

- 1701 Office Personnel Not To Express Opinion on Validity or Patentability of Patent
- 1701.01 Office Personnel Not To Testify
- 1702 Restrictions on Former Examiners
- 1703 *The Official Gazette*
- 1704 Application Records and Reports
- 1705 Examiner Docket, Time, and Activity Recordation
- 1706 Disclosure Documents
- 1711 U.S.-Philippines Search Exchange

## 1701 Office Personnel Not to Express Opinion on Validity or Patentability of Patent

Every patent is presumed to be valid, 35 U.S.C. 282, first sentence. Public policy demands that every employee of the Patent and Trademark Office refuse to express to any person any opinion as to the validity or invalidity of, or the patentability or unpatentability of any claim in any U.S. patent, except to the extent necessary to carry out (a) examination of an application seeking to reissue the patent, (b) a reexamination proceeding to reexamine the patent, or (c) an interference involving the patent.

The question of validity or invalidity is otherwise exclusively a matter to be determined by a court. Members of the patent examining corps are cautioned to be especially wary of any inquiry from any person outside the Patent and Trademark Office, including an employee of another Government agency, the answer to which might indicate that a particular patent should not have issued.

When a field of search for an invention is requested, examiners should routinely inquire whether the invention has been patented in the United States. If the invention has been patented, no field of search should be suggested.

Employees of the Patent and Trademark Office, particularly patent examiners who examined an application which matured into a patent or a reissued patent or who conducted a reexamination proceeding, should not discuss or answer inquiries from any person outside the Patent and Trademark Office as to whether or not a certain reference or other particular evidence was considered during the examination or proceeding and whether or not a claim would have been allowed over that reference or other evidence had it been considered during the examination or proceeding. Likewise, employees are cautioned against answering any inquiry concerning any entry in the patent or reexamination file, including the extent of the field of search and any entry relating thereto. The record of the file of a patent or reexamination proceeding must speak for itself.

Practitioners can be of material assistance in this regard by refraining from making improper inquiries of members of the patent examining corps. Inquiries from members of the

public relating to the matters discussed above must of necessity be refused and such refusal should not be considered discourteous or an expression of opinion as to validity or patentability.

### 1701.01 Office Personnel Not To Testify

#### *37 CFR 15a.1. Scope*

(a) This part supplements 15 CFR Part 15a and prescribes the policies and procedures of the Office with respect to the testimony of Office employees as witnesses in legal proceedings and the production of documents of the Office for use in legal proceedings pursuant to a request, order, or subpoena. This part is issued pursuant to 15 CFR 15a.(e) and is to be construed consistent with 15 CFR 15a.

(b) This part does not apply to any legal proceeding in which an Office employee is to testify, while on leave status, as to facts or events that are in no way related to the official business of the Office.

(c) This part is intended to ensure the orderly execution of the affairs of the Office and not to impede any legal proceeding and in no way affects the rights and procedures governing public access to records pursuant to the Freedom of Information Act or the Privacy Act. See 15 CFR 15a.4 and 37 CFR 1.15.

#### *37 CFR 15a.2. Definitions.*

For the purpose of this part:

(a) "Commissioner" means Assistant Secretary and Commissioner of Patents and Trademarks.

(b) "Demand" means a request, order, or subpoena for testimony or documents for use in a legal proceeding.

(c) "Document" means any record, paper, and other property held by the Office, including without limitation official patent and trademark files, official letters, telegrams, memoranda, reports, studies, calendar and diary entries, maps, graphs, pamphlets, notes, charts, tabulations, analyses, statistical or informational accumulations, any kind of summaries of meetings and conversations, film impressions, magnetic tapes, and sound or mechanical reproductions.

(d) "Legal proceeding" means a proceeding before a tribunal constituted by law, including a court, an administrative body or commission, an administrative law judge or hearing officer or any discovery proceeding in support thereof.

(e) "Office" means Patent and Trademark Office.

(f) "Office employee" means any officer or employee of the Office.

(g) "Official business" means the authorized business of the Office.

(h) "Solicitor" means the chief legal officer of the Office or other Office employee to whom the Solicitor has delegated authority to act under this part.

(i) "Testimony" means a statement given in person before a tribunal or by deposition for use before the tribunal or any other statement given for use before a tribunal in a legal proceeding, including an affidavit, declaration under 35 U.S.C. 25, or declaration under 28 U.S.C. 1746.

