Chapter 1300 Allowance and Issue

1301 Substantially Allowable Application, Special

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

1302 Final Review and Preparation for Issue

1302.01 General Review of Disclosure

When an application is apparently ready for allowance, it should be reviewed by the examiner to make certain that the whole application meets all formal and substantive (i.e., statutory) requirements and that the language of the claims is enabled by, and finds adequate descriptive support in, the application disclosure as originally filed. Neglect to give due attention to these matters may lead to confusion as to the scope of the patent.

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

¶ 13.07 Disclosure To Be Limited to Claimed Invention

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

Examiner Note:

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

¶ 13.08 Disclosed Subject Matter Outside the Bounds of the Claims

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

There should be clear support or antecedent basis in the specification for the terminology used in the claims. Usually, the original claims follow the nomenclature of the specification; but sometimes in amending the claims or in adding new claims, applicant employs terms that do not appear in the specification. This may result in uncertainty as to the interpretation to be given such terms. See MPEP § 608.01(o). It should be noted, however, that exact terms need not be used *in haec verba* to satisfy the written description requirement of the first paragraph of 35 U.S.C. 112. *Eiselstein v. Frank*, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995); *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976). See also 37 CFR 1.121(a)(5) which merely requires *substantial* correspondence between the language of the claims and the language of the specification.

Where a copending application is referred to in the specification, the examiner should ascertain whether it has matured into a patent or has become abandoned, and "now abandoned" or the patent number should be added to the specification.

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

The abstract should be checked for an adequate and clear statement of the disclosed invention. See MPEP § 608.01(b). The length of the abstract should be limited to 250 words.

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

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

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

1302.02 Requirement for a Rewritten Specification

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

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

¶ 13.01 Requirement for Rewritten Specification

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

Examiner Note:

1. Specific discussion of the sections of the specification or claims required to be rewritten must be set forth.
2. See form paragraph 6.28.01 for a substitute specification.

1302.03 Notice of Allowability

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

In *all* instances, both before and after final rejection, in which an application is placed in condition for allowance, applicant should be notified promptly of allowability of the claims by a Notice of Allowability PTOL-37. If delays in processing the Notice of Allowability are expected, e.g., because an extensive examiner's amendment must be entered, and the end of a statutory period for reply is near, the examiner should notify applicant by way of an interview that the application has been placed in condition for allowance, and an Interview Summary PTO-413 should be mailed. Prompt notice to applicant is important because it may avoid an unnecessary appeal and act as a safeguard against a holding of abandonment.

1302.04 Examiner's Amendments and Changes [R-1]

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

Correction of the following obvious errors and omissions only may be made with pen by the examiner of the application who will then initial the sheet margin and assume full responsibility for the change:

(A) Misspelled words.

(B) Disagreement of a noun with its verb.

(C) Inconsistent "case" of a pronoun.

(D) Disagreement between a reference character as used in the description and on the drawing. The character may be corrected in the description but only when the examiner is certain of the propriety of the change.

(E) Entry of "Patent No. ....." to identify a patent which has been granted on a U.S. application referred to by application number in the specification.

(F) Entry of "abandoned" if a U.S. patent application referred to by application number in the specification has become abandoned.

(G) Correction of reversed figure numbers. *Garrett v. Cox,* 233 F.2d 343, 345, 110 USPQ 52, 54 (CCPA 1956).

(H) Other obvious minor grammatical errors such as misplaced or omitted commas, improper parentheses, quotation marks, etc.

(I) Obvious informalities in the application, other than the ones noted above, or of purely grammatical nature.

Where a reference to the parent application in an otherwise allowable application filed under 37 CFR 1.53(b) or former 37 CFR 1.60 or 1.62 has inadvertently been omitted by the applicant, the examiner should insert the required reference by examiner's amendment (see MPEP § 201.11). Note that the specification of an application filed under 37 CFR 1.53(d) should not contain a reference to the parent application. See MPEP § 201.06(d).

When correcting *originally filed* papers, clean red ink *must* be used (not blue or black ink).

Other obvious informalities in the application may be corrected by the examiner, but such corrections must be by a formal examiner's amendment, signed by the primary examiner, placed in the file, and a copy sent to the applicant. The changes specified in the amendment are entered by the technical support staff in the regular way. An examiner's amendment should include Form Paragraph 13.02 and Form Paragraph 13.02.01. Form Paragraph 13.02.02 should be used if an extension of time is required.

¶ 13.02 Examiner's Amendment

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

Examiner Note:

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

¶ 13.02.01 Examiner's Amendment Authorized

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

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

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

Examiner Note:

See MPEP 706.07(f), item 10 which explains when an extension of time is needed in order to make amendments to place the application in condition for allowance.

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

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

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

Further identifying data, if deemed necessary and requested by the attorney, should also be included in the examiner's amendment.

For example, Form Paragraph 13.06 may be used to charge an extension of time fee in an examiner's amendment.

¶ 13.06 Extension of Time by Examiner's Amendment

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

Examiner Note:

1. See MPEP § 706.07(f), item 10 which explains when an extension of time is needed in order to make amendments to place the application in condition for allowance.
2. When an examiner's amendment is also authorized, use form paragraph 13.02.02 instead.

A change in the abstract may be made by examiner's amendment.

