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1701 Office Personnel Not To Express Opinion on Validity*,< Patentability>, or Enforceability< of Patent [R-3]

Every patent is presumed to be valid. 35 U.S.C. 282, first sentence. Public policy demands that every employee of the United States Patent and Trademark Office (USPTO) refuse to express to any person any opinion as to the validity or invalidity of, or the patentability or unpatentability of any claim in any U.S. patent, except to the extent necessary to carry out

(A) an examination of a reissue application of the patent,

(B) a reexamination proceeding to reexamine the patent, or

(C) an interference involving the patent.

The question of validity or invalidity is otherwise exclusively a matter to be determined by a court. >Likewise, the question of enforceability or unenforceability is exclusively a matter to be determined by a court.< Members of the patent examining corps are cautioned to be especially wary of any inquiry from any person outside the USPTO, including an employee of another U.S. Government agency, the answer to which might indicate that a particular patent should not have issued. No USPTO employee may pursue a bounty offered by a private sector source for

identifying prior art. The acceptance of payments from outside sources for prior art search activities may subject the employee to administrative disciplinary action.

When a field of search for an invention is requested, examiners should routinely inquire whether the invention has been patented in the United States. If the invention has been patented, no field of search should be suggested.

Employees of the USPTO, particularly patent examiners who examined an application which matured into a patent or a reissued patent or who conducted a reexamination proceeding, should not discuss or answer inquiries from any person outside the USPTO as to whether or not a certain reference or other particular evidence was considered during the examination or proceeding and whether or not a claim would have been allowed over that reference or other evidence had it been considered during the examination or proceeding. Likewise, *employees* are cautioned against answering any inquiry concerning any entry in the patent or reexamination file, including the extent of the field of search and any entry relating thereto. The record of the file of a patent or reexamination proceeding must speak for itself.

Practitioners **>shall not make< improper inquiries of members of the patent examining corps. Inquiries from members of the public relating to the matters discussed above must of necessity be refused and such refusal should not be considered discourteous or an expression of opinion as to validity *,< patentability >or enforceability.

The definitions set forth in 37 CFR 104.1 and the exceptions in 37 CFR 104.21 are applicable to this section.<

1701.01 Office Personnel Not To Testify [R-3]

It is the policy of the United States Patent and Trademark Office (USPTO) that its employees, including patent examiners, will not appear as witnesses or give testimony in legal proceedings, except under the conditions specified in 37 CFR Part 104, Subpart C. >The definitions set forth in 37 CFR 104.1 and the exceptions in 37 CFR 104.21 are applicable to this section.< Any employee who testifies contrary to this policy will be *dismissed or removed*.

Whenever an employee of the USPTO, including a patent examiner, is asked to testify or receives a subpoena, the employee shall immediately notify the Office of the USPTO General Counsel. Inquiries requesting testimony shall be also referred immediately to the Office of the USPTO General Counsel.

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Any individual desiring the testimony of an employee of the USPTO, including the testimony of a patent examiner or other quasi-judicial employee, must comply with the provisions of 37 CFR Part 104, Subpart C.

A request by a third party to take deposition testimony of a patent examiner in a pending *ex parte* reexamination proceeding will generally be denied in view of the *ex parte* nature of the reexamination proceeding.

A request for testimony of an employee of the USPTO should be made to the Office of the USPTO General Counsel at least **10 working days** prior to the date of the expected testimony.

>Patent examiners and other USPTO employees performing or assisting in the performance of quasi-judicial functions, are forbidden to testify as experts or to express opinions as to the validity of any patent.<

If an employee is authorized to testify, the employee will be limited to testifying about facts within the employee's personal knowledge. Employees are prohibited from giving expert or opinion testimony. *Fischer & Porter Co. v. Corning Glass Works*, 61 F.R.D. 321, 181 USPQ 329 (E.D. Pa. 1974). Likewise, employees are prohibited from answering hypothetical or speculative questions. *In re Mayewsky*, 162 USPQ 86, 89 (E.D. Va. 1969) (deposition of an examiner must be restricted to relevant matters of fact and must avoid any hypothetical or speculative questions or conclusions based thereon); *Shaffer Tool Works v. Joy Mfg. Co.*, 167 USPQ 170 (S.D. Tex. 1970) (deposition of examiner should be limited to matters of fact and must not go into hypothetical or speculative areas or the bases, reasons, mental processes, analyses, or conclusions of the examiner in acting upon a patent application). Employees will not be permitted to give testimony with respect to subject matter which is privileged. Several court decisions limit testimony with respect to quasi-judicial functions performed by employees. Those decisions

include *United States v. Morgan*, 313 U.S. 409, 422 (1941) (improper to inquire into mental processes of quasi-judicial officer or to examine the manner and extent to which the officer considered an administrative record); *Western Electric Co. v. Piezo Technology, Inc.*, 860 F.2d 428, 8 USPQ2d 1853 (Fed. Cir. 1988) (patent examiner may not be compelled to answer questions which probe the examiner's technical knowledge of the subject matter of a patent); *McCulloch Gas Processing Co. v. Department of Energy*, 650 F.2d 1216, 1229 (Temp. Emer. Ct. App. 1981) (discovery of degree of expertise of individuals performing governmental functions not permitted); *In re Nilssen*, 851 F.2d 1401, 7 USPQ2d 1500 (Fed. Cir. 1988) (technical or scientific qualifications of examiners-in-chief are not legally relevant in appeal under 35 U.S.C. 134 since board members need not be skilled in the art to render obviousness decision); *Lange v. Commissioner*, 352 F. Supp. 166, 176 USPQ 162 (D.D.C. 1972) (technical qualifications of examiners-in-chief not relevant in 35 U.S.C. 145 action).

