

Petitions Practice Within the PTO on Patent Matters

Abraham HersHKovitz ¹

TABLE OF CONTENTS ²

Topic Page

| | |
|--|----|
| I. Introduction | 3 |
| II. Purpose | 3 |
| III. Background | 3 |
| IV. Scope | 3 |
| V. Requirements of a Petition | 4 |
| A. In Writing | 4 |
| B. Statement of Facts | 5 |
| C. Fee, where appropriate | 5 |
| D. Timeliness | 5 |
| E. Special Requirements | 6 |
| VI. Specific Types of Petitions | 6 |
| A. Petitions for Access | 6 |
| B. Petitions to Expunge | 7 |
| C. Petitions Relating to Small Entity Status | 8 |
| D. Petitions to Permit Filing When Inventor Refuses to Sign or Cannot Be Reached | 9 |
| E. Corrections of Inventorship in Applications Filed Under 37 CFR 1.53(b) | 11 |
| F. Petitions to Obtain or Correct A Filing Date | 13 |
| 1. Examples of 37 CFR 1.53 Errors Resulting in Filing Date Not Being Granted | 13 |
| 2. Things to Remember | 14 |
| 3. Remedy to Correct Errors | 15 |
| 4a. Things to Remember as They Relate to Who May File Applications Under 37 CFR 1.41 and 1.53 | 15 |
| 4b. Remedy to Correct Errors | 15 |
| 5a. Express Mail Errors | 15 |
| 5b. Remedy to Correct Errors | 16 |
| 6a. Missing Drawing or Omitted Specification | 17 |
| 6b. Remedy to Correct Errors | 18 |
| G. Petitions for Extension of Time under 37 CFR 1.136(a) | 19 |

| | |
|--|----|
| H. Petitions Relating to Abandoned Applications or Lapsed Patents .. | 19 |
| 1. Revival | 20 |
| a. Typical Problems Found in 37 CFR 1.137 Petitions | 20 |
| b. Things to Remember | 21 |
| 2. Withdrawal of Holding of Abandonment | 24 |
| I. Petitions Relating to Allowed Applications | 26 |
| 1. Withdrawal from Issue | 26 |
| 2. Deferring Issuance of Patent | 27 |
| 3. Recognition of Priority Claim | 27 |
| J. Supervisory Review (37 CFR 1.181) | 28 |
| K. Suspension of Rules (37 CFR 1.183) | 28 |
| L. Questions Not Specifically Provided For (37 CFR 1.182) | 28 |
| M. Relating to Maintenance Fees | 29 |
| 1. Payment Prior to Expiration | 29 |
| 2. Payment After Expiration | 29 |
| 3. Reconsideration | 30 |
| N. Petitions Relating to Reexamination Practice | 31 |
| 1. Request for Reconsideration of Examiner Denial of Reexamination Request | 31 |
| 2. Request for Extension of Time to File Section 1.515(c) Petition .. | 31 |
| 3. Petitions Filed Under 35 U.S.C. 133 for Entry of Late Papers of Patent Owner | 32 |
| O. PCT Petition Practice | 32 |
| VII. Conclusion | 34 |

I. Introduction

Petitions practice before the United States Patent and Trademark Office is so extensive that no attempt is made in this paper to treat the subject comprehensively. The content of this document is limited to petitions to the Commissioner of Patents and Trademarks relating to patent matters. More specifically, the scope of coverage is directed to those types of petitions which are handled in the Office of the Deputy Assistant Commissioner for Patent Policy and Projects and some of the ones frequently handled in the Examining Corps. These materials are based on a consolidation of internal instructional materials and working knowledge of the Office staff who treat these petitions.

II. Purpose

The purpose of this paper is to provide practitioners with some of the basic principles of petitions practice. The various types of petitions handled in the Office of the Deputy Assistant Commissioner for Patent Policy and Projects and the Examining Corps are identified and the requisite requirements which must be met for the granting of a petition are discussed. Most importantly, to assist practitioners in more effectively practicing before the Office, an attempt is made to provide guidance on how to avoid the most common errors.

III. Background

To begin to understand the nature and function of petitions practice, one must first recognize how the Commissioner exercises his authority to review and supervise the work of the Patent and Trademark Office. It is through section 6(a) of title 35 of the United States Code that the Commissioner can "establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office." Via the establishment of the Rules of Practice and the issuance of orders, notices and memoranda stating Office policies, the Commissioner exercises his authority to manage the Office. For those patent matters which are not subject to an appeal to the Board of Patent Appeals and Interferences and the federal courts, supervisory and administrative review is conducted, in part, by the rendering of decisions on petitions. Inasmuch as the Commissioner cannot possibly personally consider all matters pertaining to the exercise of his supervisory authority, and in the interest of orderly administration of matters within the Office, the Commissioner has authorized various PTO officials to act on his behalf in deciding certain petitions. See Chapter 1000 of the Manual of Patent Examining Procedure (MPEP) for the current delegation of authority to various patent officials to decide the various types of petitions related to patent matters.

IV. Scope

While the scope of subjects to which petitions can pertain is very broad, not all questions which can be raised are proper for petition. As stated in 37 CFR 1.181(a), no petition may be taken from any action of an examiner which is subject to appeal to the Board of Patent Appeals and Interferences or the court.

Under 37 CFR 1.181(a), a petition may be taken to the Commissioner:

- (1) from any action or requirement of any examiner in the ex parte prosecution of an application which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
- (2) in cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and
- (3) to invoke the supervisory authority of the Commissioner in appropriate circumstances.

Under 37 CFR 1.182, a petition may be taken to the Commissioner in all cases not specifically provided for in the regulations and such petitions will be decided in accordance with the merits of each case by or under the authority of the Commissioner.

Under 37 CFR 1.183, a petition may be taken to the Commissioner to suspend or waive any requirement of the regulations which is not a requirement of the statutes.

37 CFR 1.181(g) provides the basis for the delegation of authority to various patent officials to decide these petitions for the Commissioner.

V. Requirements of a Petition

In general, each petition has five requirements. These requirements are as follows:

- A. The petition must be in writing, 37 CFR 1.2.
- B. The petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested, 37 CFR 1.181(b).
- C. Some petitions require a fee, 37 CFR 1.181(d).
- D. The petition must be timely filed, as required in 37 CFR 1.181(f), or as required in a specific statute or regulation.
- E. The petition must comply with any special requirements as provided by statute, regulation or Office policy.

A. In Writing

All business with the Office is transacted in writing. It is recommended that anyone preparing to submit a petition, review Chapter 1000 of the MPEP to determine the official who will be deciding the petition. The petition should have a title from those listed in the MPEP. In addition, the petition should be directed to the official delegated the authority to decide that type of petition. By directing the petition to the appropriate official, delays in the petition reaching the appropriate official for decision might be avoided. If possible, papers should be hand-carried to the appropriate official's office so as to expedite their handling.

Also, attention is directed to the provisions of 37 CFR 1.4(c) which indicate that each distinct subject or inquiry or order should be contained in a separate paper to avoid confusion and delay in answering a paper dealing with different subjects.

B. Statement of Facts

The care and completeness with which petitions are drafted can clearly influence the decision rendered. 37 CFR 1.181(b) sets forth the general requirements for the content of a petition. The petition must contain a statement of the facts involved and the point or points to be reviewed and the action or relief requested. One step that can be taken toward receiving favorable consideration on any petition is to present the petition in as complete a condition as possible. If the petition is urging error in a requirement or action by an examiner, the specific error alleged should be clearly set forth along with the reasons why the requirement or action is considered improper. The authorities, e.g., statute, regulation, notices, etc., relied upon should be clearly set forth. In situations where facts are to be proven, the proof in the form of declarations or affidavits should be presented with the petition. A complete statement of the relevant facts should also be presented. An incomplete presentation of the facts involved often results in an adverse Office decision followed by a renewed petition to present the facts initially omitted and a second decision favorable to the petitioner. Much effort on the part of both petitioner and the deciding official would be avoided by a complete presentation of the facts in the initial petition. While most statements no longer need to be verified when submitted by a non-practitioner, a signature on a paper submitted to the Office constitutes an acknowledgment that willful false statements are punishable under 18 U.S.C. 1001, and may jeopardize the validity of the application or any patent issuing thereon.

