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501 Papers Received by Correspondence and Mail Division [R-3]

*37 CFR 1.1. **>Addresses for correspondence with the Patent and Trademark Office.<*

****>(a)** Except for § 1.1(a)(3) (i) and (ii), all correspondence intended for the Patent and Trademark Office must be addressed to either "Commissioner of Patents and Trademarks, Washington, D.C. 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 attention 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, D.C. 20231."

(2) *Trademark correspondence.* All correspondence concerning trademark matters, except for trademark-related documents sent to the Assignment Division for recordation and requests for certified and uncertified copies of trademark application and registration documents, should be addressed to "Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513." This includes correspondence intended for the Trademark Trial and Appeal Board.

(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.

(iii) All other correspondence to the Office of the Solicitor shall be addressed to: Box 8, Commissioner of Patents and Trademarks, Washington, D.C. 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) Payments of maintenance fees in patents and other communications relating thereto should be additionally marked "Box M. Fee."

(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."

37 CFR 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 records, transmission of assignments for recording, and the like, and

(2) Correspondence in and relating to a particular application or other proceeding in the Office. See particularly the rules relating to the filing, processing, or other proceedings of national applications in Subpart B, §§ 1.31 to 1.378; of international applications in Subpart C, §§ 1.401 to 1.499; of reexamination of patents in Subpart D, §§ 1.501 to 1.570; of interferences in Subpart E; §§ 1.601 to 1.690; of extension of patent term in Subpart F, §§ 1.710 to 1.785; and of trademark applications §§ 2.11 to 2.189.

(b) Since each application file should be complete in itself, a separate copy of every paper to be filed in an application should be furnished for each application to which the paper pertains, even though the contents of the papers filed in two or more applications may be identical.

(c) Since different matters may be considered by different branches or sections of the Patent and Trademark Office, each distinct subject, inquiry or order should be contained in a separate letter to avoid confusion and delay in answering letters dealing with different subjects.

(d) Each piece of correspondence, except as provided for in paragraphs (e) and (f) of this section, filed in a patent or trademark application, reexamination proceeding, patent or trademark interference proceeding, patent file or trademark registration file, trademark opposition proceeding, trademark cancellation proceeding, or trademark concurrent use proceeding, which requires a person's signature, must either:

(1) Be an original, that is, have an original signature personally signed in permanent ink by that person; or

(2) Be a copy, such as a photocopy or facsimile transmission (§ 1.6(d)), of an original. In the event that a copy of the original is filed, the original should be retained as evidence of authenticity. If a question of authenticity arises, the Patent and Trademark Office may require submission of the original.

(e) Correspondence requiring person's signature and relating to registration practice before the Patent and Trademark Office in patent cases, enrollment and disciplinary investigations, or disciplinary proceedings must be submitted with an original signature personally signed in permanent ink by that person.

(f) When a document that is required by statute to be certified must be filed, a copy, including a photocopy or facsimile transmission, of the certification is not acceptable.

In addition to the Office of the Solicitor, as specified in 37 CFR 1.1*(a)(3), the Office will now have three separate addresses. The addresses are as follows.

1) FOR PATENT APPLICATIONS AND PATENT-RELATED PAPERS

Correspondence in patent-related matters under the direction of the Assistant Commissioner for Patents should be addressed to:

Assistant Commissioner for Patents
Washington, D.C. 20231

This change will affect correspondence such as: patent applications, responses to notices of informality, requests for extension of time, notices of appeal to the Board of Patent Appeals and Interferences (the Board), briefs in support of an appeal to the Board, requests for oral hearing before the Board, extensions of term of patent, requests for publication of Statutory Invention Registration (SIR), requests for reexamination, statutory disclaimers, certificates of correction, petitions to the Assistant Commissioner for Patents, submission of information disclosure state-

ments, petitions to institute a public use proceeding, petitions to revive abandoned patent applications, and other correspondence related to patent applications and patents which is processed by organizations reporting to the Assistant Commissioner for Patents.

2) FOR TRADEMARK APPLICATIONS AND TRADEMARK-RELATED PAPERS

Correspondence in trademark-related matters under the direction of the Assistant Commissioner for Trademarks should be addressed to:

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

This change will affect all trademark applications and other trademark-related mail, except for trademark documents sent to the Assignment Branch for recordation and requests for certified and uncertified copies of trademark documents. See Change of Address for Trademark Applications and Trademark Related Papers, 1163 OG 80 (June 28, 1994).

3) FOR ALL OTHER CORRESPONDENCE

Unless otherwise specified, correspondence that does not fall into one of the categories designated above should be addressed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

This change will affect such correspondence as: communications with the Board of Patent Appeals and Interferences after jurisdiction of the application has been transferred to the Board, patent services including ** patent copy sales, assignments, library services, requests for lists of patents and SIRs in a subclass, requests for the status of maintenance fee payments, as well as patent practitioner enrollment matters including admission to examination, registration to practice, certificates of good standing, and financial service matters including establishing a deposit account.

All correspondence with the PTO, except for communications relating to pending litigation and certain disciplinary proceedings as specified in 37 CFR 1.1*(a)(3), may continue to be filed directly at the Attorney's Window located in Room 1B03 of Crystal Plaza 2, 2011 ** South Clark Place, Arlington, VA.

> Trademark-related papers may also be filed at the "walk-up" window located on the third floor of the South Tower Building, 2900 Crystal Drive, Arlington, Virginia. Hand delivery of trademark papers and fees directly to the South Tower Building will expedite processing.<

Those who correspond with the PTO are requested not to mix correspondence which will have to be directed to different areas (e.g., Patents and Trademarks) of the Office in a single envelope. At the present time, use of the wrong mailing address will not affect the filing date assigned to any application or correspondence received in the PTO, except as specified in 37 CFR 1.1 * > (a)(3)(iv) <.

** > Except for certain mail addressed incorrectly to the Office of the Solicitor, there will be no penalty for addressing a document to the wrong area within the Office, as long as one of the approved addresses is used. Use of the specific addresses listed within 37 CFR 1.1 is strongly encouraged because it will facilitate the process both for the Office and the filer. Accordingly, a new application incorrectly addressed to the Commissioner will be treated the same as if the application was addressed to the specific Assistant Commissioner.<

All mailed communications are received by the Incoming-Mail Section of the ** > Office of Initial Patent Examination (OIPE) <, which opens and distributes all official mail.

Special boxes have been established to allow the forwarding of particular types of mail to appropriate areas of the Office as quickly as possible. A list of these boxes is published weekly in the *Official Gazette*. Only the specified type of document for a particular box should be placed in an envelope addressed to that box.

If any documents other than the specified type identified for each department are addressed to that department, they will be significantly delayed in reaching the appropriate area for which they were intended.

502 Depositing Correspondence [R-3]

37 CFR 1.5. Identification of application, patent or registration.

(a) No correspondence relating to an application should be filed prior to ** > receipt < of the application number ** from the Patent and Trademark Office. When a letter directed to the Patent and Trademark Office concerns a previously filed application for a patent, it must identify on the top page in a conspicuous location, the application number (consisting of the series code and the serial number; e.g., 07/123,456), or the serial number and filing date assigned to that application by the Patent and Trademark Office, or the international application number of the international application.

Any correspondence not containing such identification will be returned to the sender where a return address is available. The returned correspondence will be accompanied with a cover letter which will indicate to the sender that if the returned correspondence is resubmitted to the Patent and Trademark Office within two weeks of the * > mailing < date on the cover letter, the original date of receipt of the correspondence will be considered by the Patent and Trademark Office as the date of receipt of the correspondence. Applicants may use either the Certificate of Mailing or Transmission procedure under § 1.8 or the Express Mail procedure under § 1.10 for resubmissions of returned correspondence if they desire to have the benefit of the date of deposit in the United States Postal Service. If the returned correspondence is not resubmitted within the two-week period, the date of receipt of the resubmission will be considered to be the date of receipt of the correspondence. The two-week period to resubmit the returned correspondence will not be extended. ** In addition to the application number, all letters directed to the Patent and Trademark Office concerning applications for patents should also state ** the name of the applicant, the title of the invention, the date of filing the same, and, if known, the group art unit or other unit within the Patent and Trademark Office responsible for considering the letter and the name of the examiner or other person to which it has been assigned.

(b) When the letter concerns a patent other than for purposes of paying a maintenance fee, it should state the number and date of issue of the patent, the name of the patentee, and the title of the invention. For letters concerning payment of a maintenance fee in a patent, see the provisions of § 1.366(c).

(c) A letter relating to a trademark application should identify it as such and by the name of the applicant and the serial number and filing date of the application. A letter relating to a registered trademark should identify it by the name of the registrant and by the number and date of the certificate.

(d) A letter relating to a reexamination proceeding should identify it as such by the number of the patent undergoing reexamination, the reexamination request control number assigned to such proceeding, and, if known, the group art unit and name of the examiner to which it has been assigned.

(e) When a paper concerns an interference, it should state the names of the parties and the number of the interference. The name of the examiner-in-chief assigned to the interference (§ 1.610) and the name of the party filing the paper should appear conspicuously on the first page of the paper.

> (f) When a paper concerns a provisional application, it should identify the application as such and include the application number.<

37 CFR 1.6. Receipt of correspondence.

(a) Date of receipt and Express Mail date of deposit. Correspondence received in the Patent and Trademark Office is stamped with the date of receipt except as follows:

(1) > The Patent and Trademark Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia. Except for correspondence transmitted by facsimile as provided for in paragraph (a)(3) of this section, < no correspondence is received in the Patent and Trademark Office on Saturdays, Sundays, or Federal holidays within the District of Columbia.

(2) Correspondence filed in accordance with § 1.10 will be stamped with the date of deposit as "Express Mail" with the United States Postal Service **.

(3) Correspondence transmitted by facsimile to the Patent and Trademark Office will be stamped with the date on which the complete transmission is received in the Patent and Trademark Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the date stamped will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia.

**>(b) *Patent and Trademark Office Post Office pouch.* Mail placed in the Patent and Trademark Office pouch up to midnight on any day, except Saturdays, Sundays, and Federal holidays within the District of Columbia, by the post office at Washington, D.C., serving the Patent and Trademark Office, is considered as having been received in the Patent and Trademark Office on the day it was so placed in the pouch by the U.S. Postal Service.<

(c) Correspondence delivered by hand. In addition to being mailed, correspondence may be delivered by hand during hours the Office is open to receive correspondence.

(d) Facsimile transmission. Except in the cases enumerated below, correspondence, including authorizations to charge a deposit account, may be transmitted by facsimile. The receipt date accorded to the correspondence will be the date on which the complete transmission is received in the Patent and Trademark Office, unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. See § 1.6(a)(3). To facilitate proper processing, each transmission session should be limited to correspondence to be filed in a single application or other proceeding before the Patent and Trademark Office. The application number of a patent or trademark application, the control number of a reexamination proceeding, the interference number of an interference proceeding, the patent number of a patent, or the registration number of a trademark should be entered as a part of the sender's identification on a facsimile cover sheet. Facsimile transmissions are not permitted and, if submitted, will not be accorded a date of receipt in the following situations:

(1) Correspondence as specified in § 1.4(e), requiring an original signature;

(2) **>Certified< documents as specified in § 1.4(f);

(3) Correspondence which cannot receive the benefit of the certificate of mailing or transmission as specified in §§ 1.8(a)(2)(i)(A) through (D) and (F); 1.8(a)(2)(ii)(A) and (D); and 1.8(a)(2)(iii)(A);

(4) Drawings submitted under §§ 1.81, 1.83 through 1.85, 1.152, 1.165, 1.174, 1.437, 2.51, 2.52, or 2.72;

(5) A request for reexamination under § 1.510;

(6) Correspondence to be filed in a patent application subject to a secrecy order under §§ 5.1 through 5.8 of this chapter and directly related to the secrecy order content of the application;

(7) Requests for cancellation or amendment of a registration under section 7(e) of the Trademark Act, 15 U.S.C. 1057(e); and certificates of registration surrendered for cancellation or amendment under section 7(e) of the Trademark Act, 15 U.S.C. 1057(e);

(8) Correspondence to be filed with the Trademark Trial and Appeal Board, except the notice of *ex parte* appeal;

(9) Correspondence to be filed in an interference proceeding which consists of a preliminary statement under § 1.621; a transcript of a deposition under § 1.676 or of interrogatories, cross-interrogato-

ries, or recorded answers under § 1.684(c); or an evidentiary record and exhibits under § 1.653.

(e) *Interruptions in U.S. Postal Service.*

If interruptions or emergencies in the United States Postal Service which have been so designated by the Commissioner occur, the Patent and Trademark Office will consider as filed on a particular date in the Office any correspondence which is:

(1) Promptly filed after the ending of the designated interruption or emergency; and

(2) Accompanied by a statement indicating that such correspondence would have been filed on that particular date if it were not for the designated interruption or emergency in the United States Postal Service. Such statement must be a verified statement if made by a person other than a practitioner as defined in § 10.1(r) of this chapter.

Applications (provisional and nonprovisional), amendments, and other papers may be sent to the Patent and Trademark Office by mail (see MPEP § 501), by facsimile (see MPEP § 502.01) or they may be deposited in the **>Office of Initial Patent Examination (OIPE). Any correspondence sent to the Patent and Trademark Office should include the sender's return address and ZIP code designation.

All correspondence with the Office, except for communications relating to pending litigation and certain disciplinary proceedings as specified in 37 CFR 1.1(a)(3), may be filed directly at the Customer Service Window at the following address, or delivered by private courier to:

Assistant Commissioner for Patents
[or Commissioner of Patents and Trade-
marks, or Assistant Commissioner for
Trademarks]
USPTO Correspondence and Mail Division
Crystal Plaza Building 2, Room 1B03
2011 South Clark Place
Arlington, VA 22202

Trademark-related papers may also be filed or delivered by private courier to the "walk-up" window located on the third floor of the South Tower Building, 2900 Crystal Drive, Arlington, Virginia. Hand delivery of trademark papers and fees directly to the South Tower Building is recommended, to expedite processing.<

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All correspondence related to a national patent application already filed with the Patent and Trademark Office must include the identification of the serial number and either the series code or the filing date assigned to the application by the Office. Any correspondence not containing the proper identification set forth in 37 CFR 1.5(a) must be sent by the group with a signed note to the

****>OIPE<** for return to the sender. Each paper should be inspected to assure that the papers being returned contain either a mail room date stamp or a group date stamp. A minor error in the identification of the application can be corrected by the group provided the correct identification can be quickly discovered. Examples of minor errors are transposed numbers, typographical errors, and listing the parent application number. The failure to give any serial number is not a minor error. The Office often experiences difficulty in matching incoming papers with the application file to which they pertain because insufficient or erroneous information is given. This applies especially to amendments, powers of attorney, changes of address, status letters, petitions for extension of time, and other petitions.

Frequently, there are errors in the serial number or in the group art unit number, or the incoming paper uses the old group art unit number where an application has been transferred and acted on by a different examining group.

Where the group art unit number is entirely omitted, the routine operations of the Correspondence and Mail Division must be interrupted solely for the purpose of determining the location of the application so that the communication can be properly routed. Under these circumstances, the efficiency of the Correspondence and Mail Division is impaired and the incoming paper is delayed in reaching its proper destination. Where such papers are not essential to compliance with a statutory period or time limit for response, they may be returned for completion to identify the location of the files.

It would be of great assistance to the Office if *all* incoming papers pertaining to a filed application carried the following items:

1. Application number (checked for accuracy).
2. Group art unit number (copied from filing receipt or most recent Office Action).
3. Filing date.
4. Name of the examiner who prepared the most recent Office Action.
5. Title of invention.

Applicants may be reminded of this provision by including Form Paragraph 5.01.

¶ 5.01 *Proper Heading for Incoming Papers.*

It would be of great assistance to the Office if all incoming papers pertaining to a filed application carried the following items:

1. Application number (checked for accuracy, including series code and serial no.).

2. Group art unit number (copied from most recent Office communication).
3. Filing date.
4. Name of the examiner who prepared the most recent Office action.
5. Title of invention.

During pre-examination processing, drawings are temporarily separated from the rest of the application papers. To facilitate the matching of drawings with the application, it would be helpful if the applicant's name, docket number, and the title of the invention were put on the back of the drawings. This may be done by writing lightly on the drawings or by using gummed labels.

When the Office receives formal or substitute drawings for patent applications, a cover letter identifying the drawings by application number should accompany them. The application number should be placed on each sheet of drawings in accordance with 37 CFR 1.84(c). It is possible to associate the drawings with the files when this information is missing.

Identifying indicia should include the application number or the title of the invention, inventor's name, docket number (if any), and the name and telephone number of a person to call. This information should be placed on the back of each sheet of drawings with a minimum distance of 1.5 cm (5/8-inch) down from the top of the page.

****>It<** is requested that the submission of additional or supplemental papers on a newly filed application be deferred until ****>an application number<** has been received. It also would be appreciated if the filing of additional papers relating to an allowed application were deferred until a notice of allowance (PTOL-85) is received.

Patent and Trademark documents which have no particular time or sequence requirements should be filed with materials submitted in response to the statutory or regulatory requirements. Examples are certified copies of foreign documents to support priority in patent applications, changes of power of attorney, or changes in mailing address following first action.

All letters relating to a reexamination proceeding should identify the proceeding involved by patent number and reexamination request control number.

ISSUE BATCH NUMBER

All papers filed by applicant in the Office after receiving the Notice of Allowance and before the time the Issue Fee

Receipt is received should include the Issue Batch Number. The Issue Batch Number is printed on the Notice of Allowance form under the heading "Batch No.". The Issue Batch Number consists of a capital letter followed by two digits, for example; "A03", "D18", "F42", "J79." Use of the Issue Batch Numbers is important since the allowed applications are filed by these numbers.

Any paper filed after receiving the Issue Fee Receipt should include the indicated patent number rather than the Issue Batch Number. At this time in the processing, the Issue Batch Number is no longer useful since the application has been removed from the batch at the time the patent number was assigned.

If the above suggestions are adopted, the processing of both new and allowed applications could proceed more efficiently and promptly through the Patent and Trademark Office.

HAND-DELIVERY OF PAPERS

Any paper which relates to a pending application may be personally delivered to an examining group. However, the examining group will accept the paper only if: (1) the paper is accompanied by some form of receipt which can be handed back to the person delivering the paper; and (2) the examining group being asked to receive the paper is responsible for acting on the paper. Patent applications, including those filed under 37 CFR 1.60 and 1.62, may be delivered in person **>addressed to the Assistant Commissioner for Patents, USPTO Office of Initial Patent Examination, Crystal Plaza Building 2, Room 1B03, 2011 South Clark Place, Arlington, VA 22202<, but not to the examining groups.

The receipt accompanying a hand-delivered paper may take the form of a card identifying the paper. The identifying data on the card should be so complete as to leave no uncertainty as to the paper filed. For example, the card should contain the applicant's name(s), application *>number<, the filing date, and a description of the paper being filed. If more than one paper is being filed for the same application, the card should contain a description of each paper or item.

Under this procedure, the paper and receipt will be date stamped with the group date stamp. Group personnel receiving a paper will check it against the receipt to make sure that the paper is accurately described on the receipt and that the receipt does not list papers which are not being filed. The receipt will be handed back to the person hand-delivering the paper. The paper will be cor-

related with the application and made an official paper in the file, thereby avoiding the necessity of processing and forwarding the paper to the examining group via the Mail Room.

If duplicate copies of a request for an extension of time under 37 CFR 1.136(b) are hand-delivered to an examining group, both copies are dated, either stamped approved or indicated as being denied, and signed. The duplicate copy is returned to the delivering person regardless of whether the request was signed by a registered attorney or agent, either of record or acting in a representative capacity, the applicant, or the assignee of record of the entire interest.

