

(5) The name of the mass media in which the invention promoter advertised providing such services;

(6) An explanation of the relationship between the customer and the invention promoter; and

(7) A signature of the complainant.

(c) The complaint should fairly summarize the action of the invention promoter about which the person complains. Additionally, the complaint should include names and addresses of persons believed to be associated with the invention promoter. Complaints, and any replies, must be addressed to: Mail Stop 24, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

(d) Complaints that do not provide the information requested in paragraphs (b) and (c) of this section will be returned. If complainant's address is not provided, the complaint will be destroyed.

(e) No originals of documents should be included with the complaint.

(f) A complaint can be withdrawn by the complainant or the named customer at any time prior to its publication.

[65 FR 3129, Jan. 20, 2000, as amended at 68 FR 14338, Mar. 25, 2003]

§ 4.4 Invention promoter reply.

(a) If a submission appears to meet the requirements of a complaint, the invention promoter named in the complaint will be notified of the complaint and given 30 days to respond. The invention promoter's response will be made available to the public along with the complaint. If the invention promoter fails to reply within the 30-day time period set by the Office, the complaint will be made available to the public. Replies sent after the complaint is made available to the public will also be published.

(b) A response must be clearly marked, or otherwise identified, as a response by an invention promoter. The response must contain:

(1) The name and address of the invention promoter;

(2) A reference to a complaint forwarded to the invention promoter or a complaint previously published;

(3) The name of the individual signing the response; and

(4) The title or authority of the individual signing the response.

§ 4.5 Notice by publication.

If the copy of the complaint that is mailed to the invention promoter is returned undelivered, then the USPTO will primarily publish a Notice of Complaint Received on the USPTO's Internet home page at <http://www.uspto.gov>. Only where the USPTO's Web site is unavailable for publication will the USPTO publish the Notice of Complaint in the *Official Gazette* and/or the FEDERAL REGISTER. The invention promoter will be given 30 days from such notice to submit a reply to the Notice of Complaint. If the USPTO does not receive a reply from the invention promoter within 30 days, the complaint alone will become publicly available.

[68 FR 9553, Feb. 28, 2003]

§ 4.6 Attorneys and Agents.

Complaints against registered patent attorneys and agents will not be treated under this section, unless a complaint fairly demonstrates that invention promotion services are involved. Persons having complaints about registered patent attorneys or agents should contact the Office of Enrollment and Discipline at Mail Stop OED, Director of the United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450, and the attorney discipline section of the attorney's state licensing bar if an attorney is involved.

[68 FR 14338, Mar. 25, 2003]

PART 5—SECRECY OF CERTAIN INVENTIONS AND LICENSES TO EXPORT AND FILE APPLICATIONS IN FOREIGN COUNTRIES

SECRECY ORDERS

Sec.

5.1 Applications and correspondence involving national security.

5.2 Secrecy order.

5.3 Prosecution of application under secrecy orders; withholding patent.

5.4 Petition for rescission of secrecy order.

5.5 Permit to disclose or modification of secrecy order.

5.6-5.8 [Reserved]

§ 5.1

37 CFR Ch. I (7–1–15 Edition)

LICENSES FOR FOREIGN EXPORTING AND FILING

- 5.11 License for filing in, or exporting to, a foreign country an application on an invention made in the United States or technical data relating thereto.
- 5.12 Petition for license.
- 5.13 Petition for license; no corresponding application.
- 5.14 Petition for license; corresponding U.S. application.
- 5.15 Scope of license.
- 5.16–5.17 [Reserved]
- 5.18 Arms, ammunition, and implements of war.
- 5.19 Export of technical data.
- 5.20 Export of technical data relating to sensitive nuclear technology.
- 5.25 Petition for retroactive license.

GENERAL

- 5.31–5.33 [Reserved]

AUTHORITY: 35 U.S.C. 2(b)(2), 41, 181–188, as amended by the Patent Law Foreign Filing Amendments Act of 1988, Pub. L. 100–418, 102 Stat. 1567; the Arms Export Control Act, as amended, 22 U.S.C. 2571 *et seq.*; the Atomic Energy Act of 1954, as amended, 42 U.S.C. 2011 *et seq.*; the Nuclear Non Proliferation Act of 1978; 22 U.S.C. 3201 *et seq.*; and the delegations in the regulations under these Acts to the Director (15 CFR 734.3(b)(1)(v), 22 CFR 125.04, and 10 CFR 810.7), as well as the Export Administration Act of 1979, 50 U.S.C. app. 2401 *et seq.*; the International Emergency Economic Powers Act, 50 U.S.C. 1701 *et seq.*; E.O. 12938, 59 FR 59099, 3 CFR, 1994 Comp., p. 950; E.O. 13222, 66 FR 44025, 3 CFR, 2001 Comp., p. 783; Notice of August 2, 2005, 70 FR 45273 (August 5, 2005).

SOURCE: 24 FR 10381, Dec. 22, 1959, unless otherwise noted.

EDITORIAL NOTE: Nomenclature changes to part 5 appear at 68 FR 14338, Mar. 25, 2003.

SECURITY ORDERS

§ 5.1 Applications and correspondence involving national security.

(a) All correspondence in connection with this part, including petitions, should be addressed to: Mail Stop L&R, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313–1450.

(b) *Definitions.* (1) Application as used in this part includes provisional applications (§ 1.9(a)(2) of this chapter), non-provisional applications (§ 1.9(a)(3)), international applications (§ 1.9(b)), or international design applications (§ 1.9(n)).

(2) Foreign application as used in this part includes, for filing in a foreign

country, foreign patent office, foreign patent agency, or international agency (other than the United States Patent and Trademark Office acting as a Receiving Office for international applications (35 U.S.C. 361, § 1.412) or as an office of indirect filing for international design applications (35 U.S.C. 382, § 1.1002)) any of the following: An application for patent, international application, international design application, or application for the registration of a utility model, industrial design, or model.

(c) Patent applications and documents relating thereto that are national security classified (see § 1.9(i) of this chapter) and contain authorized national security markings (e.g., “Confidential,” “Secret” or “Top Secret”) are accepted by the Office. National security classified documents filed in the Office must be either hand-carried to Licensing and Review or mailed to the Office in compliance with paragraph (a) of this section.

(d) The applicant in a national security classified patent application must obtain a secrecy order pursuant to § 5.2(a). If a national security classified patent application is filed without a notification pursuant to § 5.2(a), the Office will set a time period within which either the application must be declassified, or the application must be placed under a secrecy order pursuant to § 5.2(a), or the applicant must submit evidence of a good faith effort to obtain a secrecy order pursuant to § 5.2(a) from the relevant department or agency in order to prevent abandonment of the application. If evidence of a good faith effort to obtain a secrecy order pursuant to § 5.2(a) from the relevant department or agency is submitted by the applicant within the time period set by the Office, but the application has not been declassified or placed under a secrecy order pursuant to § 5.2(a), the Office will again set a time period within which either the application must be declassified, or the application must be placed under a secrecy order pursuant to § 5.2(a), or the applicant must submit evidence of a good faith effort to again obtain a secrecy order pursuant to § 5.2(a) from the relevant department or agency in order to

prevent abandonment of the application.

(e) An application will not be published under §1.211 of this chapter or allowed under §1.311 of this chapter if publication or disclosure of the application would be detrimental to national security. An application under national security review will not be published at least until six months from its filing date or three months from the date the application was referred to a defense agency, whichever is later. A national security classified patent application will not be published under §1.211 of this chapter or allowed under §1.311 of this chapter until the application is declassified and any secrecy order under §5.2(a) has been rescinded.

(f) Applications on inventions made outside the United States and on inventions in which a U.S. Government defense agency has a property interest will not be made available to defense agencies.

[65 FR 54682, Sept. 8, 2000, as amended at 65 FR 57060, Sept. 20, 2000; 68 FR 14338, Mar. 25, 2003; 69 FR 29880, May 26, 2004; 80 FR 17969, Apr. 2, 2015]

§ 5.2 Secrecy order.

(a) When notified by the chief officer of a defense agency that publication or disclosure of the invention by the granting of a patent would be detrimental to the national security, an order that the invention be kept secret will be issued by the Commissioner for Patents.

(b) Any request for compensation as provided in 35 U.S.C. 183 must not be made to the Patent and Trademark Office, but directly to the department or agency which caused the secrecy order to be issued.

(c) An application disclosing any significant part of the subject matter of an application under a secrecy order pursuant to paragraph (a) of this section also falls within the scope of such secrecy order. Any such application that is pending before the Office must be promptly brought to the attention of Licensing and Review, unless such application is itself under a secrecy order pursuant to paragraph (a) of this section. Any subsequently filed application containing any significant part

of the subject matter of an application under a secrecy order pursuant to paragraph (a) of this section must either be hand-carried to Licensing and Review or mailed to the Office in compliance with §5.1(a).

[24 FR 10381, Dec. 22, 1959, as amended at 62 FR 53203, Oct. 10, 1997; 65 FR 54683, Sept. 8, 2000]

§ 5.3 Prosecution of application under secrecy orders; withholding patent.

Unless specifically ordered otherwise, action on the application by the Office and prosecution by the applicant will proceed during the time an application is under secrecy order to the point indicated in this section:

(a) National applications under secrecy order which come to a final rejection must be appealed or otherwise prosecuted to avoid abandonment. Appeals in such cases must be completed by the applicant but unless otherwise specifically ordered by the Commissioner for Patents will not be set for hearing until the secrecy order is removed.

(b) An interference or derivation will not be instituted involving a national application under secrecy order. An applicant whose application is under secrecy order may suggest an interference (§41.202(a) of this title), but the Office will not act on the request while the application remains under a secrecy order.

(c) When the national application is found to be in condition for allowance except for the secrecy order the applicant and the agency which caused the secrecy order to be issued will be notified. This notice (which is not a notice of allowance under §1.311 of this chapter) does not require reply by the applicant and places the national application in a condition of suspension until the secrecy order is removed. When the secrecy order is removed the Patent and Trademark Office will issue a notice of allowance under §1.311 of this chapter, or take such other action as may then be warranted.

(d) International applications and international design applications under secrecy order will not be mailed, delivered, or otherwise transmitted to the international authorities or the applicant. International applications under

§ 5.4

37 CFR Ch. I (7–1–15 Edition)

secrecy order will be processed up to the point where, if it were not for the secrecy order, record and search copies would be transmitted to the international authorities or the applicant.

(Pub. L. 94–131, 89 Stat. 685)

[43 FR 20470, May 11, 1978, as amended at 53 FR 23736, June 23, 1988; 62 FR 53203, Oct. 10, 1997; 69 FR 50002, Aug. 12, 2004; 77 FR 46629, Aug. 6, 2012; 80 FR 17969, Apr. 2, 2015]

§ 5.4 Petition for rescission of secrecy order.

