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1701 Examiners Not To Express Opinion on Validity

Congress, in 35 U.S.C. 282, has endowed every patent granted by the Patent and Trademark Office with a presumption of validity. Public policy demands that every employee of the Patent and Trademark Office refuse to express to any person any opinion or view as to the invalidity of any United States Patent except in the course of examining a reissue or reexamination application. The question of validity or invalidity is exclusively a matter for the courts to determine. Each member of the examining corps is cautioned to be especially wary of any inquiry from any person outside the Patent and Trademark Office (including any employee of another government agency), the answer to which might indicate that a particular patent should not have been issued.

Further, when a field of search for an invention is requested, Patent and Trademark Office employees should routinely inquire whether the invention has been patented in the United States.

Examiners are especially cautioned against answering inquiries from any person outside the Patent and Trademark Office as to whether or not a certain reference was considered and whether or not a claim would have been allowed over that reference. This applies to anything in the patented file, including the extent of the field of search and any entry relating thereto. The record of a patented file must speak for itself. Practitioners can be of material assistance in this regard by refraining from making such inquiries of members of the examining corps. Answers to inquiries of this nature must of necessity be refused, and such refusal should be considered neither discourteous nor an expression of opinion as to validity. Searches suggested to members of the public who conduct validity searches might well serve as a basis for concluding that the examiner who examined the application during its prosecution overlooked a pertinent area of prior art during his or her search. This might adversely affect the presumption of validity.

The examiner who offers suggestions as to fields of search might well find himself or herself in a position where the offer to help might lead to statements made by the examiner which adversely reflect on the patent itself. These statements, while not part of the Patent and Trademark Office written record, may result in the examiner being sought for testimony in connection with litigation resulting from the issuance of that patent. While § 1701.01 points out that the testimony of examiners can be taken by deposition in appropriate situations, the circumstances noted are not appro-

priate. Examiner's testimony is limited to factual amplification of the written record established during the application's prosecution history. In validity search situations, comments made by the examiner occur after the fact (issuance of the patent) and could only lead to improper examiner testimony since they amount to "second guessing" of the original examiner's work methods and professional judgment. As pointed out above, the determination of validity of a United States patent is strictly a matter for determination by competent judicial authority.

1701.01 Examiners Not To Testify as Patent Experts

Inasmuch as public policy does not permit examiners to decide, as judges in the Patent and Trademark Office, questions upon which they have been retained to give opinions as expert witnesses in patent cases in the courts, every examiner who shall testify as an expert in a patent case pending in any court will be dismissed, unless he or she shall have so testified involuntarily, upon compulsion by competent judicial authority, and without retainer or preparation.

Whenever an examiner is asked or subpoenaed to testify in a suit concerning a patent, trademark registration, or application for either, the examiner is directed to report that fact *immediately* to the Solicitor. Where the suit involves a patent or an application for a patent, the examiner must also promptly notify the Office of the Deputy Assistant Commissioner for Patents.

Also, examiners are reminded that, in view of the long established policy of the Patent and Trademark Office to refuse to permit members of the staff of the Patent and Trademark Office to testify in patent suits, they should, before allowing an application, determine that the written record is accurate and complete.

Patent examiners are forbidden to testify as patent experts or to express opinions, in testimony or otherwise, as to the invalidity of any issued patent. Patent examiners have, in connection with litigation involving patent validity, been called to testify on factual matters. In those cases, the practice had been to permit the examiner to testify only upon the issuance of a subpoena.

However, under current practice, patent examiners are permitted to testify on deposition in patent suits, without the need for a subpoena, provided the following conditions are satisfied:

- (1) The party proposing to take the testimony will state in writing, that the questions to be asked of the examiner will be phrased to comply with the permissible scope of inquiry as outlined in the protective orders contained in the Court opinions in *In re Mayewsky*, 162 USPQ 86, 89, and *Shaffer Tool Works v. Joy Manufacturing Co.*, 167 USPQ 170, 171:

"* * * the scope of the oral deposition of the patent examiners is hereby 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 patent examiners in acting upon the patent applications maturing into the patent [in suit]." 167 USPQ 171.

(2) That in addition to complying with the requirements of Rule 30 of the Federal Rules of Civil Procedure, the party taking the testimony will agree to give adequate notice of the taking of the deposition of the patent examiner to the Solicitor, preferably, at least thirty days prior to the date on which the taking of the deposition is desired.

