

Chapter 1700 Miscellaneous

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1701 Office Personnel Not to Express Opinion on Validity or Patentability of Patent

Every patent is presumed to be valid, 35 U.S.C. 282, first sentence. Public policy demands that every employee of the Patent and Trademark Office refuse to express to any person any opinion as to the validity or invalidity of, or the patentability or unpatentability of any claim in any U.S. patent, except to the extent necessary to carry out (a) examination of an application seeking to reissue the patent, (b) a reexamination proceeding to reexamine the patent, or (c) an interference involving the patent.

The question of validity or invalidity is otherwise exclusively a matter to be determined by a court. Members of the patent examining corps are cautioned to be especially wary of any inquiry from any person outside the Patent and Trademark Office, including an employee of another Government agency, the answer to which might indicate that a particular patent should not have issued.

When a field of search for an invention is requested, examiners should routinely inquire whether the invention has been patented in the United States. If the invention has been patented, no field of search should be suggested.

Employees of the Patent and Trademark Office, particularly patent examiners who examined an application which matured into a patent or a reissued patent or who conducted a reexamination proceeding, should not discuss or answer inquiries from any person outside the Patent and Trademark Office as to whether or not a certain reference or other particular evidence was considered during the examination or proceeding and whether or not a claim would have been allowed over that reference or other evidence had it been considered during the examination or proceeding. Likewise, employees are cau-

tioned against answering any inquiry concerning any entry in the patent or reexamination file, including the extent of the field of search and any entry relating thereto. The record of the file of a patent or reexamination proceeding must speak for itself.

Practitioners can be of material assistance in this regard by refraining from making improper inquiries of members of the patent examining corps. Inquiries from members of the public relating to the matters discussed above must of necessity be refused and such refusal should not be considered discourteous or an expression of opinion as to validity or patentability.

1701.01 Office Personnel Not To Testify

37 CFR 15a.1. Scope

(a) This part supplements 15 CFR Part 15a and prescribes the policies and procedures of the Office with respect to the testimony of Office employees as witnesses in legal proceedings and the production of documents of the Office for use in legal proceedings pursuant to a request, order, or subpoena. This part is issued pursuant to 15 CFR 15a.1(e) and is to be construed consistent with 15 CFR 15a.

(b) This part does not apply to any legal proceeding in which an Office employee is to testify, while on leave status, as to facts or events that are in no way related to the official business of the Office.

(c) This part is intended to ensure the orderly execution of the affairs of the Office and not to impede any legal proceeding and in no way affects the rights and procedures governing public access to records pursuant to the Freedom of Information Act or the Privacy Act. See 15 CFR 15a.4 and 37 CFR 1.15.

37 CFR 15a.2. Definitions.

For the purpose of this part:

(a) "Commissioner" means Assistant Secretary and Commissioner of Patents and Trademarks.

(b) "Demand" means a request, order, or subpoena for testimony or documents for use in a legal proceeding.

(c) "Document" means any record, paper, and other property held by the Office, including without limitation official patent and trademark files, official letters, telegrams, memoranda, reports, studies, calendar and diary entries, maps, graphs, pamphlets, notes, charts, tabulations, analyses, statistical or informational accumulations, any kind of summaries of meetings and conversations, film impressions, magnetic tapes, and sound or mechanical reproductions.

(d) "Legal proceeding" means a proceeding before a tribunal constituted by law, including a court, an administrative body or commission, an administrative law judge or hearing officer or any discovery proceeding in support thereof.

(e) "Office" means Patent and Trademark Office.

(f) "Office employee" means any officer or employee of the Office.

(g) "Official business" means the authorized business of the Office.

(h) "Solicitor" means the chief legal officer of the Office or other Office employee to whom the Solicitor has delegated authority to act under this part.

(i) "Testimony" means a statement given in person before a tribunal or by deposition for use before the tribunal or any other statement given for use before a tribunal in a legal proceeding, including an affidavit, declaration under 35 U.S.C. 25, or declaration under 28 U.S.C. 1746.

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(j) "United States" means the Federal Government, its departments and agencies, and individuals acting on behalf of the Federal Government.

37 CFR 15a.3. Office policy.

The Office policy is that its documents will not be voluntarily produced and Office employees will not voluntarily appear as witnesses or give testimony in a legal proceeding. The reasons for this policy include:

(a) To conserve the time of Office employees for conducting official business.

(b) To minimize the possibility of involving the Office in controversial or other issues which are not related to the mission of the Office.

(c) To prevent the possibility that the public will misconstrue variances between personal opinions of Office employees and Office policy.

(d) To avoid spending the time and money of the United States for private purposes.

