# Refresher Training: Terminal disclaimer requirements and processing

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UNITED STATES
PATENT AND TRADEMARK OFFICE
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# Objectives

- To understand:
  - The requirements for all terminal disclaimers (TDs)
  - How to identify the three different types of TDs
  - How to use the flowchart to identify the type of TD filed
  - The types of signature permitted in a TD
  - How to process JRA TDs

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# Requirements for filing a terminal disclaimer

# Statutory basis for terminal disclaimers

- The America Invents Act (AIA) did not substantively change 35 U.S.C. 253, the patent statute governing terminal disclaimers.
- The patent statute, 35 U.S.C. 253 (pre-AIA) (and AIA 35 U.S.C. 253(b), for applications filed on/after 9/16/12)) states that "any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted."
- The statute does not provide for a terminal disclaimer of only a specified claim or claims.
  - Thus, the terminal disclaimer must operate with respect to, i.e., must terminally disclaim, all claims in the patent that results from the application or reexamination proceeding.
- The AIA and pre-AIA versions of the statute are reproduced in the appendix.

# Regulation (rule) for terminal disclaimers

- 37 CFR 1.321 governs what a terminal disclaimer can and must contain.
  - The text of the rule for applications filed before 9/16/2012 (pre-AIA version) and that for applications filed on or after 9/16/2012 (AIA version) is reproduced in the appendix.

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# Summary of regulation (rule) changes affecting TD practice (pre-AIA vs. AIA rules)

- **For applications filed on or after 9/16/2012**, the term applicant is no longer synonymous with the term inventor.
  - Besides the inventor, other persons with interests in the application are permitted to file a patent application and can be an assignee, an obligated assignee, or a person who shows a sufficient propriety interest in the claimed invention.
- **For applications filed on or after 9/16/2012**, **the applicant** (**AS SHOWN IN PALM, IN DAV, AND ON THE FILING RECEIPT**) is:
  - the one named in the application datasheet (ADS) as the applicant; or
  - the inventor if an applicant is not named in the ADS.
- **For terminal disclaimers filed in patents, the signature requirements have not been changed by the AIA**.
  - Regardless of the filing date of the application that issued as the patent, the patent owner or an attorney or agent of record may sign the TD filed in a patent.

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# Summary of regulation (rule) changes affecting TD practice (pre-AIA vs. AIA rules)

- The signature requirements for TDs have changed for applications filed on or after 9/16/2012.
  - For applications filed before 9/16/2012 (pre-AIA rule), the TD must be signed:
    i. by the applicant (who is the inventor for applications filed before 9/16/2012), or
    ii. if there is an assignee of record of an undivided part interest, by the applicant and such assignee, or
    iii. if there is an assignee of record of the entire interest, by such assignee, or
    iv. by an attorney or agent of record;
  - For applications filed on or after 9/16/2012 (AIA rule), the TD must be signed by the applicant (who may not be the inventor) or an attorney or agent of record.
    - An assignee who is not the applicant cannot sign the TD in an application filed on or after 9/16/2012.

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# Determining who is the applicant of record

- There are several ways to determine who is the applicant of record:
  - From the applicant information in PALM (recommended)
  - From the applicant information under the "Application Data tab" in DAV (recommended)
  - From the latest filing receipt

# Determining who is the applicant of record (cont.)

*Applicant information in PALM*

# Determining who is the applicant of record (cont.)

*Applicant information under "Application Data" tab in DAV*

# Determining who is the applicant of record (cont.)

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NUMBER | FILING or 371(c) DATE | GRP ART UNIT | FIL FEE REC'D | ATTY.DOCKET.NO | TOT CLAIMS | IND CLAIMS |
|---|---|---|---|---|---|---|

14/xxx,xxx

**CORRECTED FILING RECEIPT**

Date Mailed: 09/23/2019

**Inventor(s)**

Adam Smith, Cambridge, MA

**Applicant(s)**

Wealth of Nations, Inc., Cambridge, MA

*Applicant information on the latest filing receipt*

# Changing the applicant vs. correcting or updating the name of the applicant

- To change the applicant under 37 CFR 1.46(c)(2), the following is required:
  - a request to change the applicant,
  - a corrected ADS (with markings to show changes), and
  - a 3.73(c) Statement showing chain of title to the new applicant.
- To correct or update the name of the applicant under 37 CFR 1.46(c)(1), the following is required:
  - a request to correct or update the name of the applicant, and
  - a corrected ADS (with markings to show changes).

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# Changing the applicant vs. correcting or updating the name of the applicant (cont.)

- A 3.73(c) Statement is not needed to correct or update the name of the applicant because there is no a change in who owns the application.
  - This difference in requirements to change the applicant vs. requirements to correct or update the name of the applicant is shown in form PTO/AIA/41 ("REQUEST TO CORRECT OR UPDATE THE NAME OF THE APPLICANT UNDER 37 CFR 1.46(c)(1), OR CHANGE THE APPLICANT UNDER 37 CFR 1.46(c)(2)).
- ***__**Important:**__ If the request to change the applicant is filed with the TD, the TD __**cannot be processed**__ until after the request to change the applicant has been processed.

# Where the attorney or agent of record signs the terminal disclaimer

- Where the attorney or agent of record signs the disclaimer, there is no need to comply with 37 CFR 3.73.
- ***<u>**Important:**</u> If a request to change the power of attorney (POA) is filed with the TD, the TD **cannot be processed until after** the request to change the POA has been processed.

# Determining who has power of attorney

- There are at least two ways to determine who has power of attorney in an application.
  - From the attorney/agent information in PALM
  - From the "Attorneys of Record" information under the "Application Data tab" in DAV

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# Determining who has power of attorney (cont.)

*Attorney/agent information in PALM*

# Determining who has power of attorney (cont.)

*"Attorneys of Record" information under the "Application Data" tab in DAV*

# Requirements for all terminal disclaimers

- A terminal disclaimer to be recorded in the USPTO, must:
  1. Be appropriately signed;
  2. Identify the patent or application for which the disclaimer is filed, and the term of the patent or the term of any patent to be granted being disclaimed.
  3. Identify the disclaimant* and the present extent of the disclaimant's interest in the patent or application.
  4. Include a provision that the disclaimer is binding upon the disclaimant and its successors and assigns; and
  5. Be accompanied by the fee set forth in 37 CFR 1.20(d).

See 37 CFR 1.321(a) (TD filed in a patent) and 1.321(b) (TD filed in an application) for the requirements that apply to all terminal disclaimers.

*disclaimaint is the one making the disclaimer.

# Requirements for all of terminal disclaimers (cont.)

- The disclaimer must be of a terminal portion of the term of the entire patent. As previously discussed, the statute requires that the terminal disclaimer must operate with respect to all claims in the patent.
  - For example, the disclaimant is not permitted to disclaim only some claims, e.g., the claim(s) rejected under nonstatutory double patenting.

# Requirements for all of terminal disclaimers (cont.)

- **The entirety of the ownership** must sign the terminal disclaimer for each target reference.
- For example, Companies A and B are the applicants (for an application filed on or after September 16, 2012) or the assignees (for an application filed before September 16, 2012) having the entire interest.
  - Both Companies A and B must disclaim over references X and Y to obviate nonstatutory double patenting over those references either in one TD or in separate TDs. It would be improper for Company A to disclaim over reference X in one TD and Company B to disclaim over reference Y is a second TD.

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# Fees for terminal disclaimers

- The regulation for the terminal disclaimer fee is 37 CFR 1.20(d).
  - As of October 2, 2020, the current fee amount is $170 (fee code 1814/2814/3814). There is no longer a small entity discount for this fee as of 2013, and there is no micro entity discount.
  - Charge one TD fee for each TD filed, even if multiple patents are listed and disclaimed in the TD. See MPEP 804.02 (IV).
  - Also, do not charge a second TD fee, where the first TD was not entered because it was improper, and the second TD is filed as a replacement to fix the defects in the first TD.

# Fees for terminal disclaimers (cont.)

- Re-filing of the TD is required even though the only defect is non-payment of the TD fee.
- Filing a TD fee in EFS-Web or even with a transmittal letter will not trigger any notification that a TD should be reviewed.
- Furthermore, because the TD has already been disapproved, the Office cannot remove the DISQ form that disapproved the TD.

# Three types of terminal disclaimers provided by 37 CFR 1.321

- **37 CFR 1.321(c): Terminal disclaimer based on common ownership to obviate nonstatutory double patenting** [*most frequently filed*]

- **37 CFR 1.321(d): Terminal disclaimer based on a joint research agreement (JRA) to obviate nonstatutory double patenting** [*less commonly filed*]

- **37 CFR 1.321(a) (filed in a patent) and (b)(filed in an application): Terminal disclaimer that disclaims or dedicates to the public the entire term or a terminal part of the term of any patent to be granted or granted** (**does not have any enforcement provisions and does not obviate nonstatutory double patenting**) [*rarely filed*]

# Additional requirements for terminal disclaimers under 37 CFR 1.321(c) and (d)

- A proper terminal disclaimer under 37 CFR 1.321(c) and (d) must disclaim the terminal part of the statutory term of any patent granted on the application being examined (or the statutory term of the patent) which would extend beyond the expiration date of the full statutory term, shortened by any terminal disclaimer, of the patent (or of any patent granted on the application) to which the disclaimer is directed.

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# Additional requirements for terminal disclaimers under 37 CFR 1.321(c) and (d)

- **For a TD filed under 37 CFR 1.321(c) based on common ownership**, the owner of the application under examination or patent subject to the reexamination proceeding must:
  - *Enforcement Language 1* – Agree that any patent granted on the application being examined or any patent subject to the reexamination proceeding shall be enforceable only for and during the period that the patent is commonly owned with the reference application or patent which formed the basis for the nonstatutory double patenting

- **For a TD filed under 37 CFR 1.321(d) based on a joint research agreement (JRA)**, the owner of the application under examination or patent subject to the reexamination proceeding must:
  - *Prior art requirement* – Disqualify the non-commonly owned reference on which the nonstautory double patenting is based as prior art as set forth in either 37 CFR 1.104(c)(4)(ii) or (c)(5)(ii)
  - *Enforcement Language 2* – Waive the right to separately enforce any patent granted on the application being examined or any patent subject to the reexamination proceeding and the reference patent or any patent granted on the reference application which formed the basis for the nonstatutory double patenting. 37 CFR 1.321(d)(3)
  - Agree that any patent granted on the application being examined or any patent subject to the reexamination proceeding shall be enforceable only for and during the period that the patent and the reference are not separately enforced. 37 CFR 1.321(d)(3)

# Additional requirements for terminal disclaimers under 37 CFR 1.321(c) and (d)

- There are only two differences between the requirements for a TD based on common ownership and a TD based on a JRA, which are:
  - (1) the different enforcement provisions in the these two types of TDs, and
  - (2) the reference in the JRA TD must have been disqualified as prior art.

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# Terminal disclaimer informal checklist includes checking for appropriate language in a JRA TD

| Rev. 11/2013 | Doc. Code: DISQ.CKLIST |
|---|---|

**TERMINAL DISCLAIMER INFORMAL CHECKLIST**

| | |
|---|---|
| **APPL. S.N.:** | **DATE:** |
| **EXAMINER:** | **ART UNIT:** |
| **PARALEGAL:** | **MAIL ROOM DATE:** |
| **NUMBER OF TD(s) FILED:** | |

**INSTRUCTIONS**: The paralegal has reviewed the submitted TD with the results as set forth below.
If you agree, please use the appropriate form paragraphs identified by this informal memo in your next Office action to notify applicant about the TD. If you disagree, please contact a QAS.

**THIS CHECKLIST IS AN INFORMAL, INTERNAL CHECKLIST ONLY. IT MUST NOT BE MAILED TO APPLICANT. IT WILL BE SOFT SCANNED AND NOT VIEWABLE TO THE PUBLIC.**

- ☐ The TD is PROPER and has been accepted and recorded. (See FP 14.23.)
- ☐ The TD is NOT PROPER and has not been accepted for the reason(s) checked below. (See FP 14.24.)
- ☐ The disclaimer fee under 37 CFR 1.20(d) in the amount of $ ____ has not been submitted, nor is there any pre authorization in the application to charge to a deposit account. (See FP 14.24 and 14.26.07.)
- ☐ The LIE has not processed fee for TD (the Paralegal should ask LIE to process the fee).
- ☐ The TD does not satisfy 37 CFR 1.321(b) (3) in that the person who signed the TD has not stated either: (a) the extent of his/her ownership interest, or (b) the extent of the business/organization entity's ownership interest on whose behalf the person signed. (See FPs 14.26 and 14.26.01.)
- ☐ The TD lacks the – enforceable only during the period of common ownership – clause needed to overcome a double patenting 37 CFR 1.321(c). (See FP 14.27.01).
- ☐ The words "legal title" in the clause do not include common ownership as to equitable title required to be included by 37 CFR 1.321(c)(3) use of the words "commonly assigned."

*FP 14.27.011*

# ¶ 14.27.011 Lacks 37 CFR 1.321(d) Statement for Joint Research Agreement under 35 U.S.C. 102(c) or pre-AIA 35 U.S.C. 103(c)(2)&(3)

It does not include the **waiver and enforceability provisions of 37 CFR 1.321(d)**. The terminal disclaimer must include a provision:

1) **waiving the right to separately enforce** (a) any patent granted on that application or the patent being reexamined and (b) the reference patent, or any patent granted on the reference application which formed the basis for the double patenting rejection; and

2) agreeing that any patent granted on that application or patent being reexamined **shall be enforceable only for** and during such period that said patent and the reference patent, or any patent granted on the reference application, which formed the basis for the double patenting are not separately enforced. See 37 CFR 1.321(d)(3)

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# Terminal disclaimers under 37 CFR 1.321(a) and (b)

- In contrast to terminal disclaimers based on 37 CFR 1.321(c) and (d), terminal disclaimers based on 37 CFR 1.321(a) or (b) (these are rare but have been filed) **do not have an enforcement provision**.
- Terminal disclaimers without any enforcement provision must be:
  - filed under 37 CFR 1.321(a) or (b),
  - cannot be filed under 37 CFR 1.321(c) or (d), and
  - cannot overcome any nonstatutory double patenting.

# Processing of terminal disclaimers under 37 CFR 1.321(b) filed in applications

- A paper that is **clearly labeled as a terminal disclaimer under 37 CFR 1.321(b) filed in an application** and that **does not contain** either a common ownership enforcement provision or a joint research agreement enforcement provision **will be approved** by the Patent Legal Research Center (PLRC) **if the terminal disclaimer complies with 37 CFR 1.321(b).**
- The terminal disclaimer review decision form (document code DISQ) issued by the PLRC will contain the following "Examiner note" if the terminal disclaimer is approved:
  - This terminal disclaimer was filed under 37 CFR 1.321(b) and is not effective to overcome any nonstatutory double patenting rejection. In order to obviate nonstatutory double patenting, a terminal disclaimer must be filed either under 37 CFR 1.321(c) or 1.321(d).
- To alert examiners, the PLRC will annotate the paper in the IFW as a terminal disclaimer filed under 37 CFR 1.321(b) if the terminal disclaimer is approved.
- ***<u>Important</u>: **Please contact OPLA** before approving a terminal disclaimer under 37 CFR 1.321(b).