In view of the discussion above, if an employee is authorized to testify in connection with the employee's involvement or assistance in a quasi-judicial proceeding which took place before the USPTO, the employee will not be permitted to give testimony in response to questions that the Office determines are impermissible. Impermissible questions include, but are not limited to, questions directed to discovering the mental processes or expertise of a quasi-judicial official, such as:

(A) Information about that employee's:

- (1) Background;
- (2) Expertise;
- (3) Qualifications to examine or otherwise consider a particular patent or trademark application;
- (4) Usual practice or whether the employee followed a procedure set out in any Office manual of practice (including the MPEP or TMPEP) in a particular case;
- (5) Consultation with another Office employee;
- (6) Understanding of:
 - (a) A patented invention, an invention sought to be patented, or patent application, patent, reexamination or interference file;

(b) Prior art;

(c) Registered subject matter, subject matter sought to be registered, or a trademark application, registration, opposition, cancellation, interference, or concurrent use file;

(d) Any Office manual of practice;

(e) Office regulations;

(f) Patent, trademark, or other law; or

(g) The responsibilities of another Office employee;

(7) Reliance on particular facts or arguments;

(B) To inquire into the manner in and extent to which the employee considered or studied material in performing a quasi-judicial function; or

(C) To inquire into the bases, reasons, mental processes, analyses, or conclusions of that Office employee in performing the quasi-judicial function.

Any request for testimony addressed or delivered to the Office of the USPTO General Counsel shall comply with 37 CFR 104.22(c). All requests must be in *writing*. The need for a subpoena may be obviated where the request complies with 37 CFR 104.22(c) if the party requesting the testimony further meets the following conditions:

(A) The party requesting the testimony identifies the civil action or other legal proceeding for which the testimony is being taken. The identification shall include the:

(1) Style of the case;

(2) Civil action number;

(3) District in which the civil action is pending;

(4) Judge assigned to the case; and

(5) Name, address, and telephone number of counsel for all parties in the civil action.

(B) The party agrees not to ask questions seeking information which is precluded by 37 CFR 104.23;

(C) The party shall comply with applicable provisions of the Federal Rules of Civil Procedure, including Rule 30, and give 10 working days notice to the Office of the USPTO General Counsel prior to the date a deposition is desired. Fifteen working days notice is required for any deposition which is desired to be taken between November 15 and January 15;

(D) The party agrees to notice the deposition at a place convenient to the USPTO. The Conference Room in the Office of the USPTO General Counsel is deemed to be a place convenient to the Office; and

(E) The party agrees to supply a copy of the transcript of the deposition to the USPTO for its records.

Absent a written agreement meeting the conditions specified in paragraphs (A) through (E), a party must comply with the precise terms of 37 CFR 104.22(c) and the USPTO will not permit a deposition without issuance of a subpoena.

1702 Restrictions on ****>Practice in Patent Matters< [R-3]**

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37 CFR 11.10. Restrictions on practice in patent matters.

(a) Only practitioners who are registered under § 11.6 or individuals given limited recognition under § 11.9(a) or (b) are permitted to prosecute patent applications of others before the Office; or represent others in any proceedings before the Office.

(b) *Post employment agreement of former Office employee.* No individual who has served in the patent examining corps or elsewhere in the Office may practice before the Office after termination of his or her service, unless he or she signs a written undertaking agreeing:

(1) To not knowingly act as agent or attorney for, or otherwise represent, or assist in any manner the representation of, any other person:

(i) Before the Office,

(ii) In connection with any particular patent or patent application,

(iii) In which said employee participated personally and substantially as an employee of the Office; and

(2) To not knowingly act within two years after terminating employment by the Office as agent or attorney for, or otherwise represent, or assist in any manner the representation of any other person:

(i) Before the Office,

(ii) In connection with any particular patent or patent application,

(iii) If such patent or patent application was pending under the employee's official responsibility as an officer or employee within a period of one year prior to the termination of such responsibility.

(3) The words and phrases in paragraphs (b)(1) and (b)(2) of this section are construed as follows:

(i) *Represent* and *representation* mean acting as patent attorney or patent agent or other representative in any appearance before the Office, or communicating with an employee of the Office with intent to influence.

(ii) *Assist in any manner* means aid or help another person on a particular patent or patent application involving representation.

(iii) *Particular patent or patent application* means any patent or patent application, including, but not limited to, a provisional, substitute, international, continuation, divisional, continuation-in-part, or reissue patent application, as well as any protest, reexamination, petition, appeal, or interference based on the patent or patent application.

