

Nos. 2018-2390, 2018-2391, 2018-2392, 2019-1038, 2019-1039, 2019-1049,
2019-1070, 2024-1992, 2024-1993, 2024-1994, 2024-1995

IN THE
**United States Court of Appeals
for the Federal Circuit**

GILBERT P. HYATT,
Plaintiff-Cross-Appellant

v.

JOHN A. SQUIRES, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE,
Defendant-Appellant

APPEALS FROM THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF
COLUMBIA IN NOS. 1:05-cv-02310-RCL, 1:09-cv-01864-RCL, 1:09-cv-01869-
RCL, 1:09-cv-01872-RCL, SENIOR JUDGE ROYCE C. LAMBERTH.

**CONSENTED MOTION OF THE SMALL BUSINESS TECHNOLOGY
COUNCIL FOR LEAVE TO FILE LATE AN *AMICUS CURIAE* BRIEF IN
SUPPORT OF THE PETITION FOR REHEARING *EN BANC***

Charles E. Miller
Counsel-of-Record
LEICHTMAN LAW PLLC
185 Madison Avenue
New York, NY 10016
Tel.: (516) 641-3378
Email: cmiller@leichtmanlaw.com

November 13, 2025

FORM 9. Certificate of Interest

Form 9 (p. 1)
March 2023

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

CERTIFICATE OF INTEREST

Case Number 2018-2390 et al.

Short Case Caption Gilbert P. Hyatt v. John A. Squires

Filing Party/Entity Small Business Technology Council (SBTC)

Instructions:

1. Complete each section of the form and select none or N/A if appropriate.
2. Please enter only one item per box; attach additional pages as needed, and check the box to indicate such pages are attached.
3. In answering Sections 2 and 3, be specific as to which represented entities the answers apply; lack of specificity may result in non-compliance.
4. Please do not duplicate entries within Section 5.
5. Counsel must file an amended Certificate of Interest within seven days after any information on this form changes. Fed. Cir. R. 47.4(c).

I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Date: 11/12/2025

Signature: /s/ Charles E. Miller

Name: Charles E. Miller

FORM 9. Certificate of Interest

Form 9 (p. 2)
March 2023

1. Represented Entities. Fed. Cir. R. 47.4(a)(1).	2. Real Party in Interest. Fed. Cir. R. 47.4(a)(2).	3. Parent Corporations and Stockholders. Fed. Cir. R. 47.4(a)(3).
Provide the full names of all entities represented by undersigned counsel in this case.	Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities. ☒ None/Not Applicable	Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities. ☐ None/Not Applicable
Small Business Technology Council		National Small Business Association (NSBA)

☐ Additional pages attached

FORM 9. Certificate of Interest

Form 9 (p. 3)
March 2023

4. Legal Representatives. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

☐ None/Not Applicable ☐ Additional pages attached

Charles E. Miller	Leichtman Law PLLC	

5. Related Cases. Other than the originating case(s) for this case, are there related or prior cases that meet the criteria under Fed. Cir. R. 47.5(a)?

☐ Yes (file separate notice; see below) ☐ No ☒ N/A (amicus/movant)

If yes, concurrently file a separate Notice of Related Case Information that complies with Fed. Cir. R. 47.5(b). **Please do not duplicate information.** This separate Notice must only be filed with the first Certificate of Interest or, subsequently, if information changes during the pendency of the appeal. Fed. Cir. R. 47.5(b).

6. Organizational Victims and Bankruptcy Cases. Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

☒ None/Not Applicable ☐ Additional pages attached

REASONS FOR GRANTING THE MOTION

1. Pursuant to Federal Rule of Appellate Procedure 29(a)(3) and Federal Circuit Rule 29(a), the Small Business Technology Council (SBTC), respectfully requests leave of the Court to late-file the attached proposed *amicus curiae* brief in support of the Petition for rehearing *en banc*.
2. The SBTC is the nation's largest association of small, technology-based companies in diverse fields. SBTC is a council of the National Small Business Association (NSBA), the nation's first small-business advocacy organization. NSBA is a staunchly nonpartisan organization with 65,000 members in every state and every industry in the US. SBTC advocates on behalf of the 6000 firms who participate in the Small Business Innovation Research (SBIR) and Small Business Technology Transfer (STTR) programs. These SBIR/STTR companies obtain more patents at the US Patent and Trademark Office (PTO) than all the American universities combined in most years.
3. While we support Petitioner's request for rehearing *on banc*, our proposed *amicus* brief takes no position on the ultimate question of the patentability of Petitioner's underlying patent applications at issue in this case.
4. This Motion for Leave includes three requests:
 - (a) To file the attached *amicus* brief;
 - (b) To incorporate the addenda at the end of the brief; and
 - (c) To file the aforementioned *amicus* submission later than that specified by this Court's rules, after an attempt to e-file on time failed due to an unforeseen technical issue.

The reasons for each request are explained below:

(a) Reasons for the *amicus* brief

5. The materials and arguments in the proposed *amicus* brief should aid the Court and allow it to consider legal arguments and evidence that the Petition did not advance. These are highly relevant and dispositive, as they demonstrate how the Panel erroneously imported presumptions that can be reasonably interpreted as rendering some 30% of issued patents presumptively unenforceable. That interpretation has already been adopted by accused patent infringers, as noted in the brief in footnote 4 and accompanying text.

6. The *amicus* brief advances arguments for rehearing *en banc* that were not raised by the Petition related to the Panel's error in overlooking the degree to which PTO regulations under the Patent Act regulate applicants' timeliness and conduct to avoid "unreasonable and unexplained delay in prosecution."

(b) Reasons for including the addenda

7. Addendum 1 includes factual information on the prospective impact of this Court's decision in this case. It contains numerical calculations of statistical information that is a matter of public record regarding the percentage of US patents the enforcement of which may be adversely affected by this Panel's decision, should it not be corrected by the full Court *en banc*.

8. Addendum 2 is a compendium of 132 PTO regulations prescribing patent applicants' conduct and timing requirements relevant to this case. It is necessary to show the breadth and completeness of regulatory limits on all aspects of applicant's timeliness and conduct requirements, supporting the *amicus* argument.

(c) Reason for late filing

9. November 12, 2025, was the last day prescribed by Federal Circuit Rule 40(i)(2) for filing this *amicus* submission and the undersigned logged into his account on PACER on that day. However, the undersigned discovered that while his account is activated for ECF e-filing in some courts, it is not so activated for the Federal Circuit. The undersigned immediately initiated a request for upgrading the account for e-filing at the Federal Circuit, and the request was still pending with no activation at the end of the day.

10. To ensure that both parties to this case timely received the *amicus* submission, it was nevertheless sent directly to their emails, copied to the Clerk's Office, on November 12, 2025. Subsequently, activation for e-filing in the federal Circuit was obtained later today, on November 13, 2025, the day of this late filing.

CONSENT OF THE PARTIES

11. In response to the email sent to both parties with the copy of the *amicus* submission, the undersigned received emails on November 13, 2025 from counsel for Hyatt consenting to the late filing of the *amicus* submission, and from counsel for the PTO expressing no objection to such late filing.

CONCLUSION

For the foregoing reasons, the Court should grant this motion to file the proposed *amicus* brief.

Respectfully submitted,

/s/ Charles E. Miller

Charles E. Miller
Counsel-of-Record
LEICHTMAN LAW PLLC
185 Madison Avenue
New York, NY 10016
Tel.: (516) 641-3378
Email: cmiller@leichtmanlaw.com

November 13, 2025

FORM 19. Certificate of Compliance with Type-Volume Limitations

Form 19
July 2020

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITATIONS

Case Number: 2018-2390 et al.

Short Case Caption: Gilbert P. Hyatt v. John A. Squires

Instructions: When computing a word, line, or page count, you may exclude any items listed as exempted under Fed. R. App. P. 5(c), Fed. R. App. P. 21(d), Fed. R. App. P. 27(d)(2), Fed. R. App. P. 32(f), or Fed. Cir. R. 32(b)(2).

The foregoing filing complies with the relevant type-volume limitation of the Federal Rules of Appellate Procedure and Federal Circuit Rules because it meets one of the following:

- ☒ the filing has been prepared using a proportionally-spaced typeface and includes 706 words.
- ☐ the filing has been prepared using a monospaced typeface and includes _____ lines of text.
- ☐ the filing contains _____ pages / _____ words / _____ lines of text, which does not exceed the maximum authorized by this court's order (ECF No. _____).

Date: 11/13/2025

Signature: /s/ Charles E. Miller

Name: Charles E. Miller

Nos. 2018-2390, 2018-2391, 2018-2392, 2019-1038, 2019-1039, 2019-1049,
2019-1070, 2024-1992, 2024-1993, 2024-1994, 2024-1995

IN THE
United States Court of Appeals
for the Federal Circuit

GILBERT P. HYATT,
Plaintiff-Cross-Appellant

v.

JOHN A. SQUIRES, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE,
Defendant-Appellant

APPEALS FROM THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF
COLUMBIA IN NOS. 1:05-cv-02310-RCL, 1:09-cv-01864-RCL, 1:09-cv-01869-
RCL, 1:09-cv-01872-RCL, SENIOR JUDGE ROYCE C. LAMBERTH.

**BRIEF OF *AMICUS CURIAE* SMALL BUSINESS TECHNOLOGY
COUNCIL IN SUPPORT OF REHEARING *EN BANC***

Counsel-of-Record
Charles E. Miller
LEICHTMAN LAW PLLC
185 Madison Avenue
New York, NY 10016
Tel.: (516) 641-3378
Email: cmiller@leichtmanlaw.com

November 12, 2025

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

CERTIFICATE OF INTEREST

Case Number 2018-2390 et al.

Short Case Caption Gilbert P. Hyatt v. John A. Squires

Filing Party/Entity Small Business Technology Council (SBTC)

Instructions:

1. Complete each section of the form and select none or N/A if appropriate.
2. Please enter only one item per box; attach additional pages as needed, and check the box to indicate such pages are attached.
3. In answering Sections 2 and 3, be specific as to which represented entities the answers apply; lack of specificity may result in non-compliance.
4. Please do not duplicate entries within Section 5.
5. Counsel must file an amended Certificate of Interest within seven days after any information on this form changes. Fed. Cir. R. 47.4(c).

I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Date: 11/12/2025

Signature: /s/ Charles E. Miller

Name: Charles E. Miller

FORM 9. Certificate of Interest

Form 9 (p. 2)
March 2023

1. Represented Entities. Fed. Cir. R. 47.4(a)(1).	2. Real Party in Interest. Fed. Cir. R. 47.4(a)(2).	3. Parent Corporations and Stockholders. Fed. Cir. R. 47.4(a)(3).
Provide the full names of all entities represented by undersigned counsel in this case.	Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities. ☒ None/Not Applicable	Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities. ☐ None/Not Applicable
Small Business Technology Council		National Small Business Association (NSBA)

☐ Additional pages attached

FORM 9. Certificate of Interest

Form 9 (p. 3)
March 2023

4. Legal Representatives. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

☐ None/Not Applicable

☐ Additional pages attached

Charles E. Miller	Leichtman Law PLLC	

5. Related Cases. Other than the originating case(s) for this case, are there related or prior cases that meet the criteria under Fed. Cir. R. 47.5(a)?

☐ Yes (file separate notice; see below) ☐ No ☒ N/A (amicus/movant)

If yes, concurrently file a separate Notice of Related Case Information that complies with Fed. Cir. R. 47.5(b). **Please do not duplicate information.** This separate Notice must only be filed with the first Certificate of Interest or, subsequently, if information changes during the pendency of the appeal. Fed. Cir. R. 47.5(b).

