Notice of Proposed Rule Making

Changes to Practice for the Examination of Claims in Patent Applications


Los Angeles Intellectual Property Law Association

“Washington and the West” Conference

January 25, 2006
Objectives of Proposed Changes
Claims NPR

- Better, more thorough, and reliable examination quality through focused initial patentability examination of a limited number of representative claims, which are selected by applicant.
- Applicant may have more (representative) claims receive an initial patentability examination, provided applicant submits support for patentability.
- All claims (including all other claims) will be (continue to be) examined before allowance.
Highlights of Proposed Changes
Claims NPR

- Only **representative claims** will be **initially** examined.
  - Representative claims are all of the **independent** claims in an application, and only those **dependent** claims that are **expressly** designated by the **applicant** for **initial** examination.

- **Up to 10 representative claims** will get an **initial** examination.

- If applicant submits more than 10 independent claims, or designates additional dependent claims so there are more than 10 representative claims to be initially examined, the Office will require the applicant to submit an **examination support document**, or take other appropriate action.
Highlights of Proposed Changes (cont.)
Claims NPR

Actions that an applicant may take to avoid submission of an Examination Support Document

A. Cancel any extra (over 10) independent claims;
B. Rescind designation of enough dependent claims so total of representative claims is 10 or less; or
C. Submit a proposed restriction requirement, with an election w/o traverse of an invention to which there are drawn 10 or fewer representative claims.

Note: Refunds may be given for claims cancelled before examination.
Highlights of Proposed Changes (cont.)

Claims NPR

- Examination Support Document will require: a pre-examination search, an IDS, identification of limitations shown by cited references, a patentability statement, a utility statement, and a showing of how limitations are supported by disclosure.

- Dependent claims that are not designated for initial examination will get a deferred examination after the initial examination yields allowable representative claims.

- Patentably indistinct claims in certain related applications will be collectively considered as being in one application.

- Some dependent claims, which are effectively independent claims, will be treated as independent claims.
Claims NPR
If Proposed Changes are Adopted

- 10 representative claims initially examined,
  - all independent claims, or combination of all independent and designated dependent claims.

- Exceptional cases (more than 10 claims presented for initial examination)
  - can only have more than 10 claims initially examined by submission of an examination support document.
When is an examination support document required?

- An examination support document is only needed in cases where more than 10 representative claims are presented, a) either as more than 10 independent claims, or b) more than 10 claims as a combination of all independent claims and designated dependent claims.

Proposed 37 CFR 1.261 (new) sets forth the requirements of an Examination Support Document.
Claims NPR
If Proposed Changes are Adopted

How submission of an examination support document can be avoided:
A. Cancel any extra (over 10) independent claims;
B. Rescind designation of enough dependent claims so total of representative claims is 10 or less; or
C. Submit a proposed restriction requirement, with an election w/o traverse of an invention to which there are drawn 10 or fewer representative claims.
Claims NPR
Rules Proposed to be Changed or Added in 37 CFR

- § 1.75(b) and (c) Claim(s)
- § 1.104(a)(1), (b), and (c)(1) Nature of examination
- § 1.105(a)(1)(ix) Requirements for information
- § 1.117 (new) Refund due to cancellation of claim
- § 1.261 (new) Examination support document
- § 1.704 (c)(11) and (c)(12) Reduction of period of adjustment of patent term
Proposed Changes to 37 CFR 1.75(b)

Designation of dependent claims

- Proposed 1.75(b)* provides that:
  - Unless a dependent claim has been designated for initial examination prior to the application being taken up for examination, the examination of such dependent claim may be held in abeyance until the application is otherwise in condition for allowance. See also proposed § 1.104(b).
    - This differs from the current practice where ALL claims (independent and dependent) receive initial examination
  - The mere presentation of a dependent claim in an application is not a designation of the dependent claim for initial examination.

* See preamble to proposed § 1.75(b).
Proposed Changes to 37 CFR 1.75(b)

Designation of dependent claims

- Failure to designate any dependent claim(s):
  - If applicant fails to designate any dependent claim for initial examination, the Office will initially examine only the independent claims.