The fact that applicant is entitled to an earlier U.S. effective filing date under 35 U.S.C. 120, 121, or 365(c) or 35 U.S.C. 119(e) is sometimes overlooked. To minimize this possibility, the statement that, "This is a division (continuation, continuation-in-part) of Application Number -/---

, filed ---" should appear as the first sentence of the description of applications >other than CPAs< claiming priority under 35 U.S.C. 120, except in the case of design applications where it should appear as set forth in MPEP § 1503.01. >The request for a CPA filed under 37 CFR 1.53(d) is itself the specific reference, as required by 35 U.S.C. 120 and 37 CFR 1.78(a)(2), to every application assigned the same application number identified in the request. In the case of an application filed under 37 CFR 1.53(b) as a division, continuation or continuation-in-part of a CPA, there would be only one reference to the series of applications assigned the same application number with the filing date cited being that of the original non-continued application.< In applications claiming priority under 35 U.S.C. 119(e), a statement such as "This application claims the benefit of U.S. Provisional Application No. 60/ - --, filed - --" should appear as the first sentence of the description. In addition, for an application which is claiming the benefit under 35 U.S.C. 120 of a prior application which in turn claims the benefit of a provisional application under 35 U.S.C. 119(e), a suitable reference would read, "This application is a continuation of U.S. Application No. 08/ - --, filed - --, now abandoned, which claims the benefit of U.S. Provisional Application No. 60/ - --, filed - --." The status (whether patented or abandoned) of the nonprovisional application(s) for which priority is claimed should also be included. Any such statements appearing elsewhere in the specification should be relocated. The technical support staff indicates the change for the printer in the appropriate margin when checking new applications for matters of form.

References cited as being of interest by examiners when passing an application to issue will not be supplied to applicant. The references will be cited as usual on form PTO-892, a copy of which will be attached to the Notice of Allowability, form PTOL-37.

Where an application is ready for issue except for a slight defect in the drawing not involving a change in structure, the examiner will prepare a letter indicating the change to be made and note in pencil on the drawing the addition or alteration to be made. See MPEP § 608.02(w).

No other changes may be made by any person in any record of the Patent and Trademark office without the written approval of the Commissioner of Patents and Trademarks.

In reviewing the application, all errors should be carefully noted. It is not necessary that the language be the best; it is, however, essential that it be clear in meaning, and free from errors in syntax. Any necessary examiner's amendment is usually made at the time an application is being prepared for issue by the examiner. However, the need for such may not be noted until after the proof of the patent is read and the application is sent to the examiner with a "printer waiting" slip (form PTO-97). A copy of any formal examiner's amendment is sent to applicant even if the application is already in the printer's hands. See MPEP § 1309.02.

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

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

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

1302.04(a) Title of Invention

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

1302.04(b) Cancellation of Nonstatutory Claim

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

1302.04(c) Cancellation of Claims to Nonelected Invention

See MPEP § 821.01 and § 821.02.

1302.04(d) Cancellation of Claim Lost in Interference

See MPEP § 2363.03.

1302.04(e) Cancellation of Rejected Claims Following Appeal

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

1302.04(f) Data of Copending Application Referred to Should Be Brought Up-to-Date

Where a patent application which is ready for issue refers by application number to a U.S. nonprovisional application which has matured into a patent, the examiner is authorized to enter the patent number without a formal examiner's amendment. This entry should be in the following form: ", Patent No. .....". The entry is to be initialed and dated in the margin by the examiner to fix responsibility for the same. The entry and the initials should be in red ink.

If the nonprovisional application referred to has become abandoned, the entry "abandoned" should be made in red ink, and initialed and dated by the examiner in the margin. A formal examiner's amendment is not required.

1302.04(g) Identification of Claims

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

1302.05 Correction of Drawing [R-1]

Where an application otherwise ready for issue requires correction of the drawing, **>the application is processed for allowance in the Examining Group and then forwarded to the Publishing Division. Any papers subsequently filed by the applicant, including corrected drawings, are forwarded to the Publishing Division in order to be matched with the application file.<

1302.05(a) Original Drawings Cannot Be Located

When the original drawings cannot be located and the application is otherwise in condition for allowance, no "Official Search" need be undertaken. The Examining Group should check its own area and attempt to obtain the drawing from abandoned files. If the drawing cannot be located, a yellow tag should be placed on the application to flag it as having a drawing problem. A memorandum as outlined below should be stapled to the outside of the file when forwarding it to the Publishing Division.

Memorandum

Application No._____

Date forwarded_____

ATTENTION PUBLISHING DIVISION, DRAWING MISSING

I have attempted to locate the drawing in this application without success. The drawing cannot be located in the Examining Group. (The drawing cannot be obtained from Abandoned Files.)

Print O.G. Fig_____

Class_____

Subclass_____

1302.06 Prior Foreign Application

See MPEP § 201.14(c) and § 202.03.

1302.07 Use of Retention Labels To Preserve Abandoned Companion Applications

Related applications referred to in patent specifications are preserved from destruction by a retention label (form PTO-150) which is attached to the outside of the file wrapper. The technical support staff of the group prepares such a label for use as indicated below on each application (which has not become a patent) which is referred to in the specification or oath or declaration of the application ready for allowance (or in any Office letter therein).

If the application referred to is:

(A) Still pending: Fill in and paste label on the face of the pending file wrapper in the space provided. Make no change in specification of the allowable application.

(B) Abandoned for failure to pay issue fee: If file has been forwarded to Files Repository, fill in label and send it to Files Repository for attachment to the wrapper. If not forwarded, treat the same as pending case.

(C) Abandoned: If file has been forwarded to the Files Repository, fill in label and send it to Files Repository for attachment to the wrapper. If not forwarded, treat the same as pending case. Add "abandoned" in red ink and initials to the allowable application.

(D) Already patented: No label is required. Insert patent number in specification if not already present. Formal examiner's amendment not necessary if this is only change.

(E) In issue: Fill in label. Make no change in the specification of the allowable application.

