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USPTO: Common patent prosecution pitfalls to avoid and patent updates

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UNITED STATES
PATENT AND TRADEMARK OFFICE ®

Common patent prosecution pitfalls to avoid

- Pitfalls related to foreign priority and domestic benefit claims
- Pitfalls related to terminal disclaimers
- Pitfalls related to invoking the 35 U.S.C.102(b) exceptions
- Pitfalls related to petitions

Appendix - Patent updates

- Recent expedited examination initiatives
 - Climate Change Mitigation Pilot Program
 - Cancer Moonshot Expedited Examination Pilot Program
 - First-Time Filer Expedited Examination Pilot Program
- Selected topics on the July 2022 revision of the 9th Edition of the Manual of Patent Examining Procedure (MPEP)
- Patent Center Electronic Office Action Program

Appendix - Patent updates (cont.)

- Recent final rules
 - Standardization of the Patent Term Adjustment Statement Regarding Information Disclosure Statements, 88 FR 39172 (June 15, 2023)
 - Setting and adjusting patent fees during fiscal year 2020, 88 FR 36956 (June 6, 2023)
 - Reducing patent fees for small entities and micro entities under the Unleashing American Innovators Act of 2022, 88 FR 17147 (March 22, 2023)
 - Establishing permanent electronic filing for patent term extension applications, 88 FR 13028 (March 2, 2023)

Appendix - Patent updates (cont.)

- Recent final rules (cont.)
 - Official transition to issuing electronic patent grants in 2023, 88 FR 12560 (February 28, 2023)
- USPTO patent statistics and information

Common patent prosecution pitfalls to avoid

Pitfalls related to foreign priority and domestic benefit claims:

Not timely making or correcting a foreign priority claim or a domestic benefit claim

Time periods for making foreign priority and domestic benefit claims

- For utility and plant applications filed under 35 U.S.C. 111(a):
 - Foreign priority claims and domestic benefit claims must be made during the pendency of the application and within the later of four months from the actual filing date of the application, or sixteen months from the filing date of the prior-filed application.
 - This time period, commonly referred to as “the 4/16 month time period,” is not extendable, and does not apply to design applications.
- For design applications:
 - Foreign priority claims and domestic benefit claims must be made during the pendency of the design application.

Time periods for making foreign priority and domestic benefit claims (cont.)

- For national stage applications under 35 U.S.C. 371:
 - Domestic benefit claims must be made during the pendency of the application and within the later of:
 - Four months from the date of national stage commencement;
 - Four months from the date of the initial submission to enter the national stage; or
 - Sixteen months from the filing date of the prior-filed application.
 - Foreign priority claims must be made in the international application entering the national stage under 35 U.S.C. 371.

Time periods for making foreign priority and domestic benefit claims (cont.)

- For more information regarding the time period for making domestic benefit claims, see MPEP 211.03 and 37 CFR 1.78(a)(4) and 1.78(d)(3).
- For more information regarding the time period for making foreign priority claims, see MPEP 214.01 and 37 CFR 1.55(d)(1) and 1.55(d)(2).

Foreign priority and domestic benefit claims must be in an application data sheet (ADS)

- Foreign priority claims and domestic benefit claims in applications filed on or after September 16, 2012 must appear in an ADS.
 - See 37 CFR 1.55 for foreign priority claims and 37 CFR 1.78 for domestic benefit claims.
- For applications filed on or after September 16, 2012
 - Presence of the foreign priority claim in the inventor's oath or declaration **will not be recognized**.
 - Presence of the domestic benefit claim in the first sentence(s) of the specification **will not be recognized**.

Two instances where the foreign priority claim is not required to be in an ADS

- In a national stage application under 35 U.S.C. 371. See 37 CFR 1.55(d)(2).
 - The foreign priority claim has to be made in the international phase of the application within the time limit set forth in the PCT and the Regulations under the PCT.
 - It is permissible, but not required, to present the claim for priority in an ADS in a national stage application under 35 U.S.C. 371.
- In a nonprovisional international design application where the priority claim was made in accordance with the Hague Agreement and the Hague Agreement Regulations in the international design application. See 37 CFR 1.55(m).
 - Otherwise, the priority claim must be presented in an ADS.

What is the cure for correcting an untimely foreign priority or domestic benefit claim?

A petition to accept an unintentionally delayed priority or benefit claim

- The petition to accept an unintentionally delayed priority claim under 37 CFR 1.55 or benefit claim under 37 CFR 1.78 must be accompanied by:
 - A corrected ADS listing the benefit claim or priority claim, unless previously submitted;
 - A petition fee under 37 CFR 1.17(m) (undiscounted - \$2100, small entity - \$840; micro entity - \$420);
 - A statement that the entire delay between the date the priority claim or benefit claim was due and the date the priority claim or benefit claim was filed, was unintentional; AND
 - For an unintentionally delayed priority claim, a certified copy of the foreign application unless previously submitted, or an exception applies under 37 CFR 1.55(h), (i) or (j).

A petition to accept an unintentionally delayed priority or benefit claim (cont.)

- The Director may require additional information where there is a question whether the delay was unintentional.
- However, if the petition to accept an unintentionally delayed benefit or priority claim was filed more than two years after the date the claim was due, an additional explanation of the circumstances surrounding the delay that establishes that the entire delay was unintentional is required.
 - See “Clarification of the Practice for Requiring Additional Information in Petitions Filed in Patent Applications and Patents Based on Unintentional Delay,” 85 Fed. Reg. 12222 (March 2, 2020)
 - This requirement is in addition to the requirement to provide a statement that the entire delay was unintentional.

Adding or correcting a benefit claim after allowance or a final rejection

- In addition to the petition to accept an unintentionally delayed benefit claim and a corrected ADS, it may be necessary to file a request for continued examination (RCE) under 37 CFR 1.114, if the application is under a final rejection or has been allowed (see MPEP 706.07(h)).
 - A corrected ADS filed after final rejection or allowance is not entered as a matter of right and must be filed in compliance with 37 CFR 1.116 or 1.312, respectively.

MPEP 211.02(a) and 601.05(a)(II)



Claim for priority filed after issue fee payment but before patent grant

- The priority claim will be placed in the file record but will not be reviewed, and the patent when published will not include the priority claim.
 - A certificate of correction under 35 U.S.C. 255 and 37 CFR 1.323 can be filed to have the priority claim considered after publication of the patent.

MPEP 214.02 and 216.01



Petition to accept an unintentionally delayed benefit or priority claim where claim was not submitted during pendency

- Effective May 13, 2015, 37 CFR 1.78(d)(3) and 37 CFR 1.55(e) were amended to permit, respectively, the filing of a petition to accept an unintentionally delayed benefit claim or priority claim in a design application where the benefit claim or priority claim was not submitted during the pendency of the design application (previously available only for utility and plant applications).

See MPEP 211.04, 216.01, and 1481.03



Petition to accept an unintentionally delayed benefit or priority claim where claim was not submitted during pendency (cont.)

- Thus, a petition to accept an unintentionally delayed benefit claim under 37 CFR 1.78(d)(3) or priority claim under 37 CFR 1.55(e) may be filed along with request for a certificate of correction under 35 U.S.C. 255 and 37 CFR 1.323 after patent grant in utility, plant, and design applications.
 - However, the petition may not be granted if further examination is required.

See MPEP 211.04, 216.01, and 1481.03

Certificate of correction to add or correct a priority or benefit claim in an issued patent

- A certificate of correction can generally be used to add or correct a priority or benefit claim in an issued patent except in certain situations.
- A petition to accept an unintentionally delayed priority claim or benefit claim filed with a request for a certificate of correction in an issued patent would not be granted in the following situations:
 - Where the correction sought would require further examination
 - Where the grant of the petition would have the appearance of extending the patent term

MPEP 1481.03 and 216.01



Common reasons why foreign priority claim or domestic benefit claim is not captured

- Untimely foreign priority claim or domestic benefit claim
- Improperly signed ADS
- Incorrect order of domestic benefit applications listed in the ADS
- Nonprovisional utility application not filed within 12 months of the filing date of the prior-filed foreign priority application or provisional application

Common reasons why foreign priority claim or domestic benefit claim is not captured (cont.)

- Typographical error in the filing year of the provisional or foreign priority application
 - For example, the filing year of the provisional or foreign priority application is listed as 2002 instead of 2022 in the ADS such that the actual filing date of the nonprovisional utility or plant application is more than 12 months from the filing date of the prior-filed application listed in the ADS
- Not having proper markings for corrected ADS to show changes relative to the information of record

Tips for making or correcting the foreign priority or domestic benefit claim

- Read the ADS instructions for making domestic benefit claims and foreign priority claims.
- Make sure the application numbers, the format of the application numbers, and the filing dates of the domestic benefit and foreign priority applications are correct.
 - Typographical and format errors can cost applicants money, time, and additional paperwork.

Tips for making or correcting the foreign priority or domestic benefit claim (cont.)

- Be sure to indicate the correct relationship and order of the domestic benefit applications listed in the ADS.
 - The order of the domestic benefit applications should be listed beginning from the instant application and continuing through the list of parents in reverse chronological order (newest to oldest).
 - If the order is incorrect, then the USPTO may not be able to recognize all of the desired benefit claims.
 - An example of an incorrect relationship is non-specific relationship identifiers (e.g., “Continuing” is non-specific; must be Continuation, Divisional, or CIP).

Tips for making or correcting the foreign priority or domestic benefit claim (cont.)

- Make sure the country code for the foreign priority application is correct.
 - See ADS instructions that are available on the USPTO forms webpage at https://www.uspto.gov/sites/default/files/documents/aia_ads_form_inst.docx for the country code table.
 - When the foreign priority application is a PCT application, the proper country code is the receiving office country code, not WO or IB.
 - For example, the country code for PCT/CNYYYY/XXXXX is CN.
 - The correct country code for EUIPO (formerly OHIM) is EM.

Tips for making or correcting the foreign priority or domestic benefit claim (cont.)

- If the numbers and/or letters in the foreign application number appearing in the certified copy and on the filing receipt do not exactly match, then applicant must either correct the foreign application number or provide a certified copy having an application number that matches the foreign application number on the filing receipt.
 - A petition under 37 CFR 1.55(f) or (g) is needed if the certified copy is not timely submitted.
 - A petition under 37 CFR 1.55(e) to accept an unintentionally delayed priority claim is needed to correct the foreign application number if the correction is made after the time period set forth in 37 CFR 1.55(d) to make the foreign priority claim.

Tips for making or correcting the foreign priority or domestic benefit claim (cont.)

- Make sure the ADS is properly signed by party under 37 CFR 1.33(b).
 - Every ADS must be signed by either a registered patent practitioner or the applicant.
 - When a named applicant in the “Applicant Information” section is a juristic entity (for example., a company), the ADS must be signed by a registered patent practitioner.

Tips for making or correcting the foreign priority or domestic benefit claim (cont.)

- The signature on the ADS must also comply with 37 CFR 1.4(d)(1)-(3) (the rule governing signature for correspondence (except assignments and related documents) filed with the USPTO).
- Examples of acceptable signatures are posted at the USPTO's website at https://www.uspto.gov/sites/default/files/documents/sigexamples_al_text.pdf
- An unsigned or improperly signed ADS will be treated only as a transmittal letter (37 CFR 1.76) with limited information being made of record from it.
 - The priority or benefit claim in the ADS will not be recognized if the ADS is not properly signed.



Tips for making or correcting the foreign priority or domestic benefit claim (cont.)

- Any time an ADS is used after the initial filing of the application (referred to as a corrected ADS) to correct or add a domestic benefit or foreign priority claim, it must show the information already of record being changed with markings (see 37 CFR 1.76(c)).
 - Changes made relative to the information of record (see latest filing receipt) must be shown by underlining for insertions and strike-through or brackets for deletions
- The corrected ADS will not be processed unless markings showing the changes are provided.

Tips for making or correcting the foreign priority or domestic benefit claim (cont.)

- The best way to avoid rejection of the corrected ADS due to improper markings is to use a Corrected Web-based ADS.
 - Corrected Web-based ADS will pre-populate with information that the USPTO has of record and will create the required markings.
 - Quick Start Guide for Corrected Web-based ADS is available at www.uspto.gov/sites/default/files/documents/Corrected-WebADS-QSG.pdf

Tips for making or correcting the foreign priority or domestic benefit claim (cont.)

- A corrected ADS should be accompanied by a properly identified/indexed paper requesting an action, such as a request for a corrected filing receipt.
 - Otherwise, the USPTO may not be aware that a corrected ADS was filed in an application, resulting in significant delay in processing the corrected ADS.
- For more information on the ADS, see MPEP 601.05(a).

Tips for making or correcting the foreign priority or domestic benefit claim (cont.)

REVIEW THE FILING RECEIPT PROMPTLY AND CAREFULLY

- The filing receipt will show whether the domestic benefit claim or foreign priority claim has been accurately captured by the USPTO.
- Applicant should correct any missing or incorrect benefit or foreign priority information within the required time period to make the benefit or priority claim.
- Not timely correcting the domestic benefit or foreign priority claim information in the ADS can be costly and can cause prosecution delays.

Tips for making or correcting the foreign priority or domestic benefit claim (cont.)

REVIEW THE FILING RECEIPT PROMPTLY AND CAREFULLY (cont.)

- If review of the filing receipt and the ADS identifies applicant errors in the domestic benefit claim or foreign priority claim section of the ADS, and if it is still within the time period for making or correcting the foreign priority or domestic benefit claim(s), file both:
 - a request to correct the filing receipt, AND
 - a corrected ADS with proper markings to correct the domestic benefit and/or foreign priority claim(s)

Tips for making or correcting the foreign priority or domestic benefit claim (cont.)

REVIEW THE FILING RECEIPT PROMPTLY AND CAREFULLY (cont.)

- If review of the filing receipt and the ADS identifies USPTO errors in capturing the foreign priority or domestic benefit claim in the ADS, file a request to correct the filing receipt as soon as possible with a statement that the claim was properly and timely made in the previously filed ADS.