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# Comparison of the three types of TDs that may be filed in applications

| | 37 CFR 1.321(b) | 37 CFR 1.321(c) | 37 CFR 1.321(d) |
|---|---|---|---|
| Is TD required to (1) have a proper signature; (2) specify term being disclaimed; (3) state present extent of ownership interest in the application; (4) be binding upon disclaimant, successor, or assigns; and (5) be accompanied by the TD fee? | YES | YES | YES |
| Is TD required to contain a common ownership enforcement provision? | NO | YES | NO |
| Is TD required to contain a joint research agreement enforcement provision? | NO | NO | YES |
| Is reference being disclaimed over in TD required to be disqualified as prior art? | NO | NO | YES |
| Is TD required to disclaim the terminal part of the statutory term of any patent granted on the application that would extend beyond the expiration date of the full statutory term of the reference in the TD, as shortened by any TD? | NO | YES | YES |
| Is TD able to overcome any nonstatutory double patenting? | NO | YES | YES |

# Combination of terminal disclaimers under 37 CFR 1.321(c) and (d) is not permitted

- A terminal disclaimer that **combines** a terminal disclaimer based on common ownership (37 CFR 1.321(c)) with a terminal disclaimer based on a JRA (37 CFR 1.321(d)) **is improper** because each type of terminal disclaimer has different requirements.
- A separate terminal disclaimer is required for each type of terminal disclaimer as set forth in MPEP 804.02.
  - MPEP 804.02 (IV. DISCLAIMING MULTIPLE DOUBLE PATENTING REFERENCES)
    - A terminal disclaimer fee is required for each terminal disclaimer filed. To avoid paying multiple terminal disclaimer fees, a single terminal disclaimer based on common ownership may be filed, for example, in which the term disclaimed is based on all the conflicting, commonly owned nonstatutory double patenting references. Similarly, a single terminal disclaimer based on a joint research agreement may be filed, in which the term disclaimed is based on all the conflicting nonstatutory double patenting references.

# Using the flowchart to determine the type of terminal disclaimer filed

# DETERMINING THE TYPE OF TERMINAL DISCLAIMER FILED

**Workshop exercise**
**to determine type of TD filed and**
**to identify any deficiencies in the TD**

# Exercise – Filing receipt

- When was the application (not a 371 application) filed?

- Who are the applicants?

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
PO Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NUMBER | FILING or 371(c) DATE | GRP ART UNIT | FIL FEE REC'D | ATTY.DOCKET.NO | TOT CLAIMS | IND CLAIMS |
|---|---|---|---|---|---|---|
| 16/ZZZ,ZZZ | 06/06/2018 | xxx | 1720 | xxx | 10 | 1 |

**CONFIRMATION NO. xxx**

**FILING RECEIPT**

Law Firm
2000 Washington Square
XXXX, CT XXXXX

Date Mailed: 06/29/2018

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

**Inventor(s)** Tom Edison, New Haven, CT
Ben Franklin, New Haven, CT

**Applicant(s** ALPHA CO., NEW HAVEN, CT
BETA CO., NEW HAVEN, CT

# Exercise - Text of Alpha's terminal disclaimer filed on October 9, 2019

- The applicant, Alpha Co., owner of 100 percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of reference patent No. U.S. 7,XXX,XXX as the term of said reference patent is presently shortened by any terminal disclaimer. The applicant of the instant application waives the right to separately enforce the reference patent and any patent granted on the instant application. The applicant of the instant application hereby agrees that the reference patent and any patent granted on the instant application shall be enforceable only for and during such period that the reference patent and any patent granted on the instant application are not separately enforced. The waiver, and this agreement, run with any patent granted on the instant application and are binding upon the applicant of the instant application, its successors, or assigns.

- The applicant does not disclaim any terminal part of any patent granted on the instant application prior to the expiration date of the full statutory term as defined in 35 USC §§ 154 and 173 as presently shortened by any terminal disclaimer, or in the event that any of the reference patent has its term prematurely shortened, e.g., in the event that: any of the reference patent expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR § 1.321, has all claims canceled by a reexamination certificate, is reissued, or is otherwise in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer or may be shortened by any terminal disclaimer filed prior to its grant.

# Exercise - Text of Beta's terminal disclaimer filed on October 9, 2019

- The applicant, Beta Co., owner of 100 percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of reference patent No. U.S. 8,XXX,XXX as the term of said reference patent is presently shortened by any terminal disclaimer. The applicant of the instant application waives the right to separately enforce the reference patent and any patent granted on the instant application. The applicant of the instant application hereby agrees that the reference patent and any patent granted on the instant application shall be enforceable only for and during such period that the reference patent and any patent granted on the instant application are not separately enforced. The waiver, and this agreement, run with any patent granted on the instant application and are binding upon the applicant of the instant application, its successors, or assigns.

- The applicant does not disclaim any terminal part of any patent granted on the instant application prior to the expiration date of the full statutory term as defined in 35 USC §§ 154 and 173 as presently shortened by any terminal disclaimer, or in the event that any of the reference patent has its term prematurely shortened, e.g., in the event that: any of the reference patent expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR § 1.321, has all claims canceled by a reexamination certificate, is reissued, or is otherwise in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer or may be shortened by any terminal disclaimer filed prior to its grant.

# Exercise – Questions

- Is the applicant correctly listed on each TD?
  - This requirement applies to both terminal disclaimers based on common ownership and terminal disclaimers based on a joint research agreement.
- For applications filed on or after September 16, 2012, the terminal disclaimer must be filed by the applicant.
- The applicant can be found in PALM, in DAV, and on the filing receipt.

# Exercise – Questions (cont.)

- What type of TD is it?
- Is it proper?
- If not, what are the deficiencies?

# Exercise - Is the applicant correctly listed on Alpha's terminal disclaimer?

- The applicant, Alpha Co., owner of 100 percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of reference patent No. 7,XXX,XXX as the term of said reference patent is presently shortened by any terminal disclaimer. The applicant of the instant application waives the right to separately enforce the reference patent and any patent granted on the instant application. The applicant of the instant application hereby agrees that the reference patent and any patent granted on the instant application shall be enforceable only for and during such period that the reference patent and any patent granted on the instant application are not separately enforced. The waiver, and this agreement, run with any patent granted on the instant application and are binding upon the applicant of the instant application, its successors, or assigns.

- The applicant does not disclaim any terminal part of any patent granted on the instant application prior to the expiration date of the full statutory term as defined in 35 USC §§ 154 and 173 as presently shortened by any terminal disclaimer, or in the event that any of the reference patent has its term prematurely shortened, e.g., in the event that: any of the reference patent expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR § 1.321, has all claims canceled by a reexamination certificate, is reissued, or is otherwise in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer or may be shortened by any terminal disclaimer filed prior to its grant.

# Exercise - Is the applicant correctly listed on Beta's terminal disclaimer?

- The applicant, Beta Co., owner of 100 percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of reference patent No. 8,XXX,XXX as the term of said reference patent is presently shortened by any terminal disclaimer. The applicant of the instant application waives the right to separately enforce the reference patent and any patent granted on the instant application. The applicant of the instant application hereby agrees that the reference patent and any patent granted on the instant application shall be enforceable only for and during such period that the reference patent and any patent granted on the instant application are not separately enforced. The waiver, and this agreement, run with any patent granted on the instant application and are binding upon the applicant of the instant application, its successors, or assigns.

- The applicant does not disclaim any terminal part of any patent granted on the instant application prior to the expiration date of the full statutory term as defined in 35 USC §§ 154 and 173 as presently shortened by any terminal disclaimer, or in the event that any of the reference patent has its term prematurely shortened, e.g., in the event that: any of the reference patent expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR § 1.321, has all claims canceled by a reexamination certificate, is reissued, or is otherwise in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer or may be shortened by any terminal disclaimer filed prior to its grant.

# Exercise - Text of Alpha's terminal disclaimer

*disclaiming statement*

The applicant, Alpha Co., owner of 100 percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of reference patent No. U.S. 7,XXX,XXX as the term of said reference patent is presently shortened by any terminal disclaimer. The applicant of the instant application waives the right to separately enforce the reference patent and any patent granted on the instant application. The applicant of the instant application hereby agrees that the reference patent and any patent granted on the instant application shall be enforceable only for and during such period that the reference patent and any patent granted on the instant application are not separately enforced. The waiver, and this agreement, run with any patent granted on the instant application and are binding upon the applicant of the instant application, its successors, or assigns.

*enforceability provision*

*Optional protection clause or exculpatory statement*

The applicant does not disclaim any terminal part of any patent granted on the instant application prior to the expiration date of the full statutory term as defined in 35 USC §§ 154 and 173 as presently shortened by any terminal disclaimer, or in the event that any of the reference patent has its term prematurely shortened, e.g., in the event that: any of the reference patent expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR § 1.321, has all claims canceled by a reexamination certificate, is reissued, or is otherwise in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer or may be shortened by any terminal disclaimer filed prior to its grant.

# Exercise - Text of Alpha's terminal disclaimer

*disclaiming statement*

*enforceability provision*

The applicant, Alpha Co., owner of 100 percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of reference patent No. U.S. 7,XXX,XXX as the term of said reference patent is presently shortened by any terminal disclaimer. The applicant of the instant application waives the right to separately enforce the reference patent and any patent granted on the instant application. The applicant of the instant application hereby agrees that the reference patent and any patent granted on the instant application shall be enforceable only for and during such period that the reference patent and any patent granted on the instant application are not separately enforced. The waiver, and this agreement, run with any patent granted on the instant application and are binding upon the applicant of the instant application, its successors, or assigns.

What type of TD is it?

**Processing JRA TD Flowchart (Step 1)**

# Exercise - Text of Alpha's terminal disclaimer

*disclaiming statement*

The applicant, Alpha Co., owner of 100 percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of reference patent No. U.S. 7,XXX,XXX as the term of said reference patent is presently shortened by any terminal disclaimer. The applicant of the instant application waives the right to separately enforce the reference patent and any patent granted on the instant application. The applicant of the instant application hereby agrees that the reference patent and any patent granted on the instant application shall be enforceable only for and during such period that the reference patent and any patent granted on the instant application are not separately enforced. The waiver, and this agreement, run with any patent granted on the instant application and are binding upon the applicant of the instant application, its successors, or assigns.

*enforceability provision*

What type of TD is it?

**Processing JRA TD Flowchart (Step 2)**

# Exercise - Text of Alpha's terminal disclaimer

*disclaiming statement*

The applicant, Alpha Co., owner of 100 percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of reference patent No. U.S. 7,XXX,XXX as the term of said reference patent is presently shortened by any terminal disclaimer. The applicant of the instant application waives the right to separately enforce the reference patent and any patent granted on the instant application. The applicant of the instant application hereby agrees that the reference patent and any patent granted on the instant application shall be enforceable only for and during such period that the reference patent and any patent granted on the instant application are not separately enforced. The waiver, and this agreement, run with any patent granted on the instant application and are binding upon the applicant of the instant application, its successors, or assigns.

*enforceability provision*

What type of TD is it?

**Processing JRA TD Flowchart (Step 3)**

# Exercise - Text of Beta's terminal disclaimer

*disclaiming statement*

The applicant, Beta Co., owner of 100 percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of reference patent No. U.S. 8,XXX,XXX as the term of said reference patent is presently shortened by any terminal disclaimer. The applicant of the instant application waives the right to separately enforce the reference patent and any patent granted on the instant application. The applicant of the instant application hereby agrees that the reference patent and any patent granted on the instant application shall be enforceable only for and during such period that the reference patent and any patent granted on the instant application are not separately enforced. The waiver, and this agreement, run with any patent granted on the instant application and are binding upon the applicant of the instant application, its successors, or assigns.

*enforceability provision*

What type of TD is it?

# Exercise - Compare exculpatory statement on PTO/AIA/26 with that on Alpha's and Beta's terminal disclaimers

*from PTO/AIA/26*

In making the above disclaimer, the applicant does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term of the **prior patent**, "as the term of said **prior patent** is presently shortened by any terminal disclaimer," in the event that said **prior patent** later:

expires for failure to pay a maintenance fee;
is held unenforceable;
is found invalid by a court of competent jurisdiction;
is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321;
has all claims canceled by a reexamination certificate;
is reissued; or
is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

*from Alpha's and Beta's terminal disclaimers*

The applicant does not disclaim any terminal part of any patent granted on the instant application prior to the expiration date of the full statutory term as defined in 35 USC §§ 154 and 173 as presently shortened by any terminal disclaimer, or in the event that any of the reference patent has its term prematurely shortened, e.g., in the event that: any of the reference patent expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR § 1.321, has all claims canceled by a reexamination certificate, is reissued, or is otherwise in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer or may be shortened by any terminal disclaimer filed prior to its grant.

# Exercise – Example of proper language for the JRA TD

The applicants, Alpha Co. and Beta Co., together owners of 100 percent interest in the instant application, hereby disclaim the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of U.S. patent Nos. 7,XXX,XXX and 8,XXX, XXX ("the reference patents") as the term of the reference patents is presently shortened by any terminal disclaimer. The applicants of the instant application waive the right to separately enforce the reference patents and any patent granted on the instant application. The applicants of the instant application hereby agree that the reference patents and any patent granted on the instant application shall be enforceable only for and during such period that the reference patents and any patent granted on the instant application are not separately enforced. The waiver, and this agreement, run with any patent granted on the instant application and are binding upon the applicants of the instant application, its successors, or assigns.

For each listed reference patent:

In making the above disclaimer, the applicants do not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term of the reference patent, as the term of the reference patent is presently shortened by any terminal disclaimer, in the event that the reference patent:

expires for failure to pay a maintenance fee; is held unenforceable; is found invalid by a court of competent jurisdiction; is later statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321; has all claims canceled by a reexamination or trial certificate; is reissued; or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

**Note** - All applicants of record with 100% ownership interest must disclaim over the same reference(s).

# Types of signatures permitted in a terminal disclaimer

# Three types of signatures permitted in a terminal disclaimer - 37 CFR 1.4(d)

- Handwritten (personally signed) signatures are provided for in 37 CFR 1.4(d)(1).
- S-signatures are provided for in 37 CFR 1.4(d)(2):
  - An S-signature is a permitted type of signature between forward slash marks that is not a handwritten signature as defined by 37 CFR 1.4(d)(1).
- Graphic representation of a handwritten signature or a graphic representation of an S-signature may be submitted via the Office electronic filing system (EFS-Web or Patent Center) (37 CFR 1.4(d)(3)).