6. Organizational Victims and Bankruptcy Cases. Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

☒ None/Not Applicable

☐ Additional pages attached

TABLE OF CONTENTS

	Page
CERTIFICATE OF INTEREST	i
TABLE OF CONTENTS	ii
TABLE OF AUTHORITIES	iii
TABLE OF ABBREVIATIONS	v
INTEREST OF <i>AMICUS CURIAE</i>	1
ARGUMENT	2
1 The “law of the case” doctrine does not apply where the Panel’s decision conflicts with Supreme Court precedents	2
2 This Court should grant rehearing <i>en banc</i> to correct erroneous presumptions reasonably interpreted to render 30% of issued patents unenforceable.....	4
2.1 The six years presumption of laches in <i>Hyatt I</i> is invalid as it lacks rational connection between actual facts and the fact presumed	6
3 The <i>en banc</i> court should recognize that Congress’ composite statutory <i>and</i> administrative regulatory framework foreclosed on the equitable doctrine of prosecution laches	9
CONCLUSION	13

TABLE OF AUTHORITIES

Page

CASES

<i>Christianson v. Colt Indus. Operating Corp.</i> , 486 U.S. 800 (1988).....	3, 4
<i>Hyatt v. Hirshfeld</i> , 998 F. 3d 1347 (Fed. Cir. 2021).....	2, 3, 4, 5, 6
<i>Hyatt v. Stewart</i> , Case 18-2390 (Fed. Cir. August 29, 2025)	3
<i>In re Amaitis, et al.</i> 2012 Commr. Pat. LEXIS 13 (Comm'r Pat. & Trademarks February 27, 2012).....	11
<i>In re Colyvas</i> , 2010 Commr. Pat. LEXIS 24 (Comm'r Pat. & Trademarks May 24, 2010)	10
<i>In re Gilbert et al.</i> , 2011 Commr. Pat. LEXIS 328 (Comm'r Pat. & Trademarks July 14, 2011).....	10
<i>In re Goodman, et al.</i> , 1987 Commr. Pat. LEXIS 19 (Comm'r Pat. & Trademarks January 28, 1987).....	10
<i>National Archives and Records Admin. v. Favish</i> , 541 US 157 (2004)	6
<i>Petrella v. Metro Goldwyn Mayer, Inc.</i> 572 U.S. 663 (2014)	2, 3, 4, 12
<i>PMC v. Apple</i> , Appeal No. 21-2275, Oral Argument (Fed. Cir. July 7, 2022)	5
<i>SCA Hygiene Prod. Aktiebolag v. First Quality Baby Prod., LLC</i> , 580 U.S. 328 (2017).....	2, 3, 4
<i>Sebelius v. Auburn Reg'l Med. Ctr.</i> , 568 U.S. 145 (2013).....	12
<i>Symbol Techs., Inc. v. Lemelson Med.</i> , 277 F.3d 1361 (Fed. Cir. 2002).....	2
<i>Symbol Techs., Inc. v. Lemelson Med.</i> , 422 F.3d 1378 (Fed. Cir. 2005).....	8
<i>Wanlass v. Gen. Elec. Co.</i> , 148 F.3d 1334 (Fed. Cir. 1998).....	4
<i>Wirtgen America v. Caterpillar</i> , 746 F.Supp.3d 218 (D. Del. 2024)	5

STATUTES

35 U.S.C. § 2(b)(2).....	9
42 U.S.C. § 1395oo(a)(3).....	12

REGULATIONS

37 C.F.R. § 1.78(f)	11
37 C.F.R. § 1.111(b)	10
37 C.F.R. § 1.135(c).....	11
37 C.F.R. §1.142(b)	7
37 C.F.R. §1.143	7
37 C.F.R. §1.144	8
37 C.F.R. § 10.18	11
37 C.F.R. § 11.18(b)	6, 11
37 C.F.R. § 11.18(c).....	11
42 C.F.R. § 405.1841(b)	12

RULES

Federal Rules of Appellate Procedure 29(a)(4)(E)	1
Federal Rules of Evidence, Rule 301	6, 7

OTHER AUTHORITIES

50 <i>Fed. Reg.</i> 5172 (Feb. 6, 1985)	11
Hyatt Reply Brief (December 3, 2024).....	2
MPEP § 809	8
MPEP § 821.04	8

TABLE OF ABBREVIATIONS

<i>Symbol I</i>	<i>Symbol Techs., Inc. v. Lemelson Med.</i> , 277 F.3d 1361 (Fed. Cir. 2002)
<i>Symbol II</i>	<i>Symbol Techs., Inc. v. Lemelson Med.</i> , 422 F.3d 1378 (Fed. Cir. 2005)
<i>Hyatt I</i>	<i>Hyatt v. Hirshfeld</i> , 998 F. 3d 1347 (Fed. Cir. 2021)
<i>Hyatt II</i>	<i>Hyatt v. Stewart</i> , Case 18-2390 (Fed. Cir. August 29, 2025)
Hyatt Reply Br.	Hyatt Reply Brief After Remand, ECF 120 (December 3, 2024)

INTEREST OF *AMICUS CURIAE*¹

For reasons more fully described in the accompanying Motion for Leave to file this *Amicus* brief, the Small Business Technology Council is particularly qualified to aid this Court in understanding the adverse impact on our inventor and patent holder members, both when prosecuting their patent applications at the US Patent and Trademark Office (“PTO”) or enforcing patents, if the precedential rulings of the Panel in this case are not corrected. For the reasons detailed below, we support the petition for rehearing *en banc*.

¹ Under Federal Rules of Appellate Procedure 29(a)(4)(E), the undersigned states that this brief was authored by *amicus curiae*, and that no counsel for a party authored this brief in whole or in part, and no counsel or party other than *amicus curiae* contributed money intended to fund preparing or submitting the brief.

ARGUMENT

Rehearing *en banc* should be granted because the Panel’s decisions conflict with Supreme Court precedents that are central to the case; because the Panel failed to resolve questions of exceptional importance; and because the Panel’s decision, if uncorrected, will remain a precedent that may be interpreted as presumptively rendering unenforceable 30% of issued U.S. patents.

1 The “law of the case” doctrine does not apply where the Panel’s decision conflicts with Supreme Court precedents

The Federal Circuit held that the equitable doctrine of prosecution laches could be applied to render unenforceable a patent that issued after “unreasonable and unexplained delay” in prosecution. *Symbol Techs., Inc. v. Lemelson Med.*, 277 F.3d 1361 (Fed. Cir. 2002) (“*Symbol I*”). However, later Supreme Court decisions in *Petrella v. Metro Goldwyn Mayer, Inc.* 572 U.S. 663 (2014), and *SCA Hygiene Prod. Aktiebolag v. First Quality Baby Prod., LLC*, 580 U.S. 328 (2017) on laches in infringement actions, clarified the *general principles* of unavailability of laches. These general principles also apply to prosecution laches, suggesting that *Symbol I* is abrogated.

Petitioner’s reply brief specifically noted the silence on these precedents in *Hyatt v. Hirshfeld*, 998 F. 3d 1347 (Fed. Cir. 2021) (“*Hyatt I*”). See Hyatt Reply Br. at 19 (“[N]ot a sentence of the opinion discusses *SCA Hygiene*, *Petrella*, or the

viability of *Symbol I*.”) (Emphasis added). Moreover, in *Hyatt v. Stewart*, Case 18-2390 (Fed. Cir. August 29, 2025) (“*Hyatt II*”), the Panel again failed to address the core argument supported by these authorities. Instead, the Panel now inexplicably characterized as “the law of the case” its *Hyatt I* decision, and stated that “we necessarily considered them and did not find them convincing.” *Hyatt II*, at *8. However, that is no reasoning for ignoring these arguments again. Nowhere in *Hyatt I* or *Hyatt II*, did the Panel address the reasons *SCA Hygiene* and *Petrella* are inapplicable, nor their distinguishability from the issues of prosecution laches.

We submit that the Panel improperly applied the doctrine of “the law of the case.” That doctrine is subject to exceptions “in extraordinary circumstances such as where the initial decision was clearly erroneous and would work a manifest injustice.” *Christianson v. Colt Indus. Operating Corp.*, 486 U.S. 800, 817 (1988) (cleaned up). Indeed, this is an extraordinary circumstance, as the Panel’s conclusion was clear error as it cannot be reconciled with these precedents. Adhering to that conclusion would result in a manifest injustice to many patent applicants by extinguishing a statutorily secured property right based on impermissible equitable doctrines.

To be sure, *Christianson* also held that the fact that the appellate court “did not explicate its rationale is irrelevant, for the law of the case turns on whether a court

previously decided upon a rule of law . . . not on whether, or how well, it explained the decision.” *Christianson*, 486 U.S. at 817. However, the Panel's decision is not an unexplained application of controlling law, but rather an application of a rule of law that is itself *clearly erroneous* in light of Supreme Court precedent. The Panel's silence on *SCA Hygiene* and *Petrella* is *evidence* of this failure, not necessarily the failure itself. The *en banc* review should be granted because correction in this matter is of exceptional importance.

2 This Court should grant rehearing *en banc* to correct erroneous presumptions reasonably interpreted to render 30% of issued patents unenforceable

The Panel declared: “In the context of laches, we have held that a delay of more than six years raises a ‘*presumption* that it is unreasonable, inexcusable, and prejudicial.’”² The Panel further stated: “Consistent with both *Cancer Research* and *Wanlass*, we now hold that, . . . an unreasonable and unexplained prosecution delay of six years or more *raises a presumption* of prejudice, including intervening rights.”³ There would be little reason for the Panel to remove the context of *bringing suit* in reference to *Wanlass*, and to mention “consistency” with *Wanlass*,

² *Hyatt I*, 998 F.3d at 1369 (emphasis added) (Quoting *Wanlass v. Gen. Elec. Co.*, 148 F.3d 1334, 1337 (Fed. Cir. 1998)).

³ 998 F.3d at 1370 (emphasis added).

had the Panel not intended to import *Wanlass*' six-year delay as triggering the presumption of "unreasonable, inexcusable, and prejudicial" delay in prosecution laches. These statements are justifiably interpreted as creating such a presumption, as argued by counsel for accused infringers.⁴ These are *precedential*⁵ presumptions applicable broadly—not only to Mr. Hyatt.

Patent application prosecution from priority filing to patent issuance involves objective and necessary durations spanning several years. A statistical study reported in Addendum 1 hereto shows that 30% of US patents have issued more than six years after their earliest priority date. This cannot mean that patent applicants of 30% of US patents have engaged in "unreasonable, inexcusable, and prejudicial" delay.⁶ The Panel's holding, as reasonably interpreted, presumed *facts that cannot happen* under PTO's regulations described below and in Addendum 2.

⁴ *Wirtgen America v. Caterpillar*, 746 F.Supp.3d 218, 227 (D. Del. 2024) ("Caterpillar cites to *Hyatt* for the proposition that a six-year delay is *presumptively unreasonable*." (Emphasis added); *PMC v. Apple*, Appeal No. 21-2275, Oral Argument (Fed. Cir. July 7, 2022) (Apple's counsel states at 21:50: PMC's delay until filing a continuation "was eight years; *that's enough*, as [*Hyatt I*] said, to trigger laches." www.cafc.uscourts.gov/oral-arguments/21-2275_07072022.mp3).

⁵ *Hyatt I* is classified as "precedential" at www.cafc.uscourts.gov/10-12-2021-20-2321-hyatt-v-hirshfeld-opinion-20-2321-opinion-10-12-2021_1847303/

⁶ *Hyatt I*, 998 F.3d at 1369.