(a) A petition for rescission or removal of a secrecy order may be filed by, or on behalf of, any principal affected thereby. Such petition may be in letter form, and it must be in duplicate.

(b) The petition must recite any and all facts that purport to render the order ineffectual or futile if this is the basis of the petition. When prior publications or patents are alleged the petition must give complete data as to such publications or patents and should be accompanied by copies thereof.

(c) The petition must identify any contract between the Government and any of the principals, under which the subject matter of the application or any significant part thereof was developed, or to which the subject matter is otherwise related. If there is no such contract, the petition must so state.

(d) Appeal to the Secretary of Commerce, as provided by 35 U.S.C. 181, from a secrecy order cannot be taken until after a petition for rescission of the secrecy order has been made and denied. Appeal must be taken within sixty days from the date of the denial, and the party appealing, as well as the department or agency which caused the order to be issued, will be notified of the time and place of hearing.

[24 FR 10381, Dec. 22, 1959, as amended at 62 FR 53204, Oct. 10, 1997]

§ 5.5 Permit to disclose or modification of secrecy order.

(a) Consent to disclosure, or to the filing of an application abroad, as provided in 35 U.S.C. 182, shall be made by a “permit” or “modification” of the secrecy order.

(b) Petitions for a permit or modification must fully recite the reason or purpose for the proposed disclosure. Where any proposed disclosee is known to be cleared by a defense agency to receive classified information, adequate explanation of such clearance should be made in the petition including the name of the agency or department granting the clearance and the date and degree thereof. The petition must be filed in duplicate.

(c) In a petition for modification of a secrecy order to permit filing abroad, all countries in which it is proposed to file must be made known, as well as all attorneys, agents and others to whom the material will be consigned prior to being lodged in the foreign patent office. The petition should include a statement vouching for the loyalty and integrity of the proposed disclosees and where their clearance status in this or the foreign country is known all details should be given.

(d) Consent to the disclosure of subject matter from one application under secrecy order may be deemed to be consent to the disclosure of common subject matter in other applications under secrecy order so long as not taken out of context in a manner disclosing material beyond the modification granted in the first application.

(e) Organizations requiring consent for disclosure of applications under secrecy order to persons or organizations in connection with repeated routine operation may petition for such consent in the form of a general permit. To be successful such petitions must ordinarily recite the security clearance status of the disclosees as sufficient for the highest classification of material that may be involved.

[24 FR 10381, Dec. 22, 1959, as amended at 62 FR 53204 Oct. 10, 1997]

U.S. Patent and Trademark Office, Commerce

§ 5.11

§§ 5.6-5.8 [Reserved]

LICENSES FOR FOREIGN EXPORTING AND FILING

§ 5.11 License for filing in, or exporting to, a foreign country an application on an invention made in the United States or technical data relating thereto.

(a) A license from the Commissioner for Patents under 35 U.S.C. 184 is required before filing any application for patent including any modifications, amendments, or supplements thereto or divisions thereof or for the registration of a utility model, industrial design, or model, in a foreign country, foreign patent office, foreign patent agency, or any international agency (other than the United States Patent and Trademark Office acting as a Receiving Office for international applications (35 U.S.C. 361, §1.412) or as an office of indirect filing for international design applications (35 U.S.C. 382, §1.1002)), if the invention was made in the United States, and:

(1) An application on the invention has been filed in the United States less than six months prior to the date on which the application is to be filed; or

(2) No application on the invention has been filed in the United States.

(b) The license from the Commissioner for Patents referred to in paragraph (a) of this section would also authorize the export of technical data abroad for purposes relating to the preparation, filing or possible filing and prosecution of a foreign application without separately complying with the regulations contained in 22 CFR parts 120 through 130 (International Traffic in Arms Regulations of the Department of State), 15 CFR parts 730 through 774 (Export Administration Regulations of the Bureau of Industry and Security, Department of Commerce), and 10 CFR part 810 (Assistance to Foreign Atomic Energy Activities Regulations of the Department of Energy).

(c) Where technical data in the form of a patent application, or in any form, are being exported for purposes related to the preparation, filing or possible filing and prosecution of a foreign application, without the license from the Commissioner for Patents referred to

in paragraphs (a) or (b) of this section, or on an invention not made in the United States, the export regulations contained in 22 CFR parts 120 through 130 (International Traffic in Arms Regulations of the Department of State), 15 CFR parts 730 through 774 (Export Administration Regulations of the Bureau of Industry and Security, Department of Commerce), and 10 CFR part 810 (Assistance to Foreign Atomic Energy Activities Regulations of the Department of Energy) must be complied with unless a license is not required because a United States application was on file at the time of export for at least six months without a secrecy order under § 5.2 being placed thereon. The term "exported" means export as it is defined in 22 CFR part 120, 15 CFR part 734, and activities covered by 10 CFR part 810.

(d) If a secrecy order has been issued under § 5.2, an application cannot be exported to, or filed in, a foreign country (including an international agency in a foreign country), except in accordance with § 5.5.

(e) No license pursuant to paragraph (a) of this section is required:

(1) If the invention was not made in the United States, or

(2) If the corresponding United States application is not subject to a secrecy order under § 5.2, and was filed at least six months prior to the date on which the application is filed in a foreign country, or

(3) For subsequent modifications, amendments and supplements containing additional subject matter to, or divisions of, a foreign patent application if:

(i) A license is not, or was not, required under paragraph (e)(2) of this section for the foreign application;

(ii) The corresponding United States application was not required to be made available for inspection under 35 U.S.C. 181; and

(iii) Such modifications, amendments, and supplements do not, or did not, change the general nature of the invention in a manner which would require any corresponding United States application to be or have been available for inspection under 35 U.S.C. 181.

(f) A license pursuant to paragraph (a) of this section can be revoked at

§5.12

37 CFR Ch. I (7–1–15 Edition)

any time upon written notification by the United States Patent and Trademark Office. An authorization to file a foreign application resulting from the passage of six months from the date of filing of a United States patent application may be revoked by the imposition of a secrecy order.

[49 FR 13461, Apr. 4, 1984, as amended at 56 FR 1928, Jan. 18, 1991; 62 FR 53204, Oct. 10, 1997; 70 FR 56129, Sept. 26, 2005; 80 FR 17969, Apr. 2, 2015]

§5.12 Petition for license.

(a) Filing of an application on an invention made in the United States will be considered to include a petition for license under 35 U.S.C. 184 for the subject matter of the application. The filing receipt or other official notice will indicate if a license is granted. If the initial automatic petition is not granted, a subsequent petition may be filed under paragraph (b) of this section.

(b) A petition for license must include the fee set forth in §1.17(g) of this chapter, the petitioner's address, and full instructions for delivery of the requested license when it is to be delivered to other than the petitioner. The petition should be presented in letter form.

(35 U.S.C. 6, Pub. L. 97–247)

[48 FR 2714, Jan. 20, 1983, as amended at 49 FR 13462, Apr. 4, 1984; 62 FR 53204, Oct. 10, 1997; 65 FR 54683, Sept. 8, 2000; 69 FR 56546, Sept. 21, 2004; 80 FR 17970, Apr. 2, 2015]

§5.13 Petition for license; no corresponding application.

If no corresponding national, international design, or international application has been filed in the United States, the petition for license under §5.12(b) must also be accompanied by a legible copy of the material upon which a license is desired. This copy will be retained as a measure of the license granted.

[80 FR 17970, Apr. 2, 2015]

§5.14 Petition for license; corresponding U.S. application.

(a) When there is a corresponding United States application on file, a petition for license under §5.12(b) must also identify this application by application number, filing date, inventor,

and title, but a copy of the material upon which the license is desired is not required. The subject matter licensed will be measured by the disclosure of the United States application.

(b) Two or more United States applications should not be referred to in the same petition for license unless they are to be combined in the foreign or international application, in which event the petition should so state and the identification of each United States application should be in separate paragraphs.

(c) Where the application to be filed or exported abroad contains matter not disclosed in the United States application or applications, including the case where the combining of two or more United States applications introduces subject matter not disclosed in any of them, a copy of the application as it is to be filed or exported abroad, must be furnished with the petition. If, however, all new matter in the application to be filed or exported is readily identifiable, the new matter may be submitted in detail and the remainder by reference to the pertinent United States application or applications.

(Pub. L. 94–131, 89 Stat. 685)

[43 FR 20471, May 11, 1978, as amended at 49 FR 13462, Apr. 4, 1984; 62 FR 53204, Oct. 10, 1997; 80 FR 17970, Apr. 2, 2015]

§5.15 Scope of license.

(a) Applications or other materials reviewed pursuant to §§5.12 through 5.14, which were not required to be made available for inspection by defense agencies under 35 U.S.C. 181, will be eligible for a license of the scope provided in this paragraph. This license permits subsequent modifications, amendments, and supplements containing additional subject matter to, or divisions of, a foreign application, if such changes to the application do not alter the general nature of the invention in a manner that would require the United States application to have been made available for inspection under 35 U.S.C. 181. Grant of this license authorizes the export and filing of an application in a foreign country or to any foreign patent agency or international patent agency when the

subject matter of the foreign application corresponds to that of the domestic application. This license includes authority:

(1) To export and file all duplicate and formal application papers in foreign countries or with international agencies;

(2) To make amendments, modifications, and supplements, including divisions, changes or supporting matter consisting of the illustration, exemplification, comparison, or explanation of subject matter disclosed in the application; and

(3) To take any action in the prosecution of the foreign application provided that the adding of subject matter or taking of any action under paragraph (a)(1) or (2) of this section does not change the general nature of the invention disclosed in the application in a manner that would require such application to have been made available for inspection under 35 U.S.C. 181 by including technical data pertaining to:

(i) Defense services or articles designated in the United States Munitions List applicable at the time of foreign filing, the unlicensed exportation of which is prohibited pursuant to the Arms Export Control Act, as amended, and 22 CFR parts 120 through 130; or

(ii) Restricted Data, sensitive nuclear technology or technology useful in the production or utilization of special nuclear material or atomic energy, dissemination of which is subject to restrictions of the Atomic Energy Act of 1954, as amended, and the Nuclear Non-Proliferation Act of 1978, as implemented by the regulations for Assistance to Foreign Atomic Energy Activities, 10 CFR part 810, in effect at the time of foreign filing.

