Changes Affecting the Filing and Prosecuting of Patent Applications

IPO/PTO Day
December 5, 2005

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Examination Policy

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Presented to the
January 17, 2006
Torchia's Restaurant
Briarcliff, NY Scotia, NY

By
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List of Topics

I. Changes to Statutes and/or Fees
II. Changes to Filing Mechanics/Procedures
III. Changes to Examination Practice
IV. Miscellaneous

Topic 1: Changes to Statutes and/or Fees

Changes to Implement the Cooperative Research and Technology Enhancement Act of 2004
Other Recent Fee Changes and Notes

35 U.S.C. 103(c)

35 U.S.C. 103(c) as amended by the Cooperative Research and Technology Enhancement (CREATE) Act
(Public Law 108-453) enacted December 10, 2004
and
as implemented by a Final Rule Entitled
"Changes to Implement the Cooperative Research and Technology Enhancement Act of 2004," 70 FR 54259
(September 14, 2005)
35 U.S.C. 103(c)
as Amended by the CREATE Act
(P.L. 108-453)

CREATE Act revised 35 U.S.C. 103(c) as follows:
Former 35 U.S.C. 103(c) was redesignated as 35 U.S.C. 103(c)(1) (no substantial change to the text)
New subsections 35 U.S.C. 103(c)(2) and (3) were established
Effective Date: December 10, 2004
Applies to any patent granted on or after December 10, 2004

35 U.S.C. 103(c)(2) (NEW)
as Amended by the CREATE Act
(P.L. 108-453)

35 U.S.C. 103(c)(2):
For purposes of this subsection, subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if—
(A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;
(B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and
(C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement. (emphasis added)

35 U.S.C. 103(c)(3) (NEW)
as Amended by the CREATE Act
(P.L. 108-453)

For purposes of the CREATE Act, the term "joint research agreement" means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention. (Emphasis added.)

35 U.S.C. 103(c)
as Amended by the CREATE Act
(P.L. 108-453)

Effective Date Information (see also slide 1):
The revised 35 U.S.C. 103(c) applies to any reissue patent granted on or after its date of enactment.
The recapture doctrine may prevent the presentation of claims in reissue applications that were amended or canceled (e.g., to avoid rejection under 35 U.S.C. 103(a)) based upon subject matter that may now be disqualified under the CREATE Act from the application which resulted in the patent being reissued.
The 1999 change of "subsection (f) or (g)" to "one or more of subsections (e), (f), or (g)" in 35 U.S.C. 103(c) is now also applicable to applications filed prior to November 29, 1999 that were pending on December 10, 2004.
The CREATE Act also includes the amendment to 35 U.S.C. 103(c) made by § 4337 of the American Invents Act Protection Act of 1999 (see Pub. L. 106-11, 113 Stat. 1521, 1503A-891 (1999)), which applied only to applications filed on or after November 29, 1999.

35 U.S.C. 103(c)
as Amended by the CREATE Act
(P.L. 108-453)

Applicant may overcome a rejection under 35 U.S.C. 103(a) based upon subject matter (i.e., a patent document, publication, or other evidence) which qualifies as prior art only under 35 U.S.C. 102(e), (f) or (g) by invoking 35 U.S.C. 103(c) as amended by the CREATE Act.
Applicant cannot rely on the provisions of 35 U.S.C. 103(c) to overcome the following rejections:
• Obviousness double patenting rejections;
• Rejections under 35 U.S.C. 102.
35 U.S.C. 103(c) as Amended by the CREATE Act (P.L. 108-453) and as implemented by final rule (70 FR 54259)

To overcome a rejection by invoking the joint research agreement provisions of 35 U.S.C. 103(c), applicant must:
1. Provide a statement signed by a 37 CFR 1.52(d) party, and
2. Amend the specification* to disclose the names of the parties to the joint research agreement (see 37 CFR 1.77(g) and 1.77(h)(4) and 35 U.S.C. 103(d)(2)(C)).

The final rule deleted the requirement to amend the specification to state either:
A. The date that the joint research agreement was executed and a concise statement of the field of the claimed invention; or
B. Where (i.e., by real and frame number) this information is recorded in the Office’s assignment records.

*Unless the specification discloses the required information.

35 U.S.C. 103(c) as Amended by the CREATE Act (P.L. 108-453) and as implemented by final rule (70 FR 54259)

A subsequent new double patenting rejection based upon the disqualified prior art may apply. See the double patenting guidelines in the final rule.