C. Fee, Where Appropriate

Many petitions to the Commissioner require a fee before consideration of the merits will be given. 37 CFR 1.17(h), (i), (l), (m) and 37 CFR 1.20(b) should be reviewed to determine whether a fee is appropriate for the petition being filed.

To avoid a petition being dismissed for lack of or insufficient petition fee, a general authorization to charge any required fee to petitioner's deposit account in the Office is recommended.

D. Timeliness

One very important point to keep in mind with regard to petitions is the necessity for filing petitions in a timely manner. Generally, a petition not filed within **two months** from the date of the action complained of may be dismissed as untimely. Further, the mere filing of a petition will not stay the period for replying to an examiner's action that may be running against an application or act as a stay of other proceedings, 37 CFR 1.181(f). The prompt submission of a petition can be of utmost benefit to both the applicant and the Office. For example, a petition to withdraw the finality of an Office action as premature, if filed promptly upon the receipt of the action, might be decided with sufficient time remaining in the period for response to give applicant the benefit of the decision in determining the appropriate response to be made to the outstanding action. Another example of a benefit achieved by prompt filing of a petition involves petitions to revive an abandoned application or to withdraw a holding of abandonment. In situations where an application has been abandoned, a terminal disclaimer may be required. Prompt filing of a grantable petition may reduce the period to be disclaimed in a terminal disclaimer.

E. Special Requirements

Care should be taken to review the applicable statute, regulation or Office policy to determine if there are any other requirements that need to be met in submitting a petition.

VI. Specific Types of Petitions

A. Petitions for Access

Applications are ordinarily preserved in secrecy pursuant to 35 U.S.C. 122 and 37 CFR 1.14(a). However, certain abandoned applications are available without a petition. See 37 CFR 1.14(a)(3)(iv). Furthermore, if a patent incorporates an application by reference, a copy of the application as filed may be obtained upon payment of the fee set forth in 37 CFR 1.19(b)(1) without notice to the applicant. In order for a member of the public to get access to, or copies of, any pending or abandoned applications preserved in secrecy pursuant to

35 U.S.C. 122 and 37 CFR 1.14(a), he or she must either file (1) a petition accompanied by the petition fee set forth in § 1.17(i); or (2) provide written authority for access from the applicant, assignee or attorney or agent of record. 37 CFR 1.14(e). Typical showings are based on the identification of the application to be accessed as an earlier filed copending application upon which benefit of 35 U.S.C. 120 is based, an application incorporated by reference in a U.S. patent application that is open to public inspection, or an application relied upon in making a double patenting rejection against applicant.

Two other types of petitions involving access are (1) by an assignee to exclude the inventor from inspecting the file under 37 CFR 3.71 (see MPEP 106) and (2) by an inventor or assignee to identify an application where suspicion of filing an application exists.

Common errors associated with petitions for access:

1. A copy of the referencing U.S. patent is not provided.
2. Insufficient identification is submitted of the application for which access is sought.
3. The petition is addressed to the wrong application file, i.e., the header is directed to the patented file rather than the application (of which access is desired) referred to in the patented file.
4. Petitioner fails to serve a copy of the petition on the owner of the application sought to be accessed or no duplicate of the served document is submitted.
5. Multiple petitions are contained in a single document rather than filing of individual petitions for each application sought to be accessed.

To ensure prompt treatment of these types of petitions, petitioners should hand-carry or fax them to the Office of Petitions and include an authorization to charge fees to one's deposit account number in the event of any insufficiency in required fees.

B. Petitions to Expunge.

Applicants may expunge information from application files, other than information forming part of the original disclosure, by the filing of a petition under 37 CFR 1.59(b) which satisfies the following criteria:

1. There must be a clear identification of the information to be expunged without disclosure of the details of the contents.
2. A clear statement must be made that the materials constitute a trade secret, or are confidential and/or subject to a protective order.
3. An averment that the information to be expunged has not otherwise been made public must be present.
4. The application papers which hold that the information is not material to examination (in the sense that the information would not be important to a reasonable examiner in deciding whether to allow the application to issue as a patent) must be identified.
5. A statement must be filed that the information will be retained for the term of the patent.
6. The petition must show that it has been submitted by, or on behalf of, the real party in interest.
7. The petition must be accompanied by the requisite fee.

Information that may be expunged under this rule includes information submitted as part of a confidential information disclosure statement pursuant to MPEP section 724.05, information that was unintentionally submitted in an application, and papers that were submitted with the incorrect heading so that they are present in the incorrect application file.

Some of the most common defects found in petitions to expunge is failure to satisfy criterion one, *supra*, namely, that the petition to expunge does either not clearly identify the document or clearly identifies the document, e.g., an application number, and alleges that the application number is confidential information.

Petitioners can improve their chances for success by following the guidance in MPEP 724.02 and clearly labeling any confidential, trade secret or proprietary information. Additionally, it would be desirable to submit the petition to expunge immediately upon allowance of the application to allow sufficient time for action on the petition prior to issuance of the patent. Normally, a decision on the petition, if filed prior to allowance, will be held in abeyance until allowance in order to ensure that the examiner's determination of the "materiality" of the information in question is based on a complete application file record.

To ensure prompt treatment of these types of petitions, petitioners should hand-carry them to the Examining Group having jurisdiction over the application and include an authorization to charge fees to one's deposit account number in the event of any insufficiency in required fees.

C. Petitions Relating to Small Entity Status

Where small entity status is established in good faith, and fees as a small entity are paid in good faith, in any application or patent and it is discovered that the small entity status was established through error or that through error the Office was not notified of a change in status, 37 CFR 1.28(c) provides for excusing such error if the deficiency in fee between the amount paid and the amount due is paid. The deficiency is based on the amount of the fee paid and the non-small entity fee in effect at the time the deficiency is paid in full.

The most frequent errors in papers filed under 37 CFR 1.28(c)(1) which result in a refusal to accept a fee deficiency payment are:

1. Fee deficiencies are not paid at current fee levels.
2. Inquiries regarding whether the Office will accept a particular explanation for the erroneous payment of a small entity fee are unnecessary. The Office will accept a fee deficiency payment under 37 CFR 1.28(c) as a representation by the party submitting the payment that small entity status was established in good faith and that the original payment of small entity fees was made in good faith. As an explanation of the error in the original payment is no longer necessary, any paper submitted under § 1.28(c) will be placed in the file without review.
3. The Office is requested to render an opinion: 1) as to qualification for small entity status, 2) as to the possible transfer of rights under an agreement, or 3) whether an issue under § 1.28(c) exists. No issue under § 1.28(c) will be deemed to be present once a deficiency is paid. All deficiency payments made under § 1.28(c) will be accepted when made, such as when submitted merely out of an abundance of caution. The Small Business Administration's size standards staff should be contacted for questions relating to size determinations.
4. Some small entity forms for Small Business Concerns and for Non-Profit Organizations, where intended to be the only small entity statement submitted, fail to clearly identify that "exclusive rights" have been retained by the sole party submitting the statement. Such statements merely refer to "rights" ("rights" can be some rights and do not necessarily imply exclusive rights) being conveyed and remaining with the party submitting the statement and they omit a following form paragraph (MPEP 509.03) that when present but not completed identifies the transferred rights as exclusive. Exclusive rights means all rights in the U.S. application without limitation, such as by geographic area.
5. Some fee deficiency payments under § 1.28(c) are not addressed to the appropriate office, which may cause some delay in processing.
6. A single check submitted under § 1.28(c) for more than one application and/or patent in which the fees to be applied are not specifically identified. Where payment of fee deficiencies relate to more than one application and/or patent, a separate check for the fee deficiencies for each application and/or patent should be submitted with a breakout of how the check total is to be applied.

