



UNITED STATES PATENT AND TRADEMARK OFFICE

PETITIONS PRACTICE

Thurman K. Page
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
For Patent Examination Policy



Petitions Handled in the Office of Petitions

- Petitions to Accord or Correct Filing Date (37 CFR 1.57(a), 1.53(e), 1.182, 1.10).
- Petitions to Revive Abandoned Applications (37 CFR 1.137(a), (b) and (f)).
- Petitions to Withdraw Holding of Abandonment (37 CFR 1.181).
- Petitions to Reinstate Expired Patents (37 CFR 1.377 and 1.378(b), (c)).
- Petitions to Accept Unintentionally Delayed Benefit Claims (37 CFR 1.78, 1.55).
- Petitions to Correct Assignee Data (37 CFR 3.81)
- Petitions to Make Special under Prioritized Examination, Patent Prosecution Highway, Age, and Health (37 CFR 1.102).
- Petitions to withdraw patent applications from issue after payment of the issue fee under 37 CFR 1.313(c).



Petitions Handled in the Office of Petitions (cont.)

- Petitions for Applicant Showing Sufficient Proprietary Interest (37 CFR 1.46), only for applications filed on or after September 16, 2012.
- Petitions to Accept Declaration w/o signature of Inventors (37 CFR 1.47(a), (b)), only for applications filed prior to September 16, 2012.
- Petitions to Expunge Application or Assignment Information (37 CFR 1.59 and 1.182)
- Requests to Withdraw as Attorney or Agent of Record (37 CFR 1.36)
- Requests for Patent Term Adjustment (37 CFR 1.705(b), (d))
- Requests for Corrected Patent Application Publication (37 CFR 1.221(b))
- Late Requests for Foreign Filing License (37 CFR 5.11)

See generally MPEP 1002.02 to determine which Office to direct your petition.



ePetitions

PDF-based EFS-Web Petitions Filed and Decided Electronically:

- Petition to Accept Unintentionally Delayed Payment of Maintenance Fee
- Petitions to Make Special Based on Age

Web-based (non-PDF) – information entered directly into EFS-Web screens:

- Request for Withdrawal as Attorney or Agent of Record (37 CFR 1.36)
- Petitions to Withdraw from Issue after Payment of the Issue Fee
 - Petition to Withdraw from Issue after Payment of the Issue Fee (37 CFR 1.313(c)(1) or (2))
 - Petition to Withdraw from Issue after Payment of the Issue Fee (37 CFR 1.313(c)(3))
 - Petition to Withdraw from Issue after Payment of the Issue Fee (37 CFR 1.313(c)(1) or (2) with Assigned Patent Number)
 - Petition to Withdraw from Issue after Payment of the Issue Fee (37 CFR 1.313(c)(3) with Assigned Patent Number)



ePetitions (cont.)

Web-based (non-PDF) – information entered directly into EFS-Web screens (cont.):

- Petitions for Revival
 - Petition to Accept Late Payment of Issue Fee - Unintentional Late Payment (37 CFR 1.137(b))
 - Petition for Revival of an Application based on Failure to Notify the Office of a Foreign or International Filing (37 CFR 1.137(f))
 - Petition for Revival of an Application for Continuity Purposes Only (37 CFR 1.137(b))
 - Petition for Revival of an Application Abandoned Unintentionally (37 CFR 1.137(b)) (For cases abandoned after 1st action and prior to Notice of Allowance)
- Petition for Issuance of Patent in Name of the Assignee or Correction of Assignee Name After Payment of the Issue Fee Under 37 CFR 3.81



ePetition Processing

- ❑ ePetitions can be completely filled out online
- ❑ Decisions are instantaneous and uploaded to IFW
- ❑ ePetitions will only be accepted if every requirement is satisfied, therefore the only decision of record is a grant
- ❑ When the ePetition is granted, petitioner will receive an acknowledgement receipt that will also include a petition grant letter confirming approval of the ePetition
- ❑ A Quick Start Guide for ePetitions is available at:
<http://www.uspto.gov/patents/process/file/efs/guidance/epetition-quickstart.pdf>



Filing Date Petitions

The filing date of an application is the date of receipt of the necessary component parts (MPEP 503, 506.02):

PROVISIONAL Application must include:

- SPECIFICATION – written description, but no claim required.
- DRAWING – if required for understanding of invention (generally not required for process, composition, or method claims).