Applicant may file a terminal disclaimer under 37 CFR 1.321(d) to overcome the double patenting rejection.

- Note: the disclaimer requires common enforcement of the involved patents in addition to a common term requirement.

35 U.S.C. 103(c) as Amended by the CREATE Act (P.L. 108-453) and as implemented by final rule (70 FR 54259)

Requirements for a terminal disclaimer under 37 CFR 1.321(d):

The owners of the rejected application must:
- Waive the right to separately enforce the patents. See 37 CFR 1.321(b)(2).
- Agree that the patents shall be enforceable only during the period that the patents are not separately enforced. See 37 CFR 1.321(b)(3).
- Agree that such waiver is binding upon the owner, its successors, or assigns. See 37 CFR 1.321(b).

The final rule eliminates any requirement in regard to the common licensing of the invention and the disqualified subject matter.

35 U.S.C. 103(c) as Amended by the CREATE Act (P.L. 108-453) and as implemented by final rule (70 FR 54259)

Requirements for a terminal disclaimer under 37 CFR 1.321(d) (cont’d):


Signed by applicant in accordance with 37 CFR 1.321(b)(1) or patentee in accordance with 37 CFR 1.321(a)(1), as applicable. (See 37 CFR 1.321(d)(2))

The final rule eliminates the requirement for the owner of disqualified subject matter to sign the terminal disclaimer.

Topic 1: Changes to Statutes and/or Fees

Changes to Patent Fees Under the Consolidated Appropriations Act (H.R. 4818/P.L. 108-447)

Effective date:
The Consolidated Appropriations Act (CAA) (H.R. 4818/P.L. 108-447) is effective on the date it was signed by the President (December 8, 2004 date of enactment).

The patent fee structure provided for in CAA is in effect during the remainder of fiscal year 2006.

Changes to Patent Fees Under CAA
Final Rule

Final Rule revises the patent fees set forth in the rules of practice to conform them to the patent fees set forth in the CAA.


Effective Date: December 8, 2004.

The Consolidated Appropriations Act
Final Rule — Applications filed without appropriate fees

Final Rule (Effective July 1, 2005):
1. Requires a surcharge for applications filed without search fee or examination fee;
2. Establishes a page size equivalent of 3 kilobytes per page for compact disk (CD) submissions;
3. Requires payment of the basic filing fee (by eliminating the processing and retention fee) to permit benefit of the application to be claimed under 35 USC 120;
4. Establishes a page size equivalent of 75% of the number of sheets of paper when the application is entered into the Office file wrapper for applications submitted via the Office electronic filing system (EFS).


Changes to Patent Fees Under CAA
Fees for Nonprovisional Applications

The following fees are required for applications filed under 35 USC 111(a) on or after December 8, 2004:

Basic filing fee (35 USC 41(a)(1)): $330 for a utility application (non-small entity)
Search fee (35 USC 41(a)(1)): $220 for a utility application (non-small entity)
Examination fee (35 USC 41(a)(3)): $320 for a utility application (non-small entity)
Application size fee (35 USC 41(a)(1)(B)): and if the specification and drawings exceed 100 sheets of paper, $250 (non-small entity) for each additional 50 sheets of paper or fraction thereof.
Excess Claims Fees (35 USC 41(a)(2)):
$200 (non-small entity) for each independent claim in excess of 2;
$100 (non-small entity) for each claim in excess of 2, and
$30 (non-small entity) for each application containing a multiple dependent claim.

Changes to Patent Fees Under CAA
Fees for Nonprovisional Applications

The Basic filing fee is reduced by 75% (i.e., $75.00) only if:
1. Small entity status is properly asserted (§ 1.27(c));
2. The application is filed via the Office’s Electronic Filing System (EFS); and
3. The application is an original utility nonprovisional application filed under 35 USC 111(a).

Note: the 75% reduction does not apply to:
Any applicant who is not a small entity; or
Design or plant applications, reissue applications, or provisional applications.
Changes to Patent Fees Under CAA
Search and Examination Fees

The search and examination fees apply to:
Nonprovisional applications filed under 35 USC 111(a) or after December 8, 2004; and
International applications entering the national stage for which the basic national fee was not paid before December 8, 2004.