Practitioners are advised that if the small entity status statement is defective at the time of filing, a surcharge under 37 CFR 1.16(e) will be applied where authorization to charge large entity fees to a deposit account number is not given. Also, the omission of a statement from any (additional) small entity required to file a statement will cause an otherwise appropriate small entity status to be improper.

D. Petitions to Permit Filing When An Inventor Refuses to Sign or Cannot Be Reached

Where a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, a petition under 37 CFR 1.47(a) can be filed to permit acceptance of an application filed by the other inventor(s) on his or her behalf and that of the non-signing inventor. The submission must contain proof of the pertinent facts of the diligent efforts made, the required fee and the last known address of the non-signing inventor.

Similarly, whenever all of the inventors or the sole inventor refuse(s) to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventors have assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action may file an application for patent on behalf of the non-signing inventor(s). A petition to permit filing under 37 CFR 1.47(b) must be submitted with the oath or declaration executed by the Rule 47 applicant on behalf of the non-signing inventor(s) and the Rule 47 applicant.

Either of the above petitions must include:

1. Proof that the non-signing inventors were presented with the application papers and refused to sign the oath or declaration or that the non-signing inventor(s) could not be found or reached after diligent effort;
2. The required fee; and
3. The last known address of the non-signing inventor(s).

Additionally, when filing under 37 CFR 1.47(b) petitioner must provide proof of proprietary interest and state that the filing of the application for patent is necessary to preserve the rights of the parties or to prevent irreparable damage. Proof of proprietary interest may be provided with a copy of an assignment, a written agreement to assign or a memorandum of law establishing that a court of competent jurisdiction

would award title to the Rule 47 applicant.

In a continuation or divisional application, a copy of an oath or declaration from a prior application may be filed. If a petition under 37 CFR 1.47 was granted in the prior application and the non-signing inventor(s) or, if the inventor is deceased, the legal representative(s) did not later join the application, a copy of the decision granting status under 37 CFR 1.47 must also be filed. See 37 CFR 1.63(d)(3)(i). Accordingly, neither a new petition under 37 CFR 1.47 nor a petition fee will be required if a copy of the oath or declaration from a prior application and a copy of the decision according status are filed in a continuation or divisional application.

To guide practitioners in improving their petitions filed under 37 CFR 1.47 the following information should be noted.

1. 37 CFR 1.47(b) is only available where none of the inventors are willing to sign an oath or declaration. If at least one of the joint inventors is available to execute the application, the petition must be filed under § 1.47(a).
2. Where the petition is filed under 37 CFR 1.47(a), all the signing inventors must sign the 37 CFR 1.63 Declaration on behalf of themselves and on behalf of the non-signing inventor(s). It is insufficient if only one of the other joint inventors signs on behalf of the non-signing inventor(s).
3. Where the petition is filed under 37 CFR 1.47(b), the title, post office address and residence of the person signing on behalf of the non-signing inventor(s) must also be stated in the 37 CFR 1.63 Declaration.
4. If the § 1.47(b) applicant is a corporation, an authorized representative of the corporation must sign the § 1.63 Declaration on behalf of and as agent for the non-signing inventor(s).
5. A § 1.47 petition must be accompanied by proof of presentation of the application papers to the non-signing inventor(s) for review. An offer to the inventor(s) to go to counsel's office to review the application is insufficient. Sending the § 1.63 Declaration without a copy of the application to the inventor(s) is insufficient.
6. Applicant cannot use the procedure under 37 CFR 1.47 where the inventor is on vacation or out of town for a certain amount of time and is therefore unavailable to sign the § 1.63 Declaration and the application must be filed during the absence of the inventor for reasons such as to meet the one year priority deadline. Section 1.47 is only available where the inventor(s) refuses to sign the § 1.63 Declaration or cannot be found or reached after diligent efforts. The fact that the inventor(s) is on vacation or out of town ordinarily would not fall within 37 CFR 1.47.
7. Where the reason for filing under § 1.47 is that the inventor(s) cannot be found after diligent efforts have been made, it is insufficient to just check the employment record to see if there is a forwarding address or to just check the telephone directory. A § 1.47 applicant must at least check the post office servicing the last known address of the non-signing inventor(s) to see if there is a forwarding address for the non-signing inventor(s).
8. Hearsay statements are not acceptable. The statements to support the § 1.47 petition must be by a person having first-hand knowledge of the details.
9. If the non-signing inventor is a deceased inventor, then for § 1.47 to be applicable, the legal representative of the deceased inventor must have refused to join in the filing of the application or could not be reached. Furthermore, the oath or declaration in such an application should name the legal representative and set forth their residence, citizenship and post office address as well as that of the deceased inventor.

E. Correction of Inventorship in Applications Filed under 37 CFR 1.53(b)

Where through error without deceptive intention the original oath or declaration of an application is filed naming incorrect inventor(s), applicant may petition under 37 CFR 1.48 for correction. The requirements of the petition are:

1. A statement of facts by each person being added as an inventor and from each person being deleted as an inventor that the error occurred without deceptive intention;
2. An oath or declaration under 37 CFR 1.63 executed by the correct inventors;
3. A petition fee; and
4. The written consent of any existing assignee of the originally named inventors supported by a 37 CFR 3.73(b) certification.

The defects most frequently occurring in the filing of correction of inventorship petitions are described below.

A. Statement of Facts

A statement by an added or deleted inventor is not submitted as the party is hostile. Consider: either filing a petition for waiver of the requirement under 37 CFR 1.183 where the application has been assigned and the assignee is in agreement with the requested change, or refiling of the application naming the correct inventive entity.

B. When more than one § 1.63 declaration is used for execution of the application by the inventors, each declaration does not list all the inventors.

C. Use of a § 1.63 declaration with an attached application to identify a previously submitted specification that the § 1.63 declaration is intended to execute, rather than simple reliance on the application's filing date and application number, often results in:

1. a failure to, in fact, attach the specification to the declaration;
2. a failure to supply the required statement that the attached specification is a copy of the specification and any amendments thereto which were filed in the Office in order to obtain a filing date for the application. MPEP 601.01. Part of the problem may stem from a failure to recognize that the declaration being submitted is for an already pending application and is not being supplied with the application papers.

D. A failure to state that no assignee exists when a small entity statement is submitted on behalf of a small business, university or

non-profit organization that is a licensee.

E. A failure to establish that the written consent of an assignee has been executed by a party authorized to do so. 37 CFR 3.73(b) establishing right of assignee to take action is applicable to written consent of the assignee.

F. Submission of a § 1.48(a) petition in a reissue application. The § 1.48(a) petition is superfluous as an inventorship error in a patent is correctable by the reissue application itself.

G. Listing the parent application's inventive entity on the Declaration of continuing applications, in the erroneous belief that the same inventive entity is required to obtain benefit of the parent application's filing date under 35 U.S.C. 120 and 37 CFR 1.78, rather than naming the correct inventive entity and avoiding a § 1.48(a) issue as long as there is at least one inventor overlap. Inventors can be deleted by filing a statement requesting deletion. Inventors can be added by filing a new declaration.