Examiners are reminded that only one retention label is necessary. Thus, if a retention label is already present, it is sufficient to merely add "et al." to the application number cited thereon.

1302.08 Interference Search

Assuming that the application is found ready for issue, the examiner makes an interference search and notes the date and class and subclasses searched in the file wrapper. To do this, the examiner inspects all the pending prints and drawings (or all the claims if the invention is not susceptible of illustration) in the interference files of the relevant subclasses of the class in which the application is classified, and all other pertinent classes, whether in his or her group or elsewhere, in order to ascertain whether any other applicant is claiming substantially the same subject matter as is being allowed in the case in hand. When any of the drawings or claims shows such a condition to be likely, the corresponding file is reviewed.

Note also MPEP § 2301.01(b).

If the search does not disclose any interfering application, the examiner should prepare the application for issue.

An interference search may be required in Group 3640. Inspection of pertinent prints, drawings, brief cards, and applications in Group 3640 will be done on request by an examiner in Group 3640.

1302.09 Notations on File Wrapper [R-1]

The examiner preparing the application for issue fills out, in black ink, the appropriate spaces on the face of the file wrapper.

To aid the Publishing Division and the printers, examiners should write the class and subclass on the outside of the file wrapper as carefully and legibly as possible. Each numeral should be distinct and any decimal point should be shown clearly and in its proper position.

Spaces are provided on the file wrapper label or PALM bib-data sheet for identifying data of a prior abandoned application for which the instant application is a substitute, and of parent application(s) and prior provisional and foreign application(s). Examiners must review the data regarding prior U.S. applications to make sure that the information is correct when preparing the application for issue. If any claim to priority under 35 U.S.C. 120, 121, or 365(c) is added, deleted, and/or modified during prosecution of the application and such addition, deletion, and/or modification has been approved, the examiner must make sure that the information on the file wrapper label or PALM bib-data sheet and in the PALM data base are current and up to date. If the PALM system has not been updated, the application must be forwarded to Office of Initial Patent Examination Customer Corrections, accompanied by a completed Application Branch Data Base Routing Slip, with an explanation of the correction to be made. Examiners should also review the data regarding prior provisional and foreign applications for accuracy.

The class and subclass and the name of the examiner which are written in pencil on the file wrapper should correspond to the class and subclass in which the patent will issue and to the name of the examiner preparing the application for issue.

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

See MPEP § 202.03 for notation as to foreign patent application to be placed on file wrapper.

See MPEP § 1302.13 for name of examiner.

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

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

(A) The broadest claim should be selected.

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

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

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

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

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

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

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

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

Ordinarily a single figure is selected for printing. This figure should be consistent with the claim to be printed in the *Official Gazette*. The figure to be printed in the *Official Gazette* must not be one that is labeled "prior art." If there is no figure illustrative of or helpful in understanding the

claimed invention, no figure need be selected. "None" may be written in the box labeled "**Print Fig**." on the face of the file wrapper.<

1302.10 ** Issue Classification * >Notations< [R-1]

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See MPEP § 903.07, § 903.07(b) and § 903.09 for notations to be applied **>in the issuing classification boxes on the face of the file wrapper, or on the blue issue classification slip for series 08/ and earlier applications<.

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

1302.11 Reference to Assignment Division

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

1302.12 Listing of References

All references which have been cited by the examiner during the prosecution, including those appearing in Board of Patent Appeals and Interferences decisions or listed in the reissue oath, must be listed on either a form PTO-892 or PTO-1449. All such reference citations will be printed in the patent.

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

When preparing an application for allowance, the technical support staff will verify that there is at least one list of references (PTO-892 or PTO-1449) in the application. All lists of references are maintained in the center section of the file wrapper.

In the first action after termination of an interference, the examiner should make of record in each application all references not already of record which were pertinent to any preliminary motions and which were discussed in the decision on motion.

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

Any new reference cited when the application is in issue, under the practice of MPEP § 1308.01, should be added by way of a PTO-892 or PTO-1449.

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

1302.13 Signing

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

Only the names of the primary examiner and the assistant examiner appearing on the face of the application file wrapper will be listed in the printed patent.

1302.14 Reasons for Allowance

37 CFR 1.104. Nature of examination.

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

REASONS FOR ALLOWANCE

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

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

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

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

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

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

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

Where specific reasons are recorded by the examiner, care must be taken to ensure that such reasons are accurate, precise, and do not place unwarranted interpretations, whether broad or narrow, upon the claims. The examiner should keep in mind the possible misinterpretations of his or her statement that may be made and its possible estoppel effects. Each statement should include at least (1) the major difference in the claims not found in the prior art of record, and (2) the reasons why that difference is considered to define patentably over the prior art if either of these reasons for allowance is not clear in the record. The statement is not intended to necessarily state all the reasons for allowance or all the details why claims are allowed and should not be written to specifically or impliedly state that all the reasons for allowance are set forth.

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

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

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

(1) When the arguments are presented in an appeal brief.

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

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

(B) First action issue:

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

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

(C) Withdrawal of a rejection for reasons not suggested by applicant, for example:

(1) As a result of an appeal conference.

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

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

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

(E) Allowance coincident with the citation of newly found references that are very close to the claims, but claims are considered patentable thereover:

(1) When reference is found and cited (but not argued) by applicant.

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

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

(G) Allowance based on a claim interpretation which might not be readily apparent, for example:

(1) Article claims in which method limitations impart patentability.

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

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

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

(H) Allowance following decision by the United States Court of Appeals for the Federal Circuit or District Court of the District of Columbia.

