TTAB

# IN THE
# UNITED STATES
# PATENT AND TRADEMARK OFFICE

**IN RE**
**APPLICATION OF:** 401(k) Advisors, Inc.
**CASE:** 110744.014100
**SERIAL NO:** 76/713,315
**FILING DATE:** January 29, 2013
**MARK:** 401 K ADVISORS & Design

**NOTICE OF APPEAL**

COMMISSIONER FOR TRADEMARKS
P.O. Box 1451, Alexandria, VA 22313-1451

ATTENTION OF:
Samuel Paquin
Law Office 101

U.S. Patent and Trademark Office #72

Dear Sir:

If any charges or fees must be paid in connection with the following communication, they may be paid out of our Deposit Account No. 50-2428.

## NOTICE OF APPEAL

Applicant hereby provides notice of intention to appeal, to the Trademark Trial and Appeal Board, from the decision of the Examining Attorney dated March 6, 2014, finally refusing registration of the above-identified trademark.

The appeal fee required in Rule 2.6 is to be paid out of Applicant's Attorneys' Deposit Account No. 50-2428.

09/10/2014 SWILSON1 00000005 502428 76713315
01 FC:6403 100.00 DA

Dated: September 8, 2014

Respectfully submitted,

GREENBERG TRAURIG LLP

Richard D. Harris
One of the Attorneys for Applicant

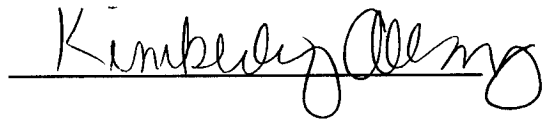
**GREENBERG TRAURIG, LLP**
77 W. Wacker Drive, Suite 2500
Chicago, Illinois 60601
(312) 456-8400

| | | | |
|---|---|---|---|
| Richard D. Harris | 27898 | Richard E. Dick | 27778 |
| Howard E. Silverman | 32492 | Brad R. Bertoglio | 47422 |
| John S. Pacocha | 25197 | Jeffrey P. Dunning | 50686 |
| Douglas B. Teaney | 33459 | Cameron M. Nelson | 55486 |
| Herbert H. Finn | 38139 | Thomas E. Williams | 54735 |
| Mark R. Galis | 36805 | Jeffrey G. Mote | 48791 |
| Gary R. Jarosik | 35906 | | |

## CERTIFICATE OF MAILING

I hereby certify that this NOTICE OF APPEAL is being deposited, pursuant to 37 C.F.R. §1.8, with the United States Postal Service on the date set forth below as First Class Mail, postage pre-paid, in an envelope addressed to Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

Dated: September 9, 2014



IN THE
# UNITED STATES
# PATENT AND TRADEMARK OFFICE

| | |
|---|---|
| **IN RE APPLICATION OF:** | 401(k) Advisors, Inc. |
| **CASE:** | 110744.014100 |
| **SERIAL NO:** | 76/713,315 |
| **FILING DATE:** | January 29, 2013 |
| **TRADEMARK:** | 401 K ADVISORS & Design |

**PETITION TO REINSTATE WORDING UNINTENTIONALLY DELETED FROM APPLICANT'S IDENTIFICATION OF SERVICES**

COMMISSIONER FOR TRADEMARKS
P.O. Box 1451, Alexandria, VA 22313-1451

Attention: Samuel Paquin
Law Office 101

Dear Sir:

Applicant authorizes the Commissioner to charge Applicant's Deposit Account No. 50-2428 the Petition filing fee of $100.00, and any other charges necessitated hereby. If any other charges or fees must be paid in connection with the following communication, they may be paid out of our Deposit Account No. 50-2428.

This Petition To Reinstate Wording Unintentionally Deleted From Applicant's Identification of Services is being filed in response to the Office Action issued on March 6, 2014.