H. Applicants fail to check whether a § 1.48 petition filed in the prior application is actually granted prior to filing a continuing application.

Occasionally, a petition under 37 CFR 1.48(a) filed in a pending application is not acted upon before issuance. In such instances, the failure to act on the petition should be promptly brought to the attention of the Office so that the petition could be treated under § 1.324. This is particularly critical where there is a § 1.183 waiver request which cannot be treated under § 1.324.

F. Petitions to Obtain or Correct a Filing Date

37 CFR 1.53 provides procedures for filing applications. Under § 1.53(b), an original, continuation, divisional or continuation-in-part (C-I-P) application may be filed. All applications filed under 37 CFR 1.53(b) require a specification, including at least one claim and drawings, if necessary to understand the claimed subject matter. The Office no longer permits transfer of drawings from one application to another application. As of December 1st, 1997, 37 CFR 1.41 and 1.53 no longer require that the inventors be identified at the time of filing the application. As permitted by 37 CFR 1.53(f), the filing fee and the signed oath or declaration identifying the names of the inventors may be filed later than the filing date upon payment of the surcharge required by 37 CFR 1.16(e).

Continuing applications may no longer be filed under § 1.60 or § 1.62. Instead, a continued prosecution application (CPA) may be filed under § 1.53(d). A CPA will not receive a new application number. Rather, the filing of a CPA will simply result in a continuation of prosecution as part of the same application file. No new matter may be introduced into a CPA.

An application purporting to be an application filed under § 1.60 will be treated as a new application filed under § 1.53 (the reference to § 1.60 will simply be ignored). An application purporting to be an application filed under § 1.62 will be treated as a CPA filed under § 1.53(d). Those applications that do not meet the requirements of § 1.53(d) (e.g., C-I-P applications) will be treated as improper CPAs under § 1.53(d). Such improper applications may be accepted and treated as a proper application under § 1.53(b) by way of petition under § 1.53(e) and submission of the petition fee under § 1.17(i).

To avoid the necessity of filing a petition to cure a filing date problem, be aware of the requirements of each of the aforementioned rules. For example, for CPA filing under § 1.53(d), new application papers or copies of the parent application are unnecessary and should not be submitted with the request. Also, one cannot file a CPA after payment of the issue fee, unless the application has been withdrawn from issue. See 37 CFR 1.313(b).

Review the official filing receipt for applications filed under 37 CFR 1.53(b) and (c) to ascertain whether the filing date and other application data are correct. Do not delay in filing a petition to change a filing date since petitions not filed within two months from an action complained of may be dismissed as untimely.

To provide practitioners with a more detailed recitation of the typical types of errors committed in filing applications and how to rectify such errors, the following discussion is provided.

1. Examples of 37 CFR 1.53 Errors Resulting In Filing Date Not Being Granted

- a. When filing a continuing application under 37 CFR 1.53(b), an old transmittal form is used requesting the Office to make a copy of the prior application.
- b. Applicant requests a continuation-in-part application (C-I-P) under § 1.60 or § 1.62 which is no longer permitted by the rule.
- c. Continuing applications are filed with no copendency with the parent application;
- d. A continuing application is filed without copendency because applicant tried to use § 1.8 rather than § 1.10 mailing procedures.
- e. Applicants try to file more than one CPA based on the same parent application;
- f. Applicants attempt to file a single CPA from two different prior applications;
- g. Continuation or divisional applications under 37 CFR 1.53(d) which are intended to replace the parent application are filed after the issue fee is paid in the parent application and the parent application has not been withdrawn from issue as provided by 37 CFR 1.313(b);

2. Things to Remember

- a. For a proper 37 CFR 1.53(d) CPA, the prior application must be complete under 37 CFR 1.51(b);

- b. Filing of a continuation or divisional application using a copy of the oath or declaration from the prior application is still permitted under 37 CFR 1.53(b);
- c. A § 1.53(d) CPA requires only a request. It is unnecessary to submit a specification, declaration or drawings. If submitted, they would be treated as a preliminary amendment. The file wrapper contents of the prior application constitute the new § 1.53(d) application;
- d. The prior application is expressly abandoned upon filing of a proper § 1.53(d) request;
- e. One or more inventors may be deleted by a simple statement requesting deletion (such as when filing a continuation or divisional application under 37 CFR 1.53(b) or (d));
- f. In a CPA, a specific reference to a prior application should not be added to the first line of the specification;
- g. Small entity status requests and elections of inventions do not carry automatically over to the CPA from the prior application. While a new small entity statement is not required for a CPA, authorizations to charge filing fees to a deposit account, without specifying the exact amount to be charged, will result in fees charged in an amount appropriate for a non-small entity.
- h. A C-I-P may only be filed under § 1.53(b).

3. Remedy to Correct Errors

The usual remedy to correct a § 1.53 filing error is to file a petition explaining the delay in filing the omitted item directed to the Office of Petitions. Any missing parts should accompany the petition and should be accompanied by the fee required by 37 CFR 1.17(i) for CPAs and non-provisional applications or the fee required by 37 CFR 1.17(q) for provisional applications. Such petitions are liberally treated where a requirement of a statute is not involved and the petition is timely filed. Remember, copendency cannot be waived as it is a statutory requirement. Therefore, applicant must petition to revive the parent application under 37 CFR 1.137 to obtain copendency if the parent application became abandoned prior to filing of the § 1.53 application.

To correct a defective § 1.53(d) filing, a petition to convert to a § 1.53(b) filing, accompanied by the petition fee set forth in 37 CFR 1.17(i) is required. Any lack of copendency must be corrected by petition to revive the prior application under 37 CFR 1.137.

4a. Things to Remember as They Relate to Who May File Applications Under 37 CFR 1.41 and 1.53.

While a patent is applied for in the name(s) of the actual inventor(s), sections 1.41 and 1.53 no longer require identification of the actual inventors to be accorded a filing date. Any alphanumeric combination may be used on the transmittal form to identify the inventor(s). The requirement for use of full names of inventors appears in § 1.63(a). Thus, identification of full names of the actual inventor(s) in a nonprovisional application may be postponed until the filing of the § 1.63 declaration. The inventorship of a provisional application is set forth on the cover sheet as prescribed in § 1.51(c)(1)(ii). If a cover sheet is not filed during pendency of the provisional application, the inventorship is taken from the papers filed pursuant to § 1.53(c).

4b. Remedy to Correct Errors

If an oath or declaration as prescribed by § 1.63 is not filed during pendency of a non-provisional application, or if a cover sheet as prescribed by § 1.51(c)(1) is not filed during pendency of a provisional application, a petition supplying or changing the name(s) of the inventor(s) should be filed accompanied by the fee set forth in 37 CFR 1.17(i) for a non-provisional application or the fee set forth in 37 CFR 1.17(q) for a provisional application.

5a. Express Mail Errors

Typical Errors committed by applicants who use the provisions of § 1.10 are described below.

- A. Problems arise when mail is deposited in an Express Mail drop box late in the day after the last pick-up has occurred. The "Date-In" on the label is the date the Post Office received the application. Applicants should carry mail to the Post Office window when possible and get a receipt and then check the "Date-In" on the receipt. The "Date-In" must be entered by the Post Office, not applicant;
- B. Applicants file separate papers or different applications in the same mailing envelope which do not each have the Express Mail number thereon;
- C. The proper postage has not been provided.
- D. The Express Mail label is not properly addressed.

5b. Remedy to Correct Errors

- A. Express Mail correspondence received in the PTO, but given a date other than "date-in" on the receipt.