Pitfalls related to foreign priority and domestic benefit claims:

Not timely filing certified copy of foreign priority document

Time period for filing a certified copy of a foreign priority document

- For utility and plant applications filed under 35 U.S.C. 111(a) on or after March 16, 2013, an applicant must file a certified copy of a foreign priority application within the later of (see 37 CFR 1.55(f)(1)):
 - Four months from the actual filing date of the application, or
 - Sixteen months from the filing date of the foreign priority application.
- This “4/16 month” time period does not apply to design applications. However, the certified copy must be filed during the pendency of the design application. See 37 CFR 1.55(g).

Time period for filing a certified copy of a foreign priority document (cont.)

- For national stage applications 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 PCT Rules. 37 CFR 1.55(f)(2).
- If a certified copy is not filed in the international application in which the national stage commenced on or after December 18, 2013, the certified copy must be filed within the later of (37 CFR 1.55(f)(2)):
 - Four months from the date of national stage commencement,
 - Four months from the date of the initial submission to enter the national stage, or
 - Sixteen months from the filing date of the foreign priority application.

Three exceptions to the time period requirement in 37 CFR 1.55(f)

- The time period in 37 CFR 1.55(f)(1) or 1.55(f)(2) for filing a certified copy of the foreign application does not apply if one of the following three exceptions is met (see also MPEP 215.02 for discussion):
 - A certified copy was filed in another U.S. patent or application for which domestic benefit was claimed in the present application. (37 CFR 1.55(h))
 - For reissue applications, the certified copy may be contained in the patented application for which reissue is sought.
 - The patent or application containing the priority document must be identified.
 - An electronic copy was retrieved via priority document exchange prior to patent grant. (37 CFR 1.55(i))
 - An interim copy of the foreign application was timely filed and a certified copy was filed prior to patent grant. (37 CFR 1.55(j))

Untimely filing of the certified copy during pendency and before issue fee payment

- If a certified copy of the foreign application is not filed within the time period specified in 37 CFR 1.55(f)(1) or (f)(2) (does not apply to design applications), and the exceptions in 37 CFR 1.55(h), (i), and (j) are not applicable, the certified copy of the foreign application must be accompanied by a petition under 37 CFR 1.55(f).

Untimely filing of the certified copy during pendency and before issue fee payment (cont.)

- The petition under 37 CFR 1.55(f) must include:
 - A showing of good and sufficient cause for the delay;
 - The certified copy of the foreign application; and
 - the petition fee set forth in 37 CFR 1.17(g).
- A petition under 37 CFR 1.55(e) is not required if the foreign priority claim was timely made.

Certified copy filed or retrieved after issue fee payment but before patent grant

- If the priority claim was timely made on or before the date the issue fee was paid, but the certified copy was filed or retrieved after issue fee payment, the certified copy will be placed in the file record but will not be reviewed and the patent when published will not include the priority claim.
 - A request for a certificate of correction under 35 U.S.C. 255 and 37 CFR 1.323 can be filed to have the certified copy considered after publication of the patent.
 - A petition under 37 CFR 1.55(f) is also required if the certified copy was filed outside of the time period set forth in 37 CFR 1.55(f) and the exceptions in 37 CFR 1.55(h), (i), and (j) are not applicable. The time period in 37 CFR 1.55(f) does not apply to design applications.

MPEP 214.03 and 216.01



Late filing of certified copy after patent grant where priority claim was timely

- Where the priority claim was timely made in the application during pendency but was not included on the patent because the certified copy was filed after patent grant, the patent may be corrected to include the priority claim via:
 - a certificate of correction under 35 U.S.C. 255 and 37 CFR 1.323, accompanied by
 - a grantable petition under 37 CFR 1.55(f) (non-design applications), or
 - a grantable petition under 37 CFR 1.55(g) (design applications)
- In this situation, a petition under 37 CFR 1.55(e) to accept an unintentionally delayed priority claim is not needed because the priority claim was timely made during pendency.

Late filing of certified copy after patent grant where priority claim was timely (cont.)

- A grantable petition under 37 CFR 1.55(f) or (g) must include:
 - Good and sufficient cause for the delay in filing the certified copy,
 - The certified copy of the foreign application, and
 - The fee set forth in 37 CFR 1.17(g) (undiscounted - \$220, small entity - \$88; micro entity - \$44);
 - Compare this fee to the petition fee under 37 CFR 1.17(m) (undiscounted - \$2100, small entity - \$840; micro entity - \$420) for a petition to accept a delayed submission of a priority or benefit claim.

MPEP 215.03 and 216.01



Live Content Slide

When playing as a slideshow, this slide will display live content

Poll: 1) If a foreign priority claim is timely made during the pendency of a design application but the certified copy of the foreign priority application was filed after patent grant, which petition is required?

Pitfalls related to foreign priority and domestic benefit claims:

Priority document exchange related issues

Priority document exchange (PDX) related issues

1. Priority application number was not in proper format for retrieval.
 - Please consult table in the USPTO PDX webpage at <https://www.uspto.gov/patents/basics/international-protection/electronic-priority-document-exchange-pdx> for the recommended application number format for successful retrieval.
2. The correct country code was not used.
 - Please make sure that the correct country code is used (for example, EM for EUIPO and RECEIVING OFFICE COUNTRY CODE for PCTs, not WO).
 - See WIPO ST.3 and ADS Instructions for list of country codes for foreign priority claims.

Priority document exchange (PDX) related issues (cont.)

3. The correct USPTO form was not used to provide the access code after filing of the application.
 - To provide the access code after the initial filing of the application, **use a corrected ADS** and request for corrected filing receipt. Form PTO/SB/38 has been recently revised and cannot be used for this purpose.

Priority document exchange (PDX) related issues (cont.)

4. Applicant waits until after close of prosecution to check to see if the “Access Code Provided” text and the “Request for Retrieve” paragraph are on the filing receipt.
 - Applicant should promptly review the filing receipt to make sure that this text and paragraph appear on the filing receipt.
 - If the filing receipt shows the text “Access Code Provided” next to the priority claim and the “Request for Retrieve” paragraph, the USPTO will attempt to retrieve the priority document shortly after the filing receipt is mailed.
 - Keep in mind that delaying the review may not allow sufficient time to have the USPTO complete the retrieval process during pendency if corrections are needed, and that the opportunity to amend the priority claim (if necessary) may be limited after the close of prosecution.

Priority document exchange (PDX) related issues (cont.)

5. The applicant does not promptly check to see if the USPTO has retrieved the correct priority document.
 - Applicant is encouraged to promptly confirm receipt by the USPTO of appropriate documents.
 - Make sure that the foreign application number and type (for example, design v. utility; registration v. application) are correct.
 - Applicant continues to bear the ultimate responsibility for ensuring that the priority document is filed during the pendency of the application and before the patent is issued. See MPEP 215.02(a).

Priority document exchange (PDX) related issues (cont.)

6. The priority document was not retrieved even though the correct access code, application number, and format for the priority application are shown on the filing receipt.
 - Please direct any questions as to why the priority document was not retrieved to the Electronic Business Center (EBC) at 866-217-9197 during its operating hours of 6 a.m. to midnight ET, Monday–Friday, or at ebc@uspto.gov.

Priority document exchange (PDX) related issues (cont.)

Applications are easily tracked using the DAS for Applicants workbench and notifications at <https://www3.wipo.int/dasapplicant>.

The screenshot shows the WIPO Digital Access Service – Applicant Portal interface. The header includes the WIPO IP PORTAL logo, a MENU button, the service name, a DEMO tag, HELP, and a WIPO ACCOUNT USERNAME field with a notification bell icon. Below the header, a message states: "Below application details can be used for demo and test purposes:". A table displays application details:

IP Right	Office Code and Priority Number	Filing date	Access Code
Utility Model	ES U201230131	2012-02-08	E82D

Below the table, there are tabs for "Workbench" (highlighted with a yellow circle) and "Notifications". A "Items:" dropdown is set to "20", and a "Filter Priority Documents:" dropdown is set to "All in Workbench". A message indicates "1 record(s) found matching the filter criteria." Below this, a table lists the application details:

<input type="checkbox"/>	IP Right	Office Code and Priority Number	Filing date	Access Code	Date of Availability	Last Accessed	Tracked By	Comments
<input type="checkbox"/>	Utility Model	ES U 201230131	2012-02-08	E82D	2013-04-18	2022-08-31 12:39:26.0		

At the bottom, there are navigation buttons: "Add Tracking" (highlighted with a yellow arrow) and "Remove Tracking".

Pitfalls related to terminal disclaimers

Common terminal disclaimer pitfalls to avoid

Filing a terminal disclaimer without the required reply to an outstanding Office action

- To respond to a non-final Office action, a reply under 37 CFR 1.111 is required.
- To respond to a final Office action, a reply under 37 CFR 1.113 or a request for reconsideration is required. See MPEP 706.07(e)

Common terminal disclaimer pitfalls to avoid (cont.)

Filing a terminal disclaimer without the required reply to an outstanding Office action (cont.)

37 CFR 1.111 Reply by applicant ...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 ... must reply and request reconsideration or further examination, with or without amendment....

(b) In order to be entitled to reconsideration or further examination, the applicant...must reply to the Office action. The reply by the applicant ...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....



Common terminal disclaimer pitfalls to avoid (cont.)

Filing a terminal disclaimer without the required reply to an outstanding Office action (cont.)

- A reply under 37 CFR 1.113 is limited to:
 - (A) an amendment, affidavit, or other evidence complying with 37 CFR 1.116;
 - (B) a Notice of Appeal (and appeal fee); or
 - (C) a request for continued examination (RCE) filed under 37 CFR 1.114 with a proper submission and fee.

See MPEP 714.13

Common terminal disclaimer pitfalls to avoid (cont.)

Filing a terminal disclaimer without the required reply to an outstanding Office action (cont.)

- A terminal disclaimer does not satisfy the requirements of 37 CFR 1.111 or 1.113 because it is not an amendment, an affidavit, evidence, a request for reconsideration, or a request for continued examination.
- A terminal disclaimer filed by itself does not toll the time period set forth in the outstanding Office action.
- A terminal disclaimer can be filed at any time during prosecution even if there is no nonstatutory double patenting rejection of record.

Common terminal disclaimer pitfalls to avoid (cont.)

Filing a terminal disclaimer without the required reply to an outstanding Office action (cont.)

- A request for an extension of time is not required to file a terminal disclaimer.
- The filing of a terminal disclaimer without a reply to an outstanding Office action will not trigger placement of the application onto the examiner's amended docket.
 - The examiner will not know about the terminal disclaimer without the required reply to the outstanding Office action.

Common terminal disclaimer pitfalls to avoid (cont.)

Not checking to make sure that the reference application number or reference patent number is correctly listed in the terminal disclaimer

- The paralegal will approve a terminal disclaimer if it meets the requirements of 37 CFR 1.321 regardless of whether the reference listed in the terminal disclaimer is a nonstatutory double patenting reference of record (for example, applicant may preemptively file a terminal disclaimer).
- Electronic terminal disclaimers (eTDs) are automatically approved. When the applicant files an eTD, the applicant is certifying that the information is correct.
 - Reminder - eTDs cannot be filed in issued patents, Also, eTDs are terminal disclaimers based on common ownership and are not terminal disclaimers based on a joint research agreement.

Common terminal disclaimer pitfalls to avoid (cont.)

Not checking to make sure that the reference application number or reference patent number is correctly listed in the terminal disclaimer (cont.)

- If timely requested, a recorded terminal disclaimer may be withdrawn before the application in which it is filed issues as a patent, or if a terminal disclaimer is filed in a reexamination proceeding, before the reexamination certificate issues.
- After a patent or reexamination certificate issues, a recorded terminal disclaimer will not be withdrawn. See MPEP 1490(VIII)
- Failure to withdraw a recorded terminal disclaimer listing an incorrect reference could result in loss of additional term and inability to enforce the patent because it is not commonly owned with the incorrect reference.

Common terminal disclaimer pitfalls to avoid (cont.)

Filing a terminal disclaimer signed by a patent practitioner who does not have power of attorney

- For applications filed on or after September 16, 2012, the terminal disclaimer must be signed by (see 37 CFR 1.321(b)(1)):
 - The applicant (and if applicant is a juristic entity assignee, a person legally empowered by the applicant assignee can also sign the terminal disclaimer) OR
 - An attorney or agent of record.

Note: An attorney acting in a representative capacity cannot sign the terminal disclaimer.

Common terminal disclaimer pitfalls to avoid (cont.)

Filing of a terminal disclaimer not by the applicant of record

- For applications filed on or after September 16, 2012, the terminal disclaimer must be by the applicant of record in the application. See 37 CFR 1.321(b).
- If the inventors are the applicant but not the owner(s) of the application, then the owners will need to become the applicant by filing a request to change the applicant under 37 CFR 1.46(c)(2) (can use form PTO/AIA/41 for this request), a corrected ADS, and a statement under 37 CFR 3.73(c) to show chain of title.
- For example, if a terminal disclaimer lists two applicants but the latest filing receipt shows that there is only one applicant of record, then the applicant has to file a request to change the applicant or file a corrected terminal disclaimer listing the applicant of record.

Common terminal disclaimer pitfalls to avoid (cont.)

Using the USPTO terminal disclaimer form for a reference patent instead of the form for a reference application and vice versa

- The correct terminal disclaimer form to use in an application filed on or after September 16, 2012 to obviate a nonstatutory double patenting (NSDP) rejection based on a reference application is **PTO/AIA/25**.
- The correct terminal disclaimer form to use in an application filed on or after September 16, 2012 to obviate a nonstatutory double patenting (NSDP) rejection based on a reference patent is **PTO/AIA/26**.

Note: All of the USPTO terminal disclaimer forms listed above are for terminal disclaimers based on common ownership.

Common terminal disclaimer pitfalls to avoid (cont.)

Improperly modifying a USPTO terminal disclaimer form

- Any modification of USPTO forms must comply with 37 CFR 1.4(d)(5), which states, in part:
 - 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.

