

Friday Seminar Series

July 30, 2010

Petition Practice Before the
USPTO

PETITION PRACTICE BEFORE THE US PTO

- What is a Petition
- What is an Appeal

Scope

- Under 37 CFR 1.182, a petition may be taken to the Commissioner in all cases not specifically provided for in the regulations and such petitions will be decided in accordance with the merits of each case by or under the authority of the Commissioner.

Scope (cont'd)

- Under 37 CFR 1.183, a petition may be taken to the Commissioner to suspend or waive any requirement of the regulations which is not a requirement of the statutes.

Scope (cont'd)

- 37 CFR 1.181(g) provides the basis for the delegation of authority to various patent officials to decide these petitions for the Commissioner.

Requirements of a Petition

- In general, each petition has five requirements. These requirements are as follows:
 - A. The petition must be in writing, 37 CFR 1.2.
 - B. The petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested, 37 CFR 1.181(b).

Requirements of a Petition (cont'd)

- C. Some petitions require a fee, 37 CFR 1.181(d).
- D. The petition must be timely filed, as required in 37 CFR 1.181(f), or as required in a specific statute or regulation.
- E. The petition must comply with any special requirements as provided by statute, regulation or Office policy.

Requirements of a Petition

- **A. In Writing**
- All business with the Office is transacted in writing. It is recommended that anyone preparing to submit a petition, review Chapter 1000 of the MPEP to determine the official who will be deciding the petition.

Requirements of a Petition

- **B. Statement of Facts**
- The petition must contain a statement of the facts involved and the point or points to be reviewed and the action or relief requested.

Requirements of a Petition (cont'd)

- If the petition is urging error in a requirement or action by an examiner, the specific error alleged should be clearly set forth along with the reasons why the requirement or action is considered improper. The authorities, e.g., statute, regulation, notices, etc., relied upon should be clearly set forth. In situations where facts are to be proven, the proof in the form of declarations or affidavits should be presented with the petition. A complete statement of the relevant facts should also be presented.

Requirements of a Petition

- **C. Fee, Where Appropriate**
- Many petitions to the Commissioner require a fee before consideration of the merits will be given. 37 CFR 1.17(h), (i), (l), (m) and 37 CFR 1.20(b) should be reviewed to determine whether a fee is appropriate for the petition being filed.

Requirements of a Petition

■ D. Timeliness

- One very important point to keep in mind with regard to petitions is the necessity for filing petitions in a timely manner. Generally, a petition not filed within **two months** from the date of the action complained of may be dismissed as untimely. Further, the mere filing of a petition will not stay the period for replying to an examiner's action that may be running against an application or act as a stay of other proceedings, 37 CFR 1.181(f).

Requirements of a Petition

- **E. Special Requirements**
- Care should be taken to review the applicable statute, regulation or Office policy to determine if there are any other requirements that need to be met in submitting a petition.

Specific Types of Petitions

■ A. Petitions for Access

- Applications are ordinarily preserved in secrecy pursuant to 35 U.S.C. 122 and 37 CFR 1.14(a). However, certain abandoned applications are available without a petition. See 37 CFR 1.14(a)(1)(iv).

Specific Types of Petitions

- Furthermore, if a patent incorporates an application by reference, a copy of the application as filed may be obtained upon payment of the fee set forth in 37 CFR 1.19(b)(1) without notice to the applicant. In order for a member of the public to get access to, or copies of, any pending or abandoned applications preserved in secrecy pursuant to 35 U.S.C. 122 and 37 CFR 1.14(a), he or she must either file (1) a petition accompanied by the petition fee set forth in § 1.17(i); or (2) provide written authority for access from the applicant, assignee or attorney or agent of record. 37 CFR 1.14(e).

Specific Types of Petitions

- **A. Petitions For Access (cont'd)**
- Once an application is published, copies of file wrapper of application may be obtained without a petition
- Two other types of petitions involving access are (1) by an assignee to exclude the inventor from inspecting the file under 37 CFR 3.71 (see MPEP 106) and (2) by an inventor or assignee to identify an application where suspicion of filing an application exists.

