

PETITION PRACTICE BEFORE THE USPTO

U.S. PATENT AND TRADEMARK OFFICE

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PETITION PRACTICE BEFORE THE USPTO

ABE HERSHKOVITZ

Hershkovitz & Associates, LLC

ahershkovitz@hershkovitz.net

PETITION PRACTICE BEFORE THE USPTO

- 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)(3)(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 application filed before June 8, 1995, or a 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 USPQ 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, seven ½ and eight 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 reissue applications is computed from the date of grant of the original non-reissue 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

Prosecution Before the PTO

- How to Cut Costs
 - Decide Importance of Invention
 - Quick-Responses to Associates
 - Electronic Copies, Use of E-mails
 - Do it Right the First Time
 - Interviews
 - Information Disclosure Statements

Patent Term Adjustment (PTA)

- Effective May 29, 2000
- Applies to utility and plant applications filed on or after May 29, 2000
- The patent term extension provisions of Public Law 103-465 (URAA) will continue to apply to utility and plant applications filed before May 29, 2000 but on or after June 8, 1995

Patent Term Adjustment (PTA)

- Patent term adjustment or extension under 35 U.S.C. § 154(b) does not apply to design applications
- Since June 8, 1995, patent term runs 20-years from the earliest effective filing date (including claims under 35 USC 120 and 365(c)) with (as of May 29, 2000) new possible positive PTA due to PTO delays

PTA: RCE Eligibility

- A request for continued examination (RCE) is not a new application
- Filing a RCE on/after May 29, 2000 in an application filed before May 29, 2000 does not cause that application to be eligible for patent term adjustment under the “American Inventors Protection Act of 1999”

Patent Term Adjustment: Bases

- **Provides three (3) bases for adjustment:**
 - (1) USPTO failure to take certain actions within specified time frames (35 U.S.C. § 154(b)(1)(A)),
 - (2) USPTO failure to issue a patent within three years of the actual filing date (35 U.S.C. § 154(b)(1)(B)), and
 - (3) Delays due to interference, secrecy order, or successful appellate review (35 U.S.C. § 154(b)(1)(C))
- Provides day-for-day adjustment for each failure or delay resulting in adjustment

PTA: Failure of USPTO to take certain actions within specified time frames (1st basis)

- Failure to initially act on the application within fourteen **(14)** months after filing or national stage entry date
- Failure to act on a reply or appeal within four **(4)** months
- Failure to act on an application within four **(4)** months after a BPAI or court decision where allowable claims remain in the application
- Failure to issue the patent within four **(4)** months of the date the issue fee was paid and all outstanding requirements were satisfied

PTA: USPTO failure to issue a patent within three years of the actual filing date (2nd basis)

- The following periods are not counted against the three years—
 - time consumed by continued examination under 35 U.S.C. § 132(b) (RCE)
 - time consumed by secrecy order, interference, or appellate review
 - time consumed by applicant requested delays

PTA: Delays due to interference, secrecy order, or successful appellate review (3rd basis)

- Delays caused by an interference proceeding (35 U.S.C. § 135(a))
- Delays caused by imposition of a secrecy order (35 U.S.C. § 181)
- Delays caused by appellate review in a case in which the patent was issued under a decision in the review reversing an **adverse determination** of patentability
 - Note: a final decision reversing ALL rejections of at least one claim is required
 - An allowance after a remand is not a final decision

The above-three delays are the bases for patent term extension under Public Law 103-465 (URAA)

PTA: Limitations on (patent term) adjustments (as to all three bases)

- No double counting of overlapping delays
- No adjustment beyond any date specified in a terminal disclaimer
- Reduction of adjustment for period during which applicant failed to engage in reasonable efforts to conclude processing or examination of an application (to be defined by regulation)
 - The reductions offset or reduce any of the 3 bases for PTA
 - PTA, however, may not be negative

PTA: Reduction of (patent term) adjustments (as to all 3 bases)