# Types of signatures permitted in a terminal disclaimer - 37 CFR 1.4(d)

- The name of the patent practitioner of record **printed** in the signature block of the terminal disclaimer does not have to exactly match the name in PALM.
  - 37 CFR 1.4(d)(iii) requires that the signer's name must be presented in printed or typed form preferably immediately below or adjacent the S-signature, and reasonably specific enough so that the identity of the signer can be readily recognized.
- For example, if the name of the attorney listed in PALM is **Frank Paul Jones**, the below **examples of printed names** would be acceptable **because the name is reasonably specific enough so that the identity of the signer can be readily recognized**, especially where the registration number for the attorney of record is also required:
  - Frank P. Jones
  - F. Paul Jones
  - F. P. Jones
  - Frank Jones

# 37 CFR 1.4(d): Signatures

# 37 CFR 1.4(d): Signatures

- 37 CFR 1.4(d) is the rule governing signatures for correspondence filed in an application, patent file, or other proceeding in the United States Patent and Trademark Office ("Office") that requires a person's signature.
- Assignments and related documents that are recorded in the Office's assignment records are not governed by the Office's signature rules.
  - The cover sheet, which must accompany an assignment document to be recorded, must be signed in accordance with 37 CFR 3.31(a)(7).
- The Office electronic filing system is EFS-Web or Patent Center.
- Note: Samples of acceptable signatures are posted on the office's web site (pages 1-4):
  - www.uspto.gov/sites/default/files/documents/sigexamples_alt_text.pdf

# 37 CFR 1.4(d): Signatures (cont.)

- Three types of permitted signatures:
- A signature must be personally inserted/applied by the individual identified as the signer, regardless of the manner of making the signature.
  - Handwritten (personally signed) signatures are provided for in § 1.4(d)(1).
  - S-signatures are provided for in § 1.4(d)(2):
    - An S-signature is a permitted type of signature between forward slash marks that is not a handwritten signature as defined by § 1.4(d)(1).
    - Previously not permitted for correspondence being submitted to OED or on the paper credit card form (though temporary waiver was put in place on 3/19/2020)
  - Graphic representation of a handwritten signature or a graphic representation of an S-signature may be submitted via the Office electronic filing system (EFS-Web or Patent Center) (§ 1.4(d)(3)).
- **Exception to personal insertion requirement**: a person physically unable to use a keyboard may, while simultaneously reviewing the document for signature, direct another person to press the appropriate keys to form the S-signature

# Handwritten signatures – Three requirements in 37 CFR 1.4(d)(1)

- Handwritten signature ((1) personally signed) must be (2) pen applied to paper in (3) permanent dark ink or its equivalent.
- May be an original document or a photocopy of the document.
- A hand stamp or signature replication is not a handwritten signature under § 1.4(d(1)), and therefore is not acceptable for paper submissions.
- However, a hand stamp or signature replication may be acceptable.
  - For correspondence submitted in any manner, as an S-signature (§ 1.4(d)(2)) if submitted between forward slashes, or
  - For correspondence submitted via EFS-Web, as a graphic representation of a handwritten signature (§ 1.4(d)(3))

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# S-signatures – requirements in 37 CFR 1.4(d)(2)

- The S-signature must consist only of letters (including Kanji, etc.), or Arabic numbers, or both, and appropriate spaces, commas, periods, apostrophes, or hyphens for punctuation, § 1.4(d)(2)(i).
- The person signing must insert his or her own signature between the forward slash marks, § 1.4(d)(2)(i).
  - Only the signer can insert his or her own signature:
    - A secretary, paralegal, etc., Is not permitted to sign/insert another person's signature, e.g. a practitioner's or inventor's signature, and
    - A practitioner is not permitted to sign/insert an inventor's signature or another practitioner's signature
    - The signature block may include the forward slashes for the person to insert their signature therebetween
    - No one is permitted to insert the forward slashes after the inventor has inserted his signature

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# S-signatures – requirements in 37 CFR 1.4(d)(2)

- The name of the person signing must be printed or typed immediately adjacent (i.e., below, above, or beside) to the S-signature, and be reasonably specific, so the identity of the signer can be readily recognized.
  - The name of the person signing may be inserted by someone other than the person signing, but the person signing must personally insert the S-signature.
  - A secretary, paralegal, etc., may type the name of the person signing at any time (e.g., before or after the person signing inserts his or her own signature).
- A patent practitioner may S-sign but his or her registration number is required, either as part of the S-signature, or immediately below or adjacent to the signature (§ 1.4(d)(2)(ii)).
  - For example: /John Attorney Reg. #99999/ John Attorney

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# Name requirement for S-signatures

- There is no requirement that the signer's actual, full, or legal name be used.
  - It is strongly suggested that the full name be used for both;
  - The typed or printed name below the signature must be reasonably specific enough so that the identity of the signer can be readily recognized (§ 1.4(d)(2)(iii)(B));
  - Exception Oath or Declaration requires legal name.
- Titles may be included as part of the signature.
- Changes in S-signature (different papers or different applications) are not recommended (§ 1.4(h)).
  - Example: An S-signature that includes the attorney docket number for that application would not be a consistent signature.

# S-signature examples

- S-signature within forward slashes, name below:
  - /Noah B. Dey/ Proper S-signature
    Noah B. Dey
  - /s/ Proper S-signature
    Noah B. Dey
  - / *Noah B. Dey* / Proper S-signature in script font
    Noah B. Dey
  - / / Image of handwritten signature
    John T. Smith personally inserted, may comply with 37 CFR 1.4(d)(2) and (3)

# S-signature examples (cont.)

- S-signature created in a commercial platform with forward slashes, which will be personally inserted adjacent printed name, is also acceptable under 37 CFR 1.4(d)(3).

***Signature inserted between forward slashes***

# S-signature examples (cont.)

- S-signature made using a commercial platform. The S-signature with forward slashes is created and personally inserted on a document adjacent the printed name. 37 CFR 1.4(d)(2) and (3).

# S-signature examples (cont.)

- S-signature under 37 CFR 1.4(d)(2), wherein the paper to be signed was pre-populated with two forward slashes. The signer inserted his signature between the forward slashes. The signature was typed using a script font. As such it needs to be within forward slashes.

LEGAL NAME OF INVENTOR

Inventor: Noah B. Dey

DocuSigned by:

Signature: / Noah B. Dey /

F319CFD5DCA84C7...

Note: An application data sheet (PTO/SB/14 or equivalent)
been previously filed. Use an additional PTO/AIA/01 form

## 37 CFR 1.4(d)(3): Graphic representation of a signature for electronically submitted correspondence

- A graphic representation of a handwritten signature is permitted if the correspondence is being submitted via the Office electronic filing system.
- A graphic representation of an S-signature is permitted if the correspondence is being submitted via the Office electronic filing system.
- **37 CFR 1.4(d)(3) <u>DOES NOT APPLY</u> to documents submitted in paper.** A graphic representation of a signature may only be used if the paper is submitted via the Office electronic filing system.

# Graphic representation of handwritten signature

- Signature created using a commercial platform and inserted on the document by the signer. It is submitted via the Office electronic filing system and it does not require forward slashes. This was done with a stylus, note "Draw Your Signature" below.

# Commercial signing systems

- Commercial signing systems (e.g., DocuSign, Dotloop, Adobe) may be acceptable.
  - Under 37 CFR 1.4(d)(2) if the signature is inserted between forward slash marks
  - Under 37 CFR 1.4(d)(3) if the signature is a graphic representation of either a handwritten signature or an S-signature and submitted via the Office electronic filing system. 37 CFR 1.4(d)(3) does not apply to documents submitted in paper

# Questionable signatures

- Ratification, confirmation, or evidence of authenticity of a signature may be required where the Office has:
  - Reasonable doubt as to its authenticity,
  - Where the signature and typed or printed name do not clearly identify the person signing.
- The failure to follow the S-signature format and content requirements will usually be treated as a bona fide attempt, but will cause the paper to be treated as unsigned with differing results, e.g.:
  - Responses to Office action would receive a two-month time period (MPEP 714.01)
  - § 1.63 declarations may a receive a two-month time period and a surcharge may be imposed
  - § 1.63 declarations may result in abandonment of the application, if submitted with the issue fee payment after the Notice of Allowance

# 37 CFR 1.4(d)(4): Certification requirements

**Certification requirement:**

- For your own signature: The person inserting a signature under § 1.4(d)(2) in a document submitted to the Office certifies that the inserted signature appearing in the document is his or her own signature.
- For another's signature: A person submitting a document signed by another under § 1.4(d)(2):
  - Is obligated to have a reasonable basis to believe that the person whose signature is present on the document actually inserted that signature, and
  - Should retain evidence of authenticity of the signature.

**Violations of the signature certifications may result in the imposition of sanctions under §§ 11.18(c) and (d).**

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# Processing JRA TDs

# Processing of terminal disclaimer under 37 CFR 1.321(d) based on JRA

- The processing of a JRA TD is identical to the processing of a TD based on common ownership except for the following:
  - The enforcement language in the JRA TD is different from that in the TD based on common ownership.
  - The reference(s) listed in the JRA TD that is subject to a joint research agreement must have been disqualified as prior art in accordance with 37 CFR 1.104(c)(4)(ii) or (c)(5)(ii), as applicable.

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# Processing of terminal disclaimer under 37 CFR 1.321(d) based on JRA (cont.)

- The reference(s) listed in the JRA TD is disqualified as prior art if:
  - The reference is prior art (TC checks for this through the JRA requirements questionnaire; if reference is not prior art, a grantable petition under 37 CFR 1.183 needs to be filed with the JRA TD); and
  - The three requirements to establish the existence of a joint research agreement have been met (TC checks for this through the JRA requirements questionnaire).

# Processing of terminal disclaimer under 37 CFR 1.321(d) based on JRA (cont.)

- The three requirements to establish the existence of a joint research agreement involving the reference(s) are (TC checks for this through the JRA requirements questionnaire):
  - A statement filed in accordance with either 37 CFR 1.104(c)(4)(ii) or 37 CFR 1.104(c)(5)(ii) ("the JRA Statement").
  - The specification contains or is amended to contain the names of the parties to the JRA.
    - The fee as set forth in 37 CFR 1.71(g)(2), if required, accompanied any amendment to the specification under 37 CFR 1.71(g)(1) to disclose the names of the parties to the JRA. It is possible for the names of the parties to the JRA to be in specification as filed, and no fee would be required in this instance.

# Processing of terminal disclaimer under 37 CFR 1.321(d) based on JRA (cont.)

- After the PLRC has determined that a JRA TD has been filed, the PLRC emails the JRA requirements questionnaire to the SPE (use email template from OPLA) and should cc the examiner who is assigned the application in which the JRA TD is filed.

# Processing of terminal disclaimer under 37 CFR 1.321(d) based on JRA – APPROVAL scenario

- Generate the DISQ message below on the terminal disclaimer review form (**DISQ document code**) when:
  - the TC has determined by completing a JRA requirements questionnaire(s) FOR EACH OF THE REFERENCE(S) LISTED IN THE JRA TD that the JRA REQUIREMENTS HAVE BEEN MET (the completed questionnaire form(s) should be attached to the end of the DISQ document) AND
  - the paralegal has determined that ALL OTHER FORMAL TERMINAL DISCLAIMER REQUIREMENTS (E.G., SIGNATURE, ETC.) HAVE BEEN SATISFIED.

**DISQ MESSAGE**:

The terminal disclaimer under 37 CFR 1.321(d) based on a joint research agreement (JRA TD) lists the following references: {lists references here}.

The JRA TD is APPROVED. The terminal disclaimer requirements and requirements establishing the existence of a joint research agreement (JRA) for each reference listed in the JRA TD have been met.

Please see the **attached sheet(s)** regarding the requirements to establish the existence of a joint research agreement for the reference(s) listed in the JRA TD.

# Processing of terminal disclaimer under 37 CFR 1.321(d) based on JRA – DISAPPROVAL scenario #1

- Generate the message below on the terminal disclaimer review form (**DISQ document code**) when
  - the TC has determined by completing a questionnaire(s) FOR THE REFERENCE(S) LISTED IN THE JRA TD that the JRA REQUIREMENTS HAVE NOT BEEN MET (the completed questionnaire form(s) should be attached to the end of the DISQ document):

DISQ MESSAGE:

The terminal disclaimer under 37 CFR 1.321(d) based on a joint research agreement (JRA TD) lists the following reference(s): {list reference(s) here}.

The JRA TD is DISAPPROVED because the requirements to establish the existence of a JRA for the reference(s) have not been met. Please see the attached sheet(s) identifying the missing requirement(s).

Please note that the reference(s) listed in the terminal disclaimer must have been disqualified as prior art as required by 37 CFR 1.321(d). If the reference(s) has not been disqualified as prior art, a grantable petition under 37 CFR 1.183 requesting waiver of the requirement in 37 CFR 1.321(d) would be needed.

As a reminder, the following is required to establish the existence of a joint research agreement for each reference:

- Applicant must file a statement in accordance with either 37 CFR 1.104(c)(4)(ii) or 37 CFR 1.104(c)(5)(ii), as applicable. The statement should either be on or begin on a separate sheet, must not be directed to other matters (37 CFR 1.4(c)), and must be signed in accordance with 37 CFR 1.33(b). See MPEP 706.02(l)(2)(III) or MPEP 717.02(a)(II), as applicable.
- The specification must disclose or is amended to disclose the names of the parties to the joint research agreement. See 37 CFR 1.104(c)(4)(ii) or 37 CFR 1.104(c)(5)(ii), as applicable.
- A fee may be required depending on when the amendment naming the parties to the JRA was filed. The fee and the time periods are set forth in 37 CFR 1.71(g)(2).

In addition, examples of acceptable terminal disclaimer language can be found in form paragraphs 14.27.07.fti, 14.27.07.1, and 14.27.08, as applicable.

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{**INSTRUCTIONS TO PARALEGAL**: Also include in the DISQ message ANY FORMAL TERMINAL DISCLAIMER REQUIREMENTS THAT HAS NOT BEEN SATISFIED (e.g., signature requirement not met, etc.)}

# Processing of terminal disclaimer under 37 CFR 1.321(d) based on JRA – DISAPPROVAL scenario #2

- Generate the message below on the terminal disclaimer review form (**DISQ document code**) when:
  - The TC has determined by completing a questionnaire(s) FOR THE REFERENCE(S) LISTED IN THE JRA TD that the JRA REQUIREMENTS HAVE BEEN MET (the completed questionnaire form(s) should be attached to the end of the DISQ document);
  - BUT paralegal has determined that the FORMAL TERMINAL DISCLAIMER REQUIREMENTS HAVE NOT BEEN MET (e.g., improper signature, no extent of ownership listed, no disclaiming statement, etc.)

DISQ MESSAGE:

The terminal disclaimer under 37 CFR 1.321(d) based on a joint research agreement (JRA TD) lists the following reference(s): {please list reference(s) here}.

The JRA requirements for the references listed in the JRA TD have been met. Please see the attached sheet(s) regarding the requirements to establish the existence of a joint research agreement for the reference(s) listed in the JRA TD.

However, the JRA TD is DISAPPROVED because the following terminal disclaimer requirements have not been met:

{the paralegal identifies any formal TD requirements (e.g., improper signature) that have not been satisfied}.

# JRA requirements questionnaire

- The TC must complete a JRA requirements questionnaire for EACH REFERENCE LISTED IN A JRA TD.
- Please email questionnaire to the SPE and cc the examiner who is assigned the application in which the JRA TD is filed.
- If **any one of the references** listed in the JRA TD does not meet all of the JRA requirements, then the **entire JRA TD is disapproved**.
- A reference does not meet all of the JRA requirements if:
  - ANY of the responses to questions 1b, 2a, 2c, 3a, and 4a (those shaded in grey) is NO in the questionnaire for the reference.
- A date is required for the response to item 2b (also shaded in grey). If the response to item 2b is missing, the questionnaire is incomplete and must be returned to the TC for correction.