The examining group will accept and date stamp a paper, other than an application, even though the paper is accompanied by a check or the paper contains an authorization to charge a Deposit Account. However, in such an instance, the paper will be hand-carried by group personnel to the Office of Finance for processing and then made an official paper in the file.

All such papers, together with the cash, checks, or money orders, shall be hand-carried to the *>Customer Service< Window, >Crystal Plaza Building 2,< Room 2-1B01 **.

>"<EXPRESS MAIL>"< SERVICE

There are two types of >"<Express Mail>"< delivery offered by the U.S. Postal Service — "Post Office to Addressee" and "Post Office to Post Office." The only type of service which can be used for >"<Express Mail>"< directed to the Patent and Trademark Office is >the< "Post Office to Addressee" >service of the U.S. Postal Service. 37 CFR 1.10.< This service provides for the use of a mailing label which clearly indicates the date on which a particular paper or fee was deposited.

The *>addresses< that should be used for >"<Express Mail>"< sent to the Patent and Trademark Office **>are set forth in 37 CFR 1.1 (see MPEP § 501).<

"Post Office to Post Office" Express Mail *does not* provide for delivery but instead is retained at the postal facility of the addressee for pickup. The Postal Service *does not* notify the addressee that this type of Express Mail has been received and is awaiting pickup. If not picked up, this mail is held for 15 days and then returned to the sender.

Therefore, since the Patent and Trademark Office does not have resources for picking up any mail, including Express Mail, the "Post Office to Post Office" Express Mail will not reach the Patent and Trademark Office.

See MPEP § 513 for the use of >the< Express Mail
** Mailing procedure of 37 CFR 1.10.

502.01 Correspondence Transmitted by Facsimile [R-3]

37 CFR 1.6. *Receipt of correspondence.*

(d) *Facsimile transmission.* Except in the cases enumerated below, correspondence, including authorizations to charge a deposit account, may be transmitted by facsimile. The receipt date accorded to the correspondence will be the date on which the complete transmission is received in the Patent and Trademark Office, unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. See § 1.6(a)(3). To facilitate proper processing, each transmission session should be limited to correspondence to be filed in a single application or other proceeding before the Patent and Trademark Office. The application number of a patent or trademark application, the control number of a reexamination proceeding, the interference number of an interference proceeding, the patent number of a patent, or the registration number of a trademark should be entered as a part of the sender's identification on a facsimile cover sheet. Facsimile transmissions are not permitted and, if submitted, will not be accorded a date of receipt in the following situations:

- (1) Correspondence as specified in § 1.4(e), requiring an original signature;
- (2) **>Certified< documents as specified in § 1.4(f);
- (3) Correspondence which cannot receive the benefit of the certificate of mailing or transmission as specified in §§ 1.8(a)(2)(i)(A) through (D) and (F); 1.8(a)(2)(ii)(A) and (D); and 1.8(a)(2)(iii)(A);
- (4) Drawings submitted under §§ 1.81, 1.83 through 1.85, 1.152, 1.165, 1.174, 1.437, 2.51, 2.52, or 2.72;
- (5) A request for reexamination under § 1.510;
- (6) Correspondence to be filed in a patent application subject to a secrecy order under §§ 5.1 through 5.8 of this chapter and directly related to the secrecy order content of the application;
- (7) Requests for cancellation or amendment of a registration under section 7(e) of the Trademark Act, 15 U.S.C. 1057(e); and certificates of registration surrendered for cancellation or amendment under section 7(e) of the Trademark Act, 15 U.S.C. 1057(e);
- (8) Correspondence to be filed with the Trademark Trial and Appeal Board, except the notice of *ex parte* appeal;
- (9) Correspondence to be filed in an interference proceeding which consists of a preliminary statement under § 1.621; a transcript of a deposition under § 1.676 or of interrogatories, cross-interrogatories, or recorded answers under § 1.684(c); or an evidentiary record and exhibits under § 1.653.

>Aside from the timeliness treatment provided when using a Certificate of Transmission in accordance with 37 CFR 1.8,< the date of receipt accorded to any correspondence permitted to be sent by facsimile transmission is the date the complete transmission is received by an Office facsimile unit, unless the transmission is completed on a Saturday, Sunday, or Federal holiday within the District of Columbia. Correspondence for which transmission was completed on a Saturday, Sunday, or Federal holiday within the District of Columbia, will be accorded a receipt date of the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia. For example, a facsimile transmission to the Office from California starting on a Friday at 8:45 p.m. Pacific time and taking 20 minutes, would be completed at 9:05 p.m. Pacific time. The complete transmission would be received in the Office around 12:05 a.m. Eastern time on Saturday. The receipt date accorded to the correspondence is the date of the following business day, which in this case, would be Monday (assuming that Monday was not a Federal holiday within the District of Columbia). >Note however, that if the certificate of transmission is available (for documents not proscribed by 37 CFR 1.8(a)(2)), then the above facsimile may be considered timely filed on Friday if it contains a certificate of transmission and is in compliance with 37 CFR 1.8(a)(1)(i)(B) and (ii).<

37 CFR 1.6(d) specifies the types of correspondence which may be transmitted by facsimile. These would include amendments, declarations, petitions, issue fee transmittals and authorizations to charge deposit accounts. The situations where transmissions by facsimile are prohibited are identified in 37 CFR 1.6(d)(1)-(9). Prohibitions cover situations where originals are required as specified in 37 CFR 1.4 (e) and (f), and situations where accepting a facsimile transmission would be unduly burdensome on the Office. As a courtesy, the Office will attempt to notify senders whenever correspondence is sent to the Office by facsimile transmission that falls within one of these prohibitions. Senders are cautioned against submitting correspondence by facsimile transmission which is not permitted under 37 CFR 1.6(d) since such correspondence will not be accorded a receipt date.

The following list itemizes types of correspondence which *may not* be filed by facsimile transmission, and, if

submitted by facsimile, will not be accorded a date of receipt:

Correspondence Relative to Patents and Patent Applications Where Filing by Facsimile Transmission is Not Permitted

(1) A document that is required by statute to be certified;

(2) A national patent application specification and drawing (provisional or nonprovisional) or other correspondence for the purpose of obtaining an application filing date;

(3) Drawings submitted under 37 CFR 1.81, 1.83–1.85, 1.152, 1.165, 1.174, or 1.437;

(4) Correspondence in an interference which an Administrative Patent Judge orders to be filed by hand or “Express Mail”;

(5) Agreements between parties to an interference under 35 U.S.C. 135(c);

(6) Correspondence to be filed in an interference proceeding which consists of a preliminary statement under 37 CFR 1.621; a transcript of a deposition under 37 CFR 1.676 or of interrogatories, cross-interrogatories, or recorded answers under 37 CFR 1.684(c); or an evidentiary record and exhibits under 37 CFR 1.653;

(7) Correspondence to be filed in a patent application subject to a secrecy order under 37 CFR 5.1–5.8 of this chapter and directly related to the secrecy order content of the application;

(8) An international application for patent;

(9) A copy of the international application and the basic national fee necessary to enter the national stage, as specified in 37 CFR 1.494(b) or 37 CFR 1.495(b);

(10) A request for reexamination under 37 CFR 1.510.

Under 37 CFR 1.6(d)(4), drawings submitted under 37 CFR 1.81, 1.83–1.85, 1.152, 1.165, 1.174, or 1.437 may not be filed by facsimile in patent applications. However, applicants may submit by facsimile transmission proposed drawing corrections for approval by the Office.

See MPEP § 1834.01 for a discussion concerning facsimile transmissions in PCT applications.

502.02 Correspondence Signature Requirements [R-3]

37 CFR 1.4. Nature of correspondence and signature requirements.

(d) Each piece of correspondence, except as provided * in paragraphs (e) and (f) of this section, filed in a patent or trademark application, reexamination proceeding, patent or trademark interference proceeding, patent file or trademark registration file, trademark opposition proceeding, trademark cancellation proceeding, or trademark concurrent use proceeding, which requires a person's signature, must either:

(1) Be an original, that is, have an original signature personally signed in permanent ink by that person; or

(2) Be a copy, such as a photocopy or facsimile transmission (§ 1.6(d)), of an original. In the event that a copy of the original is filed, the original should be retained as evidence of authenticity. If a question of authenticity arises, the Patent and Trademark Office may require submission of the original.

(e) Correspondence requiring person's signature and relating to registration practice before the Patent and Trademark Office in patent cases, enrollment and disciplinary investigations, or disciplinary proceedings must be submitted with an original signature personally signed in permanent ink by that person.

(f) When a document that is required by statute to be certified must be filed, a copy, including a photocopy or facsimile transmission, of the certification is not acceptable.

Correspondence filed in the Office, which requires a person's signature, may be an original, or a copy thereof. The word original, as used herein, is defined as correspondence which is personally signed in permanent ink by the person whose signature appears thereon. Where copies of correspondence are acceptable, photocopies or facsimile transmissions may be filed. For example, a photocopy or facsimile transmission of an original of an amendment, declaration (e.g., under 37 CFR 1.63 or 1.67), petition, issue fee transmittal form, authorization to charge a deposit account, etc., may be submitted in a patent application. Where copies are permitted, second and further generation copies (i.e., copy of a copy) are acceptable. For example, a client may fax a paper to an attorney and the attorney may then fax the paper to the office, provided the paper is eligible to be faxed (see MPEP § 502.1). The original, if not submitted to the Office, should be retained as evidence of proper execution in the event that questions arise as to the authenticity of the signature reproduced on the photocopy or facsimile-transmitted correspondence. If a question of authenticity arises, the Office may require submission of the original.

When a document that is required by statute to be certified must be filed (such as a certified copy of a foreign patent application, pursuant to 35 U.S.C. 119 or a certified copy of an international application, pursuant to 35 U.S.C. 365) a copy of the certification, including a photocopy or facsimile transmission, will not be acceptable. The requirement for an original certification does not apply to certifications such as required under 37 CFR 1.8, * 1.60, 1.97(e) and 3.73(b), since these certifications are not required by statute.

503 Serial Number and Filing Receipt [R-3]

37 CFR 1.54. Parts of application to be filed together; filing receipt.

(a) It is desirable that all parts of the complete application be deposited in the Office together; otherwise a letter must accompany each part, accurately and clearly connecting it with the other parts of the application. See § 1.53 with regard to completion of an application.

(b) Applicant will be informed of the application * number and filing date by a filing receipt.

Application numbers consisting of a series code and a serial number are assigned **> by the Office of Initial Patent Examination (OIPE)< immediately after mail has been opened.

If a self-addressed postcard is submitted with a patent application, that postcard will be *> provided< with both the receipt date and *> application< number prior to returning it to the addressee. >The application number identified on such a postcard receipt is merely the preliminary assignment of an application number to the application, and should not be relied upon (e.g., with respect to foreign filings) as necessarily representing the application number assigned to such application. The filing receipt represents the official assignment by the PTO of a specific application number to a particular application. See 37 CFR 1.53(b)(2). The application number officially assigned to an application on the filing receipt may differ from the application number identified on a postcard receipt submitted with such application, and, as between inconsistent filing receipts and postcard receipts, the application number on the filing receipt is controlling.<

The identifying data on the postcard should include: (1) applicant's name(s); (2) title of invention; (3) number of pages of specification, claims (for nonprovisional applications), and sheets of drawing; (4) whether oath or declaration included; (5) provisional application cover sheet; and (6) amount and manner of paying the fee.

A return postcard should be attached to *each* patent application for which a receipt is desired.

It is important that the return postcard itemize all of the components of the application. If the postcard does not itemize each of the components of the application, it will not serve as evidence that any component which was not itemized was received by the Office.

It should be recognized that the identification of an application by serial number does not necessarily signify that the Patent and Trademark Office has accepted the application as complete (37 CFR 1.53(a)).

A nonprovisional application is entitled to a filing date as of the date of the identification of all of the inventors and receipt of the specification, including claims, and any required drawing. **>The filing receipt will be mailed at the time a determination is made that the application meets the minimum requirements to receive a filing date.< The oath or declaration and filing fee may be filed later than the remaining application papers, but if so, they must be accompanied by the required surcharge. If the oath or declaration, and/or filing fee, and appropriate surcharge are not timely filed, the application will be abandoned **.

A provisional application is entitled to a filing date as of the date of the identification of all the inventors as required by 37 CFR 1.41 and receipt of the specification and any required drawing(s), and a cover sheet identifying the application as a provisional application. See 37 CFR 1.53(b)(2).

In the **>OIPE<, each application which meets the requirements is given a filing date. It is important, when referring to application files, to identify them by their filing dates as well as by application numbers.

The **>OIPE< mails a filing receipt to the attorney or agent, if any, otherwise to the applicant, for each complete application filed, giving the *> application< number, filing date, and group to which assigned. See MPEP § 506.

Attorney docket numbers must be limited to a maximum of 12 characters to prevent truncation. The Patent Application Location and Monitoring (PALM) system data base allows a maximum of 12 characters for the attorney docket numbers. Spaces, slashes, and hyphens will no longer be included in the entered docket number on the official filing receipt. In an application where CASE or NAVY-CASE appears before the first character in the docket number, only the

characters after CASE or NAVY-CASE will be entered on the official filing receipt.

In the **>OIPE<, the application papers are placed in a file wrapper and certain data placed thereon.

Applications which are entitled to a filing date and are filed, whether by regular mail or "Express Mail" under 37 CFR 1.10, by hand-delivery or otherwise, will not be returned to applicant even if requested. See 37 CFR 1.59. Accordingly, applicants must be careful not to file applications which are not intended to be filed; e.g., duplicates of applications already filed. Since 37 CFR 1.26(a) precludes refund of an application filing fee when applicant desires to withdraw an application, any request by applicant not to process or charge an application filing fee because the application was not intended to be filed must be in the form of a petition under 37 CFR 1.183 requesting suspension of the rules to the extent that the filing fee not be processed or charged. Any such petition must include the fee set forth in 37 CFR 1.17(h) and must be accompanied by an express abandonment of the application in accordance with 37 CFR 1.138. In order for such a petition to be granted, it must ordinarily be filed and acted upon prior to the date on which the application filing fee is processed or charged by the Office with regard to the application.

RETURN POSTCARD

If a receipt of any paper filed in the Patent and Trademark Office is desired, it may be obtained by enclosing with the paper a self-addressed postcard identifying the paper. The Patent and Trademark Office will stamp the receipt date on the card and place it in the outgoing mail.

The identifying data on the card should be so complete as to clearly identify the paper for which receipt is requested. For example, the card should identify the applicant's name(s), serial number, filing date, interference number, etc., and the paper(s) should be identified by specifying the type thereof, namely affidavit, amendment, appeal, components of applications, brief, drawings, fees, motions, supplemental oath or declaration, petition, etc.

Upon return of a postcard receipt from the PTO, the receipt should be promptly reviewed by the person who filed the papers to ensure that each itemized paper was received by the PTO. If the postcard receipt has been annotated to indicate that a particular paper was not re-

ceived, the postcard receipt will not serve as *prima facie* evidence of receipt of that paper in the PTO. Likewise, the postcard receipt will not serve as *prima facie* evidence of receipt of papers which are not adequately itemized. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application if one of the components is found to be missing by the PTO. Instead, each separate component; e.g., the number of pages of specification, number of claims (nonprovisional applications), number of sheets of drawings, cover sheet (provisional applications), etc. should be itemized on the postcard.

The person receiving the paper(s) in the Patent and Trademark Office should check the listing on the postcard against the papers being filed to be sure they are properly identified and that all the items listed are present. If any of the items listed are not being filed, those items should be crossed off and the card initialed by the person receiving the papers.

A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO.

504 Assignment of Application for Examination [R-1]

The Application Division assigns * >a nonprovisional< application to the examining group to which it appears to belong. >Provisional applications will not be examined.<

505 "Office Date" Stamp of Receipt [R-3]

37 CFR 1.6. Receipt of correspondence.

(a) *Date of receipt and Express Mail date of deposit.* Correspondence received in the Patent and Trademark Office is stamped with the date of receipt except as follows:

(1) **>The Patent and Trademark Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia. Except for correspondence transmitted by facsimile as provided for in paragraph (a)(3) of this section, no correspondence is received in the Patent and Trademark Office on Saturdays, Sundays, or Federal holidays within the District of Columbia.<

(2) Correspondence filed in accordance with § 1.10 will be stamped with the date of deposit as "Express Mail" with the United States Postal Service **.

(3) Correspondence transmitted by facsimile to the Patent and Trademark Office will be stamped with the date on which the complete transmission is received in the Patent and Trademark Office unless that date is a Saturday, Sunday, or Federal holiday within the District of

Columbia, in which case the date stamped will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia.

The Office stamps papers and fees with the date of their receipt in the Patent and Trademark Office. The stamp is referred to as the "Office Date" stamp.

When the last day for taking any action or paying any fee in the U.S. Patent and Trademark Office falls on a Saturday, Sunday, or a Federal holiday within the District of Columbia, the action or the fee is considered timely if the action is taken or the fee is paid on the next succeeding business day.

WARNING: Since a provisional application can be pending for no more than twelve months, the last day of pendency may occur on a Saturday, Sunday, or Federal holiday within the District of Columbia which for copendency would require the nonprovisional application to be filed prior to the Saturday, Sunday, or Federal holiday. See 37 CFR 1.78(a)(3). >However, note that new patent applications filed in accordance with 37 CFR 1.10 will be stamped by the Office with the date of deposit as "Express Mail" with the United States Postal Service. For example, if a new patent application is deposited in "Express Mail" in accordance with 37 CFR 1.10 on a Saturday and the United States Postal Service gives it a date of deposit of Saturday, the Office will accord and stamp the correspondence with the Saturday date. 37 CFR 1.6(a)(2).<

If an application includes the necessary components for a filing date (see 37 CFR 1.41(a) and 1.53(b) and MPEP § 506), the "Office Date" stamp establishes the "filing date." Applications will not be accepted and stamped in the examining groups. They must be date stamped in the Mail Room.

506 Completeness of Original Application [R-2]

37 CFR 1.53. Serial number, filing date, and completion of application.

(a) Any application for a patent received in the Patent and Trademark Office will be assigned an application number for identification purposes.

(b)(1) The filing date of an application for patent filed under this section, except for a provisional application, is the date on which: a specification containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75; and any drawing required by § 1.81(a), are filed in the Patent and Trademark Office in the name of the actual inventor or inventors as required by § 1.41. No new

matter may be introduced into an application after its filing date § 1.118). If all the names of the actual inventor or inventors are not supplied when the specification and any required drawing are filed, the application will not be given a filing date earlier than the date upon which the names are supplied unless a petition with the fee set forth in § 1.17(i) is filed which sets forth the reasons the delay in supplying the names should be excused. A continuation or divisional application (filed under the conditions specified in 35 U.S.C. 120 or 121 and § 1.78(a)) may be filed under this section, § 1.60 or § 1.62. A continuation-in-part application may be filed under this section or § 1.62.

(2) The filing date of a provisional application is the date on which: a specification as prescribed by 35 U.S.C. 112, first paragraph; and any drawing required by § 1.81(a), are filed in the Patent and Trademark Office in the name of the actual inventor or inventors as required by § 1.41. No amendment, other than to make the provisional application comply with all applicable regulations, may be made to the provisional application after the filing date of the provisional application. If all the names of the actual inventor or inventors are not supplied when the specification and any required drawing are filed, the provisional application will not be given a filing date earlier than the date upon which the names are supplied unless a petition with the fee set forth in § 1.17(q) is filed which sets forth the reasons the delay in supplying the names should be excused.