(b) Applications or other materials which were required to be made available for inspection under 35 U.S.C. 181 will be eligible for a license of the scope provided in this paragraph. Grant of this license authorizes the export and filing of an application in a foreign country or to any foreign patent agency or international patent agency. Further, this license includes authority to export and file all duplicate and formal papers in foreign countries or with foreign and international patent agencies and to make amendments, modifica-

tions, and supplements to, file divisions of, and take any action in the prosecution of the foreign application, provided subject matter additional to that covered by the license is not involved.

(c) A license granted under § 5.12(b) pursuant to § 5.13 or § 5.14 shall have the scope indicated in paragraph (a) of this section, if it is so specified in the license. A petition, accompanied by the required fee (§ 1.17(g) of this chapter), may also be filed to change a license having the scope indicated in paragraph (b) of this section to a license having the scope indicated in paragraph (a) of this section. No such petition will be granted if the copy of the material filed pursuant to § 5.13 or any corresponding United States application was required to be made available for inspection under 35 U.S.C. 181. The change in the scope of a license will be effective as of the date of the grant of the petition.

(d) In those cases in which no license is required to file or export the foreign application, no license is required to file papers in connection with the prosecution of the foreign application not involving the disclosure of additional subject matter.

(e) Any paper filed abroad or transmitted to an international patent agency following the filing of a foreign application that changes the general nature of the subject matter disclosed at the time of filing in a manner that would require such application to have been made available for inspection under 35 U.S.C. 181 or that involves the disclosure of subject matter listed in paragraph (a)(3)(i) or (ii) of this section must be separately licensed in the same manner as a foreign application. Further, if no license has been granted under § 5.12(a) on filing the corresponding United States application, any paper filed abroad or with an international patent agency that involves the disclosure of additional subject matter must be licensed in the same manner as a foreign application.

(f) Licenses separately granted in connection with two or more United States applications may be exercised by combining or dividing the disclosures, as desired, provided:

§§ 5.16–5.17

37 CFR Ch. I (7–1–15 Edition)

(1) Subject matter which changes the general nature of the subject matter disclosed at the time of filing or which involves subject matter listed in paragraph (a)(3) (i) or (ii) of this section is not introduced, and

(2) In the case where at least one of the licenses was obtained under § 5.12(b), additional subject matter is not introduced.

(g) A license does not apply to acts done before the license was granted. See § 5.25 for petitions for retroactive licenses.

[49 FR 13462, Apr. 4, 1984, as amended at 56 FR 1928, Jan. 18, 1991; 62 FR 53204, Oct. 10, 1997; 69 FR 56546, Sept. 21, 2004; 80 FR 17970, Apr. 2, 2015]

§§ 5.16–5.17 [Reserved]

§ 5.18 Arms, ammunition, and implements of war.

(a) The exportation of technical data relating to arms, ammunition, and implements of war generally is subject to the International Traffic in Arms Regulations of the Department of State (22 CFR parts 120 through 130); the articles designated as arms, ammunitions, and implements of war are enumerated in the U.S. Munitions List (22 CFR part 121). However, if a patent applicant complies with regulations issued by the Commissioner for Patents under 35 U.S.C. 184, no separate approval from the Department of State is required unless the applicant seeks to export technical data exceeding that used to support a patent application in a foreign country. This exemption from Department of State regulations is applicable regardless of whether a license from the Commissioner for Patents is required by the provisions of §§ 5.11 and 5.12 (22 CFR part 125).

(b) When a patent application containing subject matter on the Munitions List (22 CFR part 121) is subject to a secrecy order under § 5.2 and a petition is made under § 5.5 for a modification of the secrecy order to permit filing abroad, a separate request to the Department of State for authority to export classified information is not required (22 CFR part 125).

[62 FR 53205, Oct. 10, 1997]

§ 5.19 Export of technical data.

(a) Under regulations (15 CFR 734.3(b)(1)(v)) established by the Department of Commerce, a license is not required in any case to file a patent application or part thereof in a foreign country if the foreign filing is in accordance with the regulations (§§ 5.11 through 5.25) of the U.S. Patent and Trademark Office.

(b) An export license is not required for data contained in a patent application prepared wholly from foreign-origin technical data where such application is being sent to the foreign inventor to be executed and returned to the United States for subsequent filing in the U.S. Patent and Trademark Office (15 CFR 734.10(a)).

[70 FR 56129, Sept. 26, 2005]

§ 5.20 Export of technical data relating to sensitive nuclear technology.

Under regulations (10 CFR 810.7) established by the United States Department of Energy, an application filed in accordance with the regulations (§§ 5.11 through 5.25) of the Patent and Trademark Office and eligible for foreign filing under 35 U.S.C. 184, is considered to be information available to the public in published form and a generally authorized activity for the purposes of the Department of Energy regulations.

[62 FR 53205, Oct. 10, 1997]

§ 5.25 Petition for retroactive license.

(a) A petition for a retroactive license under 35 U.S.C. 184 shall be presented in accordance with § 5.13 or § 5.14(a), and shall include:

(1) A listing of each of the foreign countries in which the unlicensed patent application material was filed,

(2) The dates on which the material was filed in each country,

(3) A verified statement (oath or declaration) containing:

(i) An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order,

(ii) A showing that the license has been diligently sought after discovery of the proscribed foreign filing, and

(iii) An explanation of why the material was filed abroad through error

U.S. Patent and Trademark Office, Commerce

§§ 5.31–5.33

without the required license under § 5.11 first having been obtained, and

(4) The required fee (§ 1.17(g) of this chapter).

(b) The explanation in paragraph (a) of this section must include a showing of facts rather than a mere allegation of action through error. The showing of facts as to the nature of the error should include statements by those persons having personal knowledge of the acts regarding filing in a foreign country and should be accompanied by copies of any necessary supporting documents such as letters of transmittal or instructions for filing. The acts which are alleged to constitute error should cover the period leading up to and including each of the proscribed foreign filings.

(c) If a petition for a retroactive license is denied, a time period of not less than thirty days shall be set, during which the petition may be renewed. Failure to renew the petition within the set time period will result in a final denial of the petition. A final denial of a petition stands unless a petition is filed under § 1.181 within two months of the date of the denial. If the petition for a retroactive license is denied with respect to the invention of a pending

application and no petition under § 1.181 has been filed, a final rejection of the application under 35 U.S.C. 185 will be made.

[49 FR 13463, Apr. 4, 1984, as amended at 56 FR 1929, Jan. 18, 1991; 62 FR 53206, Oct. 10, 1997; 69 FR 56546, Sept. 21, 2004; 77 FR 48826, Aug. 14, 2012]

GENERAL

§§ 5.31–5.33 [Reserved]

PART 6—CLASSIFICATION OF GOODS AND SERVICES UNDER THE TRADEMARK ACT

EDITORIAL NOTE: Part 6 is placed in the separate grouping of parts pertaining to trademarks regulations.

PART 7—RULES OF PRACTICE IN FILINGS PURSUANT TO THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

EDITORIAL NOTE: Part 7 is placed in the separate grouping of parts pertaining to trademarks regulations.

INDEX I—RULES RELATING TO PATENTS

EDITORIAL NOTE: This listing is provided for informational purposes only. It is compiled and kept current by the Department of Commerce. This index is updated as of July 1, 2015.

Section

A

Abandoned applications:	
Abandonment by failure to prosecute.....	1.135
Abandonment during interference	41.127(b)
Abandonment for failure to pay issue fee	1.316
Express abandonment	1.138
To avoid publication	1.138(c)
Referred to in issued patents.....	1.14
Revival of.....	1.137
When open for public inspection	1.14
Abandonment of application. (See Abandoned applications)	
Abstract of the disclosure.(content, physical requirements)	1.72(b)
Separate sheet required for commencement of	1.52(b)(4), 1.72(b)
Arrangement in overall application	1.77, 1.163
Access to pending applications (limited)	1.14
Action by applicant	1.111-1.116, 1.121-1.138
Address, Correspondence, only one recognized by Office	1.33(c)
Address for notice to Director of appeal to Fed. Cir	90.2
Address of Solicitor's Office	1.1(a)(3)
Address of the Patent and Trademark Office.....	1.1
Mail Stop Assignment Recordation Services	1.1(a)(4), 3.27
Mail Stop Document Services	1.1(a)(4)
Mail Stop Ex Parte Reexam.....	1.1(c)(1), 1.1(c)(4)
Mail Stop Inter Partes Reexam	1.1(c)(2)
Mail Stop Interference	41.10(b)
Mail Stop OED.....	1.1(a)(5), 4.6
Mail Stop Patent Ext	1.1(e)
Mail Stop PCT	1.1(b)
Mail Stop Supplemental Examination.....	1.1(c)(3)
Adjustment of patent term. (See Patent term adjustment)	
Administrator, executor, or other legal representative may make appli- cation and receive patent	1.42, 1.43
In an international application	1.422
Oath or declaration	1.64
Admission to practice. (See Attorneys and agents)	
Affidavit (see also Oath in patent application):	
After appeal	41.33(d)
In support of application for reissue	1.175
To disqualify commonly owned patent as prior art.....	1.131(c)
To overcome cited patent or publication.....	1.131
Traversing grounds of rejection.....	1.132
Agents. (See Attorneys and agents)	
Allowance and issue of patent:	
Amendment after allowance (before or with issue fee).....	1.312
Deferral of issuance	1.314
Delivery of patent.....	1.315

37 CFR Ch. I (7-1-15 Edition)

Failure to pay issue fee	1.137(c), 1.316
Issuance of patent.....	1.314
Notice of allowance.....	1.311
Patent to issue upon payment of issue fee.....	1.314
Reasons for	1.104(e)
Withdrawal from issue.....	1.313
Amendment:	
Adding or substituting claims	1.111, 1.121
After appeal	1.116, 41.33, 41.63
After decision on appeal, based on new rejection of Patent Trial and Appeal Board	41.50(b)
After final action	1.116, 41.33
After final action (transitional procedures)	1.129
After notice of allowance.....	1.312
By patent owner	1.530
Copying claim of another application for interference	41.202
Copying claim of issued patent	41.202
Deletions and insertions	1.121
Drawings.....	1.84, 1.85, 1.121(d)
Manner of making.....	1.121
May be required	1.121
New matter prohibited.....	1.121(f), 1.173(a)
Numbering of claims.....	1.126
Of amendments	1.121
Of claims.....	1.111, 1.121
Of disclosure	1.121
Of drawing	1.121(d)
Of specification.....	1.121
Paper and writing.....	1.52
Petition from refusal to admit	1.127
Preliminary	1.115
Proposed during interference.....	41.121, 41.208
Provisional application	1.53(c), 1.121(k)
Reexamination proceedings	1.121(j), 1.530, 1.941
Reissue	1.121(i), 1.173(b)
Requisites of	1.33(b), 1.111, 1.116, 1.121, 1.125
Right to amend.....	1.111, 1.114, 1.116, 1.121, 1.127
Signature to	1.33(b)
Substitute specification	1.125
Time for	1.134
To applications in interference.....	41.121, 41.208
To correct inaccuracies	1.121(e)
To correspond to original drawing or specification	1.121(e)
To reissues	1.121(i), 1.173
To save from abandonment.....	1.135
America Invents Act Post-Grant Proceedings (See Inter parte review, post-grant review, covered business method review, and derivation proceeding)	
Amino Acid Sequences. (See Nucleotide and/or Amino Acid Sequences)	
Appeal to Patent Trial and Appeal Board:	
Action following decision	41.54
Affidavits after appeal.....	41.33(d)
Brief.....	41.37
Decision by Board.....	41.50(b)
Examiner's answer.....	41.39
Fees.....	41.20, 41.45
Hearing of	41.47
New grounds for rejecting a claim.....	41.50(b)
Notice of appeal	41.31