# JRA requirements questionnaire (cont.)

- If, for EACH REFERENCE listed in the JRA TD, ALL of the responses to questions 1b, 2a, 2c, 3a, and 4a (those shaded in grey) are YES and a date is provided for item 2b (also shaded in grey), then APPROVE THE JRA TD if all other formal requirements for a TD (e.g., proper signature) are met.
- The completed JRA requirements questionnaire for EACH REFERENCE listed in the JRA TD must be attached to the end of the DISQ document.

# Completed JRA requirements questionnaire to be attached to the end of the DISQ document

[INTERNAL DOCUMENT – DO NOT MAIL] ATTACHMENT TO DISQ DOCUMENT

**Application/Proceeding Number** _____ **Terminal Disclaimer Filing Date** _____
**Questionnaire Completed by** _____ **Date of Completion** _____

**QUESTIONNAIRE TO ESTABLISH EVIDENCE OF A JOINT RESEARCH AGREEMENT FOR REFERENCE**

Rule 321(d) provides for the filing of a terminal disclaimer based on a joint research agreement (JRA TD). In order for the Patent Legal Research Center (PLRC) to process the JRA TD filed in the instant case, please complete this questionnaire for the reference listed in the JRA TD. If the **JRA TD lists more than one reference**, please complete a copy of this questionnaire for each additional reference. Completed questionnaire(s) will be included as part of the terminal disclaimer review decision (**DISQ document**).

| Item Related to the JRA Requirements for Reference Listed in the JRA TD | Response |
|---|---|
| **1a. What is the application number or patent number of the REFERENCE listed in the JRA TD?**<br>**Note:** The claim(s) in the reference forms the basis of any nonstatutory double patenting rejection. | |
| **1b. Is the reference listed in the JRA TD prior art? (YES/NO)**<br>**Note:** See pre-AIA 35 U.S.C. 103(c) and 35 U.S.C. 102(c), as applicable.<br>**If the reference is not prior art, then a grantable petition under 37 CFR 1.183 requesting waiver of the prior art requirement in 37 CFR 1.321(d) would be needed.** | |
| **2a. Did applicant file a statement under 37 CFR 1.104(c)(4)(ii)(A) or 37 CFR 1.104(c)(5)(ii)(A) as applicable (hereinafter JRA statement) in the instant application? (YES/NO)**<br>**Note:** For pre-AIA (FTI) cases, see pre-AIA 35 U.S.C. 103(c)(2), 37 CFR 1.104(c)(5)(ii)(A), and MPEP 706.02(l)(2)(III). For AIA (FITF) cases, see 35 U.S.C. 102(c), 37 CFR 1.104(c)(4)(ii)(A) and MPEP 717.02(a)(II). | |
| **2b. If the response to item 2a is YES, please provide the date of the JRA statement.** | (MM/DD/YYYY) |
| **2c. Is the JRA statement proper? (YES/NO)**<br>**Note:** See MPEP 706.02(l)(2)(III) or MPEP 717.02(a)(II), as applicable. | |
| **2d. If the response to item 2c is NO, please briefly explain in the space immediately below why the JRA statement is improper. THE JRA STATEMENT IS IMPROPER BECAUSE:** | If applicable, please explain in space below the question. |

# Completed JRA requirements questionnaire to be attached to the end of the DISQ document (cont.)

| | |
|---|---|
| **3a. Does the specification of the instant application disclose or is amended to disclose the names of the parties to the JRA? (YES/NO)**<br>**Note:** See pre-AIA 35 U.S.C. 103(c)(2) or 35 U.S.C. 102(c), as applicable. | |
| **3b. If the response to item 3a is YES, was an amendment made to include the names of the parties to the JRA? (YES/NO)** **Note:** Please respond "NO" ONLY IF the names of the parties to the JRA were in the specification on filing. | |
| **3c. If response to item 3b is YES, please include the date of the amendment.** | (MM/DD/YYYY) |
| **4a. Has applicant met the fee requirement in CFR 1.71(g)(2) either because (1) the fee was paid, (2) no fee was required because the amendment naming the parties to the JRA was timely, or (3) no fee was required because amendment was not needed (the names of the parties to the JRA were in the specification on filing)? (YES/NO)**<br>**Note:** If the fee set forth in 37 CFR 1.17(i) was required by 37 CFR 1.71(g)(2) and was not paid, then the response to item 4a **should be NO**. The answer **should be YES** if the TC charges or have charged the required fee, the amendment was timely or amendment was not needed (names of parties to JRA in specification on filing). If the required fee has not been paid and there is authorization to charge a deposit account for any fee deficiencies associated with the filing of the JRA TD, please **charge the fee using fee code 1830/2830/3830**. | |
| **4b. If the fee discussed in item 4a was paid or charged, please provide the date it was paid or charged.** | (MM/DD/YYYY) |

Page 1 of **1**

# Questions?

- For more information, please:
  - Contact the Office of Patent Legal Administration at (571) 272-7704 or
  - Email to Patent Practice@USPTO.gov; or
  - Contact:
    - Mark Polutta at (571) 272-7709
    - Terry Dey (571) 272-7730
    - Susy Tsang-Foster at (571) 272-7711

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# Appendix

# Statutory basis for terminal disclaimers

**35 U.S.C. 253 (pre-AIA). Disclaimer.**

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, and recorded in the Patent and Trademark Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

# Statutory basis for terminal disclaimers

**35 U.S.C. 253. Disclaimer.**

(a) IN GENERAL. – Whenever a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, and recorded in the Patent and Trademark Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

(b) ADDITIONAL DISCLAIMER OR DEDICATION. – In the manner set forth in subsection (a), any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

# 37 CFR 1.321 (pre-AIA) Statutory disclaimers, including terminal disclaimers

(a) A patentee owning the whole or any sectional interest in a patent may disclaim any complete claim or claims in a patent. In like manner any patentee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted. Such disclaimer is binding upon the grantee and its successors or assigns. A notice of the disclaimer is published in the *Official Gazette* and attached to the printed copies of the specification. The disclaimer, to be recorded in the Patent and Trademark Office, must:

(1) Be signed by the patentee, or an attorney or agent of record;

(2) Identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term, will be refused recordation;

(3) State the present extent of patentee's ownership interest in the patent; and

(4) Be accompanied by the fee set forth in § 1.20(d).

# 37 CFR 1.321 (pre-AIA) Statutory disclaimers, including terminal disclaimers (cont.)

(b) An applicant or assignee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of a patent to be granted. Such terminal disclaimer is binding upon the grantee and its successors or assigns. The terminal disclaimer, to be recorded in the Patent and Trademark Office, must:

(1) Be signed:

- (i) By the applicant, or
- (ii) If there is an assignee of record of an undivided part interest, by the applicant and such assignee, or
- (iii) If there is an assignee of record of the entire interest, by such assignee, or
- (iv) By an attorney or agent of record;

(2) Specify the portion of the term of the patent being disclaimed;

(3) State the present extent of applicant's or assignee's ownership interest in the patent to be granted; and

(4) Be accompanied by the fee set forth in § 1.20(d).

# 37 CFR 1.321 (pre-AIA) Statutory disclaimers, including terminal disclaimers (cont.)

(c) A terminal disclaimer, when filed to obviate judicially created double patenting in a patent application or in a reexamination proceeding except as provided for in paragraph (d) of this section, must:

(1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;

(2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding; and

(3) Include a provision that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the judicially created double patenting.

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# 37 CFR 1.321 (pre-AIA) Statutory disclaimers, including terminal disclaimers (cont.)

(d) A terminal disclaimer, when filed in a patent application or in a reexamination proceeding to obviate double patenting based upon a patent or application that is not commonly owned but was disqualified as prior art as set forth in either § 1.104(c)(4)(ii) or (c)(5)(ii) as the result of activities undertaken within the scope of a joint research agreement, must:

(1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;

(2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or be signed in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding;

(3) Include a provision waiving the right to separately enforce any patent granted on that application or any patent subject to the reexamination proceeding and the patent or any patent granted on the application which formed the basis for the double patenting, and that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent and the patent, or any patent granted on the application, which formed the basis for the double patenting are not separately enforced.

# 37 CFR 1.321 Statutory disclaimers, including terminal disclaimers

(a) A patentee owning the whole or any sectional interest in a patent may disclaim any complete claim or claims in a patent. In like manner any patentee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted. Such disclaimer is binding upon the grantee and its successors or assigns. A notice of the disclaimer is published in the *Official Gazette* and attached to the printed copies of the specification. The disclaimer, to be recorded in the Patent and Trademark Office, must:

(1) Be signed by the patentee, or an attorney or agent of record;

(2) Identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term, will be refused recordation;

(3) State the present extent of patentee's ownership interest in the patent; and

(4) Be accompanied by the fee set forth in § 1.20(d).

# 37 CFR 1.321 Statutory disclaimers, including terminal disclaimers (cont.)

(b) An applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of a patent to be granted. Such terminal disclaimer is binding upon the grantee and its successors or assigns. The terminal disclaimer, to be recorded in the Patent and Trademark Office, must:

(1) Be signed by the applicant or an attorney or agent of record;

(2) Specify the portion of the term of the patent being disclaimed;

(3) State the present extent of applicant's ownership interest in the patent to be granted; and

(4) Be accompanied by the fee set forth in § 1.20(d).

# 37 CFR 1.321 Statutory disclaimers, including terminal disclaimers (cont.)

(c) A terminal disclaimer, when filed to obviate judicially created double patenting in a patent application or in a reexamination proceeding except as provided for in paragraph (d) of this section, must:

(1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;

(2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding; and

(3) Include a provision that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the judicially created double patenting.

# 37 CFR 1.321 Statutory disclaimers, including terminal disclaimers (cont.)

(d) A terminal disclaimer, when filed in a patent application or in a reexamination proceeding to obviate double patenting based upon a patent or application that is not commonly owned but was disqualified as prior art as set forth in either § 1.104(c)(4)(ii) or (c)(5)(ii) as the result of activities undertaken within the scope of a joint research agreement, must:

(1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;

(2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or be signed in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding;

(3) Include a provision waiving the right to separately enforce any patent granted on that application or any patent subject to the reexamination proceeding and the patent or any patent granted on the application which formed the basis for the double patenting, and that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent and the patent, or any patent granted on the application, which formed the basis for the double patenting are not separately enforced.

# Introduction: What is a terminal disclaimer?

- A terminal disclaimer is a statement filed by an owner (of the entirety) of a patent or of a patent to be granted (i.e., an application) that disclaims or dedicates to the public the entire term or any terminal part of the term of a patent or patent to be granted.
- The owner of a patent or an application is the original inventor(s) who has/have not assigned away their rights or the assignee(s) of the original inventor(s), or a combination of the two.
- The patent or application is assigned by one assignment or by multiple assignments which establish a chain of title from the inventor(s) to the assignee(s).

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# Introduction: What is the purpose of a terminal disclaimer?

- A terminal disclaimer in an application or a reexamination proceeding is generally filed for the purpose of:
  - Overcoming a nonstatutory double patenting (NSDP) rejection (also called obviousness-type double patenting rejection or ODP rejection) based on a reference U.S. patent or application that is commonly owned. See MPEP § § 804.02, 717.02(b) and (c), 2146.03(III), and 2154.02(c).
  - Overcoming an NSDP rejection based on a reference U.S. patent or application that is not commonly owned but was disqualified as prior art as a result of activities undertaken within the scope of a joint research agreement (JRA). See MPEP § § 804.02, 717.02(b) and (c), 2146.03(III), and 2154.02(c).
  - Protecting any patent to be issued from an NSDP rejection, even though no such rejection is made at the time of filing the TD (preemptive filing of a TD).

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# Introduction: When can a terminal disclaimer be filed?

- There is no requirement for a nonstatutory double patenting rejection to made before a terminal disclaimer can be filed.
  - Applicant may file a terminal disclaimer at any time during prosecution even though there is no nonstatutory double patenting rejection of record in the application or in the reexamination proceeding.

# When pre-AIA or AIA rules related to TD practice apply

# Determining whether AIA or pre-AIA rules apply

- If the filing date of an application is **before September 16, 2012**, then the **pre-AIA** rules apply.
- If the filing date of an application is **on or after September 16, 2012**, then the **AIA** rules apply.
- To determine filing date, look at either:
  - Filing receipt;
  - Bib data sheet; or
  - PALM (recommended)

# How to determine the filing date of an application

# The filing date of a nonprovisional application under 35 U.S.C. 111(a)

- The filing date of a nonprovisional application (except design) filed under 35 U.S.C. 111(a) on or after December 18, 2013 is:
  - The date on which a specification, with or without claims, is received in the USPTO.
- The filing date of an application for a design patent is:
  - The date on which the specification as prescribed by 35 U.S.C. 112, including at least one claim, and any required drawings are received in the USPTO.

MPEP 601.01(a) and 601.01(b); 37 CFR 1.53(b) and (c)

uspto

# The filing date of a nonprovisional application under 35 U.S.C. 111(a)

**Application Number Information**

Application Number: **12/xxx,xxx** Assignments

Filing or 371(c) Date: **05/11/2010** eDan

Effective Date: **05/11/2010**

Application Received: **05/11/2010**

Pat. Num./Pub. Num: yyyyyyy/zzzzzzzzzzz

Issue Date: **06/03/2014**

Date of Abandonment: **00/00/0000**

Attorney Docket Number: **123456789**

Status: **150 /PATENTED CASE**

AIA (First Inventor to File): **NO**

Examiner Number: **009/ LEGAL, PAT N.**

Group Art Unit: 2662

Class/Subclass: **348/229.100**

Interference Number:

Unmatched Petition: **NO**

L&R Code: Secrecy Code:**1**

Third Level Review: **NO**

Confirmation Number: **5278**

Oral Hearing: **NO**

Title of Invention: **IMAGE CAPTURING APPARATUS AND CONTROL PROGRAM FOR T**

*The filing date*

| Bar Code | PALM Location | Location Date | Charge to Loc | Charge to Name | Empl |
|---|---|---|---|---|---|

**Appln Info** Contents | Petition Info | Atty/Agent Info | Continuity Data | Foreign Data | Inventors | Applicants | Ac

# The filing date of a nonprovisional application under 35 U.S.C. 111(a)

*A screenshot of a filing receipt in IFW:*

*The filing date of a 111(a) application is always located here on the filing receipt*

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NUMBER | FILING or 371(c) DATE | GRP ART UNIT | FIL FEE REC'D | ATTY.DOCKET.NO | TOT CLAIMS | IND CLAIMS |
|---|---|---|---|---|---|---|
| 12/xxx,xxx | 05/11/2010 | 2873 | 1090 | 123456789 | 4 | 2 |

**CONFIRMATION NO. 5278**

**FILING RECEIPT**

Law Firm
999999 K Street, N.W.
Washington, DC 20005-3315

*OC000000041706445*

Date Mailed: 05/24/2010

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit**

# The filing date of a U.S. national stage application under 35 U.S.C. 371

- The filing date of a U.S. national stage application under 35 U.S.C. 371 ("the 371 application") is the international filing date of the PCT application.
  - Often the date of entry into the national stage is confused with the filing date. See MPEP § 1893.03(b).

