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[3510-16-P]

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

[Docket No. PTO-P-2016-0027]

Request for Comments on the Extended Missing Parts Pilot Program

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Request for Comments.

SUMMARY: The United States Patent and Trademark Office (USPTO) has a pilot program (Extended Missing Parts Pilot Program) in which an applicant, under certain conditions, can request a 12-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 is currently set to expire on December 31, 2016. The USPTO is seeking public comment on whether the Extended Missing Parts Pilot Program offers sufficient benefits to the patent community for it to be made permanent or whether the USPTO should permit the program to expire.

DATES: Comment Deadline Date: Written comments must be received on or before [INSERT DATE 60 DAYS AFTER THE DATE OF PUBLICATION IN THE FEDERAL REGISTER].

ADDRESSES: Comments should be sent by electronic mail message over the Internet addressed to: extendedmissingparts2016@uspto.gov. Comments may also be submitted by postal 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.

Although comments may be submitted by postal mail, the Office prefers to receive comments by electronic mail message over the Internet in order to facilitate posting on the USPTO's Internet Web site. Electronic comments are preferred to be submitted in plain text, but also may be submitted in ADOBE[®] portable document format or MICROSOFT WORD[®] format. Comments not submitted electronically should be submitted on paper in a format that facilitates convenient digital scanning into ADOBE[®] portable document format.

The comments will be available for public inspection at the Office of the Commissioner for Patents, currently located in Madison East, Tenth Floor, 600 Dulany Street, Alexandria, Virginia 22314. Comments also will be available for viewing via the USPTO's Internet Web site (<http://www.uspto.gov>). Because comments will be made available for public inspection, information that the submitter does not desire to make

public, such as an address or phone number, should not be included in the comments. It would be helpful to the USPTO if comments included information about: (1) the name and affiliation of the individual responding; and (2) an indication of whether the comments represent views of the respondent's organization or are the respondent's personal views.

FOR FURTHER INFORMATION CONTACT: Eugenia A. Jones, Senior Legal Advisor, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy, by telephone at (571) 272-7727, or Erin M. Harriman, Legal Advisor, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy, by telephone at (571) 272-7747.

SUPPLEMENTARY INFORMATION:

I. Background

On December 8, 2010, after considering written comments from the public, the USPTO implemented the Extended Missing Parts Pilot Program. 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). Over the course of the pilot program, the USPTO provided extensions of the Extended Missing Parts Pilot Program through notices published in the Federal Register. The most recent notice extended the program until December 31, 2016, to allow the USPTO time to seek public comment on whether the Extended Missing Parts Pilot Program offers sufficient benefits to the patent community for it to be made permanent. See Extension of

Extended Missing Parts Pilot Program, 80 FR 80325 (Dec. 24, 2015), 1422 Off. Gaz. Pat. Office 192 (Jan. 19, 2016). Since the Extended Missing Parts Pilot Program has been in place for more than five years, it is now a good opportunity to seek public comment on whether the program offers sufficient benefits to the patent community for it to be made permanent or whether the USPTO should permit the program to expire.

Summary of the Extended Missing Parts Pilot Program: In order for an applicant to be provided a 12-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) the 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/AIA/421, titled “Certification and Request for Extended Missing Parts Pilot Program”; (2) the application must be an original (i.e., not a Reissue) 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 12 months, and the specific reference to the provisional application must be in an application data sheet under 37 CFR 1.76 (see 37 CFR 1.78(a)(3)); and (4) the applicant must not have filed a nonpublication request.

As required for all nonprovisional applications, the applicant must satisfy filing date requirements and publication requirements. If the application submitted on filing does not meet the requirements for publication, or if the application is filed without any claims, the Office of Patent Application Processing will issue an appropriate notice setting a two-month (extendable) time period within which to respond. The Extended Missing Parts Pilot Program does not change the two-month time period set forth in any such notice. In accordance with 35 U.S.C. 122(b), the USPTO will publish the application promptly after the expiration of 18 months from the earliest filing date for which benefit is sought.

If the applicant satisfies the requirements (discussed above) on filing of the nonprovisional application and the application is in condition for publication, the USPTO will send the applicant a Notice to File Missing Parts of Nonprovisional Application that sets a 12-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). If an applicant files a timely reply to the Notice to File Missing Parts within the 12-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 additional discussion, 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), and Extension of the Extended Missing Parts Pilot Program, 80 FR 80325 (Dec. 24, 2015), 1422 Off. Gaz. Pat. Office 192 (Jan. 19, 2016).

II. Request for Public Comments

The USPTO is requesting written public comments on whether the Extended Missing Parts Pilot Program should be made permanent. The USPTO seeks input from the public on the following:

1. Have you participated in the Extended Missing Parts Pilot Program? If so, please discuss what aspects of the program you think are beneficial and what aspects are not.
2. Please discuss why an applicant would be discouraged from participating in the Extended Missing Parts Pilot Program.
3. Do you think the USPTO should make the Extended Missing Parts Pilot Program permanent? Why or why not?
4. Please provide any other input that you would like the USPTO to consider in determining whether the Extended Missing Parts Pilot Program should be made permanent.

Dated: August 29, 2016

Russell Slifer

Deputy Under Secretary of Commerce for Intellectual Property and
Deputy Director of the United States Patent and Trademark Office

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