Index I

Reexamination, <i>inter partes</i> proceeding	1.959
Rehearing	41.52
Reopening after decision	1.198
Reply brief	41.41
Statement of grounds for rejecting, by Patent Trial and Appeal Board	41.50
Appeal to Court of Appeals for the Federal Circuit:	
Fee provided by rules of court.....	90.2
From Patent Trial and Appeal Board.....	90.1-90.3
Notice and reasons of appeal	90.2
Reexamination, <i>inter partes</i> proceeding	1.983
Time for	90.3
Applicant for patent.....	1.42, 1.421
Change.....	1.46, 1.472
Deceased or legally incapacitated inventor.....	1.43, 1.64(b), 1.422
Executor or administrator	1.43
Informed of application number	1.54(b)
Joint changed to sole	1.48, 1.472
Letters for, sent to attorney or agent.....	1.33(a)
May be represented by patent practitioner.....	1.31
Must be represented by patent practitioner if juristic entity	1.31
Personal attendance unnecessary	1.2
Required to conduct business with decorum and courtesy	1.3
Required to report assistance received.....	1.4(g)
Sole changed to another sole	1.48, 1.497(d)
Sole changed to joint	1.48, 1.497(d)
Application data sheet	1.76
Application for patent (see also Abandoned applications, Claims, Drawing, Examination of application Reissues, Provisional applications, Specification):	
Access to	1.14
Acknowledgement of filing	1.54(b)
Alteration after execution	1.52(c)
Alteration before execution	1.52(c)
Applicant.....	1.42
Application number and filing date	1.54
Arrangement	1.77, 1.154, 1.163
Continuation or division, reexecution not required.....	1.63(d)
Continued Prosecution Application (CPA), Design.....	1.53(d)
Copies of, furnished to applicants	1.59(c)
Cross-references of related applications.....	1.78
Deceased or legally incapacitated inventor.....	1.43, 1.64
International phase.....	1.422
Declaration in lieu of oath	1.68
Duty of disclosure	1.56
Elements of, order and arrangement of.....	1.77, 1.154, 1.163
Filed apparently without all figures of drawing:	
Petition asserting all figures of drawing were filed	1.53(e)
Petition and filing of missing figures seeking new filing date.....	1.182
Filed apparently without all pages of specification, petition asserting all pages were filed.....	1.53(e)
Filed apparently without any drawing, petition asserting drawing was filed, or was not necessary, or adding drawing and seeking new filing date	1.53(e)
Filed by other than inventor.....	1.42, 1.43, 1.46
Filed by reference	1.57(a)
International phase.....	1.421(c), 1.422
Filing and national fees	1.16, 1.445, 1.492
Filing date.....	1.53

37 CFR Ch. I (7-1-15 Edition)

International application	1.431(b)
Foreign language oath or declaration	1.69
Formulas and tables	1.58
General requisites	1.51
Identification required in letters concerning	1.5
Incomplete application not forwarded for examination	1.53
Language, paper, writing, margin	1.52
Later completion of nonprovisional application	1.53(f)
Must be made by actual inventor, with exceptions	1.42, 1.46, 1.64
Names of all inventors required	1.41, 1.53
Non-English language	1.52(b)(1)(ii)
Nonprovisional, filing of petition to convert to a provisional applica- tion	1.53(c)(2)
Nonprovisional application forwarded for examination only when com- plete	1.53
Owned by Government	1.103(f)
Papers forming part of original disclosure not to be expunged	1.59(a)(2)
Parts filed separately	1.54
Parts of application desirably filed together	1.54
Parts of complete application	1.51
Processing fees	1.17
Provisional application	1.9(a)(2), 1.51(c), 1.53(e), 1.121(k)
Publication. (See Publication of applications)	
Relating to atomic energy	1.14(d)
Reservation for future application not permitted	1.79
Secrecy order	5.1-5.5
Tables and formulas	1.58
To be made to Director of the U.S. Patent and Trademark Office	1.51
To claim one independent and distinct invention	1.141
Two or more by same party with patentably indistinct claims	1.78(f), (g)
Application number	1.5(a), 1.53(a), 1.54(b)
Application size fee	1.16(s), 1.52(f)
Arbitration award filing	1.335
Arbitration in interference	41.126
Assertion of micro entity status	1.29
Assertion of small entity status	1.27(c)
Assignee:	
Correspondence held with assignee of entire interest	3.71, 3.73
Establishing ownership	3.73(b)
If of entire interest, patent may issue to	1.46, 3.81
If of undivided part interest, correspondence will be held with inven- tor	1.33
If of undivided part interest, must assent to application for reissue of patent	1.172
If of undivided part interest, patent may issue jointly	1.46, 3.81
May conduct prosecution of application	3.71, 3.73
May take action in interference	41.9
Assignments and recording:	
Abstracts of title, fee for	1.19(b)
Conditional assignments	3.56
Correction of Cover Sheet errors	3.34
Cover Sheet required	3.28, 3.31
Date of receipt is date of record	3.51
Effect of recording	3.54
Fees	1.21(h), 3.41
If recorded before payment of issue fee, patent may issue to as- signee	3.81
Impact on entitlement to micro entity status	1.29

Index I

Impact on entitlement to small entity status	1.27
May serve as inventor's oath or declaration	1.63(e)
Must be recorded in Patent and Trademark Office to issue patent to assignee	3.81
Must identify patent or application	3.21
Orders for copies of	1.12
Patent may issue to assignee	3.81
Recording of assignments	3.11
Records open to public inspection	1.12
Requirements for recording	3.21-3.41
What will be accepted for recording	3.11
Atomic energy applications reported to Department of Energy	1.14
Attorneys and agents:	
Acting in a representative capacity	1.33, 1.34
Assignment will not operate as a revocation of power	1.36
Certificate of good standing	1.21(a)(4)
Fee on admission	1.21(a)
Office cannot aid in selection of	1.31
Personal interviews with examiners	1.133
Power of attorney	1.32
Representation in international application	1.455
Representative capacity	1.33, 1.34
Required to conduct business with decorum and courtesy	1.3
Revocation of power	1.36(a)
Withdrawal of	1.36(b), 41.5
Authorization of agents. (See Attorneys and agents)	
Award in arbitration	1.335

B

Balance in deposit account	1.25
Basic filing fee	1.16
Basic national fee	1.492
Benefit of earlier application	1.78
Bill in equity. (See Civil action)	
Biological material. (See Deposit of Biological material)	
Board of Patent Appeals and Interferences (renamed as Patent Trial and Appeal Board). (See Appeal to Patent Trial and Appeal Board, Patent Trial and Ap- peal Board, Inter Partes Review, Post-Grant Review, Derivation Proceeding, Patent Trial Practice and Procedure, and Interferences)	
Briefs:	
In petitions to Director	1.181
On appeal to Patent Trial and Appeal Board	41.37
Business to be conducted with decorum and courtesy	1.3
Business to be transacted in writing	1.2

C

Certificate of correction	1.322, 1.323
Fee	1.20(a)
Mistakes not corrected	1.325
Certificate of mailing (as first class mail) or transmission	1.8
Certificate, reexamination	1.570
Certified copies of records, papers, etc	1.4(f), 1.13
Fee for certification	1.19(b)
Chemical and mathematical formulas and tables	1.58
Citation of prior art in patent	1.501
Citation of references by examiner	1.104(d)

37 CFR Ch. I (7-1-15 Edition)

Civil action	90.1-90.3
Claims (see also Examination of applications):	
Amendment of	1.121
Date of invention of	1.110
Dependent	1.75
Design patent	1.153
In an international application	1.436
May be in dependent form	1.75
More than one permitted	1.75
Multiple dependent	1.75
Must conform to invention and specification	1.75
Notice of rejection of	1.104
Numbering of	1.126
Part of complete application	1.51
Patentably indistinct, same applicant or owner	1.78(f), (g)
Plant patent	1.164
Rejection of	1.104(c)
Required	1.75
Separate Sheet required for commencement of claim(s)	1.52(b), 1.75(h)
Twice or finally rejected before appeal	41.31(a)
Color drawing	1.84(a)(2)
Color photographs	1.84(b)(2)
Commissioner of Patents and Trademarks. (See Director of the USPTO)	
Common Ownership, statement by assignee may be required	1.78
Compact disc submissions:	
Computer program listings	1.96
Requirements	1.52(e)
Sequence listings	1.821(c)
Tables	1.58
Complaints against examiners, how presented	1.3
Composition of matter, specimens of ingredients may be required	1.93
Computer program listings	1.96
Concurrent office proceedings	1.565
Conduct of <i>ex parte</i> reexamination proceedings	1.550
Continued examination, request for	1.114
Continued Prosecution Application (CPA), Design	1.53(d)
Continuing application for invention disclosed and claimed in prior ap- plication	1.53(b)
Copies of patents, published applications, records, etc.	1.11, 1.12, 1.13
Copies of records, fees	1.19(b), 1.59
Copyright notice in drawings	1.84(s)
Copyright notice in specification	1.71(d)
Corrected publication of application	1.221
Correction, certificate of	1.322, 1.323
Correction of inventorship	1.48, 1.324
Correspondence:	
Address, only one recognized	1.33(c)
Addresses for non-trademark correspondence	1.1
Business with the Office to be transacted by	1.2
Discourteous communications not entered	1.3
Double, with different parties in interest not allowed	1.33
Facsimile transmissions	1.6(d)
Held with attorney or agent	1.33
Identification of application or patent in letter relating to	1.5
Involving national security	5.1
May be held exclusively with assignee of entire interest	3.71
Nature of	1.4
Patent owners in reexamination	1.33(c)