In accordance with 37 CFR 1.10(c), any person filing correspondence, may file a petition to have an earlier filing date accorded, provided that:

- (i) 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;

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

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

B. Express Mail correspondence given incorrect date or no date by the USPS.

In accordance with 37 CFR 1.10(d), any person filing correspondence, may file a petition to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:

(i) 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;

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

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

C. Express Mail correspondence not received in the PTO.

In accordance with 37 CFR 1.10(e), any person filing correspondence, may file a petition to have such correspondence considered as having been filed in the PTO on the USPS deposit date, provided that:

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

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

(iii) The petition includes a copy of the originally deposited paper(s) or fee(s) that constitute the correspondence showing the number of the "Express Mail" mailing label thereon, a copy of any returned postcard receipt, a copy of the "Express Mail" mailing label showing the "date-in," a copy of any other official notation by the USPS relied upon to show the date of deposit, and, if the requested filing date is a date other than the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS, a showing pursuant to paragraph 2(C), above, that the requested filing date was the date the correspondence was deposited in "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day; and

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

6a. Missing Drawing or Omitted Specification

A. A drawing is required for a filing date where it is necessary for the understanding of the subject matter sought to be patented (35 U.S.C. 111 and 113, 1st sentence), or if described in the specification (MPEP, 506, 601.01 and 608.02);

B. Check the application before filing to ensure that any drawing referred to in the specification is present;

C. Check the drawings to ensure that each figure is properly labeled;

D. Number each page of the specification in consecutive order and review the application for completeness before filing;

E. A postcard receipt should contain a specific itemization of all the items being submitted (MPEP 503). Therefore, the post card receipt should specifically itemize the number of pages of the specification, the number of pages of the declaration and the number of sheets of drawings (including the number of figures contained thereon) being submitted. (Note: hundreds of postcard receipts each year are never returned to counsel because correct postage or return address is lacking);

F. The best evidence of what the Office received is a properly itemized postcard receipt stamped with the mail room date.

6b. Remedy to Correct Errors

If an application is filed without all the pages of the specification or without all of the figures of the drawings, the Office will still accord a filing date to any application that contains something that can be construed as a written description, any necessary drawing, and, in a nonprovisional application, at least one claim. The Office will mail a notice to applicant indicating that the application has been accorded a filing date, but is missing pages of the specification or figures of drawings. Failure to promptly (within an extendable two month period) file a petition under 37 CFR 1.53(c) or 1.182 in response to such notice will result in the Office treating the application as including only those papers originally deposited. Amendment of the specification is required in a nonprovisional application to renumber the pages consecutively and to cancel any incomplete sentences.

Alternatively, applicant may promptly submit the omitted pages or drawings in a nonprovisional application and accept the date of such submission as the application filing date. The submission must include an oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such page(s) and a petition under 37 CFR 1.182 (with the petition fee under 37 CFR 1.17(h)) requesting the later filing date.

An applicant asserting that the page(s) was in fact deposited in the Office with the application papers must promptly file a petition under 37 CFR 1.53(c) (and the petition fee under 37 CFR 1.17(i) for a nonprovisional application or under 37 CFR 1.17(q) for a provisional application, which will be refunded if it is determined that the page(s) was in fact received by the PTO) with evidence of such deposit.

Petitions to obtain or correct a filing date should be directed to the attention of the Office of Petitions and must include the petition fee or an authorization to charge the petition fee to a deposit account. If the petition alleges that no defect exists, a request for refund of the petition fee may be included in the petition.

G. Petitions for Extension of Time under 37 CFR 1.136(a)

Effective for papers filed on or after December 1, 1997, a number of changes related to extension of time under section 1.136(a) have been implemented. The following is a summary of the changes:

1. A maximum five-month extension of time may be obtained under 37 CFR 1.136(a). Thus, a one-month or 30-day period for reply to a restriction requirement may be extended up to the six-month statutory period set forth in 35 U.S.C. 133 by paying for a five-month extension of time.

The one-month non-extendable time limit specified in 37 CFR 135(c) to complete a response has been replaced by a one-month shortened statutory period which can similarly be extended up to the maximum six-month statutory period by paying for a five-month extension of time.

In addition, as the two-month period set in § 1.192(a) for filing an appeal brief is not subject to the maximum six-month maximum period, the filing of an appeal brief may be extended up to seven months by paying for a five-month extension of time.

Similarly, where an extension of time for requesting reconsideration of an adverse decision on petition is extendable under 37 CFR 1.136(a), a five-month maximum extension may be obtained to extend the due date to the maximum seven-month period.

2. The filing in an application, of a general authorization to treat any reply requiring a petition for an extension of time for its timely submission, or a specific authorization to treat an accompanying reply requiring a petition for extension of time for its timely submission, will constitute a request for the appropriate length of time without the need for a separate petition for extension of time. The authorization may be filed at any time prior to or with the submission of a reply, but will not apply to a reply filed prior to the authorization. In order to avoid having general authorizations for payment of fees and petitions for extension of time overlooked by Office staff, it is recommended that applicants file these as separate papers rather than sentences buried in papers directed to other matters. If the appropriate payment is enclosed or is available in an Office deposit account being authorized to be debited, the reply will be deemed to have been timely filed.

The other major area of petition practice relates to matters involving abandoned, allowed and patented applications. These matters are handled by the Office of Petitions and are described at length infra.

H. Petitions Relating to Abandoned Applications or Lapsed Patents

1. Revival

37 CFR 1.137 covers petitions to revive applications abandoned for failure to prosecute, or failure to pay the required issue fee and petitions to revive a lapsed patent for failure to pay any balance of the issue fee due. There are two kinds of petitions to revive identified in this regulation. Section 1.137(a) concerns revival based upon an unavoidable delay in prosecution or payment of the required issue fee, whereas § 1.137(b) concerns revival based upon an unintentional delay in prosecution or payment of the required issue fee.

(a) Requirements for a petition under 37 CFR 1.137(a) (delay was unavoidable):

(1) Required reply, unless previously filed.

(2) Petition fee set forth in 37 CFR 1.17(l).

(3) Showing that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable.

(4) Any terminal disclaimer under 37 CFR 1.321 (with fee; 37 CFR 1.20(d)) dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application if the application is a design application (regardless of filing date) or a utility application filed before June 8, 1995, or a plant patent application filed before June 8, 1995. The terminal disclaimer provisions of this paragraph do not apply to lapsed patents.

(b) Requirements for a petition under 37 CFR 1.137(b) (delay was unintentional):

(1) Required reply, unless previously filed.

(2) Petition fee set forth in 37 CFR 1.17(m).

(3) 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 was unintentional. No showing of reasons for delay is necessary.