(iv) *Participate personally and substantially.* (A) Basic requirements. The restrictions of § 11.10(a)(1) apply only to those patents and patent applications in which a former Office employee had “personal and substantial participation,” exercised “through decision, approval, disapproval, recommendation, the rendering of advice, investigation or otherwise.” To *participate personally* means directly, and includes the participation of a subordinate when actually directed by the former Office employee in the patent or patent application. *Substantially* means that the employee’s involvement must be of significance to the matter, or form a basis for a reasonable appearance of such significance. It requires more than official responsibility, knowledge, perfunctory involvement, or involvement on an administrative or peripheral issue. A finding of substantiality should be based not only on the effort devoted to a patent or patent application, but also on the importance of the effort. While a series of peripheral involvements may be insubstantial, the single act of approving or participation in a critical step may be substantial. It is essential that the participation be related to a “particular patent or patent application.” (See paragraph (b)(3)(iii) of this section.)

(B) Participation on ancillary matters. An Office employee’s participation on subjects not directly involving the substantive merits of a patent or patent application may not be “substantial,” even if it is time-consuming. An employee whose official responsibility is the review of a patent or patent application solely for compliance with administrative control or budgetary considerations and who reviews a particular patent or patent application for such a purpose should not be regarded as having participated substantially in the patent or patent application, except when such considerations also are the subject of the employee’s proposed representation.

(C) Role of official responsibility in determining substantial participation. *Official responsibility* is defined in paragraph (b)(3)(v) of this section. “Personal and substantial participation” is different from “official responsibility.” One’s responsibility may, however, play a role in determining the “substantiality” of an Office employee’s participation.

(v) *Official responsibility* means the direct administrative or operating authority, whether intermediate or final, and either exercisable alone or with others, and either personally or through subordinates, to approve, disapprove, or otherwise direct Government actions.

(A) Determining official responsibility. Ordinarily, those areas assigned by statute, regulation, Executive Order, job description, or delegation of authority determine the scope of an employee’s “official responsibility”. All particular matters under consideration in the Office are under the “official responsibility” of the Director of the Office, and each is under that of any intermediate supervisor having responsibility for an employee who actually participates in the patent or patent application within the

scope of his or her duties. A patent examiner would have “official responsibility” for the patent applications assigned to him or her.

(B) Ancillary matters and official responsibility. *Administrative* authority as used in paragraph (v) of this section means authority for planning, organizing and controlling a patent or patent application rather than authority to review or make decisions on ancillary aspects of a patent or patent application such as the regularity of budgeting procedures, public or community relations aspects, or equal employment opportunity considerations. Responsibility for such an ancillary consideration does not constitute official responsibility for the particular patent or patent application, except when such a consideration is also the subject of the employee’s proposed representation.

(C) Duty to inquire. In order for a former employee, *e.g.*, former patent examiner, to be barred from representing or assisting in representing another as to a particular patent or patent application, he or she need not have known, while employed by the Office, that the patent or patent application was pending under his or her official responsibility. The former employee has a reasonable duty of inquiry to learn whether the patent or patent application had been under his or her official responsibility. Ordinarily, a former employee who is asked to represent another on a patent or patent application will become aware of facts sufficient to suggest the relationship of the prior matter to his or her former office, *e.g.*, technology center, group or art unit. If so, he or she is under a duty to make further inquiry. It would be prudent for an employee to maintain a record of only patent application numbers of the applications actually acted upon by decision or recommendation, as well as those applications under the employee’s official responsibility which he or she has not acted upon.

(D) Self-disqualification. A former employee, *e.g.*, former patent examiner, cannot avoid the restrictions of this section through self-disqualification with respect to a patent or patent application for which he or she otherwise had official responsibility. However, an employee who through self-disqualification does not participate personally and substantially in a particular patent or patent application is not subject to the lifetime restriction of paragraph (b)(1) of this section.

(vi) *Pending* means that the matter was in fact referred to or under consideration by persons within the employee’s area of official responsibility.

(4) Measurement of the two-year restriction period. The two-year period under paragraph (b)(2) of this section is measured from the date when the employee’s official responsibility in a particular area ends, not from the termination of service in the Office, unless the two occur simultaneously. The prohibition applies to all particular patents or patent applications subject to such official responsibility in the one-year period before termination of such responsibility.

(c) *Former employees of the Office.* This section imposes restrictions generally parallel to those imposed in 18 U.S.C. 207(a) and (b)(1). This section, however, does not interpret these statutory provisions or any other post-employment restrictions that may apply to former Office employees, and such former employees should not assume that conduct not prohibited by this section is otherwise permissible. Former employees of the Office,

whether or not they are practitioners, are encouraged to contact the Department of Commerce for information concerning applicable post-employment restrictions.

(d) An employee of the Office may not prosecute or aid in any manner in the prosecution of any patent application before the Office.

(e) Practice before the Office by Government employees is subject to any applicable conflict of interest laws, regulations or codes of professional responsibility.<

See also MPEP § 309.