1. On January 29, 2013, Applicant filed the instant application through paper correspondence sent via the United States Postal Service (USPS). The application, as filed, included payment for, and listed services in, two international classes—Class 35 and Class 36—setting forth the following identification of services:

> --BUSINESS CONSULTATION SERVICES FOR FINANCIAL ORGANIZATIONS IN THE FIELDS OF BUSINESS PORTFOLIO MANAGEMENT, ANALYZING AND COMPILING DATA FOR MEASURING THE PERFORMANCE OF MUTUAL FUNDS, in International Class 35--
>
> and

--CONSULTING SERVICES FOR EMPLOYEE BENEFITS CONCERNING RETIREMENT PLANS; ADVISORY SERVICES IN THE FIELD OF RETIREMENT PLANNING; ADVISORY SERVICES IN THE FIELD OF MUTUAL FUNDS AND SEPARATE RETIREMENT ACCOUNT MANAGEMENT; AND FINANCIAL DUE DILIGENCE SERVICES FOR INVESTMENT PRODUCTS AND MANAGERS, in International Class 36--

2. On May 24, 2013, the Examining Attorney issued the first Office Action. Since Applicant filed the Office Action using paper correspondence sent via the USPS, the Office Action likewise issued in paper form, which was mailed to the undersigned. In the Office Action, the Examining Attorney asserted that "[t]he wording 'advisory services in the field of retirement planning' **in Class 36** is indefinite and overbroad because it might apply to services in other classes." (Office Action, at p. 5 (emphasis added).) Accordingly, the Examining Attorney recommended that Applicant adopt the following amendment for that particular wording, if accurate: "**financial** advisory services in the field of retirement planning" in Class 36. (*Id.*)

3. On November 27, 2013, Applicant responded to the first Office Action—again, using paper correspondence sent via the USPS. In its Response, Applicant requested that the Examining Attorney amend the identification of the services at issue to read "**financial** advisory services in the field of retirement planning" in International Class 36, and noted "Applicant has revised the identification of services to the wording proposed by the Examining Attorney, which accurately describes Applicant's services, namely, '**financial** advisory services in the field of retirement planning' in International Class 36." (November 27, 2013 Response to Office Action, at p. 1-2.) Immediately before the signature line, the Response stated: "Should anything further be required, a telephone call to the undersigned at (312) 456-8400 is respectfully solicited." (*Id.* at p. 11.)

4. On February 24, 2014, without sending any hard copy notification, and without phoning the undersigned, the Examining Attorney sent an **email** to the undersigned, stating: "I wanted to confirm that you are only seeking to amend the entry '***financial*** advisory services in the field of retirement planning' in Class 36 and not to delete the remaining entries. (*See* Exhibit A, at p. 2.) The Examining Attorney then set

forth the full identification of services as it should have been amended, and then stated: "Otherwise, it appears you are asking to amend the identification of Services to read '***financial*** advisory services in the field of retirement planning' in Class 36 in its entirety." (*Id.* at pp. 2-3.) Despite the clear statement in the Response soliciting a telephone call "should anything further be required," the Examining Attorney did not telephone the undersigned on February 24, or at any other time.

5. On March 6, 2014, upon discovering the email, the undersigned immediately sent an email in response to the Examining Attorney's email, confirming that Applicant merely sought to adopt the Examining Attorney's suggestion of adding the word "financial" before the wording "advisory services in the field of retirement planning" and stating:

> We do not wish to delete any of the remaining entries in the identification of services. As you will recall, your suggestion was to add the word "financial," and we simply intended to follow that specific advice.

(*Id.* at p. 1.) The undersigned then set forth the full, original identification of services, with the addition of the single word "financial," as suggested by the Examining Attorney. (*Id.* at pp. 1-2.)

6. On (Sunday) March 9, 2014, the Examining Attorney responded via email, stating: "Unfortunately, I had to move forward with the final refusals using a plain language reading of the Response to Office Action." (*Id.* at p. 1.) Thus, "[t]he identification of services for both applications has been amended to read 'financial advisory services in the field of retirement planning' in Class 36 in the entirety.

7. The Final Office Action issued on March 6, 2014, on the same day the undersigned responded to the Examining Attorney's earlier email, without Applicant's knowledge of the Final Office Action. Since all official correspondence in this application is in the form of paper sent via the USPS, the undersigned did not receive the hard copy of the Final Office Action until March 10, 2014. The Final Office Action was not emailed to the undersigned.

8. The facts set forth above establish that there existed confusion as to how Applicant intended to amend its identification of services. In an attempt to clarify and resolve that confusion, the Examining Attorney sent an email to the undersigned.

However, despite the explicit request in the Response to Office Action, the Examining Attorney never telephoned the undersigned.

