

Terminal Disclaimer Requirements and Processing



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Objectives

- To understand:
 - AIA rules effective on 9/16/2012 affecting terminal disclaimer (TD) practice
 - the requirements for filing a TD governed by patent statute and patent regulation (rule)
 - the requirements to establish an assignment and a power of attorney
 - who can sign a TD and the types of signature permitted
- To review:
 - when terminal disclaimers (TDs) can be filed
 - the specific parts of two types of TDs (common ownership vs. joint research agreement)
 - examples of proper TDs and improper TDs
 - general terminal disclaimer processing



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When can a terminal disclaimer be filed?

- A terminal disclaimer in an application or a reexamination proceeding is generally filed for the purpose of:
 - Overcoming a non-statutory double patenting (DP) rejection based on a U.S. patent or application that is commonly owned. See MPEP § § 804.02, 717.02(c), and 2154.02(c).
 - Overcoming a non-statutory DP rejection based on a 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(c), and 2154.02(c).
 - Protecting any patent to be issued - from a non-statutory DP rejection, even though no such rejection is made at the time.



When can a terminal disclaimer be filed? (cont'd)

- To be clear - There is no requirement for a non-statutory double patenting rejection to be 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 reexamination.
 - For example, the applicant may file a copy of a terminal disclaimer (TD) from a parent case in a continuing application if the terms of the TD extend to continuing applications. See MPEP § 1490, under heading "B. Effect of Disclaimers in Continuing Applications and in Reissues."



For apps filed before 9/16/12

Statutory basis for terminal disclaimers

The statute - 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.



For apps filed on/after 9/16/12

Statutory basis for terminal disclaimers

The statute - 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.



Statutory basis for terminal disclaimers (cont'd)

- The AIA does not substantively change 35 U.S.C. 253, the patent statute governing TDs.
- The patent statute, 35 U.S.C. 253 (and 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.



Regulation (Rule) Changes Affecting TD Practice (pre-AIA vs. AIA rules)



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:

- 1) Filing Receipt;
- 2) the Bib Data sheet; or
- 3) PALM



Determining the Filing Date of an Application Under 35 U.S.C. 111(a)

- The filing date of an application filed under 35 U.S.C. 111(a) is the date on which the applicant filed the application in compliance with 37 CFR 1.53(b).
 - For example, if the applicant submitted a specification, including at least one claim, and drawings (if necessary) to the Office on 6/25/02, the filing date of the application would be 6/25/02.



Nonprovisional Application Filed 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: [yyyyyy/zzzzzzzzzz](#)

Issue Date: 06/03/2014

Date of Abandonment: 00/00/0000

Attorney Docket Number: 123456789

Status: 150 /PATENTED CASE

Confirmation Number: 5278

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

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

Oral Hearing: NO

Bar Code

PALM Location

Location Date

Charge to Loc

Charge to Name

Empl

Appln
Info

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[Petition Info](#)

[Atty/Agent Info](#)

[Continuity Data](#)

[Foreign Data](#)

[Inventors](#)

[Applicants](#)

[Ac](#)

*The
filing
date*



The Filing Date of a Nonprovisional Application Under 35 U.S.C. 111(a)

A screenshot of a Filing Receipt in IFW(eDAN):

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

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

CONFIRMATION NO. 5278

FILING RECEIPT



0000000041706445

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).



The National Stage of an International Application Under 35 U.S.C. 371

Application Number Information

Application Number: 09/XXX,XXX [Order This File](#) [Assignments](#) Examiner Number: xxxxxx
Filing or 371(c) Date: 01/14/2000 [eDn](#) Group Art Unit: 1751
Effective Date: 01/14/2000 Class/Subclass: 510/446.00
Application Received: 01/14/2000 Lost Case: NO
Patent Number: xxxxxxx Interference Number:
Issue Date: 03/12/2002 Unmatched Petition: NO
Date of Abandonment: 00/00/0000 [L&R Code](#): Secrecy Code
Attorney Docket Number: 6757 Third Level Review: NO
Status: 150 /PATENTED CASE Oral Hearing: NO
Confirmation Number: 5671
Title of Invention: **PROCESS FOR MAKING A LOW DENSITY DETERGENT COMPOUND**

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 National Stage of an International Application Under 35 U.S.C. 371

Continuity/Reexam Information for 09/xxxxxxx

Parent Data

09xxxxxxx 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*

UNITED STATES PATENT AND TRADEMARK OFFICE

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

BIB DATA SHEET

CONFIRMATION NO. 5671

SERIAL NUMBER 09/xxx,xxx	FILING or 371(c) DATE 01/14/2000 RULE	CLASS 510	GROUP ART UNIT 1751	ATTORNEY DOCKET NO. 6757
APPLICANTS 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 <input type="checkbox"/> Yes <input type="checkbox"/> No	35 USC 119(a-d) conditions met <input type="checkbox"/> Yes <input type="checkbox"/> No	<input type="checkbox"/> Met after Allowance	STATE OR COUNTRY OH	SHEETS DRAWINGS
Verified and Acknowledged	Examiner's Signature	Initials	TOTAL CLAIMS 5	INDEPENDENT CLAIMS 1
ADDRESS				



A 111(a) Continuation (CON) of a 371 National Stage Application

Application Number Information

Application Number: 14/xxx,xxx [Assignments](#) AIA (Fi
Filing or 371(c) Date: **12/06/2013** [eDan](#) Examin
Effective Date: **12/06/2013** [MICH](#)
Application Received: **12/06/2013** Group /
Pat. Num./Pub. Num: [ZZZZZZZ](#) Class/S
Issue Date: **00/00/0000** Interfer
Date of Abandonment: **00/00/0000** Unmatc
Attorney Docket Number: **40 xxx-xxxxx** [L&R C](#)
Status: **30 /DOCKETED NEW CASE - READY FOR EXAM** Third L
Confirmation Number: **9858** Oral He
Title of Invention: **USE OF DEXTRAN SULFATE**

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

Bar Code	PALM Location	Location Date	Charge to
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**Appln
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A 111(a) Continuation (CON) of a 371 National Application (cont'd)

Continuity/Reexam Information for 14/xxxxxxx

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

BIB DATA SHEET

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Alexandria, Virginia 22313-1450
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CONFIRMATION NO. 9858

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

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*



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** [Dan](#) Exam:
Effective Date: **10/03/2013** Group
Application Received: **10/03/2013** Class/
Pat. Num./Pub. Num: [/XXXXXXXXXXXX](#) 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 EXAM** Oral E
Con
Title of Invention: **WOUND CARE ARTICLE WITH AN EN**
MANNER

Bar Code	PALM Location	Location Date	Charge t
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Appln Info	Contents	Petition Info	Atty/Agent Info	Continuity Data
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The filing date of the 111(a) CON of a PCT (aka a bypass application)



A 111(a) Continuation (CON) of a PCT Application (cont'd)

Continuity/Reexam Information for 14/xxxxxxx

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 14/XXX,XXX	FILING or 371(c) DATE 10/03/2013 RULE	CLASS 604	GROUP ART UNIT 3778	ATTORNEY DOCKET NO. 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)



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 <u>35 U.S.C. 371</u>)	National Application (filed under <u>35 U.S.C. 111(a)</u>) involving a PCT application
Filing Date	International filing date of PCT application – Shown in the Continuity Data in PALM for the 371 application	Deposit date in USPTO of specification, claim and any necessary drawing – 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 of PALM EXPO.*



*For apps filed on/after
9/16/12*

The Applicant

- Inventors are no longer the only possible applicants (35 U.S.C. 118, §§ 1.42(a)-(c)):
 - “Applicant” is no longer synonymous with the person who must execute the oath or declaration.
- The regulations pertaining to being applicant have been separated from the regulations pertaining to execution of the inventor’s oath or declaration.