Index I

Receipt of letters and papers	1.6
Rules for conducting in general.....	1.1-1.8
Separate letter for each subject or inquiry	1.4(c)
Signature requirements.....	1.4(d)
When no attorney or agent.....	1.33
With attorney or agent after power or authorization is filed	1.33
Court of Appeals for the Federal Circuit, appeal to. (See Appeal to Court of Appeals for the Federal Circuit)	
CPA (Continued Prosecution Application), Design.....	1.53(d)
Credit card payment.....	1.23
Customer Number:	
Defined	1.32(a)(5)
Required to establish a Fee Address.....	1.363(c)
Covered Business Method Patent Review. (See also Patent Trial Practice and Procedure; Post-Grant Review):	
General	42.300-42.304
Procedure; pendency.....	42.300
Definitions.....	42.301
Who may petition	42.302
Time for filing	42.303
Content of petition	42.304

D

Date of invention of subject matter of individual claims.....	1.110
Day for taking any action or paying any fee falling on Saturday, Sunday, or Federal holiday	1.7, 1.9(h)
Daytime telephone number.....	1.33(a)
Death or legal incapacitation of inventor.....	1.43
In an international application	1.422
Decision on appeal by the Patent Trial and Appeal Board	41.50
Action following decision	41.54
Declaration (See also Oath in patent application).	
Foreign language.....	1.69
In lieu of oath.....	1.68
In patent application.....	1.68
Requirements to enter the U.S. national phase.....	1.497
Deferral of examination.....	1.103
Definitions:	
Applicant.....	1.42
Assignment	3.1
Customer Number	1.32(a)(5)
Document	3.1
Effective filing date of a claimed invention	1.109
Federal holiday within the District of Columbia	1.9(h)
Inventorship.....	1.9(d), 1.41
Joint Research Agreement	1.9(e)
Micro entity	1.29
National and international applications	1.9
National security classified	1.9(i)
Nonprofit organization(for small entity purposes)	1.27(a)(3)
Nonprovisional application.....	1.9(a)(3)
Paper	1.9(k)
Person (for small entity purposes).....	1.27(a)(1)
Power of attorney	1.32(a)(2)
Principal	1.32(a)(3)
Provisional application	1.9(a)(2)
Published application	1.9(c)

37 CFR Ch. I (7-1-15 Edition)

Recorded document.....	3.1
Revocation	1.32(a)(4)
Service of process	15 C.F.R. Part 15
Small business concern (for small entity purposes).....	1.27(a)(2)
Small entity.....	1.27(a)
Terms under Patent Cooperation Treaty	1.401
Delivery of patent.....	1.315
Deposit accounts	1.25
Fees.....	1.21(b)
Deposit of computer program listings.....	1.96
Deposit of biological material:	
Acceptable depository	1.803
Biological material	1.801
Examination procedures	1.809
Furnishing of samples.....	1.808
Need or Opportunity to make a deposit.....	1.802
Replacement or supplemental deposit	1.805
Term of deposit.....	1.806
Time of making original deposit	1.804
Viability of deposit.....	1.807
Depositions (See also Testimony in interferences):	
Certificate of officer to accompany.....	41.157(e)
Formalities to be observed in preparing	41.157
Person before whom taken	41.157
Description of invention. (See Specification)	
Design Patent Applications:	
Arrangement of specification	1.154
Claim	1.153(a)
Description	1.153(a)
Drawing	1.152
Expedited Examination	1.155
Filing fee.....	1.16(b)
Issue fee	1.18(b)
Oath.....	1.153(b)
Rules applicable.....	1.151
Title.....	1.153(a)
Determination of request for <i>ex parte</i> reexamination	1.515
Derivation Proceeding (See also Patent Trial Practice and Procedure)	
General	42.400-42.407
Procedure; pendency.....	42.400
Definitions.....	42.401
Who may petition	42.402
Time for filing	42.403
Derivation Fee.....	42.15, 42.404
Content of petition	42.405
Service of petition	42.406
Filing date	42.407
Institution of derivation proceeding	42.408
After Institution.....	42.409-42.412
Settlement agreement.....	42.409
Arbitration	42.410
Common interests in the invention	42.411
Public availability of Board records.....	42.412
Director of the USPTO (See also Petition to the Director):	
Address of	1.1
Availability of decisions by.....	1.14
Cases decided by Board reopened only by	1.198

Index I

Initiates <i>ex parte</i> reexamination.....	1.520
Disclaimer, statutory:	
During interference.....	41.127(b)
Fee.....	1.20(d)
Requirements of.....	1.321
Terminal.....	1.321
Discovery in interferences.....	41.150
Division. (See Restriction of application)	
Division of patent on reissue.....	1.177
Document supply fees.....	1.19
Drawing:	
Amendment of.....	1.121(d)
Annotated drawings.....	1.121(d)
Arrangement of views.....	1.84(i)
Arrows.....	1.84(r)
Character of lines.....	1.84(l)
Color.....	1.84(a)(2)
Content of drawing.....	1.83
Conventional features.....	1.83(a)
Copyright notice.....	1.84(s)
Correction.....	1.84(w), 1.85(c), 1.121(d)
Cost of copies of.....	1.19
Description, brief and detailed.....	1.74
Design application.....	1.152
Figure for front page.....	1.76(b)(3), 1.84(j)
Filed with application.....	1.81
Graphics.....	1.84(d)
Hatching and shading.....	1.84(m)
Holes.....	1.84(x)
Identification.....	1.84(c)
If of an improvement, must show connection with old structure.....	1.83(b)
Incorporation by reference to prior application.....	1.57
In international applications.....	1.437
Ink.....	1.84(a)(1)
Lead lines.....	1.84(q)
Legends.....	1.84(o)
Letters.....	1.84(p)
Location of names.....	1.84(c)
Margin.....	1.84(g)
Mask work notice.....	1.84(s)
Must show every feature of the invention.....	1.83(a)
No return or release.....	1.85(b)
Numbering of sheets.....	1.84(t)
Numbering of views.....	1.84(u)
Numbers.....	1.84(p)
Original should be retained by applicant.....	1.81(a)
Paper.....	1.84(e)
Part of application papers.....	1.52(b)
Photographs.....	1.84(b)
Plant patent application.....	1.81, 1.165
Printed and published by the Office when patented.....	1.84
Reference letters, numerals, and characters.....	1.74, 1.84(p)
Reissue.....	1.173(a)(2)
Release not permitted.....	1.85(b)
Replacement drawings.....	1.121(d)
Required by law when necessary for understanding.....	1.81
Scale.....	1.84(k)
Security markings.....	1.84(v)

37 CFR Ch. I (7–1–15 Edition)

Shading	1.84(m)
Size of sheet	1.84(f)
Standards for drawings	1.84
Symbols	1.84(n)
Views	1.84(h)
When necessary, part of complete application	1.51
Duplicate copies	1.4(b)
Duty of disclosure	1.56, 1.555, 1.933
Patent term extension	1.765

E

Early publication of application	1.219
Eighteen-month publication of applications. (See Publication of applications)	
Election of species	1.146
Electronic documents	1.52(e)
Application size fee	1.16(s), 1.52(f)
Non-electronic filing fee	1.16(t)
Electronic filing of application	1.6(a)(4), 1.52(a)(5)
Establishing micro entity status	1.29
Establishing small entity status	1.27, 1.28
Evidence. (See Testimony in interferences)	
<i>Ex parte</i> reexamination. (See Reexamination)	
Examination of applications:	
Advancement of examination	1.102
As to form	1.104(a)(1)
Citation of references	1.104(d)
Completeness of examiner's action	1.104(b)
Deferral of	1.103
Examiner's action	1.104(a)
International-type search	1.104(a)(3)
Nature of examination	1.104(a)
Prioritized examination	1.102(e)
Reasons for allowance	1.104(e)
Reconsideration after rejection if requested	1.111
Reissue	1.176
Rejection of claims	1.104(c)
Request for continued examination(RCE)	1.114
Requirement for information by examiner	1.105
Suspension of action by the Office	1.103
Examiners:	
Answers on appeal	41.39
Complaints against	1.3
Interviews with	1.133, 1.560
Executors	1.42, 1.64, 1.422
Exhibits. (See Models and exhibits)	
Expedited examination of design applications	1.155
Export of technical data	5.19, 5.20
Express abandonment	1.138
To avoid publication	1.138(c)
Express mail	1.10
Date of receipt of	1.6
Petition in regard to	1.10
Expungement of information	1.59
Extension of patent term. (See also Patent term adjustment):	
Due to examination delay under the URAA (35 U.S.C. 154)	1.701
Due to regulatory review period (35 U.S.C. 156):	
Applicant for	1.730

Index I

Application for	1.740
Calculation of term:	
Animal Drug Product	1.778
Food or color additive	1.776
Human drug product	1.775
Medical device	1.777
Veterinary biological product	1.779
Certificate	1.780
Conditions for	1.720
Determination of eligibility	1.750
Duty of disclosure	1.765
Filing date of application	1.741
Formal requirements	1.740
Incomplete application	1.741
Interim extension	1.760, 1.790
Multiple applications	1.785
Patents subject to	1.710
Signature requirements for application	1.730
Withdrawal of application	1.770
Extension of time	1.136
Fees	1.17(a)
Interference proceedings	41.4
Reexamination proceedings	1.550(c)

F

Facsimile transmissions	1.6(d), 1.8
Federal Holiday, time for taking action	1.7, 1.9(h)
FEDERAL REGISTER, publication of rules in	1.351
Fees and payment of money:	
Credit card	1.23(b)
Deposit account	1.25
Document supply fees	1.19
Extension of time	1.17(a)
Fee on appeal to the Court of Appeals for the Federal Circuit provided by rules of court	90.2
Fees payable in advance	1.22(a)
Foreign filing license petition	1.17(g)
For international-type search report	1.21(e)
Itemization required	1.22(b)
Method of payment	1.23
Money by mail at risk of sender	1.23(a)
Money paid by mistake or in excess	1.26
Necessary for application to be complete	1.51
Petition fees	1.17(f), 1.17(g), 1.17(h), 41.20(a)
Prioritized examination	1.17(c)
Processing fees	1.17(i)
Publication of application	1.18(d), 1.211(e)
Reexamination request	1.20(c)
Refunds	1.26, 1.28
Relating to international applications	1.445, 1.492
Schedule of fees and charges	1.16-1.21
Files open to the public	1.11, 1.14
Filing date of application	1.53
Filing, search and examination fees	1.16
Filing of interference settlement agreements	41.205
Final rejection:	
Appeal from	41.31