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# The filing date of a U.S. national stage application under 35 U.S.C. 371

**Application Number Information**

Application Number: 09/XXX,XXX Order This File Assignments
Filing or 371(c) Date: 01/14/2000 eDan
Effective Date: 01/14/2000
Application Received: 01/14/2000
Patent Number: xxxxxxx
Issue Date: 03/12/2002
Date of Abandonment: 00/00/0000
Attorney Docket Number: 6757
Status: 150 /PATENTED CASE
Confirmation Number: 5671
Title of Invention: PROCESS FOR MAKING A LOW DENSITY DETERGENT COMP

Examiner Number: xxxxxx
Group Art Unit: 1751
Class/Subclass: 510/446.0
Lost Case: NO
Interference Number:
Unmatched Petition: NO
L&R Code: Secrecy Code
Third Level Review: NO
Oral Hearing: NO

| Bar Code | PALM Location | Location Date | Charge to Loc | Ch |
|---|---|---|---|---|
| 10XXXXXX | 9200 | 03/08/2002 | No Charge to Location | No C |

Appln Info | Contents | Petition Info | Atty/Agent Info | Continuity Data | Foreign D

*The date of entry (**not** the filing date)*

# The filing date of a U.S. national stage application under 35 U.S.C. 371

**Continuity/Reexam Information for 09/xxxxxx**

**Parent Data**

09XXXXXX filed 01/14/2000, now U.S. Patent #xxxxxxx is a national stage entry of PCT/US98/xxxxxx, International Filing Date: 07/08/1998

*The U.S. filing date of a 371 is the international filing date*

*The 371(c) date, generally, the date of entry*

# The filing date of a U.S. national stage application under 35 U.S.C. 371

*The date of entry (not the filing date of the 371 national stage application ("371"))*

*The filing date of the 371*

P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

BIB DATA SHEET

CONFIRMATION NO. 5671

| SERIAL NUMBER | FILING or 371(c) DATE | CLASS | GROUP ART UNIT | ATTORNEY DOCKET NO. |
|---|---|---|---|---|
| 09/xxx,xxx | 01/14/2000 RULE | 510 | 1751 | 6757 |

**APPPLICANTS**

JOHNNY APPLE SEED, MONTGOMERY, AL
JOHN ALEXANDER GRAHAM DOE, LEXINGTON, KY;

** CONTINUING DATA **********
This application is a 371 of PCT/US98/xxxxx 07/08/1998

** FOREIGN APPLICATIONS **********

** IF REQUIRED, FOREIGN FILING LICENSE GRANTED **
04/25/2000

| Foreign Priority claimed ☐ Yes ☐ No<br>35 USC 119(a-d) conditions met ☐ Yes ☐ No<br>Verified and Acknowledged Examiner's Signature | ☐ Met after Allowance<br>Initials | STATE OR COUNTRY | SHEETS DRAWINGS | TOTAL CLAIMS | INDEPENDENT CLAIMS |
|---|---|---|---|---|---|
| | | OH | | 5 | 1 |

ADDRESS

# The filing date of a 111(a) continuation (CON) of a 371 national stage application

**Application Number Information**

Application Number: 14/xxx,xxx Assignments

Filing or 371(c) Date: **12/06/2013** eDan

Effective Date: **12/06/2013**

Application Received: **12/06/2013**

Pat. Num./Pub. Num: ZZZZZZZ

Issue Date: **00/00/0000**

Date of Abandonment: **00/00/0000**

Attorney Docket Number: **40 XXX-XXXXX**

Status: **30 /DOCKETED NEW CASE - READY FOR EXAM**

Confirmation Number: **9858**

Title of Invention: **USE OF DEXTRAN SULFATE**

AIA (Fi
Examin
MICH
Group
Class/S
Interfer
Unmatc
L&R C
Third L
Oral He

| Bar Code | PALM Location | Location Date | Charge to |
|---|---|---|---|

**Appln Info** Contents | Petition Info | Atty/Agent Info | Continuity Data

*The filing date of the 111(a) CON of a 371*

# The filing date of a 111(a) continuation (CON) of a 371 national stage application

## Continuity/Reexam Information for 14/xxxxxx

**Parent Data**

14XXXXXX filed 12/06/2013 is a continuation of 10YYYYYY, filed 01/09/2006 ,now U.S. Patent #ZZZZZZZ and having 1 RCE-type filing therein

10YYYYYY is a national stage entry of PCT/SE2003/xxxxxx, International Filing Date: 11/26/2003

claims foreign priority to XYZXYZ , filed 11/28/2002

*The U.S. filing date*

# The filing date of a 111(a) continuation (CON) of a 371 national stage application

P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

BIB DATA SHEET

CONFIRMATION NO. 9858

| SERIAL NUMBER | FILING or 371(c) DATE | CLASS | GROUP ART UNIT | ATTORNEY DOCKET NO. |
|---|---|---|---|---|
| 14/xxx,xxx | 12/06/2013<br>RULE | 514 | 1673 | 40XXX-XXXXX |

APPLICANTS
ACME CORP., UPPSALA, SWEDEN, Assignee (with 37 CFR 1.172 Interest);

INVENTORS
NEWT APPLE SEED, UPPSALA, SWEDEN
HANS ALEXANDER GRAHAM DOE, UPPSALA, SWEDEN

** CONTINUING DATA **********
This application is a CON of 10/yyy,yyy 1/09/2006 PAT ZZZZZZZ
which is a 371 of PCT/SE2003/xxxxx 11/26/2003

** FOREIGN APPLICATIONS **********
SWEDEN XYZXYZ 11/28/2002

*The filing date of the 111(a) CON of a 371 application*

# The filing date of a 111(a) continuation (CON) of a PCT application

**Application Number Information**

Application Number: 14/xxx,xxx **Assignments** AIA (
Filing or 371(c) Date: **10/03/2013** eDan Exam
Effective Date: **10/03/2013** Group
Application Received: **10/03/2013** Class/
Pat. Num./Pub. Num: /XXXXXXXXXXX Interfe
Issue Date: **00/00/0000** Unma
Date of Abandonment: **00/00/0000** L&R
Attorney Docket Number: xxxx-xxx Third
Status: **30 /DOCKETED NEW CASE - READY FOR EXA**
Con Oral
Title of Invention: **WOUND CARE ARTICLE WITH AN E MANNER**

| Bar Code | PALM Location | Location Date | Charge |
|---|---|---|---|

**Appln Info** Contents | Petition Info | Atty/Agent Info | Continuity Data

*The filing date of a 111(a) CON of a PCT (aka a **bypass application**)*

# The filing date of a 111(a) continuation (CON) of a PCT application

## Continuity/Reexam Information for 14/xxxxxx

**Parent Data**

**14XXXXXX, filed 10/03/2013 is a continuation of PCT/EP2012/XXXX, filed 04/04/2012**
**claims foreign priority to YYYYYYY.Y , filed 04/06/2011**

*The U.S. filing date of a bypass application*

# The filing date of a 111(a) continuation (CON) of a PCT application

Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

BIB DATA SHEET

CONFIRMATION NO. 2417

| SERIAL NUMBER | FILING or 371(c) DATE | CLASS | GROUP ART UNIT | ATTORNEY DOCKET NO. |
|---|---|---|---|---|
| 14/XXX,XXX | 10/03/2013<br>RULE | 604 | 3778 | XXXX-XXX |

**APPLICANTS**

**INVENTORS**

**Frederick Smith, Munster, GERMANY**

** **CONTINUING DATA** **********

This application is a CON **of PCT/EP2012/XXXX** 04/04/2012

** **FOREIGN APPLICATIONS** **********

GERMANY YYYYYYY.Y 04/06/2011

*The filing date of a 111(a) CON of a PCT application (a bypass application)*

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# Summary of the filing date of a 371 application or a 111(a) application that claims benefit to a PCT application or a 371 application

| | National stage application (submitted under 35 U.S.C. 371) | National application (filed under 35 U.S.C. 111(a)) involving a PCT application |
|---|---|---|
| **Filing date** | International filing date of PCT application – **Shown in the Continuity Data in PALM for the 371 application** | Filing date of 111(a) application - **Shown in PALM as: Filing or 371(c) Date: xx/xx/xxxx** |
| **How identified*** | 371 of the PCT | CON, DIV, or CIP of a PCT or CON, DIV, or CIP of a 371 |

- **Should be listed in the domestic benefit section of the filing receipt and in the continuity data section in PALM.*

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# Who can sign a terminal disclaimer

# Who can sign a terminal disclaimer? (For applications filed before 9/16/12)

- **THE OWNER OR ATTORNEY/AGENT OF RECORD MUST SIGN. See pre-AIA 37 CFR 1.321(b)(1)**
- A terminal disclaimer is a statement filed by an owner (in entirety) of a patent or an application for a patent to be granted, in which statement the owner relinquishes certain legal rights to the patent.
- The owner of a patent or an application is (a) all of the assignees from the inventors, plus (b) any inventors who have not assigned away their rights.
- A patent or an application is assigned by one assignment or multiple assignments which establish a chain of assignment (a chain of title) from all of the inventors to all of the assignees.
  - For example, if there are inventors A, B, and C, A and B might assign to X Corporation while C might separately assign to the Y Corporation. The Y Corporation then might assign to the Z Corporation. If so, X Corporation and Z Corporation together are the entirety of the ownership.

    A + B → X and C → Y → Z X and Z own it

# Who can sign a terminal disclaimer? (For applications filed before 9/16/12) (cont.)

- 1) The owner of the patent or application can sign a terminal disclaimer, and a person legally empowered by the owner to sign the terminal disclaimer can also sign it.
- 2) An attorney or agent of record (that is, a registered attorney or agent given power of attorney) is permitted to sign the disclaimer. See Pre-AIA 37 CFR 1.321(b)(1)(iv).
  - A registered practitioner (attorney or agent) acting in a representative capacity under 37 CFR 1.34 is NOT permitted to sign a terminal disclaimer.

# Who can sign a terminal disclaimer? (For applications filed before 9/16/12) (cont.)

- For a terminal disclaimer filed in an application, it must be signed by (see pre-AIA 37 CFR 1.321(b)(1)):
  1) The pre-AIA 37 CFR 1.41(b) applicants, where the application has not been assigned
     - pre-AIA 37 CFR 1.41(b) applicants = inventors (or pre-AIA CFR 1.42 & 1.43 representatives (of a deceased, insane or legally incapacitated inventor) other than non-joining ones under pre-AIA 37 CFR 1.47 (inventor who refuses to sign or cannot be reached)
  2) The applicant and the assignee where each owns a part interest in the application,
  3) The assignee where the assignee owns the entire interest in the application, or
  4) An attorney or agent of record.
- For 1) – 3), the entirety of all owners must provide the terminal disclaimer or separate terminal disclaimers to be effective for the patent that will issue.
  - If less than all sign, it is a valid document, but do not enter it until you get terminal disclaimers from all of the entirety of the owners.

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# Requirements of an assignee signing a terminal disclaimer (For applications filed before 9/16/12)

- Where the assignee signs the terminal disclaimer:
  - There is a requirement to comply with pre-AIA 37 CFR 3.73(b) in order to satisfy pre-AIA 37 CFR 1.321.
    - Form PTO/SB/96 ("Statement Under 37 CFR 3.73(b)") may be used for making the required statement establishing the assignee's right to take action in signing the disclaimer. See MPEP § 324.
- Where either (a) an attorney or agent of record signs the terminal disclaimer, or (b) the inventors (when patent or application is not assigned) sign, there is no need to comply with pre-AIA 37 CFR 3.73(b).

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## Requirements of an assignee signing a terminal disclaimer (For applications filed before 9/16/12) (cont.)

- In order to comply with pre-AIA 37 CFR 3.73(b), the assignee's ownership interest must be established by filing, in the application or patent, a signed statement identifying the assignee, together with either:
  1) A submission of (a) documentary evidence of a chain of title from the original owner to the assignee and (b) a statement affirming that such documentary evidence was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11, OR
  2) A statement specifying in the record of the application or patent where such documentary evidence is recorded in the Office (e.g., reel and frame number, etc.).

# Requirements of an assignee signing a terminal disclaimer (For applications filed before 9/16/12) (cont.)

- As discussed in MPEP § 324, where at least one inventor retains an ownership interest together with any partial assignee(s), the combination of all partial assignees and inventors retaining ownership interest is needed to conduct the prosecution of an application, unless one or more inventors have refused to join in the filing of the application and a petition under pre-AIA 37 CFR 1.47 has been granted.
  - If a petition under pre-AIA 37 CFR 1.47 has been granted as to all inventors retaining ownership, then the assignee need only be the assignee of the entire interest of the 37 CFR 1.47 applicant to sign a power of attorney. See pre-AIA 37 CFR 1.32(b)(4).
  - Where one or more inventors for whom a pre-AIA 37 CFR 1.47 petition has not been granted retain any ownership interest, the combination of all partial assignees and such inventors with the ownership interest is needed to conduct the prosecution of an application.
  - Note that a terminal disclaimer can only be filed where there is representation of the entire right title and interest.

# Requirements of an assignee signing a terminal disclaimer (For applications filed before 9/16/12) (cont.)

- **When should a pre-AIA 37 CFR 3.73(b) statement be filed?**
  - The establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper taking action is submitted. Pre-AIA 37 CFR 3.73(c).
    - If the submission establishing ownership is not present, the paper seeking to take action will not be given effect, and must be resubmitted with the pre-AIA 37 CFR 3.73(b) submission (or after the submission).
  - The action taken by the assignee (e.g., signing the disclaimer), and the pre-AIA 37 CFR 3.73(b) submission establishing the assignee's right to take such action, can be combined in one paper.
  - Documents submitted to establish ownership are required to be recorded, or submitted for recordation, pursuant to 37 CFR 3.11, as a condition to permitting the assignee to take action in a matter pending before the Office.

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## Requirements of an assignee signing a terminal disclaimer (For applications filed before 9/16/12) (cont.)

- The submission with respect to pre-AIA 37 CFR 3.73(b) to establish ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by either:
  i. Including a statement that the person signing the submission is authorized to act on behalf of the assignee; OR
  ii. Being signed by a person having apparent authority to sign on behalf of the assignee, e.g., an officer of the assignee. See the next slide.
- A copy of a formal legal document issued by the assignee, such as a corporate resolution, may be attached to satisfy (i) above.

## Requirements of an assignee signing a terminal disclaimer (For applications filed before 9/16/12) (cont.)

- Where the assignee is an organizational entity (e.g., corporation, partnership, university, government agency, etc.):
  - A person (in the organization) has apparent authority to sign a pre-AIA 37 CFR 3.73(b) submission on behalf of the organization per pre-AIA 37 CFR 3.73(b)(2)(ii), if the person is an officer, such as the chief executive officer, president, vice-president, secretary, treasurer, or the chairman of the board of directors.
  - Modifications of these basic titles are acceptable, such as vice-president for sales, executive vice-president, assistant treasurer, vice-chairman of the board of directors.
  - The signature of an individual director is not acceptable in the U.S.A.

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## Requirements of an assignee signing a terminal disclaimer (For applications filed **before** 9/16/12) (cont.)

- **In foreign countries**, a person who holds the title "Manager" or "Director" is normally an officer and is presumed to have the authority to sign on behalf of the organization.

- A person having a title (administrator, general counsel) **that does not clearly set forth that person as an officer of the assignee** is not presumed to have authority to sign the submission on behalf of the assignee.