(e) To preserve the integrity of the administrative process, minimize disruption of the decision-making process, and prevent interference with the Office's administrative functions.

37 CFR 15a.4. Testimony or production of documents; general rule

(a) No Office employee shall give testimony concerning the official business of the Office or produce any document in any legal proceeding without the prior authorization of the Solicitor. Where appropriate, an Office employee may be instructed in writing by the Commissioner, Solicitor, or other appropriate Office employee not to give testimony or produce a document. Without prior approval, no Office employee shall answer inquiries from a person not employed by the Department of Commerce regarding testimony or documents subject to a demand or a potential demand under the provisions of this Part. All inquiries involving a demand or potential demand on an Office employee shall be referred to the Solicitor.

(b) A certified copy of a document, not otherwise available under Chapter I of this Title, will be provided for use in a legal proceeding upon written request and payment of applicable fees required by law.

(c)(1) *Request for testimony or document.* A request for testimony of an Office employee or document shall be mailed or hand-delivered to the Office of the Solicitor. The mailing address of the Office of the Solicitor is Box 8, Patent and Trademark Office, Washington, D.C. 20231.

(2) *Subpoenas.* A subpoena for testimony by an Office employee or a document shall be served in accordance with the Federal Rules of Civil or Criminal Procedure as appropriate, or applicable state procedure, and a copy of the subpoena shall be sent to the Solicitor.

(3) *Affidavit.* Every request and subpoena shall be accompanied by an affidavit or declaration under 28 U.S.C. 1746 or, if an affidavit or declaration is not feasible, a written statement setting forth the title of the legal proceeding, the forum, the requesting party's interest in the legal proceeding, the reasons for the request or subpoena, a showing that the desired testimony or document is not reasonably available from any other source, and if testimony is requested, the intended use of the testimony, a general summary of the testimony desired, and a showing that no document could be provided and used in lieu of testimony. The purpose of this requirement is to permit the Solicitor to make an informed decision as to whether testimony or production of a document should be authorized.

(d) Any Office employee who is served with a demand shall immediately notify the Office of the Solicitor.

(e) The Solicitor may consult or negotiate with an attorney for a party or the party, if not represented by an attorney, to refine or limit a demand so that compliance is less burdensome or obtain information necessary to make the determination required by paragraph (c) of this section. Failure of the attorney or party to cooperate in good faith to enable an informed determination to be made under this part may serve as the basis for a determination not to comply with the demand.

(f) A determination under this part to comply or not to comply with a demand is not an assertion or waiver of privilege, lack of relevance, technical deficiencies or any other ground for noncompliance. The Commissioner reserves the right to oppose any demand on any legal ground independent of any determination under this part.

37 CFR 15a.3. Testimony of Office employees in proceedings involving the United States.

(a) An Office employee may not testify as an expert or opinion witness for any party other than the United States.

(b) When appropriate, the Solicitor may authorize an Office employee to give testimony as an expert or opinion witness on behalf of the United States. Expert or opinion testimony on behalf of the United States will not be authorized in any legal proceeding involving the validity or enforceability of a patent or registered trademark.

(c) Whenever, in any legal proceeding involving the United States, a request is made by an attorney representing or acting under the authority of the United States, the Solicitor will make all necessary arrangements for the Office employee to give testimony on behalf of the United States. Where appropriate, the Solicitor may require reimbursement to the Office of the expenses associated with an Office employee giving testimony on behalf of the United States.

37 CFR 15a.6. Legal proceedings between private litigants

(a) Testimony by an Office employee and production of documents in a legal proceeding not involving the United States shall be governed by § 15a.4.

(b) If an Office employee is authorized to give testimony in a legal proceeding, the testimony, if otherwise proper, shall be limited to facts within the personal knowledge of the Office employee. An Office employee is prohibited from giving expert or opinion testimony, answering hypothetical or speculative questions, or giving testimony with respect to subject matter which is privileged. If an Office employee is authorized to testify in connection with the employee's involvement or assistance in a quasi-judicial proceeding which took place before the Office, that employee is further prohibited from giving testimony in response to questions which seek:

(1) Information about that employee's:

(i) Background.

(ii) Expertise.

(iii) Qualifications to examine or otherwise consider a particular patent or trademark application.

(iv) Usual practice or whether the employee followed a procedure set out in any Office manual of practice in a particular case.

(v) Consultation with another Office employee.

(vi) Understanding of:

(A) A patented invention, an invention sought to be patented, or patent application, patent, reexamination or interference file.

(B) Prior art.

(C) Registered subject matter, subject matter sought to be registered, or a trademark application, registration, or position, cancellation, interference or concurrent use file.

(D) Any Office manual of practice.