(j) "United States" means the Federal Government, its departments and agencies, and individuals acting on behalf of the Federal Government.

#### *37 CFR 15a.3. Office policy.*

The Office policy is that its documents will not be voluntarily produced and Office employees will not voluntarily appear as witnesses or give testimony in a legal proceeding. The reasons for this policy include:

(a) To conserve the time of Office employees for conducting official business.

(b) To minimize the possibility of involving the Office in controversial or other issues which are not related to the mission of the Office.

(c) To prevent the possibility that the public will misconstrue variances between personal opinions of Office employees and Office policy.

1701.01

(d) To avoid spending the time and money of the United States for private purposes.

(e) To preserve the integrity of the administrative process, minimize disruption of the decision-making process, and prevent interference with the Office's administrative functions.

*37 CFR 15a.4. Testimony or production of documents; general rule*

(a) No Office employee shall give testimony concerning the official business of the Office or produce any document in any legal proceeding without the prior authorization of the Solicitor. Where appropriate, an Office employee may be instructed in writing by the Commissioner, Solicitor, or other appropriate Office employee not to give testimony or produce a document. Without prior approval, no Office employee shall answer inquiries from a person not employed by the Department of Commerce regarding testimony or documents subject to a demand or a potential demand under the provisions of this Part. All inquiries involving a demand or potential demand on an Office employee shall be referred to the Solicitor.

(b) A certified copy of a document, not otherwise available under Chapter I of this Title, will be provided for use in a legal proceeding upon written request and payment of applicable fees required by law.

(c)(1) *Request for testimony or document.* A request for testimony of an Office employee or document shall be mailed or hand-delivered to the Office of the Solicitor. The mailing address of the Office of the Solicitor is Box 8, Patent and Trademark Office, Washington, D.C. 20231.

(2) *Subpoenas.* A subpoena for testimony by an Office employee or a document shall be served in accordance with the Federal Rules of Civil or Criminal Procedure as appropriate, or applicable state procedure, and a copy of the subpoena shall be sent to the Solicitor.

(3) *Affidavit.* Every request and subpoena shall be accompanied by an affidavit or declaration under 28 U.S.C. 1746 or, if an affidavit or declaration is not feasible, a written statement setting forth the title of the legal proceeding, the forum, the requesting party's interest in the legal proceeding, the reasons for the request or subpoena, a showing that the desired testimony or document is not reasonably available from any other source, and if testimony is requested, the intended use of the testimony, a general summary of the testimony desired, and a showing that no document could be provided and used in lieu of testimony. The purpose of this requirement is to permit the Solicitor to make an informed decision as to whether testimony or production of a document should be authorized.

(d) Any Office employee who is served with a demand shall immediately notify the Office of the Solicitor.

(e) The Solicitor may consult or negotiate with an attorney for a party or the party, if not represented by an attorney, to refine or limit a demand so that compliance is less burdensome or obtain information necessary to make the determination required by paragraph (c) of this section. Failure of the attorney or party to cooperate in good faith to enable an informed determination to be made under this part may serve as the basis for a determination not to comply with the demand.

(f) A determination under this part to comply or not to comply with a demand is not an assertion or waiver of privilege, lack of relevance, technical deficiencies or any other ground for noncompliance. The Commissioner reserves the right to oppose any demand on any legal ground independent of any determination under this part.

*37 CFR 15a.3. Testimony of Office employees in proceedings involving the United States.*

(a) An Office employee may not testify as an expert or opinion witness for any party other than the United States.

(b) When appropriate, the Solicitor may authorize an Office employee to give testimony as an expert or opinion witness on behalf of the United States. Expert or opinion testimony on behalf of the United States will not be authorized in any legal proceeding involving the validity or enforceability of a patent or registered trademark.

(c) Whenever, in any legal proceeding involving the United States, a request is made by an attorney representing or acting under the authority of the United States, the Solicitor will make all necessary arrangements for the Office employee to give testimony on behalf of the United States. Where appropriate, the Solicitor may require reimbursement to the Office of the expenses associated with an Office employee giving testimony on behalf of the United States.

*37 CFR 15a.6. Legal proceedings between private litigants*

(a) Testimony by an Office employee and production of documents in a legal proceeding not involving the United States shall be governed by § 15a.4.