The search and examination fees are due:
On filing of an application filed under 35 USC 111(a); or
On commencement of the national stage of a PCT international application.

Changes to Patent Fees Under CAA
Search and Examination Fees

Effective July 1, 2005, the surcharge is required if the search fee or examination fee is paid on a date later than:
The filing date of an application under 35 USC 111(a) filed on or after July 1, 2005; or
Thirty months from the priority date for an international application entering the national stage in which the basic national fee is paid on or after July 1, 2005.

Changes to Patent Fees Under CAA
Search and Examination Fees

For example, if any of the following items is missing upon filing an application under 35 USC 111(a), the USPTO will issue a notice requiring the missing item and the surcharge within a specified period of time in order to avoid abandonment:
The basic filing fee;
The executed oath or declaration;
The search fee; or
The examination fee.
*Effective July 1, 2005, see the prior slide.

Search and examination fees are not required for filing a request for continued examination (RCE) under § 1.114.
The fee set forth in § 1.17(e) for filing an RCE remains the same (e.g., $750 for a non-small entity).
Search and examination fees are required when applicant files a design continued prosecution application (CPA) under § 1.53(d).
A CPA is a new application and can only be filed in a design application.

Changes to Patent Fees Under CAA
Fees for Provisional Applications

For provisional applications in which the filing fee is paid on or after December 8, 2004:
Basic filing fee (35 USC 41(a)(1)(D)) as revised by CAA applies (e.g., $200 for a non-small entity).
• The filing date of the provisional application is irrelevant.

Changes to Patent Fees Under CAA
Fees for Provisional Applications

For provisional applications filed on or after December 8, 2004:
Application size fee (35 USC 41(a)(1)(G)) is required.
• If the specification and drawings exceed 100 sheets of paper, $250 (non-small entity) for each additional 50 sheets of paper or fraction thereof.
Application size fee is not required for provisional applications filed before December 8, 2004.
Changes to Patent Fees Under CAA
Application Size Fee – 35 USC 41(a)(1)(G)

Application size fee applies to:
- Nonprovisional applications (including reissue applications) filed under 35 USC 111(a) on or after December 8, 2004;
- Provisional applications filed under 35 USC 111(b) on or after December 8, 2004; and
- International applications entering the national stage in which the basic national fee was paid on or after December 8, 2004.

Changes to Patent Fees Under CAA
Application Size Fee – 35 USC 41(a)(1)(G)

For purposes of application size fee, the Office will count:
- Applications filed via EFS
  Effective July 1, 2005, the paper size equivalent is 75% of the number of sheets of paper present in the specification and drawings when entered into the file wrapper after being rendered by EFS.
- Substitute specification
  The Office will count the sheets of paper of the substitute specification instead of the original specification, if the original specification is not legible (e.g., the font size is too small) or does not comply with other requirements set forth in § 1.52.
- Tables filed on compact discs (CDs)
  The paper size equivalent is 3 kilobytes per sheet of paper.

Changes to Patent Fees Under CAA
Elimination of Processing and Retention Fee Practice

Effective July 1, 2005*, applicant must pay the basic filing fee during the pendency of the application (rather than just the processing and retention fee) in order for the benefit of the application to be claimed under 35 USC 120 and 37 CFR 1.78(a).

Under the revised patent fee structure under CAA, the basic filing fee covers only the cost of the initial processing of an application.

The Office must retain a prior-filed nonprovisional application to permit benefit of the application to be claimed under 35 USC 120 in a later-filed application.

*The final rule applies to applications filed under 35 USC 111(a) in which the processing and retention fee was not paid before July 1, 2008.

Changes to Patent Fees Under CAA
Application Size Fee – 35 USC 41(a)(1)(G)

For purposes of application size fee, the Office will not count:
- Any sequence listing under § 1.821(c) or (e), or computer program listing under § 1.95
  The listing must be:
  • Submitted on a compact disc in compliance with § 1.52(e); or
  • Submitted via the Office’s electronic filing system (EFS) in ASCII text as part of an associated file of the application. See § 1.52(f).
  Note: any listing submitted via EFS in PDF as part of the specification or as TIFF drawing files would not be excluded when determining the application size fee.