- Express designation of dependent claims required:
  - Applicant must expressly designate which (if any) dependent claims are to be given initial examination, even if there are 10 or fewer total (independent and dependent) claims in the application. See preamble to § 1.75(b).
Proposed Changes to 37 CFR 1.75(b)

Designation of dependent claims

- **Example**: Application has 3 independent claims and 17 dependent claims. Applicant does not expressly designate any dependent claims for initial examination.
  
The Office will only give initial examination to the 3 independent claims.

- **Example**: Application has 1 independent claim and 9 dependent claims. Applicant does not expressly designate any dependent claims for initial examination.
  
Even though there are only 10 total claims in the application, the Office will only give an initial examination to the 1 independent claim in the absence of any express designation of the dependent claims.

- Applicant may designate one or more dependent claims for initial examination in:
  
  - (1) the transmittal letter, or in (2) a separate paper.
Proposed Changes to 37 CFR 1.75(b)(1)

Examination support document requirement

- Applicant must submit an examination support document in compliance with § 1.261 (proposed new) that covers each representative claim if either:
  - The application contains, or is amended to contain, more than 10 independent claims; or
  - The number of representative claims (the independent claims, and the dependent claims expressly designated for initial examination) is greater than 10.

- **Example:** Application contains 3 independent claims and a total of 20 claims.
  
  Applicant may designate up to 7 dependent claims for initial examination without filing an examination support document.
A dependent claim designated for initial examination must depend only from a claim or claims that are also so designated.

- **Example:** If dependent claim 3 depends upon dependent claim 2, which in turn depends upon independent claim 1, applicant cannot designate claim 3 for initial examination without also so designating claim 2.

- **Example:** If multiple dependent claim 4 depends (in the alternative) upon dependent claim 3 and dependent claim 2, and claim 3 and claim 2 each depend upon independent claim 1, the applicant cannot designate claim 4 for initial examination without also so designating claim 3 and claim 2.
  - Thus, the total number of claims designated for examination as representative claims, in this example, is five (5): Claims 1, 2, 3, 4/2, and 4/3.
  - Multiple dependent claims are also discussed with respect to changes to 37 CFR 1.75(c).

See proposed § 1.75(b)(1).
Proposed Changes to 37 CFR 1.75(b)(2)

Claims treated as independent claims

- A claim that refers to a claim of a different statutory class of invention will be treated as an independent claim for fee calculation purposes under § 1.16 (or § 1.492), and as a representative claim per proposed § 1.75(b)(1).

3 Examples:
- Claim 44. The product of the process of claim 1.
- Claim 6. A method for unloading...material from the opened end of a reactor tube which comprises utilizing the nozzle of claim 1.
- Claim 14. A method of treating states of agitation in a warm blooded animal which comprises administering to said animal a therapeutically effective amount of a compound according to claim 7.

See proposed § 1.75(b)(2).
Proposed Changes to 37 CFR 1.75(b)(2)

*Claims treated as independent claims*

- A claim that refers to another claim but does not incorporate by reference all of the limitations of the claim to which such claim refers will be treated as an *independent claim* for fee calculation purposes under § 1.16 (or § 1.492), and as a representative claim per proposed § 1.75(b)(1).
Proposed Changes to 37 CFR 1.75(b)(3)

Notice regarding excess representative claims

- Applicant will be notified if an application contains, or is amended to contain,
  - more than 10 independent claims,
  - or the number of independent claims plus the number of dependent claims designated for initial examination is greater than 10, and
    where an examination support document has inadvertently been omitted.

- The time period for reply is one month, which is not extendable under 1.136(a)
  - Failure to reply will result in abandonment of the application.
Proposed Changes to 37 CFR 1.75(b)(3)  
Notice regarding excess representative claims (cont.)

**Example:** 5 independent claims presented and applicant also designates 7 dependent claims for examination and fails to provide an examination support document.

Applicant will be notified that he/she must either:

1. submit an examination support document in compliance with §1.261,
2. cancel the requisite number of independent claims and/or rescind the designation for initial examination of the requisite number of dependent claims so that 10 or fewer claims are designated for examination, or
3. submit a suggested requirement for restriction accompanied by an election without traverse as per §1.75(b)(3).
Proposed Changes to 37 CFR 1.75(b)(3)

Notice regarding excess representative claims (cont.)