(E) Office regulations.

(F) Patent, trademark, or other law.

(G) The responsibilities of another Office employee.

(vii) Reliance on particular facts or arguments.

(2) To inquire into the manner in and extent to which the employee considered or studied material in performing the quasi-judicial function.

(3) To inquire into the bases, reasons, mental processes, analyses, or conclusions of that Office employee in performing the quasi-judicial function.

37 CFR 15a.7. Procedures when an Office employee receives a subpoena.

(a) Any Office employee who receives a subpoena shall immediately forward the subpoena to the Office of the Solicitor. The Solicitor will determine the extent to which an Office employee will comply with the subpoena.

(b) If the Office employee is not authorized to comply with the subpoena, the Office employee shall appear at the time and place stated in the subpoena, produce a copy of Part 15a of Title 15 and a copy of this part, and respectfully refuse to provide any testimony or produce any document. *United States ex rel. Touhy v. Ragen*, 340 U.S. 462 (1951).

(c) When necessary or appropriate, the Solicitor will request assistance from the Department of Justice or a U.S. Attorney or otherwise assure the presence of an attorney to represent the interests of the Office or an Office employee.

It is the policy of the Patent and Trademark Office that its employees, including patent examiners, will not appear as witnesses or give testimony in legal proceedings, except under the conditions specified in 37 CFR Part 15a. Any employee who testifies contrary to this policy will be *dismissed or removed*. The reasons for this policy are set out in 37 CFR 15a.3.

Whenever an employee of the Patent and Trademark Office, including a patent examiner, is asked to testify or receives a subpoena, the employee shall immediately notify the Office of the Solicitor. Inquiries requesting testimony shall be also referred immediately to the Office of the Solicitor.

Patent examiners and other Patent and Trademark Office employees performing or assisting in the performance of quasi-judicial functions, are forbidden to testify as experts or to express opinions as to the validity of any patent.

Any individual desiring the testimony of an employee of the Patent and Trademark Office, including the testimony of a patent examiner or other quasi-judicial employee, must comply with the provisions of 37 CFR Part 15a.

A request for testimony of an employee of the Patent and Trademark Office should be made to the Office of the Solicitor at least **10 working days** prior to the date of the expected testimony.

If an employee is authorized to testify, the employee will be limited to testifying about facts within the employee's personal knowledge. Employees are prohibited from giving expert or opinion testimony. *Fischer & Porter Co. v. Corning Glass Works*, 61 F.R.D. 321, 181 USPQ 329 (E.D. Pa. 1974). Likewise, employees are prohibited from answering hypothetical or speculative questions, *In re Mayewsky*, 162 USPQ 86, 89 (E.D. Va. 1969) (deposition of an examiner must be restricted to relevant matters of fact and must avoid any hypothetical or speculative questions or conclusions based thereon); *Shaffer Tool Works v. Joy Mfg. Co.*, 167 USPQ 170 (S.D. Tex. 1970) (deposition of examiner should be limited to matters of fact and must not go into hypothetical or speculative areas or the bases, reasons, mental processes, analyses, or conclusions of the examiner in acting upon a patent application). Employees will not be permitted to give testimony with respect to subject matter which is privileged. Several court decisions limit testimony with respect to quasi-judicial functions performed by employees. Those decisions include *United States v. Morgan*, 313 U.S. 409, 422 (1941) (improper to inquire into mental processes of quasi-judicial officer or to examine the manner and extent to which the officer considered an administrative record); *Western Electric Co. v. Piezo Technology, Inc.*, 860 F.2d 428, 8 USPQ 2d 1853 (Fed. Cir. 1988) (patent examiner may not be compelled to answer questions which probe the examiner's technical knowledge of the subject matter of a patent); *McCulloch Gas Processing Co. v. Department of Energy*, 650 F.2d 1216, 1229 (Temp. Emer. Ct. App. 1981) (discovery of degree of expertise of individuals performing governmental functions not permitted); *In re Nilssen*, 851 F.2d 1401, 7 USPQ 2d 1500 (Fed. Cir. 1988) (technical or scientific qualifications of examiners-in-chief are not legally relevant in appeal under 35 U.S.C. 134 since board members need not be skilled in the art to render obviousness decision); *Lange v. Commissioner*, 352 F. Supp. 166, 176 USPQ 162 (D.D.C. 1972) (technical qualifications of examiners-in-chief not relevant in 35 U.S.C. 145 action).

In view of the discussion above, if an employee is authorized to testify in connection with the employee's involvement or assistance in a quasi-judicial proceeding which took place before the Patent and Trademark Office, the employee will not be permitted to give testimony in response to questions which seek:

(1) Information about that employee's:

(A) Background.