1703 The Official Gazette [R-8]

The *Official Gazette of the United States Patent and Trademark Office (Official Gazette)* is published electronically every Tuesday in two sections, the *Official Gazette – Patents* and the *Official Gazette – Trademarks*.

The *Official Gazette — Patents* reports the reexamination certificates, reissues, plant patents, utility patents, and design patents issued and statutory invention registrations (if any) published on that day. The *Official Gazette — Patents* (eOG:P) allows browsing through the issued patents for the week. The eOG:P can be browsed by classification or type of patent, for example, utility, design, and plant. Specific patents can be accessed by class/subclass or patentee name. Links are provided to the various pages of the eOG:P:

(A) *Browse by Class/Subclass* page to access patents by a specific classification;

(B) *Classification of Patents* page with links to patents by a range of classifications;

(C) *Browse Granted Patents* page to access a patent by patent number or link to patents by type;

(D) *Index of Patentees* page to browse by names of inventors and assignees in either a cumulative alphabetical index or individual indexes by type of patent. Each patentee listing contains a link to the patent;

(E) *Geographical Index of Inventors* to link to patents by the state or country of residence of the first listed inventor; and

(F) *Notices* page containing the text of important notices for the week.

As to each patent, the following information is given:

- (A) Patent number;
- (B) Title of the invention;
- (C) Applicant's name;
- (D) Applicant's city and state of residence and, if unassigned, applicant's mailing address;
- (E) Assignee's name, city and state of residence, if assigned;
- (F) U.S. or PCT parent application data, if any;
- (G) Filing date;
- (H) Application number;
- (I) Foreign priority application data, if any;
- (J) International classification;
- (K) U.S. classification by class and subclass;
- (L) Number of claims;
- (M) Selected figure of the drawing, if any;
- (N) A claim or claims;
- (O) For reissue patents, the original patent number and issue date, and the original application number and filing date; and
- (P) Patent Application Publication Number and Publication date, if any.

The *Official Gazette – Trademarks* is published electronically and contains an illustration of each trademark published for opposition, an alphabetical list of registered trademarks, a classified list of registered trademarks, an index of registrants, a list of canceled trademark registrations, and a list of renewed trademark registrations.

The information in the *Official Gazette* pertaining to each issued patent and each trademark registration can be obtained from the Patent Grants Database and the U.S. Trademark Electronic Search System (TESS) respectively, both also available on the USPTO *>Web< site.

Regular and special notices of the United States Patent and Trademark Office are published in the *Official Gazette Notices*, both as part of the *Official Gazette — Patents* (eOG:P) and as a separate publication. The notices that are included in this publication include notices of patent and trademark suits, disclaimers filed, Certificates of Correction issued, lists of applications and patents available for license or sale, notices of 37 CFR 1.47 applications, and general information such as orders, notices, changes in rules, changes in classification, certain adverse decisions in interferences, the condition of work in the Office, registration of attorneys and agents, reprimands, suspensions, and exclusions of registered attorneys and

agents, and notices to parties not reached by mail. The *Official Gazette Notices* are available on the United States Patent and Trademark Office *Web< site (www.uspto.gov). Paper copies of the *Official Gazette Notices* are available from the Government Printing Office. Orders for the *Official Gazette Notices* should be addressed and subscriptions should be made payable to the Superintendent of Documents, Government Printing Office, Washington, D.C. 20402.

1704 Application Records and Reports [R-8]

The PALM (Patent Application Locating and Monitoring) System is the automated data management system used by the United States Patent and Trademark Office (USPTO) for the retrieval and/or online updating of the computer record of each patent application. The PALM System also maintains examiner time, activity, >and< docket >records<, and technical support staff backlog records.

Information retrieval from PALM is by means of the PALM intranet. Transactions are entered via bar code readers, by keyed entries, or by making an appropriate choice in a drop down menu. Among other items, classification, examiner docket, attorney, inventor, status, and prosecution history data as well as the location of each paper application can be retrieved and updated online with PALM.

I. DOCKET REPORTS

The recording of changes to examiner dockets is accomplished by PALM simultaneously with the recording of incoming and outgoing communications, transfers of applications to and from dockets, and other types of updating of the application record. The status of each examiner's docket can be determined by means of the PALM intranet and is supplemented by periodic printed or electronic reports. Docket reports that are generated by PALM include the individual examiner new * and amended docket which lists applications >as regular, special, or accelerated applications< in priority order; the individual examiner rejected application docket; the individual examiner new application profile, which lists the totals of new applications in each docket, sorted by month of

filing; and various summaries of the above reports at the art unit, Technology Center (TC), and corps levels.

II. BIWEEKLY TIME AND ACTIVITY REPORTS

All reporting of examiner time and activity is on a biweekly basis. Each examiner's examining and non-examining time, as **>entered in the Web Time and Attendance System is used by PALM< in the computation of productivity data. The biweekly reports produced include the individual Biweekly Examiner Time and Activity Report which lists, by application number, all applications for which actions have been counted during the biweekly period. The type of action counted for each application is also indicated on the report. This report also includes examiner time data, an action summary, and cumulative summaries to date for the current quarter and fiscal year. Various summary reports at the Art Unit, TC, and Corps levels are also produced.