(b) If an Office employee is authorized to give testimony in a legal proceeding, the testimony, if otherwise proper, shall be limited to facts within the personal knowledge of the Office employee. An Office employee is prohibited from giving expert or opinion testimony, answering hypothetical or speculative questions, or giving testimony with respect to subject matter which is privileged. If an Office employee is authorized to testify in connection with the employee's involvement or assistance in a quasi-judicial proceeding which took place before the Office, that employee is further prohibited from giving testimony in response to questions which seek:

(1) Information about that employee's:

(i) Background.

(ii) Expertise.

(iii) Qualifications to examine or otherwise consider a particular patent or trademark application.

(iv) Usual practice or whether the employee followed a procedure set out in any Office manual of practice in a particular case.

(v) Consultation with another Office employee.

(vi) Understanding of:

(A) A patented invention, an invention sought to be patented, or patent application, patent, reexamination or interference file.

(B) Prior art.

(C) Registered subject matter, subject matter sought to be registered, or a trademark application, registration, opposition, cancellation, interference or concurrent use file.

(D) Any Office manual of practice.

(E) Office regulations.

(F) Patent, trademark, or other law.

(G) The responsibilities of another Office employee.

(vii) Reliance on particular facts or arguments.

(2) To inquire into the manner in and extent to which the employee considered or studied material in performing the quasi-judicial function.

(3) To inquire into the bases, reasons, mental processes, analyses, or conclusions of that Office employee in performing the quasi-judicial function.

*37 CFR 15a.7. Procedures when an Office employee receives a subpoena.*

(a) Any Office employee who receives a subpoena shall immediately forward the subpoena to the Office of the Solicitor. The Solicitor will determine the extent to which an Office employee will comply with the subpoena.

(b) If the Office employee is not authorized to comply with the subpoena, the Office employee shall appear at the time and place stated in the subpoena, produce a copy of Part 15a of Title 15 and a copy of this part, and respectfully refuse to provide any testimony or produce any document. *United States ex rel. Touhy v. Ragen.* 340 U.S. 462 (1951).

(c) When necessary or appropriate, the Solicitor will request assistance from the Department of Justice or a U.S. Attorney or otherwise assure the presence of an attorney to represent the interests of the Office or an Office employee.

It is the policy of the Patent and Trademark Office that its employees, including patent examiners, will not appear as witnesses or give testimony in legal proceedings, except under the conditions specified in 37 CFR Part 15a. Any employee who testifies contrary to this policy will be *dismissed or removed*. The reasons for this policy are set out in 37 CFR 15a.3.

Whenever an employee of the Patent and Trademark Office, including a patent examiner, is asked to testify or receives a subpoena, the employee shall immediately notify the Office of the Solicitor. Inquiries requesting testimony shall be also referred immediately to the Office of the Solicitor.

Patent examiners and other Patent and Trademark Office employees performing or assisting in the performance of quasi-judicial functions, are forbidden to testify as experts or to express opinions as to the validity of any patent.

Any individual desiring the testimony of an employee of the Patent and Trademark Office, including the testimony of a patent examiner or other quasi-judicial employee, must comply with the provisions of 37 CFR Part 15a.

A request for testimony of an employee of the Patent and Trademark Office should be made to the Office of the Solicitor at least **10 working days** prior to the date of the expected testimony.

If an employee is authorized to testify, the employee will be limited to testifying about facts within the employee's personal knowledge. Employees are prohibited from giving expert or opinion testimony. *Fischer & Porter Co. v. Corning Glass Works*, 61 F.R.D. 321, 181 USPQ 329 (E.D. Pa. 1974). Likewise, employees are prohibited from answering hypothetical or speculative questions, *In re Mayewsky*, 162 USPQ 86, 89 (E.D. Va. 1969) (deposition of an examiner must be restricted to relevant matters of fact and must avoid any hypothetical or speculative questions or conclusions based thereon); *Shaffer-Tool Works v. Joy Mfg. Co.*, 167 USPQ 170 (S.D. Tex. 1970) (deposition of examiner should be limited to matters of fact and must not go into hypothetical or speculative areas or the bases, reasons, mental processes, analyses, or conclusions of the examiner in acting upon a patent application). Employees will not be permitted to give testimony with respect to subject matter which is privileged. Several court decisions limit testimony with respect to quasi-judicial functions performed by employees. Those decisions include *United States v. Morgan*, 313 U.S. 409, 422 (1941) (improper to inquire into mental processes of quasi-judicial officer or to examine the manner and extent to which the officer considered an administrative record); *Western Electric Co. v. Piezo Technology, Inc.*, 860 F.2d 428, 8 USPQ 2d 1853 (Fed. Cir. 1988) (patent examiner may not be compelled to answer questions which probe the examiner's technical knowledge of the subject matter of a patent); *McCulloch Gas Processing Co. v. Department of Energy*,