Example: An application as filed contains 11 independent claims and a total of 20 claims. Applicant designates 10 independent claims for initial examination. An examination support document is inadvertently omitted.

- Since the application contains more than 10 independent claims, applicant will be notified that the application contains more than 10 independent claims and that applicant must either: (1) submit an examination support document in compliance with § 1.261, (2) cancel the requisite number of independent claims that necessitate an examination support document, or (3) submit a suggested requirement for restriction accompanied by an election without traverse as per § 1.75(b)(3).
Proposed Changes to 37 CFR 1.75(b)(4)

Treatment of patentably indistinct claims between separate applications

- The Office may require elimination of patentably indistinct claims from all but one of an applicant’s nonprovisional applications:
  - if each application includes at least one claim that is patentably indistinct from at least one claim of the other application, and
  - if the applications are commonly owned, and
  - if there is 112, ¶ 1 support of the at least one indistinct claim in the earliest filed application. See proposed § 1.75(b)(4).
Where patentably indistinct claims remain in multiple applications,

- the Office will treat the independent claims and the dependent claims designated for initial examination
  - in the first nonprovisional application,
  - and in each of the other nonprovisional applications or patents as present in each of the nonprovisional applications
  - for purposes of determining whether an examination support document is required under § 1.75(b)(1).

- See proposed § 1.75(b)(4).
Proposed Changes in Related NPR

Treatment of patentably indistinct claims between separate applications (cont.)

- Note related proposed changes to 37 CFR 1.78(f) (identification and rebuttable presumption of patentably indistinct claims) in related notice of proposed rule making (NPR):

Proposed Changes in Related NPR

Treatment of patentably indistinct claims between separate applications (cont.)

- Proposed Changes to 37 CFR 1.78(f)(3)
  Applications Containing Patentably Indistinct Claims

  - Even if terminal disclaimers are submitted to overcome the presumption of patentably indistinct claims
    - In the absence of good and sufficient reason for there being multiple pending nonprovisional applications* which contain patentably indistinct claims, the Office may require elimination of the patentably indistinct claims from all but one of the applications.

*Naming at least one inventor in common and owned by the same person, or subject to an obligation of assignment to the same person.
Proposed Changes to 37 CFR 1.75(b)(4)

Treatment of patentably indistinct claims between separate applications (cont.)

Example: Three nonprovisional applications are filed with a common inventor and common assignee. Each application has 1 independent claim and 4 dependent claims and thus has a total of 5 claims. In each of the applications, applicant expressly designated the 4 dependent claims for initial examination. An examination support document was not submitted in any of the applications. At least one claim in each application is patentably indistinct from at least one claim in each of the other two applications. The patentably indistinct claims have support under 35 U.S.C. 112, first paragraph in the earliest of the three applications.

- Applicant would be notified that each application contains more than 10 claims designated for initial examination, due to the presence of patentably indistinct claims in each of the three application and an examination support document has been omitted.
- Because the Office treats each application as having 15 claims present, applicant would need to cancel the requisite number of claims or submit an examination support document in compliance with § 1.261.
Restriction Practice  
*If Claims Rule Package is Adopted*

- Any issues associated with more than 10 representative claims will be resolved* prior to forwarding the application to the Examiner for initial examination. Then, the examiner would consider all representative claims and if a restriction is appropriate.
  - Any restriction requirement, however, would be based on all the claims pending in the application.
- If restriction requirement is made, and applicant’s election results in one or more representative claims being withdrawn from consideration, applicant may designate additional representative claims for initial examination drawn to the elected invention
  - The total number of claims, however, cannot exceed 10, unless an examination support document is submitted.

*See slides 4, 5, 18, 19 and 20.
The Office is requesting comments on how claims written in the alternative form, such as claims in alternative form permitted by *Ex parte Markush*, 1925 Dec. Comm’r Pat. 126 (1924), should be counted for purposes of § 1.75(b)(1).