(i) A provisional application must also include a cover sheet identifying the application as a provisional application. Otherwise, the application will be treated as an application filed under § 1.53(b)(1).

(ii) An application for patent filed under § 1.53(b)(1) may be treated as a provisional application and be accorded the original filing date provided that a petition requesting the conversion, with the fee set forth in § 1.17(q), is filed prior to the earlier of the abandonment of the § 1.53(b)(1) application, the payment of the issue fee, the expiration of 12 months after the filing date of the § 1.53(b)(1) application, or the filing of a request for a statutory invention registration under § 1.293. The grant of any such petition will not entitle applicant to a refund of the fees which were properly paid in the application filed under § 1.53(b)(1).

(iii) A provisional application shall not be entitled to the right of priority under § 1.55 or 35 U.S.C. 119 or 365(a) or to the benefit of an earlier filing date under § 1.78 or 35 U.S.C. 120, 121 or 365(c) of any other application. No claim for priority under § 1.78(a)(3) may >be made in a design application based on a provisional application. No request under § 1.293 for a statutory invention registration may be filed in a provisional application. The requirements of §§ 1.821 - 1.825 regarding application disclosures containing nucleotide and/or amino acid sequences are not mandatory for provisional applications.<

(c) If any application is filed without the specification, drawing or name, or names, of the actual inventor or inventors required by paragraph (b)(1) or (b)(2) of this section, applicant will be so notified and given a time period within which to submit the omitted specification, drawing, name, or names, of the actual inventor, or inventors, in order to obtain a filing date as of the date of filing of such submission. A copy of the "Notice of Incomplete Application" form notifying the applicant should accompany any response thereto submitted to the Office. If the omission is not corrected within the time period set, the application will be returned or otherwise disposed of; the fee, if submitted, will be refunded less the handling fee set forth in § 1.21(n). Any request for review of a refusal to

accord an application a filing date must be by way of a petition accompanied by the fee set forth in § 1.17(i), if the application was filed under § 1.53(b)(1), or by the fee set forth in § 1.17(q), if the application was filed under § 1.53(b)(2).

(d)(1) If an application which has been accorded a filing date pursuant to paragraph (b)(1) of this section does not include the appropriate filing fee or an oath or declaration by the applicant, applicant will be so notified, if a correspondence address has been provided and given a period of time within which to file the fee, oath, or declaration and to pay the surcharge as set forth in § 1.16(e) in order to prevent abandonment of the application. A copy of the "Notice to File Missing Parts" form mailed to applicant should accompany any response thereto submitted to the Office. If the required filing fee is not timely paid, or if the processing and retention fee set forth in § 1.21(l) is not paid within one year of the date of mailing of the notification required by this paragraph, the application will be disposed of. No copies will be provided or certified by the Office of an application which has been disposed of or in which neither the required basic filing fee nor the processing and retention fee has been paid. The notification pursuant to this paragraph may be made simultaneously with any notification pursuant to paragraph (c) of this section. If no correspondence address is included in the application, applicant has two months from the filing date to file the basic filing fee, oath or declaration and to pay the surcharge as set forth in § 1.16(e) in order to prevent abandonment of the application; or, if no basic filing fee has been paid, one year from the filing date to pay the processing and retention fee set forth in § 1.21(l) to prevent disposal of the application.

(2) If a provisional application which has been accorded a filing date pursuant to paragraph (b)(2) of this section does not include the appropriate filing fee or the cover sheet required by § 1.51(a)(2), applicant will be so notified if a correspondence address has been provided and given a period of time within which to file the fee, cover sheet and to pay the surcharge as set forth in § 1.16(l) in order to prevent abandonment of the application. A copy of the "Notice to File Missing Parts" form mailed to applicant should accompany any response thereto submitted to the Office. If the required filing fee is not timely paid, the application will be disposed of. No copies will be provided or certified by the Office of an application which has been disposed of or in which the required basic filing fee has not been paid. The notification pursuant to this paragraph may be made simultaneously with any notification pursuant to paragraph (c) of this section. If no correspondence address is included in the application, applicant has two months from the filing date to file the basic filing fee, cover sheet and to pay the surcharge as set forth in § 1.16(l) in order to prevent abandonment of the application.

(e)(1) An application for a patent filed under paragraph (b)(1) of this section will not be placed upon the files for examination until all its required parts, complying with the rules relating thereto, are received, except that certain minor informalities may be waived subject to subsequent correction whenever required.

(2) A provisional application for a patent filed under paragraph (b)(2) of this section will not be placed upon the files for examination and will become abandoned no later than twelve months after its filing date pursuant to 35 U.S.C. 111(b)(1).

INCOMPLETE NONPROVISIONAL APPLICATIONS

If the nonprovisional application papers do not identify all the inventors or include at least a specification containing a description and at least one claim and **>a< drawing, **>if necessary under< 35 U.S.C. 113 **>(first sentence)<, or if the submitted application papers are too informal to be given a filing date, the case is held in the Application Division as an incomplete application and the applicant is informed of the shortcomings of the papers. No filing date is granted until the incompleteness is corrected.

Form PTO-1123, Notice of Incomplete Application Papers, is prepared and mailed by the Application Division when nonprovisional application papers are deemed incomplete under 35 U.S.C. 111(a).

Such incompleteness may consist of the omission of any one of the following parts of an application. The component parts of a nonprovisional application necessary to obtain a filing date are:

An identification of the names of all of the inventors.

A specification, 35 U.S.C. 112.

A claim, 35 U.S.C. 112.

A drawing, if **>necessary under< 35 U.S.C. 113 **>(first sentence)<.

See 37 CFR 1.53(b)(1).

Even though an application purports to include the component parts necessary to obtain a filing date, the application will still be held to be incomplete and a filing date will be refused if the component parts contain more than minor informalities resulting in the application not being acceptable for examination. See 37 CFR 1.53(c). ** If the documents purporting to be a specification are so obviously informal and incoherent that they would clearly not constitute a specification as required by 37 CFR 1.71 and 35 U.S.C. 112, the application would not be acceptable for examination and would not be accorded a filing date until corrections are made. The filing date of the application would be the date the corrections were made.

Filing dates are accorded to nonprovisional applications filed without the basic filing fee and without the oath or declaration. In such cases, a notice is mailed by the Application Division requiring that at least the basic filing fee and the oath or declaration be filed, accompanied by a surcharge (§ 1.16(e)). In those cases where the basic filing fee is paid, but additional fees are required, a

notice is mailed by the examining group, requiring that the balance of the fee be paid. See 37 CFR 1.53(d)(1).

Occasionally, nonprovisional applications which have already been signed by the inventors contain informal claims that the attorney or agent feels should not be present in the application upon filing. However, since alteration after execution by the inventor and before filing is prohibited, such applications must be filed by the attorney or agent in the form in which they were executed by the inventors. A nonprovisional application may be filed with a preliminary amendment which is limited to the cancellation of claims. This will diminish the number of claims to be considered for calculation of the filing fee. Any other changes to the application should be the subject of a separate amendment which may be entered after the filing fee has been calculated and the filing date granted. If a preliminary amendment which cancels claims does not accompany the application at the time the application is filed, the notification of insufficient fee will inform the inventor, attorney, or agent of the possibility of correcting the insufficient payment by either (1) paying the additional required fee amount, or (2) filing an amendment which cancels claims to where the remaining claims are covered by the fee submitted upon filing. However, no refund will be made once the fee for claims is properly paid, even though claims are later canceled.

In the past, the Application Division has reviewed the claimed subject matter of newly filed nonprovisional applications to determine whether a filing date should be granted. Such applications included those drawn to perpetual motion devices and methods of doing business and applications for reissue signed by assignees or filed more than 2 years after the grant of the patent which appear to contain broadened reissue claims.

Under the current practice, a filing date is normally granted in such cases if the nonprovisional application is otherwise sufficient and then forwarded to the examiner for consideration and decision during the regular course of examination.

INCOMPLETE PROVISIONAL APPLICATIONS

If the provisional application papers ** do not identify all the inventors or include at least a specification containing a description and **>a< drawing, **>if necessary under < 35 U.S.C. 113 **>(first sentence)< or if the submitted application papers are too informal to be given a filing date, the case is held in the Application Divi-

sion as an incomplete application and the applicant is informed of the shortcomings of the papers. No filing date is granted until the incompleteness is corrected.

Such incompleteness may consist of the omission of any one of the following parts of an application. The component parts of a provisional application necessary to obtain a filing date are:

**

An identification of the names of all of the inventors.

A specification, 35 U.S.C. 112, first paragraph.

A drawing, if **>necessary under< 35 U.S.C. 113 **>(first sentence)<.

Even though an application purports to include the component parts necessary to obtain a filing date, the application will still be held to be incomplete and a filing date will be refused if the component parts contain more than minor informalities resulting in the application not being acceptable. See 37 CFR 1.53(c). ** If the documents purporting to be a specification are so obviously informal and incoherent that they would clearly not constitute a specification as required by 37 CFR 1.71 and 35 U.S.C. 112, the application would not be acceptable and would not be accorded a filing date until corrections are made. The filing date of the application would be the date the corrections were made. If all the names of the actual inventor or inventors are not supplied when the specification and any required drawing are filed, the provisional application will not be given a filing date earlier than the date upon which the names are supplied unless a petition with the fee set forth in § 1.17(q) is filed which sets forth the reasons the delay in supplying the names should be excused. A provisional application will not be examined. However, a provisional application which does not include a cover sheet identifying the application as a provisional application will be treated as an application filed under 37 CFR 1.53(b)(1).

>NOTE: An application that does not include a cover sheet identifying the application as a provisional application will be treated as a nonprovisional application. See 37 CFR 1.53(b)(2)(i).<

NOTE: No amendment, other than to make the provisional application comply with all the applicable regulations, may be made to the provisional application after the filing date of the provisional application. See 37 CFR 1.53(b)(2).

INFORMAL APPLICATIONS

An application is informal if it is typed on both sides of the paper, or is not permanent, legible, or reproducible. If such informalities are timely corrected, the application is given the filing date on which the original informal papers were filed.

The Application Division accords a filing date, as of the date indicated by the "Office Date" stamp (see MPEP § 505), to application papers which include the names of all of the inventors, a specification containing a description and at least one claim (nonprovisional applications), and *a drawing*, if necessary under 35 U.S.C. 113 (first sentence) but are informal because they do not comply with the rules or notices. In such applications, the Application Division prepares form PTO-152, Notice of Informal Application, indicating the informality and places it in the file wrapper. The examining group mails the letter to applicant. Failure to correct the informality within the specified time results in abandonment of the application.

The letter of transmittal accompanying the filing of continuing applications should include such additional information as the identification by application number of a provisional or parent application, its status, and location (if known) in the Patent and Trademark Office. The supplying of this information will simplify the processing of these applications.

506.01 Return of Incomplete Application

If a request is made, the parts of an incomplete application which has not been assigned a filing date may be returned by the Application Division. They may be used by the applicant as part of a later complete application if the missing parts are later supplied. See 37 CFR 1.53.

506.02 Review of Refusal To Accord Filing Date [R-3]

The filing date of the provisional or nonprovisional application is the date of receipt in the Office of the application which identifies the names of all the inventors and includes a specification containing description pursuant to 37 CFR 1.71 and at least one claim (nonprovisional applications) pursuant to 37 CFR 1.75, and any drawings required by 37 CFR 1.81(a). See 37 CFR 1.41(a) and 1.53(b)(1) and (b)(2).

If any of these items are missing, applicant will be notified to file them and the filing date will be the date of receipt of the missing part(s). If the oath or declaration for a nonprovisional application was executed and filed with the application, a supplemental oath or declaration by the inventor is required in some circumstances; e.g., where the missing item is the claim, specification, or a drawing. The supplemental declaration must identify the missing item and indicate, as appropriate, that it accurately claims, describes, or illustrates applicant's invention. See MPEP § 601.01(d)-(f) where the application is filed without all the figures of the drawing. An error in inventorship does not raise a filing date issue, unless no inventors are named or the application is originally filed under 37 CFR 1.53(b) with "et al." as part of the inventive entity (e.g., Jones et al.).

Any review of the refusal to grant a filing date as of the date of deposit of the application would be by way of petition, accompanied by the petition fee (37 CFR 1.17(i)). Petitioner should provide any arguments that he or she has that the items noted were not missing or that a filing date should be assigned in the absence of such items if they are believed to be unnecessary. If petitioner alleges that no defect exists, a request for refund of the petition fee may be included in the petition.

For applications properly filed under 37 CFR 1.10, the filing date is the date that the application was deposited as "Express Mail" in the U.S. Postal Service. For example, if a new patent application is deposited in "Express Mail" in accordance with 37 CFR 1.10 on a Saturday and the United States Postal Service gives it a date of deposit of Saturday, the Office will accord and stamp the correspondence with the Saturday date. 37 CFR 1.6(a)(2). If the proper procedures were not followed, the application will receive a filing date as of the date it was received in the Office. Any review of these matters would be by way of petition, accompanied by the petition fee (37 CFR 1.17(i)), providing whatever arguments and evidence petitioner has that the application is entitled to a filing date as of the date it was mailed via "Express Mail."

Any petition under this section should be marked to the attention of the Special Program Law Office.

507 Drafting Division [R-1]

The drawing in a nonprovisional application is inspected by the Drafting Division for formal compliance with the rules. If the drawing is satisfactory, it is

stamped "approved." If the drawing contains defects which are not so serious as to warrant holding the application to be incomplete, the Draftsman checks the appropriate notation on the "Notice of Informal Patent Drawing" form PTO-948.

See MPEP § 608.02(a) and (b) for handling of drawings so informal as to render examination of the >nonprovisional< application impractical.

508 Distribution [R-1]

The Micrographics Division prepares permanent prints made of the drawings of all complete applications and secures the prints in the file wrappers. The drawings and files are then assembled and >nonprovisional applications are< forwarded to the examining operation.

When a new or substitute drawing is received, a print is made and forwarded to the group to be placed in the file as an official paper.

As to the procedure to be followed when a model is filed, see MPEP § 608.03 and § 608.03(a).

508.01 Papers Sent to Wrong Group

If drawings, amendments, or other papers are delivered to the wrong group, the current group assignment should be obtained from PALM and be placed on the paper and then forwarded to the appropriate group. The assignment indicated by PALM may be verified by calling the group indicated before forwarding the paper.

508.02 Papers Received After Patenting or Abandonment [R-2]

After an application is patented or abandoned, any incoming communication which is not to become part of the record ** >will be returned to the sender by the examining group.<

508.03 Unmatched Papers [R-1]

Unmatched papers >for nonprovisional applications< within a group should be frequently reviewed to determine which should be sent to the Paper Correlating Office (PCO).

Item 1 below treats the papers in the "Serial number too high" category. Items 2-6 below are directed to all other unmatched papers not in the "Serial number too high" category.

1. Unmatched papers in the "Serial No. Too High" category

This collection of papers being held by the group should be reviewed *at least* once a week. Any paper having a serial number which clearly should have already been received by the group should be removed from this collection. Where the group does not have a corresponding application for any of these papers, inquiry should be made of the Application Division to determine the group of record. If another group number is indicated, the paper should be forwarded to that group. If the Application Division does not yield a new group number for the indicated Serial No., the paper should be sent to the PCO.

2. Unmatched papers having a serial number

It can be assumed that either the group number or the serial number on these papers is incorrect. Inquiry should be made of the Application Division and PALM to determine the group of record and the procedure set out in item 1 above followed. An exception to this practice should be made where the paper has thereon the name of an examiner in the group. In these situations, a careful check of the group records and files as well as consultation with the indicated examiner should be made to determine the correct serial number. If this does not yield a new serial number, the paper should be sent to the PCO.

3. Unmatched papers relating to cases abandoned from group

The file should be ordered from Files Repository. If the file is not received therefrom, the paper should be forwarded to the PCO.

4. Papers for applications which have been sent to the Patent Issue Division

All papers for applications which PALM indicates to be located in any of the locations 7400 through 7650 should be forwarded to the Publishing Division.

The instructions of this section (4) apply to all files in Issue including those which have been assigned a Patent Number and Issue Date. Papers requiring examiner review and action will be returned to the examining group after Publishing Division personnel have matched the paper to the appropriate file.

5. Papers for applications which have been sent to the Record Room

If PALM indicates that the application for a paper is in the Record Room (location code 9210), the paper

should be forwarded to the Paper Correlating Office for response.

6. Unmatched papers for cases which are known to be pending in the group but cannot be located

Generally, these are applications which PALM indicates are present in the group, but the file is not available. These papers should be retained in the group for processing.

Each paper sent to the PCO must have a PCO Transmittal Form stapled thereto. Each form attached to a paper should be filled out as completely as possible. Transmittal Forms attached to papers in categories 1 and 2 must have an indication of the information obtained from both Application Division and PALM. The PALM information should be inserted in the large space at the bottom of the Form. This will help eliminate duplication of effort by PCO personnel. Papers received without transmittal forms or with incompletely filled out transmittal forms may be returned to the originating group.

509 Payment of Fees [R-2]

The latest fee schedule can be obtained by contacting the Public Service Center at (703) 308-4357.

37 CFR 1.22. Fees payable in advance.

(a) Patent and trademark fees and charges payable to the Patent and Trademark Office are required to be paid in advance, that is, at the time of requesting any action by the Office for which a fee or charge is payable with the exception that under § 1.53 applications for patent may be assigned a filing date without payment of the basic filing fee.

(b) All patent and trademark fees paid to the Patent and Trademark Office should be itemized in each individual application, patent or other proceeding in such a manner that it is clear for which purpose the fees are paid.

37 CFR 1.23. Method of payment.

All payments of money required for Patent and Trademark Office fees, including fees for the processing of international applications (§ 1.445), should be made in U.S. specie, Treasury notes, national bank notes, post office money orders, or by certified check. If sent in any other form, the Office may delay or cancel the credit until collection is made. Money orders and checks must be made payable to the Commissioner of Patents and Trademarks. Remittances from foreign countries must be payable and immediately negotiable in the United States for the full amount of the fee required. Money sent by mail to the Patent and Trademark Office will be at the risk of the sender; letters containing money should be registered.

37 CFR 1.24. Coupons.

Coupons in denominations of three dollars, for the purchase of patents, designs, defensive publications, statutory invention registrations, and trademark registrations are sold by the Patent and Trademark Office for the convenience of the general public; these coupons may not be used for any other purpose. The three-dollar coupons are sold individually and in books of 50 for \$150.00. These coupons are good until used; they may be transferred but cannot be redeemed.

37 CFR 1.26. Refunds.

(a) Money paid >by actual mistake or< in excess will be refunded, but a mere change of purpose after the payment of money, as when a party desires to withdraw an application, an appeal, or a request for oral hearing, will not entitle a party to demand such a return. Amounts of twenty five dollars or less will not be returned unless specifically requested within a reasonable time, nor will the payer be notified of such amount; amounts over twenty five dollars may be returned by check or, if requested, by credit to a deposit account.

(b) [Reserved]

(c) If the Commissioner decides not to institute a reexamination proceeding, a refund of \$1,690 will be made to the requester of the proceeding. Reexamination requesters should indicate whether any refund should be made by check or by credit to a deposit account.