650 F.2d 1216, 1229 (Temp. Emer. Ct. App. 1981) (discovery of degree of expertise of individuals performing governmental functions not permitted); *In re Nilssen*, 851 F.2d 1401, 7 USPQ 2d 1500 (Fed. Cir. 1988) (technical or scientific qualifications of examiners-in-chief are not legally relevant in appeal under 35 U.S.C. 134 since board members need not be skilled in the art to render obviousness decision); *Lange v. Commissioner*, 352 F. Supp. 166, 176 USPQ 162 (D.D.C. 1972) (technical qualifications of examiners-in-chief not relevant in 35 U.S.C. 145 action).

In view of the discussion above, if an employee is authorized to testify in connection with the employee's involvement or assistance in a quasi-judicial proceeding which took place before the Patent and Trademark Office, the employee will not be permitted to give testimony in response to questions which seek:

- (1) Information about that employee's:
  - (A) Background.
  - (B) Expertise.
  - (C) Qualifications to examine or otherwise consider a particular patent or trademark application.
  - (D) Usual practice or whether the employee followed a procedure set out in any Office manual of practice (including the MPEP or TMEP) in a particular case.
  - (E) Consultation with another Office employee.
  - (F) Understanding of:
    - (i) A patented invention, an invention sought to be patented, or patent application, patent, reexamination or interference file.
    - (ii) Prior art.
    - (iii) Registered subject matter, subject matter sought to be registered, or a trademark application, registration, opposition, cancellation, interference, or concurrent use file.
    - (iv) Any Office manual of practice.
    - (v) Office regulations.
    - (vi) Patent, trademark, or other law.
    - (vii) The responsibilities of another Office employee.
  - (G) Reliance on particular facts or arguments.
- (2) To inquire into the manner in and extent to which the employee considered or studied material in performing a quasi-judicial function.
- (3) To inquire into the bases, reasons, mental processes, analyses, or conclusions of that Office employee in performing the quasi-judicial function.

Any request for testimony addressed or delivered to the Office of the Solicitor shall comply with 37 CFR 15a.4(c). All requests must be in *writing*. The need for a subpoena may be obviated where the request complies with 37 CFR 15a.4(c) if the party requesting the testimony further meets the following conditions:

(1) The party requesting the testimony identifies the civil action or other legal proceeding for which the testimony is being taken. The identification shall include:

- (a) the style of the case,
- (b) the civil action number,
- (c) the district in which the civil action is pending,
- (d) the judge assigned to the case, and
- (e) the name, address, and telephone number of counsel for all parties in the civil action.

(2) The party agrees not to ask questions seeking information which is precluded by 37 CFR 15a.6(b).

(3) The party shall comply with applicable provisions of the Federal Rules of Civil Procedure, including Rule 30, and give 10 working days notice to the Office of the Solicitor prior to the date a deposition is desired. Fifteen working days notice is required for any deposition which is desired to be taken between November 15 and January 15.

(4) The party agrees to notice the deposition at a place convenient to the Patent and Trademark Office. The Conference Room in the Office of the Solicitor is deemed to be a place convenient to the Office.

(5) The party agrees to supply a copy of the transcript of the deposition to the Patent and Trademark Office for its records.

Absent a written agreement meeting the conditions specified in paragraphs (1) through (5), a party must comply with the precise terms of 37 CFR 15a.4(c) and the Patent and Trademark Office will not permit a deposition without issuance of a subpoena.

## 1702 Restrictions on Former Examiners

### *37 CFR 10.10. Restrictions on practice in patent cases.*

(a) Only practitioners who are registered under § 10.6 or individuals given limited recognition under § 10.9 will be permitted to prosecute patent applications of others before the Office.

(b) No individual who has served in the patent examining corps of the Office may practice before the Office after termination of his or her service, unless he or she signs a written undertaking.