37 CFR Ch. I (7-1-15 Edition)

Response to 1.113, 1.114, 1.116, 1.129
When and how given 1.113
First Class Mail 1.8
Foreign application 1.55
License to file 5.11-5.25
Foreign country:
Taking oath in 1.66
Taking testimony in 41.156, 41.157
Foreign mask work protection Part 150
Evaluation of request 150.4
Definition 150.1
Duration of proclamation 150.5
Initiation of evaluation 150.2
Mailing address 150.6
Submission of requests 150.3
Formulas and tables in patent applications 1.58
Fraud practiced or attempted on Office 1.27(h), 1.56, 1.555, 1.765
Freedom of Information Act Part 102

G

Gazette. (See *Official Gazette*)
General authorization to charge deposit account 1.25
General information and correspondence 1.1-1.8, 1.10
Government acquisition of foreign patent rights Part 501
Government employee invention Part 501
Government interest in patent, recording of 3.11, 3.31, 3.41, 3.58
Governmental registers 3.58

H

Hearings:
Before the Patent Trial and Appeal Board 41.47
Fee for appeal hearing 41.20
In disciplinary proceedings 11. 44
Of motions in interferences 41.124
Holiday, time for action expiring on 1.6, 1.7

I

Identification of application, patent or registration 1.5
Incorporation by Reference 1.57
Information disclosure statement:
At time of filing application 1.51(d)
Content of 1.98
Not permitted in provisional applications 1.51(d)
Reexamination 1.555, 1.902
To comply with duty of disclosure 1.97
Information, Public Part 102
Inter partes reexamination. (See Reexamination)
Interferences. (See also Depositions, Notice, Statement in interferences, Testimony in interferences):
Abandonment of the contest 41.127(b)
Access to applications 41.109
Action by examiner after interference 41.127
Addition of new party by judge 41.203
Amendment during 41.121, 41.208
Appeal to the Court of Appeals for the Federal Circuit 90.1-90.3
Applicant requests 41.202

Index I

Arbitration.....	41.126
Burden of proof	41.121(b)
Civil action.....	90.1-90.3
Concession of priority	41.127(b)
Correspondence	41.10
Decision on motions	41.125
Declaration of interference	41.203
Definition	41.100, 41.201
Disclaimer to avoid interference	41.127(b)
Discovery	41.150
Extensions of time	41.4
Identifying claim from patent.....	41.202
In what cases declared.....	41.203
Inspection of cases of opposing parties	41.109
Interference with a patent	41.202
Judgment	41.127
Junior party fails to overcome filing date of senior party.....	41.204
Jurisdiction of interference	41.103
Manner of service of papers.....	41.106
Motions	41.121, 41.155, 41.208
Notice and access to applications of opposing parties	41.109
Notice of basis for relief	41.120, 41.204
Notice of reexamination, reissue, protest or litigation.....	41.8
Notice to file civil action	90.2
Oral argument.....	41.124
Ownership of applications or patents involved	41.206
Petitions	41.3
Preparation for.....	41.202
Priority statement.....	41.204
Prosecution by assignee	41.9
Recommendation by Patent Trial and Appeal Board.....	41.127
Record and exhibits	41.106, 41.154
Records of, when open to public.....	1.11, 41.6
Reissue filed by patentee during	41.203
Request by applicant.....	41.202
Return of unauthorized papers	41.128
Review of decision by civil action	90.1-90.3
Same party.....	41.206
Sanctions for failure to comply with rules or order.....	41.128
Sanctions for taking and maintaining a frivolous position	41.128
Secrecy order cases	5.3(b)
Service of papers	41.106
Status of claims of defeated applicant after interference	41.127
Statutory disclaimer by patentee during	41.127(b)
Suggestion of claims for interference	41.202
Suspension of other proceedings	41.103
Testimony copies	41.157
Time period for completion.....	41.200
Times for discovery and taking testimony	41.150, 41.156, 41.157
Translation of document in foreign language	41.154
International application. (See Patent Cooperation Treaty)	
International Bureau	1.415
International Preliminary Examining Authority, United States as	1.416
International Searching Authority, United States as	1.413
Interview summary	1.133
Interviews with examiner	1.133, 1.560
Inter Partes Review. (See also Patent Trial Practice and Procedure):	
General	42.100-42.107

37 CFR Ch. I (7-1-15 Edition)

Procedure; pendency 42.100
Who may petition 42.101
Time for filing 42.102
Fee 42.15, 42.103
Content of petition 42.104
Service of petition 42.105
Filing date 42.106
Preliminary response 42.107
Instituting a review 42.108
After Institution 42.120-42.123
 Patent owner response 42.120
 Motion to amend 42.121
 Multiple proceedings; joinder 42.122
 Supplemental information 42.123
Invention promoters:
 Complaints regarding 4.1-4.6
 Publication of 4.1, 4.3, 4.5
 Reply to 4.4
 Submission of 4.3
 Withdrawal of 4.4
 Definition 4.2
Inventor (see also Oath in patent application):
 Death or legal incapacity of 1.43
 In international application 1.422,
 May apply for patent 1.42
 Unavailable or refuses to sign application 1.64
Inventor's certificate priority benefit 1.55
Inventorship and date of invention of the subject matter of individual
 claims 1.110
Issue fee 1.18
Issue of patent. (See Allowance and issue of patent)

J

Joinder of inventions in one application 1.141-1.146
Joint inventors 1.45, 1.47, 1.48, 1.324, 1.421(b)
Joint patent to inventor and assignee 1.46, 3.81
Jurisdiction:
 After decision by Patent Trial and Appeal Board 1.197, 1.198
 After notice of allowance 1.312, 1.313
 Of involved files in contested case 41.103

L

Legal representative of deceased or incapacitated inventor 1.42, 1.43, 1.64
 In international application 1.422
Legal Processes Part 104
Legibility of papers which are to become part of the permanent Office
 records 1.52(a)
Letters to the Office. (See Correspondence)
Library service fee 1.19(c)
License and assignment of government interest in patent 3.11, 3.31, 3.41
License for foreign filing 5.11-5.15
List of U.S. Patents classified in a subclass, cost of 1.19(d)
Local delivery box rental 1.21(d)
Lost files 1.251

Index I

M

Mail Stops	
Mail Stop Assignment Recordation Services	1.1(a)(4), 3.27
Mail Stop Document Services	1.1(a)(4)
Mail Stop Ex parte Reexam	1.1(c)(1), 1.1(c)(4)
Mail Stop Inter partes Reexam.....	1.1(c)(2)
Mail Stop Interference	41.10(b)
Mail Stop OED.....	1.1(a)(5), 4.6
Mail Stop Patent Ext	1.1(e)
Mail Stop PCT.....	1.1(b), 1.417, 1.434(a), 1.480(b)
Mail Stop Supplemental Examination.....	1.1(c)(3)
Maintenance fees.....	1.20(e)-(h)
Acceptance of delayed payment of.....	1.378
Address for payments and correspondence	1.1(d)
Fee address for.....	1.363
Review of decision refusing to accept.....	1.377
Submission of	1.366
Time for payment of.....	1.362
Mask work notice in specification	1.71(d)
Mask work notice on drawing	1.84(s)
Mask work protection, foreign.....	Part 150
Microorganisms. (See Deposit of Biological Material)	
Minimum balance in deposit accounts	1.25
Misjoinder of inventor	1.48, 1.324, 1.497(d)
Missing pages when application filed	
Petition alleging there were no missing pages.....	1.53(e)
Petition with new oath or declaration and later submission of missing pages seeking new filing date	1.182
Mistake in patent, certificate thereof issued	1.322, 1.323
Models and exhibits:	
Copies of.....	1.95
Disposal unless return arrangements made	1.94
In contested cases	41.154
May be required if deemed necessary in examination of applica- tion	1.91(b)
Model not generally admitted as part of application or patent	1.91
Not to be taken from the Office except in custody of sworn em- ployee.....	1.95
Return of.....	1.94
Working model may be required	1.91(b)
Money. (See Fees and payment of money)	
Motions in interference.....	41.121, 41.155, 41.208
To take testimony in foreign country	41.156, 41.157

N

Name of applicant	1.41
New matter inadmissible in application.....	1.53(b), 1.121(f)
New matter inadmissible in reexamination	1.530(d), 1.552(b)
New matter inadmissible in reissue.....	1.173
Non-English language specification fee.....	1.17(i)
Nonprofit organization:	
Definition (for small entity purposes).....	1.27(a)(3)
Nonpublication request.....	1.213
Notice:	
Of allowance of application	1.311
Of appeal to the Court of Appeals for the Federal Circuit.....	90.1-90.3

37 CFR Ch. I (7-1-15 Edition)

Of arbitration award 1.335
 Of defective reexamination request 1.510(c)
 Of interference 41.101, 41.203
 Of oral hearings on appeals before Patent Trial and Appeal Board 41.47
 Of rejection of an application 1.104(a)
 Nucleotide and/or Amino Acid Sequences:
 Amendments to 1.825
 Disclosure in patent application 1.821
 Form and format for computer readable form 1.824
 Format for sequence data 1.822
 Replacement of 1.825
 Requirements 1.823
 Submission on compact disc 1.52, 1.821, 1.823

O

Oath or declaration (inventor?s) in patent application:
 Assignment may serve as 1.63(e)
 Apostilles 1.66
 Before whom taken in foreign countries 1.66
 Before whom taken in the United States 1.66
 By administrator or executor 1.42, 1.63, 1.64, 1.497(b)
 Certificate of Officer administering 1.66
 Continuation-in-part 1.63(e)
 Declaration in lieu of oath 1.68
 Foreign language 1.69
 Identification of specification to which it is directed 1.63
 International application, National Stage 1.497
 Inventor's Certificate 1.63
 Made by inventor 1.41, 1.63, 1.64
 Officers authorized to administer oaths 1.66
 Part of complete application 1.51
 Person making 1.63, 1.64
 Plant patent application 1.162
 Requirements of 1.63
 Ribbed to other papers 1.66
 Sealed 1.66
 Signature to 1.4, 1.63, 1.64, 1.67
 Substitute Statement 1.64
 Supplemental 1.67
 To acknowledge duty of disclosure 1.63
 When taken abroad to seal all papers 1.66
 Oath or declaration in reissue application 1.172, 1.175
 Object of the invention 1.73
 Office action time for reply 1.134
 Office fees. (See Fees and payment of money)
 Official action, based exclusively upon the written record 1.2
 Official business, should be transacted in writing 1.2
Official Gazette:
 Amendments to rules published in 1.351
 Announces request for reexamination 1.11(c), 1.525, 1.904
 Notice of filing application to nonsigning inventor 1.47
 Notice of issuance of *ex parte* reexamination certificate 1.570(f)
 Notice of issuance of *inter partes* reexamination certificate 1.997
 Service of notices in 41.101
 Oral statements 1.2
 Order to reexamine 1.525
 Ownership, statement establishing by assignee 3.73(b)