This is because under the presumption of agency regularity,⁷ the PTO is presumed to have ensured compliance with its regulations, including that any applicant submission is not “being presented ... to cause unnecessary delay,” in contravention of 37 C.F.R. § 11.18(b)(2)(i). The PTO—not the District Court—has the specific agency expertise and experience to make the determination under this rule and must be presumed to have enforced it regularly. Accordingly, it is more probable than not, that the patent applicants of these 30% of issued US patents have not engaged in “unreasonable and unexplained delay in prosecution.” Therefore, as reasonably interpreted, the six years “presumed fact” of laches in *Hyatt I* is invalid under Rule 301, Federal Rules of Evidence, because “the nonexistence of the presumed fact is more probable than its existence.”⁸

2.1 The six years presumption of laches in *Hyatt I* is invalid as it lacks rational connection between actual facts and the fact presumed

Even if the equitable defense of laches were available (which it is not), the six years presumptions of laches cannot be legally sustained. First, the panel’s presumptions arose in the context of an unreasonable delay in *filing suit*—a charge

⁷ *National Archives and Records Admin. v. Favish*, 541 US 157, 174 (2004) (“The presumption of regularity supports the official acts of public officers and, in the absence of clear evidence to the contrary, courts presume that they have properly discharged their official duties.”) (cleaned up).

⁸ FRE 301. Notes of Advisory Committee on Proposed Rules.

that cannot impugn a patent applicant's *prosecution* conduct. Second, there must be “a rational connection between the fact proved and the fact presumed.”⁹ Here, patent applicants have legitimate objective necessity for filing continuing applications years after the original filing priority dates, leading to application pendency of more than six years after their earliest priority date, during which others may have exploited the invention.

For example, filing dates of Continuations In Part (“CIP”) applications are substantially later than the original priority filing date because they involve additional disclosure of *further* improvements obtained through research and development activities that took place after the original filing date.

Another example is divisional applications for which the timing for introducing the divisional claims must be deferred under the PTO rules and practice, which may even obviate the need for them:

1. 37 C.F.R. §1.142(b) provides for restricted claim “reinstatement in the event the requirement for restriction *is withdrawn or overruled*,” §1.143 provides for applicant traverse and election of “one invention for prosecution “*in the event the requirement becomes final*”—a finality that *only the examiner* may

⁹*Id.*

provide; §1.144 provides that applicant petition to “the Director to review the requirement ... may be deferred *until after final action on or allowance of claims to the invention elected*, but must be filed not later than appeal.”

2. The MPEP in § 809 provides that “should any linking claim be allowable, *the restriction requirement between the linked inventions must be withdrawn.*” Moreover, MPEP § 821.04 requires the examiner to *reconsider* “the propriety of a restriction requirement ... when all the claims directed to the elected invention are *in condition for allowance*, and the nonelected invention(s) should be considered for *rejoinder.*”

This Court acknowledged that reasonable delays in prosecution include (i) filing a divisional application in response to a restriction requirement—*even immediately before issuance of the parent application*; (ii) refiling an application to present new evidence of an invention's unexpected advantages; and (iii) refiling an application to add subject matter to attempt to support broader claims as the development of an invention progresses.¹⁰ This Court also noted that an applicant may refile an application for other reasons, “provided that such refiling is not

¹⁰ *Symbol Techs., Inc. v. Lemelson Med.*, 422 F.3d 1378, 1385 (Fed. Cir. 2005) (“*Symbol II*”).

unduly successive or repetitive.”¹¹ Therefore, there is no rational connection between actual facts and the fact the Panel presumed.

3 The *en banc* court should recognize that Congress’ composite statutory and administrative regulatory framework foreclosed on the equitable doctrine of prosecution laches

The extensive provisions of the Patent Act specify the timeliness, context, and modalities in which applicants must prosecute their applications, provisions implemented and *supplemented* by the administrative regulations that Congress included in *this* framework. This includes 35 U.S.C. § 2(b)(2), authorizing the PTO to “establish regulations, not inconsistent with law, which shall govern the conduct of proceedings in the Office.” Accordingly, the PTO promulgated regulations prescribing applicants’ timeliness and conduct. Addendum 2 lists 132 of these regulations that have timing and conduct requirements in all facets of prosecution and submissions to the Office.

The PTO administers these 132 regulations and others based on its expertise as to workflow and *what constitutes proper applicant conduct*. Some rules employ words requiring applicants to act “promptly,”¹² to be “diligent,”¹³ act in “good

¹¹ *Id.*

¹² *See* 37 C.F.R. §§ 1.6(f)(1)(i); 1.8(b)(1); 1.10(c)(1), (d)(1), (e)(1), (g)(1), (h)(1), (j)(1); 1.25(a); 1.803(a)(2)(vii); 1.804(b); 1.805(c), (d); 5.2(c); 11.103;

faith,”¹⁴ and demonstrate “a *bona fide* attempt to advance the application to final action.”¹⁵ The Office developed specific practices to determine applicants’ compliance. For example, for determining whether applicants’ replies “appear throughout to be a *bona fide* attempt to advance the application ... to final action” pursuant to 37 C.F.R. § 1.111(b), the examiners guidance in the Manual of Patent Examination Procedures (“MPEP”) for this rule alone contains 14 sections addressing facets of this requirement.¹⁶ More generally, the PTO routinely demonstrates active use of the timeliness rules when facing what the Office regards as applicant’s dilatory conduct.¹⁷ It is simply unreasonable to expect a District

11.104(a)(1), (a)(4); 11.118(d)(2)(ii); 41.108(c); 41.109(c); 41.120(c); and 41.124(e).

¹³ See 37 C.F.R. §§ 1.701(d)(2); 1.775(d)(1)(ii); 1.776(d)(1)(ii); 1.777(d)(1)(ii); 1.778(d)(1)(ii); 1.779(d)(1)(ii); 1.805(c)(3), (d); 5.25(a)(3)(ii); and 11.103.

¹⁴ See 37 C.F.R. §§ 1.28(c); 1.29(k); 1.56(a); 1.555(a); 1.765(a); 1.933(a); 5.1(d); and 42.11(a).

¹⁵ See 37 C.F.R. §§ 1.85(a), 1.97(f), 1.111(b), 1.135(c), and 1.957(d).

¹⁶ See MPEP §§ 608.01(b); 706.07(h); 707.07(f); 708.02(a); 714.02; 714.03(a); 804; 818.01; 1302.14; 1490; 2141; 2246; 2266, and 2269.

¹⁷ See e.g., *In re Goodman, et al.*, 1987 Commr. Pat. LEXIS 19, *8, (Comm'r Pat. & Trademarks January 28, 1987) (The “application became abandoned for failure to [meet 37 CFR § 1.111 and] file a complete response to the first Office action.”); *In re Colyvas*, 2010 Commr. Pat. LEXIS 24, *6-9 (Comm'r Pat. & Trademarks May 24, 2010) (Denying repeated petitions to withdraw holding of abandonment after extended period of delay); *In re Gilbert et al.*, 2011 Commr. Pat. LEXIS 328, *1, *16 (Comm'r Pat. & Trademarks July 14, 2011) (Denying petition to withdraw the finality of the final Office action after applicant’s prior attempt at further

Court judge to second-guess the expert agency on such prosecution issues.

The PTO, however, is well-equipped to render such determinations and to *enforce* compliance. The PTO's regulations governing applicants' conduct provide that in every submission to the Office, applicant *certifies* that it "is not being presented ... to cause unnecessary delay or needless increase in the cost of any proceeding before the Office." 37 C.F.R. § 11.18(b)(2)(i). This regulation also provides that "violations of any of [these provisions] are, after notice and reasonable opportunity to respond, subject to such sanctions or actions as deemed appropriate by the [PTO] Director, which may include, but are not limited to ... [t]erminating the proceedings in the Office." *Id.*, § 11.18(c)(5). This is equivalent to forfeiture of the application.¹⁸

For example, the PTO reviews submissions of continuing applications filed in chains spanning many years, to enforce 37 C.F.R. § 1.78(f) (requiring that "patentably indistinct claims [be eliminated] from all but one application.") While

amendments, thereby enforcing Rule 1.111(b)); *In re Amaitis, et al.* 2012 Commr. Pat. LEXIS 13, *14 (Comm'r Pat. & Trademarks February 27, 2012) (Denying applicants' petition to vacate abandonment of the application under 37 C.F.R. § 1.135(c) because applicants failed to elect between multiple inventions and "the amendment on its face is not a 'bona fide attempt to advance the application to final action.'")

¹⁸ Rule 11.18's predecessor prior to September 2008, 37 C.F.R. § 10.18, was in place since 1985. *See* 50 *Fed. Reg.* 5172 (Feb. 6, 1985).

doing so, the PTO expertly evaluates if claiming practice in the chain constitutes “unreasonable and unexplained delay,” for example, whether cancelled claims are reintroduced, or otherwise are opportunistically “presented ... to cause unnecessary delay.” If so, such contravention of § 11.18(b)(2)(i) justifies PTO’s refusal to enter submissions or even forfeit the application. § 11.18(c)(5).

Hence, the existing statutory scheme and implementing regulations are *already structured* to produce the outcome that prosecution laches purports to achieve through undue expansion of judicial equitable powers. However, “[s]uch an expansive role careens away from understandings ... of the essentially gap-filling, not legislation-overriding, office of laches.”¹⁹

The Patent Act in its full framework *including implementing regulations* leaves no room for the application of equitable doctrines to supplant statutes, where agency administrative regulations specifically do so. *See Sebelius v. Auburn Reg'l Med. Ctr.*, 568 U.S. 145, 149 (2013) (Held that equitable tolling of the 180-day statutory period for filing an appeal under 42 U.S.C. § 1395oo(a)(3) is unavailable where an administrative process by regulation in 42 C.F.R. § 405.1841(b) fills “gaps,” extending the period for three years for “good cause.”)

¹⁹ *Petrella*, 572 U.S. at 680.

CONCLUSION

For the foregoing reasons, the Court should grant rehearing *en banc*.

Respectfully submitted,

/s/ Charles E. Miller

Charles E. Miller
Counsel-of-Record
LEICHTMAN LAW PLLC
185 Madison Avenue
New York, NY 10016
Tel.: (516) 641-3378
Email: cmiller@leichtmanlaw.com

FORM 19. Certificate of Compliance with Type-Volume Limitations

Form 19
July 2020

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITATIONS

Case Number: 2018-2390 et al.

Short Case Caption: Gilbert P. Hyatt v. John A. Squires

Instructions: When computing a word, line, or page count, you may exclude any items listed as exempted under Fed. R. App. P. 5(c), Fed. R. App. P. 21(d), Fed. R. App. P. 27(d)(2), Fed. R. App. P. 32(f), or Fed. Cir. R. 32(b)(2).

The foregoing filing complies with the relevant type-volume limitation of the Federal Rules of Appellate Procedure and Federal Circuit Rules because it meets one of the following:

- ☒ the filing has been prepared using a proportionally-spaced typeface and includes 2,581 words.
- ☐ the filing has been prepared using a monospaced typeface and includes _____ lines of text.
- ☐ the filing contains _____ pages / _____ words / _____ lines of text, which does not exceed the maximum authorized by this court's order (ECF No. _____).