(4) Any terminal disclaimer under 37 CFR 1.321 (with fee; 37 CFR 1.20(d)) dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application if the application is a design application (regardless of filing date) or a utility application filed before June 8, 1995 or a plant patent application filed before June 8, 1995. The terminal disclaimer provisions of this paragraph do not apply to lapsed patents.

a. Typical Problems Found in 37 CFR 1.137 Petitions

i. Statements are filed by a petitioner who was not the party responsible for prosecuting the application at the time of the abandonment. Therefore, the petitioner is not in a position to know whether the delay was unavoidable or unintentional.

ii. The petitioner attributes fault for the delay in filing a reply to an employee such as a secretary, clerk or courier without submitting a statement from that person.

iii. A frequent defect is the submission of incomplete evidence such as docket sheets or exhibits with incorrect or missing pages for unavoidable delay petitions.

iv. Petitions are not signed prior to being sent by facsimile transmission or other delivery means to the Office.

v. Petitioner intentionally delays the filing of a petition after first becoming aware of the abandonment. While questions are not normally raised when petitions under the unintentional standard are filed within one year of the date of abandonment, it is not appropriate to intentionally delay the filing of a petition after becoming aware of the abandoned status of the application.

vi. Petitioner does not submit a proper reply to an outstanding office action with the petition. By way of example, amendments filed after a final rejection, do not constitute a proper reply if the examiner refuses to have the amendment entered due to non-compliance with 37 CFR 1.116. Unless an amendment filed after a final rejection clearly places the application in condition for allowance, it is recommended that the reply filed be a Notice of Appeal or a CPA.

vii. Petitioners mistakenly believe that lack of knowledge of the rules or reliance on oral statements by Office employees are acceptable reasons for a petition under the unavoidable standard to be granted.

viii. Petitioners attempt to revive a provisional application beyond twelve months from filing. While the petition can be filed outside the twelve-month period (usually for copendency), a provisional application can only be pending for a period of twelve months from filing.

b. THINGS TO REMEMBER

i. Petitions to revive filed under either the unavoidable or the unintentional standards should be filed within two months of becoming aware of the abandonment of the application to be considered *prima facie* timely. See 37 CFR 1.181(f).

ii. Renewed petitions to revive must be filed within two months of an adverse decision on the earlier petition to revive to be considered timely, unless a proper extension of time up to an additional five months (for a total of seven months) is obtained under 37 CFR 1.136(a). Otherwise, the Office may require a specific showing as to how the entire delay was unavoidable or unintentional. In this regard, a general authorization to charge all necessary fees to a deposit account or a specific authorization to charge extension of time fees will result in having extension of time fees charged in any renewed petitions filed outside the period set for renewing the petition if the maximum extension period has not lapsed.

iii. A petition under 37 CFR 1.137(a) must be accompanied by the petition fee set forth in 37 CFR 1.17(l) and a petition under 37 CFR 1.137 (b) must be accompanied by the petition fee set forth in 37 CFR 1.17(m). The petition fee is required by statute. See 35 U.S.C. 41(a)(7). Thus, the Office cannot grant requests for waiver or reduction of the requisite petition fee.

iv. In a non-provisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application (under either 37 CFR 1.53(b) or 1.53(d)).

v. In an application abandoned for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof even if the application is to then be abandoned in favor of a continuing application. In a patent lapsed for failure to pay the balance of issue fee due, the required reply is payment of the balance of issue fee due.

vi. In a provisional application abandoned for failure to timely comply with an Office requirement, the reply requirement must be met by a complete reply to such Office requirement.

vii. 37 CFR 1.137(b) is applicable to applications abandoned and patents lapsed, regardless of the length of time that the application was abandoned or the patent was lapsed. Thus, waiver of the one year period under 37 CFR 1.183 is no longer necessary. However, note that 37 CFR 1.137(b) requires that the entire period of delay, from the due date of the reply to the date of filing a grantable petition to revive, was unintentional for a petition under 37 CFR 1.137(b) to be granted.

viii. While a statement of unintentional delay for the entire period of abandonment is generally sufficient, 37 CFR 1.137(b) authorizes the Office to require additional information when there is a question whether the entire delay was unintentional. The Office may consider there to be a question whether the delay was unintentional when a petition under 37 CFR 1.137 is not filed either within three months of the date the applicant is first notified that the application is abandoned, or within one year of the abandonment of the application. In such instances,

the Office may require evidence for each of the three critical periods: (1) the delay in filing a timely reply before abandonment of the application or lapse of the patent; (2) the delay in filing an initial petition to revive; and (3) the delay in filing a grantable petition to revive.

ix. An applicant who deliberately delays the filing of a petition under 37 CFR 1.137 will not be able to show that "the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional".

x. Examples of situations where unintentional delay was argued but the Office held these activities to constitute intentional delay:

(A) where the applicant deliberately permits an application to become abandoned (i.e., due to a conclusion that the claims are unpatentable, that a rejection in an Office action cannot be overcome, or that an invention lacks sufficient commercial value to justify continued prosecution).

(B) where the applicant chooses not to seek or persist in seeking revival of an abandoned application, or where the applicant deliberately chooses to delay seeking revival of an abandoned application.

xi. An intentional delay resulting from a deliberate course of action chosen by the applicant is not affected by: (a) the correctness of the applicant's (or applicant's representative's) decision to abandon the application or not to seek or persist in seeking revival of the application; (b) the correctness or propriety of a rejection, or other objection, requirement, or decision by the Office; or (c) the discovery of new information or evidence, or other change in circumstances subsequent to the abandonment or decision not to seek or persist in seeking revival.

xii. An intentional abandonment of an application, or an intentional delay in seeking either the withdrawal of a holding of abandonment in, or the revival of, an abandoned application, precludes a finding of unavoidable or unintentional delay pursuant to 37 CFR 1.137.

xiii. The Office does not generally question whether there has been an intentional or otherwise permissible delay in filing an initial petition under the unavoidable or the unintentional standard, when such petition is filed (a) within three months of the date the applicant is first notified that the application is abandoned; and (b) within one year of the date of abandonment of the application (note that the date an application becomes abandoned is not the mailing date of the notice of abandonment or the extendable date for filing a reply (if in fact an extension of time was not timely requested)).

In order to avoid delays in the consideration of a petition under 37 CFR 1.137(a) or (b) in instances in which such petition was not filed within three months of the date the applicant was first notified that the application was abandoned, applicants should include a showing as to how the delay between the date of first notification and filing of a petition under 37 CFR 1.137 was unavoidable or unintentional.

Similarly, in order to avoid delays in the consideration of a petition under 37 CFR 1.137(a) or (b) in instances in which such petition was not filed within one year of the date of abandonment, applicant should include the date that the applicant first became aware of the abandonment of the application and a showing as to how the delay in discovering the abandonment status occurred despite the exercise of due care or diligence on the part of the applicant.

xiv. Where an applicant chooses not to seek revival of an application, or chooses not to persist in seeking revival after an adverse decision on an earlier petition, the resulting delay cannot be considered to be unavoidable or unintentional.

xv. The requirement for a terminal disclaimer, disclaiming the terminal part of the patent equivalent to the period of abandonment, is equally applicable under the unavoidable and unintentional standards. This requirement only applies to design applications (regardless of filing date), and utility or plant patent applications filed before June 8, 1995.

xvi. In a design application, a utility application filed before June 8, 1995, or a plant application filed before June 8, 1995, a petition to revive under the unavoidable or the unintentional standard must be accompanied by a terminal disclaimer and fee as set forth in § 1.321, disclaiming a terminal period equivalent to the period of abandonment of the application. The terminal disclaimer must also apply to any patent granted on any continuing application which claims benefit of an earlier filing date under 35 U.S.C. 120, 121, or 365(c). A terminal disclaimer disclaiming a period equivalent to the lapse of a patent will not be required. Additionally, petitions under 37 CFR 1.183 to waive the requirement for a terminal disclaimer (37 CFR 1.137(c)) will favorably be considered when the terminal disclaimer is to be filed as part of a petition to revive an application filed before June 8, 1995, solely for the purpose of establishing copendency with a utility or plant application filed on or after June 8, 1995. This is so because applicant would not benefit from the period of abandonment in this case.

xvii. A provisional application can be revived for a period not to exceed 12 months from the date of filing, even if the petition is filed outside this 12-month period.

