

Improper Requests for Continued Examination Applications

PREAMBLE: This agreement between the United States Patent and Trademark Office (USPTO) and the Patent Office Professional Association (POPA) addresses the procedures and arrangements for abandonment of applications filed under 35 U.S.C. 371 with improperly processed Requests for Continued Examination (RCE). The RCEs were improper due to the lack of an inventor's oath or declaration for each named inventor.

Procedure Outlined in Attached Email to Examiners: POPA has had an opportunity to review and comment on the email attached to this agreement. Management will provide each examiner with an abandonment on their docket, or who have issued a first action in an application that has been abandoned, with a copy of the email. As seen in the sample, the email will indicate the serial number(s) of the applications relevant to each examiner. The email also indicates how credit will be handled for these applications.

Bargaining Obligations Met: POPA acknowledges that the Agency has met its bargaining obligations related to these abandonments so long as the abandonments are processed in accordance with that attached email.

Effective Date: This agreement becomes effective on the day following approval of the agreement on agency head review, or on the thirty-first day following the signing of this agreement if the agreement is neither approved nor disapproved.

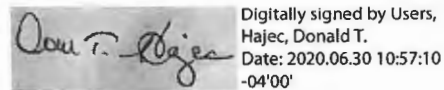
Signatures



Kathleen Duda
President
POPA

July 1, 2020

Date



Digitally signed by Users,
Hajec, Donald T.
Date: 2020.06.30 10:57:10
-04'00'

Donald Hajec
Assist. Dep. Commissioner
Patent Operations

June 30, 2020

Date

For applications filed under 35 USC 371, an oath or declaration for each named inventor must be filed before a RCE can be properly filed. A number of RCEs were improperly processed due to the lack of an oath or declaration. For a more detailed description, see the attached WORD document.

You have been identified as an examiner with one or more of these improperly processed RCEs in which the statutory period for response in the action prior to the filing of the RCE has expired. As such, the application is abandoned and a notice of abandonment will be mailed. It is anticipated that these applications will be revived.

The serial number of this/these application(s) is/are: xx/xxx, xxx. You should refrain from any further action on these applications. If any of these applications are on your regular new docket and have a clock, new case credit will not be required in order to receive credit for asterisk RCEs. If the application is selected as an asterisk, the next oldest RCE on your docket will be eligible for asterisk credit. Please contact me for these adjustments. If any of these applications have a clock, they will not generate a docket management score or result in a penalty if they exceed the ceiling.

In order to mitigate the impact from loss of a disposal credit due to a revival at a later date (e.g. next fiscal year), these cases will be abandoned and revived without the normal count credit transaction. In other words, you will not receive disposal credit for the abandonment nor will it be taken away from you when the application is revived. Once the application is revived, the application will be returned to its current status and you will be eligible to receive the current remaining count credit.

Example: An application with improper RCE is in status 041 (Non Final Action Mailed). The examiner has already received 1 count for the FAOM. As the case is abandoned and subsequently revived, the examiner will receive no additional count credit activity for these actions. However, once revived, the application will be returned to status 041 or status 071 (if a response is filed), and the remaining .75 count credit will be available to the examiner when prosecution is resumed.

These applications will be monitored and in the event that a petition to revive is not filed by 9/1/21, a disposal for the abandonment will be credited to the examiner.

Let me know if you have questions.

Improper RCE in applications filed under 35 U.S.C. 371: no inventor's oath or declaration

The RCE provisions of 37 CFR 1.114 do not apply to an international application that does not comply with 35 U.S.C. 371. *See* 37 CFR 1.114(e)(3). An inventor's oath or declaration for each named inventor is required for an international application to comply with 35 U.S.C. 371, notwithstanding the changes permitting applicants to postpone filing the inventor's oath or declaration until the date on which the issue fee is paid. *See* 37 CFR 1.495(c)(3)(ii). *See also Changes To Implement the Hague Agreement Concerning International Registration of Industrial Designs*, Final Rule, 80 Fed. Reg. 17918, 17930 (April 2, 2015).

An improper RCE does not operate to toll the running of any time period set in the previous Office action for reply to avoid abandonment of the application. As a result of an enhancement to OPESS verification process for RCEs, OPESS has been identifying improper RCEs filed in an international application where a compliant oath or declaration has not been filed from each originally named inventor. Applicants are being notified by OPESS via form PTO-2051 ("Notice of Improper Request for Continued Examination (RCE)"). However, there are applications where the first RCE was entered in an international application where a compliant oath or declaration has not been filed from each originally named inventor, and the application was forwarded to the Examiner for action. These applications are in various stages of prosecution. Since the improper RCE did not operate to toll the running of the time period set in the previous Office action (e.g., a Final Rejection or a Notice of Allowance), these applications became abandoned when the statutory period for reply set forth in the previous Office action expired, provided that no additional Office action was mailed prior to the expiration of the statutory period for reply.

There are applications in which an Office action was mailed prior to the expiration of the 6-month statutory period from the final rejection (or *Ex Parte Quayle* action) or prior to the expiration of the 3-month time period set in the Notice of Allowance to pay the issue fee, if the action prior to the RCE is a Notice of Allowance. In these applications, the Office is considering the prosecution having been reopened by the examiner. Therefore, such applications were not abandoned. This will not result in a change in the count credit available to the examiner in future Office actions.

For all the cases that are considered abandoned, OPESS will be mailing out a Notice of Abandonment.