*For apps filed on/after
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The Applicant (cont.)

- Applicant regulations:
 - § 1.41 inventorship;
 - § 1.42 applicant for patent;
 - § 1.43 legal representative;
 - § 1.45 joint inventors; and
 - § 1.46 applicants other than an inventor.
- Execution of oath or declaration regulations:
 - § 1.63 an inventor's oath or declaration or an assignment serving as such; and
 - § 1.64 substitute statement.



*For apps filed on/after
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The Applicant (cont.)

- Applicants may be persons (§§ 1.42(b), 1.46):
 - To whom the inventor has assigned;
 - To whom the inventor is under an obligation to assign; and
 - Who otherwise show sufficient proprietary interest in the matter.
- A party who has less than the entire right, title, and interest may not on their own make the application for patent.



The Applicant: Assignee, Obligated Assignee

*For apps filed on/after
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- For an assignee or obligated assignee (§ 1.46(b)(1)):
 - Documentary evidence of ownership should be recorded no later than the date the issue fee is paid, for example:
 - An assignment for an assignee, or
 - An employment agreement for an obligated assignee.



The Applicant: Sufficient Proprietary Interest

*For apps filed on/after
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- For a person who otherwise shows sufficient proprietary interest in the matter, the applicant must submit a petition including:
 - The fee set forth in § 1.17(g) (\$200);
 - A showing that such person has sufficient proprietary interest; and
 - A statement that making the application is appropriate to preserve the rights of the parties. (§ 1.46(b)(2)).

Note: Such persons are no longer restricted to situations where all the inventors refused to execute or could not be found or reached after diligent effort.



*For apps filed on/after
9/16/12*

The Applicant: Application Data Sheet (PTO/AIA/14 or equivalent)

- If an application under 35 U.S.C. 111 is made by an assignee, an obligated assignee, or a person who otherwise shows sufficient proprietary interest in the matter:
 - The application must contain an application data sheet specifying in the applicant information section:
 - The assignee;
 - Person to whom the inventor is under an obligation to assign the invention; or
 - Person who otherwise shows sufficient proprietary interest in the matter.



*For apps filed on/after
9/16/12*

The Applicant: Inventor's Name

- The Office will continue to use the inventor's name for application and patent identification purposes as inventor names tend to provide a more distinct identification than assignee names. (§ 1.5(a))



The Applicant: National Stage Applications

*For apps filed on/after
9/16/12*

- The applicant for a national stage application is (§ 1.46(b)):
 - The person identified in the international stage as an applicant for the United States.



The Applicant: International Applications

*For apps filed on/after
9/16/12*

- As in national applications, inventors are no longer the only possible applicants for purposes of the United States in international applications (35 U.S.C. 118)
- Applicant regulations for international applications:
 - § 1.421 applicant for international application;
 - § 1.422 legal representative; and
 - § 1.424 applicants other than an inventor



The Applicant: International Applications (cont.)

*For apps filed on/after
9/16/12*

- For international applications filed on/after September 16, 2012, an applicant for the purposes of the United States may be:
 - Sole or joint inventors
 - Legal representative of deceased or legally incapacitated inventor
 - Assignee
 - Obligated assignee
 - Person who otherwise shows sufficient proprietary interest
 - Proof of proprietary interest will be required in the U.S. national phase



The Applicant: Time of Identification

*For apps filed on/after
9/16/12*

- The applicant need not be identified on filing of the application.
- It is however, advisable to do so:
 - Granting a power of attorney requires that the applicant be identified so that the power can be from the applicant;
 - The Office will not require identification but may presume the identified inventors are the applicant:
 - A change in applicant would require compliance with § 3.71(b) and § 1.46(c).



*For apps filed on/after
9/16/12*

Name of the Inventor

- 35 U.S.C. 115(a) provides that an application under 35 U.S.C. 111(a) or that commences the national stage under 35 U.S.C. 371:
 - Must include or be amended to include the name of the inventor for any invention claimed in the application.



*For apps filed on/after
9/16/12*

Name of the Inventor

- Applicants may name the inventor either by use of:
 - A signed application data sheet (ADS) under § 1.76
 - If filed before or with an inventor's oath or declaration; or
 - An executed inventor's oath or declaration
 - If filed before a signed ADS identifying the inventorship.
- Note: Both the ADS and the inventor's oath or declaration require the legal name (first and last) of the inventor(s), so the names need to match between both documents.



*For apps filed on/after
9/16/12*

Name of the Inventor

- To set the inventorship, the inventor's oath or declaration must both name all of the inventors and be executed by or with respect to each inventor.
- Use form AIA/08 (Declaration for Utility or Design Application) if using the declaration rather than an ADS to name the inventor, and use both AIA/08 and AIA/10 if naming joint inventors.



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 9/16/12), 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 as explained in the previous slides) 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.



Summary of Regulation (Rule) Changes Affecting TD Practice (pre-AIA vs. AIA rules) (cont'd)

- For applications filed on or after 9/16/2012, the term applicant is no longer synonymous with the term inventor as discussed in the previous slides.
 - 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 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 changed. 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.



Regulation (Rule) For Terminal Disclaimers

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



For apps filed before 9/16/12

37 CFR 1.321. (pre-AIA) Statutory disclaimers, including terminal disclaimers [Emphasis Added]

- (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'd)

(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'd)

(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.



For apps filed before 9/16/12

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

- (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 under 35 U.S.C. 103(c) as resulting from 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.



For apps filed on/after 9/16/12

37 CFR 1.321. Statutory disclaimers, including terminal disclaimers [Emphasis Added]

- (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).



For apps filed on/after 9/16/12

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

(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).



For apps filed on/after 9/16/12

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

(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.



For apps filed on/after 9/16/12

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

(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 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.



Fees For Terminal Disclaimers

- The rule (regulation) for the terminal disclaimer fee is 37 CFR 1.20(d).
 - As of 06/02/2014, the current fee amount is \$160 (fee code 1814). There is no longer a small entity discount for this fee, and there is no micro entity discount.
 - Charge one TD fee per TD form (document), even if multiple patents are listed and disclaimed in the form (document). See MPEP § 804.02 (IV).
 - Also, do not charge a second TD fee, where the first was not entered as improper, and the second TD form (document) is filed as a replacement to fix the defects.



Who Can Sign a TD and Types of Signatures Permitted



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

- THE OWNER OR ATTORNEY/AGENT OF RECORD MUST SIGN
- A terminal disclaimer is a statement filed by an owner (in part or 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.