> Where the Office has notified an applicant, in writing, that a fee is due and has specified a particular dollar amount for that fee, if the applicant timely submits the specified fee amount in response to the notice, the applicant should be considered to have complied with the notice so as to avoid abandonment of the application. If the fee paid by the applicant is insufficient, either because the notice specified an incorrect dollar amount for the fee or because of a fee increase effective after the mailing of the notice and before payment of the fee by the applicant, the applicant should be notified in writing by the Office of the fee insufficiency and given a new time period in which to submit the remaining balance. The written notification of the fee insufficiency should set forth the reason (i.e., the fee amount indicated by the Office in the earlier notice was incorrect or the fees have increased since the earlier notice was mailed) why applicant is being required to submit an additional fee. <

509.01 Deposit Accounts [R-1]

37 CFR 1.25. Deposit accounts.

(a) For the convenience of attorneys, and the general public in paying any fees due, in ordering services offered by the Office, copies of records, etc. deposit accounts may be established in the Patent and Trademark Office upon payment of the fee for establishing a deposit account (§ 1.21(b)(1)). A minimum deposit of \$1,000 is required for paying any fees due or in ordering any services offered by the Office. However, a minimum deposit of \$300 may be paid to

establish a restricted subscription deposit account used exclusively for subscription order of patent copies as issued. At the end of each month, a deposit account statement will be rendered. A remittance must be made promptly upon receipt of the statement to cover the value of items or services charged to the account and thus restore the account to its established normal deposit. An amount sufficient to cover all fees, services, copies, etc., requested must always be on deposit. Charges to accounts with insufficient funds will not be accepted. A service charge (§ 1.21(b)(2)) will be assessed for each month that the balance at the end of the month is below \$1,000. For restricted subscription deposit accounts, a service charge (§ 1.21(b)(3)) will be assessed for each month that the balance at the end of the month is below \$300.

(b) Filing, issue, appeal, international-type search report, international application processing, petition, and post-issuance fees may be charged against these accounts if sufficient funds are on deposit to cover such fees. A general authorization to charge all fees, or only certain fees, set forth in §§ 1.16 to 1.18 to a deposit account containing sufficient funds may be filed in an individual application, either for the entire pendency of the application or with respect to a particular paper filed. An authorization to charge to a deposit account the fee for a request for reexamination pursuant to § 1.510 and any other fees required in a reexamination proceeding in a patent may also be filed with the request for reexamination. An authorization to charge a fee to a deposit account will not be considered payment of the fee on the date the authorization to charge the fee is effective as to the particular fee to be charged unless sufficient funds are present in the account to cover the fee.

An overdrawn account will be immediately suspended and no charges will be accepted against it until a proper balance is restored, together with a payment of \$10 (37 CFR 1.21(b)(1)) to cover the work done by the Patent and Trademark Office incident to suspending and reinstating the account and dealing with charges which may have been made in the meantime.

For applications filed prior to February 27, 1983, if the Office discovers that a filing fee for an application was charged to an account with insufficient funds, or to an overdrawn account, the filing date of the application will be withdrawn.

For applications filed after February 27, 1983, if there is an authorization to charge the filing fee to a deposit account which is overdrawn or has insufficient funds, a surcharge (37 CFR 1.16(e)) is required in addition to payment of the filing fee. Failure to timely pay the filing fee and surcharge will result in abandonment of the application.

It is expected, however, that reasonable precautions will be taken in all cases to avoid overdrafts, and if an account is suspended repeatedly it will be necessary to close it.

Similarly, because of the burden placed on the Patent and Trademark Office incident to the operation of de-

posit accounts, a charge of ten dollars (37 CFR 1.21(b)(1)) will be made for opening each new account.

DEPOSIT ACCOUNT AUTHORIZATIONS

The rules of practice were amended effective Oct. 1, 1982, at 37 CFR 1.25(b) to state that: "A general authorization to charge all fees, or only certain fees, set forth in 37 CFR 1.16 to 1.18 to a deposit account containing sufficient funds may be filed in an individual application, either for the entire pendency of the application or with respect to a particular paper filed." A general authorization does not apply to document supply fees under 37 CFR 1.19, such as those required for certified copies, to post-issuance fees under 37 CFR 1.20, such as those required for maintenance fees; * to miscellaneous fees and charges under 37 CFR 1.21, such as assignment recording fees>, or as a basis for a petition, such as a petition for an extension of time (see MPEP § 201.06(b), Extensions of Time)<.

Many applications filed prior to Oct. 1, 1982, contain broad language authorizing any additional fees which might have been due to be charged to a deposit account. The Patent and Trademark Office does not interpret such broad authorizations, filed prior to Oct. 1, 1982, to include authorization to charge to a deposit account the issue fee or other fees in 37 CFR 1.16, 1.17, and 1.18 except those associated with the paper containing the broad authorization. However, such a broad authorization filed in an application on or after Oct. 1, 1982, will be interpreted as authorization to charge the issue fee; as well as any other fee set forth in 37 CFR 1.16, 1.17, or 1.18. Fees under 37 CFR 1.19, 1.20, and 1.21 will not be charged as a result of a general authorization under 37 CFR 1.25.

It is recommended that authorizations to charge fees to deposit accounts include reference to the particular fees or fee sections of the rules which applicant intends to authorize. For example, if filing and processing fees under 37 CFR 1.16 and 1.17 only are intended to be included in the authorization, and not the issue fee under 37 CFR 1.18, the authorization could read: "The Commissioner is hereby authorized to charge any fees under 37 CFR 1.16 and 1.17 which may be required during the entire pendency of the application to Deposit Account No.——." Such an authorization would clearly exclude issue fees under 37 CFR 1.18 while including all the filing and processing fees listed in 37 CFR 1.16 and 1.17. Similarly, if it were intended to authorize the charging of

fees relating only to a specific paper, the authorization could read "The Commissioner is hereby authorized to charge any fees under 37 CFR 1.16 and 1.17 which may be required by this paper to Deposit Account No. _____." Such authorizations would cover situations in which a check to cover a filing and processing fee under 37 CFR 1.16 and 1.17 was omitted or was for an amount less than the amount required.

It is extremely important that the authorization be clear and unambiguous. If applicants file authorizations which are ambiguous and deviate from the usual forms of authorizations, the Office may not interpret the authorizations in the manner applicants intend. In such cases, applicants could be subject to further expenses, petitions, etc. in order to correct fees which were not charged as intended due to an ambiguous authorization.

When statutory fees are to be charged to a deposit account, the processing of the application can be facilitated by submitting the applicant's transmittal letter or other correspondence specifying the account to be charged in triplicate. Submission of these documents in triplicate will eliminate the need for the mail room to photocopy the document and will thereby reduce the processing time of incoming mail.

509.02 Small Entity Status — Definitions [R-3]

Public Law 97-247, enacted August 27, 1982, provides that effective Oct. 1, 1982, funds available under the Act to the Patent and Trademark Office "shall be used to reduce by 50 per centum the payment of fees under section 41 (a) and (b) of title 35, United States Code, by independent inventors and nonprofit organizations as defined in regulations established by the Commissioner of Patents and Trademarks, and by small business concerns as defined in Section 3 of the Small Business Act and by regulations established by the Small Business Administration." The fees which are reduced include patent application filing fees (37 CFR 1.16), extension of time, revival, and appeal fees (37 CFR 1.17), patent issue fees (37 CFR 1.18), statutory disclaimer fee (37 CFR 1.20(d)), and maintenance fees on patents (37 CFR 1.20). Other fees, established under section 41 (c) or (d) of Title 37, United States Code, are not reduced for small entities since such a reduction is not permitted or authorized by Public Law 97-247.

Fees which are not reduced include petition and processing fees (other than revival), 37 CFR 1.17(h)-(k), document supply fees, 37 CFR 1.19, certificate of correction fees, 37 CFR 1.20(a), request for reexamination fees, 37 CFR 1.20(c), miscellaneous fees and charges, 37 CFR 1.21, and international application fees, 37 CFR 1.445.

Public Law 97-247 gave the Commissioner authority to establish regulations defining independent inventors and nonprofit organizations. These definitions have been established as 37 CFR 1.9 (c) and (e). The Small Business Administration was given authority to establish the definition of a small business concern. This definition is published in 37 CFR 1.9(d). A small entity for purposes of paying reduced fees is defined in 37 CFR 1.9(f) as an independent inventor, a small business concern, or a nonprofit organization.

37 CFR 1.9. Definitions.

(a)(1) A national application as used in this chapter means a U.S. application for patent which was either filed in the Office under 35 U.S.C. 111, or which entered the national stage from an international application after compliance with 35 U.S.C. 371.

(2) A provisional application as used in this chapter means a U.S. national application for patent filed in the Office under 35 U.S.C. 111(b).

(3) A nonprovisional application as used in this chapter means a U.S. national application for patent which was either filed in the Office under 35 U.S.C. 111(a), or which entered the national stage from an international application after compliance with 35 U.S.C. 371.

(b) An international application as used in this chapter means an international application for patent filed under the Patent Cooperation Treaty prior to entering national processing at the Designated Office stage.

(c) An independent inventor as used in this chapter means any inventor who (1) has not assigned, granted, conveyed, or licensed, and (2) is under no obligation under contract or law to assign, grant, convey, or license, any rights in the invention to any person who could not likewise be classified as an independent inventor if that person had made the invention, or to any concern which would not qualify as a small business concern or a nonprofit organization under this section.

(d) A small business concern as used in this chapter means any business concern as defined by the regulations of the Small Business Administration in 13 CFR 121.1301 through 121.1305, which define a small business concern as one whose number of employees, including those of its affiliates, does not exceed 500 persons and which has not assigned, granted, conveyed, or licensed, and is under no obligation under contract or law to assign, grant, convey, or license, any rights in the invention to any person who could not be classified as an independent inventor if that person had made the invention, or to any concern which would not qualify as a small business concern or a nonprofit organization under this section. Questions related to size standards for a small business concern may

be directed to: Small Business Administration, Size Standards Staff, 409 Third Street, SW, Washington, DC 20416.

(e) A nonprofit organization as used in this chapter means (1) a university or other institution of higher education located in any country; (2) an organization of the type described in section 501(c)(3) of the Internal Revenue Code of 1954 (26 U.S.C. 501(c)(3)) and exempt from taxation under section 501(a) of the Internal Revenue Code (26 U.S.C. 501(a)); (3) any nonprofit scientific or educational organization qualified under a nonprofit organization statute of a state of this country (35 U.S.C. 201(i)); or (4) any non-profit organization located in a foreign country which would qualify as a nonprofit organization under paragraphs (e) (2) or (3) of this section if it were located in this country.

(f) A small entity as used in this chapter means an independent inventor, a small business concern, or a non-profit organization.

(g) For definitions in interferences see § 1.601.

>(h) A Federal holiday within the District of Columbia as used in this chapter means any day, except Saturdays and Sundays, when the Patent and Trademark Office is officially closed for business for the entire day.<

INDEPENDENT INVENTOR

37 CFR 1.9(c) defines an independent inventor as any inventor who (1) has not assigned, granted, conveyed, or licensed, and (2) is under no obligation under contract or law to assign, grant, convey, or license any rights in the invention to any person who could not likewise be classified as an independent inventor if that person had made the invention, or to any concern which would not qualify as a small business concern or a nonprofit organization. The "rights in the invention" are the rights in the United States. Once an individual sole inventor, or one of several joint inventors, has assigned, granted, conveyed, or licensed, or comes under an obligation to assign, grant, convey, or license, any rights to the invention to anyone who could not likewise obtain status as a small entity, the inventor(s) will no longer be entitled to pay fees in the amounts established for an independent inventor (37 CFR 1.9(c)).

Rights in the invention include the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States. Therefore, for example, status as a small entity is lost by an inventor who has transferred or has an obligation to transfer a shop right to an employer who could not qualify as a small entity.

37 CFR 1.9(c) permits an individual inventor to make an assignment, grant, conveyance, or license of partial rights in the invention to another individual or individuals who could qualify as an independent inventor or inventors if they had made the invention. In addition,

37 CFR 1.9(c) permits an individual inventor to make an assignment, grant, conveyance, or license of partial rights in the invention to a small business concern or nonprofit organization. Under the circumstances described in the previous two sentences, the individual inventor could still qualify as an independent inventor. However, if the independent inventor assigned, granted, conveyed, or licensed, or came under an obligation to assign, grant, convey, or license, any rights to the invention to any individual or organization which could not qualify as a small entity (37 CFR 1.9(f)), then the inventor would no longer qualify as an independent inventor.

SMALL BUSINESS CONCERN

37 CFR 1.9(d) provides that, in order to be a small business, the number of employees of the concern, including those of its affiliates, may not exceed 500 persons. Concerns are affiliates of each other when either, directly or indirectly, one concern controls or has the power to control the other, or a third party or parties controls or has the power to control both. For discussion and example of what constitutes "control", see the regulations of the Small Business Administration. The number of employees of a business concern is determined by averaging the number of persons of the concern and its affiliates employed on a full-time, part-time, or temporary basis during each of the pay periods for the preceding completed twelve (12) calendar months.

The definition >in 37 CFR 1.9(d)< also requires a small business for this purpose to be one "which has not assigned, granted, conveyed, or licensed, and is under no obligation under contract or law to assign, grant, convey, or license, any rights in the invention to any person who could not be classified as an independent inventor if that person had made the invention, or to any concern which would not qualify as a small business concern or a nonprofit organization under this section."

NONPROFIT ORGANIZATIONS

37 CFR 1.9(e) defines a nonprofit organization by utilizing and >interpreting< the definition contained in 35 U.S.C. 201(i). The term "university or other institution of higher education" as used in 37 CFR 1.9(e) means an educational institution which (1) admits as regular students only persons having a certificate of graduation from a school providing secondary education, or the recognized equivalent of such a certificate, (2) is legally authorized within the jurisdiction in which it operates to

provide a program of education beyond secondary education, (3) provides an educational program for which it awards a bachelor's degree or provides not less than a 2-year program which is acceptable for full credit toward such a degree, (4) is a public or other nonprofit institution, and (5) is accredited by a nationally recognized accrediting agency or association. The definition of "university or other institution of higher education" as set forth herein essentially follows the definition of "institution of higher education" contained in 20 U.S.C. 1141(a). Institutions which are strictly research facilities, manufacturing facilities, service organizations, etc., are not intended to be included within the term "other institution of higher education" even though such institutions may perform an educational function or publish the results of their work.

Nonprofit organizations also include organizations of the type described in section 501(c)(3) of the Internal Revenue Code of 1954 (26 U.S.C. 501(c)(3)) and which are exempt from taxation under 26 U.S.C. 501(a). Organizations described in 26 U.S.C. 501(c)(3) include corporations, and any community chest, fund, or foundation, organized and operated exclusively for religious, charitable, scientific, testing for public safety, literary, or educational purposes, or to foster national or international amateur sports competition (but only if no part of its activities involve the provision of athletic facilities or equipment), or for the prevention of cruelty to children or animals, no part of the net earnings of which inures to the benefit of any private shareholder or individual, no substantial part of the activities of which is carrying on propaganda, or otherwise attempting to influence legislation and which does not participate in, or intervene in (including the publishing or distributing of statements), any political campaign on behalf of any candidate for public office.

LOCATION OF SMALL ENTITY

Small entities may claim reduced fees regardless of the country in which they are located. There is no restriction requiring that the independent inventor, small business concern, or nonprofit organization be located in the United States. The same definitions apply to all applicants equally in accordance with the Paris Convention for the Protection of Industrial Property.

TRANSFER OF RIGHTS

With regard to transfer of rights in the invention, the rights in question are those in the United States to be covered by the application or patent. Transfer of rights to a Japanese patent, for example, would not affect small entity status if no rights in the United States patent were likewise transferred.

The payment of reduced fees under 35 U.S.C. 41 is limited to those situations in which all of the rights in the invention are owned by small entities; i.e., independent inventors, small business concerns, or nonprofit organizations. To do otherwise would be clearly contrary to the intended purpose of the legislation which contains no indication that fees are to be reduced in circumstances where rights are owned by non-small entities. For example, a non-small entity is not permitted to transfer patent rights to a small business concern which would pay the reduced fees and grant a license to the entity.

If rights transferred to a non-small entity are later returned to a small entity so that all rights are held by small entities, reduced fees may be claimed.

The term "license" in the definitions includes nonexclusive as well as exclusive licenses and royalty free as well as royalty generating licenses. Implied licenses to use and resell patented articles purchased from a small entity, however, will not preclude the proper claiming of small entity status. Likewise, an order by an applicant to a firm to build a prototype machine or product for the applicant's own use is not considered to constitute a license for purposes of the definitions.

RIGHTS HELD BY GOVERNMENT ORGANIZATIONS

Also, although the Federal government agencies do not qualify as nonprofit organizations for paying reduced fees under the rules, a license to a Federal agency resulting from a funding agreement with the agency pursuant to 35 U.S.C. 202(c)(4) will not preclude the proper claiming of small entity status.

Public Law 96-517 added a new chapter ^{*}18< of Title 35 of the United States Code entitled "Patent Rights in Inventions Made With Federal Assistance." Under the provisions of the statute, each funding agreement between a Federal agency and an individual, small business firm, or nonprofit organization must provide, *inter alia*, that "... the Federal agency shall have a nonexclusive, nontransferable, irrevocable, paid-up license to practice or have practiced for

or on behalf of the United States any subject invention . . .”
See 35 U.S.C. 202(c)(4).

Under the provisions of 37 CFR 1.9 and 1.27, an independent inventor, small business concern, or nonprofit organization cannot qualify for reduced patent fees if it has assigned, granted, conveyed, or licensed or is under an obligation under contract or law to assign, grant, convey, or license any rights in the invention to other than an individual who could be classified as an independent inventor if that person had made the invention, a small business concern, or a nonprofit organization. The Federal agencies do not qualify as nonprofit organizations for paying reduced patent fees under the rules. Applying this construction to the licensing of an invention to a Federal agency by an independent inventor, small business concern, or nonprofit organization pursuant to a funding agreement under 35 U.S.C. 202(c)(4) would preclude their qualifying for paying reduced fees. This, however, would frustrate the intent of Public Law 97-247 and Public Law 96-517 when taken together.

Government organizations as such, whether domestic or foreign, cannot qualify as nonprofit organizations as defined in 37 CFR 1.9(e). Thus, for example, a government research facility or other government-owned corporation could not qualify. 37 CFR 1.9(e) was based upon 35 U.S.C. 201(i), as established by Public Law 96-517. The limitation to “an organization of the type described in section 501(c)(3) of the Internal Revenue Code of 1954 (26 U.S.C. 501(c)(3)) and exempt from taxation under section 501(a) of the Internal Revenue Code (26 U.S.C. 501(a))” would by its nature exclude the U.S. government and its agencies and facilities, including research facilities and government corporations. State and foreign governments and governmental agencies and facilities would be similarly excluded. 37 CFR 1.9(e) is not intended to include within the definition of a nonprofit organization government organizations of any kind located in any country. A university or other institution of higher education located in any country would qualify, however, as a “nonprofit organization” under 37 CFR 1.9(e) even though it has some government affiliation since such institutions are specifically included.

A wholly owned subsidiary of a nonprofit organization or of a university is considered a part of the nonprofit organization or university and is not precluded from qualifying for small entity status.

509.03 Claiming Small Entity Status [R-2]

37 CFR 1.27. Statement of status as small entity.

(a) Any person seeking to establish status as a small entity (§ 1.9(f) of this part) for purposes of paying fees in an application or a patent must file a verified statement in the application or patent prior to or with the first fee paid as a small entity. Such a verified statement need only be filed once in an application or patent and remains in effect until changed.

