



[3510-16-P]

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

[Docket No.: PTO-P-2011-0076]

Extension of the Extended Missing Parts Pilot Program

AGENCY: United States Patent and Trademark Office, Commerce

ACTION: Notice.

SUMMARY: The United States Patent and Trademark Office (USPTO) implemented a pilot program (Extended Missing Parts Pilot Program) in which an applicant, under certain conditions, can request a twelve-month time period to pay the search fee, the examination fee, any excess claim fees, and the surcharge (for the late submission of the search fee and the examination fee) in a nonprovisional application. The Extended Missing Parts Pilot Program benefits applicants by permitting additional time to determine if patent protection should be sought – at a relatively low cost – and by permitting applicants to focus efforts on commercialization during this period. The Extended Missing Parts Pilot Program benefits the USPTO and the public by adding publications to the body of prior art, and by removing from the USPTO’s workload those nonprovisional applications for which applicants later decide not to pursue examination.

The USPTO is extending the Extended Missing Parts Pilot Program until December 31, 2012, to better gauge whether the Extended Missing Parts Program offers sufficient benefits to the patent community for it to be made permanent.

DATES: Effective Date: [INSERT DATE OF PUBLICATION IN THE FEDERAL REGISTER].

Duration: The Extended Missing Parts Pilot Program will run through December 31, 2012. Therefore, any certification and request to participate in the Extended Missing Parts Pilot Program must be filed before December 31, 2012. The USPTO may further extend the pilot program (with or without modifications) depending on the feedback received and the continued effectiveness of the pilot program.

FOR FURTHER INFORMATION CONTACT: Eugenia A. Jones, Senior Legal Advisor, Office of Patent Legal Administration, Office of the Associate Commissioner for Patent Examination Policy, by telephone at (571) 272-7727, or by mail addressed to: Mail Stop Comments--Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, marked to the attention of Eugenia A. Jones.

Inquiries regarding this notice may be directed to the Office of Patent Legal Administration, by telephone at (571) 272-7701, or by electronic mail at PatentPractice@uspto.gov.

SUPPLEMENTARY INFORMATION: The USPTO implemented a change to missing parts practice in certain nonprovisional applications as a pilot program (i.e., Extended Missing Parts Pilot Program) after considering written comments from the public. See Pilot Program for Extended Time Period To Reply to a Notice to File Missing Parts of Nonprovisional Application, 75 FR 76401 (Dec. 8, 2010), 1362 Off. Gaz. Pat. Office 44 (Jan. 4, 2011).

The USPTO is extending the Extended Missing Parts Pilot Program until December 31, 2012. The USPTO may further extend the Extended Missing Parts Pilot Program, or may discontinue the pilot program after December 31, 2012, depending on the results of the program. The requirements of the program are reiterated below. Applicants are strongly cautioned to review the pilot program requirements before making a request to participate in the Extended Missing Parts Pilot Program.

The USPTO cautions all applicants that, in order to claim the benefit of a prior provisional application, the statute requires a nonprovisional application filed under 35 U.S.C. 111(a) to be filed within twelve months after the date on which the corresponding provisional application was filed. See 35 U.S.C. 119(e). It is essential that applicants understand that the Extended Missing Parts Pilot Program cannot and does not change this statutory requirement.

I. Requirements: In order for an applicant to be provided a twelve-month (non-extendable) time period to pay the search and examination fees and any required excess

claims fees in response to a Notice to File Missing Parts of Nonprovisional Application under the Extended Missing Parts Pilot Program, the applicant must satisfy the following conditions: (1) applicant must submit a certification and request to participate in the Extended Missing Parts Pilot Program with the nonprovisional application on filing, preferably by using Form PTO/SB/421 titled “Certification and Request for Extended Missing Parts Pilot Program;” (2) the application must be an original nonprovisional utility or plant application filed under 35 U.S.C. 111(a) within the duration of the pilot program; (3) the nonprovisional application must directly claim the benefit under 35 U.S.C. 119(e) and 37 CFR 1.78 of a prior provisional application filed within the previous twelve months; the specific reference to the provisional application must be in the first sentence of the specification following the title or in an application data sheet under 37 CFR 1.76 (see 37 CFR 1.78(a)(5)); and (4) applicant must not have filed a nonpublication request.

As required for all nonprovisional applications, applicant will need to satisfy filing date requirements and publication requirements. In accordance with 35 U.S.C. 122(b), the USPTO will publish the application promptly after the expiration of eighteen months from the earliest filing date to which benefit is sought. Therefore, the nonprovisional application should also be in condition for publication as provided in 37 CFR 1.211(c). The following are required in order for the nonprovisional application to be in condition for publication: (1) the basic filing fee; (2) an executed oath or declaration in compliance with 37 CFR 1.63; (3) a specification in compliance with 37 CFR 1.52; (4) an abstract in compliance with 37 CFR 1.72(b); (5) drawings in compliance with 37 CFR 1.84 (if

applicable); (6) any application size fee required under 37 CFR 1.16(s); (7) any English translation required by 37 CFR 1.52(d); and (8) a sequence listing in compliance with 37 CFR 1.821-1.825 (if applicable). The USPTO also requires any petition under 37 CFR 1.47 to be granted, any compact disc requirements to be satisfied, and an English translation of the provisional application to be filed in the provisional application if the provisional application was filed in a non-English language and a translation has not yet been filed. If the requirements for publication are not met, applicant will need to satisfy the publication requirements within a two-month extendable time period.