## Who can sign a terminal disclaimer? (For applications filed on/after 9/16/12)

- For a terminal disclaimer filed in an application filed on/after 9/16/12, it **must be signed by** (see 37 CFR 1.321(b)(1)):
  1. The applicant (and if applicant is a juristic entity assignee, a person legally empowered by the applicant assignee can also sign the terminal disclaimer) OR
  2. An attorney or agent of record.
- For (1), the entirety of all owners must provide the terminal disclaimer or separate terminal disclaimers to be effective for the patent that will issue.
  - If less than all sign, it is a valid document, but do not enter it until you get terminal disclaimers from all of the entirety of the owners.

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## Who can sign a terminal disclaimer? (For applications filed on/after 9/16/12)

- Note: If the inventors are the applicant but not the owner(s) of the application, then the owners will need to become the applicant by filing a request to change the applicant under 37 CFR 1.46(c)(2), a corrected ADS, and a statement under 37 CFR 3.73(c) to show chain of title.

# Form paragraphs in MPEP 1490 for examples of acceptable language in terminal disclaimers

# Examples of acceptable language in terminal disclaimers under 37 CFR 1.321(c)

- Form paragraphs containing examples of acceptable language in a terminal disclaimer filed under 37 CFR 1.321(c) are available.

- The next few slides are examples of the acceptable language in a terminal disclaimer filed under 37 CFR 1.321(c).

# ¶ 14.27.04.fti Examples of Acceptable Terminal Disclaimer Language in Patent To Be Granted –For Applications Filed Before Sept. 16, 2012

This application was filed before September 16, 2012. Examples of acceptable language for making the disclaimer of the terminal portion of any patent granted on the subject application follow:

I. If a Provisional Nonstatutory Double Patenting Rejection Over A Pending Application was made, use:

The owner, _____, of _____ percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending reference application Number _____, filed on _____, as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application. The owner hereby agrees that any patent so granted on the instant application **shall be enforceable only for** and during such period that it and any patent granted on the **reference** application **are commonly owned**. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

# ¶ 14.27.04.fti Examples of Acceptable Terminal Disclaimer Language in Patent To Be Granted (For Applications Filed Before 9/16/2012) (cont.)

II. If a Nonstatutory Double Patenting Rejection Over A Reference Patent was made, use:

The owner, _____, of _____ percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of **patent** No. _____ (the "reference patent") as the term of said **reference patent** is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application **shall be enforceable only** for and during such period that it and the **reference patent** **are commonly owned**. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

Alternatively, Form PTO/SB/25 may be used for situation I, and Form PTO/SB/26 may be used for situation II; a copy of each form may be found at the end of MPEP § 1490.

# ¶ 14.27.04.1 Examples of Acceptable Terminal Disclaimer Language in Patent To Be Granted (For Applications Filed on or after 9/16/2012)

This application was filed on or after September 16, 2012. Examples of acceptable language for making the disclaimer of the terminal portion of any patent granted on the subject application follow:

I. If a Provisional Nonstatutory Double Patenting Rejection Over A Pending Application was made, use:

The applicant, _____, owner of _____ percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending **reference** application Number _____, filed on _____, as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application. The applicant hereby agrees that any patent so granted on the instant application **shall be enforceable only for** and during such period that it and any patent granted on the **reference** application **are commonly owned**. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

# ¶ 14.27.04.1 Examples of Acceptable Terminal Disclaimer Language in Patent To Be Granted (For Applications Filed on or after 9/16/2012) (cont.)

II. If an Nonstatutory Double Patenting Rejection Over A Reference Patent was made, use:

The applicant, _____, owner of _____ percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of **reference patent** No. _____ as the term of said **reference patent** is presently shortened by any terminal disclaimer. The applicant hereby agrees that any patent so granted on the instant application **shall be enforceable only for** and during such period that it and the **reference patent** **are commonly owned**. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

Alternatively, Form PTO/AIA/25 may be used for situation I, and Form PTO/AIA/26 may be used for situation II.

# ¶ 14.27.06 Examples of Acceptable Terminal Disclaimer Language Under 37 CFR 1.321(c) in Patent (Reexamination Situation)

Examples of acceptable language for making the disclaimer of the terminal portion of the patent being reexamined (or otherwise for an existing patent) follow:

I. If a Provisional Nonstatutory Double Patenting Rejection Over A Pending Application was made, or is otherwise believed to be applicable to the patent, use:

The patentee,_____, owner of _____percent interest in the instant patent hereby disclaims the terminal part of the statutory term of the instant patent, which would extend beyond the expiration date of the full statutory term of any patent granted on pending **reference** application No. _____, filed on _____, as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application. The patentee hereby agrees that the instant patent **shall be enforceable only for** and during such period that the instant patent and any patent granted on the pending **reference** application **are commonly owned**. This agreement is binding upon the patentee, its successors, or assigns.

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# ¶ 14.27.06 Examples of Acceptable Terminal Disclaimer Language Under 37 CFR 1.321(c) in Patent (Reexamination Situation) (cont.)

II. If a Nonstatutory Double Patenting Rejection Over A Reference Patent was made, or is otherwise believed to be applicable to the instant patent, use:

The patentee, _____, owner of _____ percent interest in the instant patent hereby disclaims the terminal part of the statutory term of the instant patent, which would extend beyond the expiration date of the full statutory term of **reference** patent No. _____ as the term of said **reference** patent is presently shortened by any terminal disclaimer. The patentee hereby agrees that the instant patent **shall be enforceable only for** and during such period that the instant patent and the **reference** patent **are commonly owned**. This agreement is binding upon the patentee, its successors, or assigns.

Alternatively, Form PTO/SB/25a may be used for situation I, and Form PTO/SB/26a may be used for situation II.

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# Examples of acceptable language in terminal disclaimers under 37 CFR 1.321(d)

- Form paragraphs containing examples of acceptable language in a terminal disclaimer filed under 37 CFR 1.321(d) are available.

- The next few slides are examples of the acceptable language in a terminal disclaimer filed under 37 CFR 1.321(d)

# 14.27.07.fti Examples of Acceptable Terminal Disclaimer Language – Application Filed Before Sept. 16, 2012, Activities Undertaken Within the Scope of a Joint Research Agreement (JRA)

This application was filed before September 16, 2012. Examples of acceptable language for making the disclaimer of the terminal portion of any patent granted on the subject application follow:

I. If a Provisional Nonstatutory Double Patenting Rejection Over A Pending Application was made, use:

The owner,_____, of _____percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending **reference** application Number _____, filed on_____, as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application.

The owner of the instant application **waives the right to separately enforce** any patent granted on the instant application and any patent granted on the **reference** application. The owner of the instant application hereby agrees that any patent granted on the instant application and any patent granted on the **reference** application **shall be enforceable only for** and during such period that any patent granted on the instant application and any patent granted on the **reference** application **are not separately enforced**. The waiver, and this agreement, run with any patent granted on the instant application and any patent granted on the reference application, and are binding upon the owner of the instant application, its successors, or assigns.

## 14.27.07.fti Examples of Acceptable Terminal Disclaimer Language – Application Filed Before Sept. 16, 2012, Activities Undertaken Within the Scope of a Joint Research Agreement (JRA) (cont.)

II. If a Nonstatutory Double Patenting Rejection Over A Reference Patent was made, use:

The owner, _____, of_____ percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of **reference** patent No. _____, as the term of said **reference** patent is presently shortened by any terminal disclaimer.

The owner of the instant application **waives the right to separately enforce** the **reference** patent and any patent granted on the instant application. The owner of the instant application hereby agrees that the **reference** patent and any patent granted on the instant application **shall be enforceable only for** and during such period that the **reference** patent and any patent granted on the instant application **are not separately enforced**. The waiver, and this agreement, run with any patent granted on the instant application and are binding upon the owner of the instant application, its successors, or assigns.

# ¶ 14.27.07.1 Examples of Acceptable Terminal Disclaimer Language – Application Filed On or After Sept. 16, 2012, Activities Undertaken Within the Scope of a Joint Research Agreement

This application was filed on or after September 16, 2012. Examples of acceptable language for making the disclaimer of the terminal portion of any patent granted on the subject application follow:

I. If a Provisional Nonstatutory Double Patenting Rejection over a Pending Application was made, use:

The applicant, _____, owner of _____ percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending **reference** application Number _____, filed on _____, as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application.

The applicant of the instant application **waives the right to separately enforce** any patent granted on the instant application and any patent granted on the **reference** application. The applicant of the instant application hereby agrees that any patent granted on the instant application and any patent granted on the **reference** application **shall be enforceable only for** and during such period that any patent granted on the instant application and any patent granted on the **reference** application **are not separately enforced**. The waiver, and this agreement, run with any patent granted on the instant application and any patent granted on the **reference** application, and are binding upon the applicant of the instant application, its successors, or assigns.

## ¶ 14.27.07.1 Examples of Acceptable Terminal Disclaimer Language – Application Filed On or After Sept. 16, 2012, Activities Undertaken Within the Scope of a Joint Research Agreement (cont.)

II. If a Nonstatutory Double Patenting Rejection Over A Reference Patent was made, use:

The applicant, _____, owner of _____ percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of **reference** patent No. _____, as the term of said **reference** patent is presently shortened by any terminal disclaimer.

The applicant of the instant application **waives the right to separately enforce** the **reference** patent and any patent granted on the instant application. The applicant of the instant application hereby agrees that the **reference** patent and any patent granted on the instant application **shall be enforceable only for** and during such period that the **reference** patent and any patent granted on the instant application **are not separately enforced**. The waiver, and this agreement, run with any patent granted on the instant application and are binding upon the applicant of the instant application, its successors, or assigns.

# ¶ 14.27.08 Examples of Acceptable Terminal Disclaimer Language in Patent (Reexamination Situation; activities Undertaken Within the Scope of a Joint Research Agreement)

Examples of acceptable language for making the disclaimer of the terminal portion of the patent being reexamined (or otherwise for an existing patent) follow:

I. If a provisional nonstatutory double patenting rejection over a Pending Application was made, or is otherwise believed to be applicable to the patent, use:

The patentee,_____, owner of _____percent interest in the instant patent hereby disclaims the terminal part of the statutory term of the instant patent, which would extend beyond the expiration date of the full statutory term of any patent granted on pending **reference** Application Number _____, filed on _____, as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application.

The patentee **waives the right to separately enforce** the instant patent and any patent granted on the pending **reference** application. The patentee agrees that the instant patent and any patent granted on the pending **reference** application **shall be enforceable only for** and during such period that the instant patent and the patent granted on the pending **reference** application **are not separately enforced**. The waiver and this agreement run with the instant patent, and are binding upon the patentee, its successors, or assigns.

## ¶ 14.27.08 Examples of Acceptable Terminal Disclaimer Language in Patent (Reexamination Situation; activities Undertaken Within the Scope of a Joint Research Agreement) (cont.)

II. If a Nonstatutory Double Patenting Rejection over a Reference Patent was made, or is otherwise believed to be applicable to the instant patent, use:

The patentee,_____, owner of _____percent interest in the instant patent hereby disclaims the terminal part of the statutory term of the instant patent, which would extend beyond the expiration date of the full statutory term of **reference** patent No. _____, as the term of said **reference** patent is presently shortened by any terminal disclaimer.

The patentee **waives the right to separately enforce** the instant patent and the **reference** patent. The patentee agrees that the instant patent and the **reference** patent **shall be enforceable only for** and during such period that the instant patent and the **reference** patent **are not separately enforced**. The waiver and this agreement run with the instant patent and are binding upon the patentee, its successors, or assigns.

# Forms for terminal disclaimers under 37 CFR 1.321(c) based on common ownership

# Forms for terminal disclaimers based on common ownership - 37 CFR 1.321(c)

- Forms **PTO/SB/25 and PTO/SB/26** - Terminal disclaimer forms based on common ownership **used in applications filed before 9/16/2012** to either obviate a provisional double patenting rejection in an application under examination over a pending "reference" application (PTO/SB/25) or over a "Prior Patent" (PTO/SB/26)
- Forms **PTO/AIA/25 and PTO/AIA/26** - Terminal disclaimer forms based on common ownership **used in applications filed on or after 9/16/2012**
- Form **PTO/SB/25a** - Terminal disclaimer form based on common ownership **used in a patent or proceeding in view of an application**
- Form **PTO/SB/26a** - Terminal disclaimer form based on common ownership **used in a patent or proceeding in view of another patent**
- Note the **optional exculpatory language** in the second paragraph of the terminal disclaimer forms:
  - ("In making the above disclaimer, the owner/applicant/patentee does not disclaim...") is permissible in a terminal disclaimer.

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# Form PTO/SB/25- Terminal disclaimer to obviate a provisional double patenting rejection over a pending "reference" application

PTO/SB/25 (08-11)
Approved for use through 07/31/2012. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

| TERMINAL DISCLAIMER TO OBVIATE A PROVISIONAL DOUBLE PATENTING REJECTION OVER A PENDING "REFERENCE" APPLICATION | Docket Number (Optional) |
|---|---|

In re Application of:

Application No.:

Filed:

For:

The owner*, _____, of _____ percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending **reference** Application Number _____ filed _____, as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the **reference** application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would exte to the expiration date of the full statutory term of any patent granted on said **reference** application, "as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application, in the event that: any such patent: granted on the pending **reference** application: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

*owner or assignee*

*extent of ownership*

*disclaiming statement*

*enforceability clause or statement of common ownership*

*optional protection clause or exculpatory statement in event the earlier related patent is lapsed, etc.*

# Form PTO/SB/25- Terminal disclaimer to obviate a provisional double patenting rejection over a pending "reference" application (cont.)

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☐ The undersigned is an attorney or agent of record. Reg. No. _____

Signature | Date

Typed or printed name

Telephone Number

☐ Terminal disclaimer fee under 37 CFR 1.20(d) is included.

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner). Form PTO/SB/96 may be used for making this statement. See MPEP § 324.

# Form PTO/AIA/25- Terminal disclaimer to obviate a provisional double patenting rejection over a pending "reference" application

PTO/AIA/25 (04-13)
Approved for use through 04/30/2013. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**TERMINAL DISCLAIMER TO OBVIATE A PROVISIONAL DOUBLE PATENTING REJECTION OVER A PENDING "REFERENCE" APPLICATION**

Docket Number (Optional)

In re Application of:

Application No.:

Filed:

For:

The applicant, _____, owner of _____ percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending **reference** Application Number_____, filed, _____, as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application. The applicant hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the **reference** application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the applicant does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term of any patent granted on said **reference** application, "as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application," in the event that: any such patent granted on the pending **reference** application expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

Check either box 1 or 2 below, if appropriate.

1. ☐ The undersigned is the applicant. If the applicant is an assignee, the undersigned is authorized to act on behalf of the assignee.

I hereby acknowledge that any willful false statements made are punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.

2. ☐ The undersigned is an attorney or agent of record. Reg. No. _____

*disclaiming statement*

*applicant*

*extent of ownership*

*optional protection clause or exculpatory statement in event the earlier related patent is lapsed, etc.*

*enforceability clause or statement of common ownership*

# Form PTO/AIA/25- Terminal disclaimer to obviate a provisional double patenting rejection over a pending "reference" application (cont.)

Check either box 1 or 2 below, if appropriate.

1. ☐ The undersigned is the applicant. If the applicant is an assignee, the undersigned is authorized to act on behalf of the assignee.

I hereby acknowledge that any willful false statements made are punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.