Specific Types of Petitions

- **B. Petitions to Permit Filing When An Inventor Refuses to Sign or Cannot Be Reached**
- Where a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, a petition under 37 CFR 1.47(a) can be filed to permit acceptance of an application filed by the other inventor(s) on his or her behalf and that of the non-signing inventor. The submission must contain proof of the pertinent facts of the diligent efforts made, the required fee and the last known address of the non-signing inventor.

Specific Types of Petitions

- **C. Correction of Inventorship in Applications Filed under 37 CFR 1.53(b)**
- Where through error without deceptive intention the original oath or declaration of an application is filed naming incorrect inventor(s), applicant may petition under 37 CFR 1.48 for correction. The requirements of the petition are:

Specific Types of Petitions

■ C. Requirements of Petition (cont'd)

1. A statement of facts by each person being added as an inventor and from each person being deleted as an inventor that the error occurred without deceptive intention;
2. An oath or declaration under 37 CFR 1.63 executed by the correct inventors;
3. A petition fee; and
4. The written consent of any existing assignee of the originally named inventors supported by a 37 CFR 3.73(b) certification.

Specific Types of Petitions

- **D. Petitions to Obtain or Correct a Filing Date**
- 37 CFR 1.53 provides procedures for filing applications. Under § 1.53(b), an original, continuation, divisional or continuation-in-part (C-I-P) application may be filed. All applications filed under 37 CFR 1.53(b) require a specification, including at least one claim and drawings, if necessary to understand the claimed subject matter.

Petitions Relating to Abandoned Applications

E. Revival

- 37 CFR 1.137 covers petitions to revive applications abandoned for failure to prosecute, or failure to pay the required issue fee. There are two kinds of petitions to revive identified in this regulation. Section 1.137(a) concerns revival based upon an unavoidable delay in prosecution or payment of the required issue fee, whereas § 1.137(b) concerns revival based upon an unintentional delay in prosecution or payment of the required issue fee.

Petitions Relating to Abandoned Applications

E. Revival (cont'd)

(a) Unavoidable Delay

Requirements for a petition under 37 CFR 1.137(a) (delay was unavoidable):

- (1) Required reply, unless previously filed.
- (2) Petition fee set forth in 37 CFR 1.17(I).

Petitions Relating to Abandoned Applications

(a) Unavoidable Delay (cont'd)

- (3) Showing that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable.
- (4) Any terminal disclaimer under 37 CFR 1.321 (with fee; 37 CFR 1.20(d)) dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application if the application is a design application (regardless of filing date) or a utility or plant patent application filed before June 8, 1995.

Petitions Relating to Abandoned Applications

- (b) Requirements for a petition under 37 CFR 1.137(b) (delay was unintentional):
 - (1) Required reply, unless previously filed.
 - (2) Petition fee set forth in 37 CFR 1.17(m).
 - (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional. No showing of reasons for delay is necessary.
 - (4) Any terminal disclaimer under 37 CFR 1.321 (with fee; 37 CFR 1.20(d)) dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application if the application is a design application (regardless of filing date) or a utility application filed before June 8, 1995 or a plant patent application filed before June 8, 1995.

Withdrawal of Holding of Abandonment

- A petition to withdraw the holding of abandonment, if promptly filed, is appropriate in at least three circumstances. This type of petition does not require a petition fee.

Withdrawal of Holding of Abandonment

- a. The first and most common circumstance is where a reply and/or fee has been filed timely and received in the Office but not correlated with the application and the application has been erroneously held abandoned. The requirements for withdrawing the holding of abandonment are:
 1. Petition to withdraw the holding of abandonment under 37 CFR 1.181.
 2. Evidence of receipt of the reply and/or fee by the Office, such as a post card receipt.
 3. A copy of the earlier filed reply and/or fee.