Index I

P

Paper, definition of	1.9(k)
Papers (requirements to become part of Office permanent records)	1.52
Handwritten, not permitted	1.52(a)
Papers not received on Saturday, Sunday or holidays	1.6
Patent application. (See Application for patent and Provisional patent applica- tions)	
Patent application publication. (See Published application)	
Patent attorneys and agents. (See Attorneys and agents)	
Patent Cooperation Treaty:	
Amendments and corrections during international processing	1.471
Amendments during international preliminary examination	1.485
Applicant for international application	1.421
Changes in person, name and address, where filed	1.421(f), 1.472
Commencement of the national stage	1.491(a)
Conduct of international preliminary examination	1.484
Definition of terms	1.401
Delays in meeting time limits	1.468
Demand for international preliminary examination	1.480
Designation of States	1.432
Election of States	1.480(d)
Entry into national stage	1.491(b), 1.495
Examination at national stage	1.496
Fees:	
Due within one month of filing international application	1.431(c)
Failure to pay results in withdrawal of application	1.431(d), 1.432
Filing and processing fees	1.445
International preliminary examination	1.481, 1.482
National stage	1.492
Refunds	1.26, 1.446, 1.480(c)
Filing by other than inventor	1.421(c), 1.422
International application requirements	1.431
Abstract	1.438
Claims	1.436
Description	1.435
Drawings	1.437
Physical requirements	1.433
Request	1.434
International Bureau	1.415
Inventor deceased	1.422, 1.497
Inventor insane or legally incapacitated	1.497
Inventors, joint	1.421(b), 1.497
Inventorship, correction in national phase	1.497(d)
National stage examination	1.496
Oath or declaration at national stage	1.497
Priority, claim for	1.451, 1.452
Record copy to International Bureau, Transmittal procedures	1.461
Representation by attorney or agent	1.455
Time limits for processing applications	1.465, 1.468
Translation:	
Of international application for U.S. national phase	1.495
Of publication of international application for provisional rights	1.417
United States as:	
Designated or Elected Office	1.414
International Preliminary Examining Authority	1.416
International Searching Authority	1.413

37 CFR Ch. I (7–1–15 Edition)

Receiving Office	1.412
Unity of invention:	
Before International Searching Authority	1.475, 1.476
Before International Preliminary Examining Authority	1.488
National stage	1.475, 1.499
Protest to lack of	1.477, 1.489
Withdrawal of international application, designations, priority claims, demands and elections	1.421(g), 1.431(d)
Patent term adjustment due to examination delay	1.702-1.705
Application for	1.705
Determination	1.705
Grounds for	1.702
Period of adjustment	1.703
Reduction of period of adjustment	1.704
Patent term extension due to examination delay	1.701
Patent term extension due to regulatory review period. (See Extension of patent term due to regulatory review period (35 U.S.C. 156))	41.101, 41.203
Patentee notified of interference	41.101, 41.203
Patents. (see also Allowance and issue of Patent):	
Available for license or sale, publication of notice	1.21(i)
Certified copies of	1.13
Correction of errors in	1.171, 1.322, 1.323, 1.324
Delivery of	1.315
Disclaimer	1.321
Identification required in letters concerning	1.5
Obtainable by civil action	90.1-90.3
Price of copies	1.19
Records of, open to public	1.11
Reissuing of, when defective	1.171-1.178
Payment of fees	1.23
Person, definition for small entity purposes	1.27(a)(1)
Personal attendance unnecessary	1.2
Petition for reissue	1.171, 1.172
Patent Trial and Appeal Board. (See Appeal to Patent Trial and Appeal Board, Inter Partes Review, Post-Grant Review, Derivation Proceeding, Patent Trial Practice and Procedure, and Interferences)	
Patent Trial Practice and Procedure (see also inter partes review, post-grant re- view, covered business method patent review, and derivation proceeding)	
General	42.1-42.14
Policy	42.1
Definitions	42.2
Jurisdiction	42.3
Notice of trial	42.4
Conduct of the proceeding	42.5
Filing of documents, including exhibits; service	42.6
Management of the record	42.7
Mandatory notices	42.8
Action by patent owner	42.9
Counsel	42.10
Duty of candor	42.11
Sanctions	42.12
Citation of authority	42.13
Public availability	42.14
Fees	42.15
Petition and Motion Practice	42.20-42.25
General	42.20
Notice of basis for relief	42.21
Content of petitions and motions	42.22

Index I

Oppositions and replies	42.23
Page limits for petitions, motions, oppositions and replies.....	42.24
Default filing times.....	42.25
Testimony and Production	42.51-42.65
Discovery	42.51
Compelling testimony and production.....	42.52
Taking testimony	42.53
Protective order.....	42.54
Confidential information in a petition.....	42.55
Expungement of confidential information	42.56
Admissibility	42.61
Applicability of the Federal Rules of Evidence.....	42.62
Form of evidence.....	42.63
Objection; motion to exclude; motion in limine	42.64
Expert testimony; tests and data.....	42.65
Oral Argument, Decision, and Settlement	42.70-74
Oral argument.....	42.70
Decision on petitions or motions	42.71
Termination of trial.....	42.72
Judgment	42.73
Settlement	42.74
Certificate.....	42.80
Petition to the Director:	
Fees	1.17
For delayed payment of issue fee.....	1.137
For license for foreign filing	5.12
For the revival of an abandoned application	1.137
From formal objections or requirements.....	1.113, 1.181
From requirement for restriction.....	1.129, 1.144
General requirements	1.181
In interferences	41.3
In reexamination	1.515(c)
On refusal of examiner to admit amendment	1.127
Petition to accept an unintentionally delayed claim for domestic ben- efit.....	1.78
Petition to accept an unintentionally delayed claim for foreign pri- ority	1.55
Questions not specifically provided for.....	1.182
Suspension of rules	1.183
To exercise supervisory authority	1.181
To make special	1.102
Plant patent applications:	
Applicant.....	1.42, 1.162
Claim	1.164
Declaration	1.162
Description	1.162
Drawings.....	1.165
Examination	1.167
Fee for copies	1.19
Filing fee.....	1.16(c)
Issue fee.....	1.18(c)
Latin named genus and species	1.76(b)(3), 1.163(c)(4)
Oath	1.162
Rules applicable.....	1.161
Specification.....	1.163
Specimens.....	1.166
Post issuance fees.....	1.20
Post Office receipt as filing date.....	1.10

37 CFR Ch. I (7-1-15 Edition)

Postal emergency or interruption.....	1.10(g)-(i)
Post-Grant Review. (See also Patent Trial Practice and Procedure):	
General	42.200-42.207
Procedure; pendency.....	42.200
Who may petition	42.201
Time for filing	42.202
Fee	42.15, 42.203
Content of petition	42.204
Service of petition	42.205
Filing date	42.206
Preliminary response.....	42.207
Instituting a review	42.208
After Institution.....	42.220-42.224
Patent owner response.....	42.220
Motion to amend	42.221
Multiple proceedings; joinder	42.222
Supplemental information	42.223
Discovery	42.224
Power of attorney. (See Attorneys and agents)	
Preliminary amendments	1.115
Preserved in confidence, applications.....	1.12, 1.14
Exceptions (status, access or copies available)	1.14
Prior art citation in patent files	1.501
Prior art statement:	
Content of	1.98
In reexamination	1.555, 1.933
To comply with duty of disclosure.....	1.97
Prior art submission by third party:	
In patent application	1.290
In patent file	1.501
In protest against pending unpublished application.....	1.291
Prior Invention, affidavit or declaration of, to overcome rejection	1.131
Prior public disclosure, affidavit or declaration of, to overcome rejection	1.130
Prioritized examination	1.102(e)
Priority, international applications.....	1.451
Priority, right of, under treaty or law	1.55
Priority statement in interferences:	
Contents of.....	41.204
Correction of statement on motion.....	41.120
Effect of statement	41.204
Failure to file.....	41.204
In case of motion to amend interference.....	41.208
May be amended if defective	41.120
Reliance on prior application.....	41.204
Requirement for	41.204
Service on opposing parties.....	41.204
When opened to inspection.....	41.204
Proclamation as to protection of foreign mask works.....	Part 150
Protests to grant of patent	1.291
Provisional patent applications:	
Claiming the benefit of	1.78
Converting a nonprovisional to a provisional	1.53(c)(2)
Converting a provisional to a nonprovisional	1.53(c)(3)
Filing date.....	1.53
Filing fee.....	1.16(d)
General requisites	1.51(c)
Later filing of filing fee and cover sheet.....	1.53(g)

Index I

Names of all inventors required.....	1.41, 1.53(c)
No right of priority	1.53(c)(4)
No examination	1.53(i)
Papers concerning, must identify provisional applications as such, and by application number	1.5(f)
Parts of complete provisional application	1.51(c)
Processing fees.....	1.17(i)
Revival of.....	1.137
When abandoned	1.53(i)
Public information.....	Part 102
Fee	1.17(j)
Publication:	
Of reexamination certificate	1.570(f), 1.997(f)
Publication of application	1.211
Early publication.....	1.219
Express abandonment to avoid publication	1.138(c)
Fee.....	1.18
Nonpublication request.....	1.213
Publication of redacted copy	1.217
Republication	1.221
Voluntary publication	1.221
Published application	
Access to	1.11, 1.14
Certified copies.....	1.13
Contents.....	1.215
Definition	1.9(c)
Records of, open to public.....	1.11, 1.12
Republication of	1.221
Third party submission in	1.290

R

RCE (Request for continued examination)	1.114
Reasons for allowance	1.104(e)
Reconsideration of Office action.....	1.112
Reconstruction of lost files	1.251
Recording of assignments. (See Assignments and recording)	
Records of the Patent and Trademark Office	1.11-1.15
Redacted publication of application	1.217
Reexamination:	
Amendments, manner of making	1.121(c)
Announcement in <i>Official Gazette</i>	1.11(c)
Correction of inventorship.....	1.530
Correspondence address.....	1.33(c)
<i>Ex parte</i> proceedings	
Amendments, manner of making	1.21(j), 1.530
Appeal to Board	41.31
Appeal to C.A.F.C.	90.1-90.3
Civil action under 35 U.S.C. 145.....	90.1-90.3
Concurrent with interference, reissue, other reexamination, litiga- tion or office proceedings(s).....	1.565
Conduct of.....	1.550
Duty of disclosure in	1.555
Examiner's determination to grant or refuse request for	1.515
Extensions of time	1.550(c)
Initiated by the Director.....	1.520
Interviews in	1.560
Issuance of certificate at conclusion of.....	1.570

