American Inventors Protection Act of 1999

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A. Request for Continued Examination (RCE)

A1. What is a request for continued examination (RCE)?

Section 4403 of the “American Inventors Protection Act of 1999” amends 35 U.S.C. §132 to provide, at the request of the applicant, for continued examination of an application for a fee (request for continued examination or RCE practice), without requiring the applicant to file a continuing application under 37 CFR 1.53(b) or a continued prosecution application (CPA) under 37 CFR 1.53(d).

To implement RCE practice, the Office has added 37 CFR 1.114 to provide a procedure under which an applicant may obtain continued examination of an application by filing a submission and paying a specified fee, even if the application is under a final rejection, appeal, or a notice of allowance.


A2. To what applications do the RCE provisions of 37 CFR 1.114 apply?

The provisions of 37 CFR 1.114 apply to utility or plant applications filed under 35 U.S.C. §111(a) on or after June 8, 1995, or international applications filed under 35 U.S.C. §363 on or after June 8, 1995. The request for continued examination provisions of 37 CFR 1.114 do not apply to: (1) a provisional application; (2) an application for a utility or plant patent filed under 35 U.S.C. §111(a) before June 8, 1995; (3) an international application filed under 35
§363 before June 8, 1995; (4) an application for a design patent; or (5) a patent under reexamination. See 37 CFR 1.114(e).

A3. When may applicant file a request for continued examination (RCE) under 37 CFR 1.114?

An applicant may obtain continued examination of an application by filing a submission and the fee set forth in 37 CFR 1.17(e) (currently, $710.00 for a large entity and $355.00 for a small entity) prior to the earliest of: (1) the date a patent is granted (but after payment of the issue fee only if a petition under 37 CFR 1.313 is granted); (2) abandonment of the application; or (3) the date applicant seeks court review of a decision by the Board of Patent Appeals and Interferences (unless the court action is terminated). See 37 CFR 1.114(a). An applicant cannot request continued examination of an application until after the prosecution in the application is closed. See 37 CFR 1.114(a).

Note: 37 CFR 1.114 in the Final Rule requires that prosecution in an application be closed (i.e., the application is under appeal, or the last Office action is a final action, a notice of allowance, or an action that otherwise closes prosecution in the application such as an Office action under Ex parte Quayle, 1935 Comm’r Dec. 11 (1935)) before an applicant can request continued examination of the application. Thus, a RCE would not be acceptable if the last Office action was a non-final rejection.

A4. What is/is not a submission under 37 CFR 1.114?

A submission as used in 37 CFR 1.114 includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. See 37 CFR 1.114(c). The definition for a “submission” in 37 CFR 1.114 is the same as the definition in 37 CFR 1.129(a). If reply to an Office action under 35 U.S.C. §132 is outstanding, the submission must meet the reply requirements of 37 CFR 1.111. See 37 CFR 1.114(c). Thus, an applicant may file a submission under 37 CFR 1.114 containing only an information disclosure statement (37 CFR 1.97 and 1.98) in an application subject to a notice of allowance under 35 U.S.C. §151. An appeal brief or a reply brief (or related papers) will not be considered a submission under 37 CFR 1.114. See 37 CFR 1.114(d). The submission, however, may consist of the arguments in a previously filed appeal brief or reply brief, or may simply consist of a statement that incorporates by reference the arguments in a previously filed appeal brief or reply brief. In addition, a previously filed amendment after final may satisfy this submission requirement.

A5. What is the status of unentered after final amendments upon the filing of a RCE (and fee)?

Upon the filing of a RCE (and fee), the finality of the last Office action is withdrawn. Any previously filed unentered amendments, amendments filed with the RCE, and any amendments filed prior to the mailing of the next Office action (after the RCE) are to be entered. Any conflicting amendments should be clarified for entry by the applicant upon
filing the RCE (and fee). Absent specific instructions for entry, all amendments filed as of the date the RCE is filed are entered in the order in which they were filed.

A6. What submission is required if applicant has submitted arguments after final which were (1) entered by the examiner (2) not found persuasive by the examiner in the prior prosecution and (3) an advisory action to that effect was mailed?