The Office is particularly interested in answers to the following questions:

- Should the Office count each alternative in the claim as a separate claim for purposes of § 1.75(b)(1)?
- Should the Office count each alternative in the claim as a separate claim for purposes of § 1.75(b)(1) unless the applicant shows that each alternative in the claim includes a common core structure and common core property or activity, in which the common core structure constitutes a structurally distinctive portion in view of existing prior art and is essential to the common property or activity?
Elements of examination support document:

1. Preexamination search was conducted, including search strategy, scope and content of search;
2. Submission of Information Disclosure Statement listing most relevant documents from preexamination search;
3. Identification of limitations of independent claims and designated dependent claims disclosed in the references;
4. Explanation, with particularity, of how claims under examination are patentable over references cited;
5. Concise statement of utility of invention as presented in independent claims; and
6. Showing where the claims under examination find support according to 35 USC 112, ¶ 1 in the written description.

See proposed 37 CFR 1.261(a) (new).
Proposed 37 CFR 1.261(b)

*Pre-examination search*

- The pre-examination search must involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature,
  - **unless** the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated source and includes such a justification with the statement required by § 1.261(a)(1).
Proposed 37 CFR 1.261(b)

Pre-examination search

- The pre-examination search must encompass all of the features of the independent claims and must cover all of the features of the designated dependent claims separately from the claim or claims from which the dependent claim depends, giving the claims the broadest reasonable interpretation.

- The pre-examination search must also encompass any disclosed features that may be claimed.
Proposed 37 CFR 1.261(c)
Corrected or supplemental document

- Applicant will be notified and given a one-month time period within which to file a corrected or supplemental examination support document to avoid abandonment if, for example:
  1. The examination support document or preexamination search is deemed insufficient;
  2. An explanation of the invention or how the independent and designated dependent claims define the invention is deemed necessary; or
  3. The claims have been amended such that the examination support document no longer covers each independent claim.
- The one-month time period is not extendable under § 1.136(a).
If an amendment canceling a claim is submitted in reply to a notice under § 1.75(b)(3) and prior to the first examination on the merits of the application, the applicant may request a refund of any fee paid on or after December 8, 2004, for such claim under § 1.16(h), (i), or (j) or under § 1.492(d), (e), or (f). See § 1.117(a).
Refunds of excess claim fee(s) are available where a timely declaration of express abandonment under § 1.138(d) is filed in the application (e.g., before the application has been taken up for examination). See § 1.117(b).
Proposed 37 CFR 1.117

Refund provisions

- A two month window exists for requesting a refund under § 1.117 for cancelled claims. See § 1.117(c).

- The availability of refunds after September 30, 2006, is dependent upon future legislation.
The failure to file an examination support document in compliance with § 1.261 when necessary under § 1.75(b) is a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application under 35 U.S.C. 154(b)(2)(C).
Proposed 37 CFR 1.704(c)(11)

Patent term adjustment

- The period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any,
  - beginning on the day after the date that is the later of the filing date of the amendment necessitating an examination support document in compliance with § 1.261, or four months from the filing date of the application in an application under 35 U.S.C. 111(a) or from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in an application which entered the national stage from an international application after compliance with 35 U.S.C. 371, and
  - ending on the date that either an examination support document in compliance with § 1.261, an amendment, or a suggested restriction requirement and election that obviates the need for an examination support document, was filed.
Proposed Changes

Effective date provision

- The proposed changes to § 1.75 would be applicable to any application filed on or after the effective date of the final rule, as well as to any application in which a first Office action on the merits was not mailed before the effective date of the final rule.

- The Office will provide applicants who filed their applications before the effective date of the final rule and who would be affected by the changes in the final rule with an opportunity to designate dependent claims for initial examination, and to submit either an examination support document or a new set of claims to avoid the need for an examination support document.
The Office is also requesting suggestions for ways in which the Office can make the changes in the final rule applicable to pending applications filed before the effective date of the final rule with a minimum of inconvenience to applicants.
More Information

- Additional information is posted on the USPTO’s Internet Web site at: http://www.uspto.gov

- 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 Clarke 571-272-7735
  - Elizabeth Dougherty 571-272-7733
  - Eugenia Jones 571-272-7727
  - Mary Till 571-272-7755
Appendix – Proposed Rules
37 CFR 1.75(b)(1)

§ 1.75 Claim(s)

(b) More than one claim may be presented provided they differ substantially from each other and are not unduly multiplied. One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application. Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim. Unless a dependent claim has been designated for initial examination prior to when the application has been taken up for examination, the examination of such dependent claim may be held in abeyance until the application is otherwise in condition for allowance. The mere presentation of a dependent claim in an application is not a designation of the dependent claim for initial examination.