2. Withdrawal of Holding of Abandonment

A petition to withdraw the holding of abandonment, if promptly filed, is appropriate in at least three circumstances. This type of petition does not require a petition fee.

a. The first and most common circumstance is where a reply and/or fee has been filed timely and received in the Office but not correlated with the application and the application has been erroneously held abandoned. The requirements for withdrawing the holding of abandonment are:

1. Petition to withdraw the holding of abandonment under 37 CFR 1.181.
2. Evidence of receipt of the reply and/or fee by the Office, such as a post card receipt.
3. A copy of the earlier filed reply and/or fee.

b. Another situation in which a petition to withdraw the holding of abandonment is appropriate is that covered by 37 CFR 1.8(b). In this situation, a proper reply and/or fee has been timely sent to the Office accompanied by a certificate of mailing or facsimile transmission but is not received by the Office. The requirements for withdrawing the holding of abandonment are:

1. Petition to withdraw the holding of abandonment under 37 CFR 1.8.
2. An additional copy of the previously sent reply and/or fee with the certificate of mailing or facsimile transmission thereon.
3. A statement attesting on a personal knowledge basis to the previous timely mailing or sending by facsimile transmission of the reply and/or fee. A copy of the sending unit's report confirming transmission may be used to support an assertion of earlier transmission by facsimile.

c. A third instance in which a petition to withdraw the holding of abandonment is appropriate is the situation which existed in *Delgar, Inc. et al. v. Schuyler*, 172 USPQ 513 (D.D.C. 1971). An Office action or notice requiring reply is mailed by the Office but never received by the applicant or the registered practitioner. It is Office practice to ensure the mailing of all papers on the date indicated thereon, and there is a strong presumption that papers duly addressed and indicated as mailed are timely delivered to the addressee. Rebuttal of this presumption may result in the withdrawal of the holding of abandonment. The requirements for withdrawing the holding of abandonment are:

1. For Practitioners

A. Petition to withdraw holding of abandonment under 37 CFR 1.181.

B. A statement from the practitioner stating that the Office action was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received. A copy of the docket record where the non-received Office action would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. (Note that this showing may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail, e.g., if the practitioner has a history of not receiving Office actions.)

2. For other than practitioners

A. Petition to withdraw holding of abandonment under 37 CFR 1.181.

B. All direct tangible and other supporting evidence reasonably available as proof contra to the presumption. Copies of records which disclose the receipt of other correspondence mailed from the Office on or about the same date as the action or notice in question but fail to disclose receipt of that action or notice. Also, copies of records in which the action or notice would have been entered had it been received, for example, file jacket notations, docket records and so forth.

C. Statement that the action or notice was not received.

I. Petitions Relating to Allowed Applications

1. Withdrawal from Issue

Petitions to withdraw an application from issue are separated into the following two categories:

(a) Prior to payment of the issue fee, the application will be withdrawn from issue if the following are filed:

- (i) Petition to withdraw an application from issue under 37 CFR 1.313(a).
- (ii) Showing of good and sufficient reasons why withdrawal is necessary.
- (iii) Petition fee unless the reason for withdrawal is the fault of the Office; 37 CFR 1.17(i).

(b) After payment of the issue fee, the application will be withdrawn from issue if the following are filed:

- (i) Petition to withdraw an application from issue under 37 CFR 1.313(b).
- (ii) Showing in support of one of the reasons enumerated under 37 CFR 1.313(b).
- (iii) Petition fee unless the reason for withdrawal is the fault of the Office; 37 CFR 1.17(i).

Petitions filed too close to the patent printing date may not be granted. There is a practical limit on the Office's ability to withdraw an application from issue late in the printing cycle.

It is quite important, therefore, that petitions to withdraw an application from issue be filed promptly and that the petition be directed to the attention of the Group Director if filed under § 1.313(a), or directed to the attention of the Office of Publications if the petition is filed under § 1.313(b). Additionally, petitioners should inquire frequently with regard to petitions filed under 37 CFR 1.313(b) as these petitions are difficult to match with the appropriate application file which may have been forwarded to the appropriate staff for printing as a patent. The mere filing of a petition to withdraw an application from issue will not operate to have the application withdrawn unless a decision granting the petition is mailed before the date of grant of the patent.

2. Deferring Issuance of a Patent

Petitions to defer the issuance of a patent are appropriate only if the issue fee has been paid and only if a patent number and issue date have not been assigned. Since the issuance of a patent cannot be deferred after a patent number and issue date have been assigned, it is important that the petition be filed promptly and directed to the attention of the Office of Petitions. Further, it is Office policy to defer issuance of a patent for a period of one month only, in the absence of extraordinary circumstances or the requirement of a regulation which would dictate a longer period. A request to have issuance of a patent deferred requires:

- (a) Petition to defer issuance of a patent under 37 CFR 1.314.
- (b) Showing of good and sufficient reasons why deferral is necessary.
- (c) Petition fee; 37 CFR 1.17(i).
- (d) Petition be correlated with application before assignment of patent number and issue date.
- (e) Extraordinary circumstances must exist to obtain a deferral period greater than one month.

3. Recognition of Priority Claim

A petition must accompany foreign priority papers and/or claims to foreign priority benefits under 35 U.S.C. 119 which are filed after the issue fee has been paid. What is required is:

- (a) Petition under 37 CFR 1.55(a) to acknowledge priority papers and/or claim.
- (b) Request that papers be entered and/or claim to priority benefits under 35 U.S.C. 119 be acknowledged.
- (c) Petition fee; 37 CFR 1.17(i).
- (d) Filing before patent issues.
- (e) The foreign application relied upon must be referred to in the oath or declaration.

J. Supervisory Review (37 CFR 1.181)

Decisions by Group Directors are subject to supervisory review. However, when a party requests that the decision of the Group Director be reviewed by a higher official, the Director's decision will be presumed to be correct in the absence of an indication that the decision was arbitrary, clearly erroneous or involves a policy issue appropriate for higher level determination.

K. Suspension of Rules (37 CFR 1.183)

Under extraordinary circumstances, when justice requires, any requirement of the regulations in 37 CFR which is not a requirement of the statutes may be suspended or waived. The situations in which it is appropriate to petition for such suspension or waiver are so varied that a detailed discussion of the topic is beyond the scope of this paper. However, as a broad guideline, a petition under 37 CFR 1.183 is appropriate only when facts are present which establish the existence of an extraordinary circumstance such that justice requires the suspension or waiver requested. In this regard, it is important to recognize that § 1.183 can be invoked only for the limited purpose of suspending or waiving a specific requirement of a specific regulation. Equitable remedies which go beyond this limited purpose are not available under § 1.183.

Petitions under 37 CFR 1.183 to suspend or waive a requirement of the regulations require:

- 1. Showing of extraordinary circumstances where justice requires the suspension or waiver.
- 2. Petition fee; 37 CFR 1.17(h).
- 3. Prompt and diligent filing.
- 4. Compliance with any requirement of the regulation in question which is not specifically suspended or waived or with such other requirements as may be imposed.

L. Questions Not Specifically Provided For (37 CFR 1.182)

Under 37 CFR 1.182, a petition may be submitted in all cases not specifically provided for in 37 CFR and will be decided in accordance with the merits of each case. For example, a petition requesting a Duplicate Letters Patent to replace an original lost by patentee is appropriate under § 1.182.

Petitions under 37 CFR 1.182 are requests not specifically provided for in the regulations of 37 CFR, which require:

- 1. Petition fee (37 CFR 1.17(h)).
- 2. Prompt and diligent filing.
- 3. Compliance with such requirements as may be imposed.

M. Relating to Maintenance Fees

Maintenance fees may be paid during the 6-month period following the 3rd, 7th, and 11th anniversary of issuance of a utility patent. If not timely paid, a surcharge will be required between 3 ½ and 4 years, seven ½ and eight years, and 11 ½ and 12 years after issuance of the patent. Utility patents will expire after 4 years, 8 years and 12 years from issuance if the maintenance fee and surcharge, if required, are

not timely paid. The due date for payment of maintenance fees in reissue applications is computed from the date of grant of the original non-reissue application.