9. Moreover, the Examining Attorney unilaterally set, but did not disclose, an arbitrary deadline by which the undersigned was expected to respond to his email, and then proceeded to resolve that confusion ***against*** Applicant's wishes, against Applicant's broader trademark interests, and to Applicant's financial detriment. Indeed, Applicant rightfully paid an application fee of seven hundred and fifty dollars ($750.00) upon filing this application, in hard copy, no less, and—if the Examining Attorney's unilateral action is allowed to stand—that action, coupled with the failure to telephone counsel or inquire in hard copy, would lead to Applicant's forfeiture of three hundred and seventy-five dollars ($375.00)—the fee for a single class—inasmuch as the Examining Attorney deleted all of the Class 35 services from the instant application without Applicant's approval. Worse yet, the Examining Attorney assumed the illogical—that Applicant would presumably delete the already paid-for and approved Class 35 language. Furthermore, Applicant has now paid yet additional fees relating to the filing of the instant Petition.[1]

10. Prior to February 24, 2014, each and every piece of correspondence relating to the instant application—including the original filing itself, the first Office Action, and Applicant's Response—were filed in the form of hard-copy paper correspondence sent via the USPS. Neither Applicant nor the undersigned **ever** provided any authorization for the Office to communicate with the undersigned using electronic mail. In fact, prior to February 24, 2014, and despite nearly forty years of practicing before the Office, the undersigned cannot recall ever receiving an official communication from the Office via electronic mail where he has filed, and prosecuted, as here, in hard copy.

11. While on occasion, his colleagues have utilized electronic filing on a few of his cases, the undersigned has never himself personally utilized the Trademark Electronic Application System (TEAS). When an applicant decides to forego paper

[1] Applicant notes that the potential forfeiture and additional fees arising from the filing of this Petition are, in fact, doubled, in view of Applicant's contemporaneous prosecution of U.S. Appl. Ser. No. 76/713,314, for a similar 401 K ADVISORS & Design mark, for which the Examining Attorney took the same action.

correspondence in favor of electronic filings, the applicant is specifically required to "opt in" to authorize the Office to communicate with the appointed attorney via email. In preparing a TEAS application, the Office notes that such authorization is in accordance with the Notice in the Federal Register dated June 21, 1999 [Internet Usage Policy, Fed. Reg. Vol. 64, No. 118 (June 21, 1999, pp. 33056-66)] (attached hereto as Exhibit B).

12. Notably, page 33059 of that same Notice explicitly states: "The PTO ***will not require*** an applicant to use Internet e-mail for ***any*** communications ***under any circumstances***." (Exhibit B, at p. 4 (emphases added).) But that is exactly what the Examining Attorney has done here.

13. Further, page 33062 of that same Notice—setting forth Article 6 ("Initiating Internet Communications") of the Trademark Internet Usage Policy also states: "Internet communications will NOT be initiated by the Trademark Organization unless it is authorized to do so by the applicant or the applicant's attorney." (*Id.* at pp. 6-7 (emphasis in original).) Again, that is exactly what happened here: the Examining Attorney initiated email correspondence to the undersigned without the Applicant's or the undersigned's permission. Then, when the undersigned failed to respond by the Examining Attorney's unilaterally-selected, undisclosed deadline, the Examining Attorney acted illogically to minimize Applicant's trademark rights, causing Applicant to lose money invested in this application and forcing Applicant to expend additional money and resources to rectify that action—all because the Examining Attorney did not telephone the undersigned, despite the fact that Applicant's counsel had expressly provided the phone number and requested that he be called if anything further was required.

14. In view of the foregoing, Applicant respectfully submits that it has met all requirements for the Commissioner to grant this Petition and to reinstate the wording unintentionally deleted from Applicant's identification of services. Accordingly, Applicant respectfully requests favorable consideration of this Petition.

Should anything further be required, a telephone call to the undersigned at (312) 456-6610 is respectfully invited.

Respectfully submitted,
GREENBERG TRAURIG, LLP

Dated: September 8, 2014

/Richard D. Harris/
Richard D. Harris,
One of the Attorneys for Applicant

**CERTIFICATE OF FIRST CLASS MAILING**

I hereby certify that this **Petition To Reinstate Wording Unintentionally Deleted From Applicant's Identification of Services** is being deposited on the date listed below with the United States Postal Service as First Class Mail under 37 C.F.R. §1.8, postage prepaid, in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

Dated: September 8, 2014

Kimberly Alvarez

Exhibit A

**Wurst-Otto, Linda (Secy-Chi-IP/Tech)**

**From:** Paquin, Samuel <Samuel.Paquin@USPTO.GOV>
**Sent:** Sunday, March 09, 2014 3:39 PM
**To:** Harris, Richard (Shld-Chi-IP)
**Subject:** RE: 401K ADVISORS Serial Nos. 76713314 & 76713315--Our File No. 110744.013900 and 110744.014100

Dear Mr. Harris,

Unfortunately, I had to move forward with the final refusals using a plain language reading of the Response to Office Action for both applications.