NONPROVISIONAL Application must include:

- SPECIFICATION – written description, including at least one CLAIM.
- DRAWING – if required for understanding of invention (generally not required for process, composition, or method claims).

NOTE: The executed Oath/Declaration and Fees are required for a Complete Application but not for the application to be Entitled to a Filing Date.



Filing Date Petitions

Incomplete Original Filing:

- Notice of Incomplete (Non) Provisional Application is mailed when an application is not entitled to a filing date because an essential component appears to be omitted.
- Notice of Omitted Items in a (Non) Provisional Application is mailed when application is entitled to filing date but is lacking some portion of essential component (e.g. some pages of specification).

Incorporation by Reference (37 CFR 1.57(a)): Rely on 1.55 or 1.78 benefit claim, if present on filing date of the application (MPEP 201.17)



Filing Date Petitions

Application filed by mail – use itemized postcard

Properly Itemized Postcard:

Example: If applicant was filing 15 pages of specification, including three (3) pages containing 10 claims, six (6) sheets of drawings containing Figures 1, 2, 3, 4A, 4B, 5, and an executed declaration, a properly itemized postcard would recite:

15 pages of specification, 10 claims, 6 pages of drawings containing Figs. 1, 2, 3, 4A, 4B, 5, and executed declaration (2 pages).

Note : ITEMIZE postcard -- No such thing as too much detail.



Filing Date Petitions

Application filed by EFS-Web - acknowledgement Receipt is an electronic post card receipt, which:

- lists the files received by the USPTO with the name and the size of each file, and includes a unique Message Digest code that is derived from the submission and
- is clear evidence that on the date noted the files were successfully received by the USPTO.

however, the assumption of receipt may be rebutted by the contents of the application

- have ability to ascertain exactly what was received on the EFS server.
- compare acknowledgement receipt with size of files in application.



Filing Date Petitions

Can prove missing component was filed by relying on:

Express Mail under 37 CFR 1.10

Certificate of Mailing Practice under 37 CFR 1.8

Declarations/Affidavits of individuals who played a role in filing the application papers



Filing Date Petitions

37 CFR 1.10. Petitions to correct filing date based on USPS Express Mail deposit date (MPEP 513):

Good source of USPS evidence of date-in: USPS Shipping and Mailing website (select track and confirm):

<http://www.usps.com/all/shippingandmailing/welcome.htm>

NOTE: Only applies if correspondence is deposited as Express Mail with the United States Postal Service. No benefit under 37 CFR 1.10 is given to correspondence delivered to the Office via commercial couriers, e.g., “Federal Express,” “DHL,” “Purolator,” “Air Borne,” “UPS” or for correspondence deposited in International Express Mail.

NOTE: Petitions under 37 CFR 1.10 must be promptly filed after applicant becomes aware that the Office has accorded or will accord an incorrect filing date to the correspondence.



Filing Date Petitions

Petition under 37 CFR 1.10 (cont.)

Common errors:

- » Failure to obtain an “Express Mail” mailing label that shows the “date-in” as entered by the USPS.
- » Failure to generate corroborating evidence of deposit that came into being after deposit and within one business day of deposit (e.g. a proper log).