Prior to submitting the request for continued examination (and fee), the final rejection continues as modified by the advisory action. The request for continued examination (and fee) may be accompanied by new arguments or amendments. The request for continued examination, however, need not be accompanied by new arguments or amendments. The fact that the previously submitted arguments were not found persuasive does not preclude them as a submission under 37 CFR 1.114, provided that such arguments are responsive within the meaning of 37 CFR 1.111 to the Office action. Consideration of whether any submission is responsive within the meaning of 37 CFR 1.111 to the last outstanding Office action is done without factoring in the “final” status of such outstanding Office action. Thus, a reply which might not be acceptable as a reply under 37 CFR 1.113 when the application is under a final rejection may very well be acceptable as a reply under 37 CFR 1.111.

A7. How should a conditional RCE be treated?

If a submission is accompanied by a “conditional” RCE and payment of the RCE fee (37 CFR 1.17(e) (i.e., an authorization to charge the 37 CFR 1.17(e) fee to a deposit account in the event that the submission would not otherwise be entered), the Office will treat the “conditional” RCE and payment as if a RCE and payment of the fee set forth in 37 CFR 1.111 had been filed.

A8. How should new matter in an amendment entered pursuant to 37 CFR 1.114 be treated?

35 U.S.C. §132(a) provides that “[n]o amendment shall introduce new matter into the disclosure of the invention.” Any amendment entered pursuant to 37 CFR 1.114 that is determined to contain new matter should be treated in the same manner that a reply under 37 CFR 1.111 determined to contain new matter is currently treated. See MPEP 706.03(o). In those instances in which an applicant seeks to add new matter to the disclosure of an application, the procedure in 37 CFR 1.114 is not available, and the applicant must file a continuation-in-part application under 37 CFR 1.53(b) containing such new matter. In addition, as 35 U.S.C. §132(b) and 37 CFR 1.114 provide continued examination of an application (and not examination of a continuing application), the applicant cannot file a RCE to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined as a matter of right (i.e., applicant cannot switch inventions) (see 37 CFR 1.145).

A9. Can the next Office action after the filing of a request for continued examination under 37 CFR 1.114 be made final?
The action immediately subsequent to the filing of a RCE with a submission and fee under 37 CFR 1.114 may be made final only if the conditions set forth in MPEP 706.07(b) for making a first action final in a continuing application are met.

**A10. What if a request for continued examination under 37 CFR 1.114 is filed in an application under final rejection?**

If an applicant timely files a RCE with the fee set forth in 37 CFR 1.17(e) and a submission, the Office will withdraw the finality of any Office action to which a reply is outstanding and the submission will be entered and considered. See 37 CFR 1.114(d). If the application is under final rejection, a submission meeting the reply requirements of 37 CFR 1.111 must be timely received to continue prosecution of an application. In other words, the mere request for, and payment of the fee for, continued examination will not operate to toll the running of any time period set in the previous Office action for reply to avoid abandonment of the application.

**A11. What if a RCE is filed with a submission and the required fee after final rejection but the submission does not meet the reply requirements of 37 CFR 1.111?**

If reply to an Office action is outstanding and the submission is not fully responsive to the prior Office action, then it must be a *bona fide* attempt to provide a complete reply to the prior Office action in order for the RCE to toll the period for reply. If the submission is a *bona fide* attempt to provide a complete reply, applicant should be informed that the submission is not fully responsive to the prior Office action, along with the reasons why, and given a new shortened statutory period of one month or thirty days (whichever is longer) to complete the reply. See 37 CFR 1.135(c). If the submission is not a *bona fide* attempt to provide a complete reply, the RCE will not toll the period for reply and the application will be abandoned after the expiration of the statutory period for reply.

**A12. What if a request for continued examination under 37 CFR 1.114 is filed in an allowed application?**

The phrase “withdraw the finality of any Office action” in 37 CFR 1.114(d) includes the withdrawal of the finality of a final rejection, as well as the closing of prosecution by an Office action under *Ex parte Quayle*, 1935 Comm’r Dec. 11 (1935), or notice of allowance under 35 U.S.C. §151 (or notice of allowability). Therefore, if an applicant files a RCE with the fee set forth in 37 CFR 1.17(e) and a submission in an application which has been allowed, prosecution will be reopened. If the issue fee has been paid, however, payment of the fee for a RCE and a submission without a petition under 37 CFR 1.313 to withdraw the application from issue will not avoid issuance of the application as a patent.