$A + B \rightarrow X$ and $C \rightarrow Y \rightarrow Z$

X and Z own it



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

- 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'd)

- For a terminal disclaimer filed in an application, it must be signed by:
 - (1) the pre-AIA § 1.41(b) applicants, where the application has not been assigned (pre-AIA § 1.41(b) applicants = inventors (or pre-AIA §§ 1.42 & 1.43 representatives other than non-joining ones under pre-AIA §1.47))
 - (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.



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

- For a terminal disclaimer filed in a reexamination proceeding, it must be signed by either:
 - (1) the patent owner (the assignee, the pre-AIA § 1.41(b) applicant(s) if the patent is not assigned, or the assignee and the pre-AIA § 1.41(b) applicant(s) if the patent is assigned-in-part), 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.
 - 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.



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) .



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

- 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'd)

When should a pre-AIA 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 § 3.73(b) submission (or after the submission).
- The action taken by the assignee (e.g., signing the disclaimer), and the pre-AIA § 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.



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

- 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 § 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'd)

- 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'd)

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 § 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.



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

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 patents issued from applications filed on/after 9/16/12)

- 1) The owner of the patent (patentee) can sign a terminal disclaimer, and a person legally empowered by the patent owner can also sign the terminal disclaimer.
- 2) An attorney or agent of record (that is, an attorney or agent given power of attorney) is permitted to sign the disclaimer. See 37 CFR 1.321(a)(1).
 - 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 on/after 9/16/12) (cont'd)

- For a terminal disclaimer filed in an application filed on/after 9/16/12, it must be signed by:
 - (1) the applicant (and if applicant is an assignee, a person legally empowered by the applicant assignee can also sign the terminal disclaimer)
or
 - (2) an attorney or agent of record. See 37 CFR 1.321(b)(1).
- 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.
- **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).



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 handwritten (see § 1.4(d)(2)(i)-(iii)).

- Graphic representation of a handwritten signature or a graphic representation of an S-signature is permitted for correspondence submitted via EFS-Web and is provided for in 37 CFR 1.4(d)(3) (new provision effective on 12/18/2013 for all applications and patents due to Patent Law Treaty).

Note: Samples of acceptable signatures are posted on the Office's web site:

www.uspto.gov/web/offices/pac/dapp/opla/preognotice/sigexamples_alt_text.pdf



Content of Terminal Disclaimers



Content of Terminal Disclaimers-Patent Term

Every terminal disclaimer must disclaim the terminal part of the statutory term of any patent granted on the application being examined (or any patent subject to a reexamination proceeding) which would extend beyond the expiration date of the full statutory term, as shortened by any terminal disclaimer, of the patent (or of any patent granted on the application) to which the disclaimer is directed. See 37 CFR 1.321(a)(2)(for TD filed in patents) and(b)(2) (for TD filed in applications).



Content of Terminal Disclaimers – Common Ownership

- 1) Terminal disclaimer may be filed where there is common ownership of the double patenting reference and the case being examined
 - 37 CFR 1.321(c) specifically provides for filing a terminal disclaimer in an application or a reexamination proceeding for the purpose of overcoming a non-statutory double patenting rejection based on a U.S. patent or application, where there is common ownership.
 - Terminal disclaimer must require common ownership, of the patent resulting from the examined case and of the reference, for the resulting patent to be enforceable.



Content of Terminal Disclaimers – Joint Research Agreement

- 2) Terminal disclaimer may be filed where there is a joint research agreement (JRA) involving the double patenting reference and the case being examined
 - 37 CFR 1.321(d) specifically provides for the filing of a terminal disclaimer in an application or a reexamination proceeding for the purpose of overcoming or precluding a nonstatutory double patenting rejection based on a U.S. patent or application that is not commonly owned but was disqualified as prior art as set forth in either 37 CFR 1.104(c)(4)(ii) or (c)(5)(ii) as the result of activities undertaken within the scope of a joint research agreement
 - Terminal disclaimer must require joint enforcement of the resulting patent and reference for the resulting patent to be enforceable, i.e., patent becomes unenforceable if separately enforced by parties to the JRA.



Requirements for Terminal Disclaimers

Requirements for a terminal disclaimer:

- For a TD filed under 37 CFR 1.321(c) based on common ownership, the owner in the rejected application must:
 - Agree that the patents shall be enforceable only during the period that the patents are commonly owned
 - Agree that such agreement is binding upon the owner, its successors, or assigns of all the parties. 37 CFR 1.321(b).
- For a TD filed under 37 CFR 1.321(d) based on JRA, the owner of the rejected application must:
 - Waive the right to separately enforce the patents. 37 CFR 1.321(d)(3)
 - Agree that the patents shall be enforceable only during the period that the patents are not separately enforced. 37 CFR 1.321(d)(3)
 - Agree that such waiver and agreement are binding upon the owner, its successors, or assigns of all the parties. 37 CFR 1.321(b).



Requirements for Terminal Disclaimers (cont'd)

Requirements for a terminal disclaimer (cont'd):

- The TD under 37 CFR 1.321(c) or (d) must comply with 37 CFR 1.321(b)(2)-(b)(4), which are respectively:
 - specify the portion of the term of the patent being disclaimed;
 - state the present extent of applicant's or assignee's ownership interest in the patent to be granted
 - be accompanied by the fee set forth in § 1.20(d).
- The TD under 37 CFR 1.321(c) or (d) must be signed in accordance with 37 CFR 1.321(b)(1) for TDs filed in applications as previously discussed or in accordance with 37 CFR 1.321(a)(1) for TDs filed in patents as previously discussed. See 37 CFR 1.321(c)(2) and (d)(2)



Requirements for Terminal Disclaimers (cont'd)

- Thus, there are only two differences between the requirements for a TD filed under 37 CFR 1.321(c) based on common ownership and a TD filed under 37 CFR 1.321(d) based on a JRA, which are: (1) the enforcement language in the TD, and (2) the reference in the JRA TD must have been disqualified as prior art based on a JRA.
 - For a TD filed under 37 CFR 1.321(c), the TD must 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. (“the 1.321(c) enforcement language”)
 - For a TD filed under 37 CFR 1.321(d), the TD must 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. (“the 1.321(d) enforcement language”)



Processing of Terminal Disclaimer Under 37 CFR 1.321(d) Based on JRA

The processing of a TD under 37 CFR 1.321(d) based on a JRA (“the 1.321(d) JRA TD”) is identical to the processing of a TD under 37 CFR 1.321(c) based on common ownership (“the 1.321(c) common ownership TD”) except for the following:

- The enforcement language in the 1.321(d) JRA TD is different from the enforcement language in the 1.321(c) common ownership TD
- The 1.321(d) JRA TD should certify that the reference has been disqualified as prior art as set forth in either 37 CFR 1.104(c)(4)(ii) or 37 CFR 1.104(c)(5)(ii), and that the fee as set forth in 37 CFR 1.71(g)(2), if required, accompanied the amendment to the specification under 37 CFR 1.71(g)(1) to disclose the names of the parties to the JRA.