2. ☐ The undersigned is an attorney or agent of record. Reg. No. _____

Signature | Date

Typed or printed name

Title | Telephone Number

☐ Terminal disclaimer fee under 37 CFR 1.20(d) is included.

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO

# Exculpatory language in forms PTO/SB/25 and PTO/AIA/25

In making the above disclaimer, the owner (PTO/SB/25) or applicant (PTO/AIA/25) does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term of any patent granted on said **reference** application, "as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application," in the event that any such patent granted on the pending **reference** application expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

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# Form PTO/SB/26- Terminal disclaimer to obviate a double patenting rejection over a "prior" patent

PTO/SB/26 (08-11)
Approved for use through 07/31/2012. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION OVER A "PRIOR" PATENT**

Docket Number (Optional)

In re Application of:

Application No.:

Filed:

For:

*owner or assignee*

*extent of ownership*

*disclaiming statement*

The owner*, _____, of _____ percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of **prior patent** No. _____ as the term of said **prior patent** is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the **prior patent** are commonly owned. This agreement runs with any patent granted on the instant applicatio and is binding upon the grantee, its successors or assigns.

*enforceability clause or statement of common ownership*

In making the above disclaimer, the owner does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term of the **prior patent**, "as the term of said **prior patent** is presently shortened by any terminal disclaimer," in the event that said **prior patent** later:

expires for failure to pay a maintenance fee;
is held unenforceable;
is found invalid by a court of competent jurisdiction;
is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321;
has all claims canceled by a reexamination certificate;
is reissued; or
is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

*optional protection clause or exculpatory statement in event the earlier related patent is lapsed, etc.*

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

# Form PTO/SB/26- Terminal disclaimer to obviate a double patenting rejection over a "prior" patent (cont.)

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☐ The undersigned is an attorney or agent of record. Reg. No._____

Signature | Date

Typed or printed name

Telephone Number

☐ Terminal disclaimer fee under 37 CFR 1.20(d) included.

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner). Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO

# Form PTO/AIA/26- Terminal disclaimer to obviate a double patenting rejection over a "prior" patent

PTO/AIA/26 (04-14)
Approved for use through 07/31/2016. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION OVER A "PRIOR" PATENT**

Docket Number (Optional)

In re Application of:

Application No.:

Filed:

For:

*disclaiming statement*

*applicant*

*extent of ownership*

The applicant, _____, owner of _____ percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of **prior patent** No. _____ as the term of said **prior patent** is presently shortened by any terminal disclaimer. The applicant hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the **prior patent** are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

*enforceability clause or statement of common ownership*

In making the above disclaimer, the applicant does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term of the **prior patent**, "as the term of said **prior patent** is presently shortened by any terminal disclaimer," in the event that said **prior patent** later:

expires for failure to pay a maintenance fee;
is held unenforceable;
is found invalid by a court of competent jurisdiction;
is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321;
has all claims canceled by a reexamination certificate;
is reissued; or
is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

*optional protection clause or exculpatory statement in event the earlier related patent is lapsed, etc.*

Check either box 1 or 2 below, if appropriate.

1. ☐ The undersigned is the applicant. If the applicant is an assignee, the undersigned is authorized to act on behalf of the assignee.

I hereby acknowledge that any willful false statements made are punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.

# Form PTO/AIA/26- Terminal disclaimer to obviate a double patenting rejection over a "prior" patent (cont.)

Check either box 1 or 2 below, if appropriate.

1. ☐ The undersigned is the applicant. If the applicant is an assignee, the undersigned is authorized to act on behalf of the assignee.

I hereby acknowledge that any willful false statements made are punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.

2. ☐ The undersigned is an attorney or agent of record. Reg. No._____

| | |
|---|---|
| Signature | Date |
| Typed or printed name | |
| Title | Telephone Number |

☐ Terminal disclaimer fee under 37 CFR 1.20(d) included.

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO

# Exculpatory language in forms PTO/SB/26 and PTO/AIA/26

In making the above disclaimer, the owner (PTO/SB/26) or applicant (PTO/AIA/26) does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term of the prior patent, "as the term of said prior patent is presently shortened by any terminal disclaimer," in the event that said prior patent later: expires for failure to pay a maintenance fee; is held unenforceable; is found invalid by a court of competent jurisdiction; is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321; has all claims canceled by a reexamination certificate; is reissued; or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

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# Form PTO/SB/25a- Terminal disclaimer in a patent or proceeding in view of an application

PTO/SB/25a (02-14)
Approved for use through 7/31/2016. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

| TERMINAL DISCLAIMER IN A PATENT OR PROCEEDING IN VIEW OF AN APPLICATION | Docket Number (Optional) |
|---|---|

Application/Control Number:
Filing Date:
First Named Inventor:
Title:
Patent No.:

*disclaiming statement*

*patentee*

*extent of ownership*

The patentee, _____, owner of _____ percent interest in the instant patent hereby disclaims, except as provided below, the terminal part of the statutory term of the instant patent which would extend beyond the expiration date of the full statutory term of any patent granted on pending **reference** application No. _____, filed _____, as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application. The patentee hereby agrees that the instant patent shall be enforceable only for and during such period that the instant patent and any patent granted on the **reference** application are commonly owned. This agreement runs with the instant patent and is binding upon the grantee, its successors or assigns.

*enforceability clause or statement of common ownership*

*optional protection clause or exculpatory statement in event the earlier related patent is lapsed, etc.*

In making the above disclaimer, the patentee does not disclaim the terminal part of the instant patent that would extend to the expiration date of the full statutory term of any patent granted on said **reference** application, "as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application," in the event that any such patent granted on the pending **reference** application: expires for failure to pay a maintenance fee; is held unenforceable; is found invalid by a court of competent jurisdiction; is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321; has all claims canceled by a reexamination certificate; is reissued; or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

I. Check either box 1, 2, or 3 below, as appropriate, if there is an assignment:

1. ☐ The current ownership was established by the filing of a statement under 37 CFR 3.73 during prosecution of the application that issued as the instant patent.

2. ☐ The instant patent was issued from an application filed on or after September 16, 2012, and the current patent owner was the applicant under 37 CFR 1.46.

3. ☐ A statement under 37 CFR 3.73 is attached herewith. Form PTO/SB/96 or PTO/AIA/96, as appropriate, may be used.

II. Authorization for Terminal Disclaimer - Check either box 1 or 2 below, if appropriate:

# Form PTO/SB/25a- Terminal disclaimer in a patent or proceeding in view of an application (cont.)

II. Authorization for Terminal Disclaimer - Check either box 1 or 2 below, if appropriate:

I hereby acknowledge that any willful false statements made are punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.

1. ☐ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

2. ☐ The undersigned is an attorney or agent of record. Reg. No. _____

| _____ | _____ |
|---|---|
| Signature | Date |
| _____ | _____ |
| Typed or printed name | Telephone number |

☐ The terminal disclaimer fee under 37 CFR 1.20(d) is included.

NOTE: Submit multiple forms if more than one signature is required, see below.*

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

☐ *Total of _____ forms are submitted.

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public, which is to file (and by the USPTO

*Note- If the patent has not been assigned, box 1 or 2 does not have to be checked if signed by the inventor.*

# Form PTO/SB/26a- Terminal disclaimer in a patent or proceeding in view of another patent

PTO/SB/26a (02-14)
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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
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| TERMINAL DISCLAIMER IN A PATENT OR PROCEEDING IN VIEW OF ANOTHER PATENT | Docket Number (Optional) |
|---|---|

Application/Control Number:
Filing Date:
First Named Inventor:
Title:
Patent No.:

*disclaiming statement*

*patentee*

*extent of ownership*

The patentee, _____, owner of _____ percent interest in the instant patent hereby disclaims, except as provided below, the terminal part of the statutory term of the instant patent which would extend beyond the expiration date of the full statutory term of patent No. _____ (the "**reference** patent"), as the term of said **reference** patent is presently shortened by any terminal disclaimer. The patentee hereby agrees that the instant patent shall be enforceable only for and during such period that the instant patent and the **reference** patent are commonly owned. This agreement runs with the instant patent and is binding upon the grantee, its successors or assigns.

*enforceability clause or statement of common ownership*

In making the above disclaimer, the patentee does not disclaim the terminal part of the instant patent that would extend to the expiration date of the full statutory term of the **reference** patent, "as the term of said **reference patent** is presently shortened by any terminal disclaimer," in the event that said **reference** patent later: expires for failure to pay a maintenance fee; is held unenforceable; is found invalid by a court of competent jurisdiction; is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321; has all claims canceled by a reexamination certificate; is reissued; or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer.

*optional protection clause or exculpatory statement in event the earlier related patent is lapsed, etc.*

I. Check either box 1, 2, or 3 below, as appropriate, if there is an assignment:

1. ☐ The current ownership was established by the filing of a statement under 37 CFR 3.73 during prosecution of the application that issued as the instant patent.

2. ☐ The instant patent was issued from an application filed on or after September 16, 2012, and the current patent owner was the applicant under 37 CFR 1.46.

3. ☐ A statement under 37 CFR 3.73 is attached herewith. Form PTO/SB/96 or PTO/AIA/96, as appropriate, may be used.

II. Authorization for Terminal Disclaimer - Check either box 1 or 2 below, if appropriate:

# Form PTO/SB/26a- Terminal disclaimer in a patent or proceeding in view of another patent (cont.)

II. Authorization for Terminal Disclaimer - Check either box 1 or 2 below, if appropriate:

I hereby acknowledge that any willful false statements made are punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.

1. ☐ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

2. ☐ The undersigned is an attorney or agent of record. Reg. No. _____

| _____ | _____ |
|---|---|
| Signature | Date |
| _____ | _____ |
| Typed or printed name | Telephone number |

☐ The terminal disclaimer fee under 37 CFR 1.20(d) is included.

NOTE: Submit multiple forms if more than one signature is required, see below.*

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

☐ *Total of _____ forms are submitted.

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public, which is to file (and by the USPTO

*Note- If the patent has not been assigned, box 1 or 2 does not have to be checked if signed by the inventor.*

# Form PTO/AIA/26- Terminal disclaimer based on <u>common ownership</u> to obviate a double patenting rejection over a reference patent

## The highlighted enforcement language would be different for a JRA TD

PTO/AIA/26 (04-14)
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| TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION OVER A "PRIOR" PATENT | Docket Number (Optional) |
|---|---|

In re Application of:

Application No.:

Filed:

For:

*applicant*

*extent of ownership*

*disclaiming statement*

The applicant, _____, owner of _____ percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of **prior patent** No. _____ as the term of said **prior patent** is presently shortened by any terminal disclaimer. The applicant hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the **prior patent** are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

*enforceability provision would be different for a JRA TD*

In making the above disclaimer, the applicant does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term of the **prior patent**, "as the term of said **prior patent** is presently shortened by any terminal disclaimer," in the event that said **prior patent** later:

expires for failure to pay a maintenance fee;
is held unenforceable;
is found invalid by a court of competent jurisdiction;
is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321;
has all claims canceled by a reexamination certificate;
is reissued; or
is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

*Optional protection clause or exculpatory statement in the event the reference patent is lapsed, etc.*

Check either box 1 or 2 below, if appropriate.

1. ☐ The undersigned is the applicant. If the applicant is an assignee, the undersigned is authorized to act on behalf of the assignee.

I hereby acknowledge that any willful false statements made are punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.

# Modification of USPTO TD forms

- Any modification of USPTO forms must comply with 37 CFR 1.4(d)(5), which states, in part:
  - The existing text of a form, other than a certification statement, may be modified, deleted, or added to, if all text identifying the form as an Office form is removed. The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any Office form with text identifying the form as an Office form by a party, whether a practitioner or non-practitioner, constitutes a certification under § 11.18(b) of this chapter that the existing text and any certification statements on the form have not been altered other than permitted by EFS-Web customization
- As an example, removing the common ownership enforcement language from a USPTO TD form and substituting it with the JRA TD enforcement language without removing the form number and OMB information is improper.

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# Example of an improperly modified USPTO form

Terminal Disclaimer Filed - 08/14/2018 1 pa

Application Number: xxxxxxxxxx Examiner: xxxxxxxxxx

Modified PTO/SB/25 (08-11)
Approved for use through 07/31/2012. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
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| TERMINAL DISCLAIMER TO OBVIATE A PROVISIONAL DOUBLE PATENTING REJECTION OVER A PENDING "REFERENCE" APPLICATION | Docket Number (Optional) xxxxxxxxxx |
|---|---|

In re Application of: xxxxxxxxxx

Application No. xxxxxxxxxx

Filed xxxxxxxxxx

For xxxxxxxxxx

The owners, xxxxxxxxxx Pharmaceuticals, who together own 100 percent interest in the instant application hereby disclaim, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending **reference** Application Number xxxxx filed on xxxxx, or pending **reference** Application Number xxxxx, filed on xxxxx, as the term of any patent(s) granted on said **reference** applications may be shortened by any terminal disclaimer(s) filed prior to the grant of any patent on the pending **reference** applications. The owners of the instant application waive the right to separately enforce any patents granted on the **reference** applications and any patent granted on the instant application. The owners of the instant application hereby agree that any patent granted on the instant application shall be enforceable only for and during such period that any patents granted on the **reference** applications and any patent granted on the instant application are not separately enforced. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

***Office form numbers are not removed***

***enforceability provision for a JRA TD not on PTO/SB/25***

# Unusual circumstances involving TDs

# Unusual circumstances – Statements regarding commonality of ownership

- Improper statements regarding commonality of ownership:
  - Where the statement is not proper, the objection is:
    - 37 CFR 1.321(c)(3) requires that a TD "Include a provision that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the judicially created double patenting" (Emphasis added), and such statement or equivalent has not been provided.
- See next slide for examples.

# Unusual circumstances – Statements regarding commonality of ownership (cont.)

- Examples of statements regarding commonality of ownership:
- 1. The **legal title** to any patent granted on the A Application is the same as that of the B Patent.

  **Not proper** - **Rationale:** The words "legal title" do not include common ownership as to equitable title.
- 2. Any patent issuing from the A Application is **co-owned** with the B Patent.

  **Not proper** - **Rationale:** "co-owned" can include a third (+) owner.
- 3. Any patent granted on the A Application is **commonly assigned** with the B Patent.

  **Proper** – **Rationale:** "assigned" is equivalent to "owned."
- 4. Any patent granted on the A Application shall be commonly owned **with** that of the B Patent.

  **Proper** – **Rationale:** "shall be" is equivalent to "is."

# Unusual circumstances - No conditional statutory disclaimers and terminal disclaimers

- The statute does not provide for conditional terminal disclaimers or statutory disclaimers.
- Thus, a proffered **disclaimer made contingent on certain conditions** such as the allowance of specific claims or the granting of a petition, **is improper** and cannot be accepted. MPEP 1490, Part VI.A.

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# Unusual circumstances – Terminal disclaimer is no longer necessary

- MPEP 1490, Part VIII.A. - If terminal disclaimer is no longer necessary - (e.g., the claims rejected as being non-statutory double patenting are cancelled or the application over which the claims were provisionally rejected is abandoned), applicant can nullify the effect of a terminal disclaimer by filing:
  - a petition under 37 CFR 1.182 requesting withdrawal of the recorded terminal disclaimer, or
  - a continuing application (but not a utility RCE or a design CPA), coupled with abandoning the application in which the terminal disclaimer has been filed, if the terminal disclaimer does not contain language to the contrary.