**A13. If a request for continued examination under 37 CFR 1.114 is filed in an allowed application after the issue fee has been paid and a petition under 37 CFR 1.313 is also filed and granted, does the applicant have to pay the issue fee again if the application is thereafter allowed?**
No. If the issue fee has been paid and prosecution is reopened, the applicant may not obtain a refund of the issue fee. If, however, the application is subsequently allowed, applicant may request that the previously submitted issue fee be applied toward payment of the issue fee required by the new notice of allowance.

A14. What if a request for continued examination under 37 CFR 1.114 is filed in an application after the filing of Notice of Appeal to the Board of Patent Appeals and Interferences but prior to a decision on the appeal?

If an applicant files a request for continued examination under 37 CFR 1.114 after the filing of a Notice of Appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner. See 37 CFR 1.114(d). Thus, the filing of a request for continued examination under §1.114 in an application containing an appeal awaiting a decision on the appeal will be treated as a withdrawal of the appeal by the applicant, regardless of whether the request for continued examination under 37 CFR 1.114 includes the appropriate fee (37 CFR 1.17(e)) or a submission (37 CFR 1.114(c)).

If a RCE is filed in an application after appeal to the Board of Patent Appeals and Interferences but the request does not include the fee required by 37 CFR 1.17(e) or the submission required by 37 CFR 1.114, or both, the examiner should withdraw the appeal pursuant to 37 CFR 1.114. The proceedings as to the rejected claims are considered terminated. Therefore, if no claim is allowed, the application is abandoned. See MPEP 1215.01. If there is at least one allowed claim, the application should be passed to issue on the allowed claim(s). If there is at least one allowed claim but formal matters are outstanding, applicant should be given a shortened statutory period of one month or thirty days (whichever is longer) in which to correct the formal matters.

A15. What if a request for continued examination under 37 CFR 1.114 is filed in an application after a decision by the Board of Patent Appeals and Interferences but before further appeal or civil action?

The filing of a request for continued examination (accompanied by the fee and a submission) after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit (Federal Circuit) or the commencement of a civil action, will also result in the finality of the rejection or action being withdrawn and the submission being considered. In addition to the res judicata effect of a Board of Patent Appeals and Interferences decision in an application (see MPEP 706.03(w)), a Board of Patent Appeals and Interferences decision in an application is the “law of the case,” and is thus controlling in that application and any subsequent, related application. See MPEP 1214.01 (where a new ground of rejection is entered by the Board of Patent Appeals and Interferences pursuant to 37 CFR 1.196(b), argument without either amendment of the claims so rejected or the submission of a showing of facts can only result in a final rejection of the claims, since the examiner is without authority to allow the claims unless amended or unless the rejection is overcome by a showing of facts not before the Board of Patent Appeals and Interferences). As such, a submission containing arguments
without either amendment of the rejected claims or the submission of a showing of facts will not be effective to remove such rejection.

A16. What if a request for continued examination under 37 CFR 1.114 is filed in an application after the filing of a Notice of Appeal to the Federal Circuit or the commencement of a civil action?

The procedure set forth in 37 CFR 1.114 is not available in an application after the filing of a Notice of Appeal to the Federal Circuit or the commencement of a civil action, unless the appeal or civil action is terminated and the application is still pending. If a RCE is filed in an application that has undergone court review, the application should be brought to the attention of the SPE or SPRE to determine whether the RCE is proper.

A17. Can a CPA still be filed after May 29, 2000?

37 CFR 1.53(d)(1)(i) has been amended to provide that continued prosecution application (CPA) practice under 37 CFR 1.53(d) does not apply to applications (other than design) if the prior application has a filing date on or after May 29, 2000. Thus, an application (except for a design application) must have an actual filing date before May 29, 2000 for the applicant to be able to file a CPA of that application. While the Office uses the filing date (and application number) of the prior application of a CPA for identification purposes, the filing date of a CPA under 37 CFR 1.53(d) is the date the request for a CPA is filed. See 37 CFR 1.53(d)(2). Thus, if a CPA of an application (other than for a design patent) is filed on or after May 29, 2000, 37 CFR 1.53(d)(1)(i) does not permit the filing of a further CPA, regardless of the filing date of the prior application as to the first CPA (i.e., the filing date used for identification purposes for the CPA).