The reasons for allowance should refer to and incorporate the briefs and the court decision.

EXAMPLES OF STATEMENTS OF SUITABLE CONTENT

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

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

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

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

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

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

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

EXAMPLES OF STATEMENTS THAT ARE NOT SUITABLE AS TO CONTENT

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

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

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

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

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

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

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

Most instances when the examiner finds a need to place in the file a statement of the reasons for allowing a claim or claims will come at the time of allowance. In such cases, the examiner should (a) check the appropriate box on the form PTOL-37 and (b) attach thereto a paper containing the examiner's statement of reasons for allowance. Such a statement should be typewritten. The paper should identify the application number and be clearly labeled "Statement of Reasons for Allowance." It should also specify that comments may be filed by the applicant on the statement and should preferably be submitted with the payment

of the issue fee so as not to delay processing of the application and in any event no later than payment of the issue fee.

Form Paragraph 13.03 may be used for this purpose.

¶ 13.03 Reasons for Allowance

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

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

Examiner Note:

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

Such comments will be entered in the application file by the Allowed Files Correspondence Branch with an appropriate notation on the "Contents" list on the file wrapper.

A statement may be sent to applicant with other communications, where appropriate, but should be clearly labeled as a "Statement of Reasons for Allowance" and contain the data indicated above. Examiners are expected to prepare any statement of their reasons for allowance (or indication of allowable subject matter) accurately and precisely so as not to place unwarranted interpretations, whether broad or narrow, on the claims. Where the examiner has a large number of reasons for allowing a claim, it may suffice to state only the major or important reasons, being careful to so couch the statement. For example, a statement might start: "The primary reason for the allowance of the claims is the inclusion of the limitation ..... in all the claims which is not found in the prior art references," with further amplification as necessary.

Stock paragraphs with meaningless or uninformative statements of the reasons for the allowance should not be used. The statement of reasons for allowance by the examiner is intended to provide information equivalent to that contained in a file in which the examiner's Office actions and the applicant's replies make evident the examiner's reasons for allowing claims.

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

Finally, comments made by applicants on the examiner's statement of reasons for allowance will not be returned to the examiner after their entry in the file and will not be commented upon by the examiner.

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

¶ 13.03.01 Reasons for Indication of Allowable Subject Matter

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

Examiner Note:

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

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

1303 Notice of Allowance

37 CFR 1.311. Notice of Allowance.

(a) If, on examination, it shall appear that the applicant is entitled to a patent under the law, a notice of allowance will be sent to applicant at the correspondence address indicated in § 1.33, calling for the payment of a specified sum constituting the issue fee (§ 1.18), which shall be paid within three months from the date of the mailing of the notice of allowance.

(b) An authorization to charge the issue fee (§ 1.18) to a deposit account may be filed in an individual application, either before or after mailing of the notice of allowance. Where an authorization to charge the issue fee to a deposit account has been filed before the mailing of the notice of allowance, the issue fee will be automatically charged to the deposit account at the time of mailing the notice of allowance.

A Notice of Allowance is prepared and mailed, and the mailing date appearing thereon is recorded on the file wrapper.

1303.01 Amendment Received After Allowance [R-1]

If the amendment is filed under 37 CFR 1.312, see MPEP § 714.15 to § 714.16(e). If the amendment contains claims copied from a patent, see MPEP § 2307.03.

ISSUE BATCH NUMBER

All papers filed by applicant in the Office after receiving the Notice of Allowance and before the time the Issue ** >Notification< is received should include >at least the Application number, the name of the first named inventor and< the Issue Batch Number. The Issue Batch Number is printed on the Notice of Allowance form. The Issue Batch Number consists of a capital letter followed by two digits, for example, "A03", "D18", "F42" or "J79". **

Any paper filed after receiving the Issue ** >Notification< should include the indicated patent number rather than the Issue Batch Number. **

1303.02 Undelivered

In case a Notice of Allowance is returned, and a new notice is sent (see MPEP § 707.13), the date of sending the notice must be changed in the file to agree with the date of such remailing.

1303.03 Not Withheld Due to Death of Inventor

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

1304 Amendments After D-10 Notice

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

1304.01 Withholding From Issue of "Secrecy Order" Applications

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

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

1305 Jurisdiction

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

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

Once the patent has been granted, the Patent and Trademark Office can take no action concerning it, except as provided in 35 U.S.C. 135 and 35 U.S.C. 251 through 256 and 35 U.S.C. 302 through 307.

1306 Issue Fee [R-1]

The issue fee is due 3 months from the date of the Notice of Allowance. The amount of the issue fee is shown on the Notice of Allowance. However, because the amount of the issue fee due is determined by the fees set forth in 37 CFR 1.18 which are in effect as of the date of submission of payment of the issue fee, the amount due may differ from the amount indicated on the Notice of Allowance. Accordingly, applicants are encouraged, at the time of submitting payment of the issue fee, to determine whether the amount of the issue fee due has changed. The amounts due under 35 U.S.C. 41(a) are reduced by 50 per centum for small entities.

Applicants and their attorneys or agents are urged to use the special fee transmittal form (PTOL-85B) provided with the Notice of Allowance when submitting their payments. >The PTOL-85B, the issue fee, and all post allowance correspondence should be addressed using the mailing address labels provided with the PTOL-85, "Notice of Allowance and Issue Fee Due." If mailing address labels were not provided, all post allowance correspondence should be addressed "Box Issue Fee."<

The payment of the issue fee due may be simplified by using a Patent and Trademark Office Deposit Account for such a fee. However, any such payment must be specifically authorized by reference to the "issue fee" or "fees due under 37 CFR 1.18."