Processing of Terminal Disclaimer Under 37 CFR 1.321(d) Based on JRA (cont'd)

- **Generate the following message on the IFW terminal disclaimer form when applicant/patent owner uses the Office's forms for a JRA TD under 37 CFR 1.321(d) and all TD requirements under 37 CFR 1.321(d) have been satisfied:**
 - **Message:**
The terminal disclaimer under 37 CFR 1.321(d) has been approved.



Processing of Terminal Disclaimer Under 37 CFR 1.321(d) Based on JRA (cont'd)

- **Generate the following message on the IFW terminal disclaimer form when applicant/patent owner DOES NOT use the Office's forms for a JRA TD under 37 CFR 1.321(d) and (1) the JRA TD under 37 CFR 1.321(d) does not certify: (A) that the reference has been disqualified as prior art as set forth in either 37 CFR 1.104(c)(4)(ii) or 37 CFR 1.104(c)(5)(ii), or (B) that the fee as set forth in 37 CFR 1.71(g)(2), if required, accompanied the amendment under 37 CFR 1.71(g)(1); and (2) all other TD requirements under 37 CFR 1.321(d) have been met.**

— **Message:**

The terminal disclaimer under 37 CFR 1.321(d) has been approved, but is only effective to obviate or preclude a double patenting rejection under certain conditions as discussed in the Examiner's Note below.

EXAMINER'S NOTE: In order for the terminal disclaimer under 37 CFR 1.321(d) based on a joint research agreement (JRA) to be effective to obviate or preclude a double patenting rejection, the reference must be disqualified as prior art via 35 U.S.C. 102(c) or pre-AIA 35 U.S.C. 103(c)(2) as set forth, respectively, in 37 CFR 1.104(c)(4)(ii) and 37 CFR 1.104(c)(5)(ii). The fee as set forth in 37 CFR 1.71(g)(2), if required, must accompany the amendment to the specification under 37 CFR 1.71(g)(1) to disclose the names of the parties to the JRA.



General Content in Terminal Disclaimers-Misc.

- The terminal disclaimer must operate with respect to all claims in the patent. Not permitted to disclaim only some claims, e.g., the claim(s) rejected under non-statutory double patenting.
- The terminal disclaimer is effective only to shorten the patent term of the application identified in the disclaimer, unless by its terms it extends to continuing applications.
 - Effective with respect to the application having the application number identified in it.



General Content in Terminal Disclaimers-Misc.

Disclaimer Identifies the Wrong Target Application or Patent

In some instances a terminal disclaimer filed to obviate a nonstatutory double patenting rejection will identify the wrong target application or patent (i.e., an application or patent which is not the basis for the double patenting rejection). In these instances, a replacement terminal disclaimer identifying the correct target application or patent would be required by the examiner. Once a correct replacement terminal disclaimer is received, the next Office action should make it clear that “the second terminal disclaimer replaces the first terminal disclaimer, and the first terminal disclaimer is thus void.” **A second terminal disclaimer fee should not be assessed/charged**, because the first fee is applied to the second terminal disclaimer.



Examples of Acceptable Language in TDs



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 Obviousness-Type 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'd)

II. If an Obviousness-Type Double Patenting Rejection Over A Prior 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 **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 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 Obviousness-Type 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'd)

II. If an Obviousness-Type Double Patenting Rejection Over A Prior 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 **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.

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



Examples of Acceptable Terminal Disclaimer Language Under 37 CFR 1.321(c) Filed in a Patent (Future Form Paragraph in the MPEP)

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 Obviousness-Type 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 instant patent, which would extend beyond the expiration date of the full statutory term of any patent granted on pending Application Number _____, filed on _____, as the term of any patent granted on said application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending 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 above-listed pending application are commonly owned.** This agreement is binding upon the patentee, its successors, or assigns.



Examples of Acceptable Terminal Disclaimer Language Under 37 CFR 1.321(c) Filed in a Patent (Future Form Paragraph in the MPEP) (cont'd)

II. If an Obviousness-Type 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 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/AIA/25a** may be used for situation I, and **Form PTO/AIA/26a** may be used for situation II.



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 Obviousness-Type 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 the instant application and 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'd)

II. If an Obviousness-Type Double Patenting Rejection Over A Prior 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 prior patent No. _____, as the term of said prior patent is presently shortened by any terminal disclaimer.

The owner of the instant application **waives the right to separately enforce** the prior patent and any patent granted on the instant application. The owner of the instant application hereby **agrees that the prior patent and any patent granted on the instant application shall be enforceable only for and during such period that the prior 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 Obviousness-Type 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 the instant application and 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'd)

II. If an Obviousness-Type Double Patenting Rejection Over A Prior 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 prior patent No. _____, as the term of said prior patent is presently shortened by any terminal disclaimer.

The **applicant** of the instant application **waives the right to separately enforce** the prior patent and any patent granted on the instant application. The **applicant** of the instant application hereby **agrees that the prior patent and any patent granted on the instant application shall be enforceable only for and during such period that the prior 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.



Examples of Acceptable Terminal Disclaimer Language Under 37 CFR 1.321(d) Filed in a Patent (Future Form Paragraph in the MPEP)

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 obviousness-type 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 instant patent, which would extend beyond the expiration date of the full statutory term of any patent granted on pending Application Number _____, filed on _____, as the term of any patent granted on said application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending application.

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



Examples of Acceptable Terminal Disclaimer Language Under 37 CFR 1.321(d) Filed in a Patent (Future Form Paragraph in the MPEP)(cont'd)

II. If an obviousness-type double patenting rejection over a Referenced 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 instant patent, which would extend beyond the expiration date of the full statutory term of referenced patent No. _____, as the term of said referenced patent is presently shortened by any terminal disclaimer.

The patentee waives the right to separately enforce the instant patent and the referenced patent. The patentee agrees that the instant patent and the referenced patent shall be enforceable only for and during such period that the instant patent and the referenced patent are not separately enforced. The waiver, and this agreement, 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)

- Terminal disclaimer forms used to either obviate a provisional double patenting rejection in an application under examination over a pending “reference” application or over a “Prior Patent” under 37 CFR 1.321(c) are provided in Forms PTO/SB/25 and PTO/SB/26, respectively, for applications filed before 9/16/12 (and Forms PTO/AIA/25 and PTO/AIA/26, respectively, for applications filed on or after 9/16/12).
- Terminal disclaimer form used in a patent or proceeding in view of an application is provided in Form PTO/SB/25a (new form)
- Terminal disclaimer form used in a patent or proceeding in view of another patent is provided in Form PTO/SB/26a (new form)
- 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.



Form PTO/SB/25- Terminal Disclaimer to Obviate a Provisional Double Patenting Rejection over a Pending "Reference" Application

For apps filed before 9/16/12

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 OBTAIN A PROVISIONAL DOUBLE PATENTING REJECTION OVER A PENDING "REFERENCE" APPLICATION		Docket Number (Optional)
In re Application of: _____		
Application No.: _____		
Filed: _____	owner or assignee	
For: _____	extent of ownership	
<p>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.</p> <p>In making the above disclaimer, the owner 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.</p> <p>Check either box 1 or 2 below, if appropriate.</p> <p>1. <input type="checkbox"/> 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.</p> <p>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.</p>		

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’d)

For apps filed before 9/16/12

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.