Filing Date Petitions

Avoid application filing date woes:

- Utilize EFS-Web

- Utilize Express Mail **and** postcard receipt practice

- Deposit Express Mail directly with USPS employee & check legibility of date-in on site

- Create a detailed Express Mail mail log after deposit and within one business day of deposit

- Incorporate by reference

- Rely on claim for benefit as limited incorporation by reference of prior-filed application

- Respond to Notice of Omitted Items within period for reply to avoid abandonment



Petitions to Make Special under 37 CFR 1.102

Prioritized Examination (Track One)

- 37 CFR 1.102 (e) AND MPEP 708.02(B)
- Provides early examination and final disposition of an application within about 12 months
- Requires fees under 37 CFR §§ 1.17(c), 1.17(i), and 1.18(d)
- Must be filed electronically via EFS-Web
- May be filed with a new application or with a Request for Continued Examination (RCE)
- Further guidance provided on USPTO website



Petitions to Make Special under 37 CFR 1.102 (cont.)

Patent Prosecution Highway

- An application already reviewed by a participating foreign patent office will be examined generally within 2-3 months from the grant of the PPH request
- The foreign patent office must rule that at least one claim is patentable, and the claims before the USPTO must sufficiently correspond to the claims ruled allowable
- Must be filed electronically via EFS-Web
- Examination of the U.S. application has not begun
- The relationship between the U.S. and foreign application must be clear
- Non-English documents must be accompanied by an English translation and a copy of the foreign language document
- Further guidance and forms provided on USPTO website



Petitions to Make Special under 37 CFR 1.102 (cont.)

Age

- Provide a statement from applicant or a registered practitioner that he or she has evidence that the applicant is 65 years of age or older

Health

- Provide evidence (e.g. doctor's certificate) showing that applicant's health is such that he or she may not be available to assist in the prosecution of the application if it runs its normal course

Note: Petitions to make special under Accelerated Examination (MPEP 708.02(a)) are processed in the Technology Center rather than the Office of Petitions



Petitions Relating to Withdrawal of Attorney

Request to withdraw as attorney of record may now be filed as an ePetition.

Office will no longer require that there be at least 30 days between approval of the request to withdraw as a practitioner of record and the later of the expiration date of the period which can be obtained by a petition for extension of time under 37 CFR 1.136(a)

Instead, Office requires practitioner to certify that he or she have 1) given reasonable notice to client, prior to the expiration of the reply period, that the practitioner intends to withdraw from employment; 2) delivered to the client or a duly authorized representative all papers and property (including funds) to which the client is entitled; and 3) notified the client of any replies that may be due and the time frame within which the client must respond.

NOTE: The Office will no longer accept address changes to a new practitioner or law firm filed with a Request, absent the filing of a power of attorney to the new representative (e.g., PTO/SB/82).



Petitions Relating to Priority Claims

Petitions to accept unintentionally delayed claims under 37 CFR 1.78 and 1.55

Must include proper specific reference to prior-filed application, including foreign priority claims, in **an executed application data sheet (ADS) if application filed after September 16, 2012.**

Presence of the priority claim in the first sentence of the specification or oath/declaration will not be recognized



Request to Correct A Publication

The Office will correct errors in a **published application** under 37 CFR 1.221(b) if:

- The request is made within 2 months of the publication date
- The error was made by the Office
- The error is material (e.g. error in the claim printed)

Otherwise, Applicant must correct the publication pursuant to 37 CFR 1.221(a). See MPEP § 1130 and USPTO website for guidance.



Petitions Relating to Abandonment

Three Options:

Petition for Withdrawal of Holding of Abandonment –
37 CFR 1.181

Petition to Revive under Unavoidable Standard –
37 CFR 1.137(a)

Petition to Revive under Unintentional Standard –
37 CFR 1.137(b)



Petitions Relating to Abandonment

Petition for Withdrawal of Holding of Abandonment (MPEP 711.03(c))

two types

- » “I never got the Office action.”
- » “I DID respond to the Office action in a timely manner.”



Petitions Relating to Abandonment

Withdrawal of Holding of Abandonment - “I never got the Office action.”

Delgar v. Schulyer, 72 USPQ 513 (D.D.C. 1971) showing:

- statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.
- statement from Practitioner that the Office action was not received at the correspondence address of record, and that a search of the practitioner’s record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required. A copy of the practitioner’s record(s) required to show non-receipt of the Office action should include the MASTER DOCKET for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action.
- If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.



