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1001 Statutory Authority of Commissioner

35 U.S.C. 6. Duties of Commissioner. The Commissioner, under the direction of the Secretary of Commerce, shall superintend or perform all duties required by law respecting the granting and issuing of patents and the registration of trademarks; and he shall have charge of property belonging to the Patent Office. He may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

1001.01 Modes of Exercising Authority [R-27]

The Commissioner's authority to review and supervise the work of the Office is exercised by the promulgation of the Rules of Practice; issuance of Orders, Notices and Memoranda stating Office policies and modes for effectuating these policies; decisions on petitions by applicants, and by the designation of particular cases which must be submitted to the Commissioner or other officials authorized by the Commissioner. The present chapter deals with the latter two items.

Rule 181, paragraph (g), states "The Commissioner may delegate to appropriate Patent Office officials the determination of petitions under this rule, with the exception of petitions under rule 183."

1002 Petitions to the Commissioner [R-27]

Rule 181. Petition to the Commissioner. (a) Petition may be taken to the Commissioner (1) from any action or requirement of any examiner in the *ex parte* prosecution of an application which is not subject to

appeal to the Board of Appeals or to the court; (2) in cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) to invoke the supervisory authority of the Commissioner in appropriate circumstances.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, it may be required that there have been a proper request for reconsideration (rule 111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.

(d) No fee is required for a petition to the Commissioner except in the case of a petition to revive an abandoned application (rule 137) or for the delayed payment of an issue fee (rule 317).

(e) Oral hearings will not be granted except when considered necessary by the Commissioner.

(f) Except as otherwise provided in these rules, any such petition not filed within two months from the action complained of, may be dismissed as untimely. The mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor act as a stay of other proceedings.

(g) The Commissioner may delegate to appropriate Patent Office officials the determination of petitions under this rule, with the exception of petitions under rule 183.

Rule 183. Suspension of rules. In an extraordinary situation, when justice requires, any requirement of these rules which is not a requirement of the statutes may be suspended or waived by the Commissioner in person on petition of the interested party, subject to such other requirements as may be imposed.

Petitions on appealable matters ordinarily are not entertained. See § 1201.

The mere filing of a petition will not stay the period for replying to an Examiner's action which may be running against an application, nor act as a stay of other proceedings (Rule 181(f)). For example, if a petition to vacate a final rejection as premature is filed within two months from the date of the final rejection, the period for response to the final rejection is not extended even if the petition is not reached for decision within that period. However, if the petition is granted and the applicant has filed an otherwise full response to the rejection *within the period for response*, the case is not abandoned.

Rule 181(f) now provides that any petition under that rule which is not filed "within two months from the action complained of" may be dismissed as untimely. Often, the "action complained of", for example, a requirement for a new drawing, is included in the same letter as an action on the merits of the claims, the latter having a three months period for response. Under such circumstances, if applicant requests reconsideration, under Rule 111(b), of the requirement for a new drawing, the Examiner's action on this request, if adverse, establishes the beginning of the two month period for filing the petition. The petition must be filed within this period even though the period for response to the rejection of the claims may extend beyond the two month period.

1002.01 Procedure [R-21]

Petitions, together with the respective application files, are sent to the Office of the Commissioner or other official having the delegated authority to decide the petition. The petition may be referred to the Examiner for a formal statement under Rule 181(c) or for an informal memorandum.

Where a formal statement under Rule 181(c) is made, a copy thereof is mailed to the petitioner by the Examiner unless the latter is otherwise directed, and the file and petition, accompanied by the original copy of his statement, are returned to the official handling the petition. If an informal memorandum is requested, no copy thereof is mailed to the petitioner by the Examiner. After the decision has been rendered, the decision is entered on the "Contents" of the file wrapper which is then returned to the Primary Examiner, who will act in accordance with the decision.

1002.02 Petitionable Subjects [R-27]

The following is a list of the most common petitions, together with a reference to the sec-

tions of this Manual where they are more fully treated:

1. To make an application special on the ground of prospective manufacture or infringement or where applicant, for lack of a patent or an Office action indicating patentable subject matter, is unable to interest capital. § 708.02.
2. To revive an abandoned application. §§ 711.03(c) and 711.03(d).
3. For filing date. §§ 409.03 and 506.
4. To accept late issue fee. § 712.
5. Second or subsequent extensions of time for filing an appeal brief. § 1206.

A. Referred to Group Directors

6. From any ex parte action or requirement by the Examiner which is not subject to appeal, as, for example,

- (a) Prematureness of final rejection. § 706.07(c).
- (b) Refusal to enter an amendment. Rule 127 and § 714.19.
- (c) Holding of abandonment. §§ 711.03(c) and 711.03(d).

