *ex parte* reexamination requester ends with the reply pursuant to §1.535, and no further submissions on behalf of the reexamination requester will be acknowledged or considered. Further, no submissions on behalf of any third parties will be acknowledged or considered unless such submissions are:

(1) in accordance with §1.510 or §1.535; or

(2) entered in the patent file prior to the date of the order for *ex parte* reexamination pursuant to §1.525.

(h) Submissions by third parties, filed after the date of the order for *ex parte* reexamination pursuant to §1.525, must meet the requirements of and will be treated in accordance with §1.501(a).

(i) A petition in an *ex parte* reexamination proceeding must be accompanied by the fee set forth in §1.20(c)(6), except for petitions under paragraph (c) of this section to extend the period for response by a patent owner, petitions under paragraph (e) of this section to accept a delayed response by a patent owner, petitions under §1.78 to accept an unintentionally delayed benefit claim, and petitions under §1.530(l) for correction of inventorship in a reexamination proceeding.

[65 FR 76776, Dec. 7, 2000, as amended at 69 FR 56545, Sept. 21, 2004; 72 FR 18905, Apr. 16, 2007; 77 FR 48851, Aug. 14, 2012; 78 FR 62407, Oct. 21, 2013]

§1.552 Scope of reexamination in *ex parte* reexamination proceedings.

(a) Claims in an *ex parte* reexamination proceeding will be examined on the basis of patents or printed publications and, with respect to subject matter added or deleted in the reexamination proceeding, on the basis of the requirements of 35 U.S.C. 112.

(b) Claims in an *ex parte* reexamination proceeding will not be permitted

to enlarge the scope of the claims of the patent.

(c) Issues other than those indicated in paragraphs (a) and (b) of this section will not be resolved in a reexamination proceeding. If such issues are raised by the patent owner or third party requester during a reexamination proceeding, the existence of such issues will be noted by the examiner in the next Office action, in which case the patent owner may consider the advisability of filing a reissue application to have such issues considered and resolved.

(d) Any statement of the patent owner and any accompanying information submitted pursuant to §1.501(a)(2) which is of record in the patent being reexamined (which includes any reexamination files for the patent) may be used after a reexamination proceeding has been ordered to determine the proper meaning of a patent claim when applying patents or printed publications.

[65 FR 76776, Dec. 7, 2000, as amended at 77 FR 46627, Aug. 6, 2012]

§ 1.555 Information material to patentability in *ex parte* reexamination and *inter partes* reexamination proceedings.

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective reexamination occurs when, at the time a reexamination proceeding is being conducted, the Office is aware of and evaluates the teachings of all information material to patentability in a reexamination proceeding. Each individual associated with the patent owner in a reexamination proceeding has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability in a reexamination proceeding. The individuals who have a duty to disclose to the Office all information known to them to be material to patentability in a reexamination proceeding are the patent owner, each attorney or agent who represents the patent owner, and every other individual who is substantively involved on behalf of the patent owner in a reexamination proceeding. The duty to disclose the information exists with respect to each claim pending in the reexamination proceeding until the claim is cancelled. Information material to the patentability of a cancelled claim need not be submitted if the information is not material to patentability of any claim remaining under consideration in the reexamination proceeding. The duty to disclose all information known to be material to patentability in a reexamination proceeding is deemed to be satisfied if all information known to be material to patentability of any claim in the patent after issuance of the reexamination certificate was cited by the Office or submitted to the Office in an information disclosure statement. However, the duties of candor, good faith, and disclosure have not been complied with if any fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct by, or on behalf of, the patent owner in the reexamination proceeding. Any information disclosure statement must be filed with the items listed in §1.98(a) as applied to individuals associated with the patent owner in a reexamination proceeding, and should be filed within two months of the date of the order for reexamination, or as soon thereafter as possible.

(b) Under this section, information is material to patentability in a reexamination proceeding when it is not cumulative to information of record or being made of record in the reexamination proceeding, and

(1) It is a patent or printed publication that establishes, by itself or in combination with other patents or printed publications, a prima facie case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the patent owner takes in:

(i) Opposing an argument of unpatentability relied on by the Office, or

(ii) Asserting an argument of patentability.

A prima facie case of unpatentability of a claim pending in a reexamination proceeding is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-

proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

(c) The responsibility for compliance with this section rests upon the individuals designated in paragraph (a) of this section and no evaluation will be made by the Office in the reexamination proceeding as to compliance with this section. If questions of compliance with this section are raised by the patent owner or the third party requester during a reexamination proceeding, they will be noted as unresolved questions in accordance with §1.552(c).

[57 FR 2036, Jan. 17, 1992, as amended at 65 FR 76776, Dec. 7, 2000]

§1.560 Interviews in *ex parte* reexamination proceedings.

(a) Interviews in *ex parte* reexamination proceedings pending before the Office between examiners and the owners of such patents or their attorneys or agents of record must be conducted in the Office at such times, within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director. Interviews for the discussion of the patentability of claims in patents involved in *ex parte* reexamination proceedings will not be conducted prior to the first official action. Interviews should be arranged in advance. Requests that reexamination requesters participate in interviews with examiners will not be granted.

(b) In every instance of an interview with an examiner in an *ex parte* reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner. An interview does not remove the necessity for response to Office actions as specified in §1.111. Patent owner's response to an outstanding Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.

[65 FR 76777, Dec. 7, 2000]

§1.565 Concurrent office proceedings which include an *ex parte* reexamination proceeding.

(a) In an *ex parte* reexamination proceeding before the Office, the patent owner must inform the Office of any prior or concurrent proceedings in which the patent is or was involved such as interferences, reissues, *ex parte* reexaminations, *inter partes* reexaminations, or litigation and the results of such proceedings. See §1.985 for notification of prior or concurrent proceedings in an *inter partes* reexamination proceeding.

(b) If a patent in the process of *ex parte* reexamination is or becomes involved in litigation, the Director shall determine whether or not to suspend the reexamination. See §1.987 for *inter partes* reexamination proceedings.

(c) If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination proceeding has not been terminated, the *ex parte* reexamination proceedings will usually be merged and result in the issuance and publication of a single certificate under §1.570. For merger of *inter partes* reexamination proceedings, see §1.989(a). For merger of *ex parte* reexamination and *inter partes* reexamination proceedings, see §1.989(b).

(d) If a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to §1.525 has been mailed are pending concurrently on a patent, a decision will usually be made to merge the two proceedings or to suspend one of the two proceedings. Where merger of a reissue application and an *ex parte* reexamination proceeding is ordered, the merged examination will be conducted in accordance with §§1.171 through 1.179, and the patent owner will be required to place and maintain the same claims in the reissue application and the *ex parte* reexamination proceeding during the pendency of the merged proceeding. The examiner's actions and responses by the patent owner in a merged proceeding will apply to both the reissue

application and the *ex parte* reexamination proceeding and will be physically entered into both files. Any *ex parte* reexamination proceeding merged with a reissue application shall be concluded by the grant of the reissued patent. For merger of a reissue application and an *inter partes* reexamination, see §1.991.

(e) If a patent in the process of *ex parte* reexamination is or becomes involved in an interference, the Director may suspend the reexamination or the interference. The Director will not consider a request to suspend an interference unless a motion (§41.121(a)(3) of this title) to suspend the interference has been presented to, and denied by, an administrative patent judge, and the request is filed within ten (10) days of a decision by an administrative patent judge denying the motion for suspension or such other time as the administrative patent judge may set. For concurrent *inter partes* reexamination and interference of a patent, see §1.993.

[65 FR 76776, Dec. 7, 2000, as amended at 69 FR 50001, Aug. 12, 2004; 72 FR 18905, Apr. 16, 2007]

Ex Parte REEXAMINATION CERTIFICATE

§1.570 Issuance and publication of *ex parte* reexamination certificate concludes *ex parte* reexamination proceeding.

(a) To conclude an *ex parte* reexamination proceeding, the Director will issue and publish an *ex parte* reexamination certificate in accordance with 35 U.S.C. 307 setting forth the results of the *ex parte* reexamination proceeding and the content of the patent following the *ex parte* reexamination proceeding.

(b) An *ex parte* reexamination certificate will be issued and published in each patent in which an *ex parte* reexamination proceeding has been ordered under §1.525 and has not been merged with any *inter partes* reexamination proceeding pursuant to §1.989(a). Any statutory disclaimer filed by the patent owner will be made part of the *ex parte* reexamination certificate.

(c) The *ex parte* reexamination certificate will be mailed on the day of its date to the patent owner at the address as provided for in §1.33(c). A copy of the *ex parte* reexamination certificate will also be mailed to the requester of the *ex parte* reexamination proceeding.

(d) If an *ex parte* reexamination certificate has been issued and published which cancels all of the claims of the patent, no further Office proceedings will be conducted with that patent or any reissue applications or any reexamination requests relating thereto.

(e) If the *ex parte* reexamination proceeding is terminated by the grant of a reissued patent as provided in §1.565(d), the reissued patent will constitute the *ex parte* reexamination certificate required by this section and 35 U.S.C. 307.

(f) A notice of the issuance of each *ex parte* reexamination certificate under this section will be published in the *Official Gazette* on its date of issuance.

[65 FR 76777, Dec. 7, 2000, as amended at 72 FR 18905, Apr. 16, 2007]

Subpart E—Supplemental Examination of Patents

SOURCE: 77 FR 48851, Aug. 14, 2012, unless otherwise noted.

§1.601 Filing of papers in supplemental examination.

(a) A request for supplemental examination of a patent must be filed by the owner(s) of the entire right, title, and interest in the patent.

(b) Any party other than the patent owner (*i.e.*, any third party) is prohibited from filing papers or otherwise participating in any manner in a supplemental examination proceeding.

(c) A request for supplemental examination of a patent may be filed at any time during the period of enforceability of the patent.

§1.605 Items of information.

(a) Each request for supplemental examination may include no more than twelve items of information believed to be relevant to the patent. More than one request for supplemental examination of the same patent may be filed at any time during the period of enforceability of the patent.

(b) An item of information includes a document submitted as part of the request that contains information, believed to be relevant to the patent,

that the patent owner requests the Office to consider, reconsider, or correct. If the information to be considered, reconsidered, or corrected is not, at least in part, contained within or based on any document submitted as part of the request, the discussion within the body of the request relative to the information will be considered as an item of information.

(c) An item of information must be in writing in accordance with §1.2. To be considered, any audio or video recording must be submitted in the form of a written transcript.

(d) If one item of information is combined in the request with one or more additional items of information, each item of information of the combination may be separately counted. Exceptions include the combination of a non-English language document and its translation, and the combination of a document that is over 50 pages in length and its summary pursuant to §1.610(b)(8).

§1.610 Content of request for supplemental examination.

(a) A request for supplemental examination must be accompanied by the fee for filing a request for supplemental examination as set forth in §1.20(k)(1), the fee for reexamination ordered as a result of a supplemental examination proceeding as set forth in §1.20(k)(2), and any applicable document size fees as set forth in §1.20(k)(3).

(b) A request for supplemental examination must include:

(1) An identification of the number of the patent for which supplemental examination is requested.

(2) A list of the items of information that are requested to be considered, reconsidered, or corrected. Where appropriate, the list must meet the requirements of §1.98(b).

(3) A list identifying any other prior or concurrent post-patent Office proceedings involving the patent for which supplemental examination is being requested, including an identification of the type of proceeding, the identifying number of any such proceeding (*e.g.*, a control number or reissue application number), and the filing date of any such proceeding.

(4) An identification of each claim of the patent for which supplemental examination is requested.

(5) A separate, detailed explanation of the relevance and manner of applying each item of information to each claim of the patent for which supplemental examination is requested.

(6) A copy of the patent for which supplemental examination is requested and a copy of any disclaimer or certificate issued for the patent.

(7) A copy of each item of information listed in paragraph (b)(2) of this section, accompanied by a written English translation of all of the necessary and pertinent parts of any non-English language item of information. The patent owner is not required to submit copies of items of information that form part of the discussion within the body of the request as specified in §1.605(b), or copies of U.S. patents and U.S. patent application publications.

(8) A summary of the relevant portions of any submitted document, other than the request, that is over 50 pages in length. The summary must include citations to the particular pages containing the relevant portions.

(9) An identification of the owner(s) of the entire right, title, and interest in the patent requested to be examined, and a submission by the patent owner in compliance with §3.73(c) of this chapter establishing the entirety of the ownership in the patent requested to be examined.

(c) The request may also include:

(1) A cover sheet itemizing each component submitted as part of the request;

(2) A table of contents for the request;

(3) An explanation of how the claims patentably distinguish over the items of information; and

(4) An explanation of why each item of information submitted with the request does or does not raise a substantial new question of patentability.

(d) The filing date of a request for supplemental examination will not be granted if the request is not in compliance with §§1.605, 1.615, and this section, subject to the discretion of the Office. If the Office determines that the request, as originally submitted, is not entitled to a filing date, the patent

owner will be so notified and will be given an opportunity to complete the request within a specified time. If the patent owner does not timely comply with the notice, the request for supplemental examination will not be granted a filing date and the fee for reexamination as set forth in §1.20(k)(2) will be refunded. If the patent owner timely files a corrected request in response to the notice that properly addresses all of the defects set forth in the notice and that otherwise complies with all of the requirements of §§1.605, 1.615, and this section, the filing date of the supplemental examination request will be the receipt date of the corrected request.

§1.615 Format of papers filed in a supplemental examination proceeding.

(a) All papers submitted in a supplemental examination proceeding must be formatted in accordance with §1.52.

(b) Court documents and non-patent literature may be redacted, but must otherwise be identical both in content and in format to the original documents, and, if a court document, to the document submitted in court, and must not otherwise be reduced in size or modified, particularly in terms of font type, font size, line spacing, and margins. Patents, patent application publications, and third-party-generated affidavits or declarations must not be reduced in size or otherwise modified in the manner described in this paragraph.

§1.620 Conduct of supplemental examination proceeding.

(a) Within three months after the filing date of a request for supplemental examination, the Office will determine whether a substantial new question of patentability affecting any claim of the patent is raised by any of the items of information presented in the request. The determination will generally be limited to a review of the item(s) of information identified in the request as applied to the identified claim(s) of the patent. The determination will be based on the claims in effect at the time of the determination and will become a part of the official record of the patent.

(b) The Office may hold in abeyance action on any petition or other paper filed in a supplemental examination proceeding until after the proceeding is concluded by the electronic issuance of the supplemental examination certificate as set forth in §1.625.

(c) If an unauthorized or otherwise improper paper is filed in a supplemental examination proceeding, it will not be entered into the official file or considered, or if inadvertently entered, it will be expunged.

(d) The patent owner must, as soon as possible upon the discovery of any other prior or concurrent post-patent Office proceeding involving the patent for which the current supplemental examination is requested, file a paper limited to notifying the Office of the post- patent Office proceeding, if such notice has not been previously provided with the request. The notice shall be limited to an identification of the post-patent Office proceeding, including the type of proceeding, the identifying number of any such proceeding (*e.g.*, a control number or reissue application number), and the filing date of any such proceeding, without any discussion of the issues of the current supplemental examination proceeding or of the identified post-patent Office proceeding(s).

(e) Interviews are prohibited in a supplemental examination proceeding.

(f) No amendment may be filed in a supplemental examination proceeding.

(g) If the Office becomes aware, during the course of supplemental examination or of any reexamination ordered under 35 U.S.C. 257 as a result of the supplemental examination proceeding, that a material fraud on the Office may have been committed in connection with the patent requested to be examined, the supplemental examination proceeding or any reexamination proceeding ordered under 35 U.S.C. 257 will continue, and the matter will be referred to the U.S. Attorney General in accordance with 35 U.S.C. 257(e).

§ 1.625 Conclusion of supplemental examination; publication of supplemental examination certificate; procedure after conclusion.

(a) A supplemental examination proceeding will conclude with the electronic issuance of a supplemental examination certificate. The supplemental examination certificate will indicate the result of the determination whether any of the items of information presented in the request raised a substantial new question of patentability.

(b) If the supplemental examination certificate states that a substantial new question of patentability is raised by one or more items of information in the request, *ex parte* reexamination of the patent will be ordered under 35 U.S.C. 257. Upon the conclusion of the *ex parte* reexamination proceeding, an *ex parte* reexamination certificate, which will include a statement specifying that *ex parte* reexamination was ordered under 35 U.S.C. 257, will be published. The electronically issued supplemental examination certificate will remain as part of the public record of the patent.

(c) If the supplemental examination certificate indicates that no substantial new question of patentability is raised by any of the items of information in the request, and *ex parte* reexamination is not ordered under 35 U.S.C. 257, the electronically issued supplemental examination certificate will be published in due course. The fee for reexamination ordered as a result of supplemental examination, as set forth in §1.20(k)(2), will be refunded in accordance with §1.26(c).

(d) Any *ex parte* reexamination ordered under 35 U.S.C. 257 will be conducted in accordance with §§1.530 through 1.570, which govern *ex parte* reexamination, except that:

(1) The patent owner will not have the right to file a statement pursuant to §1.530, and the order will not set a time period within which to file such a statement;

(2) Reexamination of any claim of the patent may be conducted on the basis of any item of information as set forth in §1.605, and is not limited to patents and printed publications or to subject matter that has been added or deleted during the reexamination proceeding, notwithstanding §1.552(a);

(3) Issues in addition to those raised by patents and printed publications, and by subject matter added or deleted during a reexamination proceeding, may be considered and resolved, notwithstanding §1.552(c); and

(4) Information material to patentability will be defined by §1.56(b), notwithstanding §1.555(b).

Subpart F—Adjustment and Extension of Patent Term

AUTHORITY: 35 U.S.C. 2(b)(2), 154, and 156.

SOURCE: 52 FR 9394, Mar. 24, 1987, unless otherwise noted.

ADJUSTMENT OF PATENT TERM DUE TO EXAMINATION DELAY

§ 1.701 Extension of patent term due to examination delay under the Uruguay Round Agreements Act (original applications, other than designs, filed on or after June 8, 1995, and before May 29, 2000).

(a) A patent, other than for designs, issued on an application filed on or after June 8, 1995, is entitled to extension of the patent term if the issuance of the patent was delayed due to:

(1) Interference or derivation proceedings under 35 U.S.C. 135(a); and/or

(2) The application being placed under a secrecy order under 35 U.S.C. 181; and/or

(3) Appellate review by the Patent Trial and Appeal Board or by a Federal court under 35 U.S.C. 141 or 145, if the patent was issued pursuant to a decision in the review reversing an adverse determination of patentability and if the patent is not subject to a terminal disclaimer due to the issuance of another patent claiming subject matter that is not patentably distinct from that under appellate review. If an application is remanded by a panel of the Patent Trial and Appeal Board and the remand is the last action by a panel of the Patent Trial and Appeal Board prior to the mailing of a notice of allowance under 35 U.S.C. 151 in the application, the remand shall be considered a decision in the review reversing an adverse determination of patentability as that phrase is used in 35

U.S.C. 154(b)(2) as amended by section 532(a) of the Uruguay Round Agreements Act, Public Law 103–465, 108 Stat. 4809, 4983–85 (1994), and a final decision in favor of the applicant under paragraph (c)(3) of this section. A remand by a panel of the Patent Trial and Appeal Board shall not be considered a decision in the review reversing an adverse determination of patentability as provided in this paragraph if there is filed a request for continued examination under 35 U.S.C. 132(b) that was not first preceded by the mailing, after such remand, of at least one of an action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151.

(b) The term of a patent entitled to extension under paragraph (a) of this section shall be extended for the sum of the periods of delay calculated under paragraphs (c)(1), (c)(2), (c)(3) and (d) of this section, to the extent that these periods are not overlapping, up to a maximum of five years. The extension will run from the expiration date of the patent.

(c)(1) The period of delay under paragraph (a)(1) of this section for an application is the sum of the following periods, to the extent that the periods are not overlapping:

(i) With respect to each interference or derivation proceeding in which the application was involved, the number of days, if any, in the period beginning on the date the interference or derivation proceeding was instituted to involve the application in the interference or derivation proceeding and ending on the date that the interference or derivation proceeding was terminated with respect to the application; and

(ii) The number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Patent and Trademark Office due to interference or derivation proceedings under 35 U.S.C. 135(a) not involving the application and ending on the date of the termination of the suspension.

(2) The period of delay under paragraph (a)(2) of this section for an application is the sum of the following periods, to the extent that the periods are not overlapping:

(i) The number of days, if any, the application was maintained in a sealed condition under 35 U.S.C. 181;

(ii) The number of days, if any, in the period beginning on the date of mailing of an examiner's answer under § 41.39 of this title in the application under secrecy order and ending on the date the secrecy order and any renewal thereof was removed;

(iii) The number of days, if any, in the period beginning on the date applicant was notified that an interference or derivation proceeding would be instituted but for the secrecy order and ending on the date the secrecy order and any renewal thereof was removed; and

(iv) The number of days, if any, in the period beginning on the date of notification under § 5.3(c) and ending on the date of mailing of the notice of allowance under § 1.311.

(3) The period of delay under paragraph (a)(3) of this section is the sum of the number of days, if any, in the period beginning on the date on which an appeal to the Patent Trial and Appeal Board was filed under 35 U.S.C. 134 and ending on the date of a final decision in favor of the applicant by the Patent Trial and Appeal Board or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145.

(d) The period of delay set forth in paragraph (c)(3) shall be reduced by:

(1) Any time during the period of appellate review that occurred before three years from the filing date of the first national application for patent presented for examination; and

(2) Any time during the period of appellate review, as determined by the Director, during which the applicant for patent did not act with due diligence. In determining the due diligence of an applicant, the Director may examine the facts and circumstances of the applicant's actions during the period of appellate review to determine whether the applicant exhibited that degree of timeliness as may reasonably be expected from, and which is ordinarily exercised by, a person during a period of appellate review.

(e) The provisions of this section apply only to original patents, except

for design patents, issued on applications filed on or after June 8, 1995, and before May 29, 2000.

[60 FR 20228, Apr. 25, 1995, as amended at 65 FR 56391, Sept. 18, 2000; 69 FR 21710, Apr. 22, 2004; 69 FR 50001, Aug. 12, 2004; 77 FR 46627, Aug. 6, 2012]

§ 1.702 Grounds for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999 (original applications, other than designs, filed on or after May 29, 2000).

(a) *Failure to take certain actions within specified time frames.* Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or the date the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application;

(2) Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken;

(3) Act on an application not later than four months after the date of a decision by the Patent Trial and Appeal Board under 35 U.S.C. 134 or 135 or a decision by a Federal court under 35 U.S.C. 141, 145, or 146 where at least one allowable claim remains in the application; or

(4) Issue a patent not later than four months after the date on which the issue fee was paid under 35 U.S.C. 151 and all outstanding requirements were satisfied.

(b) *Three-year pendency.* Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, but not including:

(1) Any time consumed by continued examination of the application under 35 U.S.C. 132(b);

(2) Any time consumed by an interference or derivation proceeding under 35 U.S.C. 135(a);

(3) Any time consumed by the imposition of a secrecy order under 35 U.S.C. 181;

(4) Any time consumed by review by the Patent Trial and Appeal Board or a Federal court; or

(5) Any delay in the processing of the application by the Office that was requested by the applicant.

(c) *Delays caused by interference and derivation proceedings.* Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to interference or derivation proceedings under 35 U.S.C. 135(a).

(d) *Delays caused by secrecy order.* Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the application being placed under a secrecy order under 35 U.S.C. 181.

(e) *Delays caused by successful appellate review.* Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to review by the Patent Trial and Appeal Board under 35 U.S.C. 134 or by a Federal court under 35 U.S.C. 141 or 145, if the patent was issued under a decision in the review reversing an adverse determination of patentability. If an application is remanded by a panel of the Patent Trial and Appeal Board and the remand is the last action by a panel of the Patent Trial and Appeal Board prior to the mailing of a notice of allowance under 35 U.S.C. 151 in the application, the remand shall be considered a decision by the Patent Trial and Appeal Board as that phrase is used in 35 U.S.C. 154(b)(1)(A)(iii), a decision in the review reversing an adverse determination of patentability as that phrase is used in 35 U.S.C. 154(b)(1)(C)(iii), and a final decision in favor of the applicant under §1.703(e). A remand by a panel of the Patent Trial and Appeal Board shall

not be considered a decision in the review reversing an adverse determination of patentability as provided in this paragraph if there is filed a request for continued examination under 35 U.S.C. 132(b) that was not first preceded by the mailing, after such remand, of at least one of an action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151.

(f) The provisions of this section and §§1.703 through 1.705 apply only to original applications, except applications for a design patent, filed on or after May 29, 2000, and patents issued on such applications.

[65 FR 56391, Sept. 18, 2000, as amended at 69 FR 21711, Apr. 22, 2004; 77 FR 46627, Aug. 6, 2012; 78 FR 19420, Apr. 1, 2013]

§ 1.703 Period of adjustment of patent term due to examination delay.

(a) The period of adjustment under §1.702(a) is the sum of the following periods:

(1) The number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or the date the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

(2) The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply under §1.111 was filed and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

(3) The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply in compliance with §1.113(c) was filed and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

(4) The number of days, if any, in the period beginning on the day after the date that is four months after the date an appeal brief in compliance with §41.37 of this title was filed and ending on the date of mailing of any of an examiner's answer under §41.39 of this title, an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

(5) The number of days, if any, in the period beginning on the day after the date that is four months after the date of a final decision by the Patent Trial and Appeal Board or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145 or 146 where at least one allowable claim remains in the application and ending on the date of mailing of either an action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151, whichever occurs first; and

(6) The number of days, if any, in the period beginning on the day after the date that is four months after the date the issue fee was paid and all outstanding requirements were satisfied and ending on the date a patent was issued.