Date: 11/12/2025

Signature: /s/ Charles E. Miller

Name: Charles E. Miller

ADDENDA

TABLE OF CONTENTS	Pages
Addendum 1 - Fraction of US Patents that Issued More Than 6 Years After Their Earliest Priority Date	AD-2
Addendum 2 - PTO Rules Specifying Timing Requirements and Applicant's Conduct	AD-3

ADDENDUM 1

Fraction of US Patents that Issued More Than 6 Years After Their Earliest Priority Date

An investigation of publically available patent databases revealed that while most provide a search field for the patent's "priority date," several of them use the metadata of the USPTO which only contains the filing date of the subject application, and therefore report that date as the priority date but not the actual *earliest* priority date. To obtain that earliest date, one must ingest the continuity chain as published in "related applications" on the front page of the patent.

Upon further investigation, it was found that the free database at www.Lens.org provides the actual earliest priority date based on the published continuity chain. The correctness of the "Earliest Priority Date" field was verified by inspecting several issued patents for their related applications.

The other important advantage available on Lens.org is the field "Priority Jurisdiction." By selecting "US" in that field, one eliminates counts of patents issued from applications entering the US National Phase under 35 U.S.C. § 371 based on their earlier foreign priority date. The result of this composite search for US patents issued from August 2, 2025 to October 6, 2025 inclusive is shown in the table below.

Search Fields Criteria	Patents	
Granted Date: ([2025-08-02 to 2025-10-06]) AND (Document Type: Granted_Patent AND (Jurisdiction: US AND Priority Jurisdiction: US))	33,449	<i>a</i>
AND Earliest Priority Date: ([1970-01-01 to 2019-08-01])	9,871	<i>b</i>
Fraction issued later than 6 years from earliest priority date: $c = b/a$	0.30	<i>c</i>

Source: www.Lens.org, October 12, 2025.

ADDENDUM 2

PTO Rules Specifying Timing Requirements and Applicant's Conduct

#	Rule in 37 CFR §	Timing requirement and conduct provisions
1	1.7 Times for taking action; Expiration on Saturday, Sunday or Federal holiday	(a) Whenever periods of time are specified in this part in days, calendar days are intended. When the day, or the last day fixed by statute or by or under this part for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or on a Federal holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding business day which is not a Saturday, Sunday, or a Federal holiday. See § 90.3 of this chapter for time for appeal or for commencing civil action. (b) If the day that is twelve months after the filing date of a provisional application under 35 U.S.C. 111(b) and § 1.53(c) falls on Saturday, Sunday, or on a Federal holiday within the District of Columbia, the period of pendency shall be extended to the next succeeding secular or business day which is not a Saturday, Sunday, or a Federal holiday.
2	1.8 Certificate of mailing or transmission.	Correspondence required to be filed in the USPTO within a set period of time will be considered as being timely filed if the procedure described in this section is followed.
3	1.10 Filing of correspondence by Priority Mail Express	Provides for mailing procedures that deems correspondence received by the USPTO that was delivered by the Priority Mail Express® Post Office to Addressee service of the United States Postal Service (USPS) will be considered filed with the USPTO on the date of deposit with the USPS .

#	Rule in 37 CFR §	Timing requirement and conduct provisions
4	1.53 Application number, filing date, and completion of application.	(b)(2) A request to convert a provisional application to a nonprovisional must be filed prior to the earliest of: (i) abandonment of the provisional; (ii) expiration of 12 months after the provisional's filing date. (c)(2) A request to convert a nonprovisional application to a provisional must be filed prior to the earliest of: (i) abandonment of the nonprovisional; (ii) payment of the issue fee on the nonprovisional; or (iii) expiration of 12 months after the nonprovisional's filing date. (c)(3) A provisional application may be converted to a nonprovisional and accorded the original provisional's filing date, if the request is filed prior to the earliest of: (i) abandonment of the provisional; or (ii) expiration of 12 months after the provisional's filing date. (d)(1)(iii) A continued prosecution application must be filed before the earliest of: (A) payment of the issue fee on the prior application, unless a petition under § 1.313(c) is granted in the prior application; (B) abandonment of the prior application; or (C) termination of proceedings on the prior application. (f)(1) If a nonprovisional application lacks required parts (basic filing fee, search/exam fee, at least one claim or inventor's oath/declaration), and a correspondence address has been provided, the applicant will be notified and given a period of time in which to file/complete those parts to avoid abandonment. (f)(2) If the same type of nonprovisional application lacks required parts and no correspondence address is provided, the applicant has three months from the filing date of the application within which to file those parts to avoid abandonment. (f)(3)(ii) The inventor's oath or declaration may be postponed until the application is otherwise in condition for allowance, no later than the date on which the issue fee for the patent is paid. (f)(4) If excess claims fees or multiple dependent claim fees are not paid on filing or on

#	Rule in 37 CFR §	Timing requirement and conduct provisions
		later presentation of the claims, the fees must be paid or the claims canceled by amendment prior to the expiration of the time period set for reply by the Office in any notice of fee deficiency. (g)(2) If a provisional application has been accorded a filing date and applicant has not provided a correspondence address, the applicant has two months from the filing date of the application within which to pay the basic filing fee, file a cover sheet, and pay the surcharge to avoid abandonment. (h) An application filed under (b) or (d) will not be placed on the files for examination until all required parts are received, except that the inventor's oath/declaration may be filed when the application is otherwise in condition for allowance under (f)(3).
5	1.55 Claim for foreign priority.	(a) The claim for foreign priority and certified copy of the foreign application must generally be filed within the time period set in § 1.78(a)(4), i.e., within the later of four months from the actual filing date or sixteen months from the foreign filing date. (b) For PCT national stage (§ 371) applications, the priority claim and certified copy must be submitted within 16 months from the foreign filing date under PCT Rule 17.1(a), or, if not already submitted, before the patent is granted. (c) For continued prosecution applications (CPA) under § 1.53(d), the time for submitting the priority claim and certified copy is the same as in the parent application; a CPA cannot introduce a new or later priority claim. (d) A priority claim may be corrected or added if the request and required information are submitted within the time period set in § 1.78(a)(4), i.e., within the later of four months from the actual filing date or sixteen months from the foreign filing date. (e) If the certified copy is not timely filed, it may still be accepted before patent grant upon petition showing that the delay was unintentional and paying the required fee. (f) For international design applications, priority documents must be furnished to the USPTO within the time prescribed by the Hague Agreement (generally within sixteen

#	Rule in 37 CFR §	Timing requirement and conduct provisions
		months from the foreign filing date), with late acceptance possible upon petition showing unintentional delay. (g) For applications filed before November 29, 2000, the priority claim and certified copy may be submitted within the time period set in former § 1.55(a). (h) Failure to comply within the periods specified results in loss of the right to priority, unless remedied under subsections (d) or (e)
6	1.56 Duty to disclose information material to patentability.	(e) In any continuation-in-part application, the duty under this section includes the duty to disclose to the Office all information known to the person to be material to patentability, as defined in paragraph (b) of this section, which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application
7	1.69 Foreign language oaths and declarations.	(b) Unless the text of any oath or declaration in a language other than English is in a form provided by the Patent and Trademark Office or in accordance with PCT Rule 4.17(iv), it must be accompanied by an English translation together with a statement that the translation is accurate, except that in the case of an oath or declaration filed under § 1.63, the translation may be filed in the Office no later than two months from the date applicant is notified to file the translation .

#	Rule in 37 CFR §	Timing requirement and conduct provisions
8	1.71 Detailed description and specification of the invention.	(a) Specification must be included at filing. (d)–(e) No new matter may ever be added after filing. (g)(2) An amendment to disclose names of parties to a joint research agreement must be filed within: 3 months of the application’s U.S. filing date, or 3 months of the PCT national stage entry date, or before the first Office action on the merits, or before the first Office action after an RCE filing. If filed later, a processing fee (§ 1.17(i)) is required. (g)(3) If such an amendment is filed after payment of the issue fee, correction must be made by certificate of correction under 35 U.S.C. 255 and § 1.323. (g) (2) An amendment under paragraph (g)(1) of this section must be accompanied by the processing fee set forth in § 1.17(i) if not filed within one of the following time periods: (i) Within three months of the filing date of a national application; (ii) Within three months of the date of entry of the national stage as set forth in § 1.491 in an international application; (iii) Before the mailing of a first Office action on the merits; or (iv) Before the mailing of a first Office action after the filing of a request for continued examination under § 1.114.

#	Rule in 37 CFR §	Timing requirement and conduct provisions
9	1.78 Claiming benefit of earlier filing date and cross-references to other applications.	(a)(1) A nonprovisional application must be filed not later than twelve months after the date on which the provisional application was filed to claim the benefit under 35 U.S.C. 119(e). (a)(2) The benefit claim must be made during the pendency of the application and within the later of: (i) four months from the actual filing date of the later-filed application; or (ii) sixteen months from the filing date of the prior-filed application. Failure to meet this requirement is considered a waiver of any benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) to such prior-filed application. (a)(4) The benefit claim must be made during the pendency of the application, which means before the application is granted or abandoned. (b) If a nonprovisional application is filed after the twelve-month period but within fourteen months of the provisional application, the applicant may file a petition under § 1.78(b) to accept the delayed benefit claim. (e) If the delay in filing the benefit claim was unintentional, a petition under § 1.78(e) may be filed to accept the delayed claim. (f) Where two or more applications filed by the same applicant or assignee contain patentably indistinct claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

#	Rule in 37 CFR §	Timing requirement and conduct provisions
10	1.85 Corrections to drawings	(a) A utility or plant application will not be placed on the files for examination until objections to the drawings have been corrected. “Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a bona fide attempt to advance the application to final action.” (b) The Office will not release drawings for purposes of correction. If corrections are necessary, new corrected drawings must be submitted within the time set by the Office. (c) If a corrected drawing is required or if a drawing does not comply with § 1.84 or an amended drawing submitted under § 1.121(d) in a nonprovisional international design application does not comply with § 1.1026 at the time an application is allowed, the Office may notify the applicant in a notice of allowability and set a three-month period of time from the mail date of the notice of allowability within which the applicant must file a corrected drawing in compliance with § 1.84 or § 1.1026, as applicable, to avoid abandonment. This time period is not extendable under § 1.136. Corrected drawings must be filed within a three-month period from the mail date of the notice of allowability to avoid abandonment.

#	Rule in 37 CFR §	Timing requirement and conduct provisions
11	1.97 Filing of information disclosure statement.	(b) An IDS filed before the mailing of a first Office action on the merits is entered without any fee or statement required. (c) An IDS filed after the mailing of the first Office action but before final rejection requires a statement under § 1.97(e) or a fee (except when the information was not known prior to the first Office action). (d) An IDS filed after final rejection but before appeal requires a petition and fee under § 1.17(p) and must comply with the requirements of § 1.97(e). (e) When an IDS is filed after the first Office action, a statement must be made regarding the relevance and timing of the cited documents, or a fee paid if no such statement is provided. (f) “No extensions of time for filing an information disclosure statement are permitted under § 1.136. If a <i>bona fide</i> attempt is made to comply with § 1.98, but part of the required content is inadvertently omitted, additional time may be given to enable full compliance. IDS after allowance is generally not entered without petition and fee.
12	1.102 Advance-ment of examination.	(e)(1) Request for prioritized examination must be filed upon filing of the application, except the applicant may file an amendment to cancel excess claims not later than one month from the first decision on the request (non-extendable). (e)(2) Request for prioritized examination after a request for continued examination must be filed before the mailing of the first Office action after the request for continued examination.