# Statements in TDs regarding statutory patent term

# Statements in terminal disclaimers as to statutory patent term

- Language like --"…full statutory term defined in 35 U.S.C. 154 -156 and 173 of U.S. Patent…"-- or -- "…full statutory term, including any extensions of the original term, including those defined in 35 U.S.C. §154 to §156 and §173…" -- is not proper in a TD.
- The full statutory term does not include extensions of the term. Boehringer v Barr, 592 F.3d 1340, 93 U.S.P.Q.2d 1417 – ["As the statute makes clear, however, the rights of a patentee during a term extension are limited in ways that do not normally apply to granted patents:…"]
- The remedy to the situation is to replace "full statutory term defined in 35 U.S.C. 154 -156 and 173" with "full statutory term" (i.e., delete the language after "full statutory term").
  - This is proper because "the full statutory term" inherently is a term defined by the patent statute.
  - This remedy is illustrated in revised TD forms PTO/SB/25 and PTO/SB/26 that were reproduced in earlier slides, which no longer contain the phrase term "<u>as defined in 35 U.S.C. 154 and 173</u>" to modify "full statutory term."

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# Statements in terminal disclaimers as to statutory patent term (cont.)

- Above we discussed optional exculpatory language in the TD forms - "In making the above disclaimer, the owner does not disclaim...," which is permissible in a TD.
- The TD may add (i.e., include):

  "The application owner also does not disclaim any extension of patent term under 35 U.S.C. 156 which is granted on the instant application."

  – *Merck v. Hi-Tech Pharmacal Co.*, 482 F.3d 1317 (Fed. Cir. 2007) - A patent term extension under 35 U.S.C. 156 may be applied to a patent subject to a terminal disclaimer.
- The TD must not add (i.e., include):

  "The application owner also does not disclaim any [extension] [adjustment] of patent term under 35 U.S.C. 154 which is granted on the instant application."

  – See 35 U.S.C. 154(b)(2)(B)(May 29, 2000).

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# General Terminal Disclaimer Processing

## General terminal disclaimer processing for an application or in a patent undergoing reexamination proceeding

- The paralegal will:
  - Determine compliance with 35 U.S.C. 253 and 37 CFR 1.321 and 3.73 (if applicable), and ensure that the appropriate terminal disclaimer fee set forth in 37 CFR 1.20(d) is/was applied (note – use terminal disclaimer informal checklist to ensure requirements are met);
  - Notify the examiner having charge of the application whether the terminal disclaimer is acceptable or not by completing a Terminal Disclaimer review decision form (DISQ form);
  - Indicate the nature of the informalities on the form if the terminal disclaimer is not acceptable, so that the examiner can inform applicant in the next Office action; and
  - Enter in PALM that the terminal disclaimer is accepted or not accepted.

# Exercises to determine whether a TD filed is proper or improper

# Exercise 1 – preemptive filing of TD

- This example applies to all applications, regardless of the filing date.
- A terminal disclaimer is filed in a continuation case. The terminal disclaimer does not have an application number listed on it and instead lists "TBD". The processing branch of the application crosses out "TBD" and fills out the application number and has the TD rescanned into the file. All other requirements of the TD are fulfilled (e.g., fee paid under Rule 20(d), disclaiming statement, common ownership enforcement, etc.). There is also no double patenting rejection in the record.

- Is the TD proper?

# Exercise 1 – preemptive filing of TD (cont.)

**Answer:**

- Yes, the originally filed TD (not having an application number listed on it and instead listing "TBD") is proper.
- There is no requirement that an attorney wait for the examiner to make a nonstatutory double patenting (NSDP) rejection (also known as an obviousness-type double patenting (ODP) rejection) before filing a TD with the Office. Here, the applicant is preemptively filing a TD with the application in anticipation of an NSPD rejection.
- However, the processing branch should not have crossed out "TBD," inserted the application number and had the modified TD scanned. USPTO personnel should not annotate the TD by writing in the application number. It is understood that the TD is part of the original application papers. Since the TD is a legal document, it is not to be changed in any manner, other than the initials and date of the original signer of the TD.

# Exercise 2 – When no fee is required for a second TD

- This example applies to applications filed **before** September 16, 2012.
- Applicant filed a terminal disclaimer on August 10, 2008, in which ABC Wireless, LLC is named as the assignee, and the TD is signed by an attorney of record. Applicant filed a Supplemental Terminal Disclaimer on September 10, 2008 to correct a clerical error stating that the assignee listed in the previous terminal disclaimer was inadvertently incorrect, because, via documents filed with the Office on June 10, 2008, the assignee name had been changed to XYZ LLC.

- Is a fee required for this replacement terminal disclaimer?

# Exercise 2 – When no fee is required for a second TD (cont.)

**Answer**:

- No, a fee is not required. There is no fee for the second replacement terminal disclaimer since a fee has already been charged for the first terminal disclaimer, and the second terminal disclaimer was filed to deal with the **same** nonstatutory double patenting (NSDP) (also called obviousness-type double patenting or ODP) reference as was the first terminal disclaimer.

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# Exercise 3: Statement of ownership in a TD

- Example drawn to statement of ownership in a TD (applies to all applications).
  A. The owner of the **entire right(s)** in the instant application.
  B. The owner of the **entirety** of the instant application.
  C. The owner of **all of the rights** in the instant application.
  D. The owner of **all of the instant application**.
  E. The **owner** of the instant application.
  F. The **sole owner** of the instant application.

- In each case, is the ownership statement of the terminal disclaimer proper?

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# Exercise 3: Statement of ownership in a TD (cont.)

**Answers**:

A. The owner of the entire right(s) in the instant application. = approve - same as 100% interest.

B. The owner of the entirety of the instant application. = approve - same as 100% interest – "rights" are understood here.

C. The owner of all of the rights in the instant application. = approve - same as 100% interest – "all of the rights" or "all rights" provides the same result as "entire."

D. The owner of all of the instant application = disapprove = not the same as 100% interest. Could be one of the assignees of an undivided portion of the application (a complete assignment from one of the joint inventors). Exception - Approve if there is only one inventor.

E. The owner of the instant application. = disapprove = See explanation for "D."

F. The sole owner of the instant application. = approve - same as 100% interest – "sole" provides the same result as "entire."

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# Exercise 4: New POA filed after filing of TD

- This example applies to all applications, regardless of the filing date.

- At the time the TD was filed, the person signing, Attorney Smith, was appointed as attorney of record by a first Power of Attorney. A second Power of Attorney is later filed revoking the first and appointing a different attorney. The TD is reviewed after the filing of the second Power. Thus, Attorney Smith is no longer the attorney of record.

- Is the terminal disclaimer signed by a proper party?

# Exercise 4: New POA filed after filing of TD (cont.)

**<u>Answer</u>**:

- Yes, the terminal disclaimer was signed by a proper party. Where, at the time the TD was filed, the person signing was the appointed attorney, that person was the attorney of record. Thus, the TD document was proper and stays proper. It does not matter when the TD was reviewed, or that a new attorney is later appointed.

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# Exercise 5: Entire ownership interests must be 100%

- Example directed to statement of ownership percentages.
- If the application is filed on after September 16, 2012, all of the assignees also must be the applicants of record in order to file the terminal disclaimer.
- A terminal disclaimer (TD) is filed to overcome an NSDP rejection over a patent reference.
- Company A is the assignee of record for 30% of the application under examination, and Company B is the assignee of record for 70% of the application.
- The TD states that Company A and Company B own 100% of the application.

- Can we approve the TD, if it is otherwise proper?

# Exercise 5: Entire ownership interests must be 100% (cont.)

**Answer:**

- Yes, we can approve the TD, since Company A and Company B together own 100% of the application. The individual percentages need not be identified.
- Likewise, if a TD states that Company A and Company B own 60% of the application, and Company C own 40% of the application, we can approve the TD, since Companies A, B, and C together own 100% of the application.

- Who signs?
  - In either situation, an attorney or agent of record may sign the TD.
  - But, if the TD is to be signed by an Officer of the owner company (assignee of record (for applications filed before September 16, 2012) or assignee-applicant (for applications filed on or after September 16, 2012)), then officers of all the companies (A and B in the first case, A,B, and C in the second case) must sign, or separate TDs must be signed by officers of all the companies and submitted concurrently.

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# Exercise 6: Only the applicant can file a TD in applications filed on/after 9/16/2012

- The inventors are the named applicant in the application (e.g., either no ADS was filed with the case or the Applicant Information section of the ADS was blank, and the filing receipt lists the inventors as the applicant.) A terminal disclaimer (TD) is filed to overcome an NSDP rejection over a patent reference.

- Company A is listed on TD Form PTO/AIA/26 as the applicant owning 100% of the application. The form is signed by an attorney of record.

- Can we approve the TD, if it is otherwise proper?

# Exercise 6: Only the applicant can file a TD in applications filed on/after 9/16/2012(cont.)

**Answer:**

- No, the TD cannot be approved. For an application filed on/after 9/16/12, the named applicant must make the disclaimer. If Company A is not listed as the applicant, then Company A must become the applicant in the application in order to file the terminal disclaimer.
- **Company A can become the applicant by** filing a request to change the applicant under 37 CFR 1.46(c), which requires a request, a corrected ADS (with markings to show changes), and a statement under 37 CFR 3.73(c) showing chain of title to the new applicant (form PTO/AIA/96 can be used).

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## Exercise 7: Assignee-applicant on filing can file a TD in application filed on/after 9/16/2012 without 3.73(c) statement

- Example applies to applications filed on/after 9/16/12
- Company A is the named applicant in the application (Company A is identified in the Applicant Information section of the ADS, and Company A is listed on the filing receipt as the applicant). A terminal disclaimer (TD) is filed to overcome an ODP rejection over a patent reference.
- Company A is listed on TD Form PTO/AIA/26 as the applicant owning 100% of the application. The form is signed by an attorney of record. No statement under 37 CFR 3.73(c) is in the file or accompanied the terminal disclaimer.

- Can we approve the TD, if it is otherwise proper?

## Exercise 7: Assignee-applicant on filing can file a TD in application filed on/after 9/16/2012 without 3.73(c) statement (cont.)

**Answer:**

- Yes, we can approve the TD. For an application filed on/after 9/16/12, assignees and obligated assignees can make the application for patent as the applicant. If the assignee (or obligated assignee) is named as the applicant in the ADS, then they can take action as the applicant (e.g., give power of attorney, sign a terminal disclaimer) without resort to practice under 37 CFR 3.71 and 3.73. 37 CFR 1.46(b) says they should record the documentary evidence no later than payment of the issue fee.
- If a different entity wants to become the applicant, they must comply with 37 CFR 3.71, 3.73 and 1.46(c) in order to do so.

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# Exercises to determine the type of TD filed

# Exercise 8

- The applicant, I-Invented Co., owner of 100 percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of reference patent No. U.S. 7,695,XXX, as the term of said reference patent is presently shortened by any terminal disclaimer. The applicant of the instant application waives the right to separately enforce the reference patent and any patent granted on the instant application. The applicant of the instant application hereby agrees that the reference patent and any patent granted on the instant application shall be enforceable only for and during such period that the reference patent and any patent granted on the instant application are not separately enforced. The waiver, and this agreement, run with any patent granted on the instant application and are binding upon the applicant of the instant application, its successors, or assigns.

- Question 1: What type of TD has been filed?
- Question 2: Is the TD language proper?

# Answers for exercise 8

- Question 1: What type of TD has been filed?
- Answer: A JRA TD.

- Question 2: Is the TD language proper?
- Answer: Yes.

# Exercise 9

- The applicant, I-Invented Co., owner of 100 percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application that would extend beyond the expiration date of the full statutory term of reference patent No. U.S. 7,695,XXX, as the term of said reference patent is presently shortened by any terminal disclaimer. The applicant hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the reference patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

- Question 1: What type of TD has been filed?
- Question 2: Is the TD language proper?

# Answers for exercise 9

- Question 1: What type of TD has been filed?
- Answer: A TD based on common ownership.

- Question 2: Is the TD language proper?
- Answer: Yes.

# Exercise 10

- The applicant, I-Invented Co., owner of 100 percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of reference patent No. U.S. 7,695,XXX, as the term of said reference patent is presently shortened by any terminal disclaimer. The applicant hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the reference patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.
- The applicant, I-Invented Co., owner of 100 percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of reference patent No. U.S. 7,392,YYY, as the term of said reference patent is presently shortened by any terminal disclaimer. The applicant of the instant application waives the right to separately enforce the reference patent U.S. 7,392,YYY and any patent granted on the instant application. The applicant of the instant application hereby agrees that the reference patent U.S. 7,392,YYY and any patent granted on the instant application shall be enforceable only for and during such period that the reference patent U.S. 7,392,YYY and any patent granted on the instant application are not separately enforced. The waiver, and this agreement, run with any patent granted on the instant application and are binding upon the applicant of the instant application, its successors, or assigns.

- Question: Assuming that the signature requirements have been met, that the instant application was filed on July 1, 2017, that the JRA requirements have been met for the U.S. 7,392,YYY reference, is this terminal disclaimer proper?

# Answer for exercise 10

- **<u>Question</u>**: Assuming that the signature requirements have been met, that the instant application was filed on July 1, 2017, that the JRA requirements have been met for the U.S. 7,695,YYY reference, is this terminal disclaimer proper?

- **<u>Answer</u>**: No. The combination of two types of TDs is not permitted. See MPEP 804.02.

# Exercise 11

- Applicant files the following terminal disclaimer:

**Terminal Disclaimer Under 37 CFR 1.321(b)**

The applicant, I-Invented Co., owner of 100 percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of reference patent No. U.S. 7,695,XXX. The applicant of the instant application waives the right to separately enforce the reference patent and any patent granted on the instant application. The applicant of the instant application hereby agrees that the reference patent and any patent granted on the instant application shall be enforceable only for and during such period that the reference patent and any patent granted on the instant application are not separately enforced. The waiver, and this agreement, run with any patent granted on the instant application and are binding upon the applicant of the instant application, its successors, or assigns.

- Question 1: What type of TD has been filed?
- Question 2: Is the TD language proper?

# Answers for exercise 11

- Question 1: What type of TD has been filed?
- Answer: This TD is treated as a TD based on a joint research agreement. The TD is mislabeled because 37 CFR 1.321(b) does not contain a waiver of the right to separately enforce and an agreement not to separately enforce provisions.

- Question 2: Is the TD language proper?
- Answer: Yes.

# Exercise 12

- The applicant, I-Invented Co., owner of 100 percent interest in the instant application hereby waives the right to separately enforce any patent granted on the instant application and U.S. Patent No. 7,765,XXX. The applicant of the instant application hereby agrees that any patent granted on the instant application and U.S. Patent Number 7,765,XXX shall be enforceable only for and during such period that the instant application and U.S. Patent No. 7,765,XXX are not separately enforced. The waiver, and this agreement, run with any patent granted on the instant application and are binding upon the applicant of the instant application, its successors, or assigns.

- Question 1: What type of TD has been filed?
- Question 2: Is the TD language proper?

# Answers for exercise 12

- Question 1:  What type of TD has been filed?
- Answer:  A JRA TD.

- Question 2: Is the TD language proper?
- Answer:  No, the disclaiming statement is missing from the JRA TD.