

§ 1.1

37 CFR Ch. I (7-1-03 Edition)

PATENT OWNER APPEAL TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT IN *Inter Partes* REEXAMINATION

1.983 Patent owner appeal to the United States Court of Appeals for the Federal Circuit in *inter partes* reexamination.

CONCURRENT PROCEEDINGS INVOLVING SSAME PATENT IN *Inter Partes* REEXAMINATION

1.985 Notification of prior or concurrent proceedings in *inter partes* reexamination.

1.987 Suspension of *inter partes* reexamination proceeding due to litigation.

1.989 Merger of concurrent reexamination proceedings.

1.991 Merger of concurrent reissue application and *inter partes* reexamination proceeding.

1.993 Suspension of concurrent interference and *inter partes* reexamination proceeding.

1.995 Third party requester's participation rights preserved in merged proceeding.

REEXAMINATION CERTIFICATE IN *Inter Partes* REEXAMINATION

1.997 Issuance of *inter partes* reexamination certificate.

AUTHORITY: 35 U.S.C. 2(b)(2), unless otherwise noted.

SOURCE: 24 FR 10332, Dec. 22, 1959, unless otherwise noted.

EDITORIAL NOTES: 1. In Patent and Trademark Office publications and usage the part number is omitted from the numbers of §§ 1.1 to 1.352 and the numbers to the right of the decimal point correspond with the respective rule numbers.

2. For nomenclature changes to part 1, see 68 FR 14335, Mar. 25, 2003.

Subpart A—General Provisions

GENERAL INFORMATION AND CORRESPONDENCE

§ 1.1 Addresses for correspondence with the United States Patent and Trademark Office.

(a) *In general.* Except as provided in paragraphs (a)(3)(i), (a)(3)(ii) and (d)(1) of this section, all correspondence intended for the United States Patent and Trademark Office must be addressed to either "Director of the United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450" or to specific areas within the Office as set out in paragraphs (a)(1), (a)(2) and (a)(3)(iii) of this

section. When appropriate, correspondence should also be marked for the attention of a particular office or individual.

(1) *Patent correspondence.* (i) *In general.* All correspondence concerning patent matters processed by organizations reporting to the Commissioner for Patents should be addressed to: Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450.

(ii) *Board of Patent Appeals and Interferences: Appeals.* All correspondence in an application involved in an appeal to the Board of Patent Appeals and Interferences during the period beginning when an appeal docketing notice is issued and ending when a decision has been rendered by the Board of Patent Appeals and Interferences, as well as any request for rehearing of a decision by the Board of Patent Appeals and Interferences, should be mailed to: Board of Patent Appeals and Interferences, United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450. Notices of appeal, appeal briefs, reply briefs, requests for oral hearing, as well as all other correspondence in an application involved in an appeal to the Board of Patent Appeals and Interferences for which an address is not otherwise specified, should be addressed as set out in paragraph (a)(1)(i) of this section.

(iii) *Board of Patent Appeals and Interferences: Interferences.* Except as an administrative patent judge or the Board may otherwise direct, all correspondence relating to patent interferences, or relating to patent applications or patents involved in an interference, should be mailed to: Mail Stop INTERFERENCE, Board of Patent Appeals and Interferences, United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450.

(2) *Trademark correspondence.*—(i) *In general.* All trademark-related documents filed on paper, except documents sent to the Assignment Services Division for recordation and requests for copies of trademark documents, should be addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514.

(ii) *Electronic applications.* An applicant may transmit an application for trademark registration electronically,

but only if the applicant uses the Office's electronic form.

(3) *Office of General Counsel correspondence.*—(i) *Litigation and service.* Correspondence relating to pending litigation or otherwise within the scope of part 104 of this title shall be addressed as provided in § 104.2.

(ii) *Disciplinary proceedings.* Correspondence to counsel for the Director of the Office of Enrollment and Discipline relating to disciplinary proceedings pending before an Administrative Law Judge or the Director shall be mailed to: Office of the Solicitor, PO Box 16116, Arlington, Virginia 22215.

(iii) *Solicitor, in general.* Correspondence to the Office of the Solicitor not otherwise provided for shall be addressed to: Mail Stop 8, Director of the United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450.

(iv) *General Counsel.* Correspondence to the Office of the General Counsel not otherwise provided for, including correspondence to the General Counsel relating to disciplinary proceedings, shall be addressed to: General Counsel, United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450.

(v) *Improper correspondence.* Correspondence improperly addressed to a Post Office Box specified in paragraphs (a)(3)(i) and (a)(3)(ii) of this section will not be filed elsewhere in the United States Patent and Trademark Office, and may be returned.

(4) *Office of Public Records correspondence.*—(i) *Assignments.* All patent-related or trademark-related documents to be recorded by Assignment Services Division, except for documents filed together with a new application or under § 3.81 of this chapter, should be addressed to: Mail Stop Assignment Recordation Services, Director of the United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450. See § 3.27.

(ii) *Documents.* All requests for certified or uncertified copies of patent or trademark documents should be addressed to: Mail Stop Document Services, Director of the United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450.

(b) *Patent Cooperation Treaty.* Letters and other communications relating to international applications during the international stage and prior to the assignment of a national serial number should be additionally marked "Mail Stop PCT."

(c) *Reexamination.* Requests for reexamination should be additionally marked "Mail Stop Reexam."

(d) *Maintenance fee correspondence.*—(1) *Payments.* Payments of maintenance fees in patents not submitted electronically should be mailed to: United States Patent and Trademark Office, P.O. Box 371611, Pittsburgh, Pennsylvania 15250-1611.

(2) *Other correspondence.* Correspondence related to maintenance fees other than payments of maintenance fees in patents is not to be mailed to P.O. Box 371611, Pittsburgh, Pennsylvania 15250-1611, but must be mailed to: Mail Stop M Correspondence, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450.

(e) *Patent term extension.* All applications for extension of patent term under 35 U.S.C. 156 and any communications relating thereto intended for the United States Patent and Trademark Office should be additionally marked "Mail Stop Patent Ext." When appropriate, the communication should also be marked to the attention of a particular individual, as where a decision has been rendered.

(f) *Provisional applications.* The filing of all provisional applications and any communications relating thereto should be additionally marked "Mail Stop Provisional Patent Application."

NOTE: Sections 1.1 to 1.26 are applicable to trademark cases as well as to national and international patent cases except for provisions specifically directed to patent cases. See § 1.9 for definitions of "national application" and "international application."

[68 FR 14335, Mar. 25, 2003; 68 FR 19371, Apr. 21, 2003]

§ 1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent