

§ 1.302

notice of appeal directed to the Commissioner (see §§1.302 and 1.304); and in the Court, file a copy of the notice of appeal and pay the fee for appeal as provided by the rules of the Court. For *inter partes* reexamination proceedings filed under §1.913, §1.983 is controlling.

[65 FR 76774, Dec. 7, 2000]

§ 1.302 Notice of appeal.

(a) When an appeal is taken to the U.S. Court of Appeals for the Federal Circuit, the appellant shall give notice thereof to the Commissioner within the time specified in §1.304.

(b) In interferences, the notice must be served as provided in §1.646.

(c) A notice of appeal, if mailed to the Office, shall be addressed as follows: Box 8, Commissioner of Patents and Trademarks, Washington, DC 20231.

[50 FR 9383, Mar. 7, 1985, as amended at 53 FR 16414, May 9, 1988]

§ 1.303 Civil action under 35 U.S.C. 145, 146, 306.

(a) Any applicant or any owner of a patent involved in an *ex parte* reexamination proceeding filed under §1.510 for a patent that issues from an original application filed in the United States before November 29, 1999, dissatisfied with the decision of the Board of Patent Appeals and Interferences, and any party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences may, instead of appealing to the U.S. Court of Appeals for the Federal Circuit (§1.301), have remedy by civil action under 35 U.S.C. 145 or 146, as appropriate. Such civil action must be commenced within the time specified in §1.304.

(b) If an applicant in an *ex parte* case or an owner of a patent involved in an *ex parte* reexamination proceeding filed under §1.510 for a patent that issues from an original application filed in the United States before November 29, 1999, has taken an appeal to the U.S. Court of Appeals for the Federal Circuit, he or she thereby waives his or her right to proceed under 35 U.S.C. 145.

(c) If any adverse party to an appeal taken to the U.S. Court of Appeals for the Federal Circuit by a defeated party in an interference proceeding files no-

37 CFR Ch. I (7-1-02 Edition)

tice with the Commissioner within twenty days after the filing of the defeated party's notice of appeal to the court (§1.302), that he or she elects to have all further proceedings conducted as provided in 35 U.S.C. 146, the notice of election must be served as provided in §1.646.

(d) For an *ex parte* reexamination proceeding filed under §1.510 for a patent that issues from an original application filed in the United States on or after November 29, 1999, and for an *inter partes* reexamination proceeding filed under §1.913, no remedy by civil action under 35 U.S.C. 145 is available.

(35 U.S.C. 6; 15 U.S.C. 1123)

[47 FR 47381, Oct. 26, 1982, as amended at 49 FR 48454, Dec. 12, 1984; 54 FR 29553, July 13, 1989; 65 FR 76774, Dec. 7, 2000]

§ 1.304 Time for appeal or civil action.

(a)(1) The time for filing the notice of appeal to the U.S. Court of Appeals for the Federal Circuit (§1.302) or for commencing a civil action (§1.303) is two months from the date of the decision of the Board of Patent Appeals and Interferences. If a request for rehearing or reconsideration of the decision is filed within the time period provided under §1.197(b), §1.658(b), or §1.979(a), the time for filing an appeal or commencing a civil action shall expire two months after action on the request. In interferences the time for filing a cross-appeal or cross-action expires:

(i) Fourteen days after service of the notice of appeal or the summons and complaint; or

(ii) Two months after the date of decision of the Board of Patent Appeals and Interferences, whichever is later.

(2) The time periods set forth in this section are not subject to the provisions of §1.136, §1.550(c), §1.956, or §1.645(a) or (b).

(3) The Commissioner may extend the time for filing an appeal or commencing a civil action:

(i) For good cause shown if requested in writing before the expiration of the period for filing an appeal or commencing a civil action, or

(ii) Upon written request after the expiration of the period for filing an appeal or commencing a civil action upon a showing that the failure to act was the result of excusable neglect.

(b) The times specified in this section in days are calendar days. The times specified herein in months are calendar months except that one day shall be added to any two-month period which includes February 28. If the last day of the time specified for appeal or commencing a civil action falls on a Saturday, Sunday or Federal holiday in the District of Columbia, the time is extended to the next day which is neither a Saturday, Sunday nor a Federal holiday.

(c) If a defeated party to an interference has taken an appeal to the U.S. Court of Appeals for the Federal Circuit and an adverse party has filed notice under 35 U.S.C. 141 electing to have all further proceedings conducted under 35 U.S.C. 146 (§1.303(c)), the time for filing a civil action thereafter is specified in 35 U.S.C. 141. The time for filing a cross-action expires 14 days after service of the summons and complaint.

[54 FR 29553, July 13, 1989, as amended at 58 FR 54502, Oct. 22, 1993; 62 FR 53198, Oct. 10, 1997; 65 FR 76774, Dec. 7, 2000]

ALLOWANCE AND ISSUE OF PATENT

§ 1.311 Notice of allowance.

(a) If, on examination, it appears that the applicant is entitled to a patent under the law, a notice of allowance will be sent to the applicant at the correspondence address indicated in § 1.33. The notice of allowance shall specify a sum constituting the issue fee which must be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. The sum specified in the notice of allowance may also include the publication fee, in which case the issue fee and publication fee (§ 1.211(e)) must both be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. This three-month period is not extendable.

(b) An authorization to charge the issue or other post-allowance fees set forth in § 1.18 to a deposit account may be filed in an individual application only after mailing of the notice of allowance. The submission of either of the following after the mailing of a no-

tice of allowance will operate as a request to charge the correct issue fee to any deposit account identified in a previously filed authorization to charge fees:

- (1) An incorrect issue fee; or
- (2) A completed Office-provided issue fee transmittal form (where no issue fee has been submitted).

[65 FR 57060, Sept. 20, 2000, as amended at 66 FR 67096, Dec. 28, 2001]

§ 1.312 Amendments after allowance.

No amendment may be made as a matter of right in an application after the mailing of the notice of allowance. Any amendment filed pursuant to this section must be filed before or with the payment of the issue fee, and may be entered on the recommendation of the primary examiner, approved by the Commissioner, without withdrawing the application from issue.

[65 FR 14873, Mar. 20, 2000]

§ 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. To request that the Office withdraw an application from issue, applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why withdrawal of the application from issue is necessary. A petition under this section is not required if a request for continued examination under § 1.114 is filed prior to payment of the issue fee. If the Office withdraws the application from issue, the Office will issue a new notice of allowance if the Office again allows the application.

(b) Once the issue fee has been paid, the Office will not withdraw the application from issue at its own initiative 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; or
- (4) For interference.

(c) Once the issue fee has been paid, the application will not be withdrawn