(1) An applicant must submit an examination support document in compliance with § 1.261 that covers each independent claim and each dependent claim designated for initial examination if either:

(i) The application contains or is amended to contain more than ten independent claims; or
(ii) The number of independent claims plus the number of dependent claims designated for initial examination is greater than ten. A dependent claim (including a multiple dependent claim) designated for initial examination must depend only from a claim or claims that are also designated for initial examination.
§ 1.75 Claim(s)

(b) * * *

(2) A claim that refers to another claim but does not incorporate by reference all of the limitations of the claim to which such claim refers will be treated as an independent claim for fee calculation purposes under § 1.16 (or § 1.492) and for purposes of paragraph (b)(1) of this section. A claim that refers to a claim of a different statutory class of invention will also be treated as an independent claim for fee calculation purposes under § 1.16 (or § 1.492) and for purposes of paragraph (b)(1) of this section.
§ 1.75 Claim(s)

(b) * * *

(3) The applicant will be notified if an application contains or is amended to contain more than ten independent claims, or the number of independent claims plus the number of dependent claims designated for initial examination in such an application is greater than ten, but an examination support document under § 1.261 has been omitted. If prosecution of the application is not closed and it appears that omission was inadvertent, the notice will set a one-month time period that is not extendable under § 1.136(a) within which, to avoid abandonment of the application, the applicant must:

(i) File an examination support document in compliance with § 1.261 that covers each independent claim and each dependent claim designated for initial examination;

(ii) Cancel the requisite number of independent claims and rescind the designation for initial examination of the requisite number of dependent claims that necessitate an examination support document under § 1.261; or

(iii) Submit a suggested requirement for restriction accompanied by an election without traverse of an invention to which there are drawn no more than ten independent claims as well as no more than ten total independent claims and dependent claims designated for initial examination.
§ 1.75 Claim(s)

(b) * * *

(4) If a nonprovisional application contains at least one claim that is patentably indistinct from at least one claim in one or more other nonprovisional applications or patents, and if such one or more other nonprovisional applications or patents and the first nonprovisional application are owned by the same person, or are subject to an obligation of assignment to the same person, and if such patentably indistinct claim has support under the first paragraph of 35 U.S.C. 112 in the earliest of such one or more other nonprovisional applications or patents, the Office may require elimination of the patentably indistinct claims from all but one of the nonprovisional applications. If the patentably indistinct claims are not eliminated from all but one of the nonprovisional applications, the Office will treat the independent claims and the dependent claims designated for initial examination in the first nonprovisional application and in each of such other nonprovisional applications or patents as present in each of the nonprovisional applications for purposes of paragraph (b)(1) of this section.
§ 1.75 Claim(s)

(c) Any dependent claim which refers to more than one other claim (“multiple dependent claim”) shall refer to such other claims in the alternative only. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. For fee calculation purposes under § 1.16 (or § 1.492) and for purposes of paragraph (b)(1) of this section, a multiple dependent claim will be considered to be that number of claims to which direct reference is made therein. For fee calculation purposes under § 1.16 (or § 1.492) and for purposes of paragraph (b)(1) of this section, any claim depending from a multiple dependent claim will be considered to be that number of claims to which direct reference is made in that multiple dependent claim. In addition to the other filing fees, any original application which is filed with, or is amended to include, multiple dependent claims must have paid therein the fee set forth in § 1.16(j). A multiple dependent claim shall be construed to incorporate by reference all the limitations of each of the particular claims in relation to which it is being considered.
§ 1.104 Nature of examination.
(a) Examiner’s action.
(1) On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the invention as claimed in the independent and the designated dependent claims. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed in the independent and the designated dependent claims, as well as with respect to matters of form, unless otherwise indicated.

* * * * *

(b) Completeness of examiner’s action. The examiner’s action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable. The examination of a dependent claim that has not been designated for initial examination may be held in abeyance until the application is otherwise in condition for allowance.