7. To make an application special on the ground of applicant's age or state of health or to make special a division, continuation or continuation-in-part of an earlier application. § 708.02.

8. To amend after decision by Board of Appeals. Rule 198 and § 1214.07.

9. From a final decision of the Examiner requiring restriction of an application. See Rule 144 and § 818.03(c).

B. Referred to Solicitor

10. For access to an application. §§ 103 and 104.

11. For certificate of correction. §§ 1402 to 1402.02.

1003 Matters Submitted to Commissioner Through the Group Directors [R-27]

The following matters require the approval of the Commissioner. For this purpose, they should be transmitted by the Examiner to his Group Director.

1. Where a patent claim is copied outside the time limit set, its entry requires the approval of the Commissioner. See § 1101.02(f).
2. Amendment copying patent claims without identifying patent. See § 1101.02(d).
3. Return of papers containing discourteous remarks. See § 714.25.

4. Return of papers other than priority papers entered on Contents of File Wrapper. See § 717.01.

5. Requests for authorization to reopen prosecution of an application after a Court decision. See § 1214.07.

1004 Matters Submitted to Group Directors [R-27]

The following is a list of matters which require the approval of the appropriate Group Director, together with a reference to the section of this Manual where they are more fully treated.

1. Request for withdrawal of an allowed application from issue. §§ 1308 to 1308.02.

2. Requests for authorization to reopen prosecution of an application after decision by the Board of Appeals. § 1214.07.

3. Return of certain priority papers. § 201.14(c).

4. Request for return of original oath. § 604.04(a).

5. Actions which hold unpatentable claims copied from a patent for interference purposes where the grounds relied upon are equally applicable to the patentee. § 1101.02(f).

6. Divisional reissue applications filed. § 1401.10(a).

7. Interferences between applications neither of which is in condition for allowance. § 1101.01(c).

8. Second or subsequent attempts at conversion of an application (addition or removal of an inventor under Rule 45), or simultaneous addition and removal of inventors. § 201.03.

9. Applications filed without drawings where there is a doubt as to the need for drawings before granting a filing date. § 608.02.

10. Fourth or subsequent complete actions on the merits which do not close the prosecution.

11. Actions on amendments after allowance (Rule 312) except the correction of mere formal matters under Order No. 3311. §§ 714.16 to 714.16(e), and 1101.02(g).

12. Second or subsequent extensions of a set shortened statutory period under Rule 136(b). § 710.02(e).

13. Second or subsequent suspensions of action under Rule 103. § 709.

14. Certain rejections on double patenting of divisional (or parent) case when restriction or election of species has previously been required. § 804.04.

15. Letters to an applicant of an allowed application informing him of a proposal to request withdrawal of said application from issue for the purpose of rejecting a claim or claims as fully met by, or obviously unpatentable over a new reference. § 1308.01.

16. Amendments presented after decision by the Board of Appeals as to which the Primary Examiner recommends entry as placing the application in condition for allowance. § 1214.07.

17. Letters requesting jurisdiction of applications involved in interference. § 1101.01(o).

18. Petitions under Rule 212 for concurrent ex parte and inter partes prosecution. § 1103.

19. Interferences including "phantom" counts. § 1101.02 (Item C II).

20. Request for patentability report. § 705.01 (e).

21. Petitions under Special Examining Procedure for certain new applications-accelerated examination. § 708.02.

22. New ground of rejection or objection or new reference cited in Examiner's Answer on appeal. Prior approval of the Group Director must be obtained before the Answer is written and the file copy of the Answer must be stamped "approved" by the Group Director if it meets with his approval. § 1208.01.

23. Letters to an applicant suggesting claims for purposes of interference, the adoption of which by the applicant would result in the withdrawal of an application from issue. § 1101.01(o).

24. Request for Interview after the application has been sent to issue. § 713.10.

25. Defensive publication requests where the subject matter is not suitable for publication. § 711.06.

26. Examiner's Answers containing a new interpretation of law. § 1208.

27. Letters to an applicant indicating a defect in his appeal brief. § 1206.

The Group Director should also be consulted in situations such as the one spelled out in § 1208.01, where it must be decided whether to fully reopen the ex parte prosecution after appeal or to proceed by introducing a new ground of rejection in the Examiner's Answer. Such consultation would ordinarily be confined to questions of policy as to whether the best interests of the applicant as well as the Office would be served by reopening the prosecution or extending the term to reply to the Answer.

All unusual questions of practice may be referred to the Group Directors.