(1) Not to prosecute or aid in any manner in the prosecution of any patent application pending in any patent examining group during his or her period of service therein, and

(2) Not to prepare or prosecute or to assist in any manner in the preparation or prosecution of any patent application of another (i) assigned to such group for examination and (ii) filed within two years after the date he or she left such group, without written authorization of the Director. Associated and related classes in other patent examining groups may be required to be included in the undertaking or designated classes may be excluded from the undertaking.

When an application for registration is made after resignation from the Office, the applicant will not be registered if he or she has prepared or prosecuted or assisted in the preparation or prosecution of any patent application as indicated in the paragraph. Knowingly preparing or pro-

secuting or providing assistance in the preparation or prosecution of any patent application contrary to the provisions of this paragraph shall constitute misconduct under § 10.23(c)(13) of this part.

(c) A practitioner who is an employee of the Office cannot prosecute or aid in any manner in the prosecution of any patent application before the Office.

(d) Practice before the Office by Government employees is subject to any applicable conflict of interest laws, regulations, or codes of professional responsibility.

See also MPEP § 309.

## 1703 The Official Gazette

The *Patent Official Gazette* reports every Tuesday the patents and design patents issued and defensive publications published on that day. As to each patent, the following information is given:

(1) the name and (2) the city and state of residence of the applicant with the Post Office address in the case of unassigned patents, (3) the same data for the assignee, if any, (4) the filing date, (5) the serial number of the application, (6) the patent number, (7) the title of the invention, (8) the number of claims, (9) the U.S. classification by class and subclass, (10) a selected figure of the drawing, if any, except in the case of a plant patent, (11) a claim or claims, (12) international classification, (13) U.S. patent application data, if any, and (14) foreign priority application data, if any. In the case of a reissue patent, there are published the additional data of the number and date of the original patent and original application.

The *Patent Official Gazette* also includes notices of patent and trademark suits, indexes of patents, disclaimers filed, Certificates of Correction issued, list of patents available for license or sale, and general information such as orders, notices, changes in rules, changes in classification, certain adverse decisions in interferences, the condition of work in the Office, disbarment, and registration of attorneys, and notices to parties not reached by mail.

*Trademark Official Gazette.* The official journal of the Patent and Trademark Office relating to trademarks is published every Tuesday. It contains an illustration of each trademark published for opposition, a list of trademarks registered, classified list of registered trademarks, and Patent and Trademark Office notices.

Orders should be addressed and remittances made payable to Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

## 1704 Application Records and Reports

The PALM (Patent Application Locating and Monitoring) System is the automated data management system used

by the Patent and Trademark Office for the retrieval and/or on-line updating of the computer record of each patent application. The PALM System also maintains examiner time, activity, docket, and clerical backlog records.

Information retrieval from PALM is by means of video display terminals. Information update is by means of video display transactions and, predominantly, by means of transactions entered via bar code readers (BCR). Among other items, classification, examiner docket, attorney, inventor, and prosecution history data as well as the location of each application can be retrieved and updated online with PALM.

### DOCKET REPORTS

The recording of changes to examiner dockets is accomplished by PALM simultaneously with the recording of incoming and outgoing communications, transfers of applications to and from dockets, and other types of updating of the application record. The status of each examiner's docket can be determined by means of online video display transactions and is supplemented by periodic printed reports. Docket reports that are generated by PALM include the individual examiner; new, special, and amended docket which lists applications in priority order; the individual examiner rejected application docket; the individual examiner new application profile, which lists the totals of new applications in each docket, sorted by month of filing; and various summaries of the above reports at the group art unit, group, and corps levels.

### TIME AND ACTIVITY REPORTS

All reporting of examiner time and activity is on a biweekly basis. Each examiner's examining and non-examining time, as listed on the examiners' Biweekly Time Worksheet, PTO-690E, is entered into PALM for use in the computation of productivity data. The biweekly reports produced include the individual examiner Time and Activity Report which lists, by serial number, all applications for which actions have been counted during the biweekly period. The type of action counted for each application is also indicated on the report. This report also includes examiner time data, an action summary, and cumulative summaries to date for the current quarter and fiscal year. Various summary reports at the group art unit, group, and corps levels are also produced.