(B) Expertise.

(C) Qualifications to examine or otherwise consider a particular patent or trademark application.

(D) Usual practice or whether the employee followed a procedure set out in any Office manual of practice (including the MPEP or TMEP) in a particular case.

(E) Consultation with another Office employee.

(F) Understanding of:

(i) A patented invention, an invention sought to be patented, or patent application, patent, reexamination or interference file.

(ii) Prior art.

(iii) Registered subject matter, subject matter sought to be registered, or a trademark application, registration, opposition, cancellation, interference, or concurrent use file.

(iv) Any Office manual of practice.

(v) Office regulations.

(vi) Patent, trademark, or other law.

(vii) The responsibilities of another Office employee.

(G) Reliance on particular facts or arguments.

(2) To inquire into the manner in and extent to which the employee considered or studied material in performing a quasi-judicial function.

(3) To inquire into the bases, reasons, mental processes, analyses, or conclusions of that Office employee in performing the quasi-judicial function.

Any request for testimony addressed or delivered to the Office of the Solicitor shall comply with 37 CFR 15a.4(c). All requests must be in *writing*. The need for a subpoena may be obviated where the request complies with 37 CFR 15a.4(c) if the party requesting the testimony further meets the following conditions:

(1) The party requesting the testimony identifies the civil action or other legal proceeding for which the testimony is being taken. The identification shall include:

(a) the style of the case,

(b) the civil action number,

(c) the district in which the civil action is pending,

(d) the judge assigned to the case, and

(e) the name, address, and telephone number of counsel for all parties in the civil action.

(2) The party agrees not to ask questions seeking information which is precluded by 37 CFR 15a.6(b).

(3) The party shall comply with applicable provisions of the Federal Rules of Civil Procedure, including Rule 30, and give 10 working days notice to the Office of the Solicitor prior to the date a deposition is desired. Fifteen working days notice is required for any deposition which is desired to be taken between November 15 and January 15.

(4) The party agrees to notice the deposition at a place convenient to the Patent and Trademark Office. The Conference Room in the Office of the Solicitor is deemed to be a place convenient to the Office.

(5) The party agrees to supply a copy of the transcript of the deposition to the Patent and Trademark Office for its records.

Absent a written agreement meeting the conditions specified in paragraphs (1) through (5), a party must comply with the precise terms of 37 CFR 15a.4(c) and the Patent and Trademark Office will not permit a deposition without issuance of a subpoena.

1702 Restrictions on Former Examiners

37 CFR 10.10. Restrictions on practice in patent cases.

(a) Only practitioners who are registered under § 10.6 or individuals given limited recognition under § 10.9 will be permitted to prosecute patent applications of others before the Office.

(b) No individual who has served in the patent examining corps of the Office may practice before the Office after termination of his or her service, unless he or she signs a written undertaking.

(1) Not to prosecute or aid in any manner in the prosecution of any patent application pending in any patent examining group during his or her period of service therein, and

(2) Not to prepare or prosecute or to assist in any manner in the preparation or prosecution of any patent application of another (i) assigned to such group for examination and (ii) filed within two years after the date he or she left such group, without written authorization of the Director. Associated and related classes in other patent examining groups may be required to be included in the undertaking or designated classes may be excluded from the undertaking.

When an application for registration is made after resignation from the Office, the applicant will not be registered if he or she has prepared or prosecuted or assisted in the preparation or prosecution of any patent application as indicated in the paragraph. Knowingly preparing or pro-

secuting or providing assistance in the preparation or prosecution of any patent application contrary to the provisions of this paragraph shall constitute misconduct under § 10.23(c)(13) of this part.

(c) A practitioner who is an employee of the Office cannot prosecute or aid in any manner in the prosecution of any patent application before the Office.

(d) Practice before the Office by Government employees is subject to any applicable conflict of interest laws, regulations, or codes of professional responsibility.

See also MPEP § 309.

1703 *The Official Gazette*

The *Patent Official Gazette* reports every Tuesday the patents and design patents issued and defensive publications published on that day. As to each patent, the following information is given:

(1) the name and (2) the city and state of residence of the applicant with the Post Office address in the case of unassigned patents, (3) the same data for the assignee, if any, (4) the filing date, (5) the serial number of the application, (6) the patent number, (7) the title of the invention, (8) the number of claims, (9) the U.S. classification by class and subclass, (10) a selected figure of the drawing, if any, except in the case of a plant patent, (11) a claim or claims, (12) international classification, (13) U.S. patent application data, if any, and (14) foreign priority application data, if any. In the case of a reissue patent, there are published the additional data of the number and date of the original patent and original application.