<input type="text"/>	<input type="text"/>
Signature	Date
<input type="text"/>	
Typed or printed name	
<input type="text"/>	
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.

This collection of information is required by 37 CFR 1.234. The information is required to obtain certain benefits by the public which is to file (and by the USPTO



Form PTO/AIA/25- Terminal Disclaimer to Obviate a Provisional Double Patenting Rejection over a Pending "Reference" Application

For apps filed on/after 9/16/12

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

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TERMINAL DISCLAIMER TO OBVIATE A PROVISIONAL DOUBLE PATENTING REJECTION OVER A PENDING "REFERENCE" APPLICATION		Docket Number (Optional)
In re Application of: _____		
Application No.: _____		
Filed: _____	Applicant	
For: _____	extent of ownership	
<p>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.</p> <p>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 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.</p>		
Check either box 1 or 2 below, if appropriate.		
1. <input type="checkbox"/> 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. <input type="checkbox"/> The undersigned is an attorney or agent of record. Reg. No. _____		

disclaiming statement

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’d)

For apps filed on/after 9/16/12

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.

<input type="text"/>	<input type="text"/>
Signature	Date
<input type="text"/>	
Typed or printed name	
<input type="text"/>	<input type="text"/>
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.



Form PTO/SB/26- Terminal Disclaimer to Obviate a Double Patenting Rejection Over a “Prior” Patent

For apps filed before 9/16/12

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

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TERMINAL DISCLAIMER TO OBIATE A DOUBLE PATENTING REJECTION OVER A “PRIOR” PATENT		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 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 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 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.		
Check either box 1 or 2 below, if appropriate.		
1. <input type="checkbox"/> 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/26- Terminal Disclaimer to Obviate a Double Patenting Rejection Over a “Prior” Patent (cont’d)

For apps filed before 9/16/12

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

For apps filed on/after 9/16/12

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

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TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION OVER A “PRIOR” PATENT	Docket Number (Optional)
<p>In re Application of: _____</p> <p>Application No.: _____</p> <p>Filed: _____</p> <p>For: _____</p> <p>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.</p> <p>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:</p> <ul style="list-style-type: none">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; oris in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer. <p>Check either box 1 or 2 below, if appropriate.</p> <p>1. <input type="checkbox"/> The undersigned is the applicant. If the applicant is an assignee, the undersigned is authorized to act on behalf of the assignee.</p> <p>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.</p>	

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/26- Terminal Disclaimer to Obviate a Double Patenting Rejection Over a “Prior” Patent (cont’d)

For apps filed on/after 9/16/12

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.



Form PTO/SB/25a- Terminal Disclaimer in a Patent or Proceeding in View of an Application

PTO/SB/25a (02-14)
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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.: _____

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.

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:

*disclaiming
statement*

Patentee

*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/SB/25a- Terminal Disclaimer in a Patent or Proceeding in View of an Application (cont'd)

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)

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.

Docket Number (Optional)

TERMINAL DISCLAIMER IN A PATENT OR PROCEEDING IN VIEW OF ANOTHER PATENT

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.

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.

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:

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

*enforceability
clause
or
statement
of
common
ownership*



Form PTO/SB/26a- Terminal Disclaimer in a Patent or Proceeding in View of Another Patent (cont'd)

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.



Power of Attorney (POA) Requirements and POA Forms



Power of Attorney

37 CFR § 1.32(b)

37 CFR § 1.32(b) sets forth power of attorney (POA) requirements. It must:

- Be in writing,
- Name one or more representatives in compliance with 37 CFR 1.32(c),
- Give the representative power to act on behalf of the principal, and
- For applications filed before 9/16/2012, be signed by the applicant for patent (pre-AIA 37 CFR 1.41(b)) or the assignee of the entire interest of the application.
 - All assignees and all applicants who have not assigned away their rights.
- For applications filed on or after 9/16/2012, be signed by the applicant under 37 CFR 1.42 or the patent owner. A patent owner who was not the applicant under 37 CFR 1.46, must become the applicant and comply with 37 CFR 3.71 and 3.73.
- If less than all sign the POA, it is a valid document, but is not effective as to the others who must join in any terminal disclaimer.



Power of Attorney

37 CFR 1.32(b) (cont'd)

A power of attorney must name as representative(s) (37 CFR 1.32(c)):

- one or more of the joint inventors;
- those registered patent practitioners associated with a Customer Number (37 CFR 1.32(a)(5)); or
- up to ten registered patent attorneys or registered patent agents.



Power of Attorney

37 CFR 1.32(b) (cont'd)

If a power of attorney names more than ten patent practitioners (37 CFR § 1.32(c)):

- Power of attorney must be accompanied by a separate paper stating which ten patent practitioners named in the power of attorney are to be recognized by the Office as being of record in application or patent to which the power of attorney is directed.
- If no separate paper, no power of attorney will be entered.
- For applications filed before 9/16/2012, the separate paper can be signed by one of the patent practitioners named in the power of attorney, by a patent practitioner acting in a representative capacity, the assignee, acting pursuant to pre-AIA 37 CFR 3.73(b), or by all of the inventors (applicants]).
- For applications filed on or after 9/16/2012, the separate paper can be signed by one of the patent practitioners named in the power of attorney, by a patent practitioner acting in a representative capacity, the patent owner, or the applicant.
- The separate paper cannot request that a Customer Number be used instead; only the applicant or assignee can give power of attorney to a Customer Number.



Acting in a Representative Capacity Under 37 CFR 1.34

A registered patent attorney or patent agent not of record but acting in a representative capacity must specify his/her:

- Registration number
- Name
- Signature



Acting in a Representative Capacity Under 37 CFR 1.34 (cont'd)

A person acting in a representative capacity may not sign:

- A power of attorney;
- A document granting access to an application unless
 - For an application filed before 9/16/12, an executed oath or declaration has not been filed, and the practitioner was named in the papers accompanying the application papers, or
 - For an application filed on or after 9/16/12, the practitioner is named in the papers accompanying the application papers, and no power of attorney has been appointed;
- A change in correspondence address except where an executed oath/declaration has not been filed and the practitioner filed the application (37 CFR 1.33(a)(1)), unless the patent has issued (37 CFR 1.33(g));
- A terminal disclaimer; or
- A request for an express abandonment without filing a continuing application.



For apps filed before 9/16/12

Power of Attorney by the Inventor

- Use the PTO/SB/81 form.
- If a power of attorney is signed by less than all the inventors/owners, it must be accompanied by a petition under 37 CFR 1.183, unless the application is proceeding under pre-AIA 37 CFR 1.42, 1.43 or 1.47.
- Different Customer Numbers can be used for power of attorney and correspondence address.
- Power of attorney cannot be given to both attorneys associated with a Customer Number and specific practitioners.
- If the inventor dies, power of attorney terminates.
- The legal representative can give power of attorney.