A18. What if applicant files a request for a CPA of a utility or plant application that was filed on or after May 29, 2000?

In the event that an applicant files a request for a CPA of a utility or plant application that was filed on or after May 29, 2000 (to which CPA practice no longer applies), the Office will automatically treat the improper CPA as a request for continued examination of the prior application (identified in the request for CPA) under new 37 CFR 1.114. If an applicant files a request for a CPA of an application to which CPA practice no longer applies and does not want the request for a CPA to be treated as a request for continued examination under 37 CFR 1.114 (e.g., the CPA is a divisional CPA), the applicant may file a petition under 37 CFR 1.53(e) requesting that the improper CPA be converted to an application under 37 CFR 1.53(b). The requirements for such a petition under 37 CFR 1.53(e) are identical to those set forth in MPEP 201.06(b) for converting an improper file wrapper continuing (FWC) application under former 37 CFR 1.62 to an application under 37 CFR 1.53(b). The Office will not grant such a petition, however, unless it is before the appropriate deciding official before an Office action has been mailed in response to the request for continued examination under 37 CFR 1.114 (as the improper CPA is being treated). If an Office action has been mailed in response to the request for continued
examination under 37 CFR 1.114, the applicant should then simply file an application under 37 CFR 1.53(b) within the period for reply to such Office action.

A19. How does the RCE procedure under 37 CFR 1.114 differ from the transitional procedure set forth in 37 CFR 1.129(a) and CPA procedure set forth in 37 CFR 1.53(d)?

The request for continued examination (RCE) procedure in 37 CFR 1.114 should not be confused with the transitional procedure for the further limited examination of patent applications set forth in 37 CFR 1.129(a) or the continued prosecution application (CPA) procedure set forth in 37 CFR 1.53(d). This chart provides a comparison of the three different procedures.

http://www.uspto.gov/web/offices/dcom/olia/aipa/RCECPA.pdf

A20. Are there new form paragraphs for use in treating a RCE?

The Office has developed new form paragraphs for use by examiners when acting on an application in which a RCE has been filed. The Office is in the process of adding these paragraphs to both ActionWriter and the Office Action Creation System (OACS). These form paragraphs are reproduced below: (click hyperlink)

A21. If a RCE is filed after the mailing of a Notice of Allowance but before payment of the issue fee, is a petition under 37 CFR 1.313 to withdraw the application from issue required?

No. If a RCE (with the fee and a submission) is filed in an allowed application prior to payment of the issue fee, a petition to withdraw the application from issue is not required. If the issue fee has been paid, however, filing of a RCE (with the fee and a submission) without a petition to withdraw the application from issue will not avoid issuance of the application as a patent. See 37 CFR 1.114(a).

A22. In an allowed application and before payment of the issue fee, is a petition under §1.313 to withdraw the application from issue required for consideration of a request for continued examination under §1.114?

No, a petition to withdraw an application from issue is not required if a request for continued examination under §1.114 is filed prior to payment of the issue fee.

A23. If I filed a provisional application on June 8, 1995, and haven’t done anything since then (so there is no pending application), does the new law now enable me to file the same application as a regular application, claim priority from the provisional, and obtain the benefit of provisional’s filing date?

On its face, Section 4801(c) of the American Inventors Protection Act of 1999 seems to create the ultimate submarine patent, and I wonder how the PTO intends to prevent this
result. If you filed a provisional application on June 8, 1995, §4801 of the AIPA extended its period of pendency from June 8, 1996 (a Saturday) until June 10, 1996 and eliminated the copendency requirement for a nonprovisional application to claim the benefit of that provisional application. Section 4801 of the AIPA, however, did not eliminate the requirement in 35 U.S.C. 119(e)(1) that a nonprovisional application be filed within twelve months of the filing date of the provisional application for the nonprovisional application to claim the benefit of the filing date of the provisional application. Under 35 U.S.C. 21(b), if this twelve-month period expires on a non-business day (June 8, 1996), it is extended to expire on the next business day (June 10, 1996). Thus, you cannot claim the benefit of the filing date of the provisional application filed on June 8, 1995 in a nonprovisional application filed after June 10, 1996.