#	Rule in 37 CFR §	Timing requirement and conduct provisions
13	1.103 Suspension of action by the Office.	(a) Petition for suspension must specify a period not exceeding six months. (b) Request for suspension must be filed with the request for a continued prosecution application (CPA). (c) Request for suspension must be filed with the request for continued examination (RCE). (d) Request for deferral of examination must be filed before the Office has issued either an Office action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151.
14	1.105 Requirements for information.	(c) Replies to a requirement for information are subject to the same time frame rules as other Office actions .
15	1.111 Reply by applicant or patent owner to a non-final Office action.	(a)(1) Applicant or patent owner must reply to an Office action within six months from the date of the action to avoid abandonment. (a)(2)(ii) A supplemental reply will be entered if filed within the period during which action by the Office is suspended under § 1.103(a) or (c). (b) The applicant's reply must appear throughout to be a <i>bona fide</i> attempt to advance the application or the reexamination proceeding to final action.
16	1.113 Final rejection or action.	(c) A reply under 37 CFR 1.113 is limited to: an amendment complying with 37 CFR 1.116; a Notice of Appeal (and appeal fee); or a request for continued examination (RCE) filed under 37 CFR 1.114 with a submission (i.e., an amendment that meets the reply requirement of 37 CFR 1.111) and the fee set forth in 37 CFR 1.17(e).

#	Rule in 37 CFR §	Timing requirement and conduct provisions
17	1.114 Request for continued examination.	(a) An applicant may request continued examination by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of: 1. Payment of the issue fee, unless a petition under § 1.313 is granted; 2. Abandonment of the application; or 3. The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated. (b) Prosecution is considered closed when: - The application is under appeal; - The last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application. (c) If a reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.111.
18	1.115 Preliminary amendments.	(a) Preliminary amendment must be received by the USPTO on or before the mail date of the first Office action under § 1.104. (b)(3) Preliminary amendment may be disapproved if filed later than three months from the filing date of the application under § 1.53(b), the filing date of a continued prosecution application under § 1.53(d), or three months from the date the national stage is entered in an international application under § 1.491. (b)(4) The time periods specified in paragraph (b)(3) are not extendable.

#	Rule in 37 CFR §	Timing requirement and conduct provisions
19	1.116 Amend-ments and affidavits or other evidence after final action and prior to appeal.	(b) Amendments or affidavits/evidence must be filed before or on the same date as filing an appeal (under § 41.31 or § 41.61). (d) In inter partes reexamination, amendments must be filed before the right of appeal notice under § 1.953. (e) Affidavits/evidence in ex parte reexamination must be filed before the right of appeal notice under § 1.953.
20	1.121 Manner of making amend-ments in applica-tions.	(c) If an amendment to the claims is filed after the filing date of the application, the applicant must submit a complete claim listing in compliance with this section. (e) If an amendment is filed in response to a non-final Office action and is non-compliant with this section, the applicant will be given a non-extendable period of two months from the mailing date of the Notice of Non-Compliant Amendment to correct the non-compliance. (f) If an amendment is filed after final rejection and is non-compliant with this section, the unentered amendment will be forwarded to the examiner. The examiner will address the non-compliance in an Advisory Action. Additional time will not be given to make the amendment compliant with the rule. (g) In inter partes reexamination, amendments must be filed before the right of appeal notice under § 1.953.

#	Rule in 37 CFR §	Timing requirement and conduct provisions
21	1.125 Substitute specification	(b) A substitute specification, excluding the claims, may be filed at any time up to payment of the issue fee, provided it is accompanied by a statement that the substitute specification includes no new matter. (c) A substitute specification must be submitted with markings showing all changes relative to the immediate prior version of the specification of record. (d) A substitute specification under this section is not permitted in a reissue application or in a reexamination proceeding.
22	1.129 Transitional procedures for limited examination after final rejection and restriction practice	(a) First submission and the fee set forth in § 1.17(r) must be filed prior to the filing of an appeal brief and prior to abandonment of the application. (b)(2) Applicant will be notified and given a time period to elect the invention or inventions to be searched and examined and to pay the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in excess of one.
23	1.131 Affidavit or declaration of prior invention or to disqualify commonly owned patent or published application as prior art.	(a) Affidavit or declaration may be submitted when any claim is rejected in the application or patent under reexamination. (e) For applications subject to § 1.130, affidavits or declarations under this section apply only with respect to a rejection under 35 U.S.C. 102(g) as in effect on March 15, 2013.

#	Rule in 37 CFR §	Timing requirement and conduct provisions
24	1.133 Interviews	(a)(2) An interview for the discussion of the patentability of a pending application will not occur before the first Office action , unless the application is a continuing or substitute application or the examiner determines that such an interview would advance prosecution of the application.
25	1.134 Time period for reply to an Office action.	“An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed. ”
26	1.135 Abandonment for failure to reply within time period.	(a) “If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.” (b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment. (c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.”

#	Rule in 37 CFR §	Timing requirement and conduct provisions
27	1.136 Extensions of time	(a)(1) If the applicant is required to reply within a non-statutory or shortened statutory time period, the applicant may extend the time period for reply up to the earlier of: (1) expiration of any maximum period set by statute, or (2) five months after the time period set for reply. (a)(2) The date on which the petition and the fee are filed is used to determine both (1) the period of extension and (2) the corresponding amount of the fee. (a)(2) A reply must be filed prior to the expiration of the period of extension to avoid abandonment. (b) When paragraph (a) is not available, a request for extension of time may be filed for sufficient cause and for a reasonable time, provided it is filed on or before the day the reply was due. (c) If the applicant is notified in a “Notice of Allowability” that the application is otherwise in condition for allowance, the following periods are NOT extendable: (1) submitting the inventor’s oath or declaration; (2) submitting formal drawings under § 1.85(c); and (3) making a deposit under § 1.809(c).
28	1.137 Revival of abandoned application, or terminated or limited reexamination prosecution.	(e) A request for reconsideration or review of a decision refusing to revive must be filed within two months of the decision (or within such time as set in the decision).

#	Rule in 37 CFR §	Timing requirement and conduct provisions
29	1.138 Express abandonment	(a) “Express abandonment of the application may not be recognized by the Office before the date of issue or publication unless it is actually received by appropriate officials in time to act.” (c) A declaration of express abandonment by way of petition with the fee must be received in sufficient time to permit the appropriate officials to recognize the abandonment and remove the application from the publication process — applicants should expect publication if the petition is not received more than four weeks prior to the projected date of publication. (d) For applications filed under 35 U.S.C. 111(a) and § 1.53(b) on or after December 8, 2004, a petition and declaration of express abandonment must be filed before an examination has been made of the application in order to obtain a refund of the search fee and excess claims fee. If a request for refund is not filed with the declaration or within two months from the date of that declaration, the Office may retain the fees. This two-month period is not extendable.
30	1.142 Requirement for restriction	(a) Examiner in an Office action may require the applicant in the reply to that action (within a shortened statutory period of 2 months per MPEP §810) to elect an invention to which the claims will be restricted.
31	1.143 Reconsideration of requirement	Applicant’s request for reconsideration and withdrawal or modification of the restriction requirement, giving the reasons therefor, must be filed with a provisional election of one invention for prosecution (within a shortened statutory period of 2 months per MPEP §810).

#	Rule in 37 CFR §	Timing requirement and conduct provisions
32	1.144 Petition from requirement for restriction.	“After a final requirement for restriction, the applicant, in addition to making any reply due on the remainder of the action, may petition the Director to review the requirement. Petition may be deferred until after final action on or allowance of claims to the invention elected, but must be filed not later than appeal. ”
33	1.146 Election of species	Examiner in an Office action may require the applicant in the reply to that action (within a shortened statutory period of 2 months per MPEP §810) to elect a species of the invention to which the claim will be restricted if no claim to the genus is found to be allowable.
34	1.155 Expedited examination of design applications	(b) “The Office will not examine an application that is not in condition for examination (e.g., missing basic filing fee) even if the applicant files a request for expedited examination under this section.”
35	1.173 Reissue specification, drawings, and amendments.	(a)(1) Reissue application requesting broadening of claims must be filed within two years from the grant of the original patent.
36	1.175 Inventor’s oath or declaration for a reissue application.	(e) The inventor’s oath or declaration must be executed before the reissue application can be released for examination.
37	1.181 Petition to the Director	(f) Any petition under this rule not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely. This two-month period is not extendable.

#	Rule in 37 CFR §	Timing requirement and conduct provisions
38	1.197 Termination of proceedings	(a) Proceedings on an application are considered terminated by the dismissal of an appeal or the failure to timely file an appeal to the court or a civil action, except where claims stand allowed in an application or where the nature of the decision requires further action by the examiner. (b) The date of termination of proceedings on an application is the date on which the appeal is dismissed or the date on which the time for appeal to the U.S. Court of Appeals for the Federal Circuit or review by civil action expires in the absence of further appeal or review. ... A civil action is terminated when the time to appeal the judgment expires. An appeal to the U.S. Court of Appeals for the Federal Circuit, whether from a decision of the Board or a judgment in a civil action, is terminated when the mandate is issued by the Court.
39	1.213 Nonpublication request.	(a) To prevent publication under 35 U.S.C. 122(b), a nonpublication request must be submitted with the application upon filing. (b) The applicant may rescind a nonpublication request at any time. (c) If a nonpublication request has been submitted and the applicant subsequently files a foreign or international application requiring publication, the applicant must notify the USPTO within 45 days of the foreign or international filing date. Failure to timely notify the USPTO will result in abandonment of the application in which the nonpublication request was submitted.
40	1.219 Early publication.	Applications may be published earlier than as set forth in § 1.211(a) at the request of the applicant .

#	Rule in 37 CFR §	Timing requirement and conduct provisions
41	1.221 Voluntary publication or re-publication of patent application publication.	“Any request for a corrected or revised patent application publication other than as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable. ”
42	1.248 Service of papers; manner of service; proof of service in cases other than interferences and trials.	(a)(4) “Transmission by first class mail. When service is by mail the date of mailing will be regarded as the date of service. ”
43	1.251 Unlocatable file.	(a) “In the event that the Office cannot locate the file of an application, patent, or other patent-related proceeding after a reasonable search, the Office will notify the applicant or patentee and set a time period within which the applicant or patentee must comply with the notice...”
44	1.290 Submissions by third parties in applications.	(b) A third-party submission must be filed before the earlier of: (b)(1) The date a notice of allowance under § 1.311 is given or mailed in the application; or (b)(2) The later of: (b)(2)(i) Six months after the date on which the application is first published by the Office under 35 U.S.C. 122(b) and § 1.211; or (b)(2)(ii) The date the first rejection under § 1.104 of any claim by the examiner is given or mailed during the examination of the application.

#	Rule in 37 CFR §	Timing requirement and conduct provisions
45	1.291 Protests by the public against pending applications	(b) A protest must be filed before the earlier of the date the application is published under § 1.211 or the date a notice of allowance under § 1.311 is given or mailed. If the protest is accompanied by the applicant's written consent, it will be considered if filed before the notice of allowance is given or mailed .
46	1.311 Notice of Allowance.	(a) The issue fee and any required publication fee must be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. This three-month period is not extendable.
47	1.312 Amendments after allowance.	“No amendment may be made as a matter of right in an application after the mailing of the notice of allowance . Any amendment filed pursuant to this section must be filed before or with the payment of the issue fee , and may be entered on the recommendation of the primary examiner, approved by the Director, without withdrawing the application from issue.”
48	1.313 Withdrawal from issue	(d) A petition to withdraw an application from issue will not be effective unless it is received and granted by the appropriate officials before the date of issue . Withdrawal of an application from issue after payment of the issue fee may not be effective to avoid publication of application information.
49	1.314 Issuance of patent	“If applicant timely pays the issue fee , the Office will issue the patent in regular course unless the application is withdrawn from issue (§ 1.313) or the Office defers issuance of the patent.”
50	1.316 Application abandoned for failure to pay issue fee.	(a) If the issue fee is not paid within three months from the date of the notice of allowance , the application will be regarded as abandoned. Such an abandoned application will not be considered as pending before the USPTO.