Changes to Patent Fees Under CAA

The CAA did not revise the fees for:
- A request for continued examination (RCE) under § 1.114 (remains at $790 for a non-small entity);
- A submission after final rejection under § 1.129(a) (remains at $790 for a non-small entity); or
- Each additional invention to be examined under § 1.129(b) (remains at $790 for a non-small entity).
Changes to Patent Fees Under CAA

Other revised patent fees include:
- Issue fees – 35 USC 41(a)(4);
- Disclaimer fee – 35 USC 41(a)(5);
- Appeal fees – 35 USC 41(a)(6);
- Revival fees – 35 USC 41(a)(7);
- Extension of time fees – 35 USC 41(a)(8); and
- Patent maintenance fees – 35 USC 41(b).

Any payments of these fees made on or after December 8, 2004 must be made in the revised fee amounts.

Changes to Patent Fees Under CAA
Additional Information

Additional information is posted on the USPTO’s Internet Web at:
http://www.uspto.gov/web/patents/hr4818/index.html
For more information, please contact the Office of Patent Legal Administration at (571) 272-7701 or e-mail to PatentPractice@USPTO.gov or contact one of the following legal advisors:
- Robert A. Clarke (571) 272-7735
- Eugenia A. Jones (571) 272-7727
- Joni Y. Chang (571) 272-7720

Changes to Patent Fees Under CAA
Additional Information -
http://www.uspto.gov/web/patents/hr4818/index.html

Topic 1: Changes to Statutes and/or Fees

Other Recent Fee Changes And Notes

Petition Fees
37 CFR 1.17

Petition fees have been adjusted to more accurately reflect the Office’s current cost of handling petitions pursuant to 35 U.S.C. § 41(d).

Three levels of petition fees are provided:
1. $130 petition fee retained in § 1.17(h);
   - e.g., § 1.102(d) to make an application special,
2. $200 petition fee created in § 1.17(g);
   - e.g., § 1.47 nonprovisional inventor and § 1.56 assignment;
   - and
3. $400 petition fee created in § 1.17(f);
   - e.g., § 1.53(a) to accept a filing date, § 1.182 for questions not specifically provided for, and § 1.183 for waiver of a requirement of the rules.

New form PTO/SB/17p is available on the USPTO forms web page.

Revised Form Language Regarding Fee Payment

WARNING:

Petitioners must ensure to avoid submitting personal information in a petition where such information is likely to be released. Personal information such as name, address, telephone, fax, email, medical history, bank account numbers, credit card numbers, and similar personal information may be released in the event of a legal proceeding. To avoid this, petitioners are advised to use generic information such as company name, address, telephone, fax, email, and similar information. This will help to ensure that personal information is not released in the event of a legal proceeding.
Topic 2: Changes to Filing Mechanics/Procedure

Preliminary Amendment Presented on Filing
Benefit of Provisional Application With a Non-English Specification
Acceptance of Non-Compliant Amendments

Preliminary Amendment Presented at Time of Filing Application

Patent application includes a preliminary amendment at time of filing
Publication of the application must be based on the disclosure as amended
by the preliminary amendment (37 CFR 1.215(a))
Only format usable for publication of the amended specification is a
substitute specification
No substitute specification required if:
Only adding or amending a benefit claim
Amending claims via complete claim listing (37 CFR 1.121(c))
Amending the Abstract via replacement Abstract (37 CFR 1.121(b))
Amending drawings using replacement or new sheet(s) (37 CFR 1.121(d))
A preliminary amendment filed upon entry of the national stage under 35
USC 371 is not part of the original disclosure

Preliminary Amendment Presented at Time of Filing Application, cont’d

Recommendations:
File clean copy of specification when filing application
Make benefit claim in Application Data Sheet
File application with new claims set
Do not amend claims by preliminary amendment at time of filing
Avoid paying application size fee
Filed specification, filed claim set and preliminary amendment are all
counted when determining application size for purposes of 37 CFR
1.16(a)
Can still file copy of executed declaration from priority application
If no new matter
53146 (October 10, 1997)

Final Rule for Claiming the Benefit of a Non-English Language Provisional Application

37 CFR 1.78(a)(5)(iv) is amended to require applicant to file:
1. An English language translation of a non-English language provisional
application; and
2. A statement that the translation is accurate,
in the provisional application.
In response to any notice mailed in a nonprovisional application that
claims the benefit of the provisional application requiring the
translation and statement, applicant must file:
1. The translation and statement in the provisional application and,
2. A confirmation in the nonprovisional application,
unless applicant amends the first sentence of the specification or ADS
to remove the benefit claim.
End of Parts I and II
Parts I and II Were Presented By
Gerald F. Dudding, J.D., Ph.D.
GFD Patents, LLC