(b) The period of adjustment under §1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the sum of the following periods:

(1) The number of days, if any, in the period beginning on the date on which any request for continued examination of the application under 35 U.S.C. 132(b) was filed and ending on the date of mailing of the notice of allowance under 35 U.S.C. 151;

(2)(i) The number of days, if any, in the period beginning on the date an interference or derivation proceeding was instituted to involve the application in the interference or derivation proceeding under 35 U.S.C. 135(a) and ending on the date that the interference or derivation proceeding was terminated with respect to the application; and

(ii) The number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Office due to interference or derivation proceedings under 35 U.S.C. 135(a) not involving the application and

ending on the date of the termination of the suspension;

(3)(i) The number of days, if any, the application was maintained in a sealed condition under 35 U.S.C. 181;

(ii) The number of days, if any, in the period beginning on the date of mailing of an examiner's answer under §41.39 of this title in the application under secrecy order and ending on the date the secrecy order was removed;

(iii) The number of days, if any, in the period beginning on the date applicant was notified that an interference or derivation proceeding under 35 U.S.C. 135(a) would be instituted but for the secrecy order and ending on the date the secrecy order was removed; and

(iv) The number of days, if any, in the period beginning on the date of notification under §5.3(c) of this chapter and ending on the date of mailing of the notice of allowance under 35 U.S.C. 151; and,

(4) The number of days, if any, in the period beginning on the date on which jurisdiction over the application passes to the Patent Trial and Appeal Board under §41.35(a) of this chapter and ending on the date that jurisdiction by the Patent Trial and Appeal Board ends under §41.35(b) of this chapter or the date of the last decision by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145, whichever is later.

(c) The period of adjustment under §1.702(c) is the sum of the following periods, to the extent that the periods are not overlapping:

(1) The number of days, if any, in the period beginning on the date an interference or derivation proceeding was instituted to involve the application in the interference or derivation proceeding under 35 U.S.C. 135(a) and ending on the date that the interference or derivation proceeding was terminated with respect to the application; and

(2) The number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Office due to interference or derivation proceedings under 35 U.S.C. 135(a) not involving the application and ending on the date of the termination of the suspension.

(d) The period of adjustment under §1.702(d) is the sum of the following periods, to the extent that the periods are not overlapping:

(1) The number of days, if any, the application was maintained in a sealed condition under 35 U.S.C. 181;

(2) The number of days, if any, in the period beginning on the date of mailing of an examiner's answer under §41.39 of this title in the application under secrecy order and ending on the date the secrecy order was removed;

(3) The number of days, if any, in the period beginning on the date applicant was notified that an interference or derivation proceeding under 35 U.S.C. 135(a) would be instituted but for the secrecy order and ending on the date the secrecy order was removed; and

(4) The number of days, if any, in the period beginning on the date of notification under §5.3(c) of this chapter and ending on the date of mailing of the notice of allowance under 35 U.S.C. 151.

(e) The period of adjustment under §1.702(e) is the sum of the number of days, if any, in the period beginning on the date on which jurisdiction over the application passes to the Patent Trial and Appeal Board under §41.35(a) of this chapter and ending on the date of a final decision in favor of the applicant by the Patent Trial and Appeal Board or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145.

(f) The adjustment will run from the expiration date of the patent as set forth in 35 U.S.C. 154(a)(2). To the extent that periods of delay attributable to the grounds specified in §1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed. The term of a patent entitled to adjustment under §1.702 and this section shall be adjusted for the sum of the periods calculated under paragraphs (a) through (e) of this section, to the extent that such periods are not overlapping, less the sum of the periods calculated under §1.704. The date indicated on any certificate of mailing or transmission under §1.8 shall not be taken into account in this calculation.

(g) No patent, the term of which has been disclaimed beyond a specified

date, shall be adjusted under §1.702 and this section beyond the expiration date specified in the disclaimer.

[65 FR 56392, Sept. 18, 2000, as amended at 69 FR 21711, Apr. 22, 2004; 69 FR 50001, Aug. 12, 2004; 77 FR 46628, Aug. 6, 2012; 77 FR 49360, Aug. 16, 2012; 78 FR 19420, Apr. 1, 2013; 80 FR 1356, Jan. 9, 2015]

§ 1.704 Reduction of period of adjustment of patent term.

(a) The period of adjustment of the term of a patent under §§1.703(a) through (e) shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution (processing or examination) of the application.

(b) With respect to the grounds for adjustment set forth in §§1.702(a) through (e), and in particular the ground of adjustment set forth in §1.702(b), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in §1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

(c) Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in §1.703 to the extent that the periods are not overlapping:

(1) Suspension of action under §1.103 at the applicant's request, in which case the period of adjustment set forth in §1.703 shall be reduced by the number of days, if any, beginning on the date a request for suspension of action under §1.103 was filed and ending on the date of the termination of the suspension;

(2) Deferral of issuance of a patent under §1.314, in which case the period of adjustment set forth in §1.703 shall be reduced by the number of days, if any, beginning on the date a request for deferral of issuance of a patent under §1.314 was filed and ending on the earlier of the date a request to terminate the deferral was filed or the date the patent was issued;

(3) Abandonment of the application or late payment of the issue fee, in which case the period of adjustment set forth in §1.703 shall be reduced by the number of days, if any, beginning on the date of abandonment or the day after the date the issue fee was due and ending on the date the grantable petition to revive the application or accept late payment of the issue fee was filed;

(4) Failure to file a petition to withdraw the holding of abandonment or to revive an application within two months from the date of mailing of a notice of abandonment, in which case the period of adjustment set forth in §1.703 shall be reduced by the number of days, if any, beginning on the day after the date two months from the date of mailing of a notice of abandonment and ending on the date a petition to withdraw the holding of abandonment or to revive the application was filed;

(5) Conversion of a provisional application under 35 U.S.C. 111(b) to a nonprovisional application under 35 U.S.C. 111(a) pursuant to 35 U.S.C. 111(b)(5), in which case the period of adjustment set forth in §1.703 shall be reduced by the number of days, if any, beginning on the date the application was filed under 35 U.S.C. 111(b) and ending on the date a request in compliance with §1.53(c)(3) to convert the provisional application into a nonprovisional application was filed;

(6) Submission of a preliminary amendment or other preliminary paper less than one month before the mailing

of an Office action under 35 U.S.C. 132 or notice of allowance under 35 U.S.C. 151 that requires the mailing of a supplemental Office action or notice of allowance, in which case the period of adjustment set forth in §1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is eight months from either the date on which the application was filed under 35 U.S.C. 111(a) or the date of commencement of the national stage under 35 U.S.C. 371(b) or (f) in an international application and ending on the date the preliminary amendment or other preliminary paper was filed;

(7) Submission of a reply having an omission (§1.135(c)), in which case the period of adjustment set forth in §1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed;

(8) Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in §1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed;

(9) Submission of an amendment or other paper after a decision by the Patent Trial and Appeal Board, other than a decision designated as containing a new ground of rejection under §41.50(b) of this title or statement under §41.50(c) of this title, or a decision by a Federal court, less than one month before the mailing of an Office action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 that requires the mailing of a supplemental Office action or supplemental notice of allowance, in which case the period of adjustment set forth in §1.703 shall be reduced by the number of days, if any, beginning on the day after the date of the decision by the Patent Trial and Appeal Board or by a Federal court and ending on date the amendment or other paper was filed;

(10) Submission of an amendment under §1.312 or other paper, other than an amendment under §1.312 or other paper expressly requested by the Office or a request for continued examination in compliance with §1.114, after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in §1.703 shall be reduced by the number of days, if any, beginning on the day after the date of mailing of the notice of allowance under 35 U.S.C. 151 and ending on the date the amendment under §1.312 or other paper was filed;

(11) Failure to file an appeal brief in compliance with §41.37 of this chapter within three months from the date on which a notice of appeal to the Patent Trial and Appeal Board was filed under 35 U.S.C. 134 and §41.31 of this chapter, in which case the period of adjustment set forth in §1.703 shall be reduced by the number of days, if any, beginning on the day after the date three months from the date on which a notice of appeal to the Patent Trial and Appeal Board was filed under 35 U.S.C. 134 and §41.31 of this chapter, and ending on the date an appeal brief in compliance with §41.37 of this chapter or a request for continued examination in compliance with §1.114 was filed;

(12) Submission of a request for continued examination under 35 U.S.C. 132(b) after any notice of allowance under 35 U.S.C. 151 has been mailed, in which case the period of adjustment set forth in §1.703 shall be reduced by the number of days, if any, beginning on the day after the date of mailing of the notice of allowance under 35 U.S.C. 151 and ending on the date the request for continued examination under 35 U.S.C. 132(b) was filed;

(13) Failure to provide an application in condition for examination as defined in paragraph (f) of this section within eight months from either the date on which the application was filed under 35 U.S.C. 111(a) or the date of commencement of the national stage under 35 U.S.C. 371(b) or (f) in an international application, in which case the period of adjustment set forth in §1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is eight months from either the date on which the application was

filed under 35 U.S.C. 111(a) or the date of commencement of the national stage under 35 U.S.C. 371(b) or (f) in an international application and ending on the date the application is in condition for examination as defined in paragraph (f) of this section; and

(14) Further prosecution via a continuing application, in which case the period of adjustment set forth in §1.703 shall not include any period that is prior to the actual filing date of the application that resulted in the patent.

(d)(1) A paper containing only an information disclosure statement in compliance with §§1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section, and a request for continued examination in compliance with §1.114 with no submission other than an information disclosure statement in compliance with §§1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraph (c)(12) of this section, if the paper or request for continued examination is accompanied by a statement that each item of information contained in the information disclosure statement:

(i) Was first cited in any communication from a patent office in a counterpart foreign or international application or from the Office, and this communication was not received by any individual designated in §1.56(c) more than thirty days prior to the filing of the information disclosure statement; or

(ii) Is a communication that was issued by a patent office in a counterpart foreign or international application or by the Office, and this communication was not received by any individual designated in §1.56(c) more than thirty days prior to the filing of the information disclosure statement.

(2) The thirty-day period set forth in paragraph (d)(1) of this section is not extendable.

(3) The statement under paragraph (d)(1) of this section must be submitted on the Office form (PTO/SB/133) provided for such a patent term adjustment statement using the appropriate document code (PTA.IDS). Otherwise, the paper or request for continued examination will be treated as not accompanied by a statement under paragraph (d)(1) of this section unless an application for patent term adjustment, in compliance with §1.705(b), is filed, establishing that the paper or request for continued examination was accompanied by a statement in compliance with paragraph (d)(1) of this section. No changes to statements on this Office form may be made. The presentation to the Office (whether by signing, filing, submitting, or later advocating) of this form, whether by a practitioner or non-practitioner, constitutes a certification under §11.18(b) of this chapter that the existing text and any certification statements on this form have not been altered.

(e) The submission of a request under §1.705(c) for reinstatement of reduced patent term adjustment will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraph (c)(10) of this section.

(f) An application filed under 35 U.S.C. 111(a) is in condition for examination when it includes a specification, including at least one claim and an abstract (§1.72(b)), and has papers in compliance with §1.52, drawings (if any) in compliance with §1.84, any English translation required by §1.52(d) or §1.57(a), a ''Sequence Listing'' in compliance with §§1.821 through 1.825 (if applicable), a ''Sequence Listing XML'' in compliance with §§1.831 through 1.835 (if applicable), an inventor's oath or declaration or an application data sheet containing the information specified in §1.63(b), the basic filing fee (§1.16(a) or (c)), the search fee (§1.16(k) or (m)), the examination fee (§1.16(o) or (q)), any certified copy of the previously filed application required by §1.57(a), and any application size fee required by the Office under §1.16(s). An international application is in condition for examination when it has entered the national stage as defined in §1.491(b), and includes a specification, including at least one claim and an abstract (§1.72(b)), and has papers in compliance with §1.52, drawings

(if any) in compliance with §1.84, a ''Sequence Listing'' in compliance with §§1.821 through 1.825 (if applicable), a ''Sequence Listing XML'' in compliance with §§1.831 through 1.835 (if applicable), an inventor's oath or declaration or an application data sheet containing the information specified in §1.63(b), the search fee (§1.492(b)), the examination fee (§1.492(c)), and any application size fee required by the Office under §1.492(j). An application shall be considered as having papers in compliance with §1.52, drawings (if any) in compliance with §1.84, and a ''Sequence Listing'' in compliance with §§1.821 through 1.825 (if applicable), or a ''Sequence Listing XML'' in compliance with §§1.831 through 1.835 (if applicable), for purposes of this paragraph (f) on the filing date of the latest reply (if any) correcting the papers, drawings, ''Sequence Listing,'' or ''Sequence Listing XML'' that is prior to the date of mailing of either an action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151, whichever occurs first.

[65 FR 56393, Sept. 18, 2000, as amended at 69 FR 21711, Apr. 22, 2004; 69 FR 50002, Aug. 12, 2004; 72 FR 46843, Aug. 21, 2007; 74 FR 52691, Oct. 14, 2009; 76 FR 74702, Dec. 1, 2011; 77 FR 46628, Aug. 6, 2012; 77 FR 49360, Aug. 16, 2012; 78 FR 19420, Apr. 1, 2013; 78 FR 62408, Oct. 21, 2013; 80 FR 1356, Jan. 9, 2015; 85 FR 36341, June 16, 2020; 87 FR 30818, May 20, 2022; 88 FR 39177, June 15, 2023]

§1.705 Patent term adjustment determination.

(a) The patent will include notification of any patent term adjustment under 35 U.S.C. 154(b).

(b) Any request for reconsideration of the patent term adjustment indicated on the patent must be by way of an application for patent term adjustment filed no later than two months from the date the patent was granted. This two-month time period may be extended under the provisions of §1.136(a). An application for patent term adjustment under this section must be accompanied by:

(1) The fee set forth in §1.18(e); and

(2) A statement of the facts involved, specifying:

(i) The correct patent term adjustment and the basis or bases under §1.702 for the adjustment;

(ii) The relevant dates as specified in §§1.703(a) through (e) for which an adjustment is sought and the adjustment as specified in §1.703(f) to which the patent is entitled;

(iii) Whether the patent is subject to a terminal disclaimer and any expiration date specified in the terminal disclaimer; and

(iv)(A) Any circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in §1.704; or

(B) That there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in §1.704.

(c) Any request for reinstatement of all or part of the period of adjustment reduced pursuant to §1.704(b) for failing to reply to a rejection, objection, argument, or other request within three months of the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request must be filed prior to the issuance of the patent. This time period is not extendable. Any request for reinstatement of all or part of the period of adjustment reduced pursuant to §1.704(b) under this paragraph must also be accompanied by:

(1) The fee set forth in §1.18(f); and

(2) A showing to the satisfaction of the Director that, in spite of all due care, the applicant was unable to reply to the rejection, objection, argument, or other request within three months of the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request. The Office shall not grant any request for reinstatement for more than three additional months for each reply beyond three months from the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request.

(d) No submission or petition on behalf of a third party concerning patent term adjustment under 35 U.S.C. 154(b) will be considered by the Office. Any such submission or petition will be returned to the third party, or otherwise

disposed of, at the convenience of the Office.

[65 FR 56394, Sept. 18, 2000, as amended at 69 FR 21711, Apr. 22, 2004; 78 FR 19420, Apr. 1, 2013]

EXTENSION OF PATENT TERM DUE TO REGULATORY REVIEW

§ 1.710 Patents subject to extension of the patent term.

(a) A patent is eligible for extension of the patent term if the patent claims a product as defined in paragraph (b) of this section, either alone or in combination with other ingredients that read on a composition that received permission for commercial marketing or use, or a method of using such a product, or a method of manufacturing such a product, and meets all other conditions and requirements of this subpart.

(b) The term *product* referred to in paragraph (a) of this section means—

(1) The active ingredient of a new human drug, antibiotic drug, or human biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Public Health Service Act) including any salt or ester of the active ingredient, as a single entity or in combination with another active ingredient; or

(2) The active ingredient of a new animal drug or veterinary biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Virus-Serum-Toxin Act) that is not primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes including site specific genetic manipulation techniques, including any salt or ester of the active ingredient, as a single entity or in combination with another active ingredient; or

(3) Any medical device, food additive, or color additive subject to regulation under the Federal Food, Drug, and Cosmetic Act.

[54 FR 30379, July 20, 1989]

§ 1.720 Conditions for extension of patent term.

The term of a patent may be extended if:

(a) The patent claims a product or a method of using or manufacturing a product as defined in § 1.710;

(b) The term of the patent has never been previously extended, except for extensions issued pursuant to §§ 1.701, 1.760, or § 1.790;

(c) An application for extension is submitted in compliance with § 1.740;

(d) The product has been subject to a regulatory review period as defined in 35 U.S.C. 156(g) before its commercial marketing or use;

(e) The product has received permission for commercial marketing or use and—

(1) The permission for the commercial marketing or use of the product is the first received permission for commercial marketing or use under the provision of law under which the applicable regulatory review occurred, or

(2) In the case of a patent other than one directed to subject matter within § 1.710(b)(2) claiming a method of manufacturing the product that primarily uses recombinant DNA technology in the manufacture of the product, the permission for the commercial marketing or use is the first received permission for the commercial marketing or use of a product manufactured under the process claimed in the patent, or

(3) In the case of a patent claiming a new animal drug or a veterinary biological product that is not covered by the claims in any other patent that has been extended, and has received permission for the commercial marketing or use in non-food-producing animals and in food-producing animals, and was not extended on the basis of the regulatory review period for use in non-food-producing animals, the permission for the commercial marketing or use of the drug or product after the regulatory review period for use in food-producing animals is the first permitted commercial marketing or use of the drug or product for administration to a food-producing animal.

(f) The application is submitted within the sixty-day period beginning on the date the product first received permission for commercial marketing or use under the provisions of law under which the applicable regulatory review

period occurred; or in the case of a patent claiming a method of manufacturing the product which primarily uses recombinant DNA technology in the manufacture of the product, the application for extension is submitted within the sixty-day period beginning on the date of the first permitted commercial marketing or use of a product manufactured under the process claimed in the patent; or in the case of a patent that claims a new animal drug or a veterinary biological product that is not covered by the claims in any other patent that has been extended, and said drug or product has received permission for the commercial marketing or use in non-food-producing animals, the application for extension is submitted within the sixty-day period beginning on the date of the first permitted commercial marketing or use of the drug or product for administration to a food-producing animal;

(g) The term of the patent, including any interim extension issued pursuant to §1.790, has not expired before the submission of an application in compliance with §1.741; and

(h) No other patent term has been extended for the same regulatory review period for the product.

[52 FR 9394, Mar. 24, 1987, as amended at 54 FR 30380, July 20, 1989; 65 FR 54679, Sept. 8, 2000]

§1.730 Applicant for extension of patent term; signature requirements.

(a) Any application for extension of a patent term must be submitted by the owner of record of the patent or its agent and must comply with the requirements of §1.740.

(b) If the application is submitted by the patent owner, the application must be signed either by:

(1) The patent owner in compliance with §3.73(c) of this chapter; or

(2) A registered practitioner on behalf of the patent owner.

(c) If the application is submitted on behalf of the patent owner by an agent of the patent owner (e.g., a licensee of the patent owner), the application must be signed by a registered practitioner on behalf of the agent. The Office may require proof that the agent is authorized to act on behalf of the patent owner.

(d) If the application is signed by a registered practitioner, the Office may require proof that the practitioner is authorized to act on behalf of the patent owner or agent of the patent owner.

[65 FR 54679, Sept. 8, 2000, as amended at 77 FR 48825, Aug. 14, 2012]

§1.740 Formal requirements for application for extension of patent term; correction of informalities.

(a) An application for extension of patent term must be made in writing to the Director. A formal application for the extension of patent term must include:

(1) A complete identification of the approved product as by appropriate chemical and generic name, physical structure or characteristics;

(2) A complete identification of the Federal statute including the applicable provision of law under which the regulatory review occurred;

(3) An identification of the date on which the product received permission for commercial marketing or use under the provision of law under which the applicable regulatory review period occurred;

(4) In the case of a drug product, an identification of each active ingredient in the product and as to each active ingredient, a statement that it has not been previously approved for commercial marketing or use under the Federal Food, Drug, and Cosmetic Act, the Public Health Service Act, or the Virus-Serum-Toxin Act, or a statement of when the active ingredient was approved for commercial marketing or use (either alone or in combination with other active ingredients), the use for which it was approved, and the provision of law under which it was approved.

(5) A statement that the application is being submitted within the sixty day period permitted for submission pursuant to §1.720(f) and an identification of the date of the last day on which the application could be submitted;

(6) A complete identification of the patent for which an extension is being sought by the name of the inventor, the patent number, the date of issue, and the date of expiration;

(7) A copy of the patent for which an extension is being sought, including the entire specification (including claims) and drawings;

(8) A copy of any disclaimer, certificate of correction, receipt of maintenance fee payment, or reexamination certificate issued in the patent;

(9) A statement that the patent claims the approved product, or a method of using or manufacturing the approved product, and a showing which lists each applicable patent claim and demonstrates the manner in which at least one such patent claim reads on:

(i) The approved product, if the listed claims include any claim to the approved product;

(ii) The method of using the approved product, if the listed claims include any claim to the method of using the approved product; and

(iii) The method of manufacturing the approved product, if the listed claims include any claim to the method of manufacturing the approved product;

(10) A statement beginning on a new page of the relevant dates and information pursuant to 35 U.S.C. 156(g) in order to enable the Secretary of Health and Human Services or the Secretary of Agriculture, as appropriate, to determine the applicable regulatory review period as follows:

(i) For a patent claiming a human drug, antibiotic, or human biological product:

(A) The effective date of the investigational new drug (IND) application and the IND number;

(B) The date on which a new drug application (NDA) or a Product License Application (PLA) was initially submitted and the NDA or PLA number; and

(C) The date on which the NDA was approved or the Product License issued;

(ii) For a patent claiming a new animal drug:

(A) The date a major health or environmental effects test on the drug was initiated, and any available substantiation of that date, or the date of an exemption under subsection (j) of Section 512 of the Federal Food, Drug, and Cosmetic Act became effective for such animal drug;

(B) The date on which a new animal drug application (NADA) was initially submitted and the NADA number; and

(C) The date on which the NADA was approved;

(iii) For a patent claiming a veterinary biological product:

(A) The date the authority to prepare an experimental biological product under the Virus-Serum-Toxin Act became effective;

(B) The date an application for a license was submitted under the Virus-Serum-Toxin Act; and

(C) The date the license issued;

(iv) For a patent claiming a food or color additive:

(A) The date a major health or environmental effects test on the additive was initiated and any available substantiation of that date;

(B) The date on which a petition for product approval under the Federal Food, Drug and Cosmetic Act was initially submitted and the petition number; and

(C) The date on which the FDA published a FEDERAL REGISTER notice listing the additive for use;

(v) For a patent claiming a medical device:

(A) The effective date of the investigational device exemption (IDE) and the IDE number, if applicable, or the date on which the applicant began the first clinical investigation involving the device, if no IDE was submitted, and any available substantiation of that date;

(B) The date on which the application for product approval or notice of completion of a product development protocol under Section 515 of the Federal Food, Drug and Cosmetic Act was initially submitted and the number of the application; and

(C) The date on which the application was approved or the protocol declared to be completed;

(11) A brief description beginning on a new page of the significant activities undertaken by the marketing applicant during the applicable regulatory review period with respect to the approved product and the significant dates applicable to such activities;

(12) A statement beginning on a new page that in the opinion of the applicant the patent is eligible for the extension and a statement as to the length of extension claimed, including how the length of extension was determined;

(13) A statement that applicant acknowledges a duty to disclose to the Director of the United States Patent and Trademark Office and the Secretary of Health and Human Services or the Secretary of Agriculture any information which is material to the determination of entitlement to the extension sought (*see* §1.765);

(14) The prescribed fee for receiving and acting upon the application for extension (see §1.20(j)); and

(15) The name, address, telephone number, and email address of the person to whom inquiries and correspondence related to the application for patent term extension are to be directed.

(b) The application under this section, and any related submissions to the Office, must be submitted using the USPTO patent electronic filing system in accordance with the USPTO patent electronic filing system requirements.

(c) If an application for extension of patent term is informal under this section, the Office will so notify the applicant. The applicant has two months from the mail date of the notice, or such time as is set in the notice, within which to correct the informality. Unless the notice indicates otherwise, this time period may be extended under the provisions of §1.136.

[54 FR 9394, Mar. 24, 1987, as amended at 54 FR 30380, July 20, 1989; 56 FR 65155, Dec. 13, 1991; 65 FR 54679, Sept. 8, 2000; 68 FR 14337, Mar. 25, 2003; 88 FR 13033, Mar. 2, 2023]

§1.741 Complete application given a filing date; petition procedure.

(a) The filing date of an application for extension of a patent term is the date on which a complete application is received in the Office via the USPTO patent electronic filing system or filed pursuant to the procedure set forth in §1.8(a)(1)(i)(C) and (a)(1)(ii). A complete application must include:

(1) An identification of the approved product;

(2) An identification of each Federal statute under which regulatory review occurred;

(3) An identification of the patent for which an extension is being sought;

(4) An identification of each claim of the patent which claims the approved product or a method of using or manufacturing the approved product;

(5) Sufficient information to enable the Director to determine under subsections (a) and (b) of 35 U.S.C. 156 the eligibility of a patent for extension, and the rights that will be derived from the extension, and information to enable the Director and the Secretary of Health and Human Services or the Secretary of Agriculture to determine the length of the regulatory review period; and

(6) A brief description of the activities undertaken by the marketing applicant during the applicable regulatory review period with respect to the approved product and the significant dates applicable to such activities.