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

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

1306.01 Deferring Issuance of a Patent

37 CFR 1.314. Issuance of patent.

If payment of the issue fee is timely made, the patent will issue in regular course unless the application is withdrawn from issue (§ 1.313), or issuance of the patent is deferred. Any petition by the applicant requesting a deferral of the issuance of a patent must be accompanied by the fee set forth in § 1.17(i) and must include a showing of good and sufficient reasons why it is necessary to defer issuance of the patent.

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

A petition to defer issuance of a patent is not appropriate until the issue fee is paid. Issuance of a patent cannot be deferred after an allowed application receives a patent number and issue date unless the application is withdrawn from issue under 37 CFR 1.313(b). The petition to defer is considered at the time the petition is correlated with the application file before the appropriate deciding official (MPEP § 1002.02(b)). In order to facilitate consideration of

a petition for deferment of issue, the petition should be firmly attached to the Issue Fee Transmittal form (PTOL-85B) and clearly labeled as a Petition to Defer Issue; Attention: Office of the Assistant Commissioner for Patents.

1306.02 Simultaneous Issuance of Patents

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

Applicants and their attorneys who desire the simultaneous issue of allowed applications must submit the request to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, Attention: Office of Patent Publication.

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

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

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

1306.03 Practice After Payment of Issue Fee [R-1]

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

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

In order to minimize disruptions and delays in the printing process, the application is **not** available after the Notice of Allowance has been mailed unless necessary for examination. Corrected filing receipts will not be mailed after the date of mailing of the Notice of Allowance unless special circumstances exist. Duplicate filing of papers is not recommended. The same correspondence should not be mailed and faxed to the Office unless the duplication has been specifically required by the Office. See MPEP § 719.01(a).<

1307 Change in Classification of Cases Which Are in Issue

See MPEP § 903.07.

1308 Withdrawal From Issue [R-1]

37 CFR 1.313. Withdrawal from issue.

(a) Applications may be withdrawn from issue for further action at the initiative of the Office or upon petition by the applicant. Any such petition by the applicant must include a showing of good and sufficient reasons why withdrawal of the application is necessary and, if the reason for the withdrawal is not the fault of the Office, must be accompanied by the fee set forth in § 1.17(i). If the application is withdrawn from issue, a new notice of allowance will be sent if the application is again allowed. Any amendment accompanying a petition to withdraw an application from issue must comply with the requirements of § 1.312.

(b) When the issue fee has been paid, the application will not be withdrawn from issue for any reason except:

(1) A mistake on the part of the Office;
(2) A violation of § 1.56 or illegality in the application;
(3) Unpatentability of one or more claims;
(4) For interference; or
(5) For abandonment to permit consideration of an information disclosure statement under § 1.97 in a continuing application.

>WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE APPLICANT<

If the applicant wishes to have an application withdrawn from issue, he or she must petition the Commissioner. Once the issue fee is paid withdrawal is permitted only for the reasons stated in 37 CFR 1.313(b). The status of the application at the time the petition is filed is determinative of whether the petition is considered under 37 CFR 1.313(a) or 37 CFR 1.313(b). Petitions to have an application withdrawn from issue before payment of the issue fee should be directed to the Group Director of the examining group to which the application is assigned (see MPEP § 1002.02(c)). Petitions to have an application withdrawn after payment of the issue fee should be directed to the ** >Office of Petitions (see MPEP § 1002.02(b))< .

In addition to the specific reasons identified in 37 CFR 1.313(b)(1)-(4), applicant should be able to identify some specific and significant defect in the allowed application before the application will be withdrawn from issue. It is the policy of the Patent and Trademark Office to permit an application to be withdrawn from issue under 37 CFR 1.313(a) to file a continuing application, unless the application to be withdrawn is itself a continuing application. This

policy does not affect applicant's right and ability to file a continuing application on or before the last day the issue fee is due and permit the parent application to become abandoned for failure to pay the issue fee (35 U.S.C. 151).

>Any petition filed under 37 CFR 1.313(b) to withdraw an application from issue after payment of the issue fee should be clearly marked "Petition under 37 CFR 1.313(b)" and be either submitted by facsimile or hand-carried to the Office of Petitions (see MPEP § 1730 for the facsimile number and location).<

For withdrawal from issue pursuant to 37 CFR 1.313(b)(5), see the discussion in MPEP § 609, paragraph B(4).

Unless applicant receives a written communication from the Office that the application has been withdrawn from issue, the issue fee must be timely submitted to avoid abandonment.

>WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE

The Commissioner may withdraw an application from issue under 37 CFR 1.313 on his or her own initiative. See *Harley v. Lehman*, 981 F. Supp. 9, 12, 44 USPQ2d 1699, 1702 (D.D.C. 1997)(adoption of 37 CFR 1.313(b) permitting applications to be withdrawn from issue under certain narrow circumstances not directly covered by the statute was not unreasonable). 35 U.S.C. 151 provides that upon payment of the issue fee, "the patent shall issue." Thus, an application cannot be withdrawn from issue after payment of the issue fee consistent with 35 U.S.C. 151 unless there has been a determination that at least one of the conditions specified at 37 CFR 1.313(b)(1) through (5) exist such that the applicant is no longer "entitled to a patent under the law" as provided in 35 U.S.C. 151. See *Harley v. Lehman*, 981 F. Supp. at 11-12, 44 USPQ2d at 1701-02 (D.D.C. 1997)(Commissioner may adopt rules permitting applications to be withdrawn from issue after payment of the issue fee in situations in which the applicant is not entitled to a patent under the law); and see *Sampson v. Dann*, 466 F. Supp. 965, 973-74, 201 USPQ 15, 22 (D.D.C. 1978)(Commissioner not authorized to withdraw an application from issue after payment of the issue fee on an *ad hoc* basis, but only in situations which meet the conditions of 37 CFR 1.313(b)).