#	Rule in 37 CFR §	Timing requirement and conduct provisions
51	1.321 Statutory disclaimers, including terminal disclaimers.	(a) May be filed at any time after a patent has been granted. (b) May be filed at any time while an application is pending and before the patent is granted. (c) Must be filed during pendency of the application or during the reexamination proceeding in which a judicially created double patenting rejection exists. (d) Must be filed during pendency of the application or during the reexamination proceeding in which the double patenting rejection based on a joint research agreement arises.
52	1.322 Certificate of correction of Office mistake	(a) May be filed at any time after a patent has been granted.
53	1.324 Correction of inventorship in patent, pursuant to 35 U.S.C. 256	(a) The Director may, on application of all the parties and assignees, or on order of a court before which such matter is called in question, issue a certificate naming only the actual inventor or inventors.
54	1.325 Other mistakes not corrected.	“Mistakes other than those provided for in §§ 1.322 , 1.323 , 1.324 , and not affording legal grounds for reissue or for reexamination, will not be corrected after the date of the patent. ”

#	Rule in 37 CFR §	Timing requirement and conduct provisions
55	1.362 Time for payment of maintenance fees	(a) The maintenance fee is due at 3 years and 6 months, 7 years and 6 months, and 11 years and 6 months after the date of grant of the patent. (b) Payment of a maintenance fee may be made without surcharge during the 6-month period beginning on each of the due dates specified in subsection (a). (c) Payment may still be made with a surcharge during the 6-month grace period immediately following the due date set in subsection (a). (d) No maintenance fee may be accepted after the expiration of 6-month grace period following the due date.
56	1.366 Submission of maintenance fees.	(a) Maintenance fees must be submitted within the time periods set forth in § 1.362. (c) A maintenance fee payment received before the window specified in § 1.362 will not be accepted; payments may only be made during the 6-month period beginning on each due date. (f) If payment is made during the 6-month grace period after the due date, the required surcharge must be submitted at the same time.
57	1.377 Review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of patent	(a) A petition to accept a delayed payment of a maintenance fee under 35 U.S.C. 41(c)(1) must be filed after expiration of the 6-month grace period following the maintenance fee due date and before the patent has expired for failure to pay the fee is considered unavoidable. (b) The petition must be filed within two months of the action complained of (or within such other time as may be set in the action).

#	Rule in 37 CFR §	Timing requirement and conduct provisions
58	1.378 Acceptance of delayed payment of maintenance fee in expired patent to reinstate patent.	(a) A petition to accept a delayed maintenance fee payment must be filed within two years from the patent's expiration date. (b) A petition to accept an unintentionally delayed maintenance fee payment must be filed within two years from the patent's expiration date. (d) A petition for reconsideration of a decision refusing to accept a delayed maintenance fee payment must be filed within two months of the decision, or within such other time as set in the decision.
59	1.495 Entering the national stage in the United States of America.	(b) Must be filed within 30 months from the priority date to prevent abandonment of the international application as to the United States. (c) If the requirements of paragraph (b) are timely fulfilled but certain documents (e.g., translation, oath or declaration) are omitted, the applicant will be notified and given a period of time to correct the deficiency. This period is usually 2 months from the date of the notification or 32 months from the priority date, whichever is later. This period may be extended for up to 5 additional months pursuant to § 1.136(a). Failure to timely file the proper reply will result in abandonment of the national stage application. (h) An international application becomes abandoned as to the United States 30 months from the priority date if the requirements of paragraph (b) have not been complied with within 30 months from the priority date.
60	1.497 Inventor's oath or declaration under 35 U.S.C. 371(c)(4)	Filing the inventor's oath or declaration under § 1.497 must be when entering the national stage under 35 U.S.C. 371 pursuant to § 1.495.

#	Rule in 37 CFR §	Timing requirement and conduct provisions
61	1.501 Citation of prior art and written statements in patent files.	(a) A written submission may be filed at any time during the period of enforceability of a patent . (c) If a reexamination proceeding has been requested and is pending for the patent in which the submission is filed, entry of the submission into the official file of the patent is subject to the provisions of §§ 1.502 and 1.902.
62	1.502 Processing of prior art citations during an ex parte reexamination proceeding	Citations by the patent owner under § 1.555 and by an ex parte reexamination requester under either § 1.510 or § 1.535 will be entered in the reexamination file during a reexamination proceeding . The entry in the patent file of citations submitted after the date of an order to reexamine pursuant to § 1.525 by persons other than the patent owner, or an ex parte reexamination requester under either § 1.510 or § 1.535 , will be delayed until the reexamination proceeding has been concluded by the issuance and publication of a reexamination certificate.
63	1.510 Request for ex parte reexamination	(a) A request for ex parte reexamination may be filed at any time during the period of enforceability of a patent . (c) If the request does not include the required fee and all required elements, the requester is given a specified time to complete the request ; failure to comply results in no filing date being granted. (d) The filing date of the request is the date on which all requirements of the section are satisfied .
64	1.515 Determination of the request for ex parte reexamination.	(a) An examiner must determine whether a substantial new question of patentability is raised by the request and prior art within three months following the filing date of the request. (c) The requester may seek review by petitioning the Director under § 1.181 within one month of the mailing date of the examiner's determination refusing reexamination.

#	Rule in 37 CFR §	Timing requirement and conduct provisions
65	1.520 Ex parte reexamination at the initiative of the Director	The Director, at any time during the period of enforceability of a patent , may determine whether or not a substantial new question of patentability is raised by patents or printed publications
66	1.525 Order for ex parte reexamination	(b) “ The notice published in the Official Gazette under § 1.11(c) will be considered to be constructive notice and ex parte reexamination will proceed.”
67	1.530 Statement by patent owner in ex parte reexamination; amendment by patent owner in ex parte or inter partes reexamination; inventorship change in ex parte or inter partes reexamination.	(b) The order for ex parte reexamination will set a period of not less than two months from the date of the order within which the patent owner may file a statement on the new question of patentability, including any proposed amendments the patent owner wishes to make. (e) Whenever there is an amendment to the claims , the patent owner must supply, on pages separate from the pages containing the changes, the status (i.e., pending or canceled) of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes to the claims made by the amendment paper. (j) No amendment may be proposed for entry in an expired patent . Moreover, no amendment, other than the cancellation of claims, will be incorporated into the patent by a certificate issued after the expiration of the patent .
68	1.535 Reply by third party requester in ex parte reexamination.	(a) A reply by the third-party requester to the patent owner’s statement under § 1.530 must be filed within two months from the date of service of the patent owner’s statement.

#	Rule in 37 CFR §	Timing requirement and conduct provisions
69	1.540 Consideration of responses in ex parte reexamination	(a) The failure to timely file or serve the documents set forth in §§ 1.530 or 1.535 may result in their being refused consideration.
70	1.550 Conduct of ex parte reexamination proceedings	(b) Patent owner has at least 30 days to respond to any Office action. (c)(2) Requests for extensions must be filed on or before the day action is due. (c)(3) Extensions may be requested no later than two months from the expiration of the original period. (c)(4) Replies or other actions must be filed prior to the expiration of the extension period. (d) Failure to respond timely terminates the prosecution. (e) Late responses may be revived by petition if the delay was unintentional. (h) Third-party submissions after the order must comply with § 1.501(a).
71	1.555 Information material to patentability in ex parte reexamination and inter partes reexamination proceedings.	(a) An Information Disclosure Statement (IDS) should be filed within two months of the date of the order for reexamination, or as soon thereafter as possible.
72	1.560 Interviews in ex parte reexamination proceedings	(a) Interviews for discussion of patentability will not be conducted prior to the first official action. (b) A written statement of the reasons presented at an interview must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.

#	Rule in 37 CFR §	Timing requirement and conduct provisions
73	1.565 Concurrent office proceedings which include an ex parte reexamination proceeding	(c) When a new ex parte reexamination is ordered while a prior ex parte reexamination proceeding is pending and prosecution in the prior proceeding has not been terminated, the proceedings may be merged. (d) When a reissue application and an ex parte reexamination proceeding are pending concurrently, a decision will be made to merge or suspend one. (e) If a patent is involved in an interference during ex parte reexamination, the Director may suspend the reexamination or the interference.
74	1.601 Filing of papers in supplemental examination.	(c) “A request for supplemental examination of a patent may be filed at any time during the period of enforceability of the patent. ”
75	1.610 Content of request for supplemental examination	(d) If the request is noncompliant, the patent owner will be notified and given an opportunity to complete the request within a specified time.
76	1.620 Conduct of supplemental examination proceeding	(a) The Office will determine whether a substantial new question of patentability is raised within three months after the filing date of a request for supplemental examination. (d) The patent owner must notify the Office as soon as possible upon the discovery of any other prior or concurrent post-patent Office proceeding involving the patent.

#	Rule in 37 CFR §	Timing requirement and conduct provisions
77	1.625 Conclusion of supplemental examination; publication of supplemental examination certificate; procedure after conclusion	(a) The Office will determine whether a substantial new question of patentability is raised within three months after the filing date of a request for supplemental examination. (b) If a substantial new question is raised, ex parte reexamination will be ordered, and an ex parte reexamination certificate will be published upon conclusion of the reexamination proceeding.
78	1.701 Extension of patent term due to examination delay under the Uruguay Round Agreements Act (original applications, other than designs, filed on or after June 8, 1995, and before May 29, 2000).	(c)(3)(i) Time during the period of appellate review that occurred before three years from the filing date of the first national application for patent presented for examination. (c)(3)(ii) Time during the period of appellate review during which the applicant for patent did not act with due diligence. (d)(1) Time during the period of appellate review that occurred before three years from the filing date of the first national application for patent presented for examination. (d)(2) Time during the period of appellate review during which the applicant for patent did not act with due diligence.

#	Rule in 37 CFR §	Timing requirement and conduct provisions
79	1.702 Grounds for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999 (original applications, other than designs, filed on or after May 29, 2000)	(a)(1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the application filing date. (a)(2) Respond to a reply under 35 U.S.C. 132 or to an appeal under 35 U.S.C. 134 not later than four months after the reply or appeal is filed.
80	1.703 Period of adjustment of patent term due to examination delay	(a)(1) Period begins the day after fourteen months from the application filing date and ends on the date of mailing of an action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151. (a)(2) Period begins the day after four months from the date a reply under § 1.111 was filed and ends on the date of mailing of an action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151. (e) Period begins on the date jurisdiction over the application passes to the Patent Trial and Appeal Board under § 41.35(a) and ends on the date of a final decision in favor of the applicant by the Board or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145.