1. Payment Prior to Expiration

A patentee who is not satisfied with the PTO refusal to accept and record a maintenance fee paid prior to expiration of a patent may petition under 37 CFR 1.377. The requirements for acceptance of the payment are:

- (a) Petition under 37 CFR 1.377.
- (b) Filing within 2 months of action complained of or within the time set in the action complained of.
- (c) Petition fee; 37 CFR 1.17(h). The petition may include a request for refund of the petition fee if the refusal to accept and record the maintenance fee is determined to be Office error.
- (d) Statement of facts as outlined at 37 CFR 1.181(b).
- (e) Signature by registered attorney or party in interest as outlined at 37 CFR 1.377(c).

2. Payment After Expiration

- (a) Requirements when the delay was unavoidable.

Payment of maintenance fees after expiration of the patent will be accepted and the patent will be reinstated as if it had never expired, provided the following are filed:

- (i) Petition under 37 CFR 1.378(b) signed by registered attorney or party in interest as outlined at 37 CFR 1.378(d).
- (ii) Maintenance fee set forth in 37 CFR 1.20(e)-(g).
- (iii) Surcharge set forth in 37 CFR 1.20(i)(1).
- (iv) Showing of unavoidable delay including an enumeration of steps taken to ensure timely payment, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.
- (b) Requirements when the delay was unintentional.

Payment of maintenance fees after expiration of the patent will be accepted and the patent will be reinstated as if it had never expired, provided the following are filed:

- (i) Petition under 37 CFR 1.378(c) filed within 24 months after the six- month grace period signed by registered attorney or party in interest as outlined at 37 CFR 1.378(d).
- (ii) Maintenance fee set forth in 37 CFR 1.20(e)-(g).
- (iii) Surcharge set forth in 37 CFR 1.20(i)(2).
- (iv) A statement that the delay in payment of the maintenance fee was unintentional.

3. Reconsideration

A first request for reconsideration will be entertained provided the following are filed within two months, or such other time as set in an adverse decision on a petition filed under 2(a) or 2(b) above:

- (a) Petition under 37 CFR 1.378(e).
- (b) Petition fee set forth in 37 CFR 1.17(h).
- (c) All pertinent evidence or arguments presented since no further request for reconsideration will be entertained.

A common error made in the filing of a maintenance fee petition is the lack of proper identification (by both the patent number and the application number) of the patent as required by

§ 1.366(c).

N. Petitions Relating to Reexamination Practice

1. Request for reconsideration of examiner denial of reexamination request.

- a. Filed under 37 CFR 1.181; 37 CFR 1.515(c).
- (i) No petition fee is required.

(ii) The request must be filed within one month of the denial date and is decided by the Group Director by way of a de novo review.

(iii) The Director's decision is final and is not appealable.

b. A common error made in these petitions is an attack on the examiner as opposed to addressing and presenting reasons why the examiner's decision is wrong.

c. The burden on petitioner is to show that the decision is not supported by evidence or is arbitrary and capricious. The mere argument that the examiner is wrong does not sustain petitioner's burden of proof.

d. A petition requesting review of an examiner's decision ordering reexamination is generally not entertained except where the decision is clearly contrary to statute.

2. Request for extension of time to file section 1.515(c) petition

a. Must be accompanied by a petition under 37 CFR 1.183 to waive the one month time limitation of § 1.515(c).

(i) A petition fee is required (37 CFR 1.17(h)).

(ii) Small entity status is not available (never available for 37 CFR 1.17(h) petition fees).

(iii) A request for waiver of the § 1.515(c) one month response period must be filed on or before day response is due and is decided by the Group Director.

(iv) The requester should fully state the reasons for the request.

(v) The requests are granted only in extraordinary situations.

b. A common error is requester's failure to appreciate that these criteria exist.

3. Petitions filed under 35 U.S.C. 133 for entry of late papers of patent owner (not available for third party requester).

a. Petition showing unavoidable delay:

(i) A petition fee is required (37 CFR 1.17(l)(1)).

(ii) Small entity status is available.

(iii) These petitions are decided by the Office of Petitions.

(iv) Petitioner must make a showing of "unavoidable delay" which should detail the specific circumstances causing the delay and should provide evidence to support the showing.

b. Reasons generally tending to support unavoidable delay:

(i) The unexpected and unforeseen breakdown of a historically accurate and reliable, comprehensive docketing system;

(ii) An unexpected and unforeseen breakdown of established, normal operating procedures; or

(iii) An unexpected and unforeseen failure on the part of a historically reliable employee.

c. Reasons not generally supportive of unavoidable delay:

(i) The attorney misapplied or did not know the law and/or rules (e.g., reliance on incorrect belief that extensions of time could be obtained under 37 CFR 1.136(a)) ;

(ii) That time pressures of other business or preoccupation with other matters caused the delay;

(iii) Attorney error in docketing or meeting docketed deadlines.

d. There is no recourse for entry of late papers under the unintentional delay standard in Reexamination Proceedings.

O. PCT Petition Practice

The International Division Legal Branch and the Office of the Deputy Assistant Commissioner for Patent Policy and Projects handle a myriad of different types of petitions. Many of the petitions raise issues commonly encountered in the consideration of U.S. applications for patent. In this regard, the consideration and application of the law is quite similar to U.S. practice. Note that PCT petitions are of two basic types:

(1) those filed in international applications while in what is called the international phase under Chapter I or Chapter II of the Patent Cooperation Treaty -- Chapter I and Chapter II refer to Chapters of the Treaty which deal with the international application and search (Chapter I) and international preliminary examination (Chapter II); and

(2) those filed in applications entering or having entered the national phase.

Those petitions filed in international stage applications frequently request *inter alia*,

(a) waiver of the rules so that a filing date can be accorded where applicant has erred (essentially a 37 CFR 1.183 waiver situation where the rule to be waived is 37 CFR 1.431(b) - this is also a PCT Article 11 issue but the treaty provisions may not be waived), and

(b) waiver of the rules so that a filing date can be accorded (Article 11 and 37 CFR 1.431) where the applicant is not a U.S. resident or national as indicated in the request for an international application.

Office policy is and has been to deny such petitions unless the circumstances are such that the failure on applicant's part to comply with treaty requirements can be considered an obvious error under Rule 91.1 of the Treaty.

Those petitions filed in national stage applications usually request relief due to quite common issues such as:

(a) adverse inventors (§ 1.47),

(b) change of inventorship (§ 1.48),

(c) deceased inventor (§ 1.42), and

(d) revival under § 1.137(a) or § 1.137(b) for failure to timely satisfy national stage filing requirements.

Consideration of these petitions involves requirements for proof similar to those requirements mandated in the consideration of U.S. applications. Where revival is concerned, the same criteria apply as those under the unavoidable and unintentional standards for U.S. applications. Petition fee amounts are the same as U.S. application petition fees.

VII. Conclusion

As one can plainly see, the scope of petitions practice in the Office is quite extensive. Hopefully, this paper has provided a coherent guide book for practitioners through the maze of myriad situations which give rise to petitions. Knowledge of statutes set forth in title 35 of the United States Code, the rules of practice set forth in title 37 of the Code of Federal Regulations, the contents of the Manual of Patent Examining Procedure, and staying abreast of Official Gazette Notices are essential to help avoid the need to file many petitions.

¹ Director, Office of Petitions, Office of the Deputy Assistant Commissioner for Patent Policy and Projects, U.S. Patent and Trademark Office.

² This paper is an update of a paper by Stephen G. Kunin published in the program materials for Patent and Trademark Office Day 1990 and published in the August 1991 issue of the Journal of the Patent and Trademark Office Society (JPTOS). This paper reflects petitions practice as of December 1, 1997.