Example of an improperly modified USPTO form

Modified PTO/SB/25 (08-11)
Approved for use through 07/31/2012 OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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

TERMINAL DISCLAIMER TO OBVIATE A PROVISIONAL DOUBLE PATENTING REJECTION OVER A PENDING "REFERENCE" APPLICATION	Docket Number (Optional) XXXXXXXXXX
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In re Application of: XXXXXXXXXXXX
Application No. XXXXXXXXXXXX
Filed XXXXXXXXXXXX
For XXXXXXXXXXXX

XXXXXXXXX who together own 100 percent interest in the instant application provided below, the terminal part of the statutory term of any patent granted on the instant application shall be the expiration date of the full statutory term of any patent granted on pending reference Application Number XXXXX, or pending reference Application Number XXXXX, filed on XXXXX. The terminal part of the statutory term of any patent granted on said reference applications may be shortened by any terminal disclaimer(s) filed prior to the filing of the instant application. The owners of the instant application waive the right to separately enforce any patent granted on the reference applications and any patent granted on the instant application. The owners of the instant application agree that any patent granted on the reference applications and any patent granted on the instant application are not to be separately enforced. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

Office form number and OMB information are not removed

Highlighted text is not in original form



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**Poll: 2) For an application filed on or after
September 16, 2012, the terminal disclaimer cannot
be signed by:**

Pitfalls related to invoking the 35 U.S.C.102(b) exceptions

Mechanisms to invoke the prior art exceptions under 35 U.S.C. 102(b)

Mechanisms to invoke the prior art exceptions	Applicable exceptions	Purpose
<p>(i) Declaration or affidavit under 37 CFR 1.130(a) (see MPEP 717.01(a))</p> <p>(ii) Statement in the specification on filing regarding prior disclosures by the inventor or a joint inventor. (see 37 CFR 1.77(b)(6))</p>	35 U.S.C. 102(b)(1)(A) and (b)(2)(A)	<u>Attribution</u> : showing that the potential prior art subject matter originated with one or more members of the inventive entity

Mechanisms to invoke the prior art exceptions under 35 U.S.C. 102(b) (cont.)

Mechanisms to invoke the prior art exceptions	Applicable exceptions	Purpose
Declaration or affidavit under 37 CFR 1.130(b) (see MPEP 717.01(b))	35 U.S.C. 102(b)(1)(B) and (b)(2)(B)	<u>Prior public disclosure</u> : showing that the potential prior art subject matter was preceded by an inventor-originated disclosure of the same subject matter

Mechanisms to invoke the prior art exceptions under 35 U.S.C. 102(b) (cont.)

Mechanisms to invoke the prior art exceptions	Applicable exceptions	Purpose
Statement under 37 CFR 1.104(c)(4)(i)(A) (see MPEP 717.02(a)(I)(B))	35 U.S.C. 102(b)(2)(C)	<u>Establishing common ownership</u> not later than the effective filing date of the claimed invention under examination.

Mechanisms to invoke the prior art exceptions under 35 U.S.C. 102(b) (cont.)

Mechanisms to invoke the prior art exceptions	Applicable exceptions	Purpose
<p>Statement under 37 CFR 1.104(c)(4)(ii)(A), <u>AND</u> Disclosure of the names of the parties to the joint research agreement in the specification (see MPEP 717.02(a)(II))</p>	<p>35 U.S.C. 102(b)(2)(C)</p>	<p><u>Establishing the existence of a joint research agreement</u> not later than the effective filing date of the claimed invention under examination such that the subject matter of the potential prior art reference under 35 U.S.C. 102(a)(2) and the claimed invention under examination are "deemed" commonly owned for the purposes of 35 U.S.C. 102(b)(2)(C).</p>

Tips for drafting rule 130 declarations

- The inventor (or one or more joint inventors) should sign the declaration when possible.
- When the inventor (or one or more joint inventors) signs the declaration, a statement asserting that they invented the relevant subject matter should be included in the declaration when possible.
- Ensure that the declaration addresses the particular subject matter that is relevant to the rejection to be overcome.

Tips for drafting rule 130 declarations (cont.)

- When a disclosure of subject matter is made by someone who is not part of the inventive entity, explain how knowledge of the subject matter was passed from one or more members of the inventive entity to the discloser.
- If a (joint) inventor's communication of subject matter to a discloser is non-public and/or within the one-year grace period, say so in the declaration in order to avoid the question of whether the communication itself constitutes prior art.
- The declaration should be clear as to how the declarant came to have knowledge of the asserted facts. Tell the story! This is particular relevant when a non-inventor is the declarant.

Tips for drafting rule 130 declarations (cont.)

- When attempting to attribute a potential prior art disclosure to the inventor or a joint inventor (rule 130(a)), explain the role of any co-authors or joint inventors of the disclosure who are not also joint inventors named in the application under examination.
- When asserting prior public disclosure (rule 130(b)), include a copy of the disclosure if it was made by way of a printed publication.

Invoking the 35 U.S.C. 102(b)(2)(C) exception based on common ownership

- MPEP 717.02(a)(I)(B) discusses the requirements:
 - A proper statement under 37 CFR 1.104(c)(4)(i)
 - The statement concerning common ownership should be clear and conspicuous (for example, on a separate piece of paper or in a separately labeled section). The statement must be signed in accordance with 37 CFR 1.33(b).
- In rare instances, the examiner may have independent evidence that raises a material doubt as to the accuracy of applicant's or patent owner's representation.
 - For example, applicant submits a statement under 37 CFR 1.104(c)(4)(i)(A) that conflicts with the assignment records for the application under examination and the potential prior art reference.

Invoking the 35 U.S.C. 102(b)(2)(C) exception based on common ownership (cont.)

- Common errors:
 - A statement of present ownership
 - There must be a signed statement on the record that the common ownership existed "not later than the effective filing date of the claimed invention" of the application under examination.
 - Pointing to assignment records in the response to the Office action to establish common ownership instead of submitting the required statement under 37 CFR 1.104(c)(4)(i)

Invoking the 35 U.S.C. 102(b)(2)(C) exception based on a joint research agreement

- MPEP 717.02(a)(II) discusses the requirements:
 - A proper statement under 37 CFR 1.104(c)(4)(ii)(A) (“JRA statement”)
 - The statement should either be on or begin on a separate piece of paper and must not be directed to other matters (37 CFR 1.4(c)). The statements must be signed in accordance with 37 CFR 1.33(b).
 - Disclosure of the names of the parties to the joint research agreement (JRA) in the specification of the application under examination (see 37 CFR 1.104(c)(4)(ii)(B))
 - The processing fee under 37 CFR 1.17(i) for an amendment to the specification under 37 CFR 1.71(g)(1) to name the parties to the JRA that is filed outside of the time periods set forth in 37 CFR 1.71(g)(2).

Invoking the 35 U.S.C. 102(b)(2)(C) exception based on a joint research agreement (cont.)

- Common errors:
 - The statement under 37 CFR 1.104(c)(4)(ii) omits the prior art reference.
 - The specification does not name the parties to the joint research agreement (JRA) when applicant is attempting to invoke the 35 U.S.C. 102(b)(2)(C) exception based on a JRA.
 - Applicant does not pay the processing fee in 37 CFR 1.17(i) when the amendment to the specification under 37 CFR 1.71(g)(1) to name the parties to the JRA is filed outside of the time periods set forth in 37 CFR 1.71(g)(2).

Example of a proper JRA statement

Statement Under 37 CFR 1.104(c)(4)(ii)(A)

Pursuant to 37 CFR 1.104(c)(4)(ii)(A), the applicant of the present application provides the following statement:

The subject matter of U.S. Patent No. XX,XXX,XXX was developed and the claimed invention of the present application was made by, or on behalf of, one or more the parties to a joint research agreement, within the meaning of 35 U.S.C. 100(h) and 37 CFR 1.9(e), that was in effect on or before the effective filing date the claimed invention, and the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement.

Example of a proper amendment to name the parties to the JRA (any fee required by 37 CFR 1.71(g)(2) was paid)

AMENDMENT TO THE SPECIFICATION

Please insert the following paragraph on page 1, after the "CROSS-REFERENCE TO RELATED APPLICATIONS" section and before the "STATEMENT REGARDING PRIOR DISCLOSURES BY THE INVENTOR OR A JOINT INVENTOR" section:

PARTIES TO A JOINT RESEARCH AGREEMENT:

The subject matter of this application was made as a result of activities undertaken within the scope of a joint research agreement between ABC Corp. and XYZ Corp.

Additional information on invoking the prior art exceptions under 35 U.S.C. 102(b)

- See the First-Inventor-to-File (FITF) comprehensive training for examiners available at https://www.uspto.gov/sites/default/files/aia_implementation/fitf_comprehensive_training_prior_art_under_aia.pdf.
- See the rule 130 declaration examiner training available at <https://www.uspto.gov/sites/default/files/documents/FITF%20Evidentiary%20Declarations.pdf>.
- For questions, contact the Office of Patent Legal Administration (OPLA) help line at (571) 272-7701.



Pitfalls related to petitions

Common pitfalls to avoid - Petitions

Using improper document descriptions for indexing petitions

- Petitions that are filed without the proper document descriptions being used will result in delays in notifying the Office of Petitions of the existence of the petition.
 - Use of the document description “Miscellaneous Incoming Letter” to index a petition can cause delays unless someone reviews and identifies the paper as a petition and notifies the appropriate office of the petition.
 - The document description “Petition for review by the Office of Petitions” is the appropriate document description for most petitions handled by the Office of Petitions.

Common pitfalls to avoid - Petitions (cont.)

Last-minute filings

- Changing order of inventors
 - Can delay processing of application or issuance of patent

Common pitfalls to avoid - Petitions (cont.)

Last-minute filings (cont.)

- Withdrawal from issue
 - The petition to withdraw from issue after payment of the issue fee must be granted before midnight on Monday the day before the patent issues.
 - Merely filing the petition to withdraw before the patent issues does not prevent the patent from issuing.
 - File via ePetition for immediate processing.
 - Otherwise, there could be delays in the processing of the petition/request, and the patent could end up being issued.

Common pitfalls to avoid - Petitions (cont.)

Delay in filing petition to withdraw as attorney

- Petition is not effective when received, but when approved by Office.
 - Can take months to process
- Use the ePetition
 - Immediate processing of petition and withdrawal from application
 - Versus months of waiting for manual processing

Common pitfalls to avoid - Petitions (cont.)

Delay in filing petition to withdraw as attorney (cont.)

- Attorney still responsible for prosecuting the application until the Request/Petition to Withdraw as Attorney is granted/approved
 - Delay in filing can result in increased cost and responsibility for the attorney

Common pitfalls to avoid - Petitions (cont.)

What to do before filing petition to withdraw as attorney

- Make sure to change all correspondence addresses before withdrawing as attorney.
 - Once attorney withdraws from representation, he/she cannot change a correspondence address.
 - Failure to change the address will result in the attorney continuing to receive correspondences from the Office.

Common pitfalls to avoid - Petitions (cont.)

What to do before filing petition to withdraw as attorney (cont.)

- Withdrawal of attorney is not processed in patented or abandoned applications.
 - The power of attorney (POA) will remain in the file and only be processed if application is taken up for some action in the future.
 - Failure to withdraw before application issues/abandons results in attorney still being of record in these applications.

Common pitfalls to avoid - Petitions (cont.)

Reminder: Petitions are not a response to an Office action

- Petitions do not stop the time running against an applicant for filing a response to an Office action.
- Even if applicant is asking for review of the decision by the Office of Petitions, a response must be filed before the period for reply expires or the application will become abandoned.

Petition resources

- See Office of Petitions webpage at <https://www.uspto.gov/patents/apply/petitions> for further information on various petitions handled by Office Petitions and other useful information.
- You can also call the Office of Petitions Help Desk at (571) 272-3282 for petitions assistance.

Appendix - Patent updates

Recent expedited examination initiatives:

Climate Change Mitigation Pilot Program

Tackling the climate crisis

- Executive Order 14008, dated January 27, 2021, proclaims a “narrow moment to pursue action” to address the climate crisis—achieving net-zero greenhouse gas emissions by 2050.
- The Climate Change Mitigation Pilot Program accelerates review of patent applications for innovations designed to make progress toward the goal of net-zero greenhouse gas emissions.
- The USPTO will accept up to 4,000 qualifying applications until June 7, 2027, subject to its discretion to terminate sooner.

Special status until first action

- Qualifying applications accepted into this pilot will be advanced out of turn until a first Office action on the merits.
 - “Special New” docket—typically examined in 28 days or less
- Applicant is afforded special status without incurring the petition to make special fee, or satisfying the other requirements of the accelerated examination program.

Meeting challenges—conditions, requirements to participate

- Incentivizing new innovations in the climate space
 - Claimed invention covers a product/process that mitigates climate change— classification requirement; and
 - Claimed product/process designed to: (a) remove greenhouse gases already present in the atmosphere; (b) reduce and/or prevent additional greenhouse gas emissions; and/or (c) monitor, track, and/or verify greenhouse gas emission reductions.
- Promoting efficiency to foster accelerated review
 - USPTO petition form required
 - Electronic filing required
 - Claim limitations
- Limiting over consumption by bulk filers
 - Petition filing limitations

Eligible applications

This pilot program is open to:

- Non-continuing original utility nonprovisional applications; and
- Original utility nonprovisional applications that claim the benefit of the filing date under 35 U.S.C. 120, 121, 365(c), or 386(c) of *only one* prior application that is either a nonprovisional application or an international application designating the United States.
- Claiming the benefit of one or more prior provisional applications or claiming priority to one or more foreign applications will not affect eligibility for this pilot program.