For apps filed before 9/16/12

Power of Attorney by the Assignee

- *Execute a single PTO/SB/80 form.*
 - *It is general POA, and it will be effective for any/all of assignee's applications in which it is filed.*
- *Use PTO/SB/96 form (Statement under pre-AIA 37 CFR 3.73(b)) to establish assignee ownership and the right of the assignee to take action in a specific application.*
 - *Indicate the reel and frame where the chain of title documents have been recorded in the Office; or Append a copy of title document(s) and check the box that documentary evidence has been, or is currently being, submitted (separately) for recordation to the Assignment Division.*
- *Give specific authority to an appointed practitioner to act on behalf of the assignee.*
 - *Practitioner must be given authority to bind the assignee entity. This can be accomplished in a separate document signed by the assignee (client) that is retained in the practitioner's files. Then, a PTO/SB/96 can be completed and signed by the practitioner for each specific application, rather than having the assignee sign a PTO/SB/96 for each application.*



For apps filed on/after 9/16/12

Powers of Attorney

- Must be signed by the applicant for patent (§ 1.42) or the patent owner.
 - An assignee, obligated assignee, or person who otherwise shows sufficient proprietary interest in the matter applying for the patent may sign the power of attorney (a § 3.73(c) statement is generally not required).
- Inventors who are not the applicant may not sign the power of attorney.
- A combined inventor declaration and power of attorney should not be used.



Powers of Attorney: Prosecution by Assignee

*For apps filed on/after
9/16/12*

- The assignee of the entire right, title and interest, or partial assignees and inventors who have not assigned who together own the entire right title and interest, may conduct prosecution of a (§ 3.71(a)):
 - National patent application as the applicant under § 1.46;
 - Supplemental examination; or
 - Reexamination proceeding.



Powers of Attorney: Prosecution by Assignee

*For apps filed on/after
9/16/12*

- An assignee who is the original applicant need not comply with 37 CFR 3.71 and 3.73 to appoint a power of attorney.
- An assignee who is not the original applicant must comply with § 1.46(c) to become the applicant and establish its ownership pursuant to § 3.73(c):
 - If more than one assignee exists, each assignee either:
 - Establishes its extent of ownership (by percentage), or
 - Submits a statement identifying the parties who together own the entire right, title and interest.



Powers of Attorney: Prosecution by Assignee

*For apps filed on/after
9/16/12*

- The power of attorney by assignee must be signed by either:
 - A person having a title that carries apparent authority (e.g., “President,” or in foreign countries “Manager” or “Director”)
 - A person who makes a statement of authorization to act.
- See MPEP 325, V. Party Who Must Sign.



Powers of Attorney: USPTO Forms

*For apps filed on/after
9/16/12*

- There are three power forms for use in patent applications filed on or after 9/16/12:
 - PTO/AIA/82 (power of attorney by applicant)
 - PTO/AIA/81 (power of attorney to one or more joint inventors)
 - PTO/AIA/80 (power of attorney by assignee that is filed with a 3.73 statement)
- Information about the new powers is available on the USPTO web site at:
http://www.uspto.gov/forms/guid_aia-poa.pdf



Powers of Attorney: AIA/82

For apps filed on/after
9/16/12

- The AIA/82 has three pages, AIA/82A, AIA/82B and AIA/82C.
- AIA/82A is the transmittal that identifies the application to which the power is directed and may be signed by the applicant or a patent practitioner (§ 1.33).

Doc Code: PA..

Document Description: Power of Attorney

PTO/AIA/82A (07-12)

Approved for use through 11/30/2014. OMB 0651-0035
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.

TRANSMITTAL FOR POWER OF ATTORNEY TO ONE OR MORE REGISTERED PRACTITIONERS

NOTE: This form is to be submitted with the Power of Attorney by Applicant form (PTO/AIA/82B or equivalent) to identify the application to which the Power of Attorney is directed, in accordance with 37 CFR 1.5. If the Power of Attorney by Applicant form is not accompanied by this transmittal form or an equivalent, the Power of Attorney will not be recognized in the application.

Application Number	
Filing Date	
First Named Inventor	
Title	
Art Unit	
Examiner Name	
Attorney Docket Number	

SIGNATURE of Applicant or Patent Practitioner

Signature		Date	
Name		Telephone	
Registration Number			

NOTE: This form must be signed in accordance with 37 CFR 1.33. See 37 CFR 1.4(d) for signature requirements and certifications.

☐ *Total of forms are submitted.

This collection of information is required by 37 CFR 1.31, 1.32 and 1.33. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 3 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



Powers of Attorney: AIA/82B

For apps filed on/after
9/16/12

- AIA/82B is the power of attorney by applicant. It must be either be accompanied by a transmittal letter (AIA/82A or equivalent) that identifies the patent application to which the power is directed, or the application number and filing date boxes on the form must be filled in.*

Doc Code: PA..

Document Description: Power of Attorney

PTO/AIA/82B (07-13)

Approved for use through 11/30/2014. OMB 0651-0051

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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POWER OF ATTORNEY BY APPLICANT

I hereby revoke all previous powers of attorney given in the application identified in either the attached transmittal letter or the boxes below.

Application Number	Filing Date

(Note: The boxes above may be left blank if information is provided on form PTO/AIA/82A.)

☐ I hereby appoint the Patent Practitioner(s) associated with the following Customer Number as my/our attorney(s) or agent(s), and to transact all business in the United States Patent and Trademark Office connected therewith for the application referenced in the attached transmittal letter (form PTO/AIA/82A) or identified above:

OR

☐ I hereby appoint Practitioner(s) named in the attached list (form PTO/AIA/82C) as my/our attorney(s) or agent(s), and to transact all business in the United States Patent and Trademark Office connected therewith for the patent application referenced in the attached transmittal letter (form PTO/AIA/82A) or identified above. (Note: Complete form PTO/AIA/82C.)

Please recognize or change the correspondence address for the application identified in the attached transmittal letter or the boxes above to:

☐ The address associated with the above-mentioned Customer Number

OR

☐ The address associated with Customer Number:

OR

Firm or
Individual Name

Address

City

State

Zip

Country

Telephone

Email



Powers of Attorney: AIA/82B

For apps filed on/after
9/16/12

- AIA/82B must be signed by the applicant. If there are multiple applicant parties, each party must execute a form.*

I am the Applicant (if the Applicant is a juristic entity, list the Applicant name in the box):

--

- ☐ Inventor or Joint Inventor (title not required below)
- ☐ Legal Representative of a Deceased or Legally Incapacitated Inventor (title not required below)
- ☐ Assignee or Person to Whom the Inventor is Under an Obligation to Assign (provide signer's title if applicant is a juristic entity)
- ☐ Person Who Otherwise Shows Sufficient Proprietary Interest (e.g., a petition under 37 CFR 1.46(b)(2) was granted in the application or is concurrently being filed with this document) (provide signer's title if applicant is a juristic entity)

SIGNATURE of Applicant for Patent

The undersigned (whose title is supplied below) is authorized to act on behalf of the applicant (e.g., where the applicant is a juristic entity).

Signature		Date (Optional)	
Name			
Title			

NOTE: Signature - This form must be signed by the applicant in accordance with 37 CFR 1.33. See 37 CFR 1.4 for signature requirements and certifications. If more than one applicant, use multiple forms.

☐ Total of forms are submitted.

This collection of information is required by 37 CFR 1.131, 1.32, and 1.33. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 3 minutes to complete.