#	Rule in 37 CFR §	Timing requirement and conduct provisions
81	1.704 Reduction of period of adjustment of patent term	(c)(11) Failure to file an appeal brief in compliance with § 41.37 within three months from the date on which a notice of appeal to the Patent Trial and Appeal Board was filed under 35 U.S.C. 134 and § 41.31. (c)(12) Submission of a request for continued examination under 35 U.S.C. 132(b) after any notice of allowance under 35 U.S.C. 151 has been mailed. (c)(13) Failure to provide an application in condition for examination as defined in paragraph (f) of this section within eight months from either the date on which the application was filed under 35 U.S.C. 111(a) or the date of commencement of the national stage under 35 U.S.C. 371(b) or (f) in an international application.
82	1.705 Patent term adjustment determination	(b) Request for reconsideration must be filed within two months of patent grant, extendible under § 1.136(a). (c) Request for reinstatement must be filed before patent issuance, not extendible.
83	1.710 Patents subject to extension of the patent term	(a) Patent term extension must be requested within 60 days after the product receives regulatory approval.
84	1.720 Conditions for extension of patent term	(f) Application for extension must be submitted within 60 days after the product first received permission for commercial marketing or use under the applicable law. (g) Patent term, including any interim extension, must not have expired before submission of an application in compliance with § 1.741. (h) No other patent term has been extended for the same regulatory review period for the product

#	Rule in 37 CFR §	Timing requirement and conduct provisions
85	1.740 Formal requirements for application for extension of patent term; correction of informalities	(a)(5) Application must be submitted within the 60-day period permitted under § 1.720(f), identifying the last day on which it could be submitted. (c) If the application is informal, applicant has two months from the notice date to correct informality; this period may be extended under § 1.136.
86	1.741 Complete application given a filing date; petition procedure	(b) Contains a two-month period for certain corrective actions after notice from the USPTO.
87	1.750 Determination of eligibility for extension of patent term	(a) Any request for a certificate of extension must be filed within 2 months after receiving the notice of allowance or final determination from the Office. (b) If the request is incomplete or informal, the applicant has 2 months from the notice to correct it; this period may be extended under § 1.136.
88	1.760 Interim extension of patent term under 35 U.S.C. 156(e)(2)	(a) Any request for an interim extension should be filed at least three months prior to the expiration date of the patent.
89	1.765 Duty of disclosure in patent term extension proceedings	(b) Applicant must submit any additional information or corrections within 2 months of receiving notice from the Office that such submission is required; this period may be extended under § 1.136.

#	Rule in 37 CFR §	Timing requirement and conduct provisions
90	1.770 Express withdrawal of application for extension of patent term	An application for patent term extension may be expressly withdrawn before the Office makes a determination under § 1.750, and may not be withdrawn after the date permitted for reply to the final determination.
91	1.775 Calculation of patent term extension for a human drug, antibiotic drug, or human biological product.	(c)(1)–(2) The regulatory review period begins on the date the applicable exemption became effective and ends on the date the application was approved. (d)(5)(i) For patents issued after September 24, 1984, add five years to the original expiration date (or to any earlier terminal disclaimer date) and use the earlier resulting date. (d)(6)(i)(A) For patents issued before September 24, 1984, and with no exemption request before that date, add five years to the original expiration date (or to any earlier terminal disclaimer date) and use the earliest resulting date.

#	Rule in 37 CFR §	Timing requirement and conduct provisions
92	1.776 Calculation of patent term extension for a food additive or color additive	(c)(1) The regulatory review period begins on the date a major health or environmental effects test on the additive was initiated. (c)(2) The regulatory review period ends on the date a petition for regulation was submitted and then the date the regulation became effective or objections resolved and commercial marketing permitted. (d)(3) Extension may be calculated by adding 14 years to the date when the regulation for use of the product became effective (or objections resolved and marketing permitted). (d)(5)(i) If the original patent was issued after September 24, 1984: add 5 years to the original expiration date (or earlier terminal disclaimer date) and compare to another determined date, selecting the earlier. (d)(6)(i)(A) If the original patent was issued before September 24, 1984 and no test or petition before that date: add 5 years to the original expiration date (or earlier terminal disclaimer date) and compare to another determined date, selecting the earlier. (d)(6)(ii)(A) If the original patent was issued before September 24, 1984 and a test or petition was submitted by that date but marketing was not approved before that date: add 2 years to the original expiration date (or earlier terminal disclaimer date) and compare to another determined date, selecting the earlier.

#	Rule in 37 CFR §	Timing requirement and conduct provisions
93	1.777 Calculation of patent term extension for a medical device.	(c)(1)–(2) The regulatory review period begins when a human clinical investigation on the device is begun and ends when the device application is approved or the protocol declared completed. (d)(3) Add 14 years to the date of application approval or protocol completion. (d)(5)(i) For patents issued after September 24, 1984, add 5 years to the original expiration date and select the earlier of that or the date determined under (d)(4). (d)(6)(i)(A) For patents issued before September 24, 1984 with no investigation before that date, add 5 years to the original expiration date and select the earlier of that or the date determined under (d)(4). (d)(6)(ii)(A) For patents issued before September 24, 1984 where the investigation started before that date but approval was not before that date, add 2 years to the original expiration date and select the earlier of that or the date determined under (d)(4).

#	Rule in 37 CFR §	Timing requirement and conduct provisions
94	1.778 Calculation of patent term extension for an animal drug product	(c)(1)–(2) The regulatory review period begins on the earlier of the date a major health or environmental-effects test is initiated or an exemption becomes effective, and ends when the drug application is approved. (d)(3) Add 14 years to the date of drug application approval. (d)(5)(i) For patents issued after November 16, 1988, add 5 years to the original expiration date and select the earlier date of that or the date determined under (d)(4). (d)(6)(i)(A) For patents issued before November 16, 1988 with no relevant test or exemption request before that date, add 5 years to the original expiration date and select the earlier of that or the date determined under (d)(4). (d)(6)(ii)(A) For patents issued before November 16, 1988 where the test or exemption request was before that date but marketing was not approved before that date, add 3 years to the original expiration date and select the earlier of that or the date determined under (d)(4).

#	Rule in 37 CFR §	Timing requirement and conduct provisions
95	1.779 Calculation of patent term extension for a veterinary biological product	(c)(1)–(2) The regulatory review period begins when authority to prepare the experimental biological product became effective and ends when the license application is submitted, and then from submission to license issuance. (d)(3) Add 14 years to the date of license issuance. (d)(5)(i) For patents issued after November 16, 1988, add 5 years to the original expiration date and select the earlier of that or the date determined under (d)(4). (d)(6)(i)(A) For patents issued before November 16, 1988 with no request before that date, add 5 years to the original expiration date and select the earlier of that or the date determined under (d)(4). (d)(6)(ii)(A) For patents issued before November 16, 1988 where a request was submitted before that date but marketing or use was not approved before that date, add 3 years to the original expiration date and select the earlier of that or the date determined under (d)(4)
96	1.785 Multiple applications for extension of term of the same patent or of different patents for the same regulatory review period for a product.	(d) A request to the applicant to supply identification of the regulatory-approval holder must be answered within a non-extendable period of not less than one month. Failure to provide such information within the period for reply set shall be regarded as conclusively establishing that the applicant is not the holder of the regulatory approval.

#	Rule in 37 CFR §	Timing requirement and conduct provisions
97	1.790 Interim extension of patent term under 35 U.S.C. 156(d)(5)	(c)(1) The initial application for interim extension must be filed during the period beginning 6 months and ending 15 days before the patent term is due to expire. (d)(1) Each subsequent application for interim extension must be filed during the period beginning 60 days before and ending 30 days before the expiration of the preceding interim extension.
98	1.791 Termination of interim extension granted prior to regulatory approval of a product for commercial marketing or use	(a) Any interim extension granted under 35 U.S.C. 156(d)(5) terminates at the end of the 60-day period beginning on the date on which the product involved receives permission for commercial marketing or use. (b) If, within that 60-day period , the patent owner or its agent files an application for extension under §§ 1.740 and 1.741, including any additional information required under 35 U.S.C. 156(d)(1) not contained in the application for interim extension, the patent shall be further extended in accordance with the provisions of 35 U.S.C. 156.
99	1.804 Time of making an original deposit.	(a) An original deposit of biological material may be made at any time before filing the application for patent or, subject to § 1.809, during pendency of the application for patent. (b) When the original deposit is made after the effective filing date of an application for patent , the applicant must promptly submit a statement from a person in a position to corroborate the fact, stating that the biological material which is deposited is a biological material specifically identified in the application as filed.

#	Rule in 37 CFR §	Timing requirement and conduct provisions
100	1.805 Replacement or supplement of deposit	(a) A depositor must notify the USPTO in writing during the pendency of an application for patent, reissue patent, or reexamination proceeding if the depository cannot furnish samples of the deposit or if the deposit has become contaminated or lost its capability to function as described in the specification. (b) A request for a certificate of correction under this section must be made promptly after the replacement or supplemental deposit has been made.
101	1.806 Term of deposit	(a) A deposit made before or during the pendency of a patent application must be maintained for at least 30 years from the date of deposit and at least 5 years after the most recent request for a sample was received by the depository..
102	1.807 Viability of deposit	(a) A deposit must be viable at the time of deposit and during the term of deposit. (b) If a viability test indicates that the deposit is not viable upon receipt, or the examiner cannot accept the statement of viability, the examiner shall proceed as if no deposit has been made.
103	1.808 Furnishing of samples	(a)(1) Access to the deposit must be available during the pendency of the patent application that refers to the deposit. (a)(2) Upon patent grant, all restrictions on the availability of the deposit are irrevocably removed. (a)(3) After issuance, access must continue for the enforceable life of the patent. (b)(3) The depository must notify the depositor in writing of the date on which the sample was furnished and the identity of the recipient.

#	Rule in 37 CFR §	Timing requirement and conduct provisions
104	1.809 Examination procedures	(a) When a deposit of biological material is necessary for compliance with 35 U.S.C. 112, the deposit must be made before or during pendency of the application. (b) If the deposit is made after the filing date of the application, the applicant must submit a statement promptly that the material deposited is the same as that originally described. (c) The examiner may require evidence of the deposit's viability or details concerning its accessibility at any time during examination. (d) Any replacement or supplemental deposit required during examination must be made within a time period set by the Office in the notice or requirement. (e) Failure to make a required deposit or to respond within the set period results in abandonment of the application.
105	1.821 Nucleotide and/or amino acid sequence disclosures in patent applications	(g) If any of the requirements of paragraphs (b) through (e) are not satisfied at the time of filing under 35 U.S.C. 111(a) or at the time of entering the national stage under 35 U.S.C. 371, the applicant will be notified and given a period of time within which to comply with such requirements. (h) If any of the requirements of paragraph (e)(3) are not satisfied at the time of filing an application under the PCT and the application is to be searched or examined by the United States authority, the applicant may be sent a notice requiring compliance within a prescribed time period.
106	1.825 Amendments to add or replace a "Sequence Listing" and CRF copy thereof	(c) For non-international applications, if a "Sequence Listing" is submitted as an ASCII plain text file without incorporation by reference, the specification must be amended on the application filing date to include a paragraph incorporating the material by reference in accordance with § 1.77(b)(5). International applications are exempt from this requirement during the international and national stages.

#	Rule in 37 CFR §	Timing requirement and conduct provisions
107	1.835 Amendment to add or replace a “Sequence Listing XML” in patent applications filed on or after July 1, 2022.	(d) If any of the requirements of §§ 1.831 through 1.834 are not satisfied in an application under 35 U.S.C. 111(a) or in a national stage application under 35 U.S.C. 371, the applicant will be notified and given a period of time within which to comply with such requirements in order to prevent abandonment of the application.
108	1.1052 Conversion to a design application under 35 U.S.C. chapter 16	(a) Petition to convert must be filed prior to publication of the international registration under Article 10(3). (b) Decision granting the petition is effective to convert the application if issued prior to transmittal of the international design application to the International Bureau under § 1.1045
109	5.1 Applications and correspondence involving national security	(d) Applicant: the Office will set a time period within which the application must be de-classified , be placed under a secrecy order, or the applicant must submit evidence of a good faith effort to obtain a secrecy order to prevent abandonment. (e) Application: will not be published at least until six months from its filing date or three months from the date the application was referred to a defense agency, whichever is later.
110	5.2 Secrecy order	(a) Office: must refer any application or document disclosing subject matter under § 5.1(b) to the appropriate defense agencies promptly after filing. (b) Defense agency: must make recommendations promptly regarding the need for a secrecy order after receiving the referral.