Classification requirement

ⓘ	Y02A	TECHNOLOGIES FOR ADAPTATION TO CLIMATE CHANGE
		NOTE This subclass <u>covers</u> technologies for adaptation to climate change, i.e. technologies that allow adapting to the adverse effects of climate change in human, industrial (including agriculture and livestock) and economic activities.
	Y02B	CLIMATE CHANGE MITIGATION TECHNOLOGIES RELATED TO BUILDINGS, e.g. HOUSING, HOUSE APPLIANCES OR RELATED END-USER APPLICATIONS
	Y02C	CAPTURE, STORAGE, SEQUESTRATION OR DISPOSAL OF GREENHOUSE GASES [GHG]
ⓘ	Y02D	CLIMATE CHANGE MITIGATION TECHNOLOGIES IN INFORMATION AND COMMUNICATION TECHNOLOGIES [ICT], I.E. INFORMATION AND COMMUNICATION TECHNOLOGIES AIMING AT THE REDUCTION OF THEIR OWN ENERGY USE
		NOTES 1. This subclass <u>covers</u> information and communication technologies [ICT] whose purpose is to minimize the use of energy during the operation of the involved ICT equipment. 2. This subclass <u>does not cover</u> the use of an ICT technology supporting energy efficient operation of a further piece of equipment, nor the reuse or recycling of ICT equipment.
	Y02E	REDUCTION OF GREENHOUSE GAS [GHG] EMISSIONS, RELATED TO ENERGY GENERATION, TRANSMISSION OR DISTRIBUTION
ⓘ	Y02P	CLIMATE CHANGE MITIGATION TECHNOLOGIES IN THE PRODUCTION OR PROCESSING OF GOODS
		NOTE This subclass <u>covers</u> climate change mitigation technologies in any kind of industrial processing or production activity, including the agroalimentary industry, agriculture, fishing, ranching and the like.
	Y02T	CLIMATE CHANGE MITIGATION TECHNOLOGIES RELATED TO TRANSPORTATION
	Y02W	CLIMATE CHANGE MITIGATION TECHNOLOGIES RELATED TO WASTEWATER TREATMENT OR WASTE MANAGEMENT

- Application must include a claim to a product or process that mitigates climate change.
- That is, there must be a claim corresponding to one or more of the technical concepts within subclass Y02A, Y02B, Y02C, Y02D, Y02E, Y02P, Y02T, or Y02W in the Cooperative Patent Classification (CPC) system.

Required certifications

- Applicant must certify in the petition to make special that:
 - the claimed invention covers a product or process that mitigates climate change (classification requirement);
 - the product or process is designed to: (a) remove greenhouse gases already present in the atmosphere; (b) reduce and/or prevent additional greenhouse gas emissions; and/or (c) monitor, track, and/or verify greenhouse gas emission reductions.
 - the applicant has a good faith belief that expediting patent examination of the application will likely positively impact the climate; and
 - the petition is within the petition filing limitations.

Petition to make special—PTO/SB/457

Doc Code: PET.CLIMATE
Document Description: Petition for Climate Change Mitigation Pilot

PTO/SB/457 (05-23)

CERTIFICATION AND PETITION TO MAKE SPECIAL UNDER THE CLIMATE CHANGE MITIGATION PILOT PROGRAM	
First Named Inventor:	Nonprovisional Application Number (if known):
Title of Invention:	
<p>APPLICANT HEREBY CERTIFIES THE FOLLOWING AND PETITIONS FOR ADVANCEMENT OF EXAMINATION UNDER THE CLIMATE CHANGE MITIGATION PILOT PROGRAM FOR THE ABOVE- IDENTIFIED APPLICATION.</p> <ol style="list-style-type: none"> The claim(s) of the above-identified application (the application) cover(s) a product or process that mitigates climate change (i.e., the claim(s) correspond(s) to one or more of the technical concepts within subclass Y02A, Y02B, Y02C, Y02D, Y02E, Y02P, Y02T or Y02W in the Cooperative Patent Classification (CPC) system). The full schedule of the Y02 class is available at https://www.uspto.gov/web/patents/classification/cpc/html/cpc-Y.html#Y02. The product or process is designed to: (a) remove greenhouse gases already present in the atmosphere; (b) reduce and/or prevent additional greenhouse gas emissions; and/or (c) monitor, track, and/or verify greenhouse gas emission reductions. The applicant has a good faith belief that expediting patent examination will likely have a positive impact on the climate. The application is a non-continuing original utility nonprovisional application or an original utility nonprovisional application that claims the benefit of only one prior nonprovisional application or one prior international application designating the United States. The application is or was filed electronically using Patent Center. The specification, claim(s) and abstract on filing or on national stage entry are or were submitted in DOCX format. A properly signed application data sheet meeting the conditions specified in 37 CFR 1.53(f)(3)(i) is or was filed in the application. No nonpublication request was filed for the application or if such a request was previously filed, the nonpublication request is or has been rescinded. Form PTO/SB/36 may be used to rescind the nonpublication request. The basic filing fee, search fee, and examination fee are filed with this request or have already been paid in the application. The applicant understands that any required application size fee must be paid for the application. The fee for a petition to make special under 37 CFR 1.102(d) has been waived for this pilot program. The applicant agrees to the following: (a) the application may not contain, or be amended to contain, more than three independent claims, more than twenty total claims, or any multiple dependent claims, (b) any reply to a non-final Office action may not cancel all claims that meet the eligibility requirements of this pilot program, and (c) if a telephone restriction requirement is made, applicant must make an election without traverse to an invention that meets the eligibility requirements of this pilot program. The inventor or any joint inventor has not been named as the inventor or a joint inventor on more than twelve other nonprovisional applications in which a petition to make special under this program has been filed. This petition is either (a) electronically filed using Patent Center with the filing of the application or entry into the National Stage as to the United States, or (b) electronically filed using Patent Center within 30 days of the filing date of the application or entry into the National Stage as to the United States. 	
Signature	Date
Name (Printed/Typed)	Practitioner Registration Number
<p>Note: This form must be signed in accordance with 37 CFR 1.33. See 37 CFR 1.4(d) for signature requirements and certifications. Submit multiple forms if more than one signature is required.*</p>	
<p><input type="checkbox"/> *Total of _____ forms are submitted.</p>	

- Applicant must file a grantable petition to make special to participate in the pilot program.
- Petition form PTO/SB/457 is required
 - contains the required certifications and statements.
 - must be filed with the application or entry into the national stage, or within 30 days of filing or national stage entry.



Requirement to electronically file using Patent Center

- Petition form (PTO/SB/457)
- Application or national stage entry
- Specification, claims, and abstract must be submitted in DOCX format at the time of filing or national stage entry.

Application Data Sheet (ADS)

- Applicant must file a properly executed ADS that meets the requirements of 37 CFR 1.53(f)(3)(i).
 - Inventor bibliographic information
 - (benefit claim information)

Claim limitations

When a petition is filed, and throughout pendency (if the petition is granted):

- Application must contain no more than 3 independent claims and 20 total claims.
- Application must not contain a multiple dependent claim.

Nonpublication request impermissible

- Applicant may not opt out of 18 month publication.
 - If applicant files the petition (form PTO/SB/457) on the date of filing of an application, the application may not be filed with a nonpublication request.
 - If applicant previously filed a nonpublication request, applicant must rescind the nonpublication request no later than the time that the petition is filed.
- Form PTO/SB/36 may be used to rescind a prior nonpublication request.

Petition filing limitations

- Applicant may not file a petition to participate if the inventor or any joint inventor has been named as an inventor or a joint inventor on more than twelve other nonprovisional applications in which a petition to make special under this program has been filed.

Decision dismissing petition

- A petition decision dismissing the petition to make special will indicate whether a deficiency can be corrected.
- Some defects are correctable, others are not.
- Applicant will be given only one opportunity to correct deficiencies identified as being correctable.

Telephonic election without traverse

- If the qualifying application contains claims directed to multiple inventions, the examiner may make a requirement for restriction or unity of invention.
- If the examiner makes telephonic requirement, applicant must make an election without traverse to an invention that meets the eligibility requirements of this pilot program.

Resources and contacts

- Learn more about the program at:
<https://www.uspto.gov/patents/laws/patent-related-notices/climate-change-mitigation-pilot-program>
- Please email questions to PatentsClimateChangePilot@uspto.gov
- To inquire about the status of a particular petition, please contact the Office of Petitions at 571-272-3282.
- For questions about Patent Center, please contact the Patent Electronic Business Center at 866-217-9197 or via email to ebc@uspto.gov.



Recent expedited examination initiatives:

Cancer Moonshot Expedited Examination Pilot Program

Cancer Moonshot Expedited Examination Pilot Program

- In February 2022, the White House renewed the national Cancer Moonshot initiative that aims to reduce the cancer mortality rate by at least 50% within 25 years.
- To support the renewed initiative, the USPTO launched the Cancer Moonshot Expedited Examination Pilot Program on February 1, 2023.
 - See Federal Register notice published on December 9, 2022 (87 FR 75608).



Cancer Moonshot Expedited Examination Pilot Program (cont.)

- The new pilot program is an expansion of, and replaces the Cancer Immunotherapy Pilot Program, which expedited examination for eligible patent applications pertaining to methods of treating a cancer using immunotherapy.
- The new pilot program broadens the scope of technologies eligible for fast-track review.
- The USPTO will accept up to 1,000 qualifying applications until January 31, 2025, subject to its discretion to terminate sooner.



Special status until first Office action

- Qualifying applications accepted into the pilot program will be advanced out of turn for examination until a first Office action.
 - Petition grant
 - “Special New” docket= 28 days or less, typically
- Application is afforded special status without applicant incurring the petition to make special fee, or satisfying the requirements of the accelerated examination program.

Eligible applications

- This pilot program is open to:
 - Non-reissue (original), nonprovisional utility applications filed under 35 U.S.C. 111(a), or international applications that have entered the national stage under 35 U.S.C. 371.
 - Limited to the field of oncology or smoking cessation
 - Must not be previously granted special status under any program

Nonpublication request impermissible

- Applicant may not opt out of 18 month publication.
 - If applicant files the petition (form PTO/SB/465) on the date of filing of an application, the application may not be filed with a nonpublication request.
 - If applicant previously filed a nonpublication request, applicant must rescind the nonpublication request no later than the time that the petition is filed.
- Form PTO/SB/36 may be used to rescind a prior nonpublication request.

Overview of claim eligibility requirements

- The application must contain at least one method claim that meets the eligibility requirements of the pilot program (“eligible method claim”).
- Details of the eligibility requirements are in Section V of the Federal Register notice announcing the pilot program.

Eligible method claims

- A method of treating or reducing the incidence of a cancer using an immunotherapeutic compound or composition (cancer immunotherapy method)
 - The petition under the program must include a statement that the applicant has a good faith belief that the specification contains evidence that the compound or composition used in the method claim to treat or reduce the incidence of a cancer is immunotherapeutic. The statement must also identify the specific page(s) of the specification containing the evidence.

Eligible method claims (cont.)

- A method of treating a cancer by targeting specific genetic markers or mutations using a specific pharmaceutical composition
 - The petition under the program must include a statement that the applicant has a good faith belief that the specification contains evidence that the pharmaceutical composition used in the method claim targets the specific genetic markers or mutations to treat the cancer. The statement must also identify the specific page(s) of the specification containing the evidence.

Eligible method claims (cont.)

- A method of treating a rare or childhood cancer using a specific pharmaceutical composition
- A method of detecting or treating a cancer using a medical device specifically adapted to detect or treat the cancer
 - The only use disclosed in the specification for the medical device is to treat or detect the cancer.
 - Applications are not eligible for the pilot program if they disclose any use for the medical device claimed or used in the method that is not related to the treatment or detection of a cancer.
- A method of treating a nicotine dependency and promoting smoking cessation by administering a specific pharmaceutical composition

Eligible method claims (cont.)

- A method of treating a cancer by administering a specific pharmaceutical composition wherein the method comprises a step to diagnose the cancer
 - The method claim must have a specific step to diagnose the cancer such as steps in a specific diagnostic method.
 - It is insufficient for the method claim to either nominally recite a step to diagnose the cancer (for example, “diagnosing the individual with cancer”) or to have a single step of “administering a pharmaceutical composition X to an individual diagnosed with cancer.”

Eligible product and apparatus claims

- Eligible product or apparatus claims are claims to:
 - the immunotherapeutic compound or composition used in an eligible method claim;
 - the pharmaceutical composition used in an eligible method claim; or
 - the medical device used in an eligible method claim.

Eligible product and apparatus claims (cont.)

- The applicant may claim an eligible product or apparatus in the application only if:
 - Claims to eligible methods using the product or apparatus are presented in the same application, and
 - These method claims depend from or are commensurate in scope with the eligible product or apparatus claims (that is, the eligible method claims must contain all of the limitations of the eligible product or apparatus claims).

Eligible product and apparatus claims (cont.)

- Eligible method claims are required in the application because the eligible product or apparatus claimed may have an additional use not related to the treatment of cancer.
- Requiring the method claims to be commensurate in scope with the claims to the product or apparatus facilitates rejoinder of the method claims if the claims are subject to a restriction requirement and the claims to the product or apparatus are elected.

Claim requirements

Claim requirements for grantable petition and for remainder of prosecution for applications granted special status under the program:

- The application must contain three or fewer independent claims and 20 or fewer total claims.
- The application must not contain any multiple dependent claim.
- The application must contain at least one eligible method claim.
- If the application contains eligible product or apparatus claims, the eligible method claims must depend from or are commensurate in scope with the eligible product or apparatus claims.

Petition to make special

Doc Code: PET.CANCER
Document Description: Petition for Cancer Moonshot Pilot

PTO/SB/465 (02-23)

CERTIFICATION AND PETITION TO MAKE SPECIAL UNDER THE CANCER MOONSHOT EXPEDITED EXAMINATION PILOT PROGRAM			
First Named Inventor:		Nonprovisional Application Number (if known):	
Title of Invention:			

APPLICANT HEREBY CERTIFIES THE FOLLOWING AND PETITIONS TO PARTICIPATE IN THE CANCER MOONSHOT EXPEDITED EXAMINATION PILOT PROGRAM ("PROGRAM") FOR THE ABOVE-IDENTIFIED APPLICATION.

(The fee for a petition to make special under 37 CFR 1.102(d) has been waived for this program. For information regarding the requirements, conditions, and guidelines of the program, see the 2022 Federal Register notice titled "Cancer Moonshot Expedited Examination Pilot Program" available on the United States Patent and Trademark Office (USPTO) website at <https://www.uspto.gov/patents/laws/patent-related-notices/patent-related-notices-2022>).