(b) If an application for extension of patent term is incomplete under this section, the Office will so notify the applicant. If applicant requests review of a notice that an application is incomplete, or review of the filing date accorded an application under this section, applicant must file a petition pursuant to this paragraph accompanied by the fee set forth in §1.17(f) within two months of the mail date of the notice that the application is incomplete, or the notice according the filing date complained of. Unless the notice indicates otherwise, this time period may be extended under the provisions of §1.136.

[52 FR 9394, Mar. 24, 1987, as amended at 59 FR 54503, Oct. 22, 1993; 61 FR 64028, Dec. 3, 1996; 65 FR 54680, Sept. 8, 2000; 69 FR 56546, Sept. 21, 2004; 88 FR 13033, Mar. 2, 2023]

§1.750 Determination of eligibility for extension of patent term.

A determination as to whether a patent is eligible for extension may be made by the Director solely on the basis of the representations contained in the application for extension filed in compliance with §1.740 or §1.790. This determination may be delegated to appropriate Patent and Trademark Office

officials and may be made at any time before the certificate of extension is issued. The Director or other appropriate officials may require from applicant further information or make such independent inquiries as desired before a final determination is made on whether a patent is eligible for extension. In an application for extension filed in compliance with §1.740, a notice will be mailed to applicant containing the determination as to the eligibility of the patent for extension and the period of time of the extension, if any. This notice shall constitute the final determination as to the eligibility and any period of extension of the patent. A single request for reconsideration of a final determination may be made if filed by the applicant within such time as may be set in the notice of final determination or, if no time is set, within one month from the date of the final determination. The time periods set forth herein are subject to the provisions of §1.136.

[60 FR 25618, May 12, 1995]

§1.760 Interim extension of patent term under 35 U.S.C. 156(e)(2).

An applicant who has filed a formal application for extension in compliance with §1.740 may request one or more interim extensions for periods of up to one year each pending a final determination on the application pursuant to §1.750. Any such request should be filed at least three months prior to the expiration date of the patent. The Director may issue interim extensions, without a request by the applicant, for periods of up to one year each until a final determination is made. The patent owner or agent will be notified when an interim extension is granted and notice of the extension will be published in the *Official Gazette of the United States Patent and Trademark Office*. The notice will be recorded in the official file of the patent and will be considered as part of the original patent. In no event will the interim extensions granted under this section be longer than the maximum period for extension to which the applicant would be eligible.

[65 FR 54680, Sept. 8, 2000]

§1.765 Duty of disclosure in patent term extension proceedings.

(a) A duty of candor and good faith toward the Patent and Trademark Office and the Secretary of Health and Human Services or the Secretary of Agriculture rests on the patent owner or its agent, on each attorney or agent who represents the patent owner and on every other individual who is substantively involved on behalf of the patent owner in a patent term extension proceeding. All such individuals who are aware, or become aware, of material information adverse to a determination of entitlement to the extension sought, which has not been previously made of record in the patent term extension proceeding must bring such information to the attention of the Office or the Secretary, as appropriate, in accordance with paragraph (b) of this section, as soon as it is practical to do so after the individual becomes aware of the information. Information is material where there is a substantial likelihood that the Office or the Secretary would consider it important in determinations to be made in the patent term extension proceeding.

(b) Disclosures pursuant to this section must be accompanied by a copy of each written document which is being disclosed. The disclosure must be made to the Office or the Secretary, as appropriate, unless the disclosure is material to determinations to be made by both the Office and the Secretary, in which case duplicate copies, certified as such, must be filed in the Office and with the Secretary. Disclosures pursuant to this section may be made to the Office or the Secretary, as appropriate, through an attorney or agent having responsibility on behalf of the patent owner or its agent for the patent term extension proceeding or through a patent owner acting on his or her own behalf. Disclosure to such an attorney, agent or patent owner shall satisfy the duty of any other individual. Such an attorney, agent or patent owner has no duty to transmit information which is not material to the determination of entitlement to the extension sought.

(c) No patent will be determined eligible for extension and no extension will be issued if it is determined that

fraud on the Office or the Secretary was practiced or attempted or the duty of disclosure was violated through bad faith or gross negligence in connection with the patent term extension proceeding. If it is established by clear and convincing evidence that any fraud was practiced or attempted on the Office or the Secretary in connection with the patent term extension proceeding or that there was any violation of the duty of disclosure through bad faith or gross negligence in connection with the patent term extension proceeding, a final determination will be made pursuant to §1.750 that the patent is not eligible for extension.

(d) The duty of disclosure pursuant to this section rests on the individuals identified in paragraph (a) of this section and no submission on behalf of third parties, in the form of protests or otherwise, will be considered by the Office. Any such submissions by third parties to the Office will be returned to the party making the submission, or otherwise disposed of, without consideration by the Office.

[24 FR 10332, Dec. 22, 1959, as amended at 54 FR 30381, July 20, 1989; 60 FR 25618, May 12, 1995]

§1.770 Express withdrawal of application for extension of patent term.

An application for extension of patent term may be expressly withdrawn before a determination is made pursuant to §1.750 by filing in the Office a written declaration of withdrawal signed by the owner of record of the patent or its agent. An application may not be expressly withdrawn after the date permitted for reply to the final determination on the application. An express withdrawal pursuant to this section is effective when acknowledged in writing by the Office. The filing of an express withdrawal pursuant to this section and its acceptance by the Office does not entitle applicant to a refund of the filing fee (§1.20(j)) or any portion thereof.

[62 FR 53201, Oct. 10, 1997, as amended at 88 FR 13033, Mar. 2, 2023]

§1.775 Calculation of patent term extension for a human drug, antibiotic drug or human biological product.

(a) If a determination is made pursuant to §1.750 that a patent for a human drug, antibiotic drug or human biological product is eligible for extension, the term shall be extended by the time as calculated in days in the manner indicated by this section. The patent term extension will run from the original expiration date of the patent or any earlier date set by terminal disclaimer (§1.321).

(b) The term of the patent for a human drug, antibiotic drug or human biological product will be extended by the length of the regulatory review period for the product as determined by the Secretary of Health and Human Services, reduced as appropriate pursuant to paragraphs (d)(1) through (d)(6) of this section.

(c) The length of the regulatory review period for a human drug, antibiotic drug or human biological product will be determined by the Secretary of Health and Human Services. Under 35 U.S.C. 156(g)(1)(B), it is the sum of—

(1) The number of days in the period beginning on the date an exemption under subsection (i) of section 505 or subsection (d) of section 507 of the Federal Food, Drug, and Cosmetic Act became effective for the approved product and ending on the date the application was initially submitted for such product under those sections or under section 351 of the Public Health Service Act; and

(2) The number of days in the period beginning on the date the application was initially submitted for the approved product under section 351 of the Public Health Service Act, subsection (b) of section 505 or section 507 of the Federal Food, Drug, and Cosmetic Act and ending on the date such application was approved under such section.

(d) The term of the patent as extended for a human drug, antibiotic drug or human biological product will be determined by—

(1) Subtracting from the number of days determined by the Secretary of Health and Human Services to be in the regulatory review period:

(i) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section which were on and before the date on which the patent issued;

(ii) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section during which it is determined under 35 U.S.C. 156(d)(2)(B) by the Secretary of Health and Human Services that applicant did not act with due diligence;

(iii) One-half the number of days remaining in the period defined by paragraph (c)(1) of this section after that period is reduced in accordance with paragraphs (d)(1) (i) and (ii) of this section; half days will be ignored for purposes of subtraction;

(2) By adding the number of days determined in paragraph (d)(1) of this section to the original term of the patent as shortened by any terminal disclaimer;

(3) By adding 14 years to the date of approval of the application under section 351 of the Public Health Service Act, or subsection (b) of section 505 or section 507 of the Federal Food, Drug, and Cosmetic Act;

(4) By comparing the dates for the ends of the periods obtained pursuant to paragraphs (d)(2) and (d)(3) of this section with each other and selecting the earlier date;

(5) If the original patent was issued after September 24, 1984,

(i) By adding 5 years to the original expiration date of the patent or any earlier date set by terminal disclaimer; and

(ii) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(5)(i) of this section with each other and selecting the earlier date;

(6) If the original patent was issued before September 24, 1984, and

(i) If no request was submitted for an exemption under subsection (i) of section 505 or subsection (d) of section 507 of the Federal Food, Drug, and Cosmetic Act before September 24, 1984, by—

(A) Adding 5 years to the original expiration date of the patent or earlier date set by terminal disclaimer; and

(B) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(i)(A) of this section with each other and selecting the earlier date; or

(ii) If a request was submitted for an exemption under subsection (i) of section 505 or subsection (d) of section 507 of the Federal Food, Drug, or Cosmetic Act before September 24, 1984 and the commercial marketing or use of the product was not approved before September 24, 1984, by—

(A) Adding 2 years to the original expiration date of the patent or earlier date set by terminal disclaimer, and

(B) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(ii)(A) of this section with each other and selecting the earlier date.

[52 FR 9394, Mar. 24, 1987, as amended at 54 FR 30381, July 20, 1989]

§ 1.776 Calculation of patent term extension for a food additive or color additive.

(a) If a determination is made pursuant to § 1.750 that a patent for a food additive or color additive is eligible for extension, the term shall be extended by the time as calculated in days in the manner indicated by this section. The patent term extension will run from the original expiration date of the patent or earlier date set by terminal disclaimer (§ 1.321).

(b) The term of the patent for a food additive or color additive will be extended by the length of the regulatory review period for the product as determined by the Secretary of Health and Human Services, reduced as appropriate pursuant to paragraphs (d)(1) through (d)(6) of this section.

(c) The length of the regulatory review period for a food additive or color additive will be determined by the Secretary of Health and Human Services. Under 35 U.S.C. 156(g)(2)(B), it is the sum of—

(1) The number of days in the period beginning on the date a major health or environmental effects test on the additive was initiated and ending on the date a petition was initially submitted with respect to the approved product under the Federal Food, Drug, and Cosmetic Act requesting the issuance of a regulation for use of the product; and

(2) The number of days in the period beginning on the date a petition was initially submitted with respect to the approved product under the Federal

Food, Drug, and Cosmetic Act requesting the issuance of a regulation for use of the product, and ending on the date such regulation became effective or, if objections were filed to such regulation, ending on the date such objections were resolved and commercial marketing was permitted or, if commercial marketing was permitted and later revoked pending further proceedings as a result of such objections, ending on the date such proceedings were finally resolved and commercial marketing was permitted.

(d) The term of the patent as extended for a food additive or color additive will be determined by

(1) Subtracting from the number of days determined by the Secretary of Health and Human Services to be in the regulatory review period:

(i) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section which were on and before the date on which the patent issued;

(ii) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section during which it is determined under 35 U.S.C. 156(d)(2)(B) by the Secretary of Health and Human Services that applicant did not act with due diligence;

(iii) The number of days equal to one-half the number of days remaining in the period defined by paragraph (c)(1) of this section after that period is reduced in accordance with paragraphs (d)(1) (i) and (ii) of this section; half days will be ignored for purposes of subtraction;

(2) By adding the number of days determined in paragraph (d)(1) of this section to the original term of the patent as shortened by any terminal disclaimer;

(3) By adding 14 years to the date a regulation for use of the product became effective or, if objections were filed to such regulation, to the date such objections were resolved and commercial marketing was permitted or, if commercial marketing was permitted and later revoked pending further proceedings as a result of such objections, to the date such proceedings were finally resolved and commercial marketing was permitted;

(4) By comparing the dates for the ends of the periods obtained pursuant to paragraphs (d)(2) and (d)(3) of this section with each other and selecting the earlier date;

(5) If the original patent was issued after September 24, 1984,

(i) By adding 5 years to the original expiration date of the patent or earlier date set by terminal disclaimer; and

(ii) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(5)(i) of this section with each other and selecting the earlier date;

(6) If the original patent was issued before September 24, 1984, and

(i) If no major health or environmental effects test was initiated and no petition for a regulation or application for registration was submitted before September 24, 1984, by—

(A) Adding 5 years to the original expiration date of the patent or earlier date set by terminal disclaimer, and

(B) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(i)(A) of this section with each other and selecting the earlier date; or

(ii) If a major health or environmental effects test was initiated or a petition for a regulation or application for registration was submitted by September 24, 1984, and the commercial marketing or use of the product was not approved before September 24, 1984, by—

(A) Adding 2 years to the original expiration date of the patent or earlier date set by terminal disclaimer, and

(B) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(ii)(A) of this section with each other and selecting the earlier date.

§ 1.777 Calculation of patent term extension for a medical device.

(a) If a determination is made pursuant to § 1.750 that a patent for a medical device is eligible for extension, the term shall be extended by the time as calculated in days in the manner indicated by this section. The patent term extension will run from the original expiration date of the patent or earlier date as set by terminal disclaimer (§ 1.321).

(b) The term of the patent for a medical device will be extended by the length of the regulatory review period for the product as determined by the

Secretary of Health and Human Services, reduced as appropriate pursuant to paragraphs (d)(1) through (d)(6) of this section.

(c) The length of the regulatory review period for a medical device will be determined by the Secretary of Health and Human Services. Under 35 U.S.C. 156(g)(3)(B), it is the sum of

(1) The number of days in the period beginning on the date a clinical investigation on humans involving the device was begun and ending on the date an application was initially submitted with respect to the device under section 515 of the Federal Food, Drug, and Cosmetic Act; and

(2) The number of days in the period beginning on the date the application was initially submitted with respect to the device under section 515 of the Federal Food, Drug, and Cosmetic Act, and ending on the date such application was approved under such Act or the period beginning on the date a notice of completion of a product development protocol was initially submitted under section 515(f)(5) of the Act and ending on the date the protocol was declared completed under section 515(f)(6) of the Act.

(d) The term of the patent as extended for a medical device will be determined by—

(1) Substracting from the number of days determined by the Secretary of Health and Human Services to be in the regulatory review period pursuant to paragraph (c) of this section:

(i) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section which were on and before the date on which the patent issued;

(ii) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section during which it is determined under 35 U.S.C. 156(d)(2)(B) by the Secretary of Health and Human Services that applicant did not act with due diligence;

(iii) One-half the number of days remaining in the period defined by paragraph (c)(1) of this section after that period is reduced in accordance with paragraphs (d)(1) (i) and (ii) of this section; half days will be ignored for purposes of subtraction;

(2) By adding the number of days determined in paragraph (d)(1) of this section to the original term of the patent as shortened by any terminal disclaimer;

(3) By adding 14 years to the date of approval of the application under section 515 of the Federal Food, Drug, and Cosmetic Act or the date a product development protocol was declared completed under section 515(f)(6) of the Act;

(4) By comparing the dates for the ends of the periods obtained pursuant to paragraphs (d)(2) and (d)(3) of this section with each other and selecting the earlier date;

(5) If the original patent was issued after September 24, 1984,

(i) By adding 5 years to the original expiration date of the patent or earlier date set by terminal disclaimer; and

(ii) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(5)(i) of this section with each other and selecting the earlier date;

(6) If the original patent was issued before September 24, 1984, and

(i) If no clinical investigation on humans involving the device was begun or no product development protocol was submitted under section 515(f)(5) of the Federal Food, Drug, and Cosmetic Act before September 24, 1984, by—

(A) Adding 5 years to the original expiration date of the patent or earlier date set by terminal disclaimer and

(B) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(i)(A) of this section with each other and selecting the earlier date; or

(ii) If a clinical investigation on humans involving the device was begun or a product development protocol was submitted under section 515(f)(5) of the Federal Food, Drug, and Cosmetic Act before September 24, 1984 and the commercial marketing or use of the product was not approved before September 24, 1984, by

(A) Adding 2 years to the original expiration date of the patent or earlier date set by terminal disclaimer, and

(B) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(ii)(A) of this section with each other and selecting the earlier date.

§ 1.778 Calculation of patent term extension for an animal drug product.

(a) If a determination is made pursuant to §1.750 that a patent for an animal drug is eligible for extension, the term shall be extended by the time as calculated in days in the manner indicated by this section. The patent term extension will run from the original expiration date of the patent or any earlier date set by terminal disclaimer (§1.321).

(b) The term of the patent for an animal drug will be extended by the length of the regulatory review period for the drug as determined by the Secretary of Health and Human Services, reduced as appropriate pursuant to paragraphs (d)(1) through (d)(6) of this section.

(c) The length of the regulatory review period for an animal drug will be determined by the Secretary of Health and Human Services. Under 35 U.S.C. 156(g)(4)(B), it is the sum of—

(1) The number of days in the period beginning on the earlier of the date a major health or environmental effects test on the drug was initiated or the date an exemption under subsection (j) of section 512 of the Federal Food, Drug, and Cosmetic Act became effective for the approved animal drug and ending on the date an application was initially submitted for such animal drug under section 512 of the Federal Food, Drug, and Cosmetic Act; and

(2) The number of days in the period beginning on the date the application was initially submitted for the approved animal drug under subsection (b) of section 512 of the Federal Food, Drug, and Cosmetic Act and ending on the date such application was approved under such section.

(d) The term of the patent as extended for an animal drug will be determined by—

(1) Subtracting from the number of days determined by the Secretary of Health and Human Services to be in the regulatory review period:

(i) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section that were on and before the date on which the patent issued;

(ii) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section during which it is determined under 35 U.S.C. 156(d)(2)(B) by the Secretary of Health and Human Services that applicant did not act with due diligence;

(iii) One-half the number of days remaining in the period defined by paragraph (c)(1) of this section after that period is reduced in accordance with paragraphs (d)(1) (i) and (ii) of this section; half days will be ignored for purposes of subtraction;

(2) By adding the number of days determined in paragraph (d)(1) of this section to the original term of the patent as shortened by any terminal disclaimer;

(3) By adding 14 years to the date of approval of the application under section 512 of the Federal Food, Drug, and Cosmetic Act;

(4) By comparing the dates for the ends of the periods obtained pursuant to paragraphs (d)(2) and (d)(3) of this section with each other and selecting the earlier date;

(5) If the original patent was issued after November 16, 1988, by—

(i) Adding 5 years to the original expiration date of the patent or any earlier date set by terminal disclaimer; and

(ii) Comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(5)(i) of this section with each other and selecting the earlier date;

(6) If the original patent was issued before November 16, 1988, and

(i) If no major health or environmental effects test on the drug was initiated and no request was submitted for an exemption under subsection (j) of section 512 of the Federal Food, Drug, and Cosmetic Act before November 16, 1988, by—

(A) Adding 5 years to the original expiration date of the patent or earlier date set by terminal disclaimer; and

(B) Comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(i)(A) of this section with each other and selecting the earlier date; or

(ii) If a major health or environmental effects test was initiated or a request for an exemption under subsection (j) of section 512 of the Federal Food, Drug, and Cosmetic Act was submitted before November 16, 1988, and the application for commercial marketing or use of the animal drug was

not approved before November 16, 1988, by—

(A) Adding 3 years to the original expiration date of the patent or earlier date set by terminal disclaimer, and

(B) Comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(ii)(A) of this section with each other and selecting the earlier date.

[54 FR 30381, July 20, 1989]

§ 1.779 Calculation of patent term extension for a veterinary biological product.

(a) If a determination is made pursuant to § 1.750 that a patent for a veterinary biological product is eligible for extension, the term shall be extended by the time as calculated in days in the manner indicated by this section. The patent term extension will run from the original expiration date of the patent or any earlier date set by terminal disclaimer (§ 1.321).

(b) The term of the patent for a veterinary biological product will be extended by the length of the regulatory review period for the product as determined by the Secretary of Agriculture, reduced as appropriate pursuant to paragraphs (d)(1) through (d)(6) of this section.

(c) The length of the regulatory review period for a veterinary biological product will be determined by the Secretary of Agriculture. Under 35 U.S.C. 156(g)(5)(B), it is the sum of—

(1) The number of days in the period beginning on the date the authority to prepare an experimental biological product under the Virus-Serum-Toxin Act became effective and ending on the date an application for a license was submitted under the Virus-Serum-Toxin Act; and

(2) The number of days in the period beginning on the date an application for a license was initially submitted for approval under the Virus-Serum-Toxin Act and ending on the date such license was issued.

(d) The term of the patent as extended for a veterinary biological product will be determined by—

(1) Subtracting from the number of days determined by the Secretary of Agriculture to be in the regulatory review period:

(i) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section that were on and before the date on which the patent issued;

(ii) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section during which it is determined under 35 U.S.C. 156(d)(2)(B) by the Secretary of Agriculture that applicant did not act with due diligence;

(iii) One-half the number of days remaining in the period defined by paragraph (c)(1) of this section after that period is reduced in accordance with paragraphs (d)(1) (i) and (ii) of this section; half days will be ignored for purposes of subtraction;

(2) By adding the number of days determined in paragraph (d)(1) of this section to the original term of the patent as shortened by any terminal disclaimer;

(3) By adding 14 years to the date of the issuance of a license under the Virus-Serum-Toxin Act;

(4) By comparing the dates for the ends of the periods obtained pursuant to paragraphs (d)(2) and (d)(3) of this section with each other and selecting the earlier date;

(5) If the original patent was issued after November 16, 1988, by—

(i) Adding 5 years to the original expiration date of the patent or any earlier date set by terminal disclaimer; and

(ii) Comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(5)(i) of this section with each other and selecting the earlier date;

(6) If the original patent was issued before November 16, 1988, and

(i) If no request for the authority to prepare an experimental biological product under the Virus-Serum-Toxin Act was submitted before November 16, 1988, by—

(A) Adding 5 years to the original expiration date of the patent or earlier date set by terminal disclaimer; and

(B) Comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(i)(A) of this section with each other and selecting the earlier date; or

(ii) If a request for the authority to prepare an experimental biological product under the Virus-Serum-Toxin Act was submitted before November 16, 1988, and the commercial marketing or

use of the product was not approved before November 16, 1988, by—

(A) Adding 3 years to the original expiration date of the patent or earlier date set by terminal disclaimer; and

(B) Comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(ii)(A) of this section with each other and selecting the earlier date.

[52 FR 9394, Mar. 24, 1987, as amended at 54 FR 30382, July 20, 1989]

§ 1.780 Certificate or order of extension of patent term.

If a determination is made pursuant to § 1.750 that a patent is eligible for extension and that the term of the patent is to be extended, a certificate of extension, under seal, or an order granting interim extension under 35 U.S.C. 156(d)(5), will be issued to the applicant for the extension of the patent term. Such certificate or order will be recorded in the official file of the patent and will be considered as part of the original patent. Notification of the issuance of the certificate or order of extension will be published in the *Official Gazette of the United States Patent and Trademark Office*. Notification of the issuance of the order granting an interim extension under 35 U.S.C. 156(d)(5), including the identity of the product currently under regulatory review, will be published in the *Official Gazette of the United States Patent and Trademark Office* and in the FEDERAL REGISTER. No certificate of, or order granting, an extension will be issued if the term of the patent cannot be extended, even though the patent is otherwise determined to be eligible for extension. In such situations, the final determination made pursuant to § 1.750 will indicate that no certificate or order will issue.

[65 FR 54680, Sept. 8, 2000]

§ 1.785 Multiple applications for extension of term of the same patent or of different patents for the same regulatory review period for a product.

(a) Only one patent may be extended for a regulatory review period for any product (§ 1.720(h)). If more than one application for extension of the same patent is filed, the certificate of extension of patent term, if appropriate, will be issued based upon the first filed application for extension.

(b) If more than one application for extension is filed by a single applicant which seeks the extension of the term of two or more patents based upon the same regulatory review period, and the patents are otherwise eligible for extension pursuant to the requirements of this subpart, in the absence of an election by the applicant, the certificate of extension of patent term, if appropriate, will be issued upon the application for extension of the patent term having the earliest date of issuance of those patents for which extension is sought.

(c) If an application for extension is filed which seeks the extension of the term of a patent based upon the same regulatory review period as that relied upon in one or more applications for extension pursuant to the requirements of this subpart, the certificate of extension of patent term will be issued on the application only if the patent owner or its agent is the holder of the regulatory approval granted with respect to the regulatory review period.

(d) An application for extension shall be considered complete and formal regardless of whether it contains the identification of the holder of the regulatory approval granted with respect to the regulatory review period. When an application contains such information, or is amended to contain such information, it will be considered in determining whether an application is eligible for an extension under this section. A request may be made of any applicant to supply such information within a non-extendable period of not less than one month whenever multiple applications for extension of more than one patent are received and rely upon the same regulatory review period. Failure to provide such information within the period for reply set shall be regarded as conclusively establishing that the applicant is not the holder of the regulatory approval.

(e) Determinations made under this section shall be included in the notice of final determination of eligibility for extension of the patent term pursuant

to §1.750 and shall be regarded as part of that determination.

[60 FR 25618, May 12, 1995, as amended at 62 FR 53201, Oct. 10, 1997]

§ 1.790 Interim extension of patent term under 35 U.S.C. 156(d)(5).

(a) An owner of record of a patent or its agent who reasonably expects that the applicable regulatory review period, described in 35 U.S.C. 156(g)(1)(B)(ii), (2)(B)(ii), (3)(B)(ii), (4)(B)(ii), or (5)(B)(ii), that began for a product that is the subject of such patent may extend beyond the expiration of the patent term in effect may submit one or more applications for interim extensions for periods of up to one year each. In no event will the interim extensions granted under this section be longer than the maximum period of extension to which the applicant would be entitled under 35 U.S.C. 156(c).