The *Patent Official Gazette* also includes notices of patent and trademark suits, indexes of patents, disclaimers filed, Certificates of Correction issued, list of patents available for license or sale, and general information such as orders, notices, changes in rules, changes in classification, certain adverse decisions in interferences, the condition of work in the Office, disbarment, and registration of attorneys, and notices to parties not reached by mail.

Trademark Official Gazette. The official journal of the Patent and Trademark Office relating to trademarks is published every Tuesday. It contains an illustration of each trademark published for opposition, a list of trademarks registered, classified list of registered trademarks, and Patent and Trademark Office notices.

Orders should be addressed and remittances made payable to Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

1704 *Application Records and Reports*

The PALM (Patent Application Locating and Monitoring) System is the automated data management system used by the Patent and Trademark Office for the retrieval and/or on-line updating of the computer record of each patent application. The PALM System also maintains examiner time, activity, docket, and clerical backlog records.

Information retrieval from PALM is by means of video display terminals. Information update is by means of video display transactions and, predominantly, by means of transactions entered via bar code readers (BCR). Among other items, classification, examiner docket, attorney, inventor, and prosecution history data as well as the location of each application can be retrieved and updated online with PALM.

DOCKET REPORTS

The recording of changes to examiner dockets is accomplished by PALM simultaneously with the recording of incoming and outgoing communications, transfers of applications to and from dockets, and other types of updating of the application record. The status of each examiner's docket can be determined by means of online video display transactions and is supplemented by periodic printed reports. Docket reports that are generated by PALM include the individual examiner; new, special, and amended docket which lists applications in priority order; the individual examiner rejected application docket; the individual examiner new application profile, which lists the totals of new applications in each docket, sorted by month of filing; and various summaries of the above reports at the group art unit, group, and corps levels.

TIME AND ACTIVITY REPORTS

All reporting of examiner time and activity is on a bi-weekly basis. Each examiner's examining and non-examining time, as listed on the examiners' Biweekly Time Worksheet, PTO-690E, is entered into PALM for use in the computation of productivity data. The biweekly reports produced include the individual examiner Time and Activity Report which lists, by serial number, all applications for which actions have been counted during the biweekly period. The type of action counted for each application is also indicated on the report. This report also includes examiner time data, an action summary,

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and cumulative summaries to date for the current quarter and fiscal year. Various summary reports at the group, art unit, and corps levels are also produced.

1705 Examiner Docket, Time, and Activity Recordation

COUNTING OF ACTIONS

Actions prepared by examiners are submitted to their respective docket clerks for counting. (See "Types of Action" and "Actions Not Counted" below which distinguishes between outgoing communications that are considered to be "actions" from those that are not). With each action, the examiner submits an Examiner's Case Action Worksheet, PTO-1472, upon which he/she indicates the type of action being taken. The docket clerk, thereafter, updates the PALM record of the application and the examiner's production record by entry of the appropriate online bar code reader transaction.

PROCEDURES FOR REPORTING AN EXAMINER'S ACTION

1. The Examiner Case Action Worksheet, PTO-1472, is filled out by the Examiner and attached to the case for processing by the docket clerk.

2. The docket clerk checks the worksheet to verify that the Examiner provided all necessary information relating to that action.

3. The docket clerk places the count date of the action on the Contents flap of the file wrapper.

4. The docket clerk will enter the examiner's action for the case directly into PALM by using a Bar Code Reader (BCR).

5. Each examiner's action reported to the PALM system will be listed by serial number on the biweekly Examiner's Time and Activity Report.

6. The Examiner should check his/her Biweekly Examiner Time and Activity Report to verify that all cases worked on for the biweekly report period are properly listed.

TYPES OF ACTION TO BE INDICATED ON EXAMINER'S CASE ACTION WORKSHEET, PTO-1472

1. Nonfinal

2. Restriction/Election Only

a. — This is not an action on the merit. Other time credit is given for time spent.

3. Final Rejection

4. *Ex parte* Quayle

5. Allowance

6. Miscellaneous Action

a. — This type of action is used when a response period is set and the other types of actions listed on the worksheet are not appropriate.

7. Advisory Action After Final Rejection

8. Interference

a. — For Interference Memo (PTO-850) and Decision on Motion Mark Interference.

b. — When an examiner issues an action; e.g., nonfinal and concurrently an initial interference memo (PTO-850) the examiner will complete a worksheet indicating; e.g., nonfinal and another worksheet indicating an interference action.

c. — A worksheet should be filled out for patented cases placed into interference.