IN THE APPLICATION

Amend the identification of services to read:

FINANCIAL ADVISORY SERVICES IN THE FIELD OF RETIREMENT PLANNING -- International Class 36 --

The identification of services for both applications has been amended to read "financial advisory services in the field of retirement planning" in Class 36 in the entirety.

Please contact me with any additional questions.

Sincerely,
Sam Paquin

SAMUEL R. PAQUIN | TRADEMARK EXAMINING ATTORNEY | U.S. PATENT & TRADEMARK OFFICE | (571) 272-2514

**From:** harrisr@gtlaw.com [mailto:harrisr@gtlaw.com]
**Sent:** Thursday, March 06, 2014 2:08 PM
**To:** Paquin, Samuel
**Cc:** horwitzb@gtlaw.com; wurstottol@gtlaw.com
**Subject:** FW: 401K ADVISORS Serial Nos. 76713314 & 76713315--Our File No. 110744.013900 and 110744.014100

Dear Mr. Paquin:

Thank you for your email below seeking clarification on the amendments responsive to the most recent office actions for U.S. Ser. Nos. 76/713,314 and 76/713,315, each for stylized or design 401K ADVISORS marks, respectively.

We confirm that we only seek to amend the term "advisory services in the field of retirement planning" to the larger phrase "***financial*** advisory services in the field of retirement planning." We do not wish to delete any of the remaining entries in the identification of services. As you will recall, your suggestion was to add the word "financial," and we simply intended to follow that specific advice. Thus, with minor correction to punctuation, you have correctly identified the identification of services, as amended, as follows:

Class 35:

**Business consultation services for financial organizations in the fields of business portfolio management, analyzing and compiling data for measuring the performance of mutual funds**

Class 36:

**Consulting services for employee benefits concerning retirement plans; financial advisory services in the field of retirement planning; advisory services in the field of mutual funds and separate retirement account management; and financial due diligence services for investment products and managers**

Should you have any further comments or questions, please do not hesitate to bring them to our attention.

Best regards,

Rick Harris

**Richard D. Harris**
Shareholder | Intellectual Property
Greenberg Traurig, LLP
77 West Wacker Drive | Suite 3100
Chicago, IL 60601
Tel 312.456.6610 | Fax 312.899.0356
harrisr@gtlaw.com | www.gtlaw.com

GT GreenbergTraurig

**From:** Paquin, Samuel [mailto:Samuel.Paquin@USPTO.GOV]
**Sent:** Monday, February 24, 2014 10:15 AM
**To:** Harris, Richard (Shld-Chi-IP)
**Subject:** 401K ADVISORS Serial Nos. 76713314 & 76713315

Dear Mr. Harris,

I wanted to confirm that you are only seeking to amend the entry "***financial*** advisory services in the field of retirement planning" in Class 36 and not to delete the remaining entries.

The Identification of Services would then be:

Class 35:
business consultation services for financial organizations in the fields of business portfolio management, analyzing and compiling data for measuring the performance of mutual funds

Class 36:
Consulting services for employee benefits concerning retirement plans; ***financial*** advisory services in the field of retirement planning; advisory services in the field of mutual funds and separate retirement account management; and financial due diligence services for investment products and managers

Otherwise, it appears you are asking to amend the Identification of Services to read "***financial*** advisory services in the field of retirement planning" in Class 36 in its entirety.

Please let me know how you would like to proceed. Thank you.

Sincerely,
Sam Paquin

IN THE
UNITED STATES
PATENT AND TRADEMARK OFFICE

| | | |
|---|---|---|
| IN RE APPLICATION OF: | 401(k) Advisors, Inc | |
| CASE: | 110744.010930 | RESPONSE TO OFFICE ACTION |
| SERIAL NO: | 76/713,314 | |
| FILING DATE: | January 29, 2013 | |
| MARK: | 401 K ADVISORS & Design | |

COMMISSIONER FOR TRADEMARKS
P.O. Box 1451
Alexandria, VA 22313-1451

ATTENTION OF
Samuel Paquin
Law Office 101

Dear Sir or Madam:
Fees of $ [illegible] are to be paid in connection with the following communication. They may be paid out of our Deposit Account No. 50-2428.