(b) Any application for interim extension under this section must be filed using the USPTO patent electronic filing system in accordance with the USPTO patent electronic filing system requirements.

(c) Complete initial applications for interim extension under this section must:

(1) Be filed during the period beginning 6 months and ending 15 days before the patent term is due to expire, and include a statement that the initial application is being submitted within the period and an identification of the date of the last day on which the initial application could be submitted;

(2) Include all of the information required for a formal application under §1.740 and a complete application under §1.741, except as follows:

(i) Paragraphs (a)(1), (2), (4), and (6) through (15) of §§1.740 and 1.741 shall be read in the context of a product currently undergoing regulatory review; and

(ii) Paragraphs (a)(3) and (5) of §1.740 are not applicable to an application for interim extension under this section; and

(3) Include a statement that the applicable regulatory review period, described in 35 U.S.C. 156(g)(1)(B)(ii), (2)(B)(ii), (3)(B)(ii), (4)(B)(ii), or (5)(B)(ii), has begun for the product that is the subject of the patent.

(d) Each subsequent application for interim extension:

(1) Must be filed during the period beginning 60 days before and ending 30 days before the expiration of the preceding interim extension and include a statement that it is being submitted within the period and an identification of the date of the last day on which it could be submitted;

(2) May be limited in content to a request for a subsequent interim extension along with any materials or information required under §§1.740 and 1.741 that are not present in the preceding interim extension application; and

(3) Must include a statement that the applicable regulatory review period, described in 35 U.S.C. 156(g)(1)(B)(ii), (2)(B)(ii), (3)(B)(ii), (4)(B)(ii), or (5)(B)(ii), has not been completed.

[88 FR 13033, Mar. 2, 2023]

§ 1.791 Termination of interim extension granted prior to regulatory approval of a product for commercial marketing or use.

Any interim extension granted under 35 U.S.C. 156(d)(5) terminates at the end of the 60-day period beginning on the date on which the product involved receives permission for commercial marketing or use. If within that 60-day period the patent owner or its agent files an application for extension under §§1.740 and 1.741 including any additional information required under 35 U.S.C. 156(d)(1) not contained in the application for interim extension, the patent shall be further extended in accordance with the provisions of 35 U.S.C. 156.

[60 FR 25619, May 12, 1995]

Subpart G—Biotechnology Invention Disclosures

DEPOSIT OF BIOLOGICAL MATERIAL

SOURCE: 54 FR 34880, Aug. 22, 1989, unless otherwise noted.

§ 1.801 Biological material.

For the purposes of these regulations pertaining to the deposit of biological

material for purposes of patents for inventions under 35 U.S.C. 101, the term biological material shall include material that is capable of self-replication either directly or indirectly. Representative examples include bacteria, fungi including yeast, algae, protozoa, eukaryotic cells, cell lines, hybridomas, plasmids, viruses, plant tissue cells, lichens and seeds. Viruses, vectors, cell organelles and other non-living material existing in and reproducible from a living cell may be deposited by deposit of the host cell capable of reproducing the non-living material.

§ 1.802 Need or opportunity to make a deposit.

(a) Where an invention is, or relies on, a biological material, the disclosure may include reference to a deposit of such biological material.

(b) Biological material need not be deposited unless access to such material is necessary for the satisfaction of the statutory requirements for patentability under 35 U.S.C. 112. If a deposit is necessary, it shall be acceptable if made in accordance with these regulations. Biological material need not be deposited, inter alia, if it is known and readily avaliable to the public or can be made or isolated without undue experimentation. Once deposited in a depository complying with these regulations, a biological material will be considered to be readily available even though some requirement of law or regulation of the United States or of the country in which the depository institution is located permits access to the material only under conditions imposed for safety, public health or similar reasons.

(c) The reference to a biological material in a specification disclosure or the actual deposit of such material by an applicant or patent owner does not create any presumption that such material is necessary to satisfy 35 U.S.C. 112 or that deposit in accordance with these regulations is or was required.

§ 1.803 Acceptable depository.

(a) A deposit shall be recognized for the purposes of these regulations if made in

(1) Any International Depositary Authority (IDA) as established under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure, or

(2) Any other depository recognized to be suitable by the Office. Suitability will be determined by the Director on the basis of the administrative and technical competence, and agreement of the depository to comply with the terms and conditions applicable to deposits for patent purposes. The Director may seek the advice of impartial consultants on the suitability of a depository. The depository must:

(i) Have a continuous existence;

(ii) Exist independent of the control of the depositor;

(iii) Possess the staff and facilities sufficient to examine the viability of a deposit and store the deposit in a manner which ensures that it is kept viable and uncontaminated;

(iv) Provide for sufficient safety measures to minimize the risk of losing biological material deposited with it;

(v) Be impartial and objective;

(vi) Furnish samples of the deposited material in an expeditious and proper manner; and

(vii) Promptly notify depositors of its inability to furnish samples, and the reasons why.

(b) A depository seeking status under paragraph (a)(2) of this section must direct a communication to the Director which shall:

(1) Indicate the name and address of the depository to which the communication relates;

(2) Contain detailed information as to the capacity of the depository to comply with the requirements of paragraph (a)(2) of this section, including information on its legal status, scientific standing, staff and facilities;

(3) Indicate that the depository intends to be available, for the purposes of deposit, to any depositor under these same conditions;

(4) Where the depository intends to accept for deposit only certain kinds of biological material, specify such kinds;

(5) Indicate the amount of any fees that the depository will, upon acquiring the status of suitable depository

under paragraph (a)(2) of this section, charge for storage, viability statements and furnishings of samples of the deposit.

(c) A depository having status under paragraph (a)(2) of this section limited to certain kinds of biological material may extend such status to additional kinds of biological material by directing a communication to the Director in accordance with paragraph (b) of this section. If a previous communication under paragraph (b) of this section is of record, items in common with the previous communication may be incorporated by reference.

(d) Once a depository is recognized to be suitable by the Director or has defaulted or discontinued its performance under this section, notice thereof will be published in the Office Gazette of the Patent and Trademark Office.

§ 1.804 Time of making an original deposit.

(a) Whenever a biological material is specifically identified in an application for patent as filed, an original deposit thereof may be made at any time before filing the application for patent or, subject to §1.809, during pendency of the application for patent.

(b) When the original deposit is made after the effective filing date of an application for patent, the applicant must promptly submit a statement from a person in a position to corroborate the fact, stating that the biological material which is deposited is a biological material specifically identified in the application as filed.

[54 FR 34880, Aug. 22, 1989, as amended at 62 FR 53202, Oct. 10, 1997]

§ 1.805 Replacement or supplement of deposit.

(a) A depositor, after receiving notice during the pendency of an application for patent, application for reissue patent or reexamination proceeding, that the depository possessing a deposit either cannot furnish samples thereof or can furnish samples thereof but the deposit has become contaminated or has lost its capability to function as described in the specification, shall notify the Office in writing, in each application for patent or patent affected. In such a case, or where the Office otherwise learns, during the pendency of an application for patent, application for reissue patent or reexamination proceeding, that the depository possessing a deposit either cannot furnish samples thereof or can furnish samples thereof but the deposit has become contaminated or has lost its capability to function as described in the specification, the need for making a replacement or supplemental deposit will be governed by the same considerations governing the need for making an original deposit under the provisions set forth in §1.802(b). A replacement or supplemental deposit made during the pendency of an application for patent shall not be accepted unless it meets the requirements for making an original deposit under these regulations, including the requirement set forth under §1.804(b). A replacement or supplemental deposit made in connection with a patent, whether or not made during the pendency of an application for reissue patent or a reexamination proceeding or both, shall not be accepted unless a certificate of correction under §1.323 is requested by the patent owner which meets the terms of paragraphs (b) and (c) of this section.

(b) A request for certificate of correction under this section shall not be granted unless the certificate identifies:

(1) The accession number for the replacement or supplemental deposit;

(2) The date of the deposit; and

(3) The name and address of the depository.

(c) A request for a certificate of correction under this section shall not be granted unless the request is made promptly after the replacement or supplemental deposit has been made and the request:

(1) Includes a statement of the reason for making the replacement or supplemental deposit;

(2) Includes a statement from a person in a position to corroborate the fact, and stating that the replacement or supplemental deposit is of a biological material which is identical to that originally deposited;

(3) Includes a showing that the patent owner acted diligently—

(i) In the case of a replacement deposit, in making the deposit after receiving notice that samples could no longer be furnished from an earlier deposit; or

(ii) In the case of a supplemental deposit, in making the deposit after receiving notice that the earlier deposit had become contaminated or had lost its capability to function as described in the specification;

(4) Includes a statement that the term of the replacement or supplemental deposit expires no earlier than the term of the deposit being replaced or supplemented; and

(5) Otherwise establishes compliance with these regulations.

(d) A depositor's failure to replace a deposit, or in the case of a patent, to diligently replace a deposit and promptly thereafter request a certificate of correction which meets the terms of paragraphs (b) and (c) of this section, after being notified that the depository possessing the deposit cannot furnish samples thereof, shall cause the application or patent involved to be treated in any Office proceeding as if no deposit were made.

(e) In the event a deposit is replaced according to these regulations, the Office will apply a rebuttable presumption of identity between the original and the replacement deposit where a patent making reference to the deposit is relied upon during any Office proceeeding.

(f) A replacement or supplement deposit made during the pendency of an application for patent may be made for any reason.

(g) In no case is a replacement or supplemental deposit of a biological material necessary where the biological material, in accordance with §1.802(b), need not be deposited.

(h) No replacement deposit of a biological material is necessary where a depository can furnish samples thereof but the depository for national security, health or environmental safety reasons is unable to provide samples to requesters outside of the jurisdiction where the depository is located.

(i) The Office will not recognize in any Office proceeding a replacement deposit of a biological material made by a patent owner where the depository could furnish samples of the deposit being replaced.

[54 FR 34880, Aug. 22, 1989, as amended at 62 FR 53202, Oct. 10, 1997]

§ 1.806 Term of deposit.

A deposit made before or during pendency of an application for patent shall be made for a term of at least thirty (30) years and at least five (5) years after the most recent request for the furnishing of a sample of the deposit was received by the depository. In any case, samples must be stored under agreements that would make them available beyond the enforceable life of the patent for which the deposit was made.

§ 1.807 Viability of deposit.

(a) A deposit of biological material that is capable of self-replication either directly or indirectly must be viable at the time of deposit and during the term of deposit. Viability may be tested by the depository. The test must conclude only that the deposited material is capable of reproduction. No evidence is necessarily required regarding the ability of the deposited material to perform any function described in the patent application.

(b) A viability statement for each deposit of a biological material defined in paragraph (a) of this section not made under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure must be filed in the application and must contain:

(1) The name and address of the depository;

(2) The name and address of the depositor;

(3) The date of deposit;

(4) The identity of the deposit and the accession number given by the depository;

(5) The date of the viability test;

(6) The procedures used to obtain a sample if the test is not done by the depository; and

(7) A statement that the deposit is capable of reproduction.

(c) If a viability test indicates that the deposit is not viable upon receipt, or the examiner cannot, for scientific or other valid reasons, accept the statement of viability received from

the applicant, the examiner shall proceed as if no deposit has been made. The examiner will accept the conclusion set forth in a viability statement issued by a depository recognized under §1.803(a).

§ 1.808 Furnishing of samples.

(a) A deposit must be made under conditions that assure that:

(1) Access to the deposit will be available during pendency of the patent application making reference to the deposit to one determined by the Director to be entitled thereto under §1.14 and 35 U.S.C. 122, and

(2) Subject to paragraph (b) of this section, all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon the granting of the patent.

(b) The depositor may contract with the depository to require that samples of a deposited biological material shall be furnished only if a request for a sample, during the term of the patent:

(1) Is in writing or other tangible form and dated;

(2) Contains the name and address of the requesting party and the accession number of the deposit; and

(3) Is communicated in writing by the depository to the depositor along with the date on which the sample was furnished and the name and address of the party to whom the sample was furnished.

(c) Upon request made to the Office, the Office will certify whether a deposit has been stated to have been made under conditions which make it available to the public as of the issue date of the patent grant provided the request contains:

(1) The name and address of the depository;

(2) The accession number given to the deposit;

(3) The patent number and issue date of the patent referring to the deposit; and

(4) The name and address of the requesting party.

§ 1.809 Examination procedures.

(a) The examiner shall determine pursuant to §1.104 in each application for patent, application for reissue patent or reexamination proceeding if a deposit is needed, and if needed, if a deposit actually made is acceptable for patent purposes. If a deposit is needed and has not been made or replaced or supplemented in accordance with these regulations, the examiner, where appropriate, shall reject the affected claims under the appropriate provision of 35 U.S.C. 112, explaining why a deposit is needed and/or why a deposit actually made cannot be accepted.

(b) The applicant for patent or patent owner shall reply to a rejection under paragraph (a) of this section by—

(1) In the case of an applicant for patent, either making an acceptable original, replacement, or supplemental deposit, or assuring the Office in writing that an acceptable deposit will be made; or, in the case of a patent owner, requesting a certificate of correction of the patent which meets the terms of paragraphs (b) and (c) of §1.805, or

(2) Arguing why a deposit is not needed under the circumstances of the application or patent considered and/or why a deposit actually made should be accepted. Other replies to the examiner's action shall be considered nonresponsive. The rejection will be repeated until either paragraph (b)(1) of this section is satisfied or the examiner is convinced that a deposit is not needed.

(c) If an application for patent is otherwise in condition for allowance except for a needed deposit and the Office has received a written assurance that an acceptable deposit will be made, the Office may notify the applicant in a notice of allowability and set a three-month period of time from the mailing date of the notice of allowability within which the deposit must be made in order to avoid abandonment. This time period is not extendable under §1.136 (*see* §1.136(c)).

(d) For each deposit made pursuant to these regulations, the specification shall contain:

(1) The accession number for the deposit;

(2) The date of the deposit;

(3) A description of the deposited biological material sufficient to specifically identify it and to permit examination; and

(4) The name and address of the depository.

(e) Any amendment required by paragraphs (d)(1), (d)(2) or (d)(4) of this section must be filed before or with the payment of the issue fee (see §1.312).

[54 FR 34880, Aug. 22, 1989, as amended at 66 FR 21092, Apr. 27, 2001; 78 FR 62408, Oct. 21, 2013]

APPLICATION DISCLOSURES CONTAINING NUCLEOTIDE AND/OR AMINO ACID SEQUENCES

SOURCE: Sections 1.821 through 1.825 appear at 55 FR 18245, May 1, 1990, unless otherwise noted.

§1.821 Nucleotide and/or amino acid sequence disclosures in patent applications.

(a) Nucleotide and/or amino acid sequences, as used in §§1.821 through 1.825, are interpreted to mean an unbranched sequence of 4 or more amino acids or an unbranched sequence of 10 or more nucleotides. Branched sequences are specifically excluded from this definition. Sequences with fewer than four specifically defined nucleotides or amino acids are specifically excluded from this section. ''Specifically defined'' means those amino acids other than ''Xaa'' and those nucleotide bases other than ''n,'' defined in accordance with Appendices A through F to this subpart. Nucleotides and amino acids are further defined as follows:

(1) *Nucleotides.* Nucleotides are intended to embrace only those nucleotides that can be represented using the symbols set forth in Appendix A to this subpart. Modifications (*e.g.*, methylated bases) may be described as set forth in Appendix B to this subpart but shall not be shown explicitly in the nucleotide sequence.

(2) *Amino acids.* Amino acids are those L-amino acids commonly found in naturally occurring proteins and are listed in appendix C to this subpart. Those amino acid sequences containing D-amino acids are not intended to be embraced by this definition. Any amino acid sequence that contains post-translationally modified amino acids may be described as the amino acid sequence that is initially translated using the symbols shown in appendix C to this subpart, with the modified positions (*e.g.*, hydroxylations or glycosylations) being described as set forth in appendix D to this subpart, but these modifications shall not be shown explicitly in the amino acid sequence. Any peptide or protein that can be expressed as a sequence using the symbols in appendix C to this subpart, in conjunction with a description in the Feature section, to describe, for example, modified linkages, cross links and end caps, non-peptidyl bonds, etc., is embraced by this definition.

NOTE 1 TO PARAGRAPH (A): Appendices A through F to this subpart contain Tables 1–6 of the World Intellectual Property Organization (WIPO) Handbook on Industrial Property Information and Documentation, Standard ST.25: Standard for the Presentation of Nucleotide and Amino Acid Sequence Listings in Patent Applications (2009).

(b) Patent applications which contain disclosures of nucleotide and/or amino acid sequences, in accordance with the definition in paragraph (a) of this section, shall, with regard to the manner in which the nucleotide and/or amino acid sequences are presented and described, conform exclusively to the requirements of §§1.821 through 1.825.

(c) Patent applications that contain disclosures of nucleotide and/or amino acid sequences, as defined in paragraph (a) of this section, must contain a ''Sequence Listing,'' which is a separate part of the specification containing each of those nucleotide and/or amino acid sequences and associated information using the symbols and format in accordance with the requirements of §§1.822 and 1.823. The ''Sequence Listing'' must be submitted as follows, except for a national stage entry under §1.495(b)(1), where the ''Sequence Listing'' has been previously communicated by the International Bureau or originally filed in the United States Patent and Trademark Office and complies with Patent Cooperation Treaty (PCT) Rule 5.2:

(1) As an ASCII plain text file, in compliance with §1.824, submitted via the USPTO patent electronic filing system or on a read-only optical disc under §1.52(e), accompanied by an incorporation by reference statement of the ASCII plain text file, in a separate paragraph of the specification, in accordance with §1.77(b)(5);

(2) As a PDF file via the USPTO patent electronic filing system; or

(3) On physical sheets of paper.

(d) Where the description or claims of a patent application discuss a sequence that is set forth in the ''Sequence Listing,'' in accordance with paragraph (c) of this section, reference must be made to the sequence by use of a sequence identifier (§1.823(a)(5)), preceded by ''SEQ ID NO:'' or the like, in the text of the description or claims, even if the sequence is also embedded in the text of the description or claims of the patent application. Where a sequence is presented in a drawing, reference must be made to the sequence by use of the sequence identifier (§1.823(a)(5)), either in the drawing or in the Brief Description of the Drawings, where the correlation between multiple sequences in the drawing and their sequence identifiers (§1.823(a)(5)) in the Brief Description is clear.

(e)(1) If the ''Sequence Listing'' under paragraph (c) of this section is submitted in an application filed under 35 U.S.C. 111(a) as a PDF file (§1.821(c)(2)) via the USPTO patent electronic filing system or on physical sheets of paper (§1.821(c)(3)), then the following must be submitted:

(i) A CRF of the ''Sequence Listing,'' in accordance with the requirements of §1.824; and

(ii) A statement that the sequence information contained in the CRF submitted under paragraph (e)(1)(i) of this section is identical to the sequence information contained in the ''Sequence Listing'' under paragraph (c) of this section.

(2) If the ''Sequence Listing'' under paragraph (c) of this section in an application submitted under 35 U.S.C. 371 is a PDF file (paragraph (c)(2) of this section) or on physical sheets of paper (paragraph (c)(3) of this section), and not also as an ASCII plain text file, in compliance with §1.824 (paragraph (c)(1) of this section), then the following must be submitted:

(i) A CRF of the ''Sequence Listing,'' in accordance with the requirements of §1.824; and

(ii) A statement that the sequence information contained in the CRF submitted under paragraph (e)(2)(i) of this section is identical to the sequence information contained in the ''Sequence Listing'' under paragraph (c)(2) or (3) of this section.

(3) If a ''Sequence Listing'' in ASCII plain text format, in compliance with §1.824, has not been submitted for an international application under the PCT, and that application contains disclosures of nucleotide and/or amino acid sequences, as defined in paragraph (a) of this section, and is to be searched by the United States International Searching Authority or examined by the United States International Preliminary Examining Authority, then the following must be submitted:

(i) A CRF of the ''Sequence Listing,'' in accordance with the requirements of §1.824;

(ii) The late furnishing fee for providing a ''Sequence Listing'' in response to an invitation, as set forth in §1.445(a)(5); and

(iii) A statement that the sequence information contained in the CRF, submitted under paragraph (e)(3)(i) of this section, does not go beyond the disclosure in the international application as filed, or a statement that the information recorded in the ASCII plain text file, submitted under paragraph (e)(3)(i) of this section, is identical to the sequence listing contained in the international application as filed, as applicable.

(4) The CRF may not be retained as a part of the patent application file.

(f) [Reserved]

(g) If any of the requirements of paragraphs (b) through (e) of this section are not satisfied at the time of filing under 35 U.S.C. 111(a) or at the time of entering the national stage under 35 U.S.C. 371, the applicant will be notified and given a period of time within which to comply with such requirements in order to prevent abandonment of the application. Any amendment to add or replace a ''Sequence Listing'' and CRF copy thereof in reply to a requirement under this paragraph must be submitted in accordance with the requirements of §1.825.

(h) If any of the requirements of paragraph (e)(3) of this section are not satisfied at the time of filing an international application under the PCT, and the application is to be searched by the United States International

Searching Authority or examined by the United States International Preliminary Examining Authority, the applicant may be sent a notice necessitating compliance with the requirements within a prescribed time period. Where a ''Sequence Listing'' under PCT Rule 13*ter* is provided in reply to a requirement under this paragraph, it must be accompanied by a statement that the information recorded in the ASCII plain text file under paragraph (e)(3)(i) of this section is identical to the sequence listing contained in the international application as filed, or does not go beyond the disclosure in the international application as filed, as applicable. It must also be accompanied by the late furnishing fee, as set forth in §1.445(a)(5). If the applicant fails to timely provide the required CRF, the United States International Searching Authority shall search only to the extent that a meaningful search can be performed without the CRF, and the United States International Preliminary Examining Authority shall examine only to the extent that a meaningful examination can be performed without the CRF.

[63 FR 29634, June 1, 1998, as amended at 65 FR 54680, Sept. 8, 2000; 69 FR 18803, Apr. 9, 2004; 70 FR 10489, Mar. 4, 2005; 86 FR 57048, Oct. 14, 2021]

§ 1.822 Symbols and format to be used for nucleotide and/or amino acid sequence data.

(a) The symbols and format to be used for nucleotide and/or amino acid sequence data shall conform to the requirements of paragraphs (b) through (e) of this section.

(b) The code for representing the nucleotide and/or amino acid sequence characters shall conform to the code set forth in appendices A and C to this subpart. No code other than that specified in these sections shall be used in nucleotide and amino acid sequences. A modified base or modified or unusual amino acid may be presented in a given sequence as the corresponding unmodified base or amino acid if the modified base or modified or unusual amino acid is one of those listed in appendices B and D to this subpart, and the modification is also set forth in the Feature section. Otherwise, each occurrence of a base or amino acid not appearing in appendices A and C, shall be listed in a given sequence as ''n'' or ''Xaa,'' respectively, with further information, as appropriate, given in the Feature section, by including one or more feature keys listed in appendices E and F to this subpart.

NOTE 1 TO PARAGRAPH (B): Appendices A through F to this subpart contain Tables 1–6 of the World Intellectual Property Organization (WIPO) Handbook on Industrial Property Information and Documentation, Standard ST.25: Standard for the Presentation of Nucleotide and Amino Acid Sequence Listings in Patent Applications (2009).

(c) *Format representation of nucleotides.* (1) A nucleotide sequence shall be listed using the lowercase letter for representing the one-letter code for the nucleotide bases set forth in appendix A to this subpart.

(2) The bases in a nucleotide sequence (including introns) shall be listed in groups of 10 bases except in the coding parts of the sequence. Leftover bases, fewer than 10 in number, at the end of noncoding parts of a sequence shall be grouped together and separated from adjacent groups of 10 or 3 bases by a space.

(3) The bases in the coding parts of a nucleotide sequence shall be listed as triplets (codons). The amino acids corresponding to the codons in the coding parts of a nucleotide sequence shall be listed immediately below the corresponding codons. Where a codon spans an intron, the amino acid symbol shall be listed below the portion of the codon containing two nucleotides.

(4) A nucleotide sequence shall be listed with a maximum of 16 codons or 60 bases per line, with a space provided between each codon or group of 10 bases.

(5) A nucleotide sequence shall be represented, only by a single strand, in the 5 to 3 direction, from left to right.

(6) The enumeration of nucleotide bases shall start at the first base of the sequence with number 1. The enumeration shall be continuous through the whole sequence in the direction 5 to 3. The enumeration shall appear in the right margin, next to the line containing the one-letter codes for the bases and giving the number of the last base of that line.

(7) For those nucleotide sequences that are circular in configuration, the enumeration method set forth in paragraph (c)(6) of this section remains applicable with the exception that the designation of the first base of the nucleotide sequence may be made at the option of the applicant.

NOTE 2 TO PARAGRAPH (C): Appendices A through F to this subpart contain Tables 1–6 of the World Intellectual Property Organization (WIPO) Handbook on Industrial Property Information and Documentation, Standard ST.25: Standard for the Presentation of Nucleotide and Amino Acid Sequence Listings in Patent Applications (2009).

(d) *Representation of amino acids.* (1) The amino acids in a protein or peptide sequence shall be listed using the three-letter abbreviation, with the first letter as an uppercase character, as in Appendix C to this subpart.

(2) A protein or peptide sequence shall be listed with a maximum of 16 amino acids per line, with a space provided between each amino acid.

(3) An amino acid sequence shall be represented in the amino to carboxy direction, from left to right, and the amino and carboxy groups shall not be represented in the sequence.