A24. Does amended 35 USC 119(e) enable a nonprovisional application to claim priority based on a corresponding provisional application when the nonprovisional is filed more than 12 months after the filing of the provisional? Please explain.

No, 35 U.S.C. 119(e)(1) still requires that a nonprovisional application be filed within twelve months of the filing date of the provisional application for the nonprovisional application to claim the benefit of the filing date of the provisional application.

A25. The legislation amended 119(e)(2) to remove the requirement of copendency for a provisional application. However, 119(e)(1) was not amended so it has retained the copendency requirement for filing a nonprovisional application claiming priority from a provisional. 37 CFR 1.78 has been amended to remove the copendency requirement entirely. This seems inconsistent with 119(e)(1). Please clarify this issue.

35 U.S.C. 119(e)(1) requires that a nonprovisional application be filed within twelve months of the filing date of the provisional application for the nonprovisional application to claim the benefit of the filing date of the provisional application. It does not require copendency for the nonprovisional application to claim the benefit of that provisional application. It is not necessary for the rules of practice to reiterate statutory requirements (it is sufficient that the statute contains the requirements) and that a rule does not reiterate all the pertinent statutory requirements does not make the rule inconsistent with the statute.

A26. An applicant filed a RCE within 3 months from the mailing of a non-final Office action (i.e., the prosecution in the application is not closed). With the RCE, the applicant submitted an amendment responsive to the Office action in compliance with 37 CFR 1.111 and the proper fee. (a) Is the RCE proper? (b) If the RCE is improper, will the amendment be entered and considered by the examiner to avoid abandonment of the application?

(a) The answer would depend on the filing date of the RCE.

If the RCE was filed before August 16, 2000, then the RCE would be proper because under the RCE Interim Rule, a RCE may be filed before the prosecution in an application is

If the RCE, however, was filed on or after August 16, 2000, then the RCE would be improper because under the RCE Final Rule, a RCE may not be filed before the prosecution in an application is closed. See 37 CFR 1.114(a) and Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule, 65 FR 50092 (Aug. 16, 2000), 1238 Off. Gaz. Pat. Office 13 (Sept. 5, 2000).

For the purpose of filing a RCE, the prosecution in an application is closed when the application is under appeal, or the last Office action is a final action, a notice of allowance or a Qualye action.

(b) Even though the RCE is improper (because it was filed on or after August 16, 2000 and before the prosecution is closed), the amendment submitted with the RCE would still be entered and considered by the examiner since it was timely filed and responsive to the non-final Office action in compliance with 37 CFR 1.111.

**B. Patent Term Adjustment**

**B1. In view of the Patent Term Guarantee, does the United States Patent and Trademark Office plan to print an explicit indication of the expiration date on the face of a patent so that the expiration date can be ascertained without having to add the patent term extension to the original patent term?**

The United States Patent and Trademark Office does not print the expiration date on issued patents because the actual date a patent will expire is dependent upon a number of future events. The actual date any particular patent will expire is, for example, dependent upon whether: (1) all maintenance fees are timely paid; (2) the patent is disclaimed, either by a statutory disclaimer of all claims or a terminal disclaimer; (3) all of the claims of the patent are canceled during a reexamination proceeding; or (4) an extension under 35 U.S.C. 156 is granted. Since less than forty percent of patentees pay all three maintenance fees, an expiration date based upon a calculation of date that is twenty years from the earliest filing date under 35 U.S.C. 111(a), 120, 121, 363, or 365(c) plus any calculated extension under 35 U.S.C. 154(b) would be incorrect and misleading over sixty percent of the time. However, the front page of the patent will indicate the number of days of term adjustment to which the patent is entitled.

**B2. May an applicant obtain patent term adjustment even if prosecution is less than 3 years?**

Yes, assuming the application is eligible, patent term adjustment is available under either 35 USC 154(b)(1)(A) (administrative delays) or (C) (interferences, secrecy orders and successful appeals) regardless of how long the application was pending in the Office. See proposed 37 CFR 1.702(a), (c), (d), and (e).
Example: An application is filed 6/1/00. A notice of allowance is mailed 9/1/01. The issue fee is paid and all formal requirements are satisfied on 12/1/01. The patent is not issued until 5/1/02. As the patent was not issued in four months following the payment of the issue fee, the period of delay from 4/2/02 to 5/1/02 would give rise to patent term adjustment pursuant 35 USC 154(b)(1)(A)(iv) and proposed 37 CFR 1.702(a)(4) and 1.703(a)(6).