(b) Any verified statement filed pursuant to paragraph (a) of this section on behalf of an independent inventor must be signed by the independent inventor except as provided in § 1.42, § 1.43, or § 1.47 of this part, and must aver that the inventor qualifies as an independent inventor in accordance with § 1.9(c) of this part. Where there are joint inventors in an application, each inventor must file a verified statement establishing status as an independent inventor in order to qualify as a small entity. Where any rights have been assigned, granted, conveyed, or licensed, or there is an obligation to assign, grant, convey, or license, any rights to a small business concern, a nonprofit organization, or any other individual, a verified statement must be filed by the individual, the owner of the small business concern, or an official of the small business concern or nonprofit organization empowered to act on behalf of the small business concern or nonprofit organization averring to their status. For purposes of a verified statement under this paragraph, a license to a Federal agency resulting from a funding agreement with that agency pursuant to 35 U.S.C. 202(c)(4) does not constitute a license as set forth in § 1.9 of this part.

(c) Any verified statement filed pursuant to paragraph (a) of this section on behalf of a small business concern must (1) be signed by the owner or an official of the small business concern empowered to act on behalf of the concern; (2) aver that the concern qualifies as a small business concern as defined in § 1.9(d); and (3) aver that exclusive rights to the invention have been conveyed to and remain with the small business concern, or if the rights are not exclusive, that all other rights belong to small entities as defined in § 1.9. Where the rights of the small business concern as a small entity are not exclusive, a verified statement must also be filed by the other small entities having rights averring to their status as such. For purposes of a verified statement under this paragraph, a license to a Federal agency resulting from a funding agreement with that agency pursuant to 35 U.S.C. 202(c)(4) does not constitute a license as set forth in § 1.9 of this part.

(d) Any verified statement filed pursuant to paragraph (a) of this section on behalf of a nonprofit organization must (1) be signed by an official of the nonprofit organization empowered to act on behalf of the organization; (2) aver that the organization qualifies as a nonprofit organization as defined in § 1.9(e) of this part specifying under which one of § 1.9(e)(1), (2), (3), or (4) of this part the organization qualifies; and (3) aver that exclusive rights to the invention have been conveyed to and remain with the organization or if the rights are not exclusive, that all other rights belong to small entities as defined in § 1.9 of this part. Where the rights of the nonprofit organization as a small entity are not exclusive, a verified statement must also be filed by the other small entities having rights averring to their status as such. For purposes of a verified statement under this paragraph, a license to a Federal agency resulting from a funding agreement with that agency pursuant to 35 U.S.C. 202(c)(4) does not constitute a conveyance of rights as set forth in this paragraph.

37 CFR 1.27 provides in paragraph (a) that any person seeking to establish status as a small entity, as defined in 37 CFR 1.9(f) for the purpose of paying reduced fees, must file a statement to that effect prior to or with the payment of the first fee paid as a small entity. 37 CFR 1.27(b) provides specifically for inventors filing statements claiming status as independent inventors.

37 CFR 1.27(c) provides for claiming status as a small business concern.

37 CFR 1.27(d) provides for claiming status as a nonprofit organization. Under 37 CFR 1.27, as long as all of the rights remain in small entities, the fees established for a small entity can be paid. This includes circumstances where the rights were divided between an independent inventor, a small business concern, and a nonprofit organization, or any combination thereof.

The statement claiming small entity status must be a verified statement; i.e., an oath or declaration. It is not required that a new verified statement be filed with each fee paid, but rather, once a statement is filed in an application or patent, small entity status remains in the application or patent until the Office is notified of a change in status. Notification of change in status is required by 37 CFR 1.28(b).

Status as a small entity may be established in a provisional application by complying with 37 CFR 1.27.

A nonprovisional application claiming benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) of a prior application may rely on a verified statement filed in the prior application if the nonprovisional application includes a reference to the verified statement in the prior application, or includes a copy of the verified statement in the prior application, and status as a small entity is still proper and desired.

The rules do not authorize a patent attorney to sign a verified statement establishing status as a small entity on behalf of a client. The client has to sign the verified statement. Paragraph (b) of 37 CFR 1.27 requires that any verified statement filed on behalf of an independent inventor must be signed by the independent inventor except as provided in 37 CFR 1.42, 1.43, or 1.47. Paragraphs (c) and (d) of 37 CFR 1.27 require that any verified statement filed on behalf of a small business concern or nonprofit organization must be signed by an official of the concern or nonprofit organization empowered to act on behalf of the concern or organization.

The term "official" is intended to include any officer, employee, or part-owner empowered to act on behalf of

a small business concern or nonprofit organization. For example, an officer or employee of a corporation empowered to act for the corporation by its board of directors would be qualified to sign such a verified statement. The intent of paragraphs (b)–(d) of 37 CFR 1.27 is that the verified statement be signed by the person in the best position to know the facts as to whether or not status as a small entity can be properly established insofar as the attorney's responsibilities and duty to investigate are concerned.

37 CFR 1.28. Effect on fees of failure to establish status, or change status, as a small entity.

(a) The failure to establish status as a small entity (§§ 1.9(f) and 1.27 of this part) in any application or patent prior to paying, or at the time of paying, any fee precludes payment of the fee in the amount established for small entities. A refund pursuant to § 1.26 of this part, based on establishment of small entity status, of a portion of fees timely paid in full prior to establishing status as a small entity may only be obtained if a verified statement under § 1.27 and a request for a refund of the excess amount are filed within two months of the date of the timely payment of the full fee. The two-month time period is not extendable under § 1.136. Status as a small entity is waived for any fee by the failure to establish the status prior to paying, at the time of paying, or within two months of the date of payment of, the fee. Status as a small entity must be specifically established in each application or patent in which the status is available and desired. Status as a small entity in one application or patent does not affect any other application or patent, including applications or patents which are directly or indirectly dependent upon the application or patent in which the status has been established. A nonprovisional application claiming benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) of a prior application may rely on a verified statement filed in the prior application if the nonprovisional application includes a reference to the verified statement in the prior application or includes a copy of the verified statement in the prior application and status as a small entity is still proper and desired. Once status as a small entity has been established in an application or patent, the status remains in that application or patent without the filing of a further verified statement pursuant to § 1.27 of this part unless the Office is notified of a change in status.

(b) Once status as a small entity has been established in an application or patent, fees as a small entity may thereafter be paid in that application or patent without regard to a change in status until the issue fee is due or any maintenance fee is due. Notification of any change in status resulting in loss of entitlement to small entity status must be filed in the application or patent prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity is no longer appropriate pursuant to § 1.9 of this part. The notification of change in status may be signed by the applicant, any person authorized to sign on behalf of the assignee, or an attorney or agent of record or acting in a representative capacity pursuant to § 1.34(a) of this part.

(c) If status as a small entity is established in good faith, and fees as a small entity are paid in good faith, in any application or patent, and it is later discovered that such status as a small entity was

established in error or that through error the Office was not notified of a change in status as required by paragraph (b) of this section, the error will be excused (1) if any deficiency between the amount paid and the amount due is paid within three months after the date the error occurred or (2) if any deficiency between the amount paid and the amount due is paid more than three months after the date the error occurred and the payment is accompanied by a statement explaining how the error in good faith occurred and how and when the error was discovered. The statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office. The deficiency is based on the amount of the fee, for other than a small entity, in effect at the time the deficiency is paid in full.

(d)(1) Any attempt to fraudulently (i) establish status as a small entity or (ii) pay fees as a small entity shall be considered as a fraud practiced or attempted on the Office.

(2) Improperly and with intent to deceive (i) establishing status as a small entity or (ii) paying fees as a small entity shall be considered as a fraud practiced or attempted on the Office.

37 CFR 1.28 provides guidance to the effect of failure to establish or notify the Office of any change from small entity status. 37 CFR 1.28(a) provides that once status as a small entity has been established in an application or patent, the status remains in that application or patent without the filing of a further verified statement pursuant to 37 CFR 1.27, unless the Office is notified of a change in status. Under 37 CFR 1.28(a), status as a small entity in one application or patent does not affect any other application or patent, including applications or patents which are directly or indirectly dependent upon the application or patent in which the status has been established. A nonprovisional application claiming the benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) of a prior application may rely on a verified statement filed in the prior application if the nonprovisional application includes a reference to the verified statement in the prior application, or includes a copy of the verified statement in the prior application, and status as a small entity is still proper and desired. 37 CFR 1.28(b) requires that notification of any change in status resulting in loss of entitlement to small entity status be filed in the application or patent prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity is no longer appropriate. Notification is not required if rights to an invention are transferred from one small entity to another small entity but small entity status is not lost thereby. This means that only four checks are required during the pendency and term of a patent after initial establishment of small entity status if such establishment was made prior to payment of the issue fee.

The Office will ordinarily require verified statements claiming small entity status only from parties holding rights in the invention. For example, if an independent inventor has transferred all rights in the invention to a small business concern, the Office will not require a verified statement from the inventor as well as from the small business concern. A verified statement from the independent inventor, however, will be required in the situation where all rights in the invention have been transferred to an individual who files the verified statement form entitled "Verified Statement (Declaration) By a Non-Inventor Supporting A Claim by Another For Small Entity Status." The language of this latter form clearly shows that it is meant to be filed in addition to another verified statement form.

No confirming statement is required where there has been no change in small entity status. Paragraph (c) of 37 CFR 1.28 requires a verified statement explaining how error in good faith establishing small entity status and paying fees as a small entity occurred only in situations where the error is not corrected within 3-months of the date on which the error occurred. This will reduce paperwork and provides a 3-month grace period to correct errors with no explanations required for correction during that 3-month period.

37 CFR 1.28 also provides guidance as to the effect of improperly establishing status as a small entity. The intent of the reduced fees for small entities is to soften the impact of the fee increases under § 41(a) and (b) of Title 35, United States Code, as such sections are amended by Public Law 97-247, upon those who are least able to absorb the increased fees without overall damage to their ability to participate in the patent system through the filing, issuing, and maintaining of patents. Accordingly, any attempt to improperly establish status as a small entity will be viewed as a serious matter by the Office and 37 CFR 1.28(d) indicates that any attempt to fraudulently establish status as a small entity or pay fees as a small entity will be considered as a fraud practiced or attempted on the Office. In addition, improperly and with intent to deceive establishing status as a small entity or paying fees as a small entity will be considered as a fraud practiced or attempted on the Office. Normally, the Office will not question a claim to status as a small entity. However, if the Office must resolve such an issue in a question

arising before it, the Office will look to the actual or practical status of the individual or organization claiming status as a small entity rather than the professed or apparent status.

Request for refunds, along with the verified statements, should be addressed to the >Assistant< Commissioner *>for< Patents **, Washington, D.C. 20231, and directed to the attention of the Refund Section, Accounting Division, Office of Finance.

The Patent and Trademark Office does not give advisory opinions as to whether or not a specific individual or organization qualifies for status as a small entity. In establishing reduced fees for independent inventors, small business concerns, and nonprofit organizations, the Congressional consideration of the legislation which became Public Law 97-247 indicated an intent that the Patent and Trademark Office rely exclusively on a self-certification that a patent applicant qualifies as an independent inventor, small business concern, or nonprofit organization. In addition, it was also stated during Congressional consideration of the legislation that no additional resources would be required to administer the system whereby fees would be reduced for small entities.

In view of the intent expressed during Congressional consideration of the legislation, it would be inappropriate for the Patent and Trademark Office to give advisory opinions as to entitlement to small entity status. Accordingly, any person seeking to establish status as a small entity for purposes of paying the fee in an application or patent must file the verified statement required by 37 CFR 1.27 and in so doing is self-certifying entitlement to small entity status.

Small entity status must not be established unless the person or persons signing the verified statement can unequivocally make the required self-certification. Any appropriately signed and filed verified statement will be considered by the Patent and Trademark Office to be a self-certification.

If a verified statement claiming small entity status is filed in a language other than English, it must be accompanied by a verified English translation (37 CFR 1.69(b)). A non-English language verified statement claiming small entity status will not be given any effect until the verified English translation is filed and the full fees will be due until then.

When small entity status has been established in error and small entity fees have been paid in error, the matter is to be addressed under 37 CFR 1.28(c). Although the Office has noted that it will no longer conduct inquiries under 37 CFR 1.28(c)(2), 1098 OG 502 (January 3, 1989), a verified statement and payment of fee deficiencies (current fee level at the time of a complete submission minus the small entity fee paid in error) under 37 CFR 1.28(c)(2) are still required. A verified statement by applicant's attorney, an inventor or on behalf of the assignee (37 CFR 3.73(b) does not apply) will be presumed to have been submitted on behalf of a party with sufficient knowledge regarding the matters to be averred to. Any paper under 37 CFR 1.28(c) should be addressed to the attention of the Special Program Law Office, Office of Petitions.

A maintenance fee improperly paid as a small entity will be treated as a matter under 37 CFR 1.28(c) and will not be considered to involve expiration of the patent under 37 CFR 1.378.

**>PTO/SB/ 09 (6-95)
 Approved for use through 07/31/96. OMB 0651-0031
 Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE<

VERIFIED STATEMENT CLAIMING SMALL ENTITY STATUS (37 CFR 1.9(f) & 1.27(b))--INDEPENDENT INVENTOR	Docket Number (Optional)									
<p>Applicant or Patentee: _____</p> <p>*>Application< or Patent No.: _____</p> <p>Filed or Issued: _____</p> <p>Title: _____</p> <p>As a below named inventor, I hereby declare that I qualify as an independent inventor as defined in 37 CFR 1.9(c) for purposes of paying reduced fees to the Patent and Trademark Office described in:</p> <p><input type="checkbox"/> the specification filed herewith with title as listed above.</p> <p><input type="checkbox"/> the application identified above.</p> <p><input type="checkbox"/> the patent identified above.</p> <p>I have not assigned, granted, conveyed or licensed and am under no obligation under contract or law to assign, grant, convey or license, any rights in the invention to any person who would not qualify as an independent inventor under 37 CFR 1.9(c) if that person had made the invention, or to any concern which would not qualify as a small business concern under 37 CFR 1.9(d) or a nonprofit organization under 37 CFR 1.9(e).</p> <p>Each person, concern or organization to which I have assigned, granted, conveyed, or licensed or am under an obligation under contract or law to assign, grant, convey, or license any rights in the invention is listed below:</p> <p><input type="checkbox"/> No such person, concern, or organization exists.</p> <p><input type="checkbox"/> Each such person, concern or organization is listed below.</p> <p>Separate verified statements are required from each named person, concern or organization having rights to the invention averring to their status as small entities. (37 CFR 1.27)</p> <p>I acknowledge the duty to file, in this application or patent, notification of any change in status resulting in loss of entitlement to small entity status prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity is no longer appropriate. (37 CFR 1.28(b))</p> <p>I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.</p> <table style="width: 100%; border: none;"> <tr> <td style="width: 33%; border-top: 1px solid black; border-bottom: 1px solid black;">NAME OF INVENTOR</td> <td style="width: 33%; border-top: 1px solid black; border-bottom: 1px solid black;">NAME OF INVENTOR</td> <td style="width: 33%; border-top: 1px solid black; border-bottom: 1px solid black;">NAME OF INVENTOR</td> </tr> <tr> <td style="border-top: 1px solid black; border-bottom: 1px solid black;">Signature of inventor</td> <td style="border-top: 1px solid black; border-bottom: 1px solid black;">Signature of inventor</td> <td style="border-top: 1px solid black; border-bottom: 1px solid black;">Signature of inventor</td> </tr> <tr> <td style="border-top: 1px solid black; border-bottom: 1px solid black;">Date</td> <td style="border-top: 1px solid black; border-bottom: 1px solid black;">Date</td> <td style="border-top: 1px solid black; border-bottom: 1px solid black;">Date</td> </tr> </table>		NAME OF INVENTOR	NAME OF INVENTOR	NAME OF INVENTOR	Signature of inventor	Signature of inventor	Signature of inventor	Date	Date	Date
NAME OF INVENTOR	NAME OF INVENTOR	NAME OF INVENTOR								
Signature of inventor	Signature of inventor	Signature of inventor								
Date	Date	Date								

**>Burden Hour Statement: This form is estimated to take .3 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.<

VERIFIED STATEMENT CLAIMING SMALL ENTITY STATUS (37 CFR 1.9(f) & 1.27(c))--SMALL BUSINESS CONCERN	Docket Number (Optional) _____
Applicant or Patentee: _____ *>Application< or Patent No.: _____ Filed or Issued: _____ Title: _____	
I hereby declare that I am <input type="checkbox"/> the owner of the small business concern identified below: <input type="checkbox"/> an official of the small business concern empowered to act on behalf of the concern identified below:	
NAME OF SMALL BUSINESS CONCERN _____ ADDRESS OF SMALL BUSINESS CONCERN _____	
<p><i>I hereby declare that the above identified small business concern qualifies as a small business concern as defined in 13 CFR 121.12, and reproduced in 37 CFR 1.9(d), for purposes of paying reduced fees to the United States Patent and Trademark Office, in that the number of employees of the concern, including those of its affiliates, does not exceed 500 persons. For purposes of this statement, (1) the number of employees of the business concern is the average over the previous fiscal year of the concern of the persons employed on a full-time, part-time or temporary basis during each of the pay periods of the fiscal year, and (2) concerns are affiliates of each other when either, directly or indirectly, one concern controls or has the power to control the other, or a third party or parties controls or has the power to control both.</i></p> <p><i>I hereby declare that rights under contract or law have been conveyed to and remain with the small business concern identified above with regard to the invention described in:</i></p> <input type="checkbox"/> the specification filed herewith with title as listed above. <input type="checkbox"/> the application identified above. <input type="checkbox"/> the patent identified above.	
<p><i>If the rights held by the above identified small business concern are not exclusive, each individual, concern or organization having rights in the invention must file separate verified statements averring to their status as small entities, and no rights to the invention are held by any person, other than the inventor, who would not qualify as an independent inventor under 37 CFR 1.9(c) if that person made the invention, or by any concern which would not qualify as a small business concern under 37 CFR 1.9(d), or a nonprofit organization under 37 CFR 1.9(e).</i></p> <p><i>Each person, concern or organization having any rights in the invention is listed below:</i></p> <input type="checkbox"/> no such person, concern, or organization exists. <input type="checkbox"/> each such person, concern or organization is listed below.	
<p><i>Separate verified statements are required from each named person, concern or organization having rights to the invention averring to their status as small entities. (37 CFR 1.27)</i></p> <p><i>I acknowledge the duty to file, in this application or patent, notification of any change in status resulting in loss of entitlement to small entity status prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity is no longer appropriate. (37 CFR 1.28(b))</i></p> <p><i>I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.</i></p>	
NAME OF PERSON SIGNING _____ TITLE OF PERSON IF OTHER THAN OWNER _____ ADDRESS OF PERSON SIGNING _____ SIGNATURE _____ DATE _____	

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**>PTO/SB/ 11 (6-95)

Approved for use through 07/31/96. OMB 0651-0031
 Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