(4) The enumeration of amino acids may start at the first amino acid of the first mature protein, with the number 1. When represented, the amino acids preceding the mature protein (*e.g.*, presequences, pro-sequences, pre-pro-sequences, and signal sequences) shall have negative numbers, counting backwards starting with the amino acid next to number 1. Otherwise, the enumeration of amino acids shall start at the first amino acid at the amino terminal as number 1, and shall appear below every five amino acids of the sequence. The enumeration method for amino acid sequences that is set forth in this section remains applicable for amino acid sequences that are circular in configuration, with the exception that the designation of the first amino acid of the sequence may be made at the option of the applicant.

(5) An amino acid sequence that contains internal terminator symbols (*e.g.*, ''Ter,'' ''*,'' or ''.,'' etc.) may not be represented as a single amino acid sequence but shall be represented as separate amino acid sequences.

NOTE 3 TO PARAGRAPH (D): Appendices A through F to this subpart contain Tables 1–6 of the World Intellectual Property Organization (WIPO) Handbook on Industrial Property Information and Documentation, Standard ST.25: Standard for the Presentation of Nucleotide and Amino Acid Sequence Listings in Patent Applications (2009).

(e) A sequence with a gap or gaps shall be represented as a plurality of separate sequences, with separate sequence identifiers (§1.823(a)(5)), with the number of separate sequences being equal in number to the number of continuous strings of sequence data. A sequence composed of one or more noncontiguous segments of a larger sequence or segments from different sequences shall be presented as a separate sequence.

[63 FR 29635, June 1, 1998, as amended at 69 FR 18803, Apr. 9, 2004; 70 FR 10489, Mar. 4, 2005; 86 FR 57050, Oct. 14, 2021]

§ 1.823 Requirements for content of a "Sequence Listing" part of the specification.

(a) The ''Sequence Listing'' must comply with the following:

(1) The order and presentation of the items of information in the ''Sequence Listing'' shall conform to the arrangement in appendix G to this subpart. The submission of those items of information designated with an ''M'' is mandatory. The submission of those items of information designated with an ''O'' is optional.

(2) Each item of information shall begin on a new line, with the numeric identifier enclosed in angle brackets, as shown in appendix G to this subpart.

(3) Set forth numeric identifiers <110> through <170> at the beginning of the ''Sequence Listing.''

(4) Include each disclosed nucleotide and/or amino acid sequence, as defined in §1.821(a).

(5) Assign a separate sequence identifier to each sequence, beginning with 1 and increasing sequentially by integers, and include the sequence identifier in numeric identifier <210>.

(6) Use the code ''000'' in place of the sequence where no sequence is present for a sequence identifier.

(7) Include the total number of SEQ ID NOs in numeric identifier <160>, as defined in appendix G to this subpart,

whether followed by a sequence or by the code ''000.''

(8) Must not contain more than 74 characters per line.

(b)(1) Unless paragraph (b)(2) of this section applies, if the ''Sequence Listing'' required by §1.821(c) is submitted as an ASCII plain text file via the USPTO patent electronic filing system or on a read-only optical disc, in compliance with §1.52(e), then the specification must contain a statement in a separate paragraph (see §1.77(b)(5)) that incorporates by reference the material in the ASCII plain text file identifying:

(i) The name of the file;

(ii) The date of creation; and

(iii) The size of the file in bytes.

(2) If the ''Sequence Listing'' required by §1.821(c) is submitted as an ASCII plain text file via the USPTO patent electronic filing system or on a read-only optical disc, in compliance with §1.52(e) for an international application during the international stage, then incorporation by reference of the material in the ASCII plain text file is not required.

(3) A ''Sequence Listing'' required by §1.821(c) that is submitted as a PDF file (§1.821(c)(2)) via the USPTO patent electronic filing system or on physical sheets of paper (§1.821(c)(3)), setting forth the nucleotide and/or amino acid sequence and associated information in accordance with paragraph (a) of this section:

(i) Must begin on a new page;

(ii) Must be titled ''Sequence Listing'';

(iii) Must not include material other than the ''Sequence Listing'' itself;

(iv) Must have sheets containing no more than 66 lines, with each line containing no more than 74 characters;

(v) Should have sheets numbered independently of the numbering of the remainder of the application; and

(vi) Should use a fixed-width font exclusively throughout.

[86 FR 57050, Oct. 14, 2021]

§ 1.824 Form and format for a nucleotide and/or amino acid sequence submission as an ASCII plain text file.

(a) A ''Sequence Listing'' under §1.821(c)(1) and the CRF required by §1.821(e) submitted as an ASCII plain text file may be created by any means, such as text editors, nucleotide/amino acid sequence editors, or other custom computer programs; however, the ASCII plain text file must conform to the following requirements:

(1) Must have the following compatibilities:

(i) Computer compatibility: PC or Mac®; and

(ii) Operating system compatibility: MS–DOS®, MS-Windows®, Mac OS®, or Unix®/Linux®.

(2) Must be in ASCII plain text, where:

(i) All printable characters (including the space character) are permitted; and

(ii) No nonprintable (ASCII control) characters are permitted, except ASCII CRLF or LF as line terminators.

(3) Must be named as *.txt, where ''*'' is one character or a combination of characters limited to upper- or lowercase letters, numbers, hyphens, and underscores and does not exceed 60 characters in total, excluding the extension. No spaces or other types of characters are permitted in the file name.

(4) Must contain no more than 74 printable characters in each line.

(5) Pagination is not permitted; the ASCII plain text file must be one continuous file, with no ''hard page break'' codes and no page numbering.

(b) The ASCII plain text file must contain a copy of a single ''Sequence Listing'' in a single file and be submitted either:

(1) Electronically via the USPTO patent electronic filing system, where the file must not exceed 100 MB, and file compression is not permitted; or

(2) On a read-only optical disc(s), in compliance with §1.52(e), where:

(i) A file that is not compressed must be contained on a single read-only optical disc;

(ii) The file may be compressed using WinZip®, 7-Zip, or Unix®/Linux® Zip;

(iii) A compressed file must not be self-extracting; and

(iv) A compressed ASCII plain text file that does not fit on a single read-only optical disc may be split into multiple file parts, in accordance with the target read-only optical disc size, and labeled in compliance with §1.52(e)(5)(vi).

[86 FR 57051, Oct. 14, 2021]

§ 1.825 Amendment to add or replace a "Sequence Listing" and CRF copy thereof.

(a) Any amendment adding a ''Sequence Listing'' (§1.821(c)) after the application filing date must include:

(1) A ''Sequence Listing,'' in accordance with the requirements of §§1.821 through 1.824, submitted as:

(i) An ASCII plain text file, under §1.821(c)(1), via the USPTO patent electronic filing system or on a read-only optical disc, in compliance with §1.52(e);

(ii) A PDF file via the USPTO patent electronic filing system; or

(iii) Physical sheets of paper;

(2) A request that the amendment be made:

(i) By incorporation by reference of the material in the ASCII plain text file, in a separate paragraph of the specification, identifying the name of the file, the date of creation, and the size of the file in bytes (*see* §1.77(b)(5)), for a ''Sequence Listing'' submitted under §1.821(c)(1), except when submitted to the United States International Preliminary Examining Authority for an international application; or

(ii) By inserting, after the abstract of the disclosure, a ''Sequence Listing'' submitted as a PDF file under §1.821(c)(2) or submitted on physical sheets of paper under §1.821(c)(3), except when submitted to the United States International Preliminary Examining Authority for an international application;

(3) A statement that indicates the basis for the amendment, with specific references to particular parts of the application (specification, claims, drawings) for all sequence data in the ''Sequence Listing'' in the application as originally filed;

(4) A statement that the ''Sequence Listing'' includes no new matter;

(5) A new or substitute CRF under §1.821(e), if:

(i) The added ''Sequence Listing'' is submitted as a PDF file, under §1.821(c)(2), or on physical sheets of paper, under §1.821(c)(3); and

(ii) A CRF, under §1.821(e), was not submitted, not compliant with §1.824, or not the same as the ''Sequence Listing''; and

(6) A statement that the sequence information contained in the CRF is the same as the sequence information contained in the added ''Sequence Listing,'' if submitted as a PDF file, under §1.821(c)(2), or on physical sheets of paper, under §1.821(c)(3).

(b) Any amendment to a ''Sequence Listing'' (§1.821(c)) must include:

(1) A replacement ''Sequence Listing,'' in accordance with the requirements of §§1.821 through 1.824, submitted as:

(i) An ASCII plain text file, under §1.821(c)(1), via the USPTO patent electronic filing system, or on a read-only optical disc, in compliance with §1.52(e), labeled as ''REPLACEMENT MM/DD/YYYY'' (with the month, day, and year of creation indicated);

(ii) A PDF file via the USPTO patent electronic filing system; or

(iii) Physical sheets of paper;

(2) A request that the amendment be made:

(i) By incorporation by reference of the material in the ASCII plain text file, in a separate paragraph of the specification (replacing any prior such paragraph, as applicable) identifying the name of the file, the date of creation, and the size of the file in bytes (see §1.77(b)(5)) for a ''Sequence Listing'' under §1.821(c)(1), except when submitted to the United States International Preliminary Examining Authority for an international application; or

(ii) By placing, after the abstract of the disclosure, a ''Sequence Listing'' submitted as a PDF file, under §1.821(c)(2), or on physical sheets of paper, under §1.821(c)(3) (replacing any prior ''Sequence Listing,'' as applicable), except when submitted to the United States International Preliminary Examining Authority for an international application;

(3) A statement that identifies the location of all deletions, replacements, or additions to the ''Sequence Listing'';

(4) A statement that indicates the basis for the amendment, with specific references to particular parts of the application (specification, claims, drawings) as originally filed for all amended sequence data in the replacement ''Sequence Listing'';

(5) A statement that the replacement ''Sequence Listing'' includes no new matter;

(6) A new or substitute CRF, under §1.821(e), with the amendment incorporated therein, if:

(i) The replacement ''Sequence Listing'' is submitted as a PDF file, under §1.821(c)(2), or on physical sheets of paper, under §1.821(c)(3); and

(ii) A CRF, under §1.821(e), was not submitted, not compliant with §1.824, or not the same as the submitted ''Sequence Listing''; and

(7) A statement that the sequence information contained in the CRF is the same as the sequence information contained in the replacement ''Sequence Listing'' when submitted as a PDF file, under §1.821(c)(2), or on physical sheets of paper, under §1.821(c)(3).

(c) The specification of a complete application, filed on the application filing date, with a ''Sequence Listing'' as an ASCII plain text file, under §1.821(c)(1), without an incorporation by reference of the material contained in the ASCII plain text file, must be amended to contain a separate paragraph incorporating by reference the material contained in the ASCII plain text file, in accordance with §1.77(b)(5), except for international applications during the international stage or national stage.

(d) Any appropriate amendments to the ''Sequence Listing'' in a patent (e.g., by reason of reissue, reexamination, or a certificate of correction) must comply with the requirements of paragraph (b) of this section.

[86 FR 57051, Oct. 14, 2021]

§ 1.831 Requirements for patent applications filed on or after July 1, 2022, having nucleotide and/or amino acid sequence disclosures.

(a) Patent applications disclosing a nucleotide and/or amino acid sequence(s) by enumeration of its residues, as defined in paragraph (b) of this section, must contain, as a separate part of the disclosure, a computer readable Sequence Listing in XML format (a ''Sequence Listing XML''). Disclosed nucleotide or amino acid sequences that do not meet the definition in paragraph (b) of this section must not be included in the ''Sequence Listing XML.'' The ''Sequence Listing XML'' contains the information of the nucleotide and/or amino acid sequence(s) disclosed in the patent application using the symbols and format in accordance with the requirements of §§1.832 through 1.834.

(b) Nucleotide and/or amino acid sequences, as used in this section and §§1.832 through 1.835, encompass:

(1) An unbranched sequence or linear region of a branched sequence containing 4 or more specifically defined amino acids, wherein the amino acids form a single peptide backbone; or

(2) An unbranched sequence or linear region of a branched sequence of 10 or more specifically defined nucleotides, wherein adjacent nucleotides are joined by:

(i) A 3′ to 5′ (or 5′ to 3′) phosphodiester linkage; or

(ii) Any chemical bond that results in an arrangement of adjacent nucleobases that mimics the arrangement of nucleobases in naturally occurring nucleic acids (*i.e.*, nucleotide analogs).

(c) Where the description or claims of a patent application discuss a sequence that is set forth in the ''Sequence Listing XML'' in accordance with paragraph (a) of this section, reference must be made to the sequence by use of the sequence identifier, preceded by ''SEQ ID NO:'' or the like in the text of the description or claims, even if the sequence is also embedded in the text of the description or claims of the patent application. Where a sequence is presented in a drawing, reference must be made to the sequence by use of the sequence identifier (§1.832(a)), either in the drawing or in the Brief Description of the Drawings, where the correlation between multiple sequences in the drawing and their sequence identifiers (§1.832(a)) in the Brief Description is clear.

(d) ''Enumeration of its residues'' means disclosure of a nucleotide or amino acid sequence in a patent application by listing, in order, each residue of the sequence, where the residues are represented in the manner as defined in paragraph 3(c)(i) or (ii) of WIPO Standard ST.26 (incorporated by reference, *see* § 1.839).

(e) ''Specifically defined'' means any amino acid or nucleotide as defined in paragraph 3(k) of WIPO Standard ST.26.

(f) ''Amino acid'' includes any D- or L-amino acid or modified amino acid as defined in paragraph 3(a) of WIPO Standard ST.26.

(g) ''Modified amino acid'' includes any amino acid as described in paragraph 3(e) of WIPO Standard ST.26.

(h) ''Nucleotide'' includes any nucleotide, nucleotide analog, or modified nucleotide as defined in paragraphs 3(f) and 3(g) of WIPO Standard ST.26.

(i) ''Modified nucleotide'' includes any nucleotide as described in paragraph 3(f) of WIPO Standard ST.26.

(j) A ''Sequence listing XML'' must not include any sequences having fewer than 10 specifically defined nucleotides, or fewer than 4 specifically defined amino acids.

[87 FR 30818, May 20, 2022, as amended at 88 FR 34091, May 26, 2023]

§ 1.832 Representation of nucleotide and/or amino acid sequence data in the "Sequence Listing XML" part of a patent application filed on or after July 1, 2022.

(a) Each disclosed nucleotide or amino acid sequence that meets the requirements of § 1.831(b) must appear separately in the ''Sequence Listing XML.'' Each sequence set forth in the ''Sequence Listing XML'' must be assigned a separate sequence identifier. The sequence identifiers must begin with 1 and increase sequentially by integers as defined in paragraph 10 of WIPO Standard ST.26 (incorporated by reference, *see* § 1.839).

(b) The representation and symbols for nucleotide sequence data shall conform to the requirements of paragraphs (b)(1) through (4) of this section.

(1) A nucleotide sequence must be represented in the manner described in paragraphs 11–12 of WIPO Standard ST.26.

(2) All nucleotides, including nucleotide analogs, modified nucleotides, and ''unknown'' nucleotides, within a nucleotide sequence must be represented using the symbols set forth in paragraphs 13–16, 19, and 21 of WIPO Standard ST.26.

(3) Modified nucleotides within a nucleotide sequence must be described in the manner discussed in paragraphs 17, 18, and 19 of WIPO Standard ST.26.

(4) A region containing a known number of contiguous ''a,'' ''c,'' ''g,'' ''t,'' or ''n'' residues for which the same description applies may be jointly described in the manner described in paragraph 22 of WIPO Standard ST.26.

(c) The representation and symbols for amino acid sequence data shall conform to the requirements of paragraphs (c)(1) through (4) of this section.

(1) The amino acids in an amino acid sequence must be represented in the manner described in paragraphs 24 and 25 of WIPO Standard ST.26.

(2) All amino acids, including modified amino acids and ''unknown'' amino acids, within an amino acid sequence must be represented using the symbols set forth in paragraphs 26–29 and 32 of WIPO Standard ST.26.

(3) Modified amino acids within an amino acid sequence must be described in the manner discussed in paragraphs 29 and 30 of WIPO Standard ST.26.

(4) A region containing a known number of contiguous ''X'' residues for which the same description applies may be jointly described in the manner described in paragraph 34 of WIPO Standard ST.26.

(d) A nucleotide and/or amino acid sequence that is constructed as a single continuous sequence derived from one or more non-contiguous segments of a larger sequence or of segments from different sequences must be listed in the ''Sequence Listing XML'' in the manner described in paragraph 35 of WIPO Standard ST.26.

(e) A nucleotide and/or amino acid sequence that contains regions of specifically defined residues separated by one or more regions of contiguous ''n'' or ''X'' residues, wherein the exact number of ''n'' or ''X'' residues in each region is disclosed, must be listed in the

''Sequence Listing XML'' in the manner described in paragraph 36 of WIPO Standard ST.26.

(f) A nucleotide and/or amino acid sequence that contains regions of specifically defined residues separated by one or more gaps of an unknown or undisclosed number of residues must be listed in the ''Sequence Listing XML'' in the manner described in paragraph 37 of WIPO Standard ST.26.

[87 FR 30818, May 20, 2022]

§ 1.833 Requirements for a "Sequence Listing XML" for nucleotide and/or amino acid sequences as part of a patent application filed on or after July 1, 2022.

(a) The ''Sequence Listing XML'' as required by § 1.831(a) must be presented as a single file in XML 1.0 encoded using Unicode UTF–8, where the character set complies with paragraphs 40 and 41 and Annex IV of WIPO Standard ST.26 (incorporated by reference, *see* § 1.839).

(b) The ''Sequence Listing XML'' presented in accordance with paragraph (a) of this section must further:

(1) Be valid according to the Document Type Definition (DTD) as presented in WIPO Standard ST.26, Annex II.

(2) Comply with the requirements of WIPO Standard ST.26 to include:

(i) An XML declaration as defined in paragraph 39(a) of WIPO Standard ST.26;

(ii) A document type (DOCTYPE) declaration as defined in paragraph 39(b) of WIPO Standard ST.26;

(iii) A root element as defined in paragraph 43 of WIPO Standard ST.26;

(iv) A general information part that complies with the requirements of paragraphs 45, 47, and 48, as applicable, of WIPO Standard ST.26; and

(v) A sequence data part that complies with the requirements of paragraphs 50–55, 57, 58, 60–69, 71–78, 80–87, 89–98, and 100, as applicable, of WIPO Standard ST.26 representing the nucleotide and/or amino acid sequences according to § 1.832.

(3) Include an INSDQualifier__value element with a value in English for any language-dependent free text qualifier as defined by paragraphs 76 and 85–87 of WIPO Standard ST.26, and as required by § 1.52(b)(1)(ii).

[87 FR 30818, May 20, 2022]

§ 1.834 Form and format for nucleotide and/or amino acid sequence submissions as the "Sequence Listing XML" in patent applications filed on or after July 1, 2022.

(a) A ''Sequence Listing XML'' encoded using Unicode UTF–8, created by any means (*e.g.*, text editors, nucleotide/amino acid sequence editors, or other custom computer programs) in accordance with §§ 1.831 through 1.833, must:

(1) Have the following compatibilities:

(i) Computer compatibility: PC or Mac®; and

(ii) Operating system compatibility: MS–DOS®, MS-Windows®, Mac OS®, or Unix®/Linux®.

(2) Be in XML format, where all permitted printable characters (including the space character) and non-printable (control) characters are defined in paragraph 40 of WIPO Standard ST.26 (incorporated by reference, *see* § 1.839).

(3) Be named as *.xml, where ''*'' is one character or a combination of characters limited to upper- or lowercase letters, numbers, hyphens, and underscores, and the name does not exceed 60 characters in total, excluding the extension. No spaces or other types of characters are permitted in the file name.

(b) The ''Sequence Listing XML'' must be in a single file containing the sequence information and be submitted either:

(1) Electronically via the USPTO patent electronic filing system, where the file size must not exceed 100 MB, and file compression is not permitted; or

(2) On read-only optical disc(s) in compliance with § 1.52(e), where:

(i) A file that is not compressed must be contained on a single read-only optical disc;

(ii) The file may be compressed using WinZip®, 7-Zip, or Unix®/Linux® Zip;

(iii) A compressed file must not be self-extracting; or

(iv) A compressed XML file that does not fit on a single read-only optical disc may be split into multiple file parts, in accordance with the target

read-only optical disc size, and labeled in compliance with §1.52(e)(5)(vi);

(c)(1) Unless paragraph (c)(2) of this section applies, when the ''Sequence Listing XML'' required by §1.831(a) is submitted in XML file format via the USPTO patent electronic filing system or on a read-only optical disc (in compliance with §1.52(e)), then the specification must contain a statement in a separate paragraph (*see* §1.77(b)(5)) that incorporates by reference the material in the XML file identifying:

(i) The name of the file;

(ii) The date of creation; and

(iii) The size of the file in bytes; or

(2) If the ''Sequence Listing XML'' required by §1.831(a) is submitted in XML file format via the USPTO patent electronic filing system or on a read-only optical disc (in compliance with §1.52(e)) for an international application during the international stage, then an incorporation by reference statement of the material in the XML file is not required.

[87 FR 30818, May 20, 2022]

§ 1.835 Amendment to add or replace a "Sequence Listing XML" in patent applications filed on or after July 1, 2022.

(a) Any amendment to a patent application adding an initial submission of a ''Sequence Listing XML'' as required by §1.831(a) after the application filing date must include:

(1) A ''Sequence Listing XML'' in accordance with §§1.831 through 1.834, submitted as an XML file:

(i) Via the USPTO patent electronic filing system; or

(ii) On a read-only optical disc, in compliance with §1.52(e);

(2) A request to amend the specification to include an incorporation by reference statement of the material in the ''Sequence Listing XML'' file, identifying the name of the file, the date of creation, and the size of the file in bytes (*see* §1.77(b)(5)(ii)), except when submitted to the United States International Preliminary Examining Authority for an international application;

(3) A statement that indicates the basis for the amendment, with specific references to particular parts of the application as originally filed (specification, claims, drawings) for all sequence data in the ''Sequence Listing XML''; and

(4) A statement that the ''Sequence Listing XML'' includes no new matter.

(b) Any amendment adding to, deleting from, or replacing sequence information in a ''Sequence Listing XML'' submitted as required by §1.831(a) must include:

(1) A replacement ''Sequence Listing XML'' in accordance with the requirements of §§1.831 through 1.834 containing the entire ''Sequence Listing XML,'' including any additions, deletions, or replacements of sequence information, which shall be submitted:

(i) Via the USPTO patent electronic filing system; or

(ii) On a read-only optical disc, in compliance with §1.52(e), labeled as ''REPLACEMENT MM/DD/YYYY'' (with the month, day, and year of creation indicated);

(2) A request to amend the specification to include an incorporation by reference statement of the material in the replacement ''Sequence Listing XML'' file that identifies the name of the file, the date of creation, and the size of the file in bytes (*see* §1.77(b)(5)(ii)), except when the replacement ''Sequence Listing XML'' is submitted to the United States International Preliminary Examining Authority for an international application;

(3) A statement that identifies the location of all additions, deletions, or replacements of sequence information relative to the replaced ''Sequence Listing XML'';

(4) A statement that indicates the support for the additions, deletions, or replacements of the sequence information, with specific references to particular parts of the application as originally filed (specification, claims, drawings) for all amended sequence data in the replacement ''Sequence Listing XML''; and

(5) A statement that the replacement ''Sequence Listing XML'' includes no new matter.

(c) The specification of a complete application, filed on the application filing date, with a ''Sequence Listing XML'' as required under §1.831(a), without an incorporation by reference of

the material contained in the ''Sequence Listing XML'' file, must be amended to include a separate paragraph incorporating by reference the material contained in the ''Sequence Listing XML'' file, in accordance with §1.77(b)(5)(ii), except for international applications.

(d)(1) If any of the requirements of §§1.831 through 1.834 are not satisfied in an application under 35 U.S.C. 111(a) or in a national stage application under 35 U.S.C. 371, the applicant will be notified and given a period of time within which to comply with such requirements in order to prevent abandonment of the application. Subject to paragraph (d)(2) of this section, any amendment to add or replace a ''Sequence Listing XML'' or add an incorporation by reference of the material contained in the ''Sequence Listing XML'' in response to a requirement under this paragraph (d)(1) must be submitted in accordance with the requirements of paragraphs (a) through (c) of this section.

(2) Compliance with paragraphs (a) through (c) of this section is not required for submission of a ''Sequence Listing XML'' that is solely an English translation of a previously submitted ''Sequence Listing XML'' that contains non-English values for any language-dependent free text elements (as per §1.833(b)(3)). The required submission will be a translated ''Sequence Listing XML'' in compliance with §§1.831 through 1.834. Updated values for attributes in the root element (§1.833(b)(2)(iii)) or elements of the general information part (§1.833(b)(2)(iv)) are not considered amendments for purposes of complying with paragraphs (a) through (c) of this section.

(e) If any of the requirements of §§1.831 through 1.834 are not satisfied at the time of filing an international application under the PCT, where the application is to be searched by the United States International Searching Authority or examined by the United States International Preliminary Examining Authority, the applicant may be sent a notice necessitating compliance with the requirements within a prescribed time period. Under PCT Rule 13*ter*, the applicant can provide, in response to such a requirement or otherwise, a sequence listing that is a ''Sequence Listing XML'' in accordance with §1.831(a). The ''Sequence Listing XML'' must be accompanied by a statement that the information recorded does not go beyond the disclosure in the international application as filed. In response to such a requirement, the late furnishing fee set forth in §1.445(a)(5) is also required. If the applicant fails to timely provide the required ''Sequence Listing XML,'' the United States International Searching Authority shall search only to the extent that a meaningful search can be performed without the ''Sequence Listing XML,'' and the United States International Preliminary Examining Authority shall examine only to the extent that a meaningful examination can be performed without the ''Sequence Listing XML.''

