

## § 1.1

## 37 CFR Ch. I (7–1–02 Edition)

### PATENT OWNER APPEAL TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT IN *Inter Partes* REEXAMINATION

1.983 Patent owner appeal to the United States Court of Appeals for the Federal Circuit in *inter partes* reexamination.

### CONCURRENT PROCEEDINGS INVOLVING SSAME PATENT IN *Inter Partes* REEXAMINATION

1.985 Notification of prior or concurrent proceedings in *inter partes* reexamination.

1.987 Suspension of *inter partes* reexamination proceeding due to litigation.

1.989 Merger of concurrent reexamination proceedings.

1.991 Merger of concurrent reissue application and *inter partes* reexamination proceeding.

1.993 Suspension of concurrent interference and *inter partes* reexamination proceeding.

1.995 Third party requester's participation rights preserved in merged proceeding.

### REEXAMINATION CERTIFICATE IN *Inter Partes* REEXAMINATION

1.997 Issuance of *inter partes* reexamination certificate.

AUTHORITY: 35 U.S.C. 2(b)(2), unless otherwise noted.

SOURCE: 24 FR 10332, Dec. 22, 1959, unless otherwise noted.

EDITORIAL NOTE: In Patent and Trademark Office publications and usage the part number is omitted from the numbers of §§1.1 to 1.352 and the numbers to the right of the decimal point correspond with the respective rule numbers.

## Subpart A—General Provisions

### GENERAL INFORMATION AND CORRESPONDENCE

#### § 1.1 Addresses for correspondence with the Patent and Trademark Office.

(a) Except for paragraphs (a)(3)(i) and (ii), and (d)(1) of this section, all correspondence intended for the United States Patent and Trademark Office must be addressed to either “Commissioner of Patents and Trademarks, Washington, DC 20231” or to specific areas within the Office as set out in paragraphs (a)(1), (2) and (3)(iii) of this section. When appropriate, correspondence should also be marked for the at-

tention of a particular office or individual.

(1) *Patent correspondence.* All correspondence concerning patent matters processed by organizations reporting to the Assistant Commissioner for Patents should be addressed to “Assistant Commissioner for Patents, Washington, DC 20231.”

(2) *Trademark correspondence.* (i) Send all trademark filings and correspondence, except as specified below or unless submitting electronically, to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202–3513.

(ii) Send trademark-related documents for the Assignment Division to record to: Commissioner of Patents and Trademarks, Box Assignment, Washington, DC 20231.

(iii) Send requests for certified or uncertified copies of trademark applications and registrations, other than coupon orders for uncertified copies of registrations, to: Commissioner of Patents and Trademarks, Box 10, Washington, DC 20231.

(iv) Send requests for coupon orders for uncertified copies of registrations to: Commissioner of Patents and Trademarks, Box 9, Washington, DC 20231.

(v) An applicant may transmit an application for trademark registration electronically, but only if the applicant uses the Patent and Trademark Office's electronic form.

(3) *Office of Solicitor correspondence.* (i) Correspondence relating to pending litigation required by court rule or order to be served on the Solicitor shall be hand-delivered to the Office of the Solicitor or shall be mailed to: Office of the Solicitor, P.O. Box 15667, Arlington, Virginia 22215; or such other address as may be designated in writing in the litigation. See §§1.302(c) and 2.145(b)(3) for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.

(ii) Correspondence relating to disciplinary proceedings pending before an Administrative Law Judge or the Commissioner shall be mailed to: Office of the Solicitor, P.O. Box 16116, Arlington, Virginia 22215.

## U.S. Patent and Trademark Office, Commerce

## § 1.4

(iii) All other correspondence to the Office of the Solicitor shall be addressed to: Box 8, Commissioner of Patents and Trademarks, Washington, DC 20231.

(iv) Correspondence improperly addressed to a Post Office Box specified in paragraphs (a)(3) (i) and (ii) of this section will not be filed elsewhere in the Patent and Trademark Office, and may be returned.

(b) Letters and other communications relating to international applications during the international stage and prior to the assignment of a national serial number should be additionally marked "Box PCT."

(c) Requests for reexamination should be additionally marked "Box Reexam."

(d) Maintenance fee correspondence.—(1) Payments of maintenance fees in patents not submitted electronically over the Internet should be mailed to: United States Patent and Trademark Office, P.O. Box 371611, Pittsburgh, PA 15250-1611.

(2) Correspondence related to maintenance fees other than payments of maintenance fees in patents is not to be mailed to P.O. Box 371611, Pittsburgh, PA 15250-1611, but must be mailed to: Box M Correspondence, Commissioner of Patents and Trademarks, Washington, DC 20231.

(e) Communications relating to interferences and applications or patents involved in an interference should be additionally marked "BOX INTERFERENCE."

(f) All applications for extension of patent term and any communications relating thereto intended for the Patent and Trademark Office should be additionally marked "Box Patent Ext." When appropriate, the communication should also be marked to the attention of a particular individual, as where a decision has been rendered.

(g) [Reserved]

(h) In applications under section 1(b) of the Trademark Act, 15 U.S.C. 1051(b), all statements of use filed under section 1(d) of the Act, and requests for extensions of time therefor, should be additionally marked "Box ITU."

(i) The filing of all provisional applications and any communications relating thereto should be additionally

marked "Box Provisional Patent Application."

NOTE: Sections 1.1 to 1.26 are applicable to trademark cases as well as to national and international patent cases except for provisions specifically directed to patent cases. See § 1.9 for definitions of "national application" and "international application."

(Pub. L. 94-131, 89 Stat. 685)

[46 FR 29181, May 29, 1981, as amended at 49 FR 34724, Aug. 31, 1984; 49 FR 48451, Dec. 12, 1984; 52 FR 9394, Mar. 24, 1987; 53 FR 16413, May 9, 1988; 54 FR 37588, Sept. 11, 1989; 60 FR 20220, Apr. 25, 1995; 61 FR 56446, Nov. 1, 1996; 64 FR 48917, Sept. 8, 1999; 67 FR 39448, July 31, 2002]

### § 1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

### § 1.3 Business to be conducted with decorum and courtesy.

Applicants and their attorneys or agents are required to conduct their business with the Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Commissioner and will be returned by the Commissioner's direct order. Complaints against examiners and other employees must be made in correspondence separate from other papers.

[61 FR 56446, Nov. 1, 1996]

### § 1.4 Nature of correspondence and signature requirements.

(a) Correspondence with the Patent and Trademark Office comprises:

(1) Correspondence relating to services and facilities of the Office, such as general inquiries, requests for publications supplied by the Office, orders for printed copies of patents or trademark registrations, orders for copies of