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

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

(1) a mistake on the part of the Office;

(2) a violation of 37 CFR 1.56 or illegality in the application;

(3) unpatentability of one or more claims;

(4) for interference; or

(5) for abandonment to permit consideration of an information disclosure statement under 37 CFR 1.97 in an already filed continuing application.

See 37 CFR 1.313(b).

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

(A) to permit the examiner to consider an information disclosure statement;

(B) to permit the examiner to consider whether one or more claims are unpatentable; or

(C) to permit the applicant to file a continuing application (including a CPA).

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

Any notice withdrawing an application from issue after payment of the issue fee must specify which of the conditions set forth in 37 CFR 1.313(b)(1) through (5) exists and thus warrants withdrawal of the application from issue. Any petition under 37 CFR 1.181 to review the decision of a Group Director to withdraw an application from issue after payment of the issue fee will be decided by the Deputy Assistant Commissioner for Patent Policy and Projects.

Procedure to be followed when an application is withdrawn from issue

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

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

1. Withdrawal From Issue Before Payment of Issue Fee

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

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

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

(C) Stick an Issue Information Label (Form 2016) on the file wrapper over the filled in boxes on the file wrapper that contain issue information.

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

¶ 10.01 Withdrawal From Issue, Fee Not Paid

Paper No. **[1]**

In re Application of **[2]** :
Appl. No.: **[3]**: : **WITHDRAWAL FROM ISSUE**
Filed: **[4]** : *37 CFR 1.313*
For: **[5]** :

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

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

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

The application is being forwarded to the examiner for action.

_____

[6]
Director,
Patent Examining Group **[7]**
[8]

Examiner Note:
1. This letter is printed with the PTO letterhead and must be signed by the Group Director.
2. Do NOT use this form letter if the issue fee has been paid. Use form paragraph 10.02 if the issue fee has been paid.
3. In bracket 8, insert the correspondence address of record.

2. Withdrawal From Issue After Payment of Issue Fee

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

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

(B) If the application has been assigned a patent number and issue date:

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

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

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

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

(D) Stick an Issue Information Label (Form 2016) on the file wrapper over the filled-in boxes on the file wrapper that contain issue information.

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

1308.01 Rejection After Allowance

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

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

If the request to withdraw from issue is approved, the letter is taken to the Publishing Division and the application is stamped "Withdrawn" over the name stamp and initials of the primary examiner. It is then returned to the group from which it came; the withdrawal from issue is entered on the PALM system, and the application is thus restored to its former status as a pending application awaiting action by the examiner. The examiner at once prepares an Office action stating that the application has been withdrawn from issue, citing the new reference, and rejecting the claims met thereby.

The action is given a paper number and placed in the file.

If the issue fee has already been paid and prosecution is reopened, the applicant may request a refund or request that the fee be credited to a deposit account. However, applicant may wait until the application is either found allowable or held abandoned. If allowed, upon receipt of a new Notice of Allowance, applicant may request that the previously submitted issue fee be applied. If abandoned, applicant may request refund or credit to a deposit account.

If the issue fee has been paid, the examiner should forward the request to withdraw the application from issue to the Office of Patent Publication after the request is approved by the Group Director. The actual withdrawal will be handled by the Office of Patent Publication and then the application will be returned to the examiner for prompt action as noted above.

1308.02 For Interference Purposes

It may be necessary to withdraw a case from issue for reasons connected with an interference. For the procedure to be followed, see MPEP § 2305.04 and § 2307.03.

1308.03 Quality Review Program for Examined Patent Applications

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

The quality review is conducted by Patentability Review Examiners on a randomly selected sample of allowed applications from each Art Unit. The sample is computer generated under the office-wide computer system (PALM), which selects a predetermined number of allowed applications from each Art Unit per year for review only, and which selects from each Art Unit's sample a sub-sample of allowed applications for both review and full re-search. The only applications excluded from the sample are those in which there has been a decision by the Board of Patent Appeals and Interferences, or by a court.

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

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

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

¶ 13.04 Reopen Prosecution - After Notice of Allowance

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

[2]

Examiner Note:

1. This paragraph should be used when a rejection is made on any previously allowed claim(s) which for one reason or another is considered unpatentable after the Notice of Allowance (PTOL-85) has been mailed.
2. Make appropriate rejection(s) as in any other action.
3. In bracket 1, identify claim(s) that are considered unpatentable.
4. In bracket 2, state all appropriate rejections for each claim considered unpatentable.

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

¶ 13.05 Reopen Prosecution - Vacate Notice of Allowance

Applicant is advised that the Notice of Allowance mailed **[1]** is vacated. If the issue fee has already been paid, applicant may request a refund or request that the fee be credited to a deposit account. However, applicant may wait until the application is either found allowable or held

abandoned. If allowed, upon receipt of a new Notice of Allowance, applicant may request that the previously submitted issue fee be applied. If abandoned, applicant may request refund or credit to a specified Deposit Account.

Examiner Note:

1. This paragraph must be used when the prosecution is reopened after the mailing of the Notice of Allowance.
2. In bracket 1, insert date of the Notice of Allowance.