(c) Rejection of claims.
(1) If the invention claimed in the independent and designated dependent claims is not considered patentable, the independent and the designated dependent claims, or those considered unpatentable, will be rejected.

January 25, 2006
§ 1.105 Requirements for information.

(a)(1) * * *

(ix) Support in the specification: Where (by page or paragraph and line) the specification of the application, or any application the benefit of whose filing date is sought under title 35, United States Code, provides written description support for the invention as defined in the claims (independent or dependent), and of manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention, under the first paragraph of 35 U.S.C. 112.
§ 1.117 Refund due to cancellation of claim.

(a) If an amendment canceling a claim is submitted in reply to a notice under § 1.75(b)(3) and prior to the first examination on the merits of the application, the applicant may request a refund of any fee paid on or after December 8, 2004, for such claim under § 1.16(h), (i), or (j) or under § 1.492(d), (e), or (f).

(b) A claim in an application filed under 35 U.S.C. 111(a) will also be considered canceled for purposes of this section if a declaration of express abandonment under § 1.138(d) has been filed in an application containing such claim in sufficient time to permit the appropriate officials to recognize the abandonment and remove the application from the files for examination before the application has been taken up for examination.

(c) Any request for refund under this section must be filed within two months from the date on which the claim was canceled. This two-month period is not extendable.
Appendix – Proposed Rules
37 CFR 1.261

§ 1.261 Examination support document.
(a) An examination support document as used in this part means a document that includes the following:
(1) A statement that a preexamination search was conducted, including an identification of the field of
search by United States class and subclass and the date of the search, where applicable, and, for database
searches, the search logic or chemical structure or sequence used as a query, the name of the file or files
searched and the database service, and the date of the search;
(2) An information disclosure statement in compliance with § 1.98 citing the reference or references
deemed most closely related to the subject matter of each of the independent claims and designated
dependent claims;
(3) For each reference cited, an identification of all the limitations of the independent claims and
designated dependent claims that are disclosed by the reference;
(4) A detailed explanation of how each of the independent claims and designated dependent claims are
patentable over the references cited with the particularity required by § 1.111(b) and (c);
(5) A concise statement of the utility of the invention as defined in each of the independent claims; and
(6) A showing of where each limitation of the independent claims and the designated dependent claims
finds support under the first paragraph of 35 U.S.C. 112 in the written description of the specification. If
the application claims the benefit of one or more applications under title 35, United States Code, the
showing must also include where each limitation of the independent claims and the designated dependent
claims finds support under the first paragraph of 35 U.S.C. 112 in each such application in which such
support exists.

January 25, 2006
§ 1.261 Examination support document.

(b) The preexamination search referred to in paragraph (a)(1) of this section must involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated source and includes such a justification with the statement required by paragraph (a)(1) of this section. The preexamination search referred to in paragraph (a)(1) of this section must be directed to the claimed invention and encompass all of the features of the independent claims and must cover all of the features of the designated dependent claims separately from the claim or claims from which the dependent claim depends, giving the claims the broadest reasonable interpretation. The preexamination search referred to in paragraph (a)(1) of this section must also encompass the disclosed features that may be claimed.

(c) If the examination support document or pre-examination search is deemed to be insufficient, an explanation of the invention or how the independent and designated dependent claims define the invention is deemed necessary, or the claims have been amended such that the examination support document no longer covers each independent claim and each designated dependent claim, and an examination support document is required, applicant will be notified and given a one-month time period within which to file a corrected or supplemental examination support document to avoid abandonment. This one-month period is not extendable under § 1.136(a).
§ 1.704 Reduction of period of adjustment of patent term.

(c) * * * *

(11) Failure to file an examination support document in compliance with § 1.261 when necessary under § 1.75(b), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is the later of the filing date of the amendment necessitating an examination support document under § 1.261, or four months from the filing date of the application in an application under 35 U.S.C. 111(a) or from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in an application which entered the national stage from an international application after compliance with 35 U.S.C. 371, and ending on the date that either an examination support document in compliance with § 1.261, or an amendment or suggested restriction requirement and election (§ 1.75(b)(3)(iii)) that obviates the need for an examination support document under § 1.261, was filed;