

U.S. Patent and Trademark Office, Commerce

§ 1.1

CONCURRENT PROCEEDINGS INVOLVING SAME PATENT IN *Inter Partes* REEXAMINATION

- 1.985 Notification of prior or concurrent proceedings in *inter partes* reexamination.
- 1.987 Suspension of *inter partes* reexamination proceeding due to litigation.
- 1.989 Merger of concurrent reexamination proceedings.
- 1.991 Merger of concurrent reissue application and *inter partes* reexamination proceeding.
- 1.993 Suspension of concurrent interference and *inter partes* reexamination proceeding.
- 1.995 Third party requester's participation rights preserved in merged proceeding.

REEXAMINATION CERTIFICATE IN *Inter Partes* REEXAMINATION

- 1.997 Issuance and publication of *inter partes* reexamination certificate concludes *inter partes* reexamination proceeding.

AUTHORITY: 35 U.S.C. 2(b)(2), unless otherwise noted.

SOURCE: 24 FR 10332, Dec. 22, 1959, unless otherwise noted.

EDITORIAL NOTES: 1. In Patent and Trademark Office publications and usage the part number is omitted from the numbers of §§1.1 to 1.352 and the numbers to the right of the decimal point correspond with the respective rule numbers.

2. For nomenclature changes to part 1, see 68 FR 14335, Mar. 25, 2003.

Subpart A—General Provisions

GENERAL INFORMATION AND CORRESPONDENCE

§ 1.1 Addresses for non-trademark correspondence with the United States Patent and Trademark Office.

(a) *In general.* Except as provided in paragraphs (a)(3)(i), (a)(3)(ii), and (d)(1) of this section, all correspondence intended for the United States Patent and Trademark Office must be addressed to either "Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450" or to specific areas within the Office as set out in paragraphs (a)(1), and (a)(3)(iii) of this section. When appropriate, correspondence should also be marked for the attention of a particular office or individual.

(1) *Patent correspondence—(i) In general.* All correspondence concerning patent matters processed by organiza-

tions reporting to the Commissioner for Patents should be addressed to: Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450.

(ii) *Patent Trial and Appeal Board.* See § 41.10 or § 42.6 of this title. Notices of appeal, appeal briefs, reply briefs, requests for oral hearing, as well as all other correspondence in an application or a patent involved in an appeal to the Board for which an address is not otherwise specified, should be addressed as set out in paragraph (a)(1)(i) of this section.

(2) [Reserved]

(3) *Office of General Counsel correspondence—(i) Litigation and service.* Correspondence relating to pending litigation or otherwise within the scope of part 104 of this title shall be addressed as provided in § 104.2.

(ii) *Disciplinary proceedings.* Correspondence to counsel for the Director of the Office of Enrollment and Discipline relating to disciplinary proceedings pending before a Hearing Officer or the Director shall be mailed to: Mail Stop 8, Office of the Solicitor, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450.

(iii) *Solicitor, in general.* Correspondence to the Office of the Solicitor not otherwise provided for shall be addressed to: Mail Stop 8, Office of the Solicitor, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450.

(iv) *General Counsel.* Correspondence to the Office of the General Counsel not otherwise provided for, including correspondence to the General Counsel relating to disciplinary proceedings, shall be addressed to: General Counsel, United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450.

(v) *Improper correspondence.* Correspondence improperly addressed to a Post Office Box specified in paragraphs (a)(3)(i) and (a)(3)(ii) of this section will not be filed elsewhere in the United States Patent and Trademark Office, and may be returned.

(4) *Office of Public Records correspondence.* (i) Assignments. All patent-related documents submitted by mail to

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be recorded by Assignment Services Division, except for documents filed together with a new application, should be addressed to: Mail Stop Assignment Recordation Services, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313–1450. *See* § 3.27.

(5) *Office of Enrollment and Discipline correspondence.* All correspondence directed to the Office of Enrollment and Discipline concerning enrollment, registration, and investigation matters should be addressed to Mail Stop OED, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313–1450.

(ii) *Documents.* All requests for certified or uncertified copies of patent documents should be addressed to: Mail Stop Document Services, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313–1450.

(b) *Patent Cooperation Treaty.* Letters and other communications relating to international applications during the international stage and prior to the assignment of a national serial number should be additionally marked “Mail Stop PCT.”

(c) *For reexamination or supplemental examination proceedings.* (1) All correspondence concerning *ex parte* reexamination, other than correspondence to the Office of the General Counsel pursuant to § 1.1(a)(3) and § 102.4 of this chapter, should be additionally marked “Mail Stop *Ex Parte* Reexam.”

(2) All correspondence concerning *inter partes* reexamination, other than correspondence to the Office of the General Counsel pursuant to § 1.1(a)(3) and § 102.4 of this chapter, should be additionally marked “Mail Stop *Inter Partes* Reexam.”

(3) Requests for supplemental examination (original and corrected request papers) and any other paper filed in a supplemental examination proceeding, should be additionally marked “Mail Stop Supplemental Examination.”

(4) All correspondence concerning a reexamination proceeding ordered as a result of a supplemental reexamination proceeding, other than correspondence to the Office of the General Counsel pursuant to § 1.1(a)(3) and § 102.4 of this

chapter should be additionally marked “Mail Stop *Ex Parte* Reexam.”

(d) Payments of maintenance fees in patents not submitted electronically over the Internet, and correspondence related to maintenance fees may be addressed to: Director of the United States Patent and Trademark Office, Attn: Maintenance Fee, 2051 Jamieson Avenue, Suite 300, Alexandria, Virginia 22314.

(e) *Patent term extension.* All applications for extension of patent term under 35 U.S.C. 156 and any communications relating thereto intended for the United States Patent and Trademark Office should be additionally marked “Mail Stop Hatch-Waxman PTE.” When appropriate, the communication should also be marked to the attention of a particular individual, as where a decision has been rendered.

(f) [Reserved]

[68 FR 14335, Mar. 25, 2003; 68 FR 19371, Apr. 21, 2003, as amended at 68 FR 48287, Aug. 13, 2003; 68 FR 71006, Dec. 22, 2003; 69 FR 29877, May 26, 2004; 69 FR 35451, June 24, 2004; 69 FR 49997, Aug. 12, 2004; 72 FR 18904, Apr. 16, 2007; 73 FR 47540, Aug. 14, 2008; 75 FR 36295, June 25, 2010; 77 FR 46624, Aug. 6, 2012; 77 FR 48811, Aug. 14, 2012; 78 FR 62393, Oct. 21, 2013]

§ 1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

§ 1.3 Business to be conducted with decorum and courtesy.

Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided. Complaints against examiners and other employees