- The above-identified application (the application) is a non-reissue (original), nonprovisional utility application filed under 35 U.S.C. 111(a), or an international application that has entered the national stage under 35 U.S.C. 371.
- Special status under this program is being sought because the application is limited to the field of oncology or smoking cessation and contains at least one of the following method claims that meet the eligibility requirements of the program ("eligible method claims"):
 - A method of treating or reducing the incidence of a cancer using an immunotherapeutic compound or composition (cancer immunotherapy method).

Note: If this box is checked, please complete the following statement:
The applicant has a good faith belief that the following page(s) of the specification contain(s) evidence that the compound or composition used in the method claim to treat or reduce the incidence of a cancer is immunotherapeutic: _____
 - A method of treating a cancer by targeting specific genetic markers or mutations using a specific pharmaceutical composition.

Note: If this box is checked, please complete the following statement:
The applicant has a good faith belief that the following page(s) of the specification contain(s) evidence that the pharmaceutical composition used in the method claim targets the specific genetic markers or mutations to treat the cancer: _____
 - A method of treating a rare or childhood cancer using a specific pharmaceutical composition.
 - A method of detecting or treating a cancer using a medical device specifically adapted to detect or treat the cancer.

The only use disclosed in the specification for the medical device is to treat or detect the cancer.
 - A method of treating a cancer by administering a specific pharmaceutical composition wherein the method comprises a step to diagnose the cancer.
 - A method of treating a nicotine dependency and promoting smoking cessation by administering a specific pharmaceutical composition.
- If the application contains eligible product or apparatus claims (that is, claims to the immunotherapeutic compound or composition, the pharmaceutical composition, or the medical device used in eligible method claims), the eligible method claims depend from or are commensurate in scope with the eligible product or apparatus claims (that is, the eligible method claims contain all of the limitations of the eligible product or apparatus claims).
- The application is being or was filed electronically using Patent Center (at <https://patentcenter.uspto.gov>).

[Page 1 of 2]

- Applicant must file a grantable petition to make special to participate in the pilot program.
- Petition form PTO/SB/465
 - is required to request participation in the pilot program.
 - contains the required certifications and statements.
 - must be filed electronically using Patent Center.
 - must be filed prior to a first Office action (which may be an Office action containing only a restriction requirement).



Application requirements: Electronic filing and DOCX format

- Application or national stage entry must be filed electronically using Patent Center.
- Specification, claims, and abstract must be submitted in DOCX format at the time of filing or national stage entry.
 - For more information on DOCX filing in Patent Center, please see www.uspto.gov/patents/docx.

Petition filing limitations

- Applicant may not file a petition to participate in the pilot program if the inventor or any joint inventor of the application has been named as an inventor or a joint inventor on more than nine other nonprovisional applications in which a petition to make special under this pilot program has been filed.
 - In other words, the inventor or a joint inventor is limited to no more than 10 nonprovisional applications in which a petition to make special under the pilot program was filed.
- Petition filing limitations prevents overuse by bulk filers and promotes diversity of applicants and inventors.
- Petitions filed under the Cancer Immunotherapy Pilot Program do not count toward the filing limits in this pilot program.



Decision dismissing petition

- A petition decision dismissing the petition to make special will indicate whether a deficiency can be corrected.
- Some defects allow for correction but others are fatal.
- Applicant will be given only one opportunity to correct deficiencies identified as being correctable.

Prosecution of applications accepted into pilot program – Restriction requirement

Requirement for restriction or unity of invention:

- If multiple inventions are found in the application, the examiner may make a requirement for restriction or unity of invention.
 - Applicants must make an election without traverse to an invention that meets the eligibility requirements of the pilot program.

Prosecution of applications accepted into pilot program - Rejoinder

When rejoinder should be considered:

- Where applicant elects claims directed to an eligible product or apparatus, and all product or apparatus claims are subsequently found allowable:
 - Withdrawn eligible method claims that include all the limitations of the allowable product or apparatus claims will be considered for rejoinder in accordance with sections 806.05 et seq. and 821.04 et seq. of the MPEP.
- In the event of rejoinder, the requirement for restriction between the product or apparatus claims and the rejoined method claims will be withdrawn by the examiner, and the rejoined method claims will be fully examined for patentability in accordance with 37 CFR 1.104.

Prosecution of applications accepted into pilot program - Amendments

Amendments

- Any amendment to a non-final office action will be considered non-responsive if it attempts to:
 - Add claims which would result in more than three independent claims or more than 20 total claims.
 - Add any multiple dependent claim.
 - Cancel all claims to the elected invention.
 - Cancel all eligible method claims.
 - Present eligible method claims that are not commensurate in scope with elected claims to an eligible product or apparatus.

Questions?

- For **questions about Patent Center**, please contact the Patent Electronic Business Center at ebc@uspto.gov or **866-217-9197**.
- For **questions regarding a Cancer Moonshot Expedited Examination Pilot Program petition**, please contact Gary B. Nickol, Supervisory Patent Examiner, Technology Center 1600, at 571-272-0835 or gary.nickol@uspto.gov; or Brandon J. Fetterolf, Supervisory Patent Examiner, Technology Center 1600, at 571-272-2919 or brandon.fetterolf@uspto.gov
- For **questions regarding the Cancer Moonshot Expedited Examination Pilot Program Federal Register Notice**, please contact the Office of Patent Legal Administration at **571-272-7704** or email PatentPractice@uspto.gov.



Recent expedited examination initiatives:

First-Time Filer Expedited Examination Pilot Program

The USPTO's Council for Inclusive Innovation (CI²)



- The USPTO's Council for Inclusive Innovation (CI²) looks to expand innovation in the United States by tapping into the strength of our nation's diversity and increasing the opportunities for all Americans to participate in innovation.
- One way in which CI² supports diversity in the innovation ecosystem is by providing programs that increase the involvement of women and other underrepresented groups.

First-Time Filer Expedited Examination Pilot Program



- This pilot program is part of CI²'s efforts to increase accessibility to the patent system for inventors who are new to the patent application process, including those in historically underserved geographic and economic areas.
- The program expedites the first Office action for program participants.
 - Expediting the first Office action reduces time-based barriers for inventors who may otherwise be unable to participate in the patent system.
- This pilot program also aligns with and supports Executive Order 13985, dated January 20, 2021, and advances the efforts of the USPTO and CI² to create more equity and diversity in innovation.
- The USPTO will accept up to 1,000 qualifying applications until March 11, 2024, subject to its discretion to terminate sooner.



Special status until first Office action

- Qualifying applications accepted into the pilot program will be advanced out of turn for examination until a first Office action.
 - Petition grant
 - “Special New” docket= 28 days or less, typically
- The application is afforded special status without applicant incurring the petition to make special fee, or satisfying the requirements of the accelerated examination program.

What can the program do for you?

- Reduce the amount of time it takes to receive a first Office action on the merits
- Give an early indication of whether the invention is patentable
- Potentially get a patent and onto the market faster

Inventor eligibility requirements: First-time filer

- Inventors must not have been named as the sole inventor or a joint inventor on any other U.S. nonprovisional application.

Inventor eligibility requirements: Reasonably trained on basics of application process

- Inventors must be reasonably trained on the basics of the USPTO's patent application process.
 - There are no specific courses or curricula required to make this certification.
 - The USPTO provides a list of training resources for inventors to meet this requirement (<https://www.uspto.gov/FirstTimePatentFiler>).
 - Applications will receive a first Office action soon after acceptance into the pilot program, so inventors should be ready and able to engage in the patent prosecution process when they receive the Office action.
 - Applicants may be represented by a registered attorney or agent.
- The USPTO provides additional support and resources for inventors and entrepreneurs at <https://www.uspto.gov/CES>.



Applicant and inventor eligibility requirements: Micro entity status

- Applicants and inventor(s) must qualify for micro entity status under the gross income basis requirement.
 - Applicants must separately and properly establish micro entity status under the gross income basis requirement no later than the date that the petition to participate in the pilot is filed.
 - See the USPTO Micro Entity Status web page for more information (<https://www.uspto.gov/PatentMicroentity>)

Eligible applications

- This program is open to non-continuing original utility nonprovisional applications that do not claim the benefit of the filing date of any prior-filed nonprovisional U.S. applications or international applications designating the United States under 35 U.S.C. 120, 121, 365(c), or 386(c).
- Note that claiming the benefit under 35 U.S.C. 119(e) of one or more prior provisional applications will not affect eligibility for this pilot program.
- Application must not be previously granted special status under any program.

Eligible applications (cont.)

- This program is not open to:
 - Continuation, continuation-in-part, divisional, and bypass applications.
 - Applications claiming a right of foreign priority under 35 U.S.C. 119(a)-(d) or (f) to one or more foreign applications.
 - Applications entering the national stage under the Patent Cooperation Treaty as set forth in 35 U.S.C. 371.

Application requirements: Electronic filing and DOCX format

- Application must be filed electronically using Patent Center.
- Specification, claims, and abstract must be submitted in DOCX format at the time of filing.
 - For more information on DOCX filing in Patent Center, please see www.uspto.gov/patents/docx.

Application requirements: Application must be complete when the petition is filed

- The application must be complete under 37 CFR 1.51(b) no later than the date the petition to make special under this program is filed. That is, your application must include:
 - A specification,
 - Drawing(s) if necessary,
 - At least one claim,
 - A properly executed oath or declaration under 37 CFR 1.63 (or a substitute statement in compliance with 37 CFR 1.64) for each named inventor, and
 - Payment of all appropriate fees (that is, basic filing, search, and examination fees, and an application size fee if required) prior to or concurrently with filing the petition to make special under this program.

Application requirements: Application must be complete when the petition is filed (cont.)

- If the application is not complete under 37 CFR 1.51(b) on the date the petition to make special under this program is filed, the petition will be dismissed without further opportunity to request participation in the program.
- You may delay filing your petition to make special until a filing receipt is issued and you are sure the application includes the items required by 37 CFR 1.51(b), to help avoid dismissal of your petition for being incomplete under 37 CFR 1.51(b).
- Your petition must still be filed before the examiner sends a first Office action in your application.

Application requirements: Claim limits and no multiple dependent claims

Claim requirements for grantable petition and for remainder of prosecution for applications granted special status:

- The application must contain three or fewer independent claims and 20 or fewer total claims.
- The application must not contain any multiple dependent claim.
- The application must not be amended to contain more than three independent claims, more than 20 total claims, or any multiple dependent claim after entry into the pilot has been granted.

Petition to make special

Doc Code: PET.CI2.FTF

Document Description: Petition for First-Time Filer Pilot

PTO/SB/464 (03-23)

CERTIFICATION AND PETITION FOR THE FIRST-TIME FILER EXPEDITED EXAMINATION PILOT PROGRAM (Page 1 of 1)			
First-Named Inventor:		Nonprovisional Application Number (if known):	
Title of Invention:			
<p>APPLICANT HEREBY CERTIFIES THE FOLLOWING AND PETITIONS TO PARTICIPATE IN THE FIRST-TIME FILER EXPEDITED EXAMINATION PILOT PROGRAM FOR THE ABOVE-IDENTIFIED APPLICATION.</p> <ol style="list-style-type: none"> The inventor or, where there are joint inventors, each joint inventor has not been named as the sole inventor or a joint inventor on any other nonprovisional application. The applicant and the inventor or, where there are joint inventors, the applicant and each joint inventor qualify for micro entity status under the gross income basis requirement. Form PTO/SB/15A is or was filed to establish micro entity status. The inventor or, where there are joint inventors, each joint inventor named on the application is reasonably trained on the basics of the USPTO's patent application process. For applicants who are unsure whether they meet this requirement, exemplary patent application training resources that could be used to meet this requirement are available at https://www.uspto.gov/FirstTimePatentFiler. The application (1) is an original, noncontinuing, nonprovisional utility application filed under 35 U.S.C. 111(a); (2) does not claim the benefit of the filing date of any prior-filed nonprovisional application or international application designating the United States; (3) does not claim a right of foreign priority under 35 U.S.C. 119(a)-(d) or (f) to any foreign application; and (4) is not entering the national stage under the Patent Cooperation Treaty (PCT) as set forth in 35 U.S.C. 371. Special status has not been previously granted in this application. This petition is being filed using Patent Center before a first Office action (including an action containing only a restriction requirement) has issued in the application. The application is being or was filed using Patent Center. The application is complete under 37 CFR 1.51. That is, the application includes a specification, drawing(s) if necessary, at least one claim, an oath or declaration, and payment of all appropriate fees (that is, basic filing, search, and examination fees, and an application size fee if required). The specification, claim(s) and abstract of the application on filing are being or were submitted in DOCX format. The applicant agrees that the application may not contain, or be amended to contain, more than three independent claims, more than twenty total claims, or any multiple dependent claims. The applicant agrees that if any joint inventor is added to the application after a petition has been granted under this program, the applicant must certify (for example, on a separate letter) that the added joint inventor(s) meet(s) the criteria in items (1) - (3) above. 			
Signature		Date	
Name (Printed/Typed)		Practitioner Registration Number (if applicable)	
<p><i>Note: This form must be signed in accordance with 37 CFR 1.33(b). See 37 CFR 1.4(d) for signature requirements and certifications. If this application is being (or was) filed by joint inventor-applicants, either a single copy of this form must be signed by a patent practitioner or each joint inventor-applicant must sign a separate copy of the form. Submit multiple forms if more than one signature is required.*</i></p>			
<p><input type="checkbox"/> *Total of _____ SB/464 forms being submitted.</p>			

- Applicant must file a grantable petition to make special to participate in the pilot program.
- Petition form PTO/SB/464
 - is required to request participation in the pilot program.
 - contains the required certifications and statements.
 - must be filed electronically using Patent Center.
 - must be filed prior to a first Office action (which may be an Office action containing only a restriction requirement).



Adding joint inventors after a petition has been granted under this program

- If any joint inventor is added to the application after a petition has been granted under this program, the applicant must certify (for example, on a separate letter) that the added joint inventor(s)
 - has not been named as the sole inventor or a joint inventor on any other U.S. nonprovisional application,
 - qualifies for micro entity status, and
 - is reasonably trained on the USPTO's patent application process.

Decision dismissing petition

- A decision dismissing the petition to make special will indicate whether a deficiency can be corrected.
- Some defects allow for correction, but others are fatal.