#	Rule in 37 CFR §	Timing requirement and conduct provisions
111	5.3 Prosecution of application under secrecy orders; withholding patent	(a) Action on the application and prosecution will proceed during the time the application is under secrecy order to the point indicated in this section; appeals will not be set for hearing until the secrecy order is removed. (b) An interference will not be declared and the Office will not act on any suggestion of interference while the application remains under secrecy order. (c) When the application is in condition for allowance except for the secrecy order, the applicant and the agency will be notified and the application will remain suspended until the secrecy order is removed; upon removal the Office will issue a notice of allowance or take other warranted action. (d) International applications under secrecy order will not be mailed, delivered, or otherwise transmitted to international authorities or the applicant and will be processed only up to the point indicated in this section while under the secrecy order.
112	5.4 Petition for rescission of secrecy order	(d) Party appealing: must take appeal within sixty days from the date of denial of the petition for rescission of the secrecy order; both the appellant and the agency that caused the order to be issued are notified of the time and place of hearing.
113	5.11 License for filing in, or exporting to, a foreign country an application on an invention made in the United States or technical data relating thereto	(a) A person must obtain a license before filing abroad if a U.S. application on the invention was filed less than six months earlier or if no U.S. application has been filed. (c) Technical data may be exported without a license only when a U.S. application has been on file for at least six months without a secrecy order. (e)(2) A license is unnecessary when the corresponding U.S. application was filed at least six months before the foreign filing and is not under secrecy order. (f) The Office may revoke a license at any time by written notice, including authorization that arose from the passage of six months following the U.S. filing.

#	Rule in 37 CFR §	Timing requirement and conduct provisions
114	5.15 Scope of license	(c) A petition to change a license's scope becomes effective on the date the petition is granted. (e) Any paper filed abroad after filing the foreign application that changes the general nature of the disclosure or discloses additional subject matter (when no §5.12(a) license was granted after the U.S. filing) must be separately licensed. (g) A license does not apply to acts performed before the license is granted.
115	5.25 Petition for retroactive license	(a) A petition must include the countries and dates of unlicensed foreign filings and a verified statement that the subject matter was not under a secrecy order at the time of filing abroad and is not currently under one, and that the license was diligently sought after discovery. (b) The explanation must contain facts covering the period leading up to and including each proscribed foreign filing, supported by statements and documents. (c) If the petition is denied, a renewal must be filed within a time period of not less than thirty days; failure to renew within that period makes the denial final, and a petition under § 1.181 must be filed within two months of the denial to avoid final rejection
116	11.4 Computing time.	(a) The time period begins the day after the triggering event. (b) The period runs continuously, counting every day including weekends and legal holidays. (c) The period ends on the final day, unless that day is a Saturday, Sunday, or legal holiday, in which case it extends to the next business day.

#	Rule in 37 CFR §	Timing requirement and conduct provisions
117	11.18 Signature and certificate for correspondence filed in the Office.	(a) All correspondence filed by a practitioner must bear their personal signature, in compliance with §1.4(d) or §2.193(a), unless the correspondence is required to be signed by the applicant or party. (b) By signing, filing, submitting, or later advocating any paper before the USPTO or a hearing officer, the party certifies that: (1) All statements are truthful, and false or fraudulent submissions may result in criminal penalties under 18 U.S.C. 1001. (2) After reasonable inquiry, the filer believes that— (i) The paper is not submitted for improper purposes (e.g., harassment, delay, or cost inflation); (ii) Legal contentions are supported by existing law or good-faith arguments for legal change; (iii) Factual contentions have or are likely to obtain evidentiary support; and (iv) Factual denials are reasonably based on evidence or lack of information. (c) If these certifications are violated, and after notice and opportunity to respond, the USPTO Director may impose sanctions such as striking papers, referring conduct for discipline, precluding submissions, reducing evidentiary weight, or terminating proceedings. (d) Practitioners violating this rule may also face disciplinary action.
118	11.103 Diligence	“A practitioner shall act with reasonable diligence and promptness in representing a client.”

#	Rule in 37 CFR §	Timing requirement and conduct provisions
119	41.3 Petitions	(e)(1)(i) A party must file a petition within 14 days from the date of the action for which relief is sought. (e)(1)(ii) A party must file any request for reconsideration within 14 days of the petition decision, unless the Board sets another time.
120	41.4 Timeliness	(a) Extensions of time may be granted only upon a showing of good cause, unless another rule provides otherwise. (b)(1) A late filing causing abandonment or termination may be revived under § 1.137. (b)(2) A late filing not causing abandonment or termination may be excused upon a showing of excusable neglect or if the Board finds that consideration on the merits would be in the interest of justice.
121	41.8 Mandatory notices	(a) A party must identify its real party-in-interest and related proceedings in the appeal brief or at the initiation of a contested case, and within 20 days of any change during the proceeding. (b) A party seeking judicial review of a Board proceeding must file a notice with the Board within 20 days of filing the complaint or notice of appeal, including a copy of that complaint or notice.

#	Rule in 37 CFR §	Timing requirement and conduct provisions
122	41.31 Appeal to Board	(a)(1) An applicant whose claims have been twice rejected must file a notice of appeal and pay the required fee within the time period provided under § 1.134 for reply. (a)(2) A patent owner in an ex parte reexamination filed before November 29, 1999, whose claims have been twice rejected, must file a notice of appeal and pay the fee within the § 1.134 reply period. (a)(3) A patent owner in an ex parte reexamination filed on or after November 29, 1999, whose claims have been finally rejected, must file a notice of appeal and pay the fee within the § 1.134 reply period. (d) The time periods in (a)(1)–(a)(3) are extendable under § 1.136 for applications and § 1.550(c) for reexaminations.
123	41.33 Amendments and affidavits or other Evidence after appeal	(a) Amendments filed after the notice of appeal but before the appeal brief may be admitted under § 1.116. (b) Amendments filed on or after the date the appeal brief is filed may be admitted only to cancel claims (without affecting others) or to rewrite dependent claims as independent. (c) All other amendments filed after the notice of appeal will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i), and 41.50(b)(1). (d)(1) Affidavits or other evidence filed after the notice of appeal but before the appeal brief may be admitted only if they overcome all rejections and good cause is shown for the delay. (d)(2) All other affidavits or other evidence filed after the notice of appeal will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i), and 41.50(b)(1).

#	Rule in 37 CFR §	Timing requirement and conduct provisions
124	41.35 Jurisdiction over appeal	(a) Jurisdiction passes to the Board upon the filing of a reply brief under § 41.41 or upon the expiration of the time to file such a reply brief, whichever is earlier. (b)(1) Jurisdiction ends when the Director or the Board enters a remand order. (b)(2) Jurisdiction ends when the Board enters a final decision and when judicial review is sought or the time for seeking judicial review has expired. (b)(3) Jurisdiction ends when an express abandonment complying with § 1.138 is recognized. (b)(4) Jurisdiction ends when a request for continued examination complying with § 1.114 is filed. (b)(5) Jurisdiction ends when appellant fails to take any required action under §§ 41.39(b), 41.50(a)(2), 41.50(b), or 41.50(d) and the Board enters an order of dismissal. (b)(6) Jurisdiction ends when appellant reopens prosecution pursuant to § 41.40(b) or in response to a new ground of rejection entered in a Board decision. (c) The Director may order the proceeding remanded prior to the Board's entry of a decision on the appeal. (d) Any information disclosure statement or petition filed while the Board possesses jurisdiction will be held in abeyance until the Board's jurisdiction ends. (e) If, after receipt and review of the proceeding, the Board determines the file is incomplete or noncompliant, the Board may relinquish jurisdiction or take other action to permit completion.

#	Rule in 37 CFR §	Timing requirement and conduct provisions
125	41.37 Appeal brief	(a) File brief within two months of notice of appeal filing. (b) Failure to file brief within period specified in (a) results in appeal dismissal. (d) Non-compliant brief filing results in notification and a new time period for amended brief; otherwise, appeal is dismissed. (e) Time periods are extendable under § 1.136 for patent applications and § 1.550(c) for ex parte reexamination proceedings.
126	41.39 Examiner's answer	(a) The examiner may furnish a written answer within such time as the Director may set. (b) The appellant must respond within two months of an examiner's answer containing a new rejection ground or risk the appeal being dismissed for the affected claims. (c) Time extensions for the two-month period in (b) are available only under specific conditions (§ 1.136(b) or § 1.550(c)).
127	41.40 Tolling of time period to file a reply brief	(a) Petition requesting review of examiner's failure to designate a rejection as new must be filed within two months of the examiner's answer and before filing a reply brief. (b) If a petition is granted, the appellant must file a reply to reopen prosecution within a two-month period. (c) If a petition is not granted, the appellant has a two-month period to file a single reply brief. (d) Filing a reply brief within two months of the examiner's answer and after filing a petition but before a decision on the petition acts as a withdrawal of the petition. (e) Extensions of time are not available under § 1.136(a) for the periods in this section, but are available under § 1.136(b) or § 1.550(c)

#	Rule in 37 CFR §	Timing requirement and conduct provisions
128	41.41 Reply brief	(a)(1) A single reply brief may be filed as a matter of right within two months from either the examiner's answer or the decision refusing the § 41.40 petition, whichever is later. (a)(2) If no new ground of rejection is made and a reply brief is not filed within the two-month period, the appeal will be forwarded to the Board. (a)(3) The appellant must file a reply brief within two months of a supplemental examiner's answer to a Board remand. (c) The time for filing a reply brief cannot be extended under § 1.136(a) but is extendable under § 1.136(b) for patent applications and § 1.550(c) for ex parte reexamination proceedings
129	41.45 Appeal forwarding fee	(a) The appeal forwarding fee must be paid within two months from the later of the examiner's answer or a decision on a § 1.181 petition concerning a new ground of rejection in the answer. (b) Failure to pay the appeal forwarding fee within the specified time will result in dismissal of the appeal. (c) The time period for payment is not extendable under § 1.136(a) but is extendable under § 1.136(b) for patent applications and § 1.550(c) for ex parte reexamination proceedings
130	41.47 Oral hearing	(b) An appellant desiring an oral hearing must file a written request and pay the fee within two months of the examiner's answer date or the reply brief filing date, whichever is earlier. (c) If no request and fee are timely filed, the appeal proceeds without an oral hearing. (d) If a timely request is made, a hearing date will be set with due notice. (g) Extensions of time for the periods in this rule are not available under § 1.136(a) for patent applications, but are available under § 1.136(b) or § 1.550(c)

#	Rule in 37 CFR §	Timing requirement and conduct provisions
131	41.50 Decisions and other actions by the Board	(a)(2) Within two months of a supplemental examiner's answer on remand, the appellant must choose to reopen prosecution or maintain the appeal via a reply brief. (b) Within two months of a Board decision designating a new ground of rejection, the appellant must either reopen prosecution before the examiner or request a rehearing by the Board. (d) The Board may set a time period for additional briefing or information, and failure to timely comply may result in dismissal. (e) A remand decision is not final for judicial review until post-remand proceedings conclude and the Board issues an order making it final. (f) The time limits cannot be extended under § 1.136(a) but are extendable under § 1.136(b) or § 1.550(c).
132	41.52 Rehearing	(a)(1) A single request for rehearing may be filed within two months of the Board's original decision. (b) Extensions of time for this section are available only under § 1.136(b) or § 1.550(c), not § 1.136(a).