- Where the applicant is a juristic entity (e.g., an assignee corporation) the power needs to identify the applicant and either be signed by someone with a title that carries apparent authority (an officer of the assignee) or include a statement of authorization to act. Note: Our form now includes authorization to act language, like the 3.73 Statement forms (PTO/SB/96 and PTO/AIA/96).*



Powers of Attorney: AIA/81

For apps filed on/after
9/16/12

- AIA/81 is used by pro se joint inventors who are the applicant to give to give power of attorney to one of more of them. The appointed inventor(s) should also submit a signed form.*

PTO/AIA/81 (07-12)
Approved for use through 11/30/2014. OMB 0651-0035
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.

POWER OF ATTORNEY TO ONE OR MORE OF THE JOINT INVENTORS AND CHANGE OF CORRESPONDENCE ADDRESS	
Application Number	
Filing Date	
First Named Inventor	
Art Unit	
Examiner Name	
Title	

NOTE: This form may be filed by *pro se* inventors (*i.e.*, prosecuting the application without a registered patent practitioner) who are identified as the Applicant in the above-identified application. For a Power of Attorney to one or more registered patent practitioners, see form PTO/AIA/82.

I hereby revoke all previous powers of attorney given in the above-identified application.

☐ I hereby appoint the following joint inventor(s) to prosecute the application identified above, and to transact all business in the United States Patent and Trademark Office connected therewith:

Please recognize or change the correspondence address for the above-identified application to:

☐ The address associated with Customer Number. (if applicable):
-To Request A Customer Number see form PTO/SB/124

OR

<input type="checkbox"/> Individual Name			
Address			
City	State	Zip	
Country			
Telephone	Email		

I am the Inventor.

SIGNATURE of Inventor			
Signature			Date
Name			Telephone

NOTE: Signatures of all the inventors are required. Submit multiple forms if more than one signature is required, see below*. See 37 CFR 1.4 for signature requirements and certifications.

☐ *Total of _____ forms are submitted.

This collection of information is required by 37 CFR 1.31, 1.32 and 1.33. The information is required to obtain or retain a benefit by the public which is to be (and by the



Powers of Attorney: AIA/80

For apps filed on/after
9/16/12

- *AIA/80 is used by assignees who are becoming the applicant under § 1.46 and are giving power of attorney.*
- *AIA/80 is submitted together with a § 3.73(c) Statement (AIA/96 or equivalent)*
- *An assignee-applicant (i.e., who was named as the applicant in the ADS) could use AIA/80 (along with AIA/96) if desired.*

PTO/AIA/80 (07-12)
Approved for use through 11/30/2014. OMB 0651-0035
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.

POWER OF ATTORNEY TO PROSECUTE APPLICATIONS BEFORE THE USPTO

I hereby revoke all previous powers of attorney given in the application identified in the attached statement under 37 CFR 3.73(c).
I hereby appoint:

☐ Practitioners associated with Customer Number:

OR

☐ Practitioner(s) named below (if more than ten patent practitioners are to be named, then a customer number must be used):

Name	Registration Number	Name	Registration Number

As attorney(s) or agent(s) to represent the undersigned before the United States Patent and Trademark Office (USPTO) in connection with any and all patent applications assigned only to the undersigned according to the USPTO assignment records or assignments documents attached to this form in accordance with 37 CFR 3.73(c).

Please change the correspondence address for the application identified in the attached statement under 37 CFR 3.73(c) to:

☐ The address associated with Customer Number:

OR

Firm or Individual Name			
Address			
City	State	Zip	
Country			
Telephone			Email

Assignee Name and Address:

A copy of this form, together with a statement under 37 CFR 3.73(c) (Form PTO/AIA/96 or equivalent) is required to be Filed in each application in which this form is used. The statement under 37 CFR 3.73(c) may be completed by one of The practitioners appointed in this form, and must identify the application in which this Power of Attorney is to be filed.

SIGNATURE of Assignee of Record
The individual whose signature and title is supplied below is authorized to act on behalf of the assignee

Signature	<input type="text"/>	Date	<input type="text"/>
Name	<input type="text"/>	Telephone	<input type="text"/>
Title	<input type="text"/>		

This collection of information is required by 37 CFR 1.31, 1.32 and 1.33. The information is required to obtain or retain a benefit by the public which it is to be used.



Examples of Terminal Disclaimers Filed



Example 1 of Terminal Disclaimers Filed

Example 1

A terminal disclaimer is filed by an attorney who is listed in the combined declaration and power of attorney filed on January 31, 2008. The power of attorney lists 30 patent attorneys.

Based on these facts alone, is the terminal disclaimer proper?



Example 1 of Terminal Disclaimers Filed (cont'd)

Applies in all applications

Answer to Example 1:

No, the TD is improper. The power of attorney is improper, because the listing of attorneys on the combined declaration and power of attorney lists more than 10 attorneys, and a separate signed paper designating 10 or fewer practitioners was not included.

37 CFR 1.32 was amended to limit number of attorneys listed on power of attorney, and the change was effective for any power of attorney filed on or after June 25, 2004. See MPEP § 402.

Thus, the attorney is acting in a representative capacity pursuant to 37 CFR 1.34 and is not of record to properly sign the TD.



Example 2 of Terminal Disclaimers Filed

Example 2:

In an Office action, claims were rejected under 35 U.S.C. 103 as being unpatentable over Reference A in view of Reference B. In response, applicant asserts (pursuant to pre-AIA 35 U.S.C. 103(c)(1) or AIA 35 U.S.C. 102(b)(2)(C)) common ownership of Reference A and the claimed invention at the time the claimed invention was made (for pre-AIA applications) or on or before the effective filing date of the claimed invention (for AIA (First Inventor to File) applications). The attorney of record also files a terminal disclaimer over Reference A. However, the examiner did not make a double patenting rejection.

Is the terminal disclaimer proper based on these facts alone?



Example 2 of Terminal Disclaimers Filed (cont'd)

Applies in all applications

Answer to Example 2:

Yes, the TD is proper. There is no requirement that an attorney wait for the examiner to make an obvious type double patenting rejection before filing a TD with the Office.

For instance, an applicant may file a continuing application and preemptively file a TD with the application in anticipation of an obvious double patenting rejection.



Example 3 of Terminal Disclaimers Filed

Example 3:

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?



Example 3 of Terminal Disclaimers Filed (cont'd)

Answer to Example 3:

The originally filed TD (not having an application number listed on it and instead listing “TBD”) is proper for the same reasons given in the answer for example 2.

However, the processing branch should not have crossed out “TBD,” inserted the application number and had the TD. Office 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.



Example 4 of Terminal Disclaimers Filed

Example 4:

Attorney of record filed a TD disclaiming over application number 14/111,111. However, the application listed in the nonstatutory double patenting rejection is 14/111,110. The TD was initially disapproved, since the application number used to form basis of the double patent rejection listed in the Office action did not match the application number listed in the TD. The examiner had a telephone interview with the attorney and they agreed that the terminal disclaimer should be approved as the examiner listed the incorrect application number in the double patent rejection of the Office action.

Should the terminal disclaimer be approved by the paralegal or should another rejection be sent out identifying the correct application number in the double patenting rejection?