Deficiencies identified as not correctable in the petition decision

- The inventor or, where there are joint inventors, at least one joint inventor has been named as the sole inventor or a joint inventor on a previously filed nonprovisional application.
- The application was not complete under 37 CFR 1.51(b) as of the filing of the petition to make special under this program. Note that applicants may wait to file the petition until they are sure that the application is complete.
- The application was previously granted special status (for example, if the application has been granted special status for age of inventor, it is not eligible for this pilot).
- The petition was not filed before a first Office action was issued in the application.

Deficiencies identified as not correctable in the petition decision (cont.)

- The application:
 - (1) claims the benefit of the filing date of one or more prior filed applications that are nonprovisional applications and/or international applications,
 - (2) claims a right to priority to one or more foreign applications, or
 - (3) is a national stage under 35 U.S.C. 371.
- The application was not filed electronically via Patent Center.
- The abstract, specification, and claim(s) were not provided in DOCX format at the time of filing the application.

Deficiencies identified as correctable in the petition decision

- Filing more than 20 claims total
- Filing more than three independent claims
- Filing any multiple dependent claims
- Not properly establishing micro entity status using form PTO/SB/15A

Deficiencies identified as correctable in the petition decision (cont.)

- Not using form PTO/SB/464 for the petition
- Not filing the petition via Patent Center
- Not signing the petition in accordance with 37 CFR 1.33(b)

Note: Applicant will have a non-extendable two-month reply period to correct the deficiencies identified in the petition decision and file a new petition to participate in pilot. Applicant has one opportunity to correct deficiencies identified as being correctable.

Prosecution of applications accepted into pilot program - Amendments

Amendments:

- Any amendment to a non-final Office action will be considered non-responsive if it attempts to:
 - Add claims which would result in more than three independent claims or more than 20 total claims.
 - Add any multiple dependent claim.

QUESTIONS?

- For **questions about Patent Center**, please contact the Patent Electronic Business Center at **ebc@uspto.gov** or **866-217-9197**.
- For **questions regarding the First-Time Filer Expedited Examination Pilot Program**, please contact the Office of Patent Legal Administration at **571-272-7704** or email **CI2FirstTimeFilerPilot@uspto.gov**.



Selected topics on the July 2022 revision of the 9th Edition of the Manual of Patent Examining Procedure (MPEP)

Overview

- A brief summary of selected topics of the July 2022 revision of the MPEP (published February 2023).
- For a complete summary of the changes, see the Change Summary posted at [Manual of Patent Examining Procedure \(uspto.gov\)](https://www.uspto.gov/web/offices/pac/mpep/index.html)
<https://www.uspto.gov/web/offices/pac/mpep/index.html>.

AIA – Applicant vs. Inventor

- Clarified guidance to ensure these terms were used consistently with the AIA definitions below:
 - *"Inventor"* - the individual or, if a joint invention, the individuals collectively who invented or discovered the subject matter of the invention. (35 U.S.C. 100).
 - *"Applicant"* - a person to whom the inventor has assigned or is under an obligation to assign an invention to file and prosecute an application for patent as the applicant, or a person who otherwise shows sufficient proprietary interest in the matter to file and prosecute an application for patent as the applicant on behalf of the inventor (MPEP § 605; 37 CFR 1.42).



Overlap in inventorship

- Clarified overlap in appropriately named inventorship for continuation, continuation-in-part, and divisional applications (MPEP §§ 201.06 and 211.01) and for foreign priority (MPEP § 213.02).
 - Overlap occurs if there is overlap upon filing of the later application and filing of the relied upon earlier application.
- Added an example for a divisional application (MPEP § 602.01(c)).

Suggesting patent practitioner

- Revised guidance on when to suggest that a pro se applicant may want to employ a patent practitioner (MPEP § 401).
 - Do not suggest if there appears to be no patentable subject matter.
- Revised form paragraph 4.10.

“Large Tables”

- Updated to include submission of “Large Tables”
 - Any individual table that is **more than 50 pages** in length or **multiple tables**, where the number of pages **exceeds 100 pages in length** (MPEP § 608.05(b)).
 - May be submitted in electronic form in **ASCII plain text** in U.S. national applications.
 - Must contain an **incorporation by reference statement** if filed in **ASCII plain text**.

“Computer Program Listing Appendix”

- Updated to include submission of a “Computer Program Listing Appendix”.
- Any computer program listing having **over 300 lines** in a U.S. national application (MPEP § 608.05(a)):
 - Must be submitted in electronic form in **ASCII plain text**.
 - Must contain an **incorporation by reference statement**.
 - Will not be part of the printed patent.

Information disclosure statement (IDS)

- Clarified that
 - when a *bona fide* attempt is made to comply with IDS content requirements, but part of the required content is inadvertently omitted, additional time may be given to enable full compliance.
 - when no page numbers are supplied, it is understood that all of the pages of the publication are the relevant pages (MPEP § 609.01) .
 - an IDS may be timely filed on the next succeeding business day if the last day of the three months period falls on a Saturday, Sunday, or a federal holiday within the District of Columbia (MPEP § 609.04(b)).

Information disclosure statement (IDS) (cont.)

- Clarified that
 - An IDS filed after the examiner has reached a final determination on the patentability will be handled by the examiner as a “Printer Rush”.
 - An information disclosure statement filed on the same day as or after the mailing date of an *Ex parte Quayle* action or notice of appeal must shall be considered if filed with a certification statement (MPEP § 609.04(b)).

Request for continued examination (RCE)

- Clarified initial processing of RCEs (MPEP § 706.07(h), III).
- Added guidance on when an RCE is timely filed after a new ground of rejection by the Patent Trial and Appeal Board (PTAB) (MPEP § 706.07(h), XI.A).

Delayed benefit claim, priority claim, and maintenance fee

- Incorporated guidance of requiring additional information for petitions filed more than two years after an action was due for:
 - unintentionally delayed benefit claim (MPEP § 211.04),
 - unintentionally delayed priority claim (MPEP § 214.02), and
 - unintentionally delayed maintenance fee (MPEP § 2590).

Abandonment and petitions to revive

- Incorporated guidance of requiring additional information for petitions to revive filed more than two years after abandonment (MPEP § 711.03(c)).
- Clarified guidance in determining whether an application is abandoned (MPEP § 711.02) and added examples (MPEP § 711.04(a)).

Interviews

- Added language clarifying that all Internet communications between USPTO employees and applicants must originate from USPTO provided links (MPEP § 502.03).
- Clarified guidance regarding use of IT tools and authorization for interviews (MPEP § 713.01).
- Updated guidance to reflect current practice with interview summaries (MPEP § 713.04).

Affidavits, declarations and evidence

- Added court decisions pertaining to the nexus requirement (MPEP § 716.01(b)).
- Included additional court decisions regarding evidence of copying (MPEP § 716.06).
- Clarified that admitted affidavits or declarations should be indicated in the coversheet form of the Office action (MPEP § 717.01(f)).

Restriction

- Clarified the serious burden requirement for restriction (MPEP § 803).
- Clarified telephone restriction practice and added a new form paragraph 8.23.03 (MPEP § 812.01).

Double patenting

- Revised guidance to define how patent term filing date is used to determine whether to make or maintain double patenting rejections (MPEP §§ 804 and 1490, VI.D).
- Clarified double patenting analysis when prior art is excepted under 35 U.S.C. 102(b)(2)(C) or disqualified under pre-AIA 35 U.S.C. 103(c) (MPEP §§ 804 and 2158).

Terminal disclaimers

- Clarified that a terminal disclaimer, by itself, is not a complete reply to a nonstatutory double patenting rejection (MPEP §§ 804 and 1504.06).
- Clarified guidance on correcting errors in a terminal disclaimer (MPEP § 1490, VIII.B).
- Revised form paragraphs (MPEP § 1490, VII).

Search and classification

- Chapter 900 revised to reflect changes associated with the Time, Routing, and Examiner PAP (TRP)
 - Definitions of thorough and complete search (MPEP § 904.02 et al.),
 - Added a discussion on searching related post-grant proceedings (MPEP § 904.04), and
 - CPC classification and C* (MPEP § 905.03(a)).

Search and classification (cont.)

- Added new sections describing the routing and docketing of applications
 - Assignment, transfer, and classification challenges in CPC (MPEP § 909.01).
 - Assignment and transfer of applications in USPC (MPEP § 909.02).
 - Limited to discussion of plant and design applications.

Appeals

- Added discussion to advise applicants that unchallenged double patenting rejections in appeals may result in summary affirmation in later proceeding (MPEP § § 1205.02, 1207.02).
 - New FP 12.278 for use in Examiner's Answers
- Added additional information on Pre-Appeal Brief Review Requests (MPEP § 1204.02).

Reissue

- Clarified reissue oath or declaration guidance
 - Signature requirements (MPEP § 1410.01)
 - Error requirements (MPEP § 1414)
- Clarified original patent requirement and overlooked aspects (MPEP § 1412.01).

Certificate of correction

- Added guidance to clarify what is considered a clerical or typographic mistake (MPEP § 1481).
- Included more details on filing a certificate of correction electronically (MPEP § 1485).
- Revised to add more information and examples on petitions under 37 CFR 1.78 (MPEP § 1481.03).

Design patents

- Clarified that design claims are limited to the article of manufacture identified in the claim and do not cover designs in the abstract (MPEP §§ 1502 and 1504.02).
- Clarified when a single plan- or planar-view may be sufficient to comply with 35 U.S.C. § 112 (MPEP §§ 1503.02 and 1504.04).

PCT practice

- Updated requirements for sequence listings (MPEP §§ 1832.02 and 1848).
- Clarified the time period for amending an application after entering the U.S. national stage and the process for amending claims under PCT Rule 66.8 (MPEP §§ 1801 and 1871).

Duty of disclosure

- Clarified the scope of the “duty of disclosure” and the “duty of reasonable inquiry” (MPEP §§ 2000.01, 2001, and 2002).
- Added guidance on duties of disclosure and reasonable inquiry related to dealings with regulatory and other government agencies (MPEP §§ 2001.06 and 2015).

Joint inventorship

- An inventor or joint inventor must be a natural person. (MPEP § 2109).
- Added citation to *Dana-Farber Cancer Inst., Inc. v. Ono Pharm. Co.* (964 F.3d 1365, 2020 U.S.P.Q.2d 10775 (Fed. Cir. 2020)) pertaining to the amount and timing of a joint inventor contribution (MPEP § 2109.01).

Evaluating prior art under 35 U.S.C. 102

- Revised guidance to refer to the “relevant time” for evaluating prior art –
 - For applications subject to the **AIA 35 U.S.C. 102**, the relevant time is “before the effective filing date of the claimed invention”.
 - For applications subject to **pre-AIA 35 U.S.C. 102**, the relevant time is “at the time of the invention”.

Grace period

- Clarified that the 1-year grace period is extended to the next business day if it would otherwise end on a federal holiday or weekend (MPEP §§ 2133 and 2153.02).

35 U.S.C. 102(b)(1)(A) - Affidavits or declarations under 37 CFR 1.130

- Clarified that an applicant may show that a disclosure was made by the inventor or a joint inventor by way of an affidavit or declaration under 37 CFR 1.130(a) (an affidavit or declaration of attribution).
 - May also show that the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor (MPEP § 2155.01).

Prophetic examples

- Added guidance that claims should be drafted in a manner that assists readers in differentiating between actual working and prophetic examples
 - Presented in a manner that forecasts simulated or predicted results (MPEP § 608.01(p), II and MPEP § 2004).
 - Should not be described using the past tense.
 - Added *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.*, 750 F.2d 1569, 1577, 224 U.S.P.Q. 409, 414 (Fed. Cir. 1984) (MPEP § 2164.02).
 - Added *Properly Presenting Prophetic and Working Examples in a Patent Application*, 86 FR 35074 (July 1, 2021) (MPEP § 608.01(p), II and MPEP § 2004).

“Sequence Listing” under ST.25

- Updated to include requirements for submissions of a “Sequence Listing” under World Intellectual Property Organization (WIPO) Standard ST.25.
 - Recommendation to submit in electronic form in **ASCII plain text** in U.S. applications for applications filed BEFORE July 1, 2022 – no CRF is needed (MPEP § 2420 *et seq.*).
 - U.S. applications require an incorporation by reference statement.

“Sequence Listing XML” under ST.26

- Incorporated “Sequence Listing XML” under World Intellectual Property Organization (WIPO) Standard ST.26.
 - Must submit disclosures of nucleotide and/or amino acid sequences in eXtensible Markup Language (XML) ON OR AFTER July 1, 2022 (MPEP § 2412-2416 and 2419).
 - U.S. applications require an incorporation by reference statement.

Patent term adjustment and extension (PTA and PTE)

- Incorporated guidance pertaining to the Supernus notice (85 FR 36335 (June 16, 2020)) for PTA (MPEP §§ 2730 and 2732).
- Clarified guidance regarding calculating PTE for reissued patents (MPEP § 2766).

International design practice

- Clarified basic flow of applications under the Hague Agreement (MPEP § 2901).
- Clarified requirements with respect to the title, description, and drawings (MPEP § 2920.04(a)-(b)).
- Clarified aspects of directly or indirectly filing an international design application and processes for foreign priority claims (MPEP §§ 2905 and 2920.05(d)).

Court decisions

- Added court decisions pertaining to:
 - Claim interpretation,
 - Prior art sources,
 - Anticipation,
 - Obviousness,
 - Written description,
 - Definiteness, and
 - Means plus function.