VERIFIED STATEMENT CLAIMING SMALL ENTITY STATUS (37 CFR 1.9(f) & 1.27(d))--NONPROFIT ORGANIZATION	Docket Number (Optional) _____
Applicant or Patentee: _____ *>Application< or Patent No. : _____ Filed or Issued: _____ Title: _____	
I hereby declare that I am an official empowered to act on behalf of the nonprofit organization identified below: NAME OF NONPROFIT ORGANIZATION _____ ADDRESS OF NONPROFIT ORGANIZATION _____	
TYPE OF NONPROFIT ORGANIZATION: <input type="checkbox"/> UNIVERSITY OR OTHER INSTITUTION OF HIGHER EDUCATION <input type="checkbox"/> TAX EXEMPT UNDER INTERNAL REVENUE SERVICE CODE (26 U.S.C. 501(a) and 501(c)(3)) <input type="checkbox"/> NONPROFIT SCIENTIFIC OR EDUCATIONAL UNDER STATUTE OF STATE OF THE UNITED STATES OF AMERICA (NAME OF STATE _____) (CITATION OF STATUTE _____) <input type="checkbox"/> WOULD QUALIFY AS TAX EXEMPT UNDER INTERNAL REVENUE SERVICE CODE (26 U.S.C. 501(a) and 501(c)(3)) IF LOCATED IN THE UNITED STATES OF AMERICA <input type="checkbox"/> WOULD QUALIFY AS NONPROFIT SCIENTIFIC OR EDUCATIONAL UNDER STATUTE OF STATE OF THE UNITED STATES OF AMERICA IF LOCATED IN THE UNITED STATES OF AMERICA (NAME OF STATE _____) (CITATION OF STATUTE _____)	
I hereby declare that the nonprofit organization identified above qualifies as a nonprofit organization as defined in 37 CFR 1.9(e) for purposes of paying reduced fees to the United States Patent and Trademark Office regarding the invention described in:	
<input type="checkbox"/> the specification filed herewith with title as listed above. <input type="checkbox"/> the application identified above. <input type="checkbox"/> the patent identified above.	
I hereby declare that rights under contract or law have been conveyed to and remain with the nonprofit organization regarding the above identified invention. If the rights held by the nonprofit organization are not exclusive, each individual, concern or organization having rights in the invention must file separate verified statements averring to their status as small entities and that no rights to the invention are held by any person, other than the inventor, who would not qualify as an independent inventor under 37 CFR 1.9(c) if that person made the invention, or by any concern which would not qualify as a small business concern under 37 CFR 1.9(d) or a nonprofit organization under 37 CFR 1.9(e).	
Each person, concern or organization having any rights in the invention is listed below:	
<input type="checkbox"/> no such person, concern, or organization exists. <input type="checkbox"/> each such person, concern or organization is listed below.	
I acknowledge the duty to file, in this application or patent, notification of any change in status resulting in loss of entitlement to small entity status prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity is no longer appropriate. (37 CFR 1.28(b))	
I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.	
NAME OF PERSON SIGNING _____	
TITLE IN ORGANIZATION OF PERSON SIGNING _____	
ADDRESS OF PERSON SIGNING _____	
SIGNATURE _____	DATE _____

****>Burden Hour Statement:** This form is estimated to take .3 hours to complete. Time will vary depending upon the needs of the individual case. Any
 comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office,
 Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents,
 Washington, DC 20231.<

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Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

**>PTO/SB/12 (4-95)

Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

**VERIFIED STATEMENT BY A NON-INVENTOR SUPPORTING
A CLAIM BY ANOTHER FOR SMALL ENTITY STATUS**

Docket Number (Optional)

Applicant or Patentee: _____
*->Application< or Patent No.: _____
Filed or Issued: _____
Title: _____

I hereby declare that I am making this verified statement to support a claim by _____ for small entity status for purposes of paying reduced fees to the United States Patent and Trademark Office, regarding the invention described in:

- the specification filed herewith with title as listed above.
- the application identified above.
- the patent identified above.

I hereby declare that I would qualify as an independent inventor as defined in 37 CFR 1.9(c) for purposes of paying fees to the United States Patent and Trademark Office, if I had made the above identified invention.

I have not assigned, granted, conveyed or licensed and am under no obligation under contract or law to assign, grant, convey or license, any rights in the invention to any person who would not qualify as an independent inventor under 37 CFR 1.9(c) if that person had made the invention, or to any concern which would not qualify as a small business concern under 37 CFR 1.9(d) or a nonprofit organization under 37 CFR 1.9(e). Note: Separate verified statements are required from each person, concern or organization having rights to the invention averring to their status as small entities. (37 CFR 1.27)

Each person, concern or organization to which I have assigned, granted, conveyed, or licensed or am under an obligation under contract or law to assign, grant, convey, or license any rights in the invention is listed below:

- no such person, concern, or organization exists.
- each such person, concern or organization is listed below.

I acknowledge the duty to file, in this application or patent, notification of any change in status resulting in loss of entitlement to small entity status prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity is no longer appropriate. (37 CFR 1.28(b))

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

NAME OF PERSON SIGNING

ADDRESS OF PERSON SIGNING

SIGNATURE

DATE

****Burden Hour Statement:** This form is estimated to take .3 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.**

510 Patent and Trademark Office Business Hours [R-3]

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The Patent and Trademark Office working hours are 8:30 a.m. to 5:00 p.m., Monday through Friday, excluding Federal holidays in the District of Columbia. Outside these hours, only Patent and Trademark Office employees are authorized to be in areas of the Patent and Trademark Office other than the Public Search Rooms.

The hours for the Public Search Room are 8:00 a.m. to 8:00 p.m., and the hours for the Trademark Search Room are 8:00 a.m. to 6:00 p.m., Monday through Friday, excluding Federal holidays in the District of Columbia.

During working hours, all applicants, attorneys, and other members of the public should announce their presence to the Office personnel in the area of their visit. In the examining groups, visitors should inform the group receptionist of their presence before visiting other areas of the group.

> Filing of Papers During Unscheduled Closings of the Patent and Trademark Office <

**>37 CFR 1.9(h) provides that the definition of "Federal holiday within the District of Columbia" includes an official closing of the Office. When the entire Patent and Trademark Office is officially closed for business for an entire day, for reasons due to adverse weather or other causes, the Office will consider each such day a "Federal holiday within the District of Columbia" under 35 U.S.C. 21. Any action or fee due on such a day may be taken, or fee paid, on the next succeeding business day the Office is open. In addition, 37 CFR 1.6(a)(1) provides "[t]he Patent and Trademark Office is not open for the filing of correspondence on any day that is a Saturday, Sunday or Federal holiday within the District of Columbia" to clarify that any day that is a Saturday, Sunday or Federal holiday within the District of Columbia is a day that the Patent and Trademark Office is not open for the filing of applications within the meaning of Article 4(C)(3) of the Paris Convention. Note further that in accordance with 37 CFR 1.6(a)(2), even when the Office is not open for the filing of correspondence on any day that is a Saturday, Sunday or Federal holiday within the District of Columbia, correspondence deposited as Express Mail with the USPS in accordance with 37 CFR 1.10 will be considered filed on the date of its deposit, regardless

of whether that date is a Saturday, Sunday or Federal holiday within the District of Columbia (under 35 U.S.C. 21(b) or 37 CFR 1.7).<

When the Patent and Trademark Office is open for business during any part of a business day between 8:30 a.m. and 5:00 p.m., papers are due on that day even though the Office may be officially closed for some period of time during the business day because of an unscheduled event. The procedures of 37 CFR 1.10 may be used for filing applications.

Information regarding whether or not the Office is officially closed on any particular day may be obtained by calling (703) *308-4357 which transposes to (703) 308-HELP.<

WARNING: Since a provisional application can be pending for no more than twelve months, the last day of pendency may occur on a Saturday, Sunday, or Federal holiday within the District of Columbia which for copendency would require the nonprovisional application to be filed prior to the Saturday, Sunday, or Federal holiday. See 37 CFR 1.78(a)(3). >However, note that new patent applications filed in accordance with 37 CFR 1.10 will be stamped by the Office with the date of deposit as "Express Mail" with the United States Postal Service. For example, if a new patent application is deposited in "Express Mail" in accordance with 37 CFR 1.10 on a Saturday and the United States Postal Service gives it a date of deposit of Saturday, the Office will accord and stamp the correspondence with the Saturday date. 37 CFR 1.6(a)(2).<

REGULATIONS FOR THE PUBLIC USE OF RECORDS IN THE PUBLIC SEARCH ROOM FOR PATENTS OF THE PATENT AND TRADEMARK OFFICE

The Patent and Trademark Office has established Procedures and Regulations for using the facilities of the Public Search Room for Patents. The procedures for the Search Room include the requirement that users obtain and show, prior to entering the Search Room facilities, a User Pass. This pass can be obtained at the receptionist's desk in the lobby of >Crystal Plaza< Building 3. User Passes will be issued to persons not under prohibition from using the search facilities who sign an application form and acknowledge receipt of a copy of the noted Regulations. User Passes are nontransferable and are valid until reissue or revocation for cause. Office

employees must show their building pass in order to enter the Public Search Room.

The procedures also include the requirement that persons entering and exiting the Search Room use designated lanes. Persons exiting the Search Room will automatically pass electronic sensing equipment designed to detect any marked documents or materials being removed from the Search Room. The sensing equipment is capable of detecting marked documents and materials in briefcases and parcels and under clothing. The equipment does not use X-ray or other high energy radiation and is, therefore, completely safe and harmless to persons, photographic film, magnetic tape, and electronic or mechanical devices such as wrist watches. New patents are marked for sensing before being placed in the Classified files.

Whenever a marked document is transported past the sensing equipment, Patent and Trademark Office officials and the security guards will be alerted to the removal of the document, and a gate on the exit lane will lock. Persons triggering the alarm will be asked to cooperate in identifying the source for the alarm. Failure to cooperate when the alarm is triggered could result in detention of the person, seizure of any briefcase or the like, or other legal measures deemed necessary and appropriate in the specific case.

The regulations for the Search Room are reprinted in a Regulation brochure. It is available in the Search Room. In order to maintain an environment conducive to search, the Regulations will be strictly enforced.

Although these procedures and regulations may cause some inconvenience, it is hoped that with understanding and cooperation they will result in improvement in search facilities which will benefit all participants in the U.S. patent system.

Persons violating the regulations may be denied the use of the facilities in the Public Search Room for Patents, and may further be subjected to prosecution under the Criminal Code. Additionally, the name of any person violating these regulations who is registered to practice before the Patent and Trademark Office may be forwarded to the Office of Enrollment and Discipline for appropriate action under 37 CFR Part 10.

USE OF PATENT EXAMINING GROUP FACILITIES

The primary function of the Patent and Trademark Office is the examination of nonprovisional applications

for patents and the issuance of valid patents based upon a search and consideration of the best available prior art. This can be accomplished only through maintaining strict search file integrity within the patent examining group facilities.

Therefore, the regulations appearing below were established for those authorized members of the public using the facilities of the patent examining groups.

Although these regulations may cause some inconvenience, it is believed that with the cooperation and understanding of the public, a more efficient and reliable examination system within the patent examining groups will result.

A copy of the following "Regulations for Users of the Patent Examining Group Facilities," is posted in each of the Patent Examining Groups and the Public Search Room for Patents:

REGULATIONS FOR USERS OF THE PATENT EXAMINING GROUP SEARCH FACILITIES

1. Group facilities are defined as those areas in Crystal City where the Examining Groups are located.
2. The use of the Group facilities for search purposes by members of the public is strictly limited to the search of materials not available in the Public Search Room for Patents or the Scientific Library and when it does not conflict with the regular business of Patent and Trademark personnel and only between the hours of 8:45 a.m. and 4:45 p.m. on regular business days.
3. Authorized Officials, under these Regulations, include Supervisory Patent Examiners and Examining Group Directors.
4. Under applicable statutes and regulations, including 40 U.S.C. 486(c); 41 CFR Subpart 101-20.3; and appropriate Sections of Department Organization Orders 30-3A and 30-3B of the Department of Commerce, the Regulations appearing below are established for those members of the public using the Group Facilities.
 - A. All persons using these facilities are subject to the Regulations Governing Conduct on Federal Property, as specified in 41 CFR Subpart 101-20.3.
 - B. All posted Official Notices are to be complied with.
 - C. A valid User Pass must be prominently displayed when searching in the Group Facilities. User Passes are nontransferable and must be surrendered upon request to authorized officials.

D. All persons holding User Passes must register with the Group Receptionist, unless otherwise directed, in each Examining Group where they search and must sign a log (e.g., indicating time-in, time-out, name, User Pass number, class(es) and subclass(es) searched).

E. No patents, records, or other documents of the Patent and Trademark Office shall be removed from the Group Facilities except by express written authorization by an authorized official in the Examining Group where the material resides. Such authorization will not be given for U.S. patents and other material readily available through the Scientific Library.

F. Smoking is not permitted except in designated areas.

G. No food or beverages in any form are to be consumed except in designated areas.

H. Loud talking, use of radios, and any other form of activity which may disturb other members of the public or Patent and Trademark Office personnel are forbidden.

I. Children brought into the Group Facilities must not be allowed to disturb others.

J. The presence or use of equipment such as dictation equipment, reproducing machines, typewriters, and photographic equipment is prohibited without prior permission from an authorized official in the Examining Group where the use is intended and then is permitted where its use does not conflict with Regulation H.

K. Patents and other documents must not be removed from their shoes for any reason other than for cursory study thereof while kept in close proximate association with the shoe and must not be moved out of their normal sequence.

L. All patent shoes must be promptly replaced in their proper location in the shoe case.

M. All textbooks, journals, and the like must be returned to their proper location.

N. The reserving of seats and/or working areas is prohibited.

O. All packages, briefcases, or other personal effects brought into the Group Facilities are subject to search by authorized officials upon request and must be removed when leaving the Group Facilities.

P. All verbal requests for compliance with these regulations or other posted Patent and Trademark Office Notices pertaining to activity in the Group Facilities, when made by authorized officials, must be promptly complied with.

5. Persons violating these regulations may be denied the use of the facilities in the Examining Groups and Public Search Room for Patents, and may further be subject to prosecution under the Criminal Code. Additionally, the name of any person violating these regulations who is registered to practice before the Patent and Trademark Office may be forwarded to the Office of Enrollment and Discipline for appropriate action under 37 CFR Part 10.

If any individual is observed in violation of any of the regulations, immediate compliance should be courteously requested. If a verbal request is not complied with, a note should be made of the individual's name and User's Pass number, if possible (the User's Pass is required to be prominently displayed) and report the incident to the Supervisory Primary Examiner, Supervisory Applications Examiner, or other appropriate supervisor who will take further action.

In addition, if any individual in a search area appears to be a stranger and is not wearing a User's Pass, some identification, such as a Building or User's Pass, should be requested. If the individual refuses, notify a supervisor. Consequently, all Office employees are expected to carry their Building Pass with them at all times, especially when searching outside of their assigned groups.

Supervisors, when aware of violations of the posted regulations, should prepare a memorandum detailing the facts of the incident and forward this memorandum to the Deputy Assistant Commissioner for Patents via their Group Director. Supervisory Patent Examiners and Group Directors are authorized to demand surrender of User Passes on-the-spot. If the Supervisory Patent Examiner exercises this function, the Group Director should be immediately notified, followed up by a memorandum as previously set forth.

511 Postal Service Emergency Contingency Plan [R-1]

35 U.S.C. 21. Filing date and day for taking action.

(a) The Commissioner may by rule prescribe that any paper or fee required to be filed in the Patent and Trademark Office will be considered filed in the Office on the date on which it was deposited with the United States Postal Service or would have been deposited with the United States Postal Service but for postal service interruptions or emergencies designated by the Commissioner.

37 CFR 1.6. Receipt of letters and papers.

(e) Interruptions in U.S. Postal Service.

If interruptions or emergencies in the United States Postal Service which have been so designated by the Commissioner occur, the Patent and Trademark Office will consider as filed on a particular date in the Office any correspondence which is:

(1) Promptly filed after the ending of the designated interruption or emergency; and

(2) Accompanied by a statement indicating that such correspondence would have been filed on that particular date if it were not for the designated interruption or emergency in the United States Postal Service. Such statement must be a verified statement if made by a person other than a practitioner as defined in § 10.1(r) of this chapter.

37 CFR 1.6(e) provides a procedure under which correspondence (papers and fees) which could not be filed on a particular date because of an interruption or emergency in the United States Postal Service which is so designated by the Commissioner, may be promptly filed after the ending of such a designated interruption or emergency and be considered as having been filed on that particular date. Authority for such a practice is found in 35 U.S.C. 21(a), as amended by Pub. L. 97-247.

The U.S. Patent and Trademark Office is establishing the following contingency plan for filing correspondence in the Office in the event of a designated interruption or emergency in the mail service in the United States. Upon determination by the Commissioner of Patents and Trademarks that such an emergency exists, a notice activating the plan will be issued by the Commissioner. The activating notice will be published in the Wall Street Journal and made available by telephone at area code 703, 557-INFO. Also, certain publications, patent bar groups, and other organizations closely associated with the patent system, will be notified. Termination of the program will be similarly announced. Where the postal emergency is not nationwide, the Commissioner will designate the areas of the United States in which the procedures outlined below will be in effect.

U.S. Department of Commerce District Offices will be designated, on an emergency basis, as receiving stations for filing correspondence in the U.S. Patent and Trademark Office.

Upon determination that an emergency exists, the following procedures may be followed: All correspondence should be enclosed in a sealed envelope addressed to the Patent and Trademark Office and deposited in one

of the District Offices. Such papers will be considered as received in the U.S. Patent and Trademark Office on the day of deposit. The District Office will date stamp each envelope and the accompanying receipt card which completely identifies the deposited papers. The receipt card will be returned to the depositor. Applicants or their representatives should assure the legibility of the date stamp.

District Office deposits should be limited to checks in payment of issue fees, new application papers wherein priority dates or statutory bars may be involved, amendments where the 6-month statutory period for response is about to expire, trademark oppositions, Section 8 affidavits, trademark renewals, and to other papers for which the patent and trademark statutes do not provide a remedy for failure to obtain a particular date.

Where papers originate from overseas, it is suggested that the papers be mailed to a registered agent in Canada, with a request that the papers be forwarded by courier to the nearest District Office in the United States.

In regard to pending applications, if the time for taking any action or paying any fee expires during the period that the Commissioner declares to be an emergency, the time will be extended until 1-month after the end of the emergency period, provided that such extension does not exceed the maximum period for response provided for in the statutes.

Since this extension of time will be automatic, there will be no record in the individual files to indicate that a response filed during the extended period is in fact timely. In order to provide a complete record, applicants or their representatives should file a paper referring to this notice in each case in which a response is filed during the extended period.

The addresses of the Department of Commerce District Offices, subject to subsequent changes, are as follows:

ALABAMA

Birmingham — Room 302, 2015 2nd Avenue North, 3rd floor, Berry Bldg. 35203, Area Code 205 Tel 731-1331.

ALASKA

Anchorage — 222 West 7th Ave., >#23,< 99513-
* >7575<, Area Code 907 Tel 271-* >5136<.

ARIZONA

Phoenix — **>Phoenix Plaza, Suite 970, 2901 N. Central Avenue, 85012, Area Code 602 Tel 640-2513<.

ARKANSAS

Little Rock — ** >Suite 700, 425 W. Capital Avenue, 72201, Area Code 501 Tel 324-5794<.

CALIFORNIA

Los Angeles — Room *>9200<, 11000 Wilshire Boulevard *>90024<, Area Code **>310 Tel 235-7104<.

**>Newport Beach - Suite 305, 3300 Irvine Avenue, 92660, Area Code 714 Tel 660-1688<.

San Diego — Suite *>230<, 6363 Greenwich Drive 92122, Area Code 619 Tel 557-5395.

San Francisco — 14th Fl., 250 Montgomery St. 94104, Area Code 415 Tel 705-*>2300<.

>Santa Clara - 5201 Great American Pkwy., #456, 95054, Area Code 408 Tel 748-7450.<

COLORADO

Denver — Rm. 680, 1625 Broadway, ** 80202, Area Code 303 Tel 844-*>6622<.

CONNECTICUT

Hartford — Room 610-B, Federal Office Building, 450 Main Street 06103, Area Code 203 Tel 240-3530.

