



[3510-16-P]

## **DEPARTMENT OF COMMERCE**

### **United States Patent and Trademark Office**

**[Docket No.: PTO-P-2016-0055]**

#### **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 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 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. While the USPTO has not yet completed its evaluation of the program, the number of participants in the program over the past several years indicates that there may be sufficient benefits to the patent community. Thus, the USPTO is extending the Extended Missing Parts Pilot Program until January 2, 2018, to allow the USPTO to continue its evaluation of the pilot program. The requirements of the program have not changed.

**DATES:** Duration: The Extended Missing Parts Pilot Program will run through January 2, 2018. Therefore, any certification and request to participate in the Extended Missing Parts Pilot Program must be filed on or before January 2, 2018. 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 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.

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. Alternatively, mail may be 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.

**SUPPLEMENTARY INFORMATION:** On December 8, 2010, after considering written comments from the public, the USPTO changed the missing parts examination procedures in certain nonprovisional applications by implementing a pilot program (i.e., 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).

On September 6, 2016, the USPTO sought 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 pilot program to expire. See Request for Comments on the Extended Missing Parts Pilot Program, 81 FR 61195 (Sept. 6, 2016), 1430 Off. Gaz. Pat. Office 269 (Sept. 27, 2016). The USPTO received a total of two comments, and both comments appear to support the pilot program. The two

comments are available via the USPTO's Internet Web site at <https://www.uspto.gov/patent/laws-and-regulations/comments-public/comments-extended-missing-parts-pilot-program>. While the USPTO has not yet completed its evaluation of the pilot program, the increase in the number of participants in the program over the past five years indicates that there may be sufficient benefits to the patent community. Thus, the USPTO is extending the Extended Missing Parts Pilot Program until January 2, 2018, to allow the USPTO to continue its evaluation of the pilot program.

The requirements of the program, which have not been modified, are reiterated below. Applicants are strongly advised to review the pilot program requirements before making a request to participate in 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).

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 12 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. Title II of the Patent Law Treaties Implementation Act of 2012 (PLTIA) amended the provisions of title 35, United States Code, including 35 U.S.C. 119(e), to implement the Patent Law Treaty (PLT). See Public Law 112-211, §§ 20-203, 126 Stat. 1527, 1533-37 (2012). In the rulemaking to implement the PLT and

title II of the PLTIA, the USPTO provided that an applicant may file a petition under 37 CFR 1.78(b) to restore the benefit of a provisional application filed up to fourteen months earlier. See Changes To Implement the Patent Law Treaty, 78 FR 62367, 62368-69 (Oct. 21, 2013) (final rule). Any petition to restore the benefit of a provisional application must include the benefit claim, the petition fee, and a statement that the delay in filing the subsequent application was unintentional. This change was effective on December 18, 2013, and applies to any application filed before, on, or after December 18, 2013. However, if a nonprovisional application is filed outside the 12 month period from the date on which the corresponding provisional application was filed, the nonprovisional application is not eligible for participation in the Extended Missing Parts Pilot Program, even though the applicant may be able to restore the benefit of the provisional application by submitting a petition under 37 CFR 1.78(b).

I. Requirements: 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 will need to satisfy filing date requirements and publication requirements. In the rulemaking to implement the PLT and title II of the PLTIA, the USPTO provided that an application (other than an application for a design patent) filed on or after December 18, 2013, is not required to include a claim to be entitled to a filing date. See Changes To Implement the Patent Law Treaty, 78 FR 62367, 62638 (Oct. 21, 2013) (final rule). This change was effective on December 18, 2013, and applies to any application filed under 35 U.S.C. 111 on or after December 18, 2013. However, if an application is filed without any claims, the Office of Patent Application Processing will issue a notice giving the applicant a two-month (extendable) time period within which to submit at least one claim in order to avoid abandonment (see 37 CFR 1.53(f)). The Extended Missing Parts Pilot Program does not change this time period. 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. 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) the executed inventor's oath or declaration in compliance with 37 CFR 1.63 or an application data sheet containing the information specified in 37 CFR 1.63(b); (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 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, the 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/AIA/421. For utility patent applications, the 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/AIA/421 is available on the USPTO Web site at <http://www.uspto.gov/sites/default/files/forms/aia0421.pdf>. Information regarding EFS-Web is available on the USPTO Web site at <http://www.uspto.gov/patents-application-process/applying-online/about-efs-web>.

The utility application including the certification and request to participate in the pilot program may also be hand-carried to the USPTO or filed by mail, for example, by

Priority Mail Express<sup>®</sup> in accordance with 37 CFR 1.10. 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 Public Law 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 12-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, the 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 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). The 12-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-application-process/checking-application-status/e-office-action-program>. After 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 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(a) and 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 the rulemaking to implement the PLT and title II of the PLTIA, the USPTO provided that, in order to be accorded a filing date, a nonprovisional application (other than an application for a design patent) must include a specification with or without claims. See Changes To Implement the Patent Law Treaty, 78 FR 62367, 62369 (Oct. 21, 2013) (final rule). This change was effective on December 18, 2013, and applies to any application filed under 35 U.S.C. 111 on or after December 18, 2013. Although a claim is not required in a nonprovisional application (other than an application for a design patent) for filing date purposes and the applicant may file an amendment adding additional claims as prescribed by 35 U.S.C. 112 and drawings as prescribed by 35 U.S.C. 113 later during prosecution, the applicant should consider the benefits of submitting a complete set of claims and any necessary drawings on filing of the nonprovisional application. This would reduce the likelihood that any claims and/or drawings 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 12-month priority period provided by the Paris Convention for the Protection of Industrial Property (Paris Convention). Accordingly, any foreign filings must, in most cases, still be made within 12 months of the filing date of the provisional application if the applicant wishes to rely on the provisional application in the foreign-filed application or if protection is desired in a country requiring filing within 12 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 15, 2016 \_\_\_\_\_

---

Michelle K. Lee  
Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office  
[FR Doc. 2016-30733 Filed: 12/20/2016 8:45 am; Publication Date: 12/21/2016]