(3) That the party taking the deposition arrange with the Solicitor to notice the deposition at a place convenient to the Patent and Trademark Office.

(4) That the party taking the deposition supply a courtesy copy of the deposition transcript to the Patent and Trademark Office for its records.

If the party desiring to take the testimony of the examiner does not agree to the conditions enumerated, the Patent and Trademark Office will not permit the examiner to be deposed without a subpoena.

See also *Monsanto Company v. Dawson Chemical Company et al.*, 176 USPQ 349 (1972); and *Fisher & Porter Company v. Corning Glass Works*, 181 USPQ 329 (1974).

1702 Restrictions on Former Examiners

Extract from 37 CFR 1.341, Registration of Attorneys and Agents.
(g) *Former examiners.* No person who has served in the examining corps of the Patent and Trademark Office will be registered after termination of his services, nor, if registered before such service, be reinstated, unless he undertakes (1) not to prosecute or aid in any manner in the prosecution of any application pending in any examining group during his period of service therein; and (2) not to prepare or prosecute nor to assist in any manner in the preparation or prosecution of any application of another filed within 2 years after the date he left such group, and assigned to such group, without the specific authorization of the Commissioner. Associated and related classes in other group may be required to be included in the undertaking or designated classes may be excluded. In case application for registration or reinstatement is made after resignation from the Office, the applicant will not be registered, or reinstated, if he has prepared or prosecuted, or assisted in the preparation or prosecution of any such application as indicated in this paragraph. (See further 18 U.S.C. 207).

See also § 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 on-line 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 on-line 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 bi-weekly basis. Each examiner's examining and non-

examining time, as listed on the examiners' Bi-Weekly Time Worksheet, PTO-690E, is entered into PALM for use in the computation of productivity data. The bi-weekly 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 bi-weekly 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 on-line 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. Non-Final
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 (PO-850) and Decision on Motion Mark Interference.

b—When an examiner issues an action, e.g., non-final and concurrently an initial interference memo (PO-850) the examiner will complete a worksheet indicating, e.g., non-final 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., NON-FINAL 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 Appeals or Court Decision

a—The action number will be the next consecutive action number of the application.

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

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 non-merit 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.

c—The action number will be the next consecutive action number of the application.

14. Abandonment After Examiner's Answer, Board of Appeals or Court Decision

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

b—The action number will be the next consecutive action number.

c. This is not a disposal credit and is indicated as a non-counter on the Biweekly Examiners' Time and Activity Report.

15. Defensive Publication Approved

a—If the examiner marks Defensive Publication Approved, then the examiner is credited with an Express Abandonment.

b—The date of approval (abandonment) is the date that the examiner submits the application to the docket clerk "for counting". See MPEP 711.06.

16. Defensive Publication Denied

a—Where the examiner marks Defensive Publication—Denied and does not also issue an Office action, no action credit is received. The examiner then takes up the case in normal order of action.

b—If an Office action is made at the same time the examiner denies the Defensive Publication, only the type of Office action is marked, e.g., non-final.

17. 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) Non-Final
- (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 (non-final, final rejection, Ex parte Quayle and allowance) and the action number 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 three items: (1) allowances, (2) abandonments, and (3) Examiner's answers.

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 be counted as actions but are reported to PALM by the docket clerk:

FORM PEP-1478
(Rev. 1-83)U. S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE**EXAMINER'S CASE ACTION WORKSHEET**

Serial Number _____

Check Type of Action Below

<input type="checkbox"/> Non-Final (1322)	<input type="checkbox"/> Restriction/ Election Only (1370)	<input type="checkbox"/> Final Rejection (1340)
<input type="checkbox"/> Ex parte Quayle (1330)	<input type="checkbox"/> Allowance (1376)	<input type="checkbox"/> Miscellaneous Action (1381)
<input type="checkbox"/> Advisory Action (1390)	<input type="checkbox"/> Interference (1430)	<input type="checkbox"/> Examiner's Answer (1462)
<input type="checkbox"/> Suspension (1386)	-- or --	<input type="checkbox"/> Allowance After Examiner's Answer (1377)

<input type="checkbox"/> Abandonment (1585)	<input type="checkbox"/> *Express Abandonment (1388)	<input type="checkbox"/> *Abandonment After Examiner's Answer (1588)						
* also enter actual date of Abandonment below								
<table border="1" style="margin: auto;"> <tr> <td style="width: 30px;">month</td> <td style="width: 30px;">day</td> <td style="width: 30px;">year</td> </tr> <tr> <td style="text-align: center;">---</td> <td style="text-align: center;">---</td> <td style="text-align: center;">---</td> </tr> </table>			month	day	year	---	---	---
month	day	year						
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-- or --