(f) Any appropriate amendments to the ''Sequence Listing XML'' in a patent (*e.g.*, by reason of reissue, reexamination, or certificate of correction) must comply with the requirements of paragraph (b) of this section.

[87 FR 30818, May 20, 2022]

§1.839 Incorporation by reference.

(a) Certain material is incorporated by reference into this subpart with the approval of the Director of the Federal Register under 5 U.S.C. 552(a) and 1 CFR part 51. All approved incorporation by reference (IBR) material is available for inspection at the USPTO and at the National Archives and Records Administration (NARA). Contact the USPTO's Office of Patent Legal Administration at 571–272–7701. For information on the availability of this material at NARA, email *fr.inspection@nara.gov* or go to *www.archives.gov/federal-register/cfr/ibr-locations.html*. The material may be obtained from the source(s) in paragraph (b) of this section.

(b) World Intellectual Property Organization (WIPO), 34 chemin des Colombettes, 1211 Geneva 20 Switzerland, *www.wipo.int*.

(1) WIPO Standard ST.26. WIPO Handbook on Intellectual Property Information and Documentation, Standard ST.26: Recommended Standard for the Presentation of Nucleotide and Amino Acid Sequence Listings Using

XML (eXtensible Markup Language) including Annexes I–VII, version 1.7, approved December 8, 2023; IBR approved for §§ 1.831 through 1.834.

(2) [Reserved]

[87 FR 30818, May 20, 2022, as amended at 88 FR 34091, May 26, 2023; 89 FR 36679, May 3, 2024]

APPENDIX A TO SUBPART G OF PART 1—LIST OF NUCLEOTIDES

Source: World Intellectual Property Organization (WIPO) Handbook on Industrial Property Information and Documentation, Standard ST.25: Standard for the Presentation of Nucleotide and Amino Acid Sequence Listings in Patent Applications (2009).

Symbol	Meaning	Origin of designation
a	a	*a*denine.
g	g	*g*uanine.
c	c	*c*ytosine.
t	t	thymine.
u	u	*u*racil.
r	g or a	purine.
y	t/u or c	p*y*rimidine.
m	a or c	a*m*ino.
k	g or t/u	*k*eto.
s	g or c	strong interactions 3H-bonds.
w	a or t/u	*w*eak interactions 2H-bonds.
b	g or c or t/u	not a.
d	a or g or t/u	not c.
h	a or c or t/u	not g.
v	a or g or c	not t, not u.
n	a or g or c or t/u, unknown, or other.	a*n*y.

[86 FR 57052, Oct. 14, 2021]

APPENDIX B TO SUBPART G OF PART 1—LIST OF MODIFIED NUCLEOTIDES

Source: World Intellectual Property Organization (WIPO) Handbook on Industrial Property Information and Documentation, Standard ST.25: Standard for the Presentation of Nucleotide and Amino Acid Sequence Listings in Patent Applications (2009).

Symbol	Meaning
ac4c	4-acetylcytidine.
chm5u	5-(carboxyhydroxymethyl)uridine.
cm	2′-O-methylcytidine.
cmnm5s2u	5-carboxymethylaminomethyl-2-thiouridine.
cmnm5u	5-carboxymethylaminomethyluridine.
d	dihydrouridine.
fm	2′-O-methylpseudouridine.
gal q	beta, D-galactosylqueuosine.
gm	2′-O-methylguanosine.
i	inosine.
i6a	N6-isopentenyladenosine.
m1a	1-methyladenosine.
m1f	1-methylpseudouridine.
m1g	1-methylguanosine.
m1i	1-methylinosine.
m22g	2,2-dimethylguanosine.
m2a	2-methyladenosine.
m2g	2-methylguanosine.
m3c	3-methylcytidine.
m5c	5-methylcytidine.
m6a	N6-methyladenosine.
m7g	7-methylguanosine.
mam5u	5-methylaminomethyluridine.
mam5s2u	5-methoxyaminomethyl-2-thiouridine.
man q	beta, D-mannosylqueuosine.
mcm5s2u	5-methoxycarbonylmethyl-2-thiouridine.
mcm5u	5-methoxycarbonylmethyluridine.
mo5u	5-methoxyuridine.
ms2i6a	2-methylthio-N6-isopentenyladenosine.
ms2t6a	N-((9-beta-D-ribofuranosyl-2-methylthiopurine-6-yl)carbamoyl)threonine.
mt6a	N-((9-beta-D-ribofuranosylpurine-6-yl)N-methylcarbamoyl)threonine.
mv	uridine-5-oxyacetic acid-methylester.
o5u	uridine-5-oxyacetic acid.
osyw	wybutoxosine.
p	pseudouridine.

Symbol	Meaning
q	queuosine.
s2c	2-thiocytidine.
s2t	5-methyl-2-thiouridine.
s2u	2-thiouridine.
s4u	4-thiouridine.
t	5-methyluridine.
t6a	N-((9-beta-D-ribofuranosylpurine-6-yl)-carbamoyl)threonine.
tm	2′-O-methyl-5-methyluridine.
um	2′-O-methyluridine.
yw	wybutosine.
x	3-(3-amino-3-carboxy-propyl)uridine, (acp3)u.

[86 FR 57052, Oct. 14, 2021]

Appendix C to Subpart G of Part 1—List of Amino Acids

Source: World Intellectual Property Organization (WIPO) Handbook on Industrial Property Information and Documentation, Standard ST.25: Standard for the Presentation of Nucleotide and Amino Acid Sequence Listings in Patent Applications (2009).

Symbol	Meaning
Ala	Alanine.
Cys	Cysteine.
Asp	Aspartic Acid.
Glu	Glutamic Acid.
Phe	Phenylalanine.
Gly	Glycine.
His	Histidine.
Ile	Isoleucine.
Lys	Lysine.
Leu	Leucine.
Met	Methionine.
Asn	Asparagine.
Pro	Proline.
Gln	Glutamine.
Arg	Arginine.
Ser	Serine.
Thr	Threonine.
Val	Valine.
Trp	Tryptophan.
Tyr	Tyrosine.
Asx	Asp or Asn.
Glx	Glu or Gln.
Xaa	unknown or other.

[86 FR 57052, Oct. 14, 2021]

Appendix D to Subpart G of Part 1—List of Modified and Unusual Amino Acids

Source: World Intellectual Property Organization (WIPO) Handbook on Industrial Property Information and Documentation, Standard ST.25: Standard for the Presentation of Nucleotide and Amino Acid Sequence Listings in Patent Applications (2009).

Symbol	Meaning
Aad	2-Aminoadipic acid.
bAad	3-Aminoadipic acid.
bAla	beta-Alanine, beta-Aminopropionic acid.
Abu	2-Aminobutyric acid.
4Abu	4-Aminobutyric acid, piperidinic acid.
Acp	6-Aminocaproic acid.
Ahe	2-Aminoheptanoic acid.
Aib	2-Aminoisobutyric acid.
bAib	3-Aminoisobutyric acid.
Apm	2-Aminopimelic acid.
Dbu	2,4 Diaminobutyric acid.
Des	Desmosine.
Dpm	2,2′-Diaminopimelic acid.
Dpr	2,3-Diaminopropionic acid.

Symbol	Meaning
EtGly	N-Ethylglycine.
EtAsn	N-Ethylasparagine.
Hyl	Hydroxylysine.
aHyl	allo-Hydroxylysine.
3Hyp	3-Hydroxyproline.
4Hyp	4-Hydroxyproline.
Ide	Isodesmosine.
aIle	allo-Isoleucine.
MeGly	N-Methylglycine, sarcosine.
MeIle	N-Methylisoleucine.
MeLys	6-N-Methyllysine.
MeVal	N-Methylvaline.
Nva	Norvaline.
Nle	Norleucine.
Orn	Ornithine.

[86 FR 57052, Oct. 14, 2021]

Appendix E to Subpart G of Part 1—List of Feature Keys Related to Nucleotide Sequences

Source: World Intellectual Property Organization (WIPO) Handbook on Industrial Property Information and Documentation, Standard ST.25: Standard for the Presentation of Nucleotide and Amino Acid Sequence Listings in Patent Applications (2009).

Key	Description
allele	a related individual or strain contains stable, alternative forms of the same gene, which differs from the presented sequence at this location (and perhaps others).
attenuator	(1) region of DNA at which regulation of termination of transcription occurs, which controls the expression of some bacterial operons; (2) sequence segment located between the promoter and the first structural gene that causes partial termination of transcription.
C__region	constant region of immunoglobulin light and heavy chains, and T-cell receptor alpha, beta, and gamma chains; includes one or more exons depending on the particular chain.
CAAT__signal	CAAT box; part of a conserved sequence located about 75 bp upstream of the start point of eukaryotic transcription units which may be involved in RNA polymerase binding; consensus=GG (C or T) CAATCT.
CDS	coding sequence; sequence of nucleotides that corresponds with the sequence of amino acids in a protein (location includes stop codon); feature includes amino acid conceptual translation.
conflict	independent determinations of the ''same'' sequence differ at this site or region.
D-loop	displacement loop; a region within mitochondrial DNA in which a short stretch of RNA is paired with one strand of DNA, displacing the original partner DNA strand in this region; also used to describe the displacement of a region of one strand of duplex DNA by a single stranded invader in the reaction catalyzed by RecA protein.
D-segment	diversity segment of immunoglobulin heavy chain, and T-cell receptor beta chain.
enhancer	a cis-acting sequence that increases the utilization of (some) eukaryotic promoters, and can function in either orientation and in any location (upstream or downstream) relative to the promoter.
exon	region of genome that codes for portion of spliced mRNA; may contain 5′UTR, all CDSs, and 3′UTR.
GC__signal	GC box; a conserved GC-rich region located upstream of the start point of eukaryotic transcription units which may occur in multiple copies or in either orientation; consensus=GGGCGG.
gene	region of biological interest identified as a gene and for which a name has been assigned.
iDNA	intervening DNA; DNA which is eliminated through any of several kinds of recombination.
intron	a segment of DNA that is transcribed, but removed from within the transcript by splicing together the sequences (exons) on either side of it.
J__segment	joining segment of immunoglobulin light and heavy chains, and T-cell receptor alpha, beta, and gamma chains.
LTR	long terminal repeat, a sequence directly repeated at both ends of a defined sequence, of the sort typically found in retroviruses.
mat__peptide	mature peptide or protein coding sequence; coding sequence for the mature or final peptide or protein product following post-translational modification; the location does not include the stop codon (unlike the corresponding CDS).
misc__binding	site in nucleic acid which covalently or non-covalently binds another moiety that cannot be described by any other Binding key (primer__bind or protein__bind).
misc__difference	feature sequence is different from that presented in the entry and cannot be described by any other Difference key (conflict, unsure, old__sequence, mutation, variation, allele, or modified__base).
misc__feature	region of biological interest which cannot be described by any other feature key; a new or rare feature.
misc__recomb	site of any generalized, site-specific or replicative recombination event where there is a breakage and reunion of duplex DNA that cannot be described by other recombination keys (iDNA and virion) or qualifiers of source key (/insertion__seq, /transposon, /proviral).

Key	Description
misc__RNA	any transcript or RNA product that cannot be defined by other RNA keys (prim__transcript, precursor__RNA, mRNA, 5′clip, 3′clip, 5′UTR, 3′UTR, exon, CDS, sig__peptide, transit__peptide, mat__peptide, intron, polyA__site, rRNA, tRNA, scRNA, and snRNA).
misc__signal	any region containing a signal controlling or altering gene function or expression that cannot be described by other Signal keys (promoter, CAAT__signal, TATA__signal, –35__signal, –10__signal, GC__signal, RBS, polyA__signal, enhancer, attenuator, terminator, and rep__origin).
misc__structure	any secondary or tertiary structure or conformation that cannot be described by other Structure keys (stem__loop and D-loop).
modified__base	the indicated nucleotide is a modified nucleotide and should be substituted for by the indicated molecule (given in the mod__base qualifier value).
mRNA	messenger RNA; includes 5′ untranslated region (5′UTR), coding sequences (CDS, exon) and 3′ untranslated region (3′UTR).
mutation	a related strain has an abrupt, inheritable change in the sequence at this location.
N__region	extra nucleotides inserted between rearranged immunoglobulin segments.
old__sequence	the presented sequence revises a previous version of the sequence at this location.
polyA__signal	recognition region necessary for endonuclease cleavage of an RNA transcript that is followed by polyadenylation; consensus=AATAAA.
polyA__site	site on an RNA transcript to which will be added adenine residues by post-transcriptional polyadenylation.
precursor__RNA	any RNA species that is not yet the mature RNA product; may include 5′ clipped region (5′clip), 5′ untranslated region (5′UTR), coding sequences (CDS, exon), intervening sequences (intron), 3′ untranslated region (3′UTR), and 3′ clipped region (3′clip).
prim__transcript	primary (initial, unprocessed) transcript; includes 5′ clipped region (5′clip), 5′ untranslated region (5′UTR), coding sequences (CDS, exon), intervening sequences (intron), 3′ untranslated region (3′UTR), and 3′ clipped region (3′clip).
primer__bind	non-covalent primer binding site for initiation of replication, transcription, or reverse transcription; includes site(s) for synthetic, for example, PCR primer elements.
promoter	region on a DNA molecule involved in RNA polymerase binding to initiate transcription.
protein__bind	non-covalent protein binding site on nucleic acid.
RBS	ribosome binding site.
repeat__region	region of genome containing repeating units.
repeat__unit	single repeat element.
rep__origin	origin of replication; starting site for duplication of nucleic acid to give two identical copies.
rRNA	mature ribosomal RNA; the RNA component of the ribonucleoprotein particle (ribosome) which assembles amino acids into proteins.
S__region	switch region of immunoglobulin heavy chains; involved in the rearrangement of heavy chain DNA leading to the expression of a different immunoglobulin class from the same B-cell.
satellite	many tandem repeats (identical or related) of a short basic repeating unit; many have a base composition or other property different from the genome average that allows them to be separated from the bulk (main band) genomic DNA.
scRNA	small cytoplasmic RNA; any one of several small cytoplasmic RNA molecules present in the cytoplasm and (sometimes) nucleus of a eukaryote.
sig__peptide	signal peptide coding sequence; coding sequence for an N-terminal domain of a secreted protein; this domain is involved in attaching nascent polypeptide to the membrane; leader sequence.
snRNA	small nuclear RNA; any one of many small RNA species confined to the nucleus; several of the snRNAs are involved in splicing or other RNA processing reactions.
source	identifies the biological source of the specified span of the sequence; this key is mandatory; every entry will have, as a minimum, a single source key spanning the entire sequence; more than one source key per sequence is permissible.
stem__loop	hairpin; a double-helical region formed by base-pairing between adjacent (inverted) complementary sequences in a single strand of RNA or DNA.
STS	Sequence Tagged Site; short, single-copy DNA sequence that characterizes a mapping landmark on the genome and can be detected by PCR; a region of the genome can be mapped by determining the order of a series of STSs.
TATA__signal	TATA box; Goldberg-Hogness box; a conserved AT-rich septamer found about 25 bp before the start point of each eukaryotic RNA polymerase II transcript unit which may be involved in positioning the enzyme for correct initiation; consensus=TATA(A or T)A(A or T).
terminator	sequence of DNA located either at the end of the transcript or adjacent to a promoter region that causes RNA polymerase to terminate transcription; may also be site of binding of repressor protein.
transit__peptide	transit peptide coding sequence; coding sequence for an N-terminal domain of a nuclear-encoded organellar protein; this domain is involved in post-translational import of the protein into the organelle.
tRNA	mature transfer RNA, a small RNA molecule (75–85 bases long) that mediates the translation of a nucleic acid sequence into an amino acid sequence.
unsure	author is unsure of exact sequence in this region.
V__region	variable region of immunoglobulin light and heavy chains, and T-cell receptor alpha, beta, and gamma chains; codes for the variable amino terminal portion; can be made up from V__segments, D__segments, N__regions, and J__segments.
V__segment	variable segment of immunoglobulin light and heavy chains, and T-cell receptor alpha, beta, and gamma chains; codes for most of the variable region (V__region) and the last few amino acids of the leader peptide.

Key	Description
variation	a related strain contains stable mutations from the same gene (for example, RFLPs, polymorphisms, etc.) which differ from the presented sequence at this location (and possibly others).
3′clip	3′-most region of a precursor transcript that is clipped off during processing.
3′UTR	region at the 3′ end of a mature transcript (following the stop codon) that is not translated into a protein.
5′clip	5′-most region of a precursor transcript that is clipped off during processing.
5′UTR	region at the 5′ end of a mature transcript (preceding the initiation codon) that is not translated into a protein.
−10_signal	pribnow box; a conserved region about 10 bp upstream of the start point of bacterial transcription units which may be involved in binding RNA polymerase; consensus=TAtAaT.
−35_signal	a conserved hexamer about 35 bp upstream of the start point of bacterial transcription units; consensus=TTGACa [] or TGTTGACA [].

[86 FR 57052, Oct. 14, 2021]

Appendix F to Subpart G of Part 1—List of Feature Keys Related to Protein Sequences

Source: World Intellectual Property Organization (WIPO) Handbook on Industrial Property Information and Documentation, Standard ST.25: Standard for the Presentation of Nucleotide and Amino Acid Sequence Listings in Patent Applications (2009).

Key	Description
CONFLICT	different papers report differing sequences.
VARIANT	authors report that sequence variants exist.
VARSPLIC	description of sequence variants produced by alternative splicing.
MUTAGEN	site which has been experimentally altered.
MOD_RES	post-translational modification of a residue.
ACETYLATION	N-terminal or other.
AMIDATION	generally at the C-terminal of a mature active peptide.
BLOCKED	undetermined N- or C-terminal blocking group.
FORMYLATION	of the N-terminal methionine.
GAMMA-CARBOXYGLUTAMIC ACID HYDROXYLATION.	of asparagine, aspartic acid, proline, or lysine.
METHYLATION	generally of lysine or arginine.
PHOSPHORYLATION	of serine, threonine, tyrosine, aspartic acid or histidine.
PYRROLIDONE CARBOXYLIC ACID	N-terminal glutamate which has formed an internal cyclic lactam.
SULFATATION	generally of tyrosine.
LIPID	covalent binding of a lipidic moiety.
MYRISTATE	myristate group attached through an amide bond to the N-terminal glycine residue of the mature form of a protein or to an internal lysine residue.
PALMITATE	palmitate group attached through a thioether bond to a cysteine residue or through an ester bond to a serine or threonine residue.
FARNESYL	farnesyl group attached through a thioether bond to a cysteine residue.
GERANYL-GERANYL	geranyl-geranyl group attached through a thioether bond to a cysteine residue.
GPI-ANCHOR	glycosyl-phosphatidylinositol (GPI) group linked to the alpha- carboxyl group of the C-terminal residue of the mature form of a protein.
N-ACYL DIGLYCERIDE	N-terminal cysteine of the mature form of a prokaryotic lipoprotein with an amide-linked fatty acid and a glyceryl group to which two fatty acids are linked by ester linkages.
DISULFID	disulfide bond; the 'FROM' and 'TO' endpoints represent the two residues which are linked by an intra-chain disulfide bond; if the 'FROM' and 'TO' endpoints are identical, the disulfide bond is an interchain one and the description field indicates the nature of the cross-link.
THIOLEST	thiolester bond; the 'FROM' and 'TO' endpoints represent the two residues which are linked by the thiolester bond.
THIOETH	thioether bond; the 'FROM' and 'TO' endpoints represent the two residues which are linked by the thioether bond.
CARBOHYD	glycosylation site; the nature of the carbohydrate (if known) is given in the description field.
METAL	binding site for a metal ion; the description field indicates the nature of the metal.
BINDING	binding site for any chemical group (co-enzyme, prosthetic group, etc.); the chemical nature of the group is given in the description field.
SIGNAL	extent of a signal sequence (prepeptide).
TRANSIT	extent of a transit peptide (mitochondrial, chloroplastic, or for a microbody).
PROPEP	extent of a propeptide.
CHAIN	extent of a polypeptide chain in the mature protein.
PEPTIDE	extent of a released active peptide.
DOMAIN	extent of a domain of interest on the sequence; the nature of that domain is given in the description field.

Key	Description
CA__BIND	extent of a calcium-binding region.
DNA__BIND	extent of a DNA-binding region.
NP__BIND	extent of a nucleotide phosphate binding region; the nature of the nucleotide phosphate is indicated in the description field.
TRANSMEM	extent of a transmembrane region.
ZN__FING	extent of a zinc finger region.
SIMILAR	extent of a similarity with another protein sequence; precise information, relative to that sequence, is given in the description field.
REPEAT	extent of an internal sequence repetition.
HELIX	secondary structure: Helices, for example, Alpha-helix, 3(10) helix, or Pi-helix.
STRAND	secondary structure: Beta-strand, for example, Hydrogen bonded beta-strand, or Residue in an isolated beta-bridge.
TURN	secondary structure Turns, for example, H-bonded turn (3-turn, 4-turn, or 5-turn).
ACT__SITE	amino acid(s) involved in the activity of an enzyme.
SITE	any other interesting site on the sequence.
INIT__MET	the sequence is known to start with an initiator methionine.
NON__TER	the residue at an extremity of the sequence is not the terminal residue; if applied to position 1, this signifies that the first position is not the N-terminus of the complete molecule; if applied to the last position, it signifies that this position is not the C-terminus of the complete molecule; there is no description field for this key.
NON__CONS	non consecutive residues; indicates that two residues in a sequence are not consecutive and that there are a number of unsequenced residues between them.
UNSURE	uncertainties in the sequence; used to describe region(s) of a sequence for which the authors are unsure about the sequence assignment.

[86 FR 57052, Oct. 14, 2021]

Appendix G to Subpart G of Part 1—Numeric Identifiers

Numeric identifier	Definition	Comments and format	Mandatory (M) or optional (O)
<110>	Applicant	If Applicant is inventor, then preferably max. of 10 names; one name per line; preferable format: Surname, Other Names and/or Initials.	M.
<120>	Title of Invention		M.
<130>	File Reference	Personal file reference	M when filed prior to assignment or appl. number.
<140>	Current Application Number.	Specify as: US 09/999,999 or PCT/US09/99999.	M, if available.
<141>	Current Filing Date	Specify as: yyyy-mm-dd	M, if available.
<150>	Prior Application Number.	Specify as: US 09/999,999 or PCT/US09/99999.	M, if applicable include priority documents under 35 U.S.C. 119 and 120.
<151>	Prior Application Filing Date.	Specify as: yyyy-mm-dd	M, if applicable.
<160>	Number of SEQ ID NOs	Count includes total number of SEQ ID NOs.	M.
<170>	Software	Name of software used to create the ''Sequence Listing''.	O.
<210>	SEQ ID NO:#:	Response shall be an integer representing the SEQ ID NO shown.	M.
<211>	Length	Respond with an integer expressing the number of bases or amino acid residues.	M.
<212>	Type	Whether presented sequence molecule is DNA, RNA, or PRT (protein). If a nucleotide sequence contains both DNA and RNA fragments, the type shall be ''DNA.'' In addition, the combined DNA/RNA molecule shall be further described in the <220> to <223> feature section.	M.
<213>	Organism	Scientific name, *i.e.,* Genus/species, Unknown or Artificial Sequence. In addition, the ''Unknown'' or ''Artificial Sequence'' organisms shall be further described in the <220> to <223> feature section.	M.

Numeric identifier	Definition	Comments and format	Mandatory (M) or optional (O)
<220>	Feature	Leave blank after <220>. <221–223> provide for a description of points of biological significance in the sequence.	M, under the following conditions: If ''n,'' ''Xaa,'' or a modified or unusual L-amino acid or modified base was used in a sequence; if ORGANISM is ''Artificial Sequence'' or ''Unknown''; if molecule is combined DNA/RNA.
<221>	Name/Key	Provide appropriate identifier for feature, from WIPO Standard ST.25 (2009), Appendices E and F to this subpart.	M, under the following conditions: If ''n,'' ''Xaa,'' or a modified or unusual L-amino acid or modified base was used in a sequence.
<222>	Location	Specify location within sequence; where appropriate, state number of first and last bases/amino acids in feature.	M, under the following conditions: If ''n,'' ''Xaa,'' or a modified or unusual L-amino acid or modified base was used in a sequence.
<223>	Other Information	Other relevant information; four lines maximum.	M, under the following conditions: If ''n,'' ''Xaa,'' or a modified or unusual L-amino acid or modified base was used in a sequence; if ORGANISM is ''Artificial Sequence'' or ''Unknown''; if molecule is combined DNA/RNA.
<300>	Publication Information	Leave blank after <30>	O.
<301>	Authors	Preferably max. of 10 named authors of publication; specify one name per line; preferable format: Surname, Other Names and/or Initials.	O.
<302>	Title		O.
<303>	Journal		O.
<304>	Volume		O.
<305>	Issue		O.
<306>	Pages		O.
<307>	Date	Journal date on which data published; specify as yyyy-mm-dd, MMM-yyyy or Season-yyyy.	O.
<308>	Database Accession Number.	Accession number assigned by database, including database name.	O.
<309>	Database Entry Date	Date of entry in database; specify as yyyy-mm-dd or MMM-yyyy.	O.
<310>	Patent Document Number.	Document number; for patent-type citations only. Specify as, for example, US 09/999,999.	O.
<311>	Patent Filing Date	Document filing date, for patent-type citations only; specify as yyyy-mm-dd.	O.
<312>	Publication Date	Document publication date, for patent-type citations only; specify as yyyy-mm-dd.	O.
<313>	Relevant Residues	FROM (position) TO (position)	O.
<400>	Sequence	SEQ ID NO should follow the numeric identifier and should appear on the line preceding the actual sequence.	M.