Example 4 of Terminal Disclaimers Filed (cont'd)

Answer to Example 4:

In the interest of compact prosecution, the examiner should fill out the interview summary to clarify the record noting the typographical error in the Office action, and the TD should then be approved by the paralegal.



Example 5 of Terminal Disclaimers Filed

For apps filed before 9/16/12

Example 5:

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 supplemental terminal disclaimer?



Example 5 of Terminal Disclaimers Filed (cont'd)

For apps filed before 9/16/12

Answer to Example 5:

No, there is no fee for the second replacement terminal disclaimer since a fee has already been charged for the first one, and the second terminal disclaimer was filed to deal with the same ODP reference as was the first terminal disclaimer.



Example 6 of Terminal Disclaimers Filed

For apps filed before 9/16/12

Example 6:

Inventors A and B are joint inventors in a patent application. Inventor A assigned his entire rights and interests to the patent application to assignee C. A terminal disclaimer for the application is filed by assignee C who owns the patent application together with inventor B.

Is the terminal disclaimer proper?



Example 6 of Terminal Disclaimers Filed (cont'd)

For apps filed before 9/16/12

Answers to Example 6:

Yes, if there is also a proper TD of record signed by inventor B, and the assignee C has established its right to take action according to pre-AIA 37 CFR 3.73(b).

Yes, if there is a petition under pre-AIA 37 CFR 1.47 that has been granted where inventor B is the uncooperative inventor and the assignee C has established its right to take action according to pre-AIA 37 CFR 3.73(b).

No, if a petition under pre-AIA 37 CFR 1.47 has not been filed and granted. In order to conduct prosecution of the patent application, the assignee or the combination of partial assignee(s) and inventor(s) must have the entirety of the ownership. [If a proper TD of record signed by inventor B is later filed (and the assignee established its right to take action according to pre-AIA 37 CFR 3.73(b)), then both TDs would be entered at this later point.

No, if the assignee C has not established its right to take action according to pre-AIA 37 CFR 3.73(b).



Example 7 of Terminal Disclaimers Filed

Example 7:

A parent application included a combined declaration and power of attorney, which lists more than 10 practitioners. Later on, a change in the power of attorney which appointed the practitioners associated with Customer Number 000123 was filed.

Even later, a continuation application is filed which includes (a) a copy of the combined declaration and power of attorney that lists more than 10 practitioners, and (b) a copy of the change in the power of attorney which appointed the practitioners associated with customer number 000123 from the parent application. The TD is signed by a practitioner associated with the customer number.

Is the terminal disclaimer proper?



Example 7 of Terminal Disclaimers Filed (cont'd)

Answer to Example 7:

Yes, the terminal disclaimer is proper, because the change in power of attorney gives power of attorney to the attorneys associated with that customer number and the attorney who signed the terminal disclaimer is one of the attorneys associated with that Customer Number.

Note: For an application filed on/after 9/16/12, the terminal disclaimer would be proper **ONLY IF** the inventors are the applicant.



Example 8 of Terminal Disclaimers Filed

Example 8: Statements of ownership in a TD.

- 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?



Example 8 of Terminal Disclaimers Filed (cont'd)

Applies in all applications

Answers to Example 8:

- 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 “D ” explanation.
- F. The **sole** owner of the instant application. = approve - same as 100 % interest – “sole” provides the same result as “entire.”



Example 9 of Terminal Disclaimers Filed

Example 9: Attorney of record.

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?



Example 9 of Terminal Disclaimers Filed (cont'd)

Applies in all applications

Answer to Example 9:

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.



Example 10 of Terminal Disclaimers Filed

For apps filed before 9/16/12

Example 10: Ownership.

A TD is filed to overcome an ODP rejection over a patent reference. Company A is the assignee of record for the application under examination, and company B is the assignee of record for the ODP patent reference. The TD identifies a parent company X, and it states that parent company X owns 100% of subsidiary company A and 100% of subsidiary company B.

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



Example 10 of Terminal Disclaimers Filed (cont'd)

For apps filed before 9/16/12

Answer to Example 10:

We can approve the TD if we get a statement from both an authorized officer of A and an authorized officer of B, stating that parent company X owns 100% of company A and company B.

If such a statement is filed, the Office will recognize company X as the sole owner of both the application under examination and the ODP patent reference, and accept the TD.

If, in the future, company A or company B becomes no-longer-owned by company X, then any patent resulting from the application under examination will become unenforceable.



Example 11 of Terminal Disclaimers Filed

For apps filed before 9/16/12

Example 11: Statement of ownership percentages.

A terminal disclaimer (TD) is filed to overcome an ODP 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?



Example 11 of Terminal Disclaimers Filed (cont'd)

For apps filed before 9/16/12

Answer to Example 11:

- 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 of record may sign the TD.
 - But, if the TD is to be signed by an Officer of the owner (assignee) company, 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.



Example 12 of Terminal Disclaimers Filed

For apps filed on/after 9/16/12

Example 12: Application 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%. 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?



Example 12 of Terminal Disclaimers Filed (cont'd)

For apps filed on/after 9/16/12

Answer to Example 12:

Yes. 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 §§ 3.71 and 3.73 practice. 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 §§ 3.71, 3.73 and 1.46(c) in order to do so.



Example 13 of Terminal Disclaimers Filed

For apps filed on/after 9/16/12

Example 13: Application filed on/after 9/16/12

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 ODP rejection over a patent reference.

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

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



Example 13 of Terminal Disclaimers Filed (cont'd)

For apps filed on/after 9/16/12

Answer to Example 13:

No. 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 § 3.73(c) Statement showing chain of title to the new applicant.



Unusual Circumstances



Unusual Circumstances – Statements *re* commonality of ownership

Improper statements re commonality of ownership:

- Where the statement is not proper, 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 *re* commonality of ownership (cont'd)

Examples statements re commonality of ownership: ...shall be enforceable only for and during such period that -

- 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 V.A.



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 **“as defined in 35 U.S.C. 154 and 173”** to modify “full statutory term.”



Statements in terminal disclaimers as to statutory patent term (cont'd)

- Above we discussed optional exculpatory language in 2nd paragraph of 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).



General Terminal Disclaimer Processing



General Terminal Disclaimer Processing

A terminal disclaimer pending in an application or in a patent undergoing reexamination proceeding will be processed by the paralegal in the following manner:

- 1) 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.
- 2) Where the terminal disclaimer is not acceptable, specify the nature of the informalities so that the examiner can inform applicant in the next Office action. The paralegal completes the Terminal Disclaimer Informal Memo Checklist to notify the examiner of the nature of any informalities in the terminal disclaimer and **scans the Checklist with a document code that does not give public access** (if the code has already been set up).



General Terminal Disclaimer Processing (cont'd)

- Where the terminal disclaimer is not acceptable, the paralegal will complete the IFW terminal disclaimer form by checking the “Disapproved” box and have the form scanned into IFW and enter in PALM that the terminal disclaimer is not accepted.
- Where the terminal disclaimer is acceptable, the paralegal will complete the IFW terminal disclaimer form by checking the “Approved” box and have the form scanned into IFW and enter in PALM that the terminal disclaimer is approved.



Thank you!



Questions?

For more information, please contact:

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