B3. Is an application for patent term adjustment under 37 CFR 1.705(c) required to include the fee set forth in 1.18(f) and the fee set forth in 1.18(e) or only the fee set forth in 1.18(f)?

Both fees. Even an application for term adjustment that is only requesting reinstatement of part of a period of adjustment by showing, in spite of all due care, that the applicant was unable to respond to any rejection, objection, argument or any other request made by the Office within a three-month period starting the date of mailing of the Office action or requirement, is required to pay the fee for an application for term adjustment set forth in 1.18(e) as well as the fee for a due care showing set forth in 1.18(f). In other words, an application under 37 CFR 1.705(c) is also required to comply with 37 CFR 1.705(b).

B4. When must an application be filed in order for the National Stage of an International Application to be eligible for Patent Term Adjustment (PTA)?

The international application must have an international filing date of May 29, 2000 or later. The date on which the international application either complies with 35 USC 371(c) or enters the National Stage is not relevant for determining eligibility for PTA. See section 4405(a) of the AIPA, 35 USC §363, and 37 CFR §1.702(f).

B5. If an International Application is filed before May 29, 2000 and is pending on or after May 29, 2000, may a continuing application filed under 35 USC 111(a) be filed on or after May 29, 2000, to seek the benefit of Patent Term Adjustment (PTA)?

Yes, the filing date of the continuing application controls, thus, if the continuing application is filed on or after May 29, 2000, the continuing application is eligible for PTA. See section 4405(a) of the AIPA, 35 USC §§111(a) and 120, and 37 CFR §1.702(f).

B6. 37 CFR 1.704(c)(10) provides that submission of an amendment under 37 CFR 1.312 or other paper after a notice of allowance has been mailed is a circumstance that constitutes a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application. Are formal drawings an “other paper” within the meaning of 37 CFR 1.704(c)(10), such that the submission of formal drawings after a notice of allowance is mailed will result in reduction of any patent term adjustment? What if the drawings are required by the notice of allowance?

Yes (regardless of whether formal drawings are required by the notice of allowance). 37 CFR 1.85 no longer permits applicants to request that a requirement for correction of drawings be held in abeyance until a notice of allowance is mailed. See Changes to Implement Eighteen-Month Publication of Patent Applications, Final rule, 65 Fed. Reg.
C. Eighteen-Month Publication

C1. Is there any information on the United States Patent and Trademark Office Web site regarding automation plans related to Pre-Grant Publication of Applications?

Yes, please see the Pre-Grant Publication Global Concept of Operations document, posted on the AIPA web page, under the heading “Presentations.”

C2. Will Divisionals, Continuations-in-Part, and/or Continuations based on original applications filed before the critical date be subject to the mandatory publication?

Yes. Any nonprovisional application (other than for a design patent) filed on or after November 29, 2000 is subject to the eighteen-month publication provisions of the AIPA. This includes continuation, divisional, and continuation-in-part applications of applications filed prior to November 29, 2000. It does not matter whether the continuing application was filed under 37 CFR 1.53(b), or as a continued prosecution application (CPA) under 37 CFR 1.53(d). Since a request for continued examination under 35 U.S.C. 132(b) and 37 CFR 1.114 is not a continuing application, filing a request for continued examination of an application filed prior to November 29, 2000 will not make that application subject to the eighteen-month publication provisions of the AIPA.

C3. Where can I find the form of the declaration under Subtitle E of the American Inventors Protection Act of 1999 that no foreign filing is planned for the invention described in a new application?

The form is not yet available, but it is under development. As soon as it is ready it will be made available on the PTO Web site.

C4. Does the American Inventors Protection Act of 1999 address the issue of royalty payments by companies who knowingly violate an invention claimed in a published patent application for infringement that occurs before the patent grant date?