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

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

1309 Issue of Patent [R-1]

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>Under the current publication process, electronic capture of most of the information to be printed in a patent will begin as soon as an allowed application is received in the Office of Patent Publication, immediately after the Notice of Allowance has been mailed. The Office of Patent Publication forwards the allowed applications to the printer for Initial Data Capture (IDC). This IDC process takes approximately three weeks to accomplish and during this time the application is **not** available to examiners. However, in case of an emergency situation, an application may be requested through the Technology Center Group Director's office. After IDC is completed, the application is returned to the Office of Patent Publication.

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

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

(A) Allowed cases which were made special by the Commissioner (including those under the Special Examining Procedure).

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

(C) Allowed reissue applications.

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

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

**

To ensure that any application falling within the scope of the categories outlined above and identified by (A) to (E) receives special treatment, the examiner should staple on the file wrapper a tag entitled "Special in Publishing Division." The special tag, PTO-1101, may be obtained from the technical support staff. The examiner shall print directly on the tag the recitation "In Publishing Division" and the appropriate printing category outlined above. The application is then forwarded to Publishing Division.

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35 U.S.C. 2. Seal.

The Patent and Trademark Office shall have a seal with which letters patent, certificates of trademark registrations, and papers issued from the Office shall be authenticated.

35 U.S.C. 153. How issued.

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

PRINTING NAMES OF PRACTITIONERS AND FIRM ON PATENTS

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

form should be left blank. If no name is listed on the form, no name will be printed on the patent.

ASSIGNMENT PRINTED ON PATENT

The Issue Fee Transmittal form portion (PTOL -85B) of the Notice of Allowance provides a space (item 3) for assignment data which should be completed in order to comply with 37 CFR 3.81. Unless an assignee's name and address are identified in item 3 of the Issue Fee Transmittal form PTOL-85B, the patent will issue to the applicant. Assignment data printed on the patent will be based solely on the information so supplied. See MPEP § 307.

ASSIGNEE NAMES

Only the first appearing name of an assignee will be printed on the patent where multiple names for the *same* party are identified on the Issue Fee Transmittal form, PTOL-85B. Such multiple names may occur when both a legal name and an "also known as" or "doing business as" name is also included. This printing practice will not, however, affect the practice of recording assignments with the Office in the Assignment Division. The assignee entry on form PTOL-85B should still be completed to indicate the assignment data as recorded in the Office. For example, the assignment filed in the Office and therefore the PTOL-85B assignee entry might read "Smith Company doing business as (d.b.a.) Jones Company." The assignee entry on the printed patent will read "Smith Company."

Various officials including the manager of the Publishing Division have been designated as attesting officers to attest to the name of the Commissioner. The assistant manager of the Publishing Division acts as attesting officer in the absence or unavailability of the manager of the Division.

1309.01 Patent Terms and Extensions [R-1]

35 U.S.C. 154. Contents and term of patent.

(a) IN GENERAL.—

(1) CONTENTS.—Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, of the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States, and, if the invention is a process, of the right to exclude others from using, offering for sale or selling throughout the United States, or importing into the United States, products made by that process, referring to the specification for the particulars thereof.

(2) TERM.—Subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under section 120, 121, or 365(c) of this title, from the date on which the earliest such application was filed.

(3) PRIORITY.—Priority under section 119, 365(a), or 365(b) of this title shall not be taken into account in determining the term of a patent.

(4) SPECIFICATION AND DRAWING.—A copy of the specification and drawing shall be annexed to the patent and be a part of such patent.

(b) TERM EXTENSION.—

(1) INTERFERENCE DELAY OR SECRECY ORDERS.—If the issue of an original patent is delayed due to a proceeding under section 135(a) of this title, or because the application for patent is placed under an order pursuant to section 181 of this title, the term of the patent shall be extended for the period of delay, but in no case more than 5 years.

(2) EXTENSION FOR APPELLATE REVIEW.—If the issue of a patent is delayed due to appellate review by the Board of Patent Appeals and Interferences or by a Federal court and the patent is issued pursuant to a decision in the review reversing an adverse determination of patentability, the term of the patent shall be extended for a period of time but in no case more than 5 years. A patent shall not be eligible for extension under this paragraph if it is subject to a terminal disclaimer due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review.

(3) LIMITATIONS.—The period of extension referred to in paragraph (2)—

(A) shall include any period beginning on the date on which an appeal is filed under section 134 or 141 of this title, or on which an action is commenced under section 145 of this title, and ending on the date of a final decision in favor of the applicant;

(B) shall be reduced by any time attributable to appellate review before the expiration of 3 years from the filing date of the application for patent; and

(C) shall be reduced for the period of time during which the applicant for patent did not act with due diligence, as determined by the Commissioner.

(4) LENGTH OF EXTENSION.—The total duration of all extensions of a patent under this subsection shall not exceed 5 years.

(c) CONTINUATION.—

(1) DETERMINATION.—The term of a patent that is in force on or that results from an application filed before the date that is 6 months after the date of the enactment of the Uruguay Round Agreements Act shall be the greater of the 20-year term as provided in subsection (a), or 17 years from grant, subject to any terminal disclaimers.

(2) REMEDIES.—The remedies of sections 283, 284, and 285 of this title shall not apply to Acts which —

(A) were commenced or for which substantial investment was made before the date that is 6 months after the date of the enactment of the Uruguay Round Agreements Act; and

(B) became infringing by reason of paragraph (1).

(3) REMUNERATION.—The acts referred to in paragraph (2) may be continued only upon the payment of an equitable remuneration to the patentee that is determined in an action brought under chapter 28 and chapter 29 (other than those provisions excluded by paragraph (2)) of this title.

For applications filed on or after June 8, 1995, utility and plant patents (other than those granted on reissue applications) will be granted for a term which begins on the date the patent issues and ends twenty years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under 35 U.S.C. 120, 121, or 365(c), twenty years from the earliest effective U.S. filing date. Patents on design applications will be granted for a term of 14 years which begins on the date the patent issues.