FLORIDA

**

Clearwater — 128 North Osceola Avenue 34615, Area Code 813 Tel 461-0011.

Orlando — **>Eola Park Centre, Suite 695, 200 E. Robinson St. 32801, Area Code 407 Tel 648-6756<.

Tallahassee — ** Rm. *>366G<, 107 W. Gaines St. 32399-2000, Area Code 904 Tel 488-6469.

GEORGIA

Atlanta — Suite 310, 4360 Chamblee-Dunwoody Rd., 30341, Area Code 404 Tel 452-910*>1<.

Savannah — 120 Barnard Street, A-107 31401, Area Code 912 Tel **>652-4204<.

HAWAII

Honolulu — P.O. Box 50026, 300 Ala Moana Boulevard 96850, Area Code 808 Tel 541-1782.

IDAHO

Boise — 2nd Fl., Hall of Mirrors, 700 W. State St., 83720, Area Code 208 Tel 334-3857.

ILLINOIS

**

Rockford — 515 North Court Street, P.O. Box 1747 61110-0247, Area Code 815 Tel 987-8123.

>Wheaton — c/o Illinois Institute of Technology, 201 E. Loop Road, 60187, Area Code 312 Tel 353-4332.<

INDIANA

Indianapolis — **>Penwood One, Suite 106, 11405 N. Pennsylvania Street, 46032, Area Code 317 Tel 582-2300.<

IOWA

Des Moines — 817 Federal Building, 210 Walnut Street 50309, Area Code 515 Tel 284-4222.

KANSAS

Wichita — 151 North *>V<olutsia, 67214-4695, Area Code 316 Tel 269-6160.

KENTUCKY

Louisville — **>Marmaduke Building, 3rd Floor, 520 South 4th Street, 40202, Area Code 502 Tel 582-5066.<

LOUISIANA

New Orleans — **>Hale Boggs Federal Building, 501 Magazine Street, Room 1043, < 70130, Area Code 504 Tel 589-6546.

MAINE

Augusta — **>187 State Street,< Area Code 207 Tel 622-8249.

**

MASSACHUSETTS

Boston — World Trade Center, Suite 307 **>164 Northern Ave., < 02210, Area Code 617 Tel **>424-5990<.

MICHIGAN

Detroit — 1140 McNamara Bldg. 477 Michigan Avenue, 48226, Area Code 313 Tel 226-3650.

Grand Rapids — 300 Monroe N.W., Rm. 409 49503, Area Code 616 Tel 456-2411.

MINNESOTA

Minneapolis — 108 Federal Building, 110 South Fourth Street 55401, Area Code 612 Tel 348-1638.

MISSISSIPPI

Jackson — **>201 West Capitol St., 310 Millsaps Bldg. 39201-2005<, Area Code 601 Tel 965-4388.

MISSOURI

St. Louis — **>8182 Maryland Avenue, Suite 303<, 63105, Area Code 314 Tel 425-3302-4.

Kansas City — Room 635, 601 East 12th Street 64106, Area Code 816 Tel **>426-3141<.

NEBRASKA

Omaha — 11133 O Street 68137, Area Code 402 Tel 221-3664.

NEVADA

Reno — 1755 E. Plumb Lane, #152, 89502, Area Code 702 Tel 784-5203.

NEW JERSEY

Trenton — 3131 Princeton Pike Bldg., 6, Suite 100, 08648, Area Code 609 Tel 989-*>2395<.

NEW MEXICO

**

>Sante Fe (Dallas Tx, District) — Attn: c/o New Mexico Dept. of Economic Development, 1100 St. Francis Dr., 87503, Area Code 505 Tel 827-0350.<

NEW YORK

Buffalo — 1312 Federal Building, 111 West Huron Street 14202, Area Code 716 Tel 846-4191.

New York — Room 3718, Federal Office Building, 26 Federal Plaza, 10278, Area Code 212 Tel 264-0634.

NORTH CAROLINA

Greensboro — Suite 400, **>400< West Market Street, 27401, Area Code *>910< Tel 333-5345.

OHIO

Cincinnati — 9504 Federal Office Building, 550 Main Street 45202, Area Code 513 Tel 684-2944.

Cleveland — **>Bank One Center, 600 Superior Ave., Suite 700< 44114, Area Code 216 Tel 522-4750.

OKLAHOMA

Oklahoma City — 6601 Broadway Extension, Suite 200 *>73116<, Area Code 405 Tel 231-5302.

Tulsa — 440 S. Houston St. 74127, Area Code 918 Tel 581-7650.

OREGON

Portland — One World Trade Center, 121 S.W. Salmon, Suite 242, 97204, Area Code 503 Tel *>326-3001<.

PENNSYLVANIA

Philadelphia — Suite 202, **>600 American Ave.<, King Of Prussia 19406, Area Code 215 Tel 962-*>4990<.

Pittsburgh — 2002 Federal Building, 1000 Liberty Avenue 15222, Area Code 412 Tel 644-2850.

PUERTO RICO

San Juan (Hato Rey) — Room G-55-Federal Building, Chardon Ave. 00918, Area Code 809 Tel 766-5555.

RHODE ISLAND

Providence — 7 Jackson Walkway 02903, Area Code 401 Tel 528-5104.

SOUTH CAROLINA

Charleston — **>c/o Trident Technical College, PO Box 118067, 66 Columbus St., 29423, Area Code 803 Tel 727-4051.<

Columbia — Strom Thurmond Fed. Bldg., Suite 172, 1835 Assembly Street 29201, Area Code 803 Tel 765-5345.

TENNESSEE

Memphis — 22 N. Front St., Suite 200, 3810* > 3 <, Area Code 901 Tel * > 544-4137 <.

Nashville — Suite * > 114 <, Parkway Towers, 404 James Robertson Pkwy., 37219-1505, Area Code 615 Tel 736-5161.

TEXAS

Dallas — ** > 2050 N. Stemmons Fwy, Suite 170, 75258, Area Code 214 Tel 767-0542. <

Houston — ** > #1 Allen Ctr. 500 Dallas, Suite 1160, < 77002, Area Code 713 Tel 229-2578.

UTAH

Salt Lake City — 324 South State St., Suite 105, 84111, Area Code 801 Tel 524-5116.

VIRGINIA

Richmond — ** > 700 Centre, 704 E. Franklin St., Suite 550, 23219, <, Area Code 804 Tel 771-2246.

WASHINGTON

Seattle — 3131 Elliott Ave., Suite 290, 98121, Area Code 206 Tel 553-561* > 5 <.

WEST VIRGINIA

Charleston — 405 Capitol Street >, Suite 807, < 25301, Area Code 304 Tel 347-5408.

WISCONSIN

Milwaukee — * > 596 < Federal Bldg., 517 East Wisconsin Avenue 53202, Area Code 414 Tel 291-3470.

512 Certificate of Mailing or Transmission [R-3]

37 CFR 1.8. Certificate of mailing or transmission.

(a) Except in the cases enumerated in paragraph (a)(2) of this section, correspondence required to be filed in the Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.

(1) Correspondence will be considered as being timely filed if:

(i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:

(A) ** > Addressed as set out in § 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail <; or

(B) Transmitted by facsimile to the Patent and Trademark Office in accordance with § 1.6(d); and

(ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.

(2) The procedure described in paragraph (a)(1) of this section does not apply to, and no benefit will be given to a certificate of Mailing or Transmission on, the following:

(i) Relative to Patents and Patent Applications—

(A) The filing of a national patent application specification and drawing or other correspondence for the purpose of obtaining an application filing date;

(B) The filing of correspondence in an interference which an examiner-in-chief orders to be filed by hand or "Express Mail";

(C) The filing of agreements between parties to an interference under 35 U.S.C. 135(c);

(D) The filing of an international application for patent;

(E) The filing of correspondence in an international application before the U.S. Receiving Office, the U.S. International Searching Authority, or the U.S. International Preliminary Examining Authority;

(F) The filing of a copy of the international application and the basic national fee necessary to enter the national stage, as specified in §§ 1.494(b) or 1.495(b).

(ii) Relative to Trademark Registrations and Trademark Applications:

(A) The filing of a trademark application.

(B) ** > [Reserved] <

(C) ** > [Reserved] <

(D) ** > [Reserved] <

(E) ** > [Reserved] <

(F) ** > [Reserved] <

(iii) Relative to Disciplinary Proceedings—

(A) Correspondence filed in connection with a disciplinary proceeding under part 10 of this chapter.

(B) *Reserved*

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence,

(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate, and

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission. Such statement must be a verified statement if made by a person other than a practitioner as defined in § 101(r) of this chapter. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

(c) The Office may require additional evidence to determine if the correspondence was timely filed.

A suggested format for a Certificate of Mailing and a Certificate of Transmission under 37 CFR 1.8 to be included with the correspondence is reproduced below.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Assistant Commissioner for Patents
Washington, D.C. 20231

on _____
(Date)

Typed or printed name of person signing this certificate

Signature _____

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) ___-___)

on _____
(Date)

Typed or printed name of person signing this certificate

Signature _____

¶ 5.02 *Format of Certificate of Mailing or Transmission*

The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under the Rules. Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for response. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Assistant Commissioner for Patents
Washington, D.C. 20231

on _____
(Date)

Typed or printed name of person signing this certificate

Signature _____

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office Fax No. (703) ___-___

on _____
(Date)

Typed or printed name of person signing this certificate

Signature _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

For a *Pro Se* inventor, Form Paragraph 17.11 may be used in place of Form Paragraph 5.02.

¶ 17.11 *Suggestion of Certificate of Mailing, Pro Se*

It is called to applicant's attention that if a communication is mailed before the response time has expired applicant may submit the response with a "Certificate of Mailing" in accordance with 37 CFR 1.8(a) which merely asserts that the response is being mailed on a given date. So mailed, before the period of response has expired, the response is considered timely. A suggested format for a certificate follows.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Assistant Commissioner for Patents
Washington, D.C. 20231

on _____
(Date)

Typed or printed name of person signing this certificate

Signature _____

Under 37 CFR 1.8, a person may state on certain papers directed to the Office (exceptions are stated in 37 CFR 1.8), the date on which the paper will be deposited in the United States Postal Service or transmitted by facsimile. If the date stated is within the period for response, the response in most instances will be considered to be timely. This is true even if the paper does not

actually reach the Office until after the end of the period for response. The Certificate of Mailing procedure does not apply to papers mailed in a foreign country.

The Certificate of Transmission procedure, however, also applies to papers transmitted to the Office from a foreign country provided that the correspondence being transmitted is not prohibited from being transmitted by facsimile and is not otherwise precluded from receiving the benefits under 37 CFR 1.8.

It should be noted, however, that the Office will continue its normal practice of stamping the date of receipt (Mail Room Stamp) on all papers received through the mail or by facsimile except those filed under 37 CFR 1.10 (See MPEP § 513). The date stamped will also be the date which is entered on Office records and from which any subsequent periods are calculated. For example, 37 CFR 1.192 gives an appellant 2 months from the date of the appeal to file an appeal brief. For example, if the last day to respond to a final rejection was November 10, 1976, and applicant deposited a Notice of Appeal with fee in the U.S. mail on November 10, 1976, and so certified, that appeal is timely even if it was not received in the Patent and Trademark Office until November 17, 1976. Since the date of receipt will be used to calculate the time at which the brief is due, the brief was due on January 17, 1977. This is 2 months after the Mail Room date.

Procedure by Applicant

(A) The certification requires a signature. Specifically, if the certification appears on a paper that requires a signature, two signatures are required, one for the paper and one for the certification. Although not specifically required by 37 CFR 1.8, it is preferred that the certificate be signed by the applicant, assignee, or registered practitioner.

(B) When possible, the certification should appear on a portion of the paper being submitted. However, if there is insufficient space to make the certification on the same paper, the certification should be on a separate sheet securely attached to the paper.

(C) When the certification is presented on a separate sheet, that sheet must (1) be signed and (2) fully identify and be securely attached to the paper it accompanies. The required identification should include the serial number and filing date of the application as well as the type of paper being filed, e.g., response to rejection or re-

fusal, Notice of Appeal, etc. An unsigned certification will not be considered acceptable.

Moreover, without the proper identifying data, a certification presented on a separate sheet will not be considered acceptable if there is any question or doubt concerning the connection between the sheet and the paper filed.

If the sheet should become detached from the paper and thereafter not associated with the appropriate file, evidence that this sheet was received in the Office can be supported by submitting a copy of a postcard receipt specifically identifying this sheet and the paper and by submitting a copy of the sheet as originally mailed. Attention is directed to MPEP § 503 relative to the use of postcards as receipts.

(D) In situations wherein the correspondence includes papers for more than one application (e.g., a single envelope containing separate papers responding to Office actions in different applications) or papers for various parts of the Office (e.g., a patent issue fee transmittal form **>PTOL-85B< and an assignment), each paper must have its own certification as a part thereof or attached thereto.

Although Form PTOL-*>85B<, Issue Fee Transmittal Form, may contain a Certificate of Mailing thereon, a separate Certificate of Mailing is required for all papers included with this form, including formal drawings, since papers are separated and flow to different areas of the Office. Checks submitted with the papers do not require a separate certification.

(E) In situations wherein the correspondence includes several papers directed to the same area of the Office for the same application (for example, a proposed response under 37 CFR 1.116 and a Notice of Appeal), each paper should have its own certification as a part thereof or attached thereto.

>(F) For the purposes of 37 CFR 1.8(a)(1)(i)(A), first class mail is interpreted as including "Express Mail" and "Priority Mail" deposited with the U.S. Postal Service.<

Alternatively, the correspondence may be submitted with a cover or transmittal letter which itemizes the papers and on which is placed the certificate under 37 CFR 1.8.

Use of Stamped Certification

Some practitioners place the certification language on the first page of a paper with an inked stamp. Such a

practice is encouraged because the certification is not only readily visible but also forms an integral part of the paper.

Office Procedure

Mail Room

The Mail Room will continue to date stamp the actual date of receipt of all papers received by mail in the Office. No attempt will be made to retain the envelopes in which the papers are received or to indicate on the papers the postal cancellation date (postmark).

However, the benefits of 37 CFR 1.8 or 1.10 apply only to documents delivered to the Office by the U.S. Postal service. A number of instances have been uncovered where individuals are certifying that documents were deposited with the U.S. Postal Service when, in fact, the documents were hand-carried or delivered to the Office via commercial couriers; e.g., "Federal Express," "DHL," "Purolator," "Air Borne," "UPS," etc. In those instances where documents include a Certificate of Mailing under 37 CFR 1.8 or "Express Mail" mailing label (commonly used to comply with 37 CFR 1.10) but were delivered to the Office by other than the U.S. Postal Service, Mail Room personnel are placing a notice indicating that fact on the correspondence involved to alert Office personnel that the benefits of 37 CFR 1.8 or 1.10 do not apply.

Processing Areas

When papers are received in an examining group, the date of receipt in the group is stamped on the papers.

The date indicated on the Certificate of Mailing or of Transmission will be used by the Office only to determine if the paper was deposited in the United States Postal Service or transmitted by facsimile within the period for response. If the paper was actually received in the Office within the period for response, there is no need to refer to the Certificate. Note however, that 37 CFR 1.6(a)(3) provides that "[c]orrespondence transmitted by facsimile to the Patent and Trademark Office will be stamped with the date on which the complete transmission is received in the Patent and Trademark Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the date stamped will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia."

When papers are received in an examining group, the date of receipt in the group should be stamped on the papers in accordance with 37 CFR 1.6(a).

If, however, the paper was received in the Patent and Trademark Office after the end of the period for response, the paper should be inspected to determine if a Certificate of Mailing or of Transmission has been included. Where no such Certificate is found, the paper is untimely since applicant did not respond within the period for response. This may result in abandonment of the application or other loss of rights.

In those instances where a Certificate of Mailing or of Transmission does appear in the paper or a cover letter thereto, a check should be made to determine whether the indicated date of deposit or transmission is within the period for response. If the date indicated in the Certificate is after the end of the period for response, the paper is untimely and no notation of the date need be made. Where the date indicated on the Certificate is within the period for response, the paper should be considered to be timely filed. A notation should be made adjacent to the Office stamp indicating the date of receipt (Mail Room Stamp) which notes the date stated on the Certificate. This notation should be "C of Mail" or "C of Fax" followed by the date. A paper with a certificate dated November 10, 1976, would be noted next to the Mail Room Stamp "(C of Mail. 11/10/76)." This notation should also appear on the "Contents" portion of the file wrapper.

If the period set for taking an action in the Patent and Trademark Office ends on a Saturday, Sunday, or Federal holiday within the District of Columbia (37 CFR 1.7), the action will be considered to be timely if deposited in the United States mail or transmitted by facsimile and certified under 37 CFR 1.8(a) on the next succeeding day which is not a Saturday, Sunday, or a Federal holiday.

It should be noted that the filing of a paper for the purpose of obtaining a continuation or division application under 37 CFR 1.60 or 1.62 is excluded from the Certificate practice under 37 CFR 1.8(a)(2)(i) since it is considered to be the filing of a national patent application.

WARNING: Since a provisional application can be pending for no more than twelve months, the last day of pendency may occur on a Saturday, Sunday, or Federal holiday within the District of Columbia which for copendency would require the nonprovisional application to be filed prior to the Saturday, Sunday, or Federal

holiday. See 37 CFR 1.78(a)(3). No benefit will be given to a Certificate of Mailing or Transmission relative to the filing of a national patent application specification and drawing or other correspondence for the purpose of obtaining an application filing date. However, note that new patent applications, filed in accordance with 37 CFR 1.10 will be stamped by the Office with the date of deposit as "Express Mail" with the United States Postal Service. For example, if a new patent application is deposited in "Express Mail" in accordance with 37 CFR 1.10 on a Saturday and the United States Postal Service gives it a date of deposit of Saturday, the Office will accord and stamp the correspondence with the Saturday date. 37 CFR 1.6(a)(2).<

All Certificates of Mailing or Transmission filed in applications should be placed in the file wrappers directly below the papers to which they refer.

Group personnel receiving a hand-delivered paper from other than U.S. Postal Service personnel should inspect the paper to ensure that the benefits of 37 CFR 1.8 or >"Express Mail" benefits under 37 CFR< 1.10 are not accorded in error. If the paper contains a certificate of mailing under 37 CFR 1.8 or >"Express Mail" mailing label (commonly used to comply with 37 CFR< 1.10>)<, the words "HAND DELIVERED" should be written adjacent to the group date stamp.

Applicant should be notified in the next Office action when a paper containing a Certificate of Mailing has been denied the benefits under 37 CFR 1.8 or >a paper containing an "Express Mail" mailing label (commonly used to comply with 37 CFR 1.10) is denied benefits under 37 CFR<1.10 by including, for example, form paragraph 5.0*>4.<

¶ 5.0*>4<Benefit of Certificate of Mailing Denied

The [1] filed [2] is not entitled to the benefits of 37 CFR [3] since it was not delivered to the Patent and Trademark Office by the U.S. Postal Service. Therefore, the date of receipt in the Patent and Trademark Office has been used to determine the timeliness of the paper.

Examiner Note:

This form paragraph is to be used in those situations where correspondence contains a Certificate of Mailing under 37 CFR 1.8 or **>requests the benefit of< "Express Mail" under 37 CFR 1.10 but the correspondence was not actually deposited with the U.S. Postal Service.

Misuse of a Certificate of Mailing under 37 CFR 1.8 or >improperly claiming the benefit of 37 CFR< 1.10 which appears to be more than a one-time, inadvertent error should be brought to the attention of the Office of Enrollment and Discipline.