Petitions Relating to Abandonment

Petition for Withdrawal of Holding of Abandonment

“I DID respond to the Office action in a timely manner .”

- » itemized postcard receipt or electronic acknowledgement receipt
- » Express Mail
- » Certificate of Mailing/Transmission practice



Petitions Relating to Abandonment

Petition for Withdrawal of Holding of Abandonment (cont.)

Certificate of Mailing Practice: Rule 1.8 (MPEP 512)

- inform the Office of the previous mailing/transmission promptly after becoming aware that the Office has no evidence of receipt of the correspondence
- supply an additional copy of the correspondence
- include a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing/transmission
 - if correspondence was sent by facsimile, a copy of the sending unit's report confirming transmission may be used to support this statement
 - If the correspondence was transmitted via the Office electronic filing system, a copy of an acknowledgment receipt generated by the Office electronic filing system confirming submission may be used to support this statement.

NOTE: The certificate of mailing or transmission cannot be relied on to obtain a filing date.



Petitions Relating to Abandonment

Petition to Revive Under 37 CFR 1.137(a)

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by :

- the required reply, unless previously filed;
- the petition fee as set forth in § 1.17(l);
- a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and
- any required terminal disclaimer and fee



Petitions Relating to Abandonment

Petition to Revive Under 37 CFR 1.137(b)

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by:

- the required reply, unless previously filed;
- the petition fee as set forth in § 1.17(m);
- a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and
- any required terminal disclaimer and fee



Petitions Relating to Abandonment

Petition to Revive Under 37 CFR 1.137(b) – cont.

The required statement of delay: “The entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional.”

- if the petition was filed a year or less from the date of abandonment, the statement need not track the required statement
- if the petition was filed greater than a year from the date of the abandonment, the delay statement must literally mean or track the language of the regulation



Petitions Relating to Abandonment

Avoid the Office of Petitions all together!

e-Petition filed under 37 CFR 1.137(b) - this automated petition may be used to revive an abandoned application where the delay was unintentional

Petitioner directly inputs the requisite filing information into a secure EFS-Web interface

Petition is auto-processed and immediately granted upon submission if all requirements are met

The reply (e.g. a submission in response to a Notice to File Missing Parts) may be attached at the EFS-Web interface



Petitions Relating to Abandonment

37 CFR 1.137(b) ePetition does not apply to petitions requiring:

- a Terminal Disclaimer, such as for a Design application or an application filed before June 8 1995;
- After Final amendments that are not accompanied by an RCE;
- submissions after allowance or applications under appeal;
- applications undergoing re-examination; and
- applications abandoned for more than 2 years.



Inventor's Oath/Declaration

Applications filed on or after September 16, 2012, the provisions of 37 CFR 1.47(a) and (b) no longer apply. Petitions under 37 CFR 1.46(b)(2) will apply, if necessary.

Prior 1.47(a) and (b) continue to apply to applications filed prior to September 16, 2012, even if petition is filed after September 16, 2012.

Term “applicant” is no longer synonymous with the inventor

Applicant may be:

- an assignee, a person to whom there is an obligation to assign, or person with a sufficient proprietary interest in the claimed invention, legal representative of a deceased or incapacitated inventor; or

- remaining joint inventor(s) if a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort

Each inventor must still execute an oath or declaration.



Substitute Statements

37 CFR 1.47 removed and reserved, effective September 16, 2012.

For applications filed on or after September 16, 2012, a Non-inventor applicant may file a substitute statement if an inventor:

- is deceased;
- is legally incapacitated;
- cannot be found or reached after diligent effort; or
- refuses to execute an oath or declaration

an assignee or obligated assignee who executes a substitute statement is not required to provide proof of the steps taken to obtain an executed oath/declaration for inventors who refuse to sign or cannot be found or reached



Substitute Statements

A petition is not required for an assignee or an obligated assignee to be considered the applicant or to execute the substitute statement:

- A petition under 37 CFR 1.46 is required for a person who otherwise shows sufficient proprietary interest in the matter.
- Proof of a refusal to execute or that the inventor cannot be found or reached after diligent effort is no longer required.