[86 FR 57052, Oct. 14, 2021]

Subpart H—*Inter Partes* Reexamination of Patents That Issued From an Original Application Filed in the United States on or After November 29, 1999

SOURCE: 65 FR 76777, Dec. 7, 2000, unless otherwise noted.

PRIOR ART CITATIONS

§ 1.902 Processing of prior art citations during an *inter partes* reexamination proceeding.

Citations by the patent owner in accordance with §1.933 and by an *inter partes* reexamination third party requester under §1.915 or §1.948 will be entered in the *inter partes* reexamination file. The entry in the patent file of other citations submitted after the

date of an order for reexamination pursuant to §1.931 by persons other than the patent owner, or the third party requester under either §1.913 or §1.948, will be delayed until the *inter partes* reexamination proceeding has been concluded by the issuance and publication of a reexamination certificate. See §1.502 for processing of prior art citations in patent and reexamination files during an *ex parte* reexamination proceeding filed under §1.510.

[72 FR 18906, Apr. 16, 2007]

REQUIREMENTS FOR *Inter Partes* REEXAMINATION PROCEEDINGS

§ 1.903 Service of papers on parties in *inter partes* reexamination.

The patent owner and the third party requester will be sent copies of Office actions issued during the *inter partes* reexamination proceeding. After filing of a request for *inter partes* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on every other party in the reexamination proceeding in the manner provided in §1.248. Any document must reflect service or the document may be refused consideration by the Office. The failure of the patent owner or the third party requester to serve documents may result in their being refused consideration.

§ 1.904 Notice of *inter partes* reexamination in *Official Gazette.*

A notice of the filing of an *inter partes* reexamination request will be published in the *Official Gazette*. The notice published in the *Official Gazette* under §1.11(c) will be considered to be constructive notice of the *inter partes* reexamination proceeding and *inter partes* reexamination will proceed.

§ 1.905 Submission of papers by the public in *inter partes* reexamination.

Unless specifically provided for, no submissions on behalf of any third parties other than third party requesters as defined in 35 U.S.C. 100(e) will be considered unless such submissions are in accordance with §1.915 or entered in the patent file prior to the date of the order for reexamination pursuant to §1.931. Submissions by third parties, other than third party requesters, filed after the date of the order for reexamination pursuant to §1.931, must meet the requirements of §1.501 and will be treated in accordance with §1.902. Submissions which do not meet the requirements of §1.501 will be returned.

§ 1.906 Scope of reexamination in *inter partes* reexamination proceeding.

(a) Claims in an *inter partes* reexamination proceeding will be examined on the basis of patents or printed publications and, with respect to subject matter added or deleted in the reexamination proceeding, on the basis of the requirements of 35 U.S.C. 112.

(b) Claims in an *inter partes* reexamination proceeding will not be permitted to enlarge the scope of the claims of the patent.

(c) Issues other than those indicated in paragraphs (a) and (b) of this section will not be resolved in an *inter partes* reexamination proceeding. If such issues are raised by the patent owner or the third party requester during a reexamination proceeding, the existence of such issues will be noted by the examiner in the next Office action, in which case the patent owner may desire to consider the advisability of filing a reissue application to have such issues considered and resolved.

§ 1.907 *Inter partes* reexamination prohibited.

(a) Once an order to reexamine has been issued under §1.931, neither the third party requester, nor its privies, may file a subsequent request for *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued under §1.997, unless authorized by the Director.

(b) Once a final decision has been entered against a party in a civil action arising in whole or in part under 28 U.S.C. 1338 that the party has not sustained its burden of proving invalidity of any patent claim-in-suit, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such civil action, and an *inter partes* reexamination requested by that party,

or its privies, on the basis of such issues may not thereafter be maintained by the Office.

(c) If a final decision in an *inter partes* reexamination proceeding instituted by a third party requester is favorable to patentability of any original, proposed amended, or new claims of the patent, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claims on the basis of issues which that party, or its privies, raised or could have raised in such *inter partes* reexamination proceeding.

§ 1.913 Persons eligible to file, and time for filing, a request for *inter partes* reexamination.

(a) Except as provided for in § 1.907 and in paragraph (b) of this section, any person other than the patent owner or its privies may, at any time during the period of enforceability of a patent which issued from an original application filed in the United States on or after November 29, 1999, file a request for *inter partes* reexamination by the Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501.

(b) Any request for an *inter partes* reexamination submitted on or after September 16, 2012, will not be accorded a filing date, and any such request will not be granted.

[76 FR 59057, Sept. 23, 2011]

§ 1.915 Content of request for *inter partes* reexamination.

(a) The request must be accompanied by the fee for requesting *inter partes* reexamination set forth in § 1.20(c)(2).

(b) A request for *inter partes* reexamination must include the following parts:

(1) An identification of the patent by patent number and every claim for which reexamination is requested.

(2) A citation of the patents and printed publications which are presented to provide a showing that there is a reasonable likelihood that the requester will prevail with respect to at least one of the claims challenged in the request.

(3) A statement pointing out, based on the cited patents and printed publications, each showing of a reasonable likelihood that the requester will prevail with respect to at least one of the claims challenged in the request, and a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested.

(4) A copy of every patent or printed publication relied upon or referred to in paragraphs (b)(1) through (3) of this section, accompanied by an English language translation of all the necessary and pertinent parts of any non-English language document.

(5) A copy of the entire patent including the front face, drawings, and specification/claims (in double column format) for which reexamination is requested, and a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent. All copies must have each page plainly written on only one side of a sheet of paper.

(6) A certification by the third party requester that a copy of the request has been served in its entirety on the patent owner at the address provided for in § 1.33(c). The name and address of the party served must be indicated. If service was not possible, a duplicate copy of the request must be supplied to the Office.

(7) A certification by the third party requester that the estoppel provisions of § 1.907 do not prohibit the *inter partes* reexamination.

(8) A statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy.

(c) If an *inter partes* request is filed by an attorney or agent identifying another party on whose behalf the request is being filed, the attorney or agent must have a power of attorney from that party or be acting in a representative capacity pursuant to § 1.34.

(d) If the *inter partes* request does not include the fee for requesting *inter partes* reexamination required by paragraph (a) of this section and meet all the requirements of paragraph (b) of this section, then the person identified

as requesting *inter partes* reexamination will be so notified and will generally be given an opportunity to complete the request within a specified time. Failure to comply with the notice will result in the *inter partes* reexamination request not being granted a filing date, and will result in placement of the request in the patent file as a citation if it complies with the requirements of § 1.501.

[65 FR 76777, Dec. 7, 2000, as amended at 71 FR 9262, Feb. 23, 2006; 71 FR 44223, Aug. 4, 2006; 72 FR 18906, Apr. 16, 2007; 76 FR 59058, Sept. 23, 2011]

§ 1.919 Filing date of request for *inter partes* reexamination.

(a) The filing date of a request for *inter partes* reexamination is the date on which the request satisfies all the requirements for the request set forth in § 1.915.

(b) If the request is not granted a filing date, the request will be placed in the patent file as a citation of prior art if it complies with the requirements of § 1.501.

[65 FR 76777, Dec. 7, 2000, as amended at 71 FR 9262, Feb. 23, 2006]

§ 1.923 Examiner's determination on the request for *inter partes* reexamination.

Within three months following the filing date of a request for *inter partes* reexamination under § 1.915, the examiner will consider the request and determine whether or not the request and the prior art establish a reasonable likelihood that the requester will prevail with respect to at least one of the claims challenged in the request. The examiner's determination will be based on the claims in effect at the time of the determination, will become a part of the official file of the patent, and will be mailed to the patent owner at the address as provided for in § 1.33(c) and to the third party requester. If the examiner determines that the request has not established a reasonable likelihood that the requester will prevail with respect to at least one of the challenged claims, the examiner shall refuse the request and shall not order *inter partes* reexamination.

[76 FR 59058, Sept. 23, 2011]

§ 1.925 Partial refund if request for *inter partes* reexamination is not ordered.

Where *inter partes* reexamination is not ordered, a refund of a portion of the fee for requesting *inter partes* reexamination will be made to the requester in accordance with § 1.26(c).

§ 1.927 Petition to review refusal to order *inter partes* reexamination.

The third party requester may seek review by a petition to the Director under § 1.181 within one month of the mailing date of the examiner's determination refusing to order *inter partes* reexamination. Any such petition must comply with § 1.181(b). If no petition is timely filed or if the decision on petition affirms that a reasonable likelihood that the requester will prevail with respect to at least one of the claims challenged in the request has not been established, the determination shall be final and nonappealable.

[76 FR 59058, Sept. 23, 2011]

Inter Partes REEXAMINATION OF PATENTS

§ 1.931 Order for *inter partes* reexamination.

(a) If it is found that there is a reasonable likelihood that the requester will prevail with respect to at least one of the claims challenged in the request, the determination will include an order for *inter partes* reexamination of the patent for resolution of the question of whether the requester will prevail.

(b) If the order for *inter partes* reexamination resulted from a petition pursuant to § 1.927, the *inter partes* reexamination will ordinarily be conducted by an examiner other than the examiner responsible for the initial determination under § 1.923.

[65 FR 76777, Dec. 7, 2000, as amended at 76 FR 59058, Sept. 23, 2011]

INFORMATION DISCLOSURE IN *Inter Partes* REEXAMINATION

§ 1.933 Patent owner duty of disclosure in *inter partes* reexamination proceedings.

(a) Each individual associated with the patent owner in an *inter partes* reexamination proceeding has a duty of candor and good faith in dealing with

the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability in a reexamination proceeding as set forth in §1.555(a) and (b). The duty to disclose all information known to be material to patentability in an *inter partes* reexamination proceeding is deemed to be satisfied by filing a paper in compliance with the requirements set forth in §1.555(a) and (b).

(b) The responsibility for compliance with this section rests upon the individuals designated in paragraph (a) of this section, and no evaluation will be made by the Office in the reexamination proceeding as to compliance with this section. If questions of compliance with this section are raised by the patent owner or the third party requester during a reexamination proceeding, they will be noted as unresolved questions in accordance with §1.906(c).

OFFICE ACTIONS AND RESPONSES (BEFORE THE EXAMINER) IN *Inter Partes* REEXAMINATION

§1.935 Initial Office action usually accompanies order for *inter partes* reexamination.

The order for *inter partes* reexamination will usually be accompanied by the initial Office action on the merits of the reexamination.

§1.937 Conduct of *inter partes* reexamination.

(a) All *inter partes* reexamination proceedings, including any appeals to the Patent Trial and Appeal Board, will be conducted with special dispatch within the Office, unless the Director makes a determination that there is good cause for suspending the reexamination proceeding.

(b) The *inter partes* reexamination proceeding will be conducted in accordance with §§1.104 through 1.116, the sections governing the application examination process, and will result in the issuance of an *inter partes* reexamination certificate under §1.997, except as otherwise provided.

(c) All communications between the Office and the parties to the *inter partes* reexamination which are directed to the merits of the proceeding must be in writing and filed with the Office for entry into the record of the proceeding.

(d) A petition in an *inter partes* reexamination proceeding must be accompanied by the fee set forth in §1.20(c)(6), except for petitions under §1.956 to extend the period for response by a patent owner, petitions under §1.958 to accept a delayed response by a patent owner, petitions under §1.78 to accept an unintentionally delayed benefit claim, and petitions under §1.530(l) for correction of inventorship in a reexamination proceeding.

[65 FR 76777, as amended at 77 FR 46628, Aug. 6, 2012; 77 FR 48853, Aug. 14, 2012]

§1.939 Unauthorized papers in *inter partes* reexamination.

(a) If an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned.

(b) Unless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the *inter partes* reexamination.

§1.941 Amendments by patent owner in *inter partes* reexamination.

Amendments by patent owner in *inter partes* reexamination proceedings are made by filing a paper in compliance with §§1.530(d)–(k) and 1.943.

§1.943 Requirements of responses, written comments, and briefs in *inter partes* reexamination.

(a) The form of responses, written comments, briefs, appendices, and other papers must be in accordance with the requirements of §1.52.

(b) Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

(c) Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is

exceeded, a certificate is required stating the number of words contained in the brief.

§ 1.945 Response to Office action by patent owner in *inter partes* reexamination.

(a) The patent owner will be given at least thirty days to file a response to any Office action on the merits of the *inter partes* reexamination.

(b) Any supplemental response to the Office action will be entered only where the supplemental response is accompanied by a showing of sufficient cause why the supplemental response should be entered. The showing of sufficient cause must include:

(1) An explanation of how the requirements of §1.111(a)(2)(i) are satisfied;

(2) An explanation of why the supplemental response was not presented together with the original response to the Office action; and

(3) A compelling reason to enter the supplemental response.

[72 FR 18906, Apr. 16, 2007]

§ 1.947 Comments by third party requester to patent owner's response in *inter partes* reexamination.

Each time the patent owner files a response to an Office action on the merits pursuant to §1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under §1.8.

§ 1.948 Limitations on submission of prior art by third party requester following the order for *inter partes* reexamination.

(a) After the *inter partes* reexamination order, the third party requester may only cite additional prior art as defined under §1.501 if it is filed as part of a comments submission under §1.947 or §1.951(b) and is limited to prior art:

(1) which is necessary to rebut a finding of fact by the examiner;

(2) which is necessary to rebut a response of the patent owner; or

(3) which for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim.

(b) [Reserved]

§ 1.949 Examiner's Office action closing prosecution in *inter partes* reexamination.

Upon consideration of the issues a second or subsequent time, or upon a determination of patentability of all claims, the examiner shall issue an Office action treating all claims present in the *inter partes* reexamination, which may be an action closing prosecution. The Office action shall set forth all rejections and determinations not to make a proposed rejection, and the grounds therefor. An Office action will not usually close prosecution if it includes a new ground of rejection which was not previously addressed by the patent owner, unless the new ground was necessitated by an amendment.

§ 1.951 Options after Office action closing prosecution in *inter partes* reexamination.

(a) After an Office action closing prosecution in an *inter partes* reexamination, the patent owner may once file comments limited to the issues raised in the Office action closing prosecution. The comments can include a proposed amendment to the claims, which amendment will be subject to the criteria of §1.116 as to whether or not it shall be admitted. The comments must be filed within the time set for response in the Office action closing prosecution.

(b) When the patent owner does file comments, a third party requester may once file comments responsive to the

patent owner's comments within 30 days from the date of service of patent owner's comments on the third party requester.

§ 1.953 Examiner's Right of Appeal Notice in *inter partes* reexamination.

(a) Upon considering the comments of the patent owner and the third party requester subsequent to the Office action closing prosecution in an *inter partes* reexamination, or upon expiration of the time for submitting such comments, the examiner shall issue a Right of Appeal Notice, unless the examiner reopens prosecution and issues another Office action on the merits.

(b) Expedited Right of Appeal Notice: At any time after the patent owner's response to the initial Office action on the merits in an *inter partes* reexamination, the patent owner and all third party requesters may stipulate that the issues are appropriate for a final action, which would include a final rejection and/or a final determination favorable to patentability, and may request the issuance of a Right of Appeal Notice. The request must have the concurrence of the patent owner and all third party requesters present in the proceeding and must identify all of the appealable issues and the positions of the patent owner and all third party requesters on those issues. If the examiner determines that no other issues are present or should be raised, a Right of Appeal Notice limited to the identified issues shall be issued.

(c) The Right of Appeal Notice shall be a final action, which comprises a final rejection setting forth each ground of rejection and/or final decision favorable to patentability including each determination not to make a proposed rejection, an identification of the status of each claim, and the reasons for decisions favorable to patentability and/or the grounds of rejection for each claim. No amendment can be made in response to the Right of Appeal Notice. The Right of Appeal Notice shall set a one-month time period for either party to appeal. If no notice of appeal is filed, prosecution in the *inter partes* reexamination proceeding will be terminated, and the Director will proceed to issue and publish a certificate under §1.997 in accordance with the Right of Appeal Notice.

[65 FR 76777, Dec. 7, 2000, as amended at 72 FR 18906, Apr. 16, 2007]

Interviews Prohibited in *Inter Partes* Reexamination

§ 1.955 Interviews prohibited in *inter partes* reexamination proceedings.

There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

Extensions of Time, Terminating of Reexamination Prosecution, and Petitions To Revive in *Inter Partes* Reexamination

§ 1.956 Patent owner extensions of time in *inter partes* reexamination.

The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition fee set forth in §1.17(g). See §1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.

[69 FR 56546, Sept. 21, 2004]

§ 1.957 Failure to file a timely, appropriate or complete response or comment in *inter partes* reexamination.

(a) If the third party requester files an untimely or inappropriate comment, notice of appeal or brief in an *inter partes* reexamination, the paper will be refused consideration.

(b) If no claims are found patentable, and the patent owner fails to file a timely and appropriate response in an *inter partes* reexamination proceeding, the prosecution in the reexamination proceeding will be a terminated prosecution and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under §1.997 in accordance with the last action of the Office.

(c) If claims are found patentable and the patent owner fails to file a timely and appropriate response to any Office action in an *inter partes* reexamination proceeding, further prosecution will be limited to the claims found patentable at the time of the failure to respond, and to any claims added thereafter which do not expand the scope of the claims which were found patentable at that time.

(d) When action by the patent owner is a *bona fide* attempt to respond and to advance the prosecution and is substantially a complete response to the Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, an opportunity to explain and supply the omission may be given.

[65 FR 76777, Dec. 7, 2000, as amended at 72 FR 18906, Apr. 16, 2007]

§ 1.958 Petition to revive inter partes reexamination prosecution terminated for lack of patent owner response.

If a response by the patent owner is not timely filed in the Office, a petition may be filed pursuant to §1.137 to revive a reexamination prosecution terminated under §1.957(b) or limited under §1.957(c) if the delay in response was unintentional.

[78 FR 62408, Oct. 21, 2013]

APPEAL TO THE PATENT TRIAL AND APPEAL BOARD IN *Inter Partes* REEXAMINATION

§ 1.959 Appeal in *inter partes* reexamination.

Appeals to the Patent Trial and Appeal Board under 35 U.S.C. 134(c) are conducted according to part 41 of this title.

[77 FR 46628, Aug. 6, 2012]

§§ 1.961–1.977 [Reserved]

§ 1.979 Return of Jurisdiction from the Patent Trial and Appeal Board; termination of appeal proceedings.

(a) Jurisdiction over an *inter partes* reexamination proceeding passes to the examiner after a decision by the Patent Trial and Appeal Board upon transmittal of the file to the examiner, subject to each appellant's right of appeal or other review, for such further action as the condition of the *inter partes* reexamination proceeding may require, to carry into effect the decision of the Patent Trial and Appeal Board.

(b) Upon judgment in the appeal before the Patent Trial and Appeal Board, if no further appeal has been taken (§1.983), the prosecution in the *inter partes* reexamination proceeding will be terminated and the Director will issue and publish a certificate under §1.997 concluding the proceeding. If an appeal to the U.S. Court of Appeals for the Federal Circuit has been filed, that appeal is considered terminated when the mandate is issued by the Court.

[77 FR 46628, Aug. 6, 2012]

§ 1.981 Reopening after a final decision of the Patent Trial and Appeal Board.

When a decision by the Patent Trial and Appeal Board on appeal has become final for judicial review, prosecution of the *inter partes* reexamination proceeding will not be reopened or reconsidered by the primary examiner except under the provisions of §41.77 of this title without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

[77 FR 46628, Aug. 6, 2012]

APPEAL TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT IN *Inter Partes* REEXAMINATION

§ 1.983 Appeal to the United States Court of Appeals for the Federal Circuit in *inter partes* reexamination.

(a) The patent owner or third party requester in an *inter partes* reexamination proceeding who is a party to an appeal to the Patent Trial and Appeal Board and who is dissatisfied with the decision of the Patent Trial and Appeal Board may, subject to §41.81, appeal to the U.S. Court of Appeals for the Federal Circuit and may be a party to any appeal thereto taken from a reexamination decision of the Patent Trial and Appeal Board.

(b) The appellant must take the following steps in such an appeal:

(1) In the U.S. Patent and Trademark Office, timely file a written notice of appeal directed to the Director in accordance with §§ 1.302 and 1.304;

(2) In the U.S. Court of Appeals for the Federal Circuit, file a copy of the notice of appeal and pay the fee, as provided for in the rules of the U.S. Court of Appeals for the Federal Circuit; and

(3) Serve a copy of the notice of appeal on every other party in the reexamination proceeding in the manner provided in § 1.248.

(c) If the patent owner has filed a notice of appeal to the U.S. Court of Appeals for the Federal Circuit, the third party requester may cross appeal to the U.S. Court of Appeals for the Federal Circuit if also dissatisfied with the decision of the Patent Trial and Appeal Board.

(d) If the third party requester has filed a notice of appeal to the U.S. Court of Appeals for the Federal Circuit, the patent owner may cross appeal to the U.S. Court of Appeals for the Federal Circuit if also dissatisfied with the decision of the Patent Trial and Appeal Board.

(e) A party electing to participate in an appellant's appeal must, within fourteen days of service of the appellant's notice of appeal under paragraph (b) of this section, or notice of cross appeal under paragraphs (c) or (d) of this section, take the following steps:

(1) In the U.S. Patent and Trademark Office, timely file a written notice directed to the Director electing to participate in the appellant's appeal to the U.S. Court of Appeals for the Federal Circuit by mail to, or hand service on, the General Counsel as provided in § 104.2;

(2) In the U.S. Court of Appeals for the Federal Circuit, file a copy of the notice electing to participate in accordance with the rules of the U.S. Court of Appeals for the Federal Circuit; and

(3) Serve a copy of the notice electing to participate on every other party in the reexamination proceeding in the manner provided in § 1.248.

(f) Notwithstanding any provision of the rules, in any reexamination proceeding commenced prior to November 2, 2002, the third party requester is precluded from appealing and cross appealing any decision of the Patent Trial and Appeal Board to the U.S. Court of Appeals for the Federal Circuit, and the third party requester is precluded from participating in any appeal taken by the patent owner to the U.S. Court of Appeals for the Federal Circuit.

[68 FR 71008, Dec. 22, 2003, as amended at 72 FR 18907, Apr. 16, 2007; 77 FR 46628, Aug. 6, 2012]

CONCURRENT PROCEEDINGS INVOLVING SAME PATENT IN *Inter Partes* REEXAMINATION

§ 1.985 Notification of prior or concurrent proceedings in *inter partes* reexamination.

(a) In any *inter partes* reexamination proceeding, the patent owner shall call the attention of the Office to any prior or concurrent proceedings in which the patent is or was involved, including but not limited to interference or trial before the Patent Trial and Appeal Board, reissue, reexamination, or litigation and the results of such proceedings.

(b) Notwithstanding any provision of the rules, any person at any time may file a paper in an *inter partes* reexamination proceeding notifying the Office of a prior or concurrent proceeding in which the same patent is or was involved, including but not limited to interference or trial before the Patent Trial and Appeal Board, reissue, reexamination, or litigation and the results of such proceedings. Such paper must be limited to merely providing notice of the other proceeding without discussion of issues of the current *inter partes* reexamination proceeding.

[77 FR 46629, Aug. 6, 2012]

§ 1.987 Suspension of *inter partes* reexamination proceeding due to litigation.

If a patent in the process of *inter partes* reexamination is or becomes involved in litigation, the Director shall determine whether or not to suspend the *inter partes* reexamination proceeding.

§ 1.989 Merger of concurrent reexamination proceedings.

(a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance and publication of a single reexamination certificate under § 1.997.

(b) An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an *ex parte* reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by §§ 1.902 through 1.997, except that the rights of any third party requester of the *ex parte* reexamination shall be governed by §§ 1.510 through 1.560.

[65 FR 76777, Dec. 7, 2000, as amended at 72 FR 18907, Apr. 16, 2007]

§ 1.991 Merger of concurrent reissue application and *inter partes* reexamination proceeding.

If a reissue application and an *inter partes* reexamination proceeding on which an order pursuant to § 1.931 has been mailed are pending concurrently on a patent, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger of a reissue application and an *inter partes* reexamination proceeding is ordered, the merged proceeding will be conducted in accordance with §§ 1.171 through 1.179, and the patent owner will be required to place and maintain the same claims in the reissue application and the *inter partes* reexamination proceeding during the pendency of the merged proceeding. In a merged proceeding the third party requester may participate to the extent provided under §§ 1.902 through 1.997 and 41.60 through 41.81, except that such participation shall be limited to issues within the scope of *inter partes* reexamination. The examiner's actions and any responses by the patent owner or third party requester in a merged proceeding will apply to both the reissue application and the *inter partes* reexamination proceeding and be physically entered into both files. Any *inter partes* reexamination proceeding merged with a reissue application shall be concluded by the grant of the reissued patent.

[72 FR 18907, Apr. 16, 2007]

§ 1.993 Suspension of concurrent interference and *inter partes* reexamination proceeding.

If a patent in the process of *inter partes* reexamination is or becomes involved in an interference or trial before the Patent Trial and Appeal Board, the Director may suspend the *inter partes* reexamination, interference, or trial. The Director will not consider a request to suspend an interference or trial unless a motion under § 41.121(a)(3) of this title to suspend the interference or trial has been presented to, and denied by, an administrative patent judge and the request is filed within ten (10) days of a decision by an administrative patent judge denying the motion for suspension or such other time as the administrative patent judge may set.