Withdrawal of Holding of Abandonment

- b. Another situation in which a petition to withdraw the holding of abandonment is appropriate is that covered by 37 CFR 1.8(b). In this situation, a proper reply and/or fee has been timely sent to the Office accompanied by a certificate of mailing or facsimile transmission but is not received by the Office. The requirements for withdrawing the holding of abandonment are:
 1. Petition to withdraw the holding of abandonment under 37 CFR 1.8.
 2. An additional copy of the previously sent reply and/or fee with the certificate of mailing or facsimile transmission thereon.
 3. A statement attesting on a personal knowledge basis to the previous timely mailing or sending by facsimile transmission of the reply and/or fee. A copy of the sending unit's report confirming transmission may be used to support an assertion of earlier transmission by facsimile.

Withdrawal of Holding of Abandonment

- c. A third instance in which a petition to withdraw the holding of abandonment is appropriate is the situation which existed in *Delgar, Inc. et al. v. Schuyler*, 172 USPO 513 (D.D.C. 1971). An Office action or notice requiring reply is mailed by the Office but never received by the applicant or the registered practitioner. It is Office practice to ensure the mailing of all papers on the date indicated thereon, and there is a strong presumption that papers duly addressed and indicated as mailed are timely delivered to the addressee. Rebuttal of this presumption may result in the withdrawal of the holding of abandonment. The requirements for withdrawing the holding of abandonment are:

Withdrawal of Holding of Abandonment

- **1. For Practitioners**
- A. Petition to withdraw holding of abandonment under 37 CFR 1.181.
- B. A statement from the practitioner stating that the Office action was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received. A copy of the docket record where the non-received Office action would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. (Note that this showing may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail, e.g., if the practitioner has a history of not receiving Office actions.)

Withdrawal of Holding of Abandonment

- **2. For other than practitioners**
- A. Petition to withdraw holding of abandonment under 37 CFR 1.181.
- B. All direct tangible and other supporting evidence reasonably available as proof contra to the presumption. Copies of records which disclose the receipt of other correspondence mailed from the Office on or about the same date as the action or notice in question, but fail to disclose receipt of that action or notice. Also, copies of records in which the action or notice would have been entered had it been received, for example, file jacket notations, docket records and so forth.
- C. Statement that the action or notice was not received.

Suspension of Rules (37 CFR 1.183)

- Petitions under 37 CFR 1.183 to suspend or waive a requirement of the regulations require:
 1. Showing of extraordinary circumstances where justice requires the suspension or waiver.
 2. Petition fee; 37 CFR 1.17(h).
 3. Prompt and diligent filing.
 4. Compliance with any requirement of the regulation in question which is not specifically suspended or waived or with such other requirements as may be imposed.

Questions Not Specifically Provided For (37 CFR 1.182)

- Petitions under 37 CFR 1.182 are requests not specifically provided for in the regulations of 37 CFR, which require:
 1. Petition fee (37 CFR 1.17(h)).
 2. Prompt and diligent filing.
 3. Compliance with such requirements as may be imposed.

Maintenance Fees

- **M. Relating to Maintenance Fees**
- Maintenance fees may be paid during the 6-month period following the 3rd, 7th, and 11th anniversary of issuance of a utility patent. If not timely paid, a surcharge will be required between 3 ½ and 4 years, 7 ½ and 8 years, and 11 ½ and 12 years after issuance of the patent. Utility patents will expire after 4 years, 8 years and 12 years from issuance if the maintenance fee and surcharge, if required, are not timely paid. The due date for payment of maintenance fees in reissued applications is computed from the date of grant of the original non-reissue patented application.