Substitute Statements Requirements

Must:

- contain the statements and information required for an oath/declaration;
- Identify the inventor with respect to whom the statement applies;
- Identify the person executing the substitute statement and the relationship to the non-signing inventor;
- Identify the permitted basis, i.e., whether the inventor is deceased, legally incapacitated, cannot be found after diligent effort, or refuses to execute



Assignment Containing Statements

Assignment may serve as an oath/declaration if the assignment as executed:

- includes the information and statements required for an oath/declaration; and**
- copy of the assignment is recorded in the Office's assignment database.**

Such assignment is not reviewed by the Office of Petitions.



Petitions for Applicant Showing Sufficient Proprietary Interest

Applicable to applications filed on or after September 16, 2012.

A grantable petition under 37 CFR 1.46(b)(2) requires:

- The fee set forth in 37 CFR 1.17(g);
- A showing of sufficient proprietary interest in the matter (e.g. a legal memorandum that a court would award title of the application to applicant – see MPEP 409.03(f)); and
- A statement that making the application for patent by a person who otherwise shows sufficient proprietary interest in the matter on behalf of and as agent for the inventor is appropriate to preserve the rights of the parties.



Petitions for Nonsigning Inventors

Applicable to applications filed prior to September 16, 2012, even where petition or renewed petition is filed on or after September 16, 2012.

Where at least one inventor signs the declaration: (MPEP 409.03(a)) A grantable petition under 37 CFR 1.47(a) requires:

- proof of the pertinent facts establishing that the nonsigning joint inventor refuses to join, or cannot be found or reached after diligent effort;
- a proper oath or declaration executed by the available joint inventor(s);
- the petition fee as set forth in 37 CFR § 1.17(g); and
- a statement of the last known address of the nonsigning inventor



Petitions for Nonsigning Inventors (cont'd)

Applicable to applications filed prior to September 16, 2012, even where petition or renewed petition is filed on or after September 16, 2012.

Where no inventor is available: (MPEP 409.03(b)) A grantable petition under 37 CFR 1.47(b) requires:

- proof that the nonsigning inventor cannot be reached or refuses to sign the oath or declaration;
- an acceptable oath or declaration;
- the petition fee set forth in 37 CFR § 1.17(g);
- a statement of the last known address of the nonsigning inventor;
- proof of proprietary interest; and
- proof of irreparable damage or necessity to preserve rights



Inventorship, Order of Inventors, and Inventor Name Corrections

Where the inventorship is to be corrected in a nonprovisional application (e.g. adding or deleting an inventor), the following must be submitted (1.48(a))

- An application data sheet for the entire actual inventive entity that identifies each inventor by his or her legal name;
- The processing fee under 1.17(i); and
- A 1.63 oath or declaration or substitute statement will be required for any actual inventor who has not yet executed such an oath or declaration (1.48(b)).

Note: A new oath or declaration is not required for changes in the order or names of inventors.



Petitions Relating to Expired Patents

Three Options Before Office of Petitions

Prove maintenance fee was timely filed:
Petition under 37 CFR 1.377

Reinstate under Unavoidable Standard:
Petition under 37 CFR 1.378(b)

Reinstate under Unintentional Standard:
Petition under 37 CFR 1.378(c)



Petitions Relating to Expired Patents

Petition under 37 CFR 1.377 – Review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of patent (MPEP 2580)

List both patent and application number on fee transmittal

If typographical error, must have at least one correct mandatory identifier (37 CFR 1.366(c))

If Office can readily identify patent for which maintenance fee payment was intended, petition may be granted.



Petitions Relating to Expired Patents

Petition under 37 CFR 1.378(b) – Unavoidable delay – must include:

- the required maintenance fee set forth in 1.20(e)-(g);
- the surcharge set forth in 1.20(i)(2); and
- an adequate showing that the delay was unavoidable, since reasonable care was taken to insure that the maintenance fee would be paid timely.