Acceptance of Certain Non-Compliant Amendments
Office will accept where amendment otherwise complies with 37 CFR 1.121 and non-compliance is limited to:
- Inclusion of text of a canceled claim
- Inclusion of text of “not entered” claim
- Certain variations of status identifiers in claim listing will be accepted if:
  - One of those listed in 1296 Off. Gaz. Pat. Office 27 (July 5, 2005), or
  - Variation that clearly and accurately identifies the status of the claim to the examiner

Pre-Appeal Conference
Background
- 21st Century Strategic Plan – Quality
  - Approximately 60% of all appealed cases are “not” forwarded to BPAI
Implemented Pre-Appeal Brief Conference Pilot Program
Goals
Avoid Filing Appeal Brief When You Can
Or, Alternatively, Reduce Size and Cost of An Appeal Brief
Identify clearly improper rejections because of factual errors
Identify clear absence of prima facie case
Narrow focus to true issues in controversy

Why This Pilot Program?
TC's already provide appeal conferences after the submission of an Appeal Brief.
Over half of the appeal conferences result in allowance or reopening of prosecution.
Thus, this pre-brief review procedure may eliminate, or reduce, the time and expense to prepare an Appeal Brief and expedite the prosecution process.

Who Can Use This Procedure?
Anyone who is filing a Notice of Appeal
except parties involved in a patent reexamination proceeding

WHEN Can It Be Requested?
ONLY WITH the Notice of Appeal

What Do You Provide?
1. Written Request
   - Preferably, use the USPTO Form PTO/SB/33
   - Otherwise, label a request as "Pre-Appeal Brief Request For Review"
   - Must be filed with the Notice of Appeal
2. Arguments
   - Not more than five (5) pages, excluding the cover request form
   - Succinct, Concise & Focused
   - Identification of CLEAR ERRORS or DEFICIENCIES in the prima facie case

What Is The Fee?
At present, there is no fee for the request.
The fee for the Notice of Appeal remains.
The fee for the Notice of Appeal is non-refundable, even in the event of a favorable outcome from the Pre-Appeal Brief conference.

What Does The USPTO Do?
Technology Center (TC) convenes a panel
TC managers and conference experienced in the pertinent field of technology
Includes a SPE and examiner of record
Panel reviews rejections identified by request, arguments submitted with the request, and application file
A determination will be made as to whether an issue for appeal is present.
When Will The Decision Be Mailed?

Generally, decisions will be made and mailed within 45 days of receiving the request.

RECAP

Remember
Use the USPTO Form, or Label your Request Form as “Pre-Appeal Brief Request For Review”
Submit WITH Notice of Appeal, as a SEPARATE Document
No Amendments, Affidavits, or Other Evidence
No Request Fee, But Notice of Appeal Fee Still Required
No More Than Five (5) Pages of Arguments Attached to the Request Form
CLEAR, CONCISE, FOCUSED

Improved Reexamination Process

A new separate Centralized Reexamination Unit (CRU) established
- 20 senior examiners to examine all new reexamination proceedings
- Panels to review all actions
- Firm processing time will be established for all reexamination proceedings so the Office will consistently handle the processing with high quality and with special dispatch set in the statute.

How Long Do You Have To File Appeal Brief Following Decision?

You Have the Longer of
- Time Remaining From Notice of Appeal
- OR
- One Month From Mailing of Decision

Usual time extensions may be obtained by fee

Topic 3: Changes to Examination Practice

Improved Reexamination Process

Second or Subsequent Reexamination Requests – Changes to Substantial New Question of Patentability
Second or Subsequent Request for Reexamination

Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination while an Earlier Filed Reexamination is Pending. 1292 Off. Gaz. Pat. Office 20 (March 1, 2005)

Notifies public of current policy set forth in MPEP 2240 (8th ed. 2001)(Rev. 3, August 2005) regarding when a second or subsequent request for reexamination is filed while an "earlier filed reexamination" proceeding is pending, and the second or subsequent request cites only prior art (hereafter "old art") which raised a substantial new question of patentability (SNQ) in the pending reexamination proceeding.

• If the old prior art cited (in the second or subsequent request) raises only the same issue that was raised to initiate and maintain the pending reexamination proceeding, the second or subsequent request will be denied.