9. Examiner's Answer

a. — If a supplemental or second Examiner's Answer is written, the action will be counted, but no disposal credit will be received.

b. — If prosecution is continued, after a Board of Appeals or a Court Decision, the examiner marks the worksheet, e.g., NONFINAL with the next consecutive action number.

10. Suspension

a.—This will give a miscellaneous action credit on the Biweekly Report. It will also be recorded in PALM as a miscellaneous Office action and a letter of suspension.

11. Allowance After Examiner's Answer, Board of Patent Appeals and Interferences or Court Decision

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

b. — Statutory Invention Registration disposal credit only after a first action on the merits.

12. Abandonment (Failure to Respond to Office Action)

a. — The actual date of abandonment is the date the Office action response period expired. See MPEP § 711.04(a).

b. — The action number reported should be the action number of the last Office action to which the applicant has failed to respond.

13. Express Abandonment

a. — The examiner will automatically be credited with a nonmerit Office action for acknowledging the Express Abandonment and an abandonment (disposal) credit.

b. — The actual date of abandonment will be the date of recognition of the letter. See MPEP § 711.01.

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

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

b. — This is not a disposal credit and is indicated as a noncounter on the Biweekly Examiners' Time and Activity Report.

15. Supplemental Office Action — When the Examiner issues a supplemental Office action (which is the same type of action previously issued), a note should be attached to the application. This will assist the docket clerk in properly reporting this supplemental Office action to the PALM system. A supplemental action may be necessary when an applicant's response and an examiner's Office action cross in the mail. Also, a supplemental action may be necessary when the examiner becomes aware of an additional ground of rejection after the mailing of an Office action.

COUNTING OF FIRST ACTION ON THE MERITS (FAOM)

Office actions on the merits are:

- (1) Nonfinal
- (2) Final Rejection
- (3) *Ex parte* Quayle
- (4) Allowance

The first time an examiner performs one of the above four merit actions, he/she receives credit for a First Action on the Merits (FAOM) on the production reports.

A second/subsequent but First Action on the Merits (FAOM) action usually occurs when the first action is a restriction/election. The examiner indicates the type of action (nonfinal, final rejection, *Ex parte* Quayle and allowance) on the worksheet, and the PALM system will automatically determine if it is an FAOM. The action will be listed and credited on the Biweekly Examiners' Time and Activity Report as a Second/Subsequent FAOM.

COUNTING OF DISPOSALS

An examiner's "disposal" count consists of four items:

(1) allowances, (2) abandonments, (3) Examiner's answers, and (4) International Preliminary Examination Reports.

An examiner receives credit for a disposal upon submission of a first Examiner's Answer prepared in an appealed application. These same items constitute the "disposals" for performance evaluation of examining art units and groups. However, disposals at the Office level consist only of allowances and abandonments.

ACTIONS NOT COUNTED

The following are not to be counted as actions but are reported to PALM by the docket clerk:

- (1) Examiner's Amendments.
- (2) Supplemental actions citing additional references or correcting the data of references of record.
- (3) Letters acknowledging receipt of communications from applicants, such as new or supplemental oaths, orders for corrections of drawings, etc., which do not bring the application up for action.
- (4) Letters stating that the Notice of Allowance will be sent in due course.
- (5) Answers to petitions to revive or to make cases special, amendments under 37 CFR 1.312 and to status letters.
- (6) Actions in Reexamination applications.
- (7) Transfers of individual cases and patentability reports are not counted as actions, but credit is given for the time spent.

CORRECTION INFORMATION

1. If any information is either missing from or incorrect on the biweekly Examiner Time and Activity Report, the examiner should promptly notify the docket clerk by providing all the pertinent information necessary to make the changes to the PALM system (e.g., examining hours, application serial number, type of action, etc.).

2. The docket clerk will report the necessary changes and corrections directly into PALM. These changes will be listed on the next biweekly Examiner Time and Activity Report.

3. If any information is missing from the last biweekly Examiner Time and Activity Report of a quarter (except at the end of a fiscal year) or is incorrect, the examiner should promptly notify the docket clerk and his/her Supervisory Patent Examiner (SPE). The docket clerk will make the appropriate changes directly into the PALM system. The changes will be listed on the next biweekly Examiner Time and Activity Report. However, these changes will not be reflected in the last Quarter's Report; the Examiner's SPE may manually make an adjustment to the records to show these changes.

4. In order to ensure that all PALM reports are correct at the end of the fiscal year (rating period), a special correction cycle is provided on the PALM system. If any information is missing from or is incorrect on the last biweekly Examiner Time and Activity Report, the examiner should immediately notify the docket clerk and his/her SPE. These changes will be reflected in the examiner's final biweekly report for the entire fiscal year.