## 1705 Examiner Docket, Time, and Activity Recordation

### COUNTING OF ACTIONS

Actions prepared by examiners are submitted to their respective docket clerks for counting. (See "Types of Action" and "Actions Not Counted" below which distinguishes

between outgoing communications that are considered to be "actions" from those that are not). With each action, the examiner submits an Examiner's Case Action Worksheet, PTO-1472, upon which he/she indicates the type of action being taken. The docket clerk, thereafter, updates the PALM record of the application and the examiner's production record by entry of the appropriate online bar code reader transaction.

### PROCEDURES FOR REPORTING AN EXAMINER'S ACTION

1. The Examiner Case Action Worksheet, PTO-1472, is filled out by the Examiner and attached to the case for processing by the docket clerk.
2. The docket clerk checks the worksheet to verify that the Examiner provided all necessary information relating to that action.
3. The docket clerk places the count date of the action on the Contents flap of the file wrapper.
4. The docket clerk will enter the examiner's action for the case directly into PALM by using a Bar Code Reader (BCR).
5. Each examiner's action reported to the PALM system will be listed by serial number on the biweekly Examiner's Time and Activity Report.
6. The Examiner should check his/her Biweekly Examiner Time and Activity Report to verify that all cases worked on for the biweekly report period are properly listed.

### TYPES OF ACTION TO BE INDICATED ON EXAMINER'S CASE ACTION WORKSHEET, PTO-1472

1. Nonfinal
2. Restriction/Election Only
  - a. — This is not an action on the merit. Other time credit is given for time spent.
3. Final Rejection
4. *Ex parte* Quayle
5. Allowance
6. Miscellaneous Action
  - a. — This type of action is used when a response period is set and the other types of actions listed on the worksheet are not appropriate.
7. Advisory Action After Final Rejection
8. Interference
  - a. — For Interference Memo (PTO-850) and Decision on Motion Mark Interference.
  - b. — When an examiner issues an action; e.g., nonfinal and concurrently an initial interference memo (PTO-850) the examiner will complete a worksheet indicat-



ing; e.g., nonfinal and another worksheet indicating an interference action.

c. — A worksheet should be filled out for patented cases placed into interference.

#### 9. Examiner's Answer

a. — If a supplemental or second Examiner's Answer is written, the action will be counted, but no disposal credit will be received.

b. — If prosecution is continued, after a Board of Appeals or a Court Decision, the examiner marks the worksheet, e.g., NONFINAL with the next consecutive action number.

#### 10. Suspension

a.—This will give a miscellaneous action credit on the Biweekly Report. It will also be recorded in PALM as a miscellaneous Office action and a letter of suspension.

#### 11. Allowance After Examiner's Answer, Board of Patent Appeals and Interferences or Court Decision

a. — This is not a disposal credit and is indicated as a "noncounter" on the biweekly Examiners' Time and Activity Report.

b. — Statutory Invention Registration disposal credit only after a first action on the merits.

#### 12. Abandonment (Failure to Respond to Office Action)

a. — The actual date of abandonment is the date the Office action response period expired. See MPEP 711.04(a).

b. — The action number reported should be the action number of the last Office action to which the applicant has failed to respond.

#### 13. Express Abandonment

a. — The examiner will automatically be credited with a nonmerit Office action for acknowledging the Express Abandonment and an abandonment (disposal) credit.

b. — The actual date of abandonment will be the date of recognition of the letter. See MPEP 711.01.

#### 14. Abandonment After Examiner's Answer, Board of Patent Appeals and Interferences, or Court Decision

a. — The date of abandonment, is the date applicant/appellant response period expired. See MPEP § 711.04(a).

b. — This is not a disposal credit and is indicated as a noncounter on the Biweekly Examiners' Time and Activity Report.

15. Supplemental Office Action — When the Examiner issues a supplemental Office action (which is the same type of action previously issued), a note should be attached to the application. This will assist the docket clerk in properly reporting this supplemental Office action to the PALM system.

A supplemental action may be necessary when an applicant's response and an examiner's Office action cross in the mail. Also, a supplemental action may be necessary when the examiner becomes aware of an additional ground of rejection after the mailing of an Office action.

### COUNTING OF FIRST ACTION ON THE MERITS (FAOM)

Office actions on the merits are:

- (1) Nonfinal
- (2) Final Rejection
- (3) *Ex parte* Quayle
- (4) Allowance

The first time an examiner performs one of the above four merit actions, he/she receives credit for a First Action on the Merits (FAOM) on the production reports.