A patent granted on an application which resulted from an international application after compliance with 35 U.S.C. 371 will have a term which ends twenty years from the filing date of the international application.

A continuation or a continuation-in-part application of an international application filed under 35 U.S.C. 363 designating the United States will have a term which ends twenty years from the filing date of the parent international application.

Foreign priority under 35 U.S.C. 119 (a)-(d), 365(a), or 365(b) is not considered in determining the term of a patent. Likewise, priority under 35 U.S.C. 119(e) to one or more U.S. provisional applications is not considered in the calculation of the twenty year term.

TRANSITIONAL RULES

All patents that are in force on June 8, 1995, or that will issue on an application that is filed before June 8, 1995, will automatically have a term that is the greater of the twenty year term discussed above or seventeen years from the patent grant. This provision affects all patents that are in force on June 8, 1995, and all patents issued thereafter on applications filed prior to June 8, 1995. The terms of these patents are, of course, subject to reduction by any applicable terminal disclaimers.

Applications filed on or after June 8, 1995 will be subject only to the twenty year term discussed above.

TERM EXTENSIONS

The twenty year patent term may be extended for a maximum of five years for delays in the issuance of the patent due to interferences, secrecy orders and/or successful appeals to the Board of Patent Appeals and Interferences or the Federal courts in accordance with 37 CFR 1.701. Extensions for successful appeals are limited in that the patent must not be subject to a terminal disclaimer. Further, the period of extension will be reduced by any time attributable to appellate review within three years of the filing date of the application and the period of extension for appellate review will be reduced by any time during which the applicant did not act with due diligence. The patent term extension that may be available under 35 U.S.C. 156 for premarket regulatory review is separate from and will be added to any extension that may be available under 35 U.S.C. 154.

At the time of issue, examiners will make no decisions regarding patent term extensions. >The PALM system will automatically calculate and print on the notice of allowance any Patent Term Extension (PTE) to which a patent is entitled under 35 U.S.C. 154(b) and 37 CFR 1.701. PTE information will be printed on the notice of allowance in the box provided. If the PTE is less than five years, it will be printed in days, for example, "35 U.S.C. 154(b) term ext. = 365 days." Since the maximum PTE under 35 U.S.C. 154(b) is five (5) years, if the PTE is equal to five (5) years, the system will simply print out "35 U.S.C. 154(b) term ext. = 5 years." The PTE information printed on the notice of allowance will also be used to print PTE information on the face of the patent.

If an applicant disagrees with the PTE information printed on the notice of allowance, the applicant may request review by way of a petition under 37 CFR 1.181. To avoid loss of patent term due to the time required to process and decide the petition, the Office will ordinarily not postpone issuance of a patent while the petition is pending. If the petition is granted after the patent issues, a Certificate of Correction pursuant to 37 CFR 1.322 will be issued. If an error is noted after the patent issues, the patent owner may seek correction of the PTE information printed on the face of a patent by filing a request for a Certificate of Correction pursuant to 37 CFR 1.322. Petitions and Certificates of Correction regarding PTE under 35 U.S.C. 154(b) should be addressed to "Box DAC, Assistant Commissioner for Patents, Washington, D.C. 20231" and will be decided in the Special Program Law Office.<

Extensions under 35 U.S.C. 156(b) will be handled by the Office of the Deputy Assistant Commissioner for Patent Policy and Projects. **

CONTINUED PROSECUTION APPLICATIONS

The application number of a continued prosecution application (CPA) will be the application number of the prior application, and the filing date indicated on any patent issuing from a continued prosecution application will be the filing date of the prior application (or, in a chain of continued prosecution applications, the filing date of the application immediately preceding the first continued prosecution application in the chain). As the continued prosecution application practice was not in effect prior to June 8, 1995, no patent issuing from a continued prosecution application is entitled to the provisions of 35 U.S.C. 154(c). However, any patent issuing from a continued prosecution application, where the prior application was filed prior to June 8, 1995, will indicate that the filing date of the application for that patent was prior to June 8, 1995. To avoid confusion as to the term of any patent issuing on a CPA of an application filed before June 8, 1995, the Office will include a notice on any patent issuing on a CPA, other than a reissue or a design patent, that: (1) the patent issued on a CPA; and (2) the patent is subject to the twenty year patent term set forth in 35 U.S.C. 154(a)(2) and (b).

The term of a design patent is defined in 35 U.S.C. 173 as 14 years from the date of grant. The term of a reissue patent is defined in 35 U.S.C. 251 as the unexpired part of

the term of the original patent. Since the term of any reissue or design patent is not affected by the filing of a CPA, no notice will be printed on either a reissue or a design patent.

1309.02 “>Query/<Printer Waiting” Cases [R-1]

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

The Publishing Division forwards such “>query/<printer waiting” applications to the Group Director's secretary. The secretary acts as a control center in each examining group and forwards the applications to the examiner by the appropriate route. The application should be taken up and acted on immediately and returned to the Group Director's secretary within *>72< hours (excluding weekends and holidays). Either necessary corrective action should be taken or an indication should be made that the application is considered to be correct as it stands.

If the examiner concurs in the criticisms, the errors should, if possible, be corrected in clean red ink and initialed or be corrected by examiner's amendment. See MPEP § 1302.04.

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

The applications are picked up from the secretary's office by the messenger and returned to the Publishing Division for forwarding to the printer.

THESE APPLICATIONS SHOULD NOT BE MAILED TO THE PUBLISHING DIVISION.