1706 Disclosure Documents [R-1]

The Patent and Trademark Office (PTO) maintains for 2 years "Disclosure Documents" as evidence of the dates of conception of inventions.

THE PROGRAM

A paper disclosing an invention and signed by the inventor or inventors may be forwarded to the PTO by the inventor (or inventors), by the owner of the invention, or by the attorney or agent of the inventor(s) or owner. The Disclosure Document will be retained for 2 years and then be destroyed unless it is referred to in a separate letter in a related application filed with those 2 years.

Disclosure Documents may also be filed at selected Patent and Trademark Office Depository Libraries, presently including the Sunnyvale Center for Innovation, Inventions, and Ideas and the Detroit Public Library. (A current listing will always be available from the PTO's Patent and Trademark Depository Library Program office.) The documents are date-stamped and numbered at these PTDLs. One copy of the document is retained at the PTDL for its records. Original documents are sent to the PTO for fee collection, processing, and retention.

The Disclosure Document is not a patent application, and the date of its receipt in the PTO will not

become the effective filing date of any patent application subsequently filed. However, like patent applications, these documents will be kept in confidence by the PTO.

This program does not diminish the value of the conventional witnessed and notarized records as evidence of conception of an invention. It should provide a more credible form of evidence than that provided by the popular practice of mailing a disclosure to oneself or another person by registered mail. A Disclosure Document is available to the public when a patent application which refers to it issues as a patent.

CONTENT OF DISCLOSURE DOCUMENT

The benefits provided by the Disclosure Document will depend upon the adequacy of the disclosure. It is recommended that the document be a clear and complete explanation of the manner and process of making and using the invention. This description must be in sufficient detail to enable a person having ordinary knowledge in the field of the invention to make and use the invention. When the nature of the invention permits, a drawing or sketch should be included.

PREPARATION OF THE DOCUMENT

To facilitate the PTO's electronic data capture and storage of the Disclosure Document, it must be on white paper having dimensions not to exceed 8½ by 11 inches (21.6 by 28.0 cm) with each page numbered. Text and drawings must be sufficiently dark to permit reproduction with commonly used office copying machines. Oversized papers, even if foldable to the above dimensions, will not be accepted. Attachments such as videotapes and working models will not be accepted and will be returned.

OTHER ENCLOSURES

The Disclosure Document must be accompanied by a separate signed cover letter stating that it is submitted by, or on behalf of, the inventor and requesting that the material be received into the Disclosure Document Program. The inventor's request may take the following form:

"The undersigned, being the inventor of the disclosed invention, requests that the enclosed papers be accepted under the Disclosure Document Program, and that they be preserved for a period of two years."

>The original submission will not be returned. A notice with an identifying number and date of receipt in the PTO will be mailed to the customer, indicating that the Disclosure Document may be relied on only as evidence and that a patent application should be diligently filed if patent protection is desired.<

DISPOSITION

The Disclosure Document ** >is retained by< the ** >PTO< for 2 years ** >. After that time, it< will be destroyed unless ** referred to in a separate letter in a related patent application filed within the 2-year period. ** >A letter must be filed in the related patent application, identifying not only the patent application but also the Disclosure Document by its title, number, and date of receipt. Acknowledgment ** of such letters * >will be< made in the next official communication or in a separate letter from the ** >PTO<. Unless it is desired to have the ** >PTO< retain the Disclosure Document beyond the 2-year period, it is not required that it be referred to in a patent application.

ACKNOWLEDGMENT

When a paper referring to a Disclosure Document is filed in a patent application within 2-years after the filing of a Disclosure Document, the ** >Examining Group Technical Support Staff member< either prepares (1) a memorandum indicating that a reference to Disclosure Document No. -- has been made in ** >Patent Application< No. -- , or (2) a copy of the paper filed in the application referring to the Disclosure Document. The memorandum or copy is forwarded to the * >Customer Contact Team< of the Correspondence and Mail Division.

Upon receipt, the >Customer Contact Team of the< Correspondence and Mail Division prepares a retention label (PTO-150) and attaches it to the Disclosure Document, >so< indicates on the forwarded memo or copy, ** and returns the memo or copy to the group. The returned memo or copy is stapled to the inside left flap of the file wrapper so that the examiner's

attention is directed to it when the next Office action is prepared. If prosecution before the examiner has been concluded, a separate letter indicating that the Disclosure Document will be retained should be sent to the applicant by the **>Examining Group Technical Support Staff member<.

After the acknowledging letter is mailed, the paper >number of the acknowledgement is noted< in the application file **. The returned memo or copy is stapled to and retained with the original paper >referring to the Disclosure Document< in the file wrapper **.