■ Payment Prior to Expiration

- A patentee who is not satisfied with the PTO refusal to accept and record a maintenance fee paid prior to expiration of a patent may petition under 37 CFR 1.377. The requirements for acceptance of the payment are:
 - (a) Petition under 37 CFR 1.377.
 - (b) Filing within 2 months of action complained of, or within the time set in the action complained of.
 - (c) Petition fee; 37 CFR 1.17(h). The petition may include a request for refund of the petition fee if the refusal to accept and record the maintenance fee is determined to be Office error.
 - (d) Statement of facts as outlined at 37 CFR 1.181(b).
 - (e) Signature by registered attorney or party in interest as outlined at 37 CFR 1.377(c).

Payment After Expiration

- **a) Requirements when the delay was unavoidable.**
- Payment of maintenance fees after expiration of the patent will be accepted and the patent will be reinstated as if it had never expired, provided the following are filed:
 - (i) Petition under 37 CFR 1.378(b) signed by registered attorney or party in interest as outlined at 37 CFR 1.378(d).
 - (ii) Maintenance fee set forth in 37 CFR 1.20(e)-(g).
 - (iii) Surcharge set forth in 37 CFR 1.20(i)(1).
 - (iv) Showing of unavoidable delay including an enumeration of steps taken to ensure timely payment, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

Payment After Expiration

- (b) Requirements when the delay was unintentional.
- Payment of maintenance fees after expiration of the patent will be accepted and the patent will be reinstated as if it had never expired, provided the following are filed:
 - (i) Petition under 37 CFR 1.378(c) filed within 24 months after the six- month grace period signed by registered attorney or party in interest as outlined at 37 CFR 1.378(d).
 - (ii) Maintenance fee set forth in 37 CFR 1.20(e)-(g).
 - (iii) Surcharge set forth in 37 CFR 1.20(i)(2).
 - (iv) A statement that the delay in payment of the maintenance fee was unintentional

Reconsideration

- **N. Petitions Relating to Reexamination Practice**
- **1. Request for reconsideration of examiner denial of reexamination request.**
- a. Filed under 37 CFR 1.181; 37 CFR 1.515(c).
- (i) No petition fee is required.
- (ii) The request must be filed within one month of the denial date and is decided by the Group Director by way of a de novo review.
- (iii) The Director's decision is final and is not appealable.

Request for extension of time to file section 1.515(c) petition

- Petitions filed under 35 U.S.C. 133 for entry of late papers of patent owner (not available for third party requester).
- a. Petition showing unavoidable delay:
 - (i) A petition fee is required (37 CFR 1.17(I)(1)).
 - (ii) Small entity status is available.
 - (iii) These petitions are decided by the Office of Petitions.
 - (iv) Petitioner must make a showing of "unavoidable delay" which should detail the specific circumstances causing the delay and should provide evidence to support the showing.

PCT Petition Practice

- Those petitions filed in international stage applications frequently request *inter alia*,
- (a) waiver of the rules so that a filing date can be accorded where applicant has erred (essentially a 37 CFR 1.183 waiver situation where the rule to be waived is 37 CFR 1.431(b) - this is also a PCT Article 11 issue but the treaty provisions may not be waived), and
- (b) waiver of the rules so that a filing date can be accorded (Article 11 and 37 CFR 1.431) where the applicant is not a U.S. resident or national as indicated in the request for an international application.

PCT Petition Practice

- Office policy is and has been to deny such petitions unless the circumstances are such that the failure on applicant's part to comply with treaty requirements can be considered an obvious error under Rule 91.1 of the Treaty.
- Those petitions filed in national stage applications usually request relief due to quite common issues such as:
 - (a) adverse inventors (§ 1.47),
 - (b) change of inventorship (§ 1.48),
 - (c) deceased inventor (§ 1.42), and
 - (d) revival under § 1.137(a) or § 1.137(b) for failure to timely satisfy national stage filing requirements.

Requirement for Concurrent Handling of PCT Application with Nonprovisional Application

- Use PCT as a way to get expedited handling of nonprovisional application especially in high first action pendency art units
- File the nonprovisional application first or within 12 months of filing the PCT application or a provisional application and select the US as the ISA
- Serves as a form of petition to make the nonprovisional application special without the hassle

Thank You

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