Court decisions - Claim interpretation

- **Intrinsic evidence – (MPEP § 2111.01)**
 - *Seabed Geosolutions (US) Inc. v. Magseis FF LLC*, 8 F.4th 1285, 2021 U.S.P.Q.2d 848 (Fed. Cir. 2021)
- **Preamble – (MPEP § 2111.02)**
 - *Shoes by Firebug LLC v. Stride Rite Children's Grp., LLC*, 962 F.3d 1362, 2020 U.S.P.Q.2d 10701 (Fed. Cir. 2020)

Court decisions - Prior art sources

- **Wayback Machine – (MPEP § 2128)**
 - *Valve Corp. v. Ironburg Inventions Ltd.*, 8 F.4th 1364, 2021 U.S.P.Q.2d 867 (Fed. Cir. 2021)
- **Library accessibility – (MPEP § 2128.01)**
 - *Telefonaktiebolaget LM Ericsson v. TCL Corp.*, 941 F.3d 1341, 2019 U.S.P.Q.2d 428076 (Fed. Cir. 2019)
- **Oral presentation – (MPEP § 2128.01)**
 - *M & K Holdings, Inc. v. Samsung Elecs. Co.*, 985 F.3d 1376, 2021 U.S.P.Q.2d 123 (Fed. Cir. 2021)
- **Official notice – (MPEP § 2144.03)**
 - *In re Ahlert*, 424 F.2d 1088, 165 U.S.P.Q. 418 (CCPA 1970)

Court decisions - Anticipation

- **Inherency – (MPEP § 2112)**

- *PAR Pharm., Inc. v. TWI Pharms., Inc.*, 773 F.3d 1186, 112 U.S.P.Q.2d 1945 (Fed. Cir. 2014)
- *Persion Pharms. LLC v. Alvogen Malta Operations Ltd.*, 945 F.3d 1184, 2019 U.S.P.Q.2d 494084 (Fed. Cir. 2019)
- *Hospira, Inc. v. Fresenius Kabi USA, LLC*, 946 F.3d 1322, 2020 U.S.P.Q.2d 6227 (Fed. Cir. 2020)

- **Disclosure of genus – (MPEP § 2131.02)**

- *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 851 F.3d 1270, 122 U.S.P.Q.2d 1116 (Fed. Cir. 2017)

Court decisions - Obviousness

- **Analogous art – (MPEP § 2141.01(a))** (discussing that “same field of endeavor” and “reasonably pertinent” are two separate tests for establishing analogous art)
 - *In re Schreiber*, 128 F.3d 1473, 44 U.S.P.Q.2d 1429 (Fed. Cir. 1997)
 - *Airbus S.A.S. v. Firepass Corp.*, 941 F.3d 1374, 2019 U.S.P.Q.2d 430083 (Fed. Cir. 2019)
 - *Donner Technology, LLC v. Pro Stage Gear, LLC*, 979 F.3d 1353, 2020 U.S.P.Q.2d 11335 (Fed. Cir. 2020)
- **Ordinary skill in the art – (MPEP §§ 2141.03 and 2145)**
 - *Uber Techs., Inc. v. X One, Inc.*, 957 F.3d 1334, 2020 U.S.P.Q.2d 10476 (Fed. Cir. 2020)

Court decisions – Obviousness (cont.)

- **Known methods – (MPEP § 2143)**
 - *B/E Aerospace, Inc. v. C&D Zodiac, Inc.*, 962 F.3d 1373, 2020 U.S.P.Q.2d 10706 (Fed. Cir. 2020)
- **Expectation of success – (MPEP § 2143.02)**
 - *OSI Pharm., LLC v. Apotex Inc.*, 939 F.3d 1375, 2019 U.S.P.Q.2d 379681 (Fed. Cir. 2019)
- **Nexus requirement – (MPEP § 2145)**
 - *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 2019 U.S.P.Q.2d 483355 (Fed. Cir. 2019)

Court decisions - Written description

- **Novelty in the specification – (MPEP § 2161.01)**
 - *Idenix Pharms. LLC v. Gilead Scis. Inc.*, 941 F.3d 1149, 2019 U.S.P.Q.2d 415844 (Fed. Cir. 2019)
- **Representative number of species – (MPEP § 2163)**
 - *Juno Therapeutics, Inc. v. Kite Pharma, Inc.*, 10 F.4th 1330, 2021 U.S.P.Q.2d 893 (Fed. Cir. 2021).
- **Support in prior application – (MPEP § 2163)**
 - *Akeva LLC v. Nike, Inc.*, 817 Fed. Appx. 1005, 2020 U.S.P.Q.2d 10797 (Fed. Cir. 2020)

Court decisions - Written description (cont.)

- **Support in prior application – (MPEP § 2163.03)**
 - *Purdue Pharma LP v. Iancu*, 767 Fed. Appx. 918, 2019 U.S.P.Q.2d 136363 (Fed. Cir. 2019)
- **Numerical range limitation – (MPEP § 2163.05)**
 - *Gen. Hosp. Corp. v. Sienna Biopharmaceuticals, Inc.*, 888 F.3d 1368, 126 U.S.P.Q.2d 1556 (Fed. Cir. 2018)

Court decisions - Definiteness

- **Analysis of claim language – (MPEP § 2173.02)**
 - *IBSA Institut Biochimique, S.A. v. Teva Pharm. USA, Inc.*, 966 F.3d 1374, 2020 U.S.P.Q.2d 10865 (Fed. Cir. 2020)
- **Inconsistency in claim terminology – (MPEP § 2173.03)**
 - *Tvngo Ltd. (BVI) v. LG Elecs. Inc.*, 861 Fed. Appx. 453, 2021 U.S.P.Q.2d 697 (Fed. Cir. 2021)
- **Negative limitations – (MPEP § 2173.05(i))**
 - *Novartis Pharms. Corp. v. Accord Healthcare, Inc.*, 38 F.4th 1013, 2022 U.S.P.Q.2d 569 (Fed. Cir. 2022)
- **Use of trade names – (MPEP § 2173.05(u))**
 - *Eli Lilly & Co. v. Apotex, Inc.*, 837 Fed. Appx. 780, 2020 U.S.P.Q.2d 11531 (Fed. Cir. 2020)

Court decisions – Means-plus-function

- **In method claims (MPEP § 2181)**
 - *Rain Computing, Inc. v. Samsung Elecs. Am. Inc.*, 989 F.3d 1002, 2021 U.S.P.Q.2d 284, (Fed. Cir. 2021)
 - *Media Rights Techs., Inc. v. Capital One Fin. Corp.*, 800 F.3d 1366, 116 U.S.P.Q.2d 1144 (Fed. Cir. 2015)
- **Generic placeholders (MPEP § 2181)**
 - *Dyfan, LLC v. Target Corp.*, 28 F.4th 1360, 2022 U.S.P.Q.2d 288 (Fed. Cir. 2022)
 - *Zeroclick, LLC v. Apple Inc.*, 891 F.3d 1003, 126 U.S.P.Q.2d 1765 (Fed. Cir. 2018)

Questions or feedback on the MPEP?



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[https://uspto-
mpep.ideascale.gov.com](https://uspto-mpep.ideascale.gov.com)



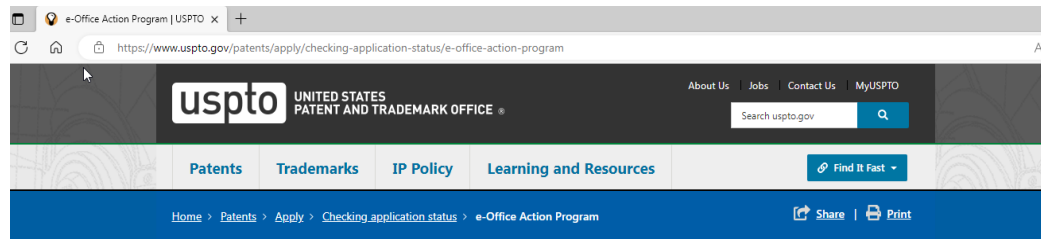
Patent Center Electronic Office Action Program

Patent Center Electronic Office (e-Office) Action Program

- Patent Center e-Office Action program
 - replaces the e-Office Action program available to Private PAIR users.
 - is another step towards fully transitioning to Patent Center.
- The USPTO announced the transition to the Patent Center e-Office Action program on April 5, 2023.
 - *See Patent Center Electronic Office Action Program, 88 FR 20138 (Apr. 5, 2023).*
- Patent Center will send an email notification listing retrievable Office communications to participating users.
- No change in how participants access correspondence in Patent Center and Private PAIR.



Patent Center Electronic Office (e-Office) Action Program (cont.)



- Patents
- Trademarks
- IP Policy
- Learning and Resources
- About Us
- Jobs
- Contact Us
- MyUSPTO

Attention e-Office Action participants: On April 12, 2023 the Office will transition all current Private PAIR e-Office Action participants to Patent Center e-Office Action. For details regarding the transition, please refer to the section **"What to expect during the transition to Patent Center e-Office Action"** on this page. **There is no need to re-enroll.**

After all participant customer numbers are migrated, there will be a two-day transition period where participants may receive both a Private PAIR and Patent Center e-notification. Following the transition period, e-Office Action participants will no longer receive an e-mail from PAIR_eOfficeAction@uspto.gov. There is no change in how participants access correspondence in Patent Center and Private PAIR.

In order to ensure timely and consistent receipt of Patent Center e-Office Action notifications and alerts, please have your information technology team add the following of parameters to your email program:

- Domain Name: USPTO.gov
- Sender address: noreply@uspto.gov
- Subject: USPTO: Patent Electronic System - Correspondence Notification for Customer Number

Participants enrolled in e-Office Action can search for new correspondence listed in the daily email by selecting Workbench/Correspondence then select the "e-notifications only" filter under Correspondence method dropdown.

Please refer to the [Federal Register Notice](#) for legal guidance. An updated Quick Start Guide is available on how to manage correspondence in Patent Center.

e-Office Action Program



The new and improved Patent Center e-Office Action program is designed to notify applicants, via e-mail, when a new Office communication is available for viewing and downloading in Patent Center or in Private PAIR. Applicants who opt-in to the program will receive a daily e-mail notification that will replace the postal mailing of an Office communication. **Program participation is optional and is based on patent applications that are**

- The USPTO transitioned all users of the Private PAIR e-Office Action program to Patent Center e-Office Action by Customer Number on April 12, 2023.
- For more information, see the e-Office Action program page at <https://www.uspto.gov/patents/apply/checking-application-status/e-office-action-program>



Patent Center e-Office Action Program: e-postcard

- Participating users may currently choose between receiving a postal postcard (**no longer available as of October 20, 2023**) or an e-postcard when none of the Office communications have been viewed or downloaded in Patent Center within seven calendar days after the date of the email notification, and at least one communication requires applicant's reply.
- If a participant chooses to receive e-postcards, Patent Center sends e-postcards to the email addresses assigned to the Customer Number for the correspondence address.
 - E-postcards reduce paper waste and mitigate the impact of potential postal delays.
 - E-postcard option prompted by stakeholder feedback.

Elimination of the postal postcard in Patent Center e-Office Action Program

- In the April 5, 2023 Federal Register notice, the USPTO invited comments on eliminating the postal postcard option for all Patent Center e-Office Action users.
 - Comment period closed June 5, 2023.
- The USPTO has determined that maintaining postal postcards is not necessary. See Elimination of the Postal Postcard in the Patent Center Electronic Office Action Program, 88 FR 64889 (Sept. 20, 2023)
 - Eliminating the postal postcard will reduce paper waste and mitigate the impact of potential postal delays.

Elimination of the postal postcard in Patent Center e-Office Action Program (cont.)

- The option to receive a courtesy postal postcard under the Patent Center e-Office Action program will no longer be available as of October 20, 2023.
 - Patent Center e-Office Action program users may manually opt in to receiving e-postcards prior to that date.
- As of October 20, 2023, e-postcards will be the only option for the courtesy postcard, and the USPTO will automatically switch over any Patent Center e-Office Action program users who have not already opted in to receiving e-postcards.
- The USPTO will continue to mail postal postcards for seven days after October 20, 2023 for any unviewed correspondence in the queue as of October 20, 2023 for those program users who were receiving postal postcards prior to that date.

Recent final rules:

Standardization of the patent term adjustment (PTA) statement regarding information disclosure statements, 88 FR 39172 (June 15, 2023)

Standardization of the PTA statement regarding information disclosure statements

- This final rule revises the rules of practice to require that the PTA statement regarding information disclosure statements (IDSs) be submitted on an Office form using the appropriate document code. *See Standardization of the Patent Term Adjustment Statement Regarding Information Disclosure Statements*, 88 FR 39172 (June 15, 2023) (final rule).
 - This requirement to use the Office form and appropriate document code applies to any statement under 37 CFR 1.704(d) filed on or after July 17, 2023.

Standardization of the PTA statement regarding information disclosure statements (cont.)

- The use of the required Office form and document code will:
 - enable the PTA computer program to determine when the statement under 37 CFR 1.704(d)(1), as required for the “safe harbor” of 37 CFR 1.704(d), has been filed in the application.
 - facilitate the accurate electronic capture of a statement under 37 CFR 1.704(d)(1) by the Office's patent application data repository, which is used by the PTA computer program.
 - streamline certain aspects of prosecution by more accurately capturing and accounting for the PTA statement without unnecessary back-and-forth between the Office and applicant.
 - conserve resources by eliminating the need for a manual review of the PTA statement.

PTO/SB/133 with document code (PTA.IDS)

Doc Code: PTA.IDS
Document Description: Patent Term Adjustment Stmt Under 37 CFR 1.704(d)

PTO/SB/133 (02-23)

PATENT TERM ADJUSTMENT STATEMENT UNDER 37 CFR 1.704(d)	Application Number	
	Filing Date	
	First Named Inventor	
	Art Unit	
	Examiner Name	
	Practitioner Docket No.	

APPLICANT HEREBY STATES THE FOLLOWING (please review 37 CFR 1.704(d) before filing this form):

Each item of information contained in the information disclosure statement 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 37 CFR 1.56(c) more than thirty days prior to the filing of the information disclosure statement.

AND/OR

Each item of information contained in the information disclosure statement 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 37 CFR 1.56(c) more than thirty days prior to the filing of the information disclosure statement.

INSTRUCTIONS:

- **This form will not satisfy the requirement of 37 CFR 1.97(e).** The present statement is filed under 37 CFR 1.704(d) and will not substitute for compliance with any of the requirements of 37 CFR 1.97 and 1.98. For an information disclosure statement to comply with 37 CFR 1.97(c) or (d), the information disclosure statement must be accompanied by a statement under 37 CFR 1.97(e) notwithstanding any statement filed under 37 CFR 1.704(d).
- The present form (PTO/SB/133) should be filed concurrently with the information disclosure statement to derive benefit under 37 CFR 1.704(d).