[77 FR 46629, Aug. 6, 2012]

§ 1.995 Third party requester's participation rights preserved in merged proceeding.

When a third party requester is involved in one or more proceedings, including an *inter partes* reexamination proceeding, the merger of such proceedings will be accomplished so as to preserve the third party requester's right to participate to the extent specifically provided for in these regulations. In merged proceedings involving different requesters, any paper filed by one party in the merged proceeding shall be served on all other parties of the merged proceeding.

REEXAMINATION CERTIFICATE IN *Inter Partes* REEXAMINATION

§ 1.997 Issuance and publication of *inter partes* reexamination certificate concludes *inter partes* reexamination proceeding.

(a) To conclude an *inter partes* reexamination proceeding, the Director will issue and publish an *inter partes* reexamination certificate in accordance with 35 U.S.C. 316 setting forth the results of the *inter partes* reexamination

proceeding and the content of the patent following the *inter partes* reexamination proceeding.

(b) A certificate will be issued and published in each patent in which an *inter partes* reexamination proceeding has been ordered under §1.931. Any statutory disclaimer filed by the patent owner will be made part of the certificate.

(c) The certificate will be sent to the patent owner at the address as provided for in §1.33(c). A copy of the certificate will also be sent to the third party requester of the *inter partes* reexamination proceeding.

(d) If a certificate has been issued and published which cancels all of the claims of the patent, no further Office proceedings will be conducted with that patent or any reissue applications or any reexamination requests relating thereto.

(e) If the *inter partes* reexamination proceeding is terminated by the grant of a reissued patent as provided in §1.991, the reissued patent will constitute the reexamination certificate required by this section and 35 U.S.C. 316.

(f) A notice of the issuance of each certificate under this section will be published in the *Official Gazette*.

[65 FR 76777, Dec. 7, 2000, as amended at 72 FR 18907, Apr. 16, 2007]

Subpart I—International Design Application

SOURCE: 80 FR 17964, Apr. 2, 2015, unless otherwise noted.

GENERAL INFORMATION

§ 1.1001 Definitions related to international design applications.

(a) *Article* as used in this subpart means an article of the Hague Agreement;

(b) *Regulations* as used in this subpart, when capitalized, means the ''Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement'';

(c) *Rule* as used in this subpart, when capitalized, means one of the Regulations;

(d) *Administrative Instructions* as used in this subpart means the Administrative Instructions referred to in Rule 34;

(e) *1960 Act* as used in this subpart means the Act signed at the Hague on November 28, 1960, of the Hague Agreement;

(f) Other terms and expressions in subpart I not defined in this section are as defined in Article 1, Rule 1, and 35 U.S.C. 381.

§ 1.1002 The United States Patent and Trademark Office as an office of indirect filing.

(a) The United States Patent and Trademark Office, as an office of indirect filing, shall accept international design applications where the applicant's Contracting Party is the United States.

(b) The major functions of the United States Patent and Trademark Office as an office of indirect filing include:

(1) Receiving and according a receipt date to international design applications;

(2) Collecting and, when required, transmitting fees due for processing international design applications;

(3) Determining compliance with applicable requirements of part 5 of this chapter; and

(4) Transmitting an international design application to the International Bureau, unless prescriptions concerning national security prevent the application from being transmitted.

§ 1.1003 The United States Patent and Trademark Office as a designated office.

(a) The United States Patent and Trademark Office will act as a designated office (''United States Designated Office'') for international design applications in which the United States has been designated as a Contracting Party in which protection is sought.

(b) The major functions of the United States Designated Office include:

(1) Accepting for national examination international design applications which satisfy the requirements of the Hague Agreement, the Regulations, and the regulations;

(2) Performing an examination of the international design application in accordance with 35 U.S.C. chapter 16; and

(3) Communicating the results of examination to the International Bureau.

§ 1.1004 The International Bureau.

(a) The International Bureau is the World Intellectual Property Organization located at Geneva, Switzerland. It is the international intergovernmental organization which acts as the coordinating body under the Hague Agreement and the Regulations.

(b) The major functions of the International Bureau include:

(1) Receiving international design applications directly from applicants and indirectly from an office of indirect filing;

(2) Collecting required fees and crediting designation fees to the accounts of the Contracting Parties concerned;

(3) Reviewing international design applications for compliance with prescribed formal requirements;

(4) Translating international design applications into the required languages for recordation and publication;

(5) Registering international designs in the International Register where the international design application complies with the applicable requirements;

(6) Publishing international registrations in the International Designs Bulletin; and

(7) Sending copies of the publication of the international registration to each designated office.

§ 1.1005 Display of currently valid control number under the Paperwork Reduction Act.

(a) Pursuant to the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*), the collection of information in this subpart has been reviewed and approved by the Office of Management and Budget under control number 0651–0075.

(b) Notwithstanding any other provision of law, no person is required to respond to nor shall a person be subject to a penalty for failure to comply with a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid Office of Management and Budget control number. This section constitutes the display required by 44 U.S.C. 3512(a) and 5 CFR 1320.5(b)(2)(i) for the collection of information under Office of Management and Budget control number 0651–0075 (*see* 5 CFR 1320.5(b)(2)(ii)(D)).

WHO MAY FILE AN INTERNATIONAL DESIGN APPLICATION

§ 1.1011 Applicant for international design application.

(a) Only persons who are nationals of the United States or who have a domicile, a habitual residence, or a real and effective industrial or commercial establishment in the territory of the United States may file international design applications through the United States Patent and Trademark Office.

(b) Although the United States Patent and Trademark Office will accept international design applications filed by any person referred to in paragraph (a) of this section, an international design application designating the United States may be refused by the Office as a designated office if the applicant is not a person qualified under 35 U.S.C. chapter 11 to be an applicant.

§ 1.1012 Applicant's Contracting Party.

In order to file an international design application through the United States Patent and Trademark Office as an office of indirect filing, the United States must be applicant's Contracting Party (Articles 4 and 1(xiv)).

THE INTERNATIONAL DESIGN APPLICATION

§ 1.1021 Contents of the international design application.

(a) *Mandatory contents.* The international design application shall be in English, French, or Spanish (Rule 6(1)) and shall contain or be accompanied by:

(1) A request for international registration under the Hague Agreement (Article 5(1)(i));

(2) The prescribed data concerning the applicant (Article 5(1)(ii) and Rule 7(3)(i) and (ii));

(3) The prescribed number of copies of a reproduction or, at the choice of the applicant, of several different reproductions of the industrial design that

is the subject of the international design application, presented in the prescribed manner; however, where the industrial design is two-dimensional and a request for deferment of publication is made in accordance with Article 5(5), the international design application may, instead of containing reproductions, be accompanied by the prescribed number of specimens of the industrial design (Article 5(1)(iii));

(4) An indication of the product or products that constitute the industrial design or in relation to which the industrial design is to be used, as prescribed (Article 5(1)(iv) and Rule 7(3)(iv));

(5) An indication of the designated Contracting Parties (Article 5(1)(v));

(6) The prescribed fees (Article 5(1)(vi) and Rule 12(1));

(7) The Contracting Party or Parties in respect of which the applicant fulfills the conditions to be the holder of an international registration (Rule 7(3)(iii));

(8) The number of industrial designs included in the international design application, which may not exceed 100, and the number of reproductions or specimens of the industrial designs accompanying the international design application (Rule 7(3)(v));

(9) The amount of the fees being paid and the method of payment, or instructions to debit the required amount of fees to an account opened with the International Bureau, and the identification of the party effecting the payment or giving the instructions (Rule 7(3)(vii)); and

(10) An indication of applicant's Contracting Party as required under Rule 7(4)(a).

(b) *Additional mandatory contents required by certain Contracting Parties.* (1) Where the international design application contains the designation of a Contracting Party that requires, pursuant to Article 5(2), any of the following elements, then the international design application shall contain such required element(s):

(i) Indications concerning the identity of the creator of the industrial design that is the subject of that application (Rule 11(1));

(ii) A brief description of the reproduction or of the characteristic features of the industrial design that is the subject of that application (Rule 11(2));

(iii) A claim (Rule 11(3)).

(2) Where the international design application contains the designation of a Contracting Party that has made a declaration under Rule 8(1), then the international application shall contain the statement, document, oath or declaration specified in that declaration (Rule 7(4)(c)).

(c) *Optional contents.* The international design application may contain:

(1) Two or more industrial designs, subject to the prescribed conditions (Article 5(4) and Rule 7(7));

(2) A request for deferment of publication (Article 5(5) and Rule 7(5)(e)) or a request for immediate publication (Rule 17);

(3) An element referred to in item (i) or (ii) of Article 5(2)(b) of the Hague Agreement or in Article 8(4)(a) of the 1960 Act even where that element is not required in consequence of a notification in accordance with Article 5(2)(a) of the Hague Agreement or in consequence of a requirement under Article 8(4)(a) of the 1960 Act (Rule 7(5)(a));

(4) The name and address of applicant's representative, as prescribed (Rule 7(5)(b));

(5) A claim of priority of one or more earlier filed applications in accordance with Article 6 and Rule 7(5)(c);

(6) A declaration, for purposes of Article 11 of the Paris Convention, that the product or products which constitute the industrial design or in which the industrial design is incorporated have been shown at an official or officially recognized international exhibition, together with the place where the exhibition was held and the date on which the product or products were first exhibited there and, where less than all the industrial designs contained in the international design application are concerned, the indication of those industrial designs to which the declaration relates or does not relate (Rule 7(5)(d));

(7) Any declaration, statement or other relevant indication as may be specified in the Administrative Instructions (Rule 7(5)(f));

(8) A statement that identifies information known by the applicant to be material to the eligibility for protection of the industrial design concerned (Rule 7(5)(g));

(9) A proposed translation of any text matter contained in the international design application for purposes of recording and publication (Rule 6(4)).

(d) *Required contents where the United States is designated.* In addition to the mandatory requirements set forth in paragraph (a) of this section, an international design application that designates the United States shall contain or be accompanied by:

(1) A claim (§§1.1021(b)(1)(iii) and 1.1025);

(2) Indications concerning the identity of the creator (*i.e.*, the inventor, see §1.9(d)) in accordance with Rule 11(1); and

(3) The inventor's oath or declaration (§§1.63 and 1.64). The requirements in §§1.63(b) and 1.64(b)(4) to identify each inventor by his or her legal name, mailing address, and residence, if an inventor lives at a location which is different from the mailing address, and the requirement in §1.64(b)(2) to identify the residence and mailing address of the person signing the substitute statement will be considered satisfied by the presentation of such information in the international design application prior to international registration.

§ 1.1022 Form and signature.

(a) The international design application shall be presented on the official form (Rules 7(1) and 1(vi)).

(b) The international design application shall be signed by the applicant.

§ 1.1023 Filing date of an international design application in the United States.

(a) Subject to paragraph (b) of this section, the filing date of an international design application in the United States is the date of international registration determined by the International Bureau under the Hague Agreement (35 U.S.C. 384 and 381(a)(5)).

(b) Where the applicant believes the international design application is entitled under the Hague Agreement to a filing date in the United States other than the date of international registration, the applicant may petition the Director under this paragraph to accord the international design application a filing date in the United States other than the date of international registration. Such petition must be accompanied by the fee set forth in §1.17(f) and include a showing to the satisfaction of the Director that the international design application is entitled to such filing date.

§ 1.1024 The description.

An international design application designating the United States must include a specification as prescribed by 35 U.S.C. 112 and preferably include a brief description of the reproduction pursuant to Rule 7(5)(a) describing the view or views of the reproductions.

§ 1.1025 The claim.

The specific wording of the claim in an international design application designating the United States shall be in formal terms to the ornamental design for the article (specifying name of article) as shown, or as shown and described. More than one claim is neither required nor permitted for purposes of the United States.

§ 1.1026 Reproductions.

Reproductions shall comply with the requirements of Rule 9 and Part Four of the Administrative Instructions.

§ 1.1027 Specimens.

Where a request for deferment of publication has been filed in respect of a two-dimensional industrial design, the international design application may include specimens of the design in accordance with Rule 10 and Part Four of the Administrative Instructions. Specimens are not permitted in an international design application that designates the United States or any other Contracting Party which does not permit deferment of publication.

§ 1.1028 Deferment of publication.

The international design application may contain a request for deferment of publication, provided the application does not designate the United States or any other Contracting Party which

does not permit deferment of publication.

FEES

§ 1.1031 International design application fees.

(a) International design applications filed through the Office as an office of indirect filing are subject to payment of a transmittal fee (35 U.S.C. 382(b) and Article 4(2)) in the amount of:

By a micro entity (§1.29)	$24.00
By a small entity (§1.27(a))	48.00
By other than a small or micro entity	120.00

(b) The Schedule of Fees annexed to the Regulations (Rule 27(1)), a list of individual designation fee amounts, and a fee calculator may be viewed on the Web site of the World Intellectual Property Organization, currently available at *http://www.wipo.int/hague*.

(c) The following fees required by the International Bureau may be paid either directly to the International Bureau or through the Office as an office of indirect filing in the amounts specified on the World Intellectual Property Organization Web site described in paragraph (b) of this section:

(1) International application fees (Rule 12(1)); and

(2) Fee for descriptions exceeding 100 words (Rule 11(2)).

(d) The fees referred to in paragraph (c) of this section may be paid as follows:

(1) Directly to the International Bureau in Swiss currency (*see* Administrative Instruction 801); or

(2) Through the Office as an office of indirect filing, provided such fees are paid no later than the date of payment of the transmittal fee required under paragraph (a) of this section. Any payment through the Office must be in U.S. dollars. Applicants paying the fees in paragraph (c) of this section through the Office may be subject to a requirement by the International Bureau to pay additional amounts where the conversion from U.S. dollars to Swiss currency results in the International Bureau receiving less than the prescribed amounts.

(e) Payment of the fees referred to in Article 17 and Rule 24 for renewing an international registration (''renewal fees'') is not required to maintain a U.S. patent issuing on an international design application in force. Renewal fees, if required, must be submitted directly to the International Bureau. Any renewal fee submitted to the Office will not be transmitted to the International Bureau.

(f) The designation fee for the United States shall consist of:

(1) A first part established in Swiss currency pursuant to Hague Rule 28 based on the combined amounts of the basic filing fee (§1.16(b)), search fee (§1.16(l)), and examination fee (§1.16(p)) for a design application. The first part is payable at the time of filing the international design application; and

(2) A second part (issue fee) as provided in §1.18(b). The second part is payable within the period specified in a notice of allowance (§1.311).

[80 FR 17964, Apr. 2, 2015, as amended at 82 FR 52816, Nov. 14, 2017; 88 FR 17158, Mar. 22, 2023]

REPRESENTATION

§ 1.1041 Representation in an international design application.

(a) The applicant may appoint a representative before the International Bureau in accordance with Rule 3.

(b) Applicants of international design applications may be represented before the Office as an office of indirect filing by a practitioner registered (§11.6) or granted limited recognition (§11.9(a) or (b)) to practice before the Office in patent matters. Such practitioner may act pursuant to §1.34 or pursuant to appointment by the applicant. The appointment must be in writing signed by the applicant, must give the practitioner power to act on behalf of the applicant, and must specify the name and registration number or limited recognition number of each practitioner. An appointment of a representative made in the international design application pursuant to Rule 3(2) that complies with the requirements of this paragraph will be effective as an appointment before the Office as an office of indirect filing.

§ 1.1042 Correspondence respecting international design applications filed with the Office as an office of indirect filing.

The applicant may specify a correspondence address for correspondence sent by the Office as an office of indirect filing. Where no such address has been specified, the Office will use as the correspondence address the address of applicant's appointed representative (§ 1.1041) or, where no representative is appointed, the address as specified in Administrative Instruction 302.

TRANSMITTAL OF INTERNATIONAL DESIGN APPLICATION TO THE INTERNATIONAL BUREAU

§ 1.1045 Procedures for transmittal of international design application to the International Bureau.

(a) Subject to paragraph (b) of this section and payment of the transmittal fee set forth in § 1.1031(a), transmittal of the international design application to the International Bureau shall be made by the Office as provided by Rule 13(1). At the same time as it transmits the international design application to the International Bureau, the Office shall notify the International Bureau of the date on which it received the application. The Office shall also notify the applicant of the date on which it received the application and of the transmittal of the international design application to the International Bureau.

(b) No copy of an international design application may be transmitted to the International Bureau, a foreign designated office, or other foreign authority by the Office or the applicant, unless the applicable requirements of part 5 of this chapter have been satisfied.

(c) Once transmittal of the international design application has been effected under paragraph (a) of this section, except for matters properly before the United States Patent and Trademark Office as an office of indirect filing or as a designated office, all further correspondence concerning the application should be sent directly to the International Bureau. The United States Patent and Trademark Office will generally not forward communications to the International Bureau received after transmittal of the application to the International Bureau. Any reply to an invitation sent to the applicant by the International Bureau must be filed directly with the International Bureau, and not with the Office, to avoid abandonment or other loss of rights under Article 8.

RELIEF FROM PRESCRIBED TIME LIMITS; CONVERSION TO A DESIGN APPLICATION UNDER 35 U.S.C. CHAPTER 16

§ 1.1051 Relief from prescribed time limits.

(a) If the delay in an applicant's failure to act within prescribed time limits under the Hague Agreement in connection with requirements pertaining to an international design application was unintentional, a petition may be filed pursuant to this section to excuse the failure to act as to the United States. A grantable petition pursuant to this section must be accompanied by:

(1) A copy of any invitation sent from the International Bureau setting a prescribed time limit for which applicant failed to timely act;

(2) The reply required under paragraph (c) of this section, unless previously filed;

(3) The fee as set forth in § 1.17(m);

(4) A certified copy of the originally filed international design application, unless a copy of the international design application was previously communicated to the Office from the International Bureau or the international design application was filed with the Office as an office of indirect filing, and a translation thereof into the English language if it was filed in another language;

(5) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and

(6) A terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

(b) Any request for reconsideration or review of a decision refusing to excuse the applicant's failure to act within prescribed time limits in connection with requirements pertaining to an international design application upon petition filed pursuant to this section, to be considered timely, must be filed within two months of the decision refusing to excuse or within such time as set in the decision. Unless a decision indicates otherwise, this time period may be extended under the provisions of §1.136.

(c) *Reply*. The reply required may be:

(1) The filing of a continuing application. If the international design application has not been subject to international registration, the reply must also include a grantable petition under §1.1023(b) to accord the international design application a filing date; or

(2) A grantable petition under §1.1052, where the international design application was filed with the Office as an office of indirect filing.

(d) *Terminal disclaimer*. Any petition pursuant to this section must be accompanied by a terminal disclaimer and fee as set forth in §1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period beginning on the due date for the reply for which applicant failed to timely act and ending on the date of filing of the reply required under paragraph (c) of this section and must also apply to any patent granted on a continuing design application that contains a specific reference under 35 U.S.C. 120, 121, 365(c) or 386(c) to the application for which relief under this section is sought.

§1.1052 Conversion to a design application under 35 U.S.C. chapter 16.

(a) An international design application designating the United States filed with the Office as an office of indirect filing and meeting the requirements under §1.53(b) for a filing date for an application for a design patent may, on petition under this section, be converted to an application for a design patent under §1.53(b) and accorded a filing date as provided therein. A petition under this section must be accompanied by the fee set forth in §1.17(t) and be filed prior to publication of the international registration under Article 10(3). The conversion of an international design application to an application for a design patent under §1.53(b) will not entitle applicant to a refund of the transmittal fee or any fee forwarded to the International Bureau, or the application of any such fee toward the filing fee, or any other fee, for the application for a design patent under §1.53(b). The application for a design patent resulting from conversion of an international design application must also include the basic filing fee (§1.16(b)), the search fee (§1.16(l)), the examination fee (§1.16(p)), the inventor's oath or declaration (§1.63 or 1.64), and a surcharge if required by §1.16(f).

(b) An international design application will be converted to an application for a design patent under §1.53(b) if a decision on petition under this section is granted prior to transmittal of the international design application to the International Bureau pursuant to §1.1045. Otherwise, a decision granting a petition under this section will be effective to convert the international design application to an application for a design patent under §1.53(b) only for purposes of the designation of the United States.

(c) A petition under this section will not be granted in an abandoned international design application absent a grantable petition under §1.1051.

(d) An international design application converted under this section is subject to the regulations applicable to a design application filed under 35 U.S.C. chapter 16.

National Processing of International Design Applications

§1.1061 Rules applicable.

(a) The rules relating to applications for patents for other inventions or discoveries are also applicable to international design applications designating the United States, except as otherwise provided in this chapter or required by the Articles or Regulations.

(b) The provisions of §1.74, §1.84, except for §1.84(c), and §§1.152 through 1.154 shall not apply to international design applications.

§ 1.1062 Examination.

(a) *Examination*. The Office shall make an examination pursuant to title 35, United States Code, of an international design application designating the United States.

(b) *Timing*. For each international design application to be examined under paragraph (a) of this section, the Office shall, subject to Rule 18(1)(c)(ii), send to the International Bureau within 12 months from the publication of the international registration under Rule 26(3) a notification of refusal (§ 1.1063) where it appears that the applicant is not entitled to a patent under the law with respect to any industrial design that is the subject of the international registration.

§ 1.1063 Notification of refusal.

(a) A notification of refusal shall contain or indicate:

(1) The number of the international registration;

(2) The grounds on which the refusal is based;

(3) A copy of a reproduction of the earlier industrial design and information concerning the earlier industrial design, where the grounds of refusal refer to similarity with an industrial design that is the subject of an earlier application or registration;

(4) Where the refusal does not relate to all the industrial designs that are the subject of the international registration, those to which it relates or does not relate; and

(5) A time period for reply under §§ 1.134 and 1.136, where a reply to the notification of refusal is required.

(b) Any reply to the notification of refusal must be filed directly with the Office and not through the International Bureau. The requirements of § 1.111 shall apply to a reply to a notification of refusal.

§ 1.1064 One independent and distinct design.

(a) Only one independent and distinct design may be claimed in a nonprovisional international design application.

(b) If the requirements under paragraph (a) of this section are not satisfied, the examiner shall in the notification of refusal or other Office action require the applicant in the reply to that action to elect one independent and distinct design for which prosecution on the merits shall be restricted. Such requirement will normally be made before any action on the merits but may be made at any time before the final action. Review of any such requirement is provided under §§ 1.143 and 1.144.

§ 1.1065 Corrections and other changes in the International Register.

(a) The effects of any correction in the International Register by the International Bureau pursuant to Rule 22 in a pending nonprovisional international design application shall be decided by the Office in accordance with the merits of each situation, subject to such other requirements as may be imposed. A patent issuing from an international design application may only be corrected in accordance with the provisions of title 35, United States Code, for correcting patents. Any correction under Rule 22 recorded by the International Bureau with respect to an abandoned nonprovisional international design application will generally not be acted upon by the Office and shall not be given effect unless otherwise indicated by the Office.

(b) A recording of a partial change in ownership in the International Register pursuant to Rule 21(7) concerning a transfer of less than all designs shall not have effect in the United States.

§ 1.1066 Correspondence address for a nonprovisional international design application.

(a) Unless the correspondence address is changed in accordance with § 1.33(a), the Office will use as the correspondence address in a nonprovisional international design application the address according to the following order:

(1) The correspondence address under § 1.1042;

(2) The address of applicant's representative identified in the publication of the international registration; and

(3) The address of the applicant identified in the publication of the international registration.

(b) Reference in the rules to the correspondence address set forth in § 1.33(a) shall be construed to include a

reference to this section for a nonprovisional international design application.

§ 1.1067 Title, description, and inventor's oath or declaration.

(a) The title of the design must designate the particular article. Where a nonprovisional international design application does not contain a title of the design, the Office may establish a title. No description, other than a reference to the drawing, is ordinarily required in a nonprovisional international design application.

(b) An international design application designating the United States must include the inventor's oath or declaration. *See* §1.1021(d). If the applicant is notified in a notice of allowability that an oath or declaration in compliance with §1.63, or substitute statement in compliance with §1.64, executed by or with respect to each named inventor has not been filed, the applicant must file each required oath or declaration in compliance with §1.63, or substitute statement in compliance with §1.64, no later than the date on which the issue fee is paid to avoid abandonment. This time period is not extendable under §1.136 (*see* §1.136(c)).

§ 1.1068 Statement of grant of protection.

Upon issuance of a patent on an international design application designating the United States, the Office may send to the International Bureau a statement to the effect that protection is granted in the United States to those industrial design or designs that are the subject of the international registration and covered by the patent.

§ 1.1070 Notification of Invalidation.

(a) Where a design patent that was granted from an international design application is invalidated in the United States, and the invalidation is no longer subject to any review or appeal, the patentee shall inform the Office.

(b) After receiving a notification of invalidation under paragraph (a) of this section or through other means, the Office will notify the International Bureau in accordance with Hague Rule 20.

§ 1.1071 Grant of protection for an industrial design only upon issuance of a patent.

A grant of protection for an industrial design that is the subject of an international registration shall only arise in the United States through the issuance of a patent pursuant to 35 U.S.C. 389(d) or 171, and in accordance with 35 U.S.C. 153.

PART 2—RULES OF PRACTICE IN TRADEMARK CASES

EDITORIAL NOTE: Part 2 is placed in the separate grouping of parts pertaining to trademarks regulations.

PART 3—ASSIGNMENT, RECORDING AND RIGHTS OF ASSIGNEE

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