As noted above, applicants should request participation in the Extended Missing Parts Pilot Program by using Form PTO/SB/421. For utility patent applications, applicant may file the application and the certification and request electronically using the USPTO electronic filing system, EFS-Web, and selecting the document description of “Certification and Request for Missing Parts Pilot” for the certification and request on the EFS-Web screen. Form PTO/SB/421 is available on the USPTO Web site at <http://www.uspto.gov/forms/sb0421.pdf>. Information regarding EFS-Web is available on the USPTO Web site at <http://www.uspto.gov/ebc/index.jsp>.

The utility application including the certification and request to participate in the pilot program may also be filed by mail (e.g., by “Express Mail” in accordance with 37 CFR 1.10) or hand-carried to the USPTO. However, applicants are advised that, effective November 15, 2011, as provided in the Leahy-Smith America Invents Act, a new additional fee of \$400.00 for a non-small entity (\$200.00 for a small entity) is due

for any nonprovisional utility patent application that is not filed by EFS-Web. See Pub. L. 112-29, § 10(h), 125 Stat. 283, 319 (2011). This non-electronic filing fee is due on filing of the utility application or within the two-month (extendable) time period to reply to the Notice to File Missing Parts of Nonprovisional Application. Applicants will not be given the twelve-month time period to pay the non-electronic filing fee. Therefore, utility applicants are strongly encouraged to file their utility applications via EFS-Web to avoid this additional fee.

For plant patent applications, applicant must file the application including the certification and request to participate in the pilot program by mail or hand-carried to the USPTO since plant patent applications cannot be filed electronically using EFS-Web. See Legal Framework for Electronic Filing System Web (EFS-Web), 74 FR 55200 (Oct. 27, 2009), 1348 Off. Gaz. Pat. Office 394 (Nov. 24, 2009).

II. Processing of Requests: If applicant satisfies the requirements (discussed above) on filing of the nonprovisional application and the application is in condition for publication, the USPTO will send applicant a Notice to File Missing Parts of Nonprovisional Application that sets a twelve-month (non-extendable) time period to submit the search fee, the examination fee, any excess claims fees (under 37 CFR 1.16(h)-(j)), and the surcharge under 37 CFR 1.16(f) (for the late submission of the search fee and examination fee). The twelve-month time period will run from the mailing date, or notification date for e-Office Action participants, of the Notice to File Missing Parts. For information on the e-Office Action program, see Electronic Office Action, 1343 Off.

Gaz. Pat. Office 45 (June 2, 2009), and http://www.uspto.gov/patents/process/status/e-Office_Action.jsp. After an applicant files a timely reply to the Notice to File Missing Parts within the twelve-month time period and the nonprovisional application is completed, the nonprovisional application will be placed in the examination queue based on the actual filing date of the nonprovisional application.

For a detailed discussion regarding treatment of applications that are not in condition for publication, processing of improper requests to participate in the program, and treatment of authorizations to charge fees, see Pilot Program for Extended Time Period To Reply to a Notice to File Missing Parts of Nonprovisional Application, 75 FR 76401, 76403-04 (Dec. 8, 2010), 1362 Off. Gaz. Pat. Office 44, 47-49 (Jan. 4, 2011).

III. Important Reminders: Applicants are reminded that the disclosure of an invention in a provisional application should be as complete as possible because the claimed subject matter in the later-filed nonprovisional application must have support in the provisional application in order for the applicant to obtain the benefit of the filing date of the provisional application.

Furthermore, the nonprovisional application as originally filed must have a complete disclosure that complies with 35 U.S.C. 112, first paragraph, which is sufficient to support the claims submitted on filing and any claims submitted later during prosecution. New matter cannot be added to an application after the filing date of the application. See 35 U.S.C. 132(a). In order to be accorded a filing date, a nonprovisional application must

include a specification concluding with at least one claim as prescribed by 35 U.S.C. 112 and a drawing as prescribed by 35 U.S.C. 113. See 35 U.S.C. 111(a). While only one claim is required in a nonprovisional application for filing date purposes and applicant may file an amendment adding additional claims later during prosecution, applicant should consider the benefits of submitting a complete set of claims on filing of the nonprovisional application. This would reduce the likelihood that any claims added later during prosecution might be found to contain new matter. Also, if a patent is granted and the patentee is successful in litigation against an infringer, provisional rights to a reasonable royalty under 35 U.S.C. 154(d) may be available only if the claims that are published in the patent application publication are substantially identical to the patented claims that are infringed, assuming timely actual notice is provided. Thus, the importance of the claims that are included in the patent application publication should not be overlooked.

Applicants are also advised that the extended missing parts period does not affect the twelve-month priority period provided by the Paris Convention for the Protection of Industrial Property (Paris Convention). Thus, any foreign filings must still be made within twelve months of the filing date of the provisional application if applicant wishes to rely on the provisional application in the foreign-filed application or if protection is desired in a country requiring filing within twelve months of the earliest application for which rights are left outstanding in order to be entitled to priority.

For additional reminders, see Pilot Program for Extended Time Period To Reply to a Notice to File Missing Parts of Nonprovisional Application, 75 FR 76401, 76405 (Dec. 8, 2010), 1362 Off. Gaz. Pat. Office 44, 50 (Jan. 4, 2011).

Date: December 6, 2011

David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

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