FEE

The fee >as< set forth in 37 CFR 1.21(c) is ** >\$10.< * >Full payment< must accompany the Disclosure Document when it is submitted to the **>PTO<.

* >NOTICE< TO INVENTORS

The 2-year retention period should not be considered to be a "grace period" during which the inventor can wait to file his >or her< patent application without possible loss of benefits. It must be recognized that in establishing priority of invention an affidavit or testimony referring to a Disclosure Document must usually also establish diligence in completing the invention or in filing the patent application since the filing of the Disclosure Document.

>Inventors not familiar with the requirement of "diligence in completing the invention" or "reduction to practice" under the U.S. patent law are advised to consult an attorney or agent registered to practice before the PTO. A publication, *Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office* is available from the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402. Patent attorneys and agents may be found in the telephone directories of most major cities. Also, many large cities have associations of patent attorneys that may be consulted.<

Inventors are also reminded that any public use or sale in the United States or publication of the invention ** more than 1 year prior to the filing of a patent application on that invention * >may< prohibit the granting of a patent on it.

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>There is a nationwide network of Patent and Trademark Depository Libraries (PTDLs), which have collections of patents and patent-related reference materials available to the public, including automated access to PTO data bases. Publications such as *General Information Concerning Patents* are available at the PTDLs. To find out the location of the PTDL closest to you, please consult the complete listing of all PTDLs that appears in every issue of the *Official Gazette* or call the PTO Public Service Branch at (703) 308-HELP/4357. To ensure assistance from a PTDL staff member, you may wish to contact a PTDL prior to visiting to learn about its collections, services, and hours.<

1711 U.S.—Philippines Search Exchange

The United States—Philippines search exchange program involves patent applications filed in the United States which are subsequently followed by corresponding applications filed in the Republic of the Philippines and patent applications filed in the Philippines subsequently followed by corresponding applications filed in the United States.

The program operates as follows:

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

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

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

from the U.S. file and promptly forward the same to the Philippines Patent Office.

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

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

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

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

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

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

>1720 Dissemination of Court and Board Decisions [R-1]

COURT DECISIONS

The Office of the Solicitor forwards to the Office of the Assistant Commissioner for Patents copies of all recent court decisions in patent cases where a precedential opinion is issued. The Office of the Assistant Commissioner for Patents will routinely provide copies of these opinions to Group Directors, the Patent Academy, and the Director of the Office of Quality Review.

Directors are to, in turn, make copies available to managers and other individuals as the Director determines to be appropriate. Directors are encouraged to discuss the contents of the opinions in their staff meetings, particularly where such meetings are being held to reinforce examination quality.

BOARD DECISIONS

A decision rendered by the Board is returned to the examiner through the Group Director and the examiner's supervisor. The examiner takes action consistent with the decision rendered by the Board unless reconsideration of the Board decision will be requested (MPEP § 1214.04). The Director may circulate and discuss the decision among some or all of the supervisors in the Group, and the supervisors, in turn, may circulate the decision among the examiners in their art units, depending on the subject matter or issues in the decisions. <

>1721 Treatment of Court and Board Decisions Affecting Patent and Trademark Office Policy and Practice [R-1]

In the event a Board or court decision is one that significantly adds to the body of law by, for example, ad-

ressing a new legal or procedural issue, or providing a new interpretation of a prior decision, such a decision may result in an internal PTO memorandum pointing out the significance of the decision to the examination process.

When any examiner or supervisor in the Patent Examining Corps concludes that a recent decision of the Board or a court affects existing PTO policy or practice, he or she should bring the matter to the attention of his/her Group Director through normal chain-of-command procedures.

When the Group Director believes that guidance to the Corps is warranted as a result of a decision, the Director should consult with the Deputy Assistant Commissioner for Patent Policy and Projects and provide a draft of the guidance that is recommended as appropriate under the circumstances. The Deputy Assistant Commissioner for Patent Policy and Projects will then take appropriate Office officials, as necessary, to formulate a recommendation to the Assistant Commissioner for Patents on the policy implications of the opinion.

It may be necessary for the Commissioner, Solicitor, Chairman of the Board, A/C for Patents, Deputy A/C for Patent Policy and Projects, Deputy A/C for Patents and Director making the recommendation to meet to review and discuss the policy ramifications of the case enabling the Commissioner to decide how the PTO will proceed.

Communication of the decision on the policy implications of the court or Board decision will normally take place by either notice in the Official Gazette and/or via memorandum to PTO personnel. Ultimately, the policy implications of the decision will be officially incorporated into the Manual of Patent Examining Procedure and Patent Academy curriculum materials during the next update cycle for these reference materials. <



MANUAL OF PATENT EXAMINING PROCEDURE