Revised Procedure for Recording Searches and Printing Information on Patent under the Heading "Field of Search"

Revised procedure for recording searches to improve application files and permit reproduction of examiner searches:

Examiner will record "Classified Search"

• Complete search of all documents in a subclass

Examiner will record "Limited Classified Search"

• Search of subclass limited by at least one text query

• Explanation of search limitation(s) required

• Printout of complete search history must be included in application file

Change to Transitional Procedures for Limited Examination After Final Rejection in Cases Pending for At Least Two Years Prior to June 8, 1995

Applies to any submission under 37 CFR 1.129(a) filed on or after June 8, 2005

37 CFR 1.129(a):

An application eligible for transitional further limited examination as set forth in 37 CFR 1.129(a) is entitled to have two (2) after final submissions entered and considered with the payment of the fee under 37 CFR 1.17(r)

If an applicant has already filed one submission under 37 CFR 1.129(a) (and the 37 CFR 1.17(r) fee), the applicant is only entitled to have one additional after final Office action submission entered and considered under 37 CFR 1.129(a)
Change to Transitional Procedures for Limited Examination After Final Rejection in Cases Pending for At Least Two Years Prior to June 8, 1995, cont'd

New procedure:

Next Office action following a timely submission under 37 CFR 1.129(a) (and the 37 CFR 1.17(f) fee) will be treated as an Office action following a reply to a non-final Office action.

In accordance with 37 CFR 1.113, this next Office action shall be made final.

Exceptions to making the next Office action final are those set forth in MPEP 706.07(a) – 706.07(e).

Examiner Interviews Prior to First Office Action

Section 1.133(a)(2) is amended to permit an interview before first Office action in any application if the examiner determines that such an interview would advance prosecution of the application.

Examiner may require that an applicant requesting an interview before first Office action provide:

• a paper that includes a general statement of the state of the art at the time of the invention, an identification of no more than three (3) references believed to be the “closest” prior art, and an explanation as to how the broadest claim distinguishes over such references.

Topic 3: Changes to Examination Practice

Interviews

Topic 4: Miscellaneous

Future Change: EFS-Web

Reciprocal Access to Application Files of Trilateral Offices

Provisional Applications available at Office Web Site

Finding Recent Announcements at the Office Web Site

Future Changes

EFS-Web: Goals

Increase Initial Patent Applications e-Filing
Expand Acceptance of Follow-on Papers
Compatibility With IP Community Process
Provide Simple, Safe, and Secure Method
Integrate With Other USPTO Systems
Make it Simple
PDF eFiling of Patent Applications via Web
PDF used in current business process
Web technology requires no client software
Simplify Security
Customer Firewall issues reduced with web solution
Increase eFiling types
Design
Amendments
371’s
etc.

Make it Safe
File PDFs as electronic paper in a simple transaction
Expanded and improved e-filing acknowledgement receipt

EFS-Web: e-Filer Experience
EFS-Web Will Provide Choices and Options to the e-Filer to Match Their Business Processes and Environments

Enter Application Information

Attach and Review Documents

Pay Fees Associated with New Filing
Reciprocal Access to and Usage of Documents in Application Files of Trilateral Offices

Reduce duplicate searching between the USPTO, EPO and JPO.
Examiner in one national Office can view file contents of published applications in one of the foreign national Offices.
Limited to published applications.
Consistent with current practice of reviewing published applications.
Allows Examiner to import published document into the application file.
Imported document becomes part of prosecution history of the recipient Office's official file.

Reciprocal Access to and Usage of Documents in Application Files of Trilateral Offices, cont'd

Imported documents limited to:
- Application as filed (request, claims, description, figures, etc.)
- List of cited references
- Available reference copies in file
- Search reports (without examiner comments or arguments)
- Appropriate translations

Provisional applications available at USPTO Web Site*

Instituted:
Most provisional applications relied upon for earlier filing date are available online at the USPTO Web Site.

Terminated:
Transitional practice of supplying copies of provisional applications with Office actions.

Navigating the PTO Web Site: How to Find the Most Recent Legal and Policy Guidance

Go to uspto.gov and click on the words "Site Index":

End of Parts III and IV

Parts III and IV Were Presented By:
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Presented to the
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Changes Affecting the Filing and Prosecuting of Patent Applications

IPR/PTD Day
December 5, 2005

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