1705 Examiner Docket, Time, and Activity Recordation [R-8]

Actions prepared by examiners are submitted >electronically and sent< to their respective legal instrument examiners for **>entry of the type of Office action into the PALM System and for mailing.<

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Each examiner's action that is counted and reported to the PALM system will be listed by application number on the Biweekly Examiner Time and Activity Report. The examiner should check his/her Biweekly Examiner Time and Activity Report to verify that all applications worked on for the biweekly report period are properly listed.

Examples of examiner's actions that are reported to PALM by the legal instrument examiner, but are not listed on the Biweekly Examiner Time and Activity Report, include examiner's amendments, actions in reexamination proceedings, interview summaries, transfers of applications, and supplemental Office actions and miscellaneous Office letters which do not set a period for reply.

**>

Application Number

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

EXAMINER'S CASE ACTION WORKSHEET

Copy (Ctrl+C)	Palm Transaction Code	Legal Instrument Examiner
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CHECK TYPE OF ACTION

DATE OF COUNT

<input type="checkbox"/> Non-Final Rejection	<input type="checkbox"/> Restriction/Election Only	<input type="checkbox"/> Final Rejection
<input type="checkbox"/> Ex Parte Quayle	<input type="checkbox"/> Allowance	<input type="checkbox"/> Advisory Action
<input type="checkbox"/> Examiner's Answer	<input type="checkbox"/> Reply Brief Noted	<input type="checkbox"/> Non-Entry of Reply Brief
<input type="checkbox"/> Defective Notice of Appeal	<input type="checkbox"/> Interference Disposal SPE _____ (Approval for Disposal)	<input type="checkbox"/> Suspension (Examiner-Initiated) SPE _____ (initial)
<input type="checkbox"/> Defective Appeal Brief	<input type="checkbox"/> SIR Disposal (use only after FAOM)	<input type="checkbox"/> Supplemental Examiner's Amendment
<input type="checkbox"/> Miscellaneous Office Letter (With Shortened Statutory Period Set)	<input type="checkbox"/> Notice of Non-Responsive Amendment (With One Month Time Period set)	<input type="checkbox"/> Miscellaneous Office Letter (No Response Period Set)
<input type="checkbox"/> Abandonment after BPAI Decision	<input type="checkbox"/> Supplemental Action	<input type="checkbox"/> Response to Rule 312 Amendment
<input type="checkbox"/> Letter Restarting Period for Response (e.g., Missing References)	<input type="checkbox"/> Interview Summary	<input type="checkbox"/> Authorization to Change Previous Office Action SPE: _____ (Initial)
<input type="checkbox"/> Abandonment	<input type="checkbox"/> Express Abandonment Date: _____	<input type="checkbox"/> Other

Examiner's Name:

AU:

II. COUNTING OF FIRST ACTION ON THE MERITS (FAOM)

Office actions on the merits consist of rejections (final and non-final), *Ex parte Quayle* actions, and allowances.

The first time an examiner performs one of the above merit actions, he/she receives credit >or a count< for a First Action on the Merits (FAOM) on the production reports.

A second/subsequent but FAOM usually occurs when the first action is a restriction/election action and the second action is an action on the merits. The examiner indicates the type of second action on the Examiner's Case Action Worksheet, and the PALM system will automatically determine if it is a FAOM. If the second action is a FAOM, the action will be listed and credited on the Biweekly Examiner Time and Activity Report as a Second/Subsequent FAOM.

III. COUNTING OF DISPOSALS

An examiner receives a "disposal" >or< count for the following actions:

- (A) Allowance;
- (B) Abandonment;
- (C) Requests for Continued Examination;
- (D) Examiner's Answer;
- (E) International Preliminary Examination Report;
- (F) Statutory Invention Registration (SIR) disposal (only after a FAOM; see MPEP § 1101); and
- (G) Interference wherein the application would be in condition for allowance but for the interference.

These same items constitute the "disposals" for performance evaluation of examining art units and TCs. However, disposals at the Office level consist only of allowances and abandonments.

For either an allowance or an abandonment after an Examiner's Answer or decision by a court or the Board of Patent Appeals and Interferences, no disposal credit is received, though these actions are indicated on the Biweekly Examiner Time and Activity Report.

IV. CORRECTION INFORMATION

(A) If any information is either missing from or incorrect on the Biweekly Examiner Time and Activ-

ity Report, the examiner should promptly notify their supervisory patent examiner (SPE) and either the legal instrument examiner or PALM troubleshooter by providing all the pertinent information necessary to make the changes to the PALM system (e.g., examining hours, application number, type of action, etc.).

(B) The PALM troubleshooter or legal instrument examiner will report the necessary changes and corrections directly into PALM. These changes will be listed on the next Biweekly Examiner Time and Activity Report.