Signature		Date	
Typed or Printed Name		Practitioner Registration Number	

Note: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature, see below.

*Total of _____ forms are submitted.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

- Applicant must use this form to make a PTA statement under 37 CFR 1.704(d)(1).
- The inclusion of document code PTA.IDS on form PTO/SB/133 satisfies the “using the appropriate document code (PTA.IDS)” requirement of 37 CFR 1.704(d)(3) for statements under 37 CFR 1.704(d)(1) not submitted via the USPTO patent electronic filing system.
- Applicants may no longer use the document code PTA.IDS for filing a statement under 37 CFR 1.704(d)(1) unless they are using form PTO/SB/133.



Use of document code PTA.IDS with form PTO/SB/133 and presentation of form PTA/SB/133 to the USPTO

- The use of the document code PTA.IDS specifically for form PTO/SB/133 is a representation that the applicant is filing form PTO/SB/133 with no alterations to the text of the form.
- The presentation to the Office (whether by signing, filing, submitting, or later advocating) of form PTO/SB/133, whether by a practitioner or non-practitioner, is a certification under 37 CFR 11.18(b) that the existing text and any certification statements on the form have not been altered.

Submission of PTA statement regarding an IDS without using Office form or the appropriate document code

- Applicants who submit a PTA statement regarding IDSs without using the Office form or the appropriate document code will need to request reconsideration of the PTA for the IDS to not be considered a failure to engage in reasonable efforts to conclude the prosecution (processing or examination) of the application.

PTA statement under 37 CFR 1.704(d) not submitted with IDS

- If an applicant submits an IDS within the 30-day period set forth in 37 CFR 1.704(d)(1) but does not include a statement under 37 CFR 1.704(d)(1) with the IDS, the applicant may consider filing a request for reconsideration under 37 CFR 1.705(b) of the PTA indicated on the patent, along with a statement under 37 CFR 1.704(d)(1) (if not previously filed) and petition under 37 CFR 1.183 requesting that the Office consider a statement under 37 CFR 1.704(d)(1) when making the PTA determination.

Petition under 37 CFR 1.183 to request acceptance of the late-filed statement under 37 CFR 1.704(d)(1)

- A petition under 37 CFR 1.183 may only be used to request acceptance of the late-filed statement under 37 CFR 1.704(d)(1).
- Under no circumstances will an IDS filed more than 30 days from the applicable communication under 37 CFR 1.704(d)(1)(i) or (ii) be treated as filed within the “safe harbor” of 37 CFR 1.704(d)(1).
- The Office will reevaluate the practice of considering such petitions under 37 CFR 1.183 now that the PTA computer program has been updated to account for the submission via Office form PTO/SB/133.
 - The Office will provide notice prior to making any changes to this procedure.

Recent final rules:

Setting and adjusting patent fees during fiscal year 2020, 88 FR 36956 (June 6, 2023)

– Update on the non-DOCX filing surcharge fee

Update on the non-DOCX filing surcharge fee

- **Requirement for a non-DOCX filing surcharge fee** (for utility nonprovisional applications filed under 35 U.S.C. 111 and submitted in a format other than DOCX (structured text)) **has been delayed until January 17, 2024.**
 - Surcharge fee prescribed in 37 CFR 1.16(u): undiscounted – \$400, small entity – \$160, micro entity – \$80
 - See “Setting and Adjusting Patent Fees During Fiscal Year 2020,” 88 FR 36956 (June 6, 2023).
 - Applicants are encouraged to begin filing patent applications in DOCX format before the new effective date of the fee.

Structured text (DOCX)

- **DOCX**
 - Is safe and stable for creating, authoring, and processing IP documents.
 - Eliminates the need to convert DOCX into a PDF for filing.
 - Is a common word processing file.
 - Is supported by most popular word processing applications.
- **Feedback document**
 - Pinpoints warnings/errors in the document.
 - Reduces examination delays.
 - Is not part of the file wrapper.
- **DOCX Information and FAQ at www.uspto.gov/patents/docx**

Paperwork Reduction Act (PRA) Clearance

- The USPTO invited public comments on a proposed information collection pertaining to the impact of the non-DOCX filing surcharge.
 - See “Agency Information Collection Activities; Submission to the Office of Management and Budget (OMB) for Review and Approval; Comment Request; DOCX Submission Requirements,” 88 FR 37039 (June 6, 2023).
 - Comment period closed August 7, 2023.
- The USPTO will submit its supporting statement for the proposed information collection, including summaries of the received comments and responses thereto, to OMB for review under the PRA.

Auxiliary PDF option

- Applicants filing in Patent Center have the option to submit an applicant-generated PDF (“Auxiliary PDF”) version of an application with the DOCX file(s).
 - See “Filing Patent Applications in DOCX Format,” 87 FR 25226 (Apr. 28, 2022).
- No additional fees incurred as a result of submitting a compliant Auxiliary PDF—e.g., application size fee.
 - Applicant must follow the process detailed in the “DOCX Auxiliary PDF QRG”, accessible from <https://www.uspto.gov/patents/docx>
- Auxiliary PDF option extended until further notice.
 - See “Extension of the Option for Submission of a PDF With a Patent Application Filed in DOCX Format,” 88 FR 37036 (June 6, 2023).

Relying on the Auxiliary PDF to correct the record

- The Auxiliary PDF may be relied upon to make a correction to the record that is not supported by the validated DOCX file(s). See 87 FR 25226 (Apr. 28, 2022).
- Applicant must file a petition under 37 CFR 1.182 accompanied by an amendment to the specification, claims, or abstract of record, unless previously submitted.
 - Amendments to the application must comply with 37 CFR 1.121.
 - The USPTO will waive the petition fee under 37 CFR 1.17(f).

Recent final rules:

Reducing patent fees for small entities and micro entities under the Unleashing American Innovators Act of 2022 (UAIA), 88 FR 17147 (March 22, 2023)

Reducing patent fees for small entities and micro entities under the UAIA

- This final rule amends the patent fees for small and micro entities set forth in its regulations to implement the provisions of the Consolidated Appropriations Act, 2023, which included the Unleashing American Innovators Act of 2022 (UAIA).
- The UAIA, signed into law on December 29, 2022, supports the USPTO's efforts to reduce the innovation ecosystem's barriers to entry.
- The UAIA increased fee discounts for small entities from 50% to 60% and fee discounts for micro entities from 75% to 80% for fees for filing, searching, examining, issuing, appealing, and maintaining patent applications and patents.
- The UAIA also increased fee discounts for small entities from 75% to 80% for filing a basic nonprovisional utility application electronically.
- The USPTO fee schedule was revised to reflect these fee discounts.



Reducing patent fees for small entities and micro entities under the UAIA (cont.)

- Because the USPTO is required to provide advance notification to the World Intellectual Property Organization (WIPO) for certain fee changes before such fee changes can take effect, the discount to certain small and micro fees were delayed until the expiration of the applicable notification period.
 - The amendments to 37 CFR 1.445(a)(2) and (a)(3) have taken effect for international applications under the Patent Cooperation Treaty having a receipt date on or after April 1, 2023.
 - The amendments to 37 CFR 1.445(a)(5) and 1.482 that apply to international applications under the Patent Cooperation Treaty took effect on April 1, 2023.
 - The amendments to 37 CFR 1.18(b)(1) will apply to international design applications under the Hague Agreement having a date of international registration on or after May 1, 2023.

Reminder of when fees are due and paid

- For patent issue fees, the fee due is the amount appearing on the Notice of Allowance and Fees Due letter (form PTOL-85).
- For other fees, the applicable fee amount is the fee amount in effect on the day the fee is paid (in full).
- The day a fee is paid is:
 - the date of receipt of the fee payment in the USPTO under 37 CFR 1.6, or
 - the date reflected on a proper certificate of mailing or transmission on the fee payment for situations where such a certificate is authorized under 37 CFR 1.8.

Recent final rules:

Establishing permanent electronic filing for patent term extension applications, 88 FR 13028 (March 2, 2023)

Establishing permanent electronic filing for patent term extension applications

- The USPTO is revising the Rules of Practice in Patent Cases to require that patent term extension (PTE) applications, interim PTE applications, and any related submissions to the USPTO be submitted electronically via the USPTO patent electronic filing system (Patent Center or EFS-Web).
- The changes are designed to streamline the filing of PTE applications and related documents and minimize paper handling, thereby making processing of such applications more efficient.



Establishing permanent electronic filing for patent term extension applications (cont.)

- PTE applications will be viewable in the USPTO patent electronic viewing systems (Patent Center or the private Patent Application Information Retrieval (PAIR) system) immediately upon filing.
- The revised Rules of Practice are effective on May 1, 2023. The final rule was published on March 2, 2023 (88 FR 13028).
- Inquiries can be sent to patentpractice@uspto.gov

Establishing permanent electronic filing for patent term extension applications (cont.)

- Beginning May 1, 2023, any application for Patent Term Extension under 35 U.S.C. 156 must be filed electronically via the USPTO Electronic Filing System.
- Any application for Patent Term Extension under 35 U.S.C. 156 means an original application under 35 U.S.C. 156(d)(1), an interim extension under 35 U.S.C. 156(d)(5) or an interim extension under 35 U.S.C. 156(e)(2).

Establishing permanent electronic filing for patent term extension applications (cont.)

In order for USPTO to effectively process requests for term extension under 35 U.S.C. 156, it is imperative that the proper document descriptions be selected:

- “Patent Term Extension Application Under 35 U.S.C. 156” (document code: TERM.REQ) is the correct document description for a PTE application under 35 U.S.C. 156(d)(1) and 37 CFR 1.740.
- “Interim Patent Term Extension Application Under 35 U.S.C. 156(d)(5)” (document code: TERM.REQ.ITM) is the correct document description for an interim PTE application under 35 U.S.C. 156(d)(5) and 37 CFR 1.790.
- “Interim Patent Term Extension Request Under 35 U.S.C. 156(e)(2)” (document code: TERM.REQ.E2) for requests for interim extension of the patent term under 35 U.S.C. 156(e)(2) and 37 CFR 1.760.



Establishing permanent electronic filing for patent term extension applications (cont.)

- In addition to initial applications, follow-on papers can be submitted electronically. For example, disclosures to the USPTO under 37 CFR 1.765 can be uploaded as “Disclosure Under 37 CFR 1.765 in a Patent Term Extension Application”(document code: TERM.PTE.DIS).
- PTE applicants are strongly encouraged to confirm correct document descriptions have been selected for any PTE submission. The Acknowledgement Receipt for the electronic filing can be reviewed to ensure the correct document descriptions were used.

Recent final rules:

Official transition to issuing electronic patent grants in 2023, 88 FR 12560 (February 28, 2023)

eGrant

- The USPTO began granting patents electronically on April 18, 2023. Final rule (88 FR 12560) published on February 28, 2023.
- The patent grant will be accessible and printable for both applicants and the public in Patent Center.
- During a transition period, the USPTO will mail a courtesy copy (Ceremonial copy) of the eGrant to the applicant that resembles today's paper patent.
- The patent may issue shortly after the payment of the issue fee. Applicant is encouraged to file continuing applications before payment of the issue fee.
- Further info may be found at <https://www.uspto.gov/patents/apply/patent-center/egrants>.

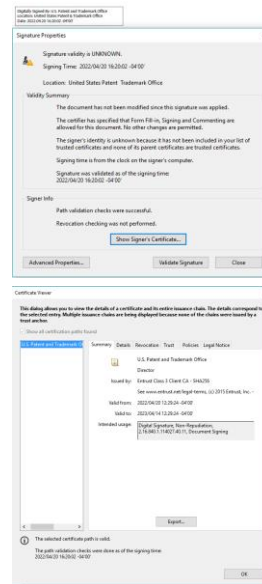


Patent eGrant front page cover sample



Digital signature to be visually represented by USPTO seal

- USPTO seal on patent eGrants represents the digital signature.
- Users can right click on the seal and see the digital signature information/details.



USPTO patent statistics and information

Fiscal year (FY) 2023 Q3 filings

- **Serialized filings +1.1%**
 - Compared to +1.7% this time last year
 - As of August 12, 2023, +0.9%
- **RCE filings -0.3%**
 - Compared to -10.3% last year
 - Less rework is a positive
 - As of August 12, 2023, -1.3%

Fiscal year (FY) 2023 Q3 filings (cont.)

- Provisional filings +1.3%
 - Compared to a -7.0% last year
- Design filings -8.7%
 - Compared to +1.3% last year
 - As of August 12, 2023, -5.6%

FY 2023 USPTO serialized filings by country of origin

- For FY 2023 through Q3, serialized UPR filings increased by 1.1%.
- Korea filings increased by 13.9%.
- Filings from China, Korea, the UK, Canada and India show an increase, while filings from Germany, Taiwan, France and Israel show a decrease.
- Japan filings have decreased by 3.1% but continue to maintain the highest number of filings outside of the United States.

Design stats (FY 2023 Q3)

- Filings decreased by 8.7%
 - Compared to increase of 1.4% in FY 2022 Q3
- Pendency
 - First action pendency is 17.7 months
 - 17.4 months this time last year
 - Total pendency 21.2 months
 - slight increase from 20.2 this time last year
- Inventory
 - Increased 2.7% year-over-year

Patent Term Adjustment (PTA) performance

PTA Category	PTA Compliance - Mailed Actions	PTA Compliance - Remaining Inventory
First Actions (14 months)	41%	62%
Response to amendment (4 months)	97%	97%
Response to RCE (4 months)	91%	89%
Response to PTAB decision (4 months)	99%	100%
Patent grant after issue fee (4 months)	99%	98%
Total time pending (36 months)	81%	95%
Overall Compliance	81%	83%

Patent Trial and Appeal Board (PTAB) results (FY 2023 Q3) – *Ex parte* appeal

- *Ex parte* appeal
 - Overall affirmance rate of 58% for FY 2023
 - Increased from 56% in FY 2022 Q3
 - Additional 9% affirmed-in-part
 - 9% in FY 2022 Q3

FY 2023 complete statistics

- See patent data visualization center webpage (dashboard) at:
 - <https://www.uspto.gov/dashboard/patents/>