The American Inventors Protection Act of 1999 (AIPA) does indeed address this issue. In the AIPA, Subtitle E - Domestic Publication of Patent Applications Published Abroad, Section 4504 on Provisional Rights addresses this very issue. By the terms of the AIPA, an eventual patentee will be able to obtain a reasonable royalty from any person, having actual notice, who “infringes” the claimed invention during the period beginning on the date of publication of the application and ending on the date the patent is issued. The right to recover a reasonable royalty is based upon actual notice and is only available if the invention as claimed in the patent is substantially identical to the invention as claimed in the published patent application.
C5. Does the Office intend to provide guidance as to the meaning of the term “substantially identical” as used in AIPA §4504 to define when reasonable royalties will be available (35 U.S.C. 154(d)(2))?  

No, because the PTO is not charged with administering provisional rights.

C6. Can an examiner reject a claim in an application being examined under 35 USC 135(b)(2) as being statutorily barred by the publication of another application?  

Yes. Applicants have one year from the publication date of a published application to present the same or substantially the same claim as a claim in a published application. When the claim is, however, presented later than one year after the publication date, a rejection under 35 USC 135(b)(2) is proper. Thus, a rejection under §135(b)(2) should be made when:

1. The effective filing date of the claim in an application being examined is later than the publication date of the published application;

2. The application being examined is claiming the same invention as claimed in the application publication, i.e., the claim in the application being examined is the same as, or for the same or substantially the same subject matter as, the published claim in the application publication; and

3. The presentation of the claim in the application being examined is later than one year after the publication date of the published application.

Note:

1. A rejection under 35 USC 102(a) and 102(e) should also be made, since the effective filing date of the claim in the application being examined is later than the publication date of the published application.

2. The published application could be a U.S. patent application or an international application designating the United States.

C7. Patents filed after 1½9/00 will be published by the USPTO 18 months after the filing unless the applicant requests an earlier publication or the applicant requests that the application not be published. The patent rights allow for a reasonable royalty from the date of publication to the date of issuance.

1. Can I request that my application be published even though I filed before 1½9/00?

2. If so, can I request immediate publication or must I wait until 1½9/00?

Initially, the right to reasonable royalties is subject to a number of conditions: e.g., (1) actual notice of the published application must be given; and (2) the patent claims must be substantially identical to the claims in the published application. In answer to your
questions: (1) Yes, provided that the application is pending on November 29, 2000 and your request complies with applicable USPTO regulations (proposed 37 CFR 1.211); and (2) You must wait until November 29, 2000 to make such a request (the statutory provisions and implementing regulations will not take effect until November 29, 2000).

C8. Is there a mechanism by which the USPTO intends to assess whether or not any foreign filings have been made contrary to the certification provided by the applicant under 35 USC 22(b)(2)(B)(i), and whether or not the notice requirements of section 122(b)(2)(iii) have subsequently been met?

The Office does not have any current plans to routinely monitor compliance with either the certification or notice requirements of 35 USC 122(b)(2). Applicants are advised that the Office’s failure to note that an application has gone abandoned as a matter of law for failing to provide the proper notice has no effect on the abandoned status of the application (will not operate to prevent the abandonment of the application), regardless of any indication of allowability from the Office.

Also, is there a mechanism by which the USPTO intends to provide notice to applicants that their patent applications have been “regarded as abandoned” for having failed to provide notice of any foreign filings within 45 days thereof, as required by section 122(b)(2)(iii)?

The Office does not have any current plans to routinely provide notice to applicant that their patent applications have been “regarded as abandoned.” Should the examiner become aware of the foreign filing, e.g., during the prior art search, the examiner does have the authority to formally hold the application abandoned.

C9. Will references in a submission under 37 CFR §1.99 be placed in the application file and forwarded to the examiner if the submissions includes explanation or references that are highlighted?

Section 1.99 provides that a submission by a member of the public of patents or publications relevant to a pending published application will be entered in the application file if the submission complies with the requirements of §1.99 and the application is still pending when the submission and application file are brought before the examiner. Section 1.99(d) provides that a submission under §1.99 may not include any explanation of the references, or any other information. The Office will dispose of any explanation or information if included in a submission under §1.99. To ensure that there is no protest, the Office will review submissions under §1.99 to determine whether they are limited to patents and publications before the submission is placed in the file of the application and forwarded to the examiner. The submission under §1.99 will not be placed in the file of the application, if the explanation of the references and any other information included in the submission are integrated in the references and cannot be extracted easily, or if the references are highlighted.
C10. If I file a PCT application designating the U.S. and then before International Bureau publishes the PCT application I abandon the application, may I submit a non-publication request under 37 CFR 1.213 with a filing of a U.S. application under 35 USC 111, that discloses the same subject matter as disclosed in the PCT application?