Petitions Relating to Expired Patents

Petition under 37 CFR 1.378(c) – Unintentional Delay

A petition to accept late payment of a maintenance fee, where the delay was unintentional, must be filed within 24 months of the expiration of the 6 month grace period as provided in 1.362(e) and include:

- the required maintenance fee set forth in 1.20(e)-(g);
- the surcharge set forth in 1.20(i)(2); and
- a statement that the delay in paying the maintenance fee was unintentional.



Petitions Relating to Expired Patents

Avoid the Office of Petitions all together!

e-Petition filed under 37 CFR 1.378(c)

Registered or unregistered e-Filers can submit this petition to accept late payment of a maintenance fee where the delay was unintentional

- must be filed by proper party

- must be filed within 24 months of the expiration of the 6 month grace period as provided in 1.362(e)

- must pay all maintenance and surcharge fees at time of submission

- must have a credit card, deposit account, or banking account that is amenable to electronic funds transfer.



Petitions Relating to Expired Patents

Avoid the Office of Petitions all together!

e-Petition filed under 37 CFR 1.378(c)

Submission Process

E-Filer uses fillable form SB/PTO/66 to enter pertinent data within the form and then attaches the completed form on the attach screen of EFS-Web

Data validation will be done on the petition form to ensure all fields within the form are completed and also at upload to verify the data entered on the form matches the data at the USPTO

If the data does not match, the petition will not be submitted.



Petitions Relating to Expired Patents

Avoid the Office of Petitions all together!

e-Petition filed under 37 CFR 1.378(c)

Not a Reinstatement Option:

If you want to reinstate an expired patent that has been reissued, or to reinstate an expired reissue

If you were not associated with the patent at the time of expiry

If you want to include an explanation of the circumstances surrounding the delay

* Not an option for renewed petitions under 378(c)



Petitions Relating to Correction of Assignee

Petition under 37 CFR 3.81(b)

to correct assignee data omitted or incorrectly set forth on Issue Fee transmittal, form 85(b)

assignment to correct assignee must have been recorded in Office prior to issuance of patent.

relief is by way of issuance of a certificate of correction

Avoid the Office of Petitions all together!

e-Petition filed under 37 CFR 3.81(b) - may be used to correct assignee information on a patent



Fee Changes

Current fee schedule available at www.uspto.gov at Patents at "Fees"

Fee reductions (if applicable):

- Small Entity – 50% reduction in fee
 - Person, small business concern, or nonprofit organization (37 CFR 1.27)

- Micro Entity – 75% reduction in fee
 - Qualifies as a small entity;
 - Has not been named as an inventor on more than 4 previous patent applications;



Fee Changes (cont.)

- Micro Entity (cont.)
 - Did not, in the calendar year preceding the calendar year in which the applicable fee is paid, have a gross income exceeding 3 times the median household income; and
 - Has not assigned, granted, or conveyed (and is not under obligation to do so) a license or other ownership interest in the application concerned to an entity that, in the calendar year preceding the calendar year in which the applicable fee is paid, has a gross income exceeding 3 times the median household income.

Qualifying income level is posted on USPTO website



Getting your Petition to the Office of Petitions

- ePetition – see slides 2 and 3 for types accepted.
- EFS-Web
- Mail
- Central Fax
- Deliver to Customer Service Window at Randolph Bldg.

ONLY FOR PETITIONS TO WITHDRAW FROM ISSUE (in addition to above)

fax to (571) 273-0025 Office of Petitions

hand carry to security gate in Madison West lobby (600 Dulany Street, Alexandria, VA)

guard will call Office of Petitions and a staff member will meet you in the lobby with log book and date stamp.



CONTACTS

Refer to the Office of Petitions website for more information and other tips

<http://www.uspto.gov/web/offices/pac/dapp/petitionsmain.html>



CONTACTS

General inquiries, status requests or routine matters (e.g., maintenance fees, provisional applications, revivals, small entity)

Office of Petitions, Phone Duty Line
(571) 272-3282



THANKS FOR YOUR ATTENTION