(C) If any information is missing from the last Biweekly Examiner Time and Activity Report of a quarter (except at the end of a fiscal year) or is incorrect, the examiner should promptly notify the PALM troubleshooter or legal instrument examiner and his/her supervisory patent examiner (SPE). The PALM troubleshooter or legal instrument examiner will make the appropriate changes directly into the PALM system. The changes will be listed on the next Biweekly Examiner Time and Activity Report. However, these changes will not be reflected in the previous Quarter's Report; the examiner's SPE may manually make an adjustment to the records to show these changes.

(D) In order to ensure that all PALM reports are correct at the end of the fiscal year (rating period), a special correction cycle is provided on the PALM system. If any information is missing from or is incorrect on the last Biweekly Examiner Time and Activity Report, the examiner should immediately notify the legal instrument examiner and his/her SPE. These changes will be reflected in the examiner's final biweekly report for the entire fiscal year.

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1711 U.S.-Philippines Search Exchange

The United States-Philippines search exchange program involves patent applications filed in the United States which are subsequently followed by corresponding applications filed in the Republic of the Philippines and patent applications filed in the Philippines subsequently followed by corresponding applications filed in the United States.

The program operates as follows:

The applicant files his or her application in the United States Patent and Trademark Office (USPTO) which will process the application in the normal man-

ner and examine the application in the usual time sequence.

If the applicant should later file a corresponding application in the Philippines Patent Office, he or she may elect to use the special filing procedure. Under this special filing procedure, applicant files his or her application in the Philippines accompanied by a notice of election to participate in the special procedure, which notice of election contains a certification that the description (excluding references to related applications), claims, and drawings are identical to those of the corresponding application originally filed in the United States. The earlier filed application must be fully identified, and, in applications without a claim of priority, a certified copy of the earlier filed U.S. application must be submitted to the Philippines Patent Office. In addition, applicant must also agree that all amendments to his or her U.S. application will also be made with respect to his or her application filed in the Philippines.

In the USPTO, applicant will regularly file two copies of each amendment. One copy must be marked "Copy for Philippines Patent Office." Upon termination of prosecution, the USPTO shall remove all copies so marked from the U.S. file and promptly forward the same to the Philippines Patent Office.

Election forms for participation in this special program must be signed in duplicate and simultaneously accompany the application to be filed in the Philippines.

Upon receipt of properly filed notice of election, the Philippines Patent Office will notify the USPTO of the election by forwarding one copy of the election forms to the USPTO. The Philippines Patent Office will defer action on the Philippines application pending receipt of information as to the disposition of the application by the USPTO. If no such information is received by the Philippines Office within a reasonable amount of time from the date of filing in the Philippines, the Philippines Office may, either on its own initiative, or at applicant's request, inquire as to the status of the U.S. application and, if desired, proceed with its own independent examination.

Upon disposal of the application by the USPTO, appropriate information will be sent to the Philippines Patent Office which will include all necessary identifying data, whether allowed or abandoned, notice of

allowance, copies of documents cited during examination, a copy of the last office action and, when necessary, any earlier actions which may be included by reference in the last action. The Philippines Office will then make its own complete office action based upon the claims as amended with USPTO, performing whatever checks desired and searching for copending interfering applications. Alternatively, the Philippines may request applicant to show cause why the results of the U.S. examination should not be accepted in the Philippines. All avenues of appeal will remain open to the applicant.

Where copending applications are cited and applied during examination in the USPTO full examination will not be forwarded to the Philippines Patent Office, and the fact that a U.S. copending application was cited would be noted as a matter of information, since such references are inapplicable in the Philippines.

Where the application originates in the Philippines Patent Office and is subsequently filed in the USPTO, a similar procedure as outlined above, consonant with U.S. law, will be followed.

It is believed that this program will facilitate the handling of U.S. origin applications filed in the Republic of the Philippines resulting in a savings in time and expense of prosecution to U.S. applicants.

1720 Dissemination of Court and Board of Patent Appeals and Interferences Decisions [R-3]

I. COURT DECISIONS

The Office of the Solicitor forwards to the Office of the Commissioner for Patents copies of all recent court decisions in patent cases where a precedential opinion is issued. The Office of the Commissioner for Patents will routinely forward these opinions to TC Directors, the **>Office of Patent Training<, and the Director of the Office of Patent Quality Assurance.

TC Directors, in turn, are to make copies available to supervisors and other individuals as the TC Director determines to be appropriate. TC Directors are encouraged to discuss the contents of the opinions in their staff meetings, particularly where such meetings are being held to reinforce examination quality.

II. BOARD OF PATENT APPEALS AND INTERFERENCES DECISIONS

A decision rendered by the Board of Patent Appeals and Interferences (Board) is returned to the examiner through the TC Director and the examiner's supervisor. The examiner takes action consistent with the decision rendered by the Board unless rehearing of the Board decision will be requested (MPEP § 1214.04). The TC Director may circulate and discuss the decision among some or all of the supervisors in the TC, and the supervisors, in turn, may circulate the decision among the examiners in their art units, depending on the subject matter or issues in the decisions.