No, the mere filing of the PCT application precludes the proper use of a non-publication request, since the invention disclosed in the US application was the subject of an application that was filed under an international agreement requiring publication at 18 months (the PCT). 35 USC 122(b)(2)(B)(i) states that “If an applicant makes a request upon filing, certifying that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing, . . .”

The trigger in the statute is not the publication, but rather the trigger is the act of filing in a foreign country that requires publication, or under international agreement that requires publication. Thus 37 CFR 1.213(a)(3) is consistent with the statutory requirement. The statute simply does not allow for abandonment of the foreign application, or application under a multilateral international agreement, prior to foreign publication at 18 months in order to provide for an appropriate request for non-publication in the US application.

D. 102(e)

D1. If an International Application (IA) was published by the International Bureau (IB) in language other than English (i.e., German) and designates the United States, is there any action that can be done (i.e., filing a translation or getting it republished in English) to make the published IA eligible to be prior art under amended 35 U.S.C. 102(e)(1)?

Assuming the new §102(e)(1), as amended by AIPA, is applicable to the IA, 35 U.S.C. 102(e)(1) clearly states that an IA only receives a 102(e)(1) date if the IA is published under PCT Article 21(2)(a) in English and designates the United States. Therefore, the IA must be published by the International Bureau pursuant to PCT Article 21(2)(a) (normal 18 month publication) in English and must designate the United States in order to be prior art under 35 U.S.C. 102(e)(1). Any filing of a translation or later publication in English will not be effective in obtaining a 102(e)(1) date for the IA published by the IB in a language other than English.

E. 103(c)

E1. Does a Continued Prosecution Application qualify for the new provisions of 35 U.S.C. 103(c) as specified in Section 4807 of the American Inventors Protection Act?

Yes, see Guidelines Concerning the Implementation of Changes to 35 U.S.C. 102(g) and 103(c) and the Interpretation of the Term “Original Application” in the American Inventors Protection Act of 1999, Notice, 1233 Off. Gaz. Pat. Office 2 (April 11, 2000).
E2. Q & A: Under the amended 35 U.S.C. 103(c), what type of evidence will provide proof that the inventions were commonly owned by, or subject to an obligation of assignment to, the same person, at the time the invention was made?

To disqualify a reference under 35 U.S.C. 103(c), applicant needs to supply evidence that the invention described in the application for patent and the invention described in the “prior art” reference applied against the application were commonly owed by, or subject to an obligation of assignment to, the same person, at the time the invention was made.

The time requirement “at the time the invention was made” is required by statute. See 35 U.S.C. 103(c). The assignment records kept by the USPTO do not supply the necessary evidence for the time requirement nor are such records required to have such timing information. Therefore, the following evidence is sufficient to provide proof of common ownership by, or subject to an obligation of assignment to, the same person at the time the invention was made:

For recorded assignments, applicant provides:

1. a statement of the location of the assignments recorded in the USPTO in accordance with 37 CFR 3.11 which convey the entire rights in the application and the reference to the same person(s) or organization(s),

2. and a statement from applicant(s) or their registered practitioner that the application for patent and the “prior art” reference applied against the application were commonly owed by, or subject to an obligation of assignment to, the same person, at the time the invention was made; or

For unrecorded assignments, applicant provides:

1. copies of unrecorded assignments which convey the entire rights in the application and the reference to the same person(s) or organization(s), and

2. a statement from applicant(s) or their registered practitioner that the application for patent and the “prior art” reference applied against the application were commonly owed by, or subject to an obligation of assignment to, the same person, at the time the invention was made; or

Applicant provides an affidavit or declaration by the common owner stating:

1. there was common ownership by, or an obligation of assignment to, the same person for the application and the “prior art” reference at the time the invention was made, and

2. why the affiant believes there was common ownership; or
3. applicant provides other evidence that established common ownership by, or an obligation of assignment to, the same person for the application and the “prior art” reference at the time the invention was made, e.g., a court decision determining the owner.

In circumstances where the common owner is a corporation or other organization, an affidavit or declaration averring ownership may be signed by an official of the corporation or organization empowered to act on behalf of the corporation or organization.

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