Original Mailed Paper Not Delivered

Paragraphs (b) and (c) of 37 CFR 1.8 concern the situation where a paper containing a Certificate was timely deposited in the U.S. mail or transmitted by facsimile, but never received by the Patent and Trademark Office. In the examining groups, all submissions under these paragraphs should be considered and the sufficiency thereof determined by the Group Director.

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35 U.S.C. 21. Filing date and day for taking action.

(a) The Commissioner may by rule prescribe that any paper or fee required to be filed in the Patent and Trademark Office will be considered filed in the Office on the date on which it was deposited with the United States Postal Service or would have been deposited with the United States Postal Service but for postal service interruptions or emergencies designated by the Commissioner.

>37 CFR 1.6. Receipt of correspondence.

(a) *Date of receipt and Express Mail date of deposit.* Correspondence received in the Patent and Trademark Office is stamped with the date of receipt except as follows:

(1) The Patent and Trademark Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia. Except for correspondence transmitted by facsimile as provided for in paragraph (a)(3) of this section, no correspondence is received in the Patent and Trademark Office on Saturdays, Sundays, or Federal holidays within the District of Columbia.

(2) Correspondence filed in accordance with § 1.10 will be stamped with the date of deposit as "Express Mail" with the United States Postal Service.

(3) Correspondence transmitted by facsimile to the Patent and Trademark Office will be stamped with the date on which the complete transmission is received in the Patent and Trademark Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the date stamped will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia.<

*37 CFR 1.10. Filing of **>correspondence< by "Express Mail"*

**

**>(a) Any correspondence received by the Patent and Trademark Office (Office) that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed in the Office on the date of deposit with the USPS. The date of deposit with the USPS is shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation. If the USPS deposit date cannot be determined, the correspondence will be accorded the Office receipt date as the filing date. See § 1.6(a).

(b) Correspondence should be deposited directly with an employee of the USPS to ensure that the person depositing the correspondence receives a legible copy of the "Express Mail" mailing label with the "date-in" clearly marked. Persons dealing indirectly with the employees

of the USPS (such as by deposit in an "Express Mail" drop box) do so at the risk of not receiving a copy of the "Express Mail" mailing label with the desired "date-in" clearly marked. The paper(s) or fee(s) that constitute the correspondence should also include the "Express Mail" mailing label number thereon. See paragraphs (c), (d) and (e) of this section.

(c) Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation, may petition the Commissioner to accord the correspondence a filing date as of the "date-in" on the "Express Mail" mailing label or other official USPS notation, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail"; and

(3) The petition includes a true copy of the "Express Mail" mailing label showing the "date-in," and of any other official notation by the USPS relied upon to show the date of deposit.

(d) Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Commissioner to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail"; and

(3) The petition includes a showing which establishes, to the satisfaction of the Commissioner, that the requested filing date was the date the correspondence was deposited in "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS. Any statement submitted in support of such a showing pursuant to this paragraph must be a verified statement if made by a person other than an employee of the USPS or a practitioner as defined in § 10.1(r) of this chapter.

(e) Any person mailing correspondence addressed as set out in § 1.1(a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS but not received by the Office, may petition the Commissioner to consider such correspondence filed in the Office on the USPS deposit date, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail";

(3) The petition includes a copy of the originally deposited paper(s) or fee(s) that constitute the correspondence showing the number of the "Express Mail" mailing label thereon, a copy of any returned postcard receipt, a copy of the "Express Mail" mailing label

showing the "date-in," a copy of any other official notation by the USPS relied upon to show the date of deposit, and, if the requested filing date is a date other than the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS, a showing pursuant to paragraph (d)(3) of this section that the requested filing date was the date the correspondence was deposited in "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day; and

(4) The petition includes a statement which establishes, to the satisfaction of the Commissioner, the original deposit of the correspondence, and that the copies of the correspondence, the copy of the "Express Mail" mailing label, the copy of any returned postcard receipt, and any official notation entered by the USPS are true copies of the originally mailed correspondence and original "Express Mail" mailing label, returned postcard receipt, and official notation entered by the USPS. Such statement must be a verified statement if made by a person other than a practitioner as defined in § 10.1(r) of this chapter.

(f) The Office may require additional evidence to determine if the correspondence was deposited as "Express Mail" with the USPS on the date in question.<

**> The statutory authority for the granting of a filing date based on the date of deposit for correspondence sent by "Express Mail" and received by the Office is found in section 21(a) of Title 35 of the United States Code.

The specific regulation for obtaining a filing date as of the date of deposit in "Express Mail" (rather than the date of receipt at the Office) is 37 CFR 1.10, as revised, effective December 2, 1996.

EFFECTIVE DATE, WEEKENDS & HOLIDAYS

Effective December 2, 1996, 37 CFR 1.6(a)(2) provides that correspondence deposited as "Express Mail" in accordance with 37 CFR 1.10 will be stamped, and, therefore, considered as filed on the date of its deposit, regardless of whether that date is a Saturday, Sunday or Federal holiday within the District of Columbia. 37 CFR 1.10 provides a procedure for assigning the date on which any paper or fee is deposited as "Express Mail" with the United States Postal Service (USPS) as the filing date of the paper or fee in the Patent and Trademark Office (Office). The date of deposit with the USPS is shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation. This holds true for any day that the correspondence may be accepted as "Express Mail" by the USPS, even when the paper or fee is deposited and accepted on a Saturday, Sunday or Federal holiday within the District of Columbia. For example, if a person files a patent application by "Express Mail" with the USPS on a Saturday in compliance with 37 CFR 1.10, he or she will receive the benefit of the Saturday date, even though the Office is closed on

Saturdays and, therefore, the person could not have filed the application by depositing it directly at the Office on that Saturday. See 37 CFR 1.6(a)(1). In those cases where the procedure of 37 CFR 1.10(a) has not been properly followed, e.g., the "date-in" is illegible, the filing date of the correspondence will be the date of actual receipt in the Office. An applicant may file a petition under the conditions specified in 37 CFR 1.10(c), (d) or (e) (discussed below) presenting whatever arguments and evidence that the paper or fee is entitled to a filing date other than the filing date accorded by the Office.

DATE-IN, DIRECT DEPOSIT, "EXPRESS MAIL" BOX RECEPTACLES & LOG BOOKS

The procedure in 37 CFR 1.10(a) requires the use of the "Express Mail Post Office to Addressee" service of the USPS. This service provides for the use of a mailing label on which the USPS clearly indicates the date on which it was deposited. Correspondence sent by the "Express Mail Post Office to Addressee" service is considered filed in the Office on the "date-in" entered by the USPS. The "date-in" on the "Express Mail" mailing label must be completed by the USPS, not by the applicant. For correspondence filed in accordance with 37 CFR 1.10, Office personnel will routinely look to the "Express Mail" mailing label, and stamp the "date-in" or other official USPS notation as the filing date of the correspondence. Accordingly, if the USPS enters the deposit date as its "date-in," the correspondence will receive the deposit date as its filing date. If the USPS deposit date cannot be determined, the correspondence will be accorded the date of receipt in the Office as the filing date. An applicant may file a petition under the conditions specified in 37 CFR 1.10(c), (d), or (e) (discussed below) presenting whatever arguments and evidence that the paper or fee is entitled to a filing date other than the filing date accorded by the Office.

37 CFR 1.10(b) further provides that correspondence should be deposited directly with an employee of the USPS to ensure that the person depositing the correspondence receives a legible copy of the "Express Mail" mailing label with the "date-in" clearly marked, and that persons dealing indirectly with the employees of the USPS (such as by depositing correspondence in an "Express Mail" drop box) do so at the risk of not receiving a copy of the "Express Mail" mailing label with the desired "date-in" clearly marked. On petition, the failure to obtain an "Express Mail" receipt with the "date-in" clearly marked may be considered an omission that could have been avoided by the exercise of due care, as dis-

cussed below. While the Office strongly urges direct deposit of "Express Mail" correspondence in order to obtain a legible copy of the "Express Mail" mailing label, parties are not precluded from using "Express Mail" drop boxes, but do so at their own risk.

A paper or fee placed in an "Express Mail" box receptacle after the box has been cleared for the last time on a given day will be considered to be deposited as of the date of receipt ("date-in") indicated on the "Express Mail" mailing label by the Postal Service "Express Mail" acceptance clerk. 37 CFR 1.10(d) permits the Office to correct a USPS "date-in" error when the correspondence is deposited in an "Express Mail" drop box prior to last scheduled pick up of the day, that is, the time clearly marked on the "Express Mail" drop box indicating when the box will be cleared for the last time on the date of deposit. 37 CFR 1.10(d) sets forth the procedures to be followed to be entitled to such a correction.

Parties who do use drop boxes can protect themselves from uncertainty due to illegible mailing labels by routinely maintaining a log of "Express Mail" deposits in which notations are entered by the person who deposited the correspondence as "Express Mail" within one business day after deposit with the USPS. Such evidence could be useful to later support a petition filed under 37 CFR 1.10(c), (d) or (e). Evidence that came into being after deposit and within one day after the deposit of the correspondence as "Express Mail" may be in the form of a log book which contains information such as the "Express Mail" number; the application number, attorney docket number or other such file identification number; the place, date and time of deposit; the time of the last scheduled pick-up for that date and place of deposit; the depositor's initials or signature; and the date and time of entry in the log. Any statement submitted in support of such a showing must be verified if made by a person other than an employee of the USPS or a practitioner as defined in 37 CFR 10.1(r).

"EXPRESS MAIL" MAILING LABEL NUMBER

Effective December 2, 1996, 37 CFR 1.10(b) no longer requires a certificate of mailing by "Express Mail" or that the "Express Mail" mailing label number be placed on the correspondence prior to mailing. Correspondence deposited with the USPS on or after December 2, 1996, and which is actually received by the Office will not be denied a filing date as of the "date-in" appearing on the "Express Mail" mailing label because the number of the "Express Mail" mailing label was not placed thereon prior to the original mailing. However, if

the number of the mailing label did not appear on the correspondence as originally filed, relief will not be granted on petition under 37 CFR 1.10(c) through (e), even if the party who filed the correspondence satisfies the other requirements of 37 CFR 1.10(c), 1.10(d) or 1.10(e). To be effective, the number must be placed on each separate paper and each fee transmittal either directly on the document or by a separate paper firmly and securely attached thereto. In situations wherein the correspondence includes several papers directed to the same application (for example, the specification, drawings, and declaration for a new application), the correspondence may be submitted with a cover or transmittal letter which should itemize the papers. It is not necessary that the number be placed on each page of a particular paper or fee transmittal. Merely placing the number in one prominent location on each separate paper or fee transmittal (or cover sheet or transmittal letter which should itemize the separate papers and fees) will be sufficient.

Since the filing of correspondence under 37 CFR 1.10 without the number of the "Express Mail" mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will not be granted on petition. A party's inadvertent failure to comply with the requirements of a rule is not deemed to be an extraordinary situation that would warrant waiver of a rule under 37 CFR 1.183, 2.146(a)(5) or 2.148, nor is such an inadvertent omission considered "unavoidable," within the meaning of 15 U.S.C. 1062(b), 35 U.S.C. 133, 37 CFR 1.137(a) or 37 CFR 2.66(a). See *Honigsbaum v. Lehman*, 903 F. Supp. 8, 37 USPQ2d 1799 (D.D.C. 1995) (Commissioner did not abuse his discretion in refusing to waive requirements of 37 CFR 1.10(c) in order to grant filing date to patent application, where applicant failed to produce "Express Mail" customer receipt or any other evidence that application was actually deposited with USPS as "Express Mail"), *aff'd without opinion*, 95 F.3d 1166 (Fed. Cir. 1996); *Nitto Chemical Industry Co., Ltd. v. Comer*, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (Commissioner's refusal to waive requirements of 37 CFR 1.10 in order to grant priority filing date to patent application not arbitrary and capricious, because failure to comply with the requirements of 37 CFR 1.10 is an "avoidable" oversight that could have been prevented by the exercise of ordinary care or diligence, and thus not an extraordinary situation under 37 CFR 1.183); *Vincent v. Mossinghoff*, 230 USPQ 621 (D.D.C. 1985) (Misunderstanding of 37 CFR 1.8 not unavoidable delay in responding to Office Ac-

tion); *Gustafson v. Strange*, 227 USPQ 174 (Comm'r Pats. 1985) (Counsel's unawareness of 37 CFR 1.8 not extraordinary situation warranting waiver of a rule); *In re Chicago Historical Antique Automobile Museum, Inc.*, 197 USPQ 289 (Comm'r Pats. 1978) (Since certificate of mailing procedure under 37 CFR 1.8 was available to petitioner, lateness due to mail delay not deemed to be extraordinary situation).

PETITIONS

37 CFR 1.10(c) through 1.10(e) set forth procedures for petitioning the Commissioner to accord a filing date as of the date of deposit as "Express Mail." Briefly, 37 CFR 1.10(c) applies where there is a discrepancy between the filing date accorded by the Office and the "date-in" entered by the USPS on the "Express Mail" mailing label or other official USPS notation; 37 CFR 1.10(d) applies where the "date-in" is incorrectly entered by the USPS; and 37 CFR 1.10(e) applies where correspondence deposited with the USPS as "Express Mail" is not received by the Office.

PETITION TO CORRECT FILING DATE AND DATE-IN DISCREPANCY

37 CFR 1.10(c) sets forth procedures for filing a petition to the Commissioner for a filing date as of the date of deposit with the USPS, where there is a discrepancy between the filing date initially accorded by the Office and the "date-in" entered by the USPS or other official USPS notation. Such a petition should: (1) be filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date, (2) include a showing that the number of the "Express Mail" mailing label was placed on each piece of correspondence prior to the original mailing, and (3) include a true copy of the "Express Mail" mailing label showing the "date-in" or other official notation by the USPS.

PETITION TO CORRECT INCORRECTLY ENTERED DATE-IN

37 CFR 1.10(d) sets forth procedures for filing a petition to the Commissioner to accord a filing date as of the actual date of deposit with the USPS, where the "date-in" or other official notation is incorrectly entered by the USPS. Such a petition should: (1) be filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS, (2) include a showing that the number of the "Express Mail" mailing label was

placed on each piece of correspondence prior to the original mailing, and (3) include a showing that the correspondence was deposited as "Express Mail" prior to the last scheduled pickup on the requested filing date. The showing under 37 CFR 1.10(d) must be corroborated by (1) evidence from the USPS, or (2) evidence that came into being after deposit and within one business day of the deposit of the correspondence as "Express Mail". Evidence from the USPS may be the "Express Mail" Corporate Account Mailing Statement. Evidence that came into being within one day after the deposit of the correspondence as "Express Mail" may be in the form of a log book which contains information such as the "Express Mail" number; the application number, attorney docket number or other such file identification number; the place, date and time of deposit; the time of the last scheduled pick-up for that date and place of deposit; the depositor's initials or signature; and the date and time of entry in the log. Any statement submitted in support of such a showing must be verified if made by a person other than an employee of the USPS or a practitioner as defined in 37 CFR 10.1(r).

The reason the Office considers correspondence to have been filed as of the date of deposit as "Express Mail" is that this date has been verified by a disinterested USPS employee, through the insertion of a "date-in," or other official USPS notation, on the "Express Mail" mailing label. Due to the questionable reliability of evidence from a party other than the USPS that did not come into being contemporaneously with the deposit of the correspondence with the USPS, 37 CFR 1.10(d) specifically requires that any petition under 37 CFR 1.10(d) be corroborated either by evidence from the USPS, or by evidence that came into being after deposit and within one business day after the deposit of the correspondence as "Express Mail."

A petition alleging that the USPS erred in entering the "date-in" will be denied if it is supported only by evidence (other than from the USPS) which was: (1) created prior to the deposit of the correspondence as "Express Mail" with the USPS (e.g., an application transmittal cover letter, or a client letter prepared prior to the deposit of the correspondence), or (2) created more than one business day after the deposit of the correspondence as "Express Mail" (e.g., an affidavit or declaration prepared more than one business day after the correspondence was deposited with the USPS as "Express Mail"). On the other hand, a notation in a log book, entered after deposit by the person who deposited the correspondence as "Express Mail" within one busi-

ness day of such deposit, setting forth the items indicated above, would be deemed on petition to be an adequate showing of the date of deposit under 37 CFR 1.10(d)(3).

37 CFR 1.10(d)(3) further provides that a party must show that correspondence was deposited as "Express Mail" before the last scheduled pickup on the requested filing date in order to obtain a filing date as of that date.

PETITION FOR CORRESPONDENCE NEVER RECEIVED

37 CFR 1.10(e) sets forth procedures for filing a petition to the Commissioner to accord a filing date as of the date of deposit with the USPS, where correspondence deposited as "Express Mail" is never received by the Office. Such a petition should: (1) be filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence, (2) include a showing that the number of the "Express Mail" mailing label was placed on each piece of correspondence prior to the original mailing, (3) include a true copy of the originally deposited correspondence showing the number of the "Express Mail" mailing label thereon, a copy of any returned postcard receipt, a copy of the "Express Mail" mailing label showing the "date-in" or other official notation entered by the USPS, and (4) include a statement, signed by the person who deposited the documents as "Express Mail" with the USPS, setting forth the date and time of deposit, and declaring that the copies of the correspondence, "Express Mail" mailing label, and returned postcard receipt accompanying the petition are true copies of the correspondence, mailing label and returned postcard receipt originally mailed or received. Any statement in support of a petition under 37 CFR 1.10(e) must be verified if made by a person other than a practitioner as defined in 37 CFR 10.1(r).

37 CFR 1.10(e) provides for the filing of a petition to accord correspondence a filing date as of the date of deposit with the USPS as "Express Mail" only where the correspondence was mailed with sufficient postage and addressed as set out in 37 CFR 1.1(a). There is no corresponding provision that correspondence be properly addressed and mailed with sufficient postage in 37 CFR 1.10(a), (c) and (d), because these sections apply only to correspondence that is actually received by the Office. Correspondence mailed by "Express Mail" that is actually received by the Office will not be denied a filing date as of the date of deposit as "Express Mail" simply because the correspondence was not mailed with sufficient postage or not addressed as set out in 37 CFR

1.1(a). 37 CFR 1.10(e)(3) provides that if the requested filing date is a date other than the "date-in" on the "Express Mail" mailing label, the petition should include a showing under 37 CFR 1.10(d)(3), as discussed above, that the correspondence was deposited as "Express Mail" before the last scheduled pickup on the requested filing date in order to obtain a filing date as of that date. 37 CFR 1.10(e) applies only in those situations in which the correspondence at issue was lost *in toto* (i.e., the entire correspondence was not delivered to the Office). Where there is a dispute as to the contents of correspondence submitted to the Office (e.g., an applicant asserts that three sheets of drawings were submitted under 37 CFR 1.10 with an application, but the Office records indicate receipt of only two sheets of drawings with the application), an applicant may not rely upon the provisions of 37 CFR 1.10(e) to establish what document(s) and/or fee(s) were filed in the Office with such correspondence. Rather, where the records of the Office (e.g., the file of

the application) contain any document(s) or fee(s) corresponding to the contents of the correspondence at issue, the Office will rely upon its official record of the contents of such correspondence in absence of convincing evidence (e.g., a postcard receipt under MPEP § 503 containing specific itemization of the document(s) or fee(s) purported to have been filed with the correspondence at issue) that the Office received and misplaced any document(s) or fee(s) that is not among the official records of the Office.

ADDITIONAL EVIDENCE MAY BE REQUIRED

37 CFR 1.10(f) provides that the Office may require additional evidence to determine whether the correspondence was deposited as "Express Mail" with the USPS on the date in question. <