A second/subsequent but First Action on the Merits (FAOM) action usually occurs when the first action is a restriction/election. The examiner indicates the type of action (nonfinal, final rejection, *Ex parte* Quayle and allowance) on the worksheet, and the PALM system will automatically determine if it is an FAOM. The action will be listed and credited on the Biweekly Examiners' Time and Activity Report as a Second/Subsequent FAOM.

### COUNTING OF DISPOSALS

An examiner's "disposal" count consists of four items:

- (1) allowances, (2) abandonments, (3) Examiner's answers, and (4) International Preliminary Examination Reports.

An examiner receives credit for a disposal upon submission of a first Examiner's Answer prepared in an appealed application. These same items constitute the "disposals" for performance evaluation of examining art units and groups. However, disposals at the Office level consist only of allowances and abandonments.

### ACTIONS NOT COUNTED

The following are not to be counted as actions but are reported to PALM by the docket clerk:

- (1) Examiner's Amendments.
- (2) Supplemental actions citing additional references or correcting the data of references of record.
- (3) Letters acknowledging receipt of communications from applicants, such as new or supplemental oaths, orders for corrections of drawings, etc., which do not bring the application up for action.
- (4) Letters stating that the Notice of Allowance will be sent in due course.

(5) Answers to petitions to revive or to make cases special, amendments under 37 CFR 1.312 and to status letters.

(6) Actions in Reexamination applications.

(7) Transfers of individual cases and patentability reports are not counted as actions, but credit is given for the time spent.

### CORRECTION INFORMATION

1. If any information is either missing from or incorrect on the biweekly Examiner Time and Activity Report, the examiner should promptly notify the docket clerk by providing all the pertinent information necessary to make the changes to the PALM system (e.g., examining hours, application serial number, type of action, etc.).

2. The docket clerk will report the necessary changes and corrections directly into PALM. These changes will be listed on the next biweekly Examiner Time and Activity Report.

3. If any information is missing from the last biweekly Examiner Time and Activity Report of a quarter (except at the end of a fiscal year) or is incorrect, the examiner should promptly notify the docket clerk and his/her Supervisory Patent Examiner (SPE). The docket clerk will make the appropriate changes directly into the PALM system. The changes will be listed on the next biweekly Examiner Time and Activity Report. However, these changes will not be reflected in the last Quarter's Report; the Examiner's SPE may manually make an adjustment to the records to show these changes.

4. In order to ensure that all PALM reports are correct at the end of the fiscal year (rating period), a special correction cycle is provided on the PALM system. If any information is missing from or is incorrect on the last biweekly Examiner Time and Activity Report, the examiner should immediately notify the docket clerk and his/her SPE. These changes will be reflected in the examiner's final biweekly report for the entire fiscal year.

### 1706 Disclosure Documents

The Patent and Trademark Office accepts and preserves, for a limited time, "Disclosure Documents" as evidence of the dates of conception of inventions.

#### THE PROGRAM

A paper disclosing an invention and signed by the inventor or inventors may be forwarded to the Patent and Trademark Office by the inventor (or by any one of the inventors when there are joint inventors), by the owner of the invention,

or by the attorney or agent of the inventor(s) or owner. It will be retained for 2 years and then be destroyed unless it is referred to in a separate letter in a related application within two years.

The Disclosure Document is not a patent application, and the date of its receipt in the Patent and Trademark Office will not become the effective filing date of any patent application subsequently filed. However, like patent applications, these documents will be kept in confidence by the Patent and Trademark Office until a patent is granted.

This program does not diminish the value of the conventional witnessed and notarized records as evidence of conception of an invention, but it should provide a more credible form of evidence than that provided by the popular practice of mailing a disclosure to oneself or another person by registered mail.

A Disclosure Document is available to the public when an application which refers to it issues as a patent.

#### CONTENT OF DISCLOSURE DOCUMENT

Although there are no restrictions as to content and claims are not necessary, the benefits afforded by the Disclosure Document will depend directly upon the adequacy of the disclosure. Therefore, it is strongly urged that the document contain a clear and complete explanation of the manner and process of making and using the invention in sufficient detail to enable a person having ordinary knowledge in the field of the invention to make and use the invention. When the nature of the invention permits, a drawing or sketch should be included. The use or utility of the invention should be described, especially in chemical inventions.