This is in response to the Office Action mailed May 28, 2013. Please consider the following remarks toward reconsideration, passage to publication and, ultimately, the registration of Applicant's mark.

IN THE APPLICATION

Amend the identification of services to read

--FINANCIAL ADVISORY SERVICES IN THE FIELD OF RETIREMENT PLANNING in International Class 36--

--Applicant's mark has become distinctive with respect to Applicant's services by reason of Applicant's substantially exclusive and continuous use of its stylized design mark in commerce since at least as early as December 2003--

GREENBERG TRAURIG, LLP
77 WEST WACKER DRIVE
SUITE 3100
CHICAGO, ILLINOIS 60601
(312) 456-8400
CUSTOMER NO. 34018

Richard D. Harris
Howard E. Greenhut
Herbert H. [illegible]
Mark R. [illegible]
Gary R. [illegible]
[illegible]
[illegible]
Jeffrey P. [illegible]
[illegible]
[illegible]
[illegible]
[illegible]
[illegible]
[illegible]
[illegible]
[illegible]

IN THE
UNITED STATES
PATENT AND TRADEMARK OFFICE

| | | |
|---|---|---|
| IN RE APPLICATION OF: | 401(k) Advisors, Inc. | |
| CASE: | 110744.014100 | RESPONSE TO OFFICE ACTION |
| SERIAL NO: | 76/713,315 | |
| FILING DATE: | January 29, 2013 | |
| MARK: | 401 K ADVISORS & Design | |

COMMISSIONER FOR TRADEMARKS
P.O. Box 1451
Alexandria, VA 22313-1451

ATTENTION OF
Samuel Paquin
Law Office 101

Dear Sir or Madam:
If any charges or fees must be paid in connection with the following communication, they may be paid out of our Deposit Account No. 50-2428.

This is in response to the Office Action mailed May 28, 2013. Please consider the following remarks toward reconsideration, passage to publication and ultimately the registration of Applicant's mark.

**IN THE APPLICATION**

Amend the identification of services to read:

--FINANCIAL ADVISORY SERVICES IN THE FIELD OF RETIREMENT PLANNING in International Class 36--

**IN THE DRAWING OF THE MARK**

Amend the Drawing to add the following statements:


GREENBERG TRAURIG, LLP
77 WEST WACKER DRIVE
SUITE 3100
CHICAGO, ILLINOIS 60601
(312) 456-8400
CUSTOMER NO. 34018

| | | | |
|---|---|---|---|
| Richard D. Harris | 37895 | Jeffrey J. Mole | 48701 |
| Howard E. Silverman | 33492 | Kevin J. O'Shea | 51241 |
| Nelson S. Fitch | 38139 | Jeffrey P. Dunning | 59686 |
| Mark R. Gale | 38825 | Cameron M. Nelson | 59468 |
| Gary S. Larson | 39906 | Barry R. Hyman | 58438 |



SAMUEL R. PAQUIN | TRADEMARK EXAMINING ATTORNEY | U.S. PATENT & TRADEMARK OFFICE | (571) 272-2514



If you are not an intended recipient of confidential and privileged information in this email, please delete it, notify us immediately at postmaster@gtlaw.com, and do not use or disseminate such information. Pursuant to IRS Circular 230, any tax advice in this email may not be used to avoid tax penalties or to promote, market or recommend any matter herein.

Exhibit B

required to respond to, nor shall any person be subject to a penalty for failure to comply with, a collection of information subject to the requirements of the PRA unless that collection of information displays a currently valid OMB control number.

A solicitation for applications will also appear in the "Commerce Business Daily."

Dated: June 15, 1999.

**Penelope D. Dalton,**

*Assistant Administrator for Fisheries, National Marine Fisheries Service.*

[FR Doc. 99-15723 Filed 6-18-99; 8:45 am]

BILLING CODE 3510-22-F

## DEPARTMENT OF COMMERCE

### National Oceanic and Atmospheric Administration

**[I.D. 060899A]**

### Marine Mammals; File No. P466B

**AGENCY:** National Marine Fisheries Service (NMFS), National Oceanic and Atmospheric Administration (NOAA), Commerce.

**ACTION:** Receipt of application for amendment.

**SUMMARY:** Notice is hereby given that Scott D. Kraus, Ph.D., Edgerton Research Laboratory, New England Aquarium, Central Wharf, Boston, MA 02110-3309, has requested an amendment to scientific research Permit No. 1014.

