Clarification of 37 CFR 1.704(c)(10) - 
Reduction of Patent Term Adjustment for 
Certain Types of Papers Filed 
After a Notice of Allowance has been Mailed

Patent term adjustment under 35 U.S.C. 154(b)(1) is reduced by the period of time 
during which the applicant “failed to engage in reasonable efforts” to conclude prosecution 
(i.e., processing or examination of an application). See 35 U.S.C. 154(b)(2)(C)(i). Pursuant 
to 35 U.S.C. 154(b)(2)(C)(iii), the United States Patent and Trademark Office (Office) has 
prescribed regulations setting forth the circumstances constituting a failure to engage in 
reasonable efforts to conclude prosecution (i.e., processing or examination of an 
application). See 37 CFR 1.704. After a “Notice of Allowance” has been mailed, 
submissions by an applicant that cause a delay in processing or examination of an 
application will be considered a “failure to engage in reasonable efforts” to conclude 
prosecution. See 37 CFR 1.704(c)(10) (“failure to engage in reasonable efforts” to conclude 
prosecution includes submission of an amendment under 37 CFR 1.312 or other paper after 
a “Notice of Allowance” has been mailed). The reason such a submission is considered a 
“failure to engage in reasonable efforts” to conclude processing or examination of an 
application is that delaying the submission of such papers until after an application is 
allowed causes substantial interference and delay in the patent issue process. See Changes to 
Implement Patent Term Adjustment under Twenty-Year Patent Term, 65 Fed. Reg. 56365, 

It should be noted, however, that only certain papers (not all papers), filed after a 
“Notice of Allowance” is mailed, cause substantial interference and delay in the patent issue 
process. Therefore, it is the filing of these papers that will be considered a “failure to engage in 
reasonable efforts” to conclude processing and examination of an application under 37 
CFR 1.704. The Office has reviewed many allowed applications (mostly continued 
prosecution applications (CPAs)) that were filed on or after May 29, 2000, in which the 
issue fee was paid. The review consistently showed that only certain papers submitted after 
a “Notice of Allowance” is mailed, interfered with and delayed the patent issue process to 
such a degree as to constitute a “failure to engage in reasonable efforts” to conclude 
processing or examination of an application.

Accordingly, the Office is publishing this notice to provide guidance in interpreting 
the provisions of 37 CFR 1.704(c)(10) to clarify that submission of certain papers after a 
“Notice of Allowance,” which do not cause substantial interference and delay in the patent 
issue process, are not considered a “failure to engage in reasonable efforts” to conclude 
processing or examination of an application. The following are examples of such papers: (1) 
Issue Fee Transmittal (PTOL-85B), (2) Power of Attorney, (3) Power to Inspect, (4) Change 
of Address, (5) Change of Status (small/not small entity status), (6) a response to the 
examiner’s reasons for allowance, and (7) letters related to government interests (e.g., those 
between NASA and the Office). Therefore, the submission of these papers after a Notice of 
Allowance will not be considered a “failure to engage in reasonable efforts” to conclude 
processing or examination of an application and would not result in reduction of a patent 
term adjustment pursuant to 37 CFR 1.704(c)(10).
In contrast, the submission of other papers after a “Notice of Allowance” is mailed that do cause substantial interference and delay in the patent issue process are considered a “failure to engage in reasonable efforts” to conclude processing or examination of an application pursuant to 37 CFR 1.704(c)(10). The following are examples of such papers: (1) a request for a refund, (2) a status letter, (3) amendments under 37 CFR 1.312, (4) late priority claims, (5) a certified copy of a priority document, (6) drawings, (7) letters related to biological deposits, and (8) oaths or declarations.

As guidance for minimizing reductions to any patent term adjustment, applicants should adopt practices that do not delay processing of the applications after the “Notice of Allowance” has been mailed. For instance, instead of filing corrected drawings or editorial amendments after the application has been allowed, applicant should submit such corrected drawings or editorial amendments prior to allowance of the application. In addition, instead of filing a status letter, applicant should use the private Patent Application Information Retrieval (PAIR) system to determine the status of the application (http://pair-direct.uspto.gov) or call the Office.

The Patent Application Locating and Monitoring (PALM) system maintains computerized contents records of all patent applications and reexaminations. PAIR is a system that provides public access to PALM for patents and applications that have been published (i.e., information for applications maintained in confidence cannot be obtained), which can be accessed over the Internet at http://pair.uspto.gov. The private side of PAIR at http://pair-direct.uspto.gov can be used by an applicant to access confidential information about his or her pending application. To access the private side of PAIR, a customer number must be associated with the correspondence address for the application, and the user of the system must have a digital certificate. For further information, contact the Customer Support Center of the Electronic Business Center at (703) 305-3028.

In addition, if PAIR is used to see the PALM records that are relied upon for patent term adjustment purposes, a contents entry with the contents code “DRWS” and the contents description “DRAWING REQUIREMENTS SATISFIED” does not indicate when the drawings were filed and is not a PALM entry that is used in the patent term adjustment calculation.

Any questions or comments about this change should be directed to Karin Tyson, Senior Legal Advisor, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy. Ms. Tyson can be reached by telephone at (703) 306-3159, or by e-mail at Karin.Tyson@uspto.gov.

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