- **Failure to engage in reasonable efforts to conclude processing or examination of an application include any of the following:**
 - Suspension of action or requesting deferral of issue
 - Abandonment of application or failure to timely request withdrawal of a holding of abandonment
 - Conversion of provisional to non-provisional

PTA: Reduction of (patent term) adjustments (as to all 3 bases) (*cont'd*)

- Failure to engage in reasonable efforts to conclude processing or examination of an application also include any of the following: (*cont'd*)
 - Submitting preliminary amendments or other papers requiring re-mailing of actions
 - Submitting replies that are not complete
 - Submitting supplemental replies
 - Submitting amendments or other papers after notice of allowance

PTA: Reduction of (patent term) adjustments (as to all 3 bases) (*cont'd*)

- Failure to engage in reasonable efforts to conclude processing or examination of an application also include any of the following: (*cont'd*)
 - Submission of amendment or other paper to reopen prosecution after BPAI or court decision
 - Failure to reply to any USPTO action within three months of the action
 - Continued prosecution via a continuing application, no entitlement to **any** PTA accumulated in any prior application of the continuing application.

PTA: Notice and Reconsideration

- USPTO shall make a determination of adjustment and include it **with** the notice of allowance
- Applicant will be provided with one opportunity to request reconsideration of the USPTO's determination
- USPTO to issue patent after completing its determination (judicial review does not delay patent grant)

PTA Example

Papers:

★ Application filed	May 29, 2000
📄 First action	January 29, 2001
☀ Reply	May 29, 2001
✳ Final rejection	August 29, 2001
⊞ Notice of appeal	November 29, 2001
⊕ Appeal brief	January 29, 2002
✧ Examiner's answer	July 29, 2002
⚡ BPAI decision (reversal)	November 29, 2003
⬠ Notice of allowance	December 29, 2003
⊛ Issue fee paid	March 29, 2004
■ Patent grant	June 29, 2004

Initial Determination of PTA

(Attachment to Notice of Allowance)

Determination of Patent Term Adjustment under 35 U.S.C. § 154(b)

The patent term adjustment to date is 857 days. If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the term adjustment will be 1058 days.

Applicant will be able to obtain more detailed information by accessing PAIR.

PTA: Procedures for initial determination of adjustment provided with the Notice of Allowance

- PALM to track events giving rise to adjustments and reductions
- Applicants can check the PALM data concerning these events via PAIR (Patent Application Information Retrieval)
- PALM will calculate adjustment at time of allowance based upon projected issue date and include determination with the notice of allowance

Interfaces

USPTO PAIR Search - Microsoft Internet Explorer

Address: <http://pair-direct.uspto.gov/cgi-bin/final/home.pl>

PATENT APPLICATION INFORMATION RETRIEVAL

Home USPTO Homepage Feedback Help

PAIR
Homepage
Feedback
Help

USPTO
Homepage
Employee Locator
Information Contacts
U.S. Patent Database

Please choose the search method
You have reached the secure access site.

Application Number Search Patent Number Search

Customer Number Search Attorney Docket Number Search

59 Search

Application Number entry screen

File Content Screen

USPTO PAIR Search - Microsoft Internet Explorer

Address: <http://pair-direct.uspto.gov/cgi-bin/final/filehist.pl>

PATENT APPLICATION INFORMATION RETRIEVAL

Home USPTO Homepage Feedback Help

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Application Filing Date:	06-16-1998	Class / Sub-Class:	S23/100
Issue Date of Patent:	-	Location:	PALM PROGRAMS
Examiner Name:	MCAHON, TIMOTHY M	Status:	Pending
Group Art Unit:	1754	Attorney Docket Number:	CLAWE-09377
Patent Number:	-	Customer Number:	59

USPTO
Homepage
Employee Locator
Information Contacts
U.S. Patent Database

Foreign Priority
Continuity Data

File Contents History

Number	Date	Contents / Description
8	06-23-1999	MAIL DATE OF OFFICE ACTION
7	06-15-1999	COUNT DATE - NON-FINAL ACTION
6	12-07-1998	DATE CASE WAS DOCKETED
5	11-30-1998	APPLICATION DISPATCHED FROM PRE-EXAM
4	11-25-1998	APPLICATION IS NOW COMPLETE
3	07-10-1998	INCOMPLETE APPLICATION UNDER RULE 53(B) - FILING DATE ASSIGNED
2	07-01-1998	APPLICATION SCANNED AND DISPATCHED FROM PRE-EXAM
1	06-23-1998	INITIAL EXAM TEAM XX