#### PREPARATION OF THE DOCUMENT

The Disclosure Document must be limited to written matter or drawings on paper or other thin, flexible material, such as linen or plastic drafting material, having dimensions or being folded to dimensions not to exceed 8 1/2 by 13 inches (21.6 by 33 cm.). Photographs also are acceptable. Each page should be numbered. Text and drawings should be sufficiently dark to permit reproduction with commonly used office copying machines.

#### OTHER ENCLOSURES

In addition to the fee described below, the Disclosure Document must be accompanied by a stamped, self-addressed envelope and a separate paper in duplicate, signed

by the inventor, stating that he or she is the inventor and requesting that the material be received for processing under the Disclosure Document Program. The papers will be stamped by the Patent and Trademark Office with an identifying number and date of receipt, and the duplicate request will be returned in the self-addressed envelope together with a notice indicating that the Disclosure Document may be relied on only as evidence and that a patent application should be diligently filed if patent protection is desired. The inventor's request may take the following form:

**“The undersigned, being the inventor of the disclosed invention, requests that the enclosed papers be accepted under the Disclosure Document Program, and that they be preserved for a period of two years.”**

#### DISPOSITION

The Disclosure Document will be preserved in the Patent and Trademark Office for 2 years and then will be destroyed unless it is referred to in a separate letter in a related patent application filed within the 2-year period. The Disclosure Document should be referred to in a separate letter filed in a pending application by identifying the Document by its title, number, and date of receipt. Acknowledgment of receipt of such letters is made in the next official communication or in a separate letter from the Patent and Trademark Office. Unless it is desired to have the Patent and Trademark Office retain the Disclosure Document beyond the 2-year period, it is not required that it be referred to in a patent application.

#### ACKNOWLEDGMENT

When a paper referring to a Disclosure Document is filed in a patent application within 2 years after the filing of a Disclosure Document, the group clerk either prepares (1) a memorandum indicating that a reference to Disclosure Document No. — has been made in application Serial No. —, or (2) a copy of the paper filed in the application referring to the Disclosure Document. The memorandum or copy is forwarded to the Head of the Correspondence and Mail Division.

Upon receipt, the Correspondence and Mail Division prepares a retention label (PTO-150) and attaches it to the Disclosure Document, indicates on the forwarded memo or copy that the retention label has been applied and returns the memo or copy to the group. The returned memo or copy is stapled to the inside left flap of the file wrapper so that the examiner's attention is directed to it when the next Office action is prepared. If prosecution before the examiner has been

concluded, a separate letter indicating that the Disclosure Document will be retained should be sent to the applicant by the group clerk.

After the acknowledging letter is mailed, the paper in the application file referring to the Disclosure Document is noted with the paper number of the acknowledgment. The returned memo or copy is stapled to and retained with the original paper in the file wrapper referring to the Disclosure Document.

#### FEE

The fee set forth in 37 CFR 1.21(c) is charged for filing a Disclosure Document. Payment must accompany the Disclosure Document when it is submitted to the Patent and Trademark Office.

#### WARNING TO INVENTORS

The 2-year retention period should not be considered to be a “grace period” during which the inventor can wait to file his patent application without possible loss of benefits. It must be recognized that in establishing priority of invention an affidavit or testimony referring to a Disclosure Document must usually also establish diligence in completing the invention or in filing the patent application since the filing of the Disclosure Document.

Inventors are also reminded that any public use or sale in the United States or publication of the invention anywhere in the world more than 1-year prior to the filing of a patent application on that invention will prohibit the granting of a patent on it.

If the inventor is not familiar with what is considered to be “diligence in completing the invention” or “reduction to practice” under the patent law, or if he has other questions about patent matters, the Patent and Trademark Office advises him to consult an attorney or agent registered to practice before the Patent and Trademark Office. A Directory of Registered Patent Attorneys and Agents Arranged by States and Counties titled ATTORNEYS AND AGENTS REGISTERED TO PRACTICE BEFORE THE U.S. PATENT AND TRADEMARK OFFICE [1982] is available from the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402. Patent attorneys and agents may be found in the telephone directories of most major cities. Also, many large cities have associations of patent attorneys which may be consulted.

#### 1711 U.S.–Philippines Search Exchange

The United States–Philippines search exchange program involves patent applications filed in the United States which





**MANUAL OF PATENT EXAMINING PROCEDURE**