1721 Treatment of Court and Board of Patent Appeals and Interferences Decisions Affecting Patent and Trademark Office Policy and Practice [R-8]

In the event the Board of Patent Appeals and Interferences (Board) or court decision is one that significantly adds to the body of law by, for example, addressing a new legal or procedural issue, or providing a new interpretation of a prior decision, such a decision may result in an internal United States Patent and Trademark Office (USPTO) memorandum pointing out the significance of the decision to the examination process.

When any examiner or supervisor in the Patent Examining Corps concludes that a recent decision of the Board or a court affects existing USPTO policy or practice, he or she should bring the matter to the attention of his/her TC Director through normal chain-of-command procedures.

When the TC Director believes that guidance to the Corps is warranted as a result of a decision, the TC Director should consult with the *>Associate< Commissioner for Patent Examination Policy and provide a draft of the guidance that is recommended as appropriate under the circumstances. The *>Associate< Commissioner for Patent Examination Policy will then consult appropriate Office officials, as necessary, to formulate a recommendation to the Commissioner for Patents on the policy implications of the opinion.

It may be necessary for the Director, General Counsel, Solicitor, Chief Administrative Patent Judge, Commissioner for Patents, *>Associate< Commissioner for Patent Examination Policy, Deputy Commissioner for *>Patents< and TC Director making the recommendation to meet to review and discuss the policy ramifications of the opinion and recommended guidance to enable the Director to decide how the USPTO will proceed.

Communication of the decision on the policy implications of the court or Board decision will normally take place by either notice in the *Official Gazette* and/or via memorandum to USPTO personnel. Ultimately, the policy implications of the decision will be officially incorporated into the Manual of Patent Examining Procedure and Office of Patent Training curriculum materials during the next update cycle for these reference materials.

1730 Information Sources [R-8]

I. IN GENERAL

General information about patents, trademarks, products and services offered by the United States Patent and Trademark Office (USPTO), and other related information is available by contacting the USPTO Contact Center at:

800-PTO-9199 or 571-272-1000

(TDD) 571-272-9950

An automated message system is available 7 days a week, 24 hours a day providing informational responses to frequently asked questions and the ability to order certain documents. Customer service representatives are available to answer questions, send materials or connect customers with other offices of the USPTO from 8:30 a.m. - 8:00 p.m. EST/EDT, Monday-Friday excluding federal holidays.

For other technical patent information needs, the Inventors Assistance Center can be reached through customer service representatives at the above numbers, Monday through Friday (except federal holidays) from 8:30 a.m. to 5:00 p.m. EST/EDT.

General information can also be obtained in person from the Public Search Facilities of the USPTO. See subsection IV. below.

II. USPTO INTERNET SITE

A. General Information

The USPTO *Web< site (<http://www.uspto.gov> or <ftp.uspto.gov>) provides a wealth of information to all users. The USPTO *Web< site offers links to news and notices (such as announcements, press releases, *Official Gazette* Notices and *Federal Register* Notices), USPTO contacts and addresses, activities and education related pages (such as the PTDL program and the Kids Pages), patent specific information (such as issued patents and published patent applications, general information pertaining to applying for a patent, electronic filing of patent applications, and reference materials such as the MPEP and examination guidelines), and trademark specific information (such as the Trademark Manual of Examining Procedure and the U.S. Trademark Electronic Search System (TESS)). In addition, the *Web< site allows downloading of a variety of USPTO forms (including PCT forms), ordering copies of patents and trademarks, accessing a list of all current fees, paying patent maintenance fees, replenishing deposit accounts, accessing various legal materials, linking to related *Web< sites, etc.

B. Electronic Business

The Patent Electronic Business Center (EBC) assists USPTO customers in filing patent applications electronically, submitting assignment documents for recordation, retrieving data, checking the status of pending actions, and submitting information and applications. The hours of operation of the EBC are Monday through Friday 6 a.m. - midnight (EST/EDT). The EBC can be reached by telephone at 866-217-9197 (toll-free) or 571-272-4100. The EBC may be reached by e-mail at ebc@uspto.gov and by fax at 571-273-0177.

1. USPTO Databases

(a) Issued Patents

The Patent Grants Database provides access to the full-text of all U.S. patents issued since 1976, and to the full-page images of all U.S. patents issued since 1790.

(b) Published Applications

The Patent Applications Database provides both full-text and full-page images of all U.S. patent applications published since March 15, 2001.

(c) Status Information

Status information relating to patent applications is available through the Patent Application Information Retrieval (PAIR) system. There is both a public and private side to PAIR. In public PAIR, information is available relating to issued patents, published patent applications, and applications to which a patented or published application claims domestic priority. In private PAIR, an applicant (or his or her registered patent attorney or registered patent agent) can securely track the progress of his or her application(s) through the USPTO. Private PAIR makes available information relating to unpublished patent applications, but the applicant must associate a Customer Number with the application to obtain access. See MPEP § 403 for Customer Number practice.

(d) Image File Wrapper (IFW)

The Image File Wrapper (IFW) system uses image technology to replace the paper processing of patent applications in the Office. Paper components of these application files (including the specification, oath or declaration, drawings, information disclosure statements, amendments, Office actions, and file jacket notations) have been scanned to create electronic image files. For patent applications in the IFW system, the IFW file is the Official file and no access is granted to the original paper document sheets used to create the IFW file. All processing and examination is conducted using the electronic images instead of the paper source documents.