Patent Term Adjustment (PTA)

PAIR review of PTA calculation:

PTA calculation for Serial Number: 59/999,999

Application Filing Date:	01-01-20001	PTO Delay (14/4/4)(PTO):	1979
Date National Stage Commenced:	07-01-2003	Three Years:	1462
Issue Date of Patent:	07-01-2010	Applicant Delay (APPL):	90
		Total PTA (days):	1979

File Contents History

Number	Date	Contents Description	PTO	APPL
15	07-01-2010	PATENT GRANT MAILED	365	
14	03-01-2009	BASE ISSUE FEE PAYMENT		
13	03-01-2009	SUBSTITUTE DRAWING FIELD		
12	02-01-2009	NOTICE OF ALLOWANCE PRINT	1614	
11	01-30-2009	COUNT DATE - NOTICE OF ALLOWANCE		
10	05-15-2004	DATE FORWARDED TO EXAMINER		
9	05-01-2004	RESPONSE AFTER NON-FINAL ACTION		90
8	05-01-2004	FIRST REQUEST FOR EXTENSION OF TIME - GRANTED (INCLUDING TO FILE BRIEF)		
7	11-01-2003	MAIL DATE OF OFFICE ACTION		
6	10-30-2003	COUNT DATE - NON-FINAL ACTION		
5	09-20-2003	DATE CASE WAS DOCKETED		
4	09-01-2003	APPLICATION DISPATCHED FROM PRE-EXAM		
3	08-01-2003	NOTICE OF DO/EO ACCEPTANCE MAILED		
2	07-01-2003	IB PAPER MATCHED		
1	07-01-2002	RECEIPT OF 371 REQUEST		

PTA: Window of time for Requesting Reconsideration of Initial PTA Determination

- **Issue fee payment ends period for filing:**
 - Reconsideration requests (for allegedly miscalculated PTA) with \$200 fee, and/or
 - Due care showings (to request reinstatement of period reduced due to failure to reply to any USPTO action within three months by showing that such failure occurred “in spite of all due care”) with \$400 fee (a change from the proposed rule’s \$450 fee).

Final Patent Term Adjustment Determination

- **Procedures for determining final adjustment:**
 - Two weeks prior to issue, PALM will make a final calculation of adjustment when the patent number and issued date is assigned with Issue Notification
 - Patent will include the USPTO's final adjustment determination; a 30 day period is provided after the patent issue date for patentee to request reconsideration of PTA attributed to an error in predicting the issue date
 - Applicant has 180 days from patent grant to seek judicial review of the USPTO's adjustment determination
 - No third party challenge to USPTO determination prior to patent grant

PTA: Impact on Patent Practice

- **Applicants need to review initial determination of PTA calculation on notice of allowance, relying on usage of PAIR, and make decisions before payment of the issue fee about:**
 - filing request for reconsideration of PTA calculation, and/or
 - submission of due care showing
- **Applicants need to review final adjustment determination on patent and decide whether to take further action**

Earliest of U.S. filing Date or International Filing Date of Utility Application

Prior to 6/8/95	6/8/95- 5/28/00	On or After 5/29/00
Not Eligible for PTA or PTE, 17 Yr Not Eligible for PTA or PTE, 17 Yr Term from Date of Issuance of Patent	Eligible for PTE	Eligible for PTA

Thank You

You can reach me for questions and comments at:

- AHershkovitz@hershkovitz.net
- 703-370-4800 (phone)
- 703-370-4809 (fax)
- www.hershkovitz.net



U.S. PATENT AND TRADEMARK OFFICE

The End

Hershkovitz & Associates, LLC
www.hershkovitz.net