<input type="checkbox"/> Defensive Publication Approved (1586)	<input type="checkbox"/> Defensive Publication Denied (1362)						
* also enter date of approval below:							
<table border="1" style="margin: auto;"> <tr> <td style="width: 30px;">month</td> <td style="width: 30px;">day</td> <td style="width: 30px;">year</td> </tr> <tr> <td style="text-align: center;">---</td> <td style="text-align: center;">---</td> <td style="text-align: center;">---</td> </tr> </table>		month	day	year	---	---	---
month	day	year					
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(See Examiner Production Reporting Manual)							

Examiner's Name _____

Group Art Unit _____

Action Number _____

- U.S. GOVERNMENT PRINTING OFFICE: 1983-307-438/7220

- (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) Actions in Patent Cooperation Treaty (PCT) applications.
- (8) 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 informa-

tion 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 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 insure 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 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 two 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 8½ 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 upon 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 two years and then will be destroyed unless it is referred to in a separate letter in a related patent application filed within the two-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 two-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 two 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

A fee of \$10 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 two-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 one 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 are subsequently followed by corresponding applications filed in the Republic of the Philippines and patent applications filed in the Philippines subsequently followed by corresponding applications filed in the United States.

The program operates as follows:

The applicant files his application in the U.S. Patent and Trademark Office which will process the application in the normal manner and examine the application in the usual time sequence.

If the applicant should later file a corresponding application in the Philippines Patent Office, he may elect to use the special filing procedure. Under this special filing procedure, applicant files his application in the Philippines accompanied by a notice of election to participate in the special procedure; which notice of election contains a certification that the description (excluding references to related applications), claims and drawings are identical to those of the corresponding application originally filed in the United States. The earlier filed application must be fully identified; and, in applications without a claim of priority, a certified copy of the earlier filed U.S. application must be submitted to the Philippines Patent Office. In addition, applicant must also agree that all amendments to his U.S. application will also be made with respect to his application filed in the Philippines.

In the U.S. Patent and Trademark Office, applicant will regularly file two copies of each amendment, one copy must be marked "Copy for Philippines Patent Office." Upon termination of prosecution, the U.S. Patent and Trademark Office shall remove all copies so marked from the U.S. file and promptly forward the same to the Philippines Patent Office.

Election forms for participation in this special program must be signed in duplicate and simultaneously accompany the application to be filed in the Philippines.

Upon receipt of properly filed notice of election, the Philippines Patent Office will notify the U.S. Patent and Trademark Office of the election by forwarding one copy of the election forms to the U.S. Patent and Trademark Office. The Philippines Patent Office will defer action on the Philippines application pending receipt of information as to the disposition of the application by the U.S. Patent and Trademark Office. If no such information is received by the Philippines Office within a reasonable amount of time from the date of filing in the Philippines, the Philippines Office may, either on its own initiative, or at applicant's request, inquire as to the status of the U.S.

application and, if desired, proceed with its own independent examination.

Upon disposal of the application by the U.S. Patent and Trademark Office, appropriate information will be sent to the Philippines Patent Office which will include all necessary identifying data, whether allowed or abandoned, notice of allowance, copies of documents cited during examination, a copy of the last office action and, when necessary, any earlier actions which may be included by reference in the last action. The Philippines Office will then make their own complete office action based upon the claims as amended with U.S. Patent and Trademark Office, performing whatever checks desired and search for copending interfering applications. Alternatively, the Philippines may request applicant to show cause why the results of the U.S. examination should not be accepted in the

Philippines. All avenues of appeal will remain open to the applicant.

Where copending applications are cited and applied during examination in the U.S. Patent and Trademark Office, full examination will not be forwarded to the Philippines Patent Office, and the fact that a U.S. copending application was cited would be noted as a matter of information, since such references are inapplicable in the Philippines.

Where the application originates in the Philippines Patent Office and is subsequently filed in the U.S. Patent and Trademark Office, a similar procedure as outlined above, consonant with U.S. Law, will be followed.

It is believed that this program will facilitate the handling of U.S. origin applications filed in the Republic of the Philippines resulting in a savings in time and expense of prosecution to U.S. applicants.