**DATES:** Written or telefaxed comments must be received on or before July 21, 1999.

**ADDRESSES:** The amendment request and related documents are available for review upon written request or by appointment in the following office(s):

Permits and Documentation Division, Office of Protected Resources, NMFS, 1315 East-West Highway, Room 13705, Silver Spring, MD 20910 (301/713-2289);

Regional Administrator, Northeast Region, NMFS, One Blackburn Drive, Gloucester, MA 01930, (978/281-9250); and

Regional Administrator, Southeast Region, NMFS, 9721 Executive Center Drive North, St. Petersburg, FL 33702-2432 (813/570-5312).

Written comments or requests for a public hearing on this request should be submitted to the Chief, Permits and Documentation Division, F/PR1, Office of Protected Resources, NMFS, 1315 East-West Highway, Room 13130, Silver Spring, MD 20910. Those individuals requesting a hearing should set forth the specific reasons why a hearing on this particular amendment request would be appropriate.

Comments may also be submitted by facsimile at (301) 713-0376, provided the facsimile is confirmed by hard copy submitted by mail and postmarked no later than the closing date of the comment period. Please note that comments will not be accepted by e-mail or other electronic media.

**FOR FURTHER INFORMATION CONTACT:** Ruth Johnson 301/713-2289.

**SUPPLEMENTARY INFORMATION:** The subject amendment to Permit No. 1014, issued on August 29, 1996 (61 FR 51688) is requested under the authority of the Marine Mammal Protection Act of 1972, as amended (16 U.S.C. 1361 *et seq.*), the Regulations Governing the Taking and Importing of Marine Mammals (50 CFR part 216), the Endangered Species Act of 1973, as amended (16 U.S.C. 1531 *et seq.*), and the regulations governing the taking, importing, and exporting of endangered fish and wildlife (50 CFR parts 222-226).

Permit No. 1014 authorizes the permit holder to: take up to 350 northern right whales (*Eubaleana glacialis*) by harassment during approach closer than 100 feet by vessel or less than 1000 ft. by aircraft. Of these 80 may be biopsy darted; 10 radio tagged, 15 satellite tagged, and 50 ultrasonically measured; collect tissue samples dead stranded animals and exported to Canada, South Africa, New Zealand, Australia and England; and export 100 samples taken legally in other countries.

The permit holder requests an amendment to: play sounds back to up to 100 right whales annually. Sounds projected will not exceed the sound pressure levels found in the normal oceanic environment. Additionally, up to 50 whales will be tagged with suction-cup acoustic recording tags to determine received sound levels from both playback experiments and controlled vessel approaches.

In compliance with the National Environmental Policy Act of 1969 (42 U.S.C. 4321 *et seq.*), an initial determination has been made that the activity proposed is categorically excluded from the requirement to prepare an environmental assessment or environmental impact statement.

Concurrent with the publication of this notice in the **Federal Register**, NMFS is forwarding copies of this application to the Marine Mammal Commission and its Committee of Scientific Advisors.

Dated: June 10, 1999.

**Ann D. Terbush,**

*Chief, Permits and Documentation Division, Office of Protected Resources, National Marine Fisheries Service.*

[FR Doc. 99-15720 Filed 6-18-99; 8:45 am]

BILLING CODE 3510-22-F

## DEPARTMENT OF COMMERCE

### Patent and Trademark Office

**[Docket No. 980326078-9120-02]**

### Internet Usage Policy

**AGENCY:** Patent and Trademark Office, Commerce.

**ACTION:** Notice.

**SUMMARY:** The Patent and Trademark Office (PTO) is publishing the final Internet usage policy to provide guidance to PTO employees regarding the use of the Internet for official PTO business. The policy covers communications with applicants via Internet electronic mail (e-mail), and using the Internet to search for information concerning patent applications and elements appearing in trademark applications. Guidelines for citing electronic information are provided in the attachment.

**DATES:** The Internet usage policy is effective June 21, 1999.

**FOR FURTHER INFORMATION CONTACT:** Magdalen Greenlief, by mail to her attention addressed to Box Comments—Patents, Assistant Commissioner for Patents, Washington, D.C. 20231; by telephone at (703) 305-8813; by facsimile transmission to (703) 305-8825; or by electronic mail through the Internet to "magdalen.greenlief@uspto.gov".

**SUPPLEMENTARY INFORMATION:** The PTO published a "Request for Comments on Proposed Internet Usage Policy" in the **Federal Register** on October 26, 1998 (63 FR 57101) and in the Official Gazette of the Patent and Trademark Office on November 17, 1998