If an IFW file has been created for a patented application, published application, or an application to which a patented or published application claims domestic priority, the IFW file (with the exception of non-patent literature) is accessible through public PAIR. All patent applications filed after June 30, 2003 have been scanned into the IFW system and will be available in public PAIR as soon as they have been published or patented. Pending applications filed before June 30, 2003 are scanned into IFW as incoming papers are received in the Office. Non-patent liter-

ature (NPL) may be viewed using private PAIR (if an IFW file has been created) or obtained from the USPTO Office of Public Records.

Questions about IFW images viewed in PAIR should be directed to the Patent EBC.

(e) Assignments on the Web (AOTW)

Assignment information is available for issued patents and published applications recorded since August 1980.

2. Transacting Electronic Business

(a) Filing Applications and Other Documents

The Electronic Filing System *>-Web (EFS-Web)< allows customers to electronically file patent application documents securely via the Internet. **> See MPEP § 502.05 for more detailed information.<

(b) Paying Fees and Replenishing Deposit Accounts

The Office of Finance On-Line Shopping page may be used to pay maintenance fees or to maintain and replenish deposit accounts.

(c) Ordering Copies and Publications

Copies of patent applications as filed and patent file wrappers that have been issued or published are available on-line from the Office of Public Records (OPR). Presentation patents may also be ordered on the web. Available service options, fees and delivery methods vary by document type. Contact OPR at 1-800-972-6382 or 571-272-3150 for more information.

III. PCT

For questions and information concerning the Patent Cooperation Treaty (PCT), the PCT Help Desk is available to provide assistance and may be reached by telephone at 571-272-4300 between the hours of 9:00 am and 4:30 pm (EST/EDT), Monday through Friday, or by facsimile at 571-273-0419, 24 hours a day. In addition, helpful information is available through the internet at the Office of PCT Legal Administration page of the USPTO *>Web< site and at the World Intellectual Property Office *>Web< site (<http://www.wipo.org/>).

IV. USPTO SEARCH AND INFORMATION RESOURCE FACILITIES

The following USPTO search and information resource facilities are accessible to the public:

(A) Public Search Facility (Madison East, first floor, 600 Dulany St., Alexandria, VA 22314) at 571-272-3275

(Hours: Weekdays, 8:00 a.m. to 8:00 p.m., EST/EDT); *

(B) Scientific and Technical Information Center

(1) Main Library (Madison West, first floor, 600 Dulany St., Alexandria, VA 22314) at 571-272-3547

(2) Biotech/Chemical Library (Remsen 1D58) at 571-272-2520

(Hours: Weekdays, 8:30 a.m. to 5:00 p.m., EST/EDT)>; and

(C) File Information Unit (Randolph Square, third floor, 2800 South Randolph St., Arlington, VA 22206) at 703-756-1800

(Hours: Weekdays, 7:00 a.m. to 6:00 p.m., EST/EDT).<

V. REGISTERED PRACTITIONERS

The USPTO cannot recommend any particular attorney or agent, or aid in the selection of an attorney or agent. A list of *Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office* may be purchased on DVD-ROM from the USPTO's Office of Electronic Information Products (571-272-5600). The DVD-ROM is also available on the USPTO *>Web< site (<http://www.uspto.gov>) from the "Products and Services Catalog."

To obtain a list of registered patent attorneys and agents for a particular area, customers may either contact a customer service representative through the USPTO Contact Center (see "In General" above), or acquire the information from the USPTO *>Web< site. The attorneys and agents list may be examined without charge at Patent and Trademark Depository Libraries (PTDLs) and at many other libraries throughout the U.S. Many large cities also have associations of patent attorneys and agents which may be consulted.

A. Recently Filed Applications

B. Pre-Grant Publication

C. Status Information

D. Correspondence

E. Copies of Documents

571-273-3250. To order file histories for self-service copying, contact the File Information Unit at *703-756-1800.<

F. Maintenance Fees

Information regarding maintenance fees may be obtained from the Patent Application Information Retrieval (PAIR) system on the USPTO [Web](#) site, or by contacting the Receipts Accounting Division at 571-272-6500.

G Assignments

For questions pertaining to filing assignments or other documents affecting title, contact the Assignment Division at 571-272-3350. Documents may be submitted to the Assignment Division by facsimile at 571-273-0140. See MPEP § 302.09 for additional information.

H. Petitions

For matters decided by the Office of Petitions, the appropriate USPTO personnel may be reached at 571-272-3282. Petitions to withdraw an application from issue may be sent by facsimile to 571-273-0025. All other facsimile transmissions to the Office of Petitions should be sent to the Central FAX Number 571-273-8300.

I. PatentIn

For information regarding orders for the PatentIn software program, call the ** Electronic Information Products >Division< at 571-272-5600. For assistance downloading or using PatentIn, contact the Patent Electronic Business Center (see subsection II.B. above).



MANUAL OF PATENT EXAMINING PROCEDURE