37 CFR Ch. I (7-1-15 Edition)

Order for reexamination by examiner	1.525
Patent owner's statement	1.530, 1.540
Processing of prior art citations during	1.502
Reply to patent owner's statement to third party requester	1.535, 1.540
Request for	1.510
Scope of	1.552
Service of papers	1.248
Examiner's action	1.104
Fee	1.20(c)
Fee charged to deposit account	1.25
Identification in letter	1.5(d)
<i>Inter partes</i> proceedings	1.902-907
Amendments, manner of making	1.121(j), 1.530, 1.941
Appeal to Board	41.61
Appeal to C.A.F.C.	1.983
Civil action under 35 U.S.C. 145 not available	90.1-90.3
Concurrent with interference, reissue, other reexamination, litigation or office proceedings(s)	1.565, 1.985
Conduct of	1.937
Duty of disclosure in	1.555, 1.933
Examiner's determination to grant or refuse request for	1.923-1.927
Extensions of time	1.956
Filing date of request for	1.919
Issuance of certificate at conclusion of	1.997
Merged with concurrent reexamination proceedings	1.989
Merged with reissue application	1.991
Notice of, in the <i>Official Gazette</i>	1.904
Persons eligible to file request for	1.903
Processing of prior art citations during	1.902
Scope of	1.906
Service of papers	1.248, 1.903
Submission of papers by the public	1.905
Subsequent requests for	1.907
Suspension due to concurrent interference	1.993
Suspension due to litigation	1.987
Information Disclosure Statements	1.98, 1.555
Open to public	1.11(d)
Reconsideration before final action	1.112
Refund of fee	1.26
Reply to action	1.111
Revival of termination examination	1.137
Reference characters in drawings	1.74, 1.84(p)
References cited on examination	1.104(d)
Refund of money paid by mistake	1.26
Refund of international application filing and processing fees	1.446
Register of Government interest in patents	3.58
Rehearing:	
Of appeal decisions by Patent Trial and Appeal Board	41.52
Request for, time for appeal after action on	90.3
Reissues:	
Amendments	1.173
Applicants, assignees	1.172
Application for reissue	1.171
Application made and sworn to by inventor, if living	1.172
Declaration	1.175
Drawings	1.173(a)(2), 1.173(b)(3)
Examination of reissue	1.176
Filed during interference	41.202, 41.203

Index I

Filing during reexamination	1.565, 1.985
Filing fee	1.16
Filing of announced in <i>Official Gazette</i>	1.11(b)
Grounds for and requirements.....	1.171-1.173, 1.175-1.178
Issue fee	1.18(a)
Oath	1.175
Open to public	1.11
Original claims subject to reexamination	1.176
Original patent surrendered	1.178
Reissue in divisions	1.177
Restriction.....	1.176
Specification.....	1.173
Take precedence in order of examination.....	1.176
To contain no new matter	1.173(a)
What must accompany application.....	1.171, 1.172
Rejection:	
After two rejections appeal may be taken from examiner to Board of Appeals	1.191, 41.31
Applicant will be notified of rejection with reasons and references.....	1.104(a)(2)
Examiner may rely on admissions by applicant or patent owner, or facts within examiner's knowledge.....	1.104(c)(3)
Final	1.113
Formal objections.....	1.104
On account of invention shown by others but not claimed, how overcome	1.131
References will be cited	1.104(c)
Requisites of notice of	1.104
Reply brief	41.41
Reply by applicant or patent owner	1.111
Reply by requester.....	1.535, 1.947
Representative capacity	1.34(a)
Request for continued examination(RCE)	1.114
Request for reconsideration.....	1.112
Request for <i>ex parte</i> reexamination	1.510
Request for <i>inter partes</i> reexamination	1.913-1.927
Requirement for information	1.105
Reservation clauses not permitted.....	1.79
Response time to Office action	1.134
Restriction of application	1.141-1.146
Claims to nonelected invention withdrawn	1.142
Constructive election	1.145
Petition from requirements for	1.129, 1.144
Provisional election.....	1.143
Reconsideration of requirement	1.143
Reissue.....	1.176
Requirement for.....	1.142
Subsequent presentation of claims for different invention	1.145
Transitional procedures.....	1.129
Return of correspondence	1.5(a)
Revival of abandoned application or terminated or limited reexamination proceeding	1.137
Unintentional abandonment fee	1.17(m)
Revocation of power of attorney or authorization of agent.....	1.36(a)
Rules of Practice:	
Amendments to rules will be published	1.351

S

Saturday, when last day falls on	1.7, 1.9(h)
--	-------------

37 CFR Ch. I (7-1-15 Edition)

Scope of reexamination proceedings.....	1.552, 1.906
Secrecy order.....	5.1-5.5
Serial number of application (see also Application Number).....	1.5, 1.53, 1.54(b)
Service of notices:	
For taking testimony.....	41.157
In contested cases.....	41.101
Of appeal to the Court of Appeals for the Federal Circuit.....	90.1-90.3
Service of papers.....	1.248
Shortened period for reply.....	1.134
Signature:	
Handwritten.....	1.4(d)(1)
Implicit certifications.....	1.4(d), 1.18
S-Signature.....	1.4(d)(2)
To a written assertion of small entity status.....	1.27(c)(2)
To amendments and other papers.....	1.33(b)
To an application for extension of patent term.....	1.730
To express abandonment.....	1.138
To oath.....	1.63
To reissue oath or declaration.....	1.172
When copy is acceptable.....	1.4
Small business concern:	
Definition (for small entity purposes).....	1.27(a)(2)
Small entity:	
Definition.....	1.27(a)
License to Federal Agency.....	1.27(a)(4)
Status establishment.....	1.27, 1.28
Status update.....	1.27(g), 1.28
Written assertion.....	1.27(c)
Solicitor's address.....	1.1(a)(3)
Species of invention claimed.....	1.141, 1.146
Specification (see also Application for patent, Claims):	
Abstract.....	1.72
Amendments to.....	1.121, 1.125
Arrangement of.....	1.77, 1.154, 1.163
Best mode.....	1.71
Claim.....	1.75
Contents of.....	1.71-1.75
Copyright notice.....	1.71(d)
Cross-references to other applications.....	1.78
Description of the invention.....	1.71
Filed by reference.....	1.57(a)
If defective, reissue to correct.....	1.171-1.178
Incorporation by reference of prior filed application.....	1.57(b)
Mask work notice.....	1.71(d)
Must conclude with specific and distinct claim.....	1.75
Must point out new improvements specifically.....	1.71
Must refer by figures to drawings.....	1.74
Must set forth the precise invention.....	1.71
Object of the invention.....	1.73
Order of arrangement in framing.....	1.77
Paper, writing, margins.....	1.52
Paragraph numbering.....	1.52(b)(6)
Part of complete application.....	1.51
Reference to drawings.....	1.74
Requirements of.....	1.71-1.75
Reservation clauses not permitted.....	1.79
Substitute.....	1.125
Summary of the invention.....	1.73

Index I

Title of the invention.....	1.72(a)
To be rewritten, if necessary	1.125
Specimens. (See Models and exhibits)	
Specimens of composition of matter to be furnished when required.....	1.93
Specimens of plants	1.166
Statutory disclaimer fee	1.20(d)
Sufficient funds in deposit account.....	1.25
Suit in equity. (See Civil action)	
Summary of invention	1.73
Sunday, when last day falls on.....	1.7, 1.9(h)
Supervisory authority, petition to Director to exercise.....	1.181
Supplemental oath/declaration	1.67
Supplemental Examination of Patents:	
Conclusion of	1.625
Conduct of.....	1.620
Content of request	1.610.
Filing of papers in supplemental examination	1.601
Format of papers filed	1.615
Procedure after conclusion	1.625
Publication of certificate	1.625
Surcharge for completion of nonprovisional application after filing date.....	1.16(f), 1.53(f)
Suspension of action by Office.....	1.103
CPA, Design.....	1.103(b)
Deferral of examination	1.103(d)
For cause	1.103(a)
RCE.....	1.103(c)
Suspension of <i>ex parte</i> prosecution during interference	41.103
Suspension of rules	1.183
Symbols for drawings.....	1.84(n)
Symbols for nucleotide and/or amino acid sequence data.....	1.822

T

Tables in patent applications.....	1.58
Technological Invention	42.301
Terminal disclaimer	1.321
Testimony by Office employees	15 C.F.R. Part 15a
Testimony in interferences:	
Additional time for taking	41.4
Assignment of times for taking	41.157
Certification and filing by officer	41.157
Copies of.....	41.157
Depositions must be filed	41.157
Discovery	41.150
Effect of errors and irregularities in deposition	41.155, 41.157
Evidence must comply with rules	41.152
Examination of witnesses.....	41.157
Form of deposition	41.157
Formal objections to	41.155, 41.157
Formalities in preparing depositions	41.157
In foreign countries	41.156, 41.157
Manner of taking testimony of witnesses	41.157
Notice of examination of witnesses.....	41.157
Objections noted in depositions	41.155, 41.157
Objections to formal matters	41.155, 41.157
Officer's certificate	41.157
Persons before whom depositions may be taken	41.157

37 CFR Ch. I (7-1-15 Edition)

Service of notice.....	41.157
Stipulations or agreements concerning	41.157
Taken by depositions	41.157
Time for taking	41.157
Third-party submission in published application	1.290
Time expiring on Saturday, Sunday, or holiday	1.7, 1.9(h)
Time for payment of issue fee.....	1.311
Time for reply by applicant	1.134, 1.136
Time for reply by patent owner	1.530, 1.945
Time for reply by requester.....	1.535, 1.947
Time for reply to Office action	1.134, 1.136
Time, periods of.....	1.7
Timely filing of correspondence.....	1.8, 1.10
Title of invention.....	1.72(a)
Title reports, fee for.....	1.19(b)(4)
Transitional procedures.....	1.129

U

Unintentional abandonment.....	1.137
Unintentional delay in reexamination	1.550(e), 1.958
United States as:	
Designated Office.....	1.414
Elected Office.....	1.414
International Preliminary Examining Authority	1.416
International Searching Authority	1.413
Receiving Office.....	1.412
Unlocatable files.....	1.251
Unsigned continuation or divisional application.....	1.53, 1.63
Use of file of parent application.....	1.53(d)

V

Voluntary publication of application	1.221
--	-------

W

Waiver of confidentiality	1.53(d)(6)
Withdrawal from issue.....	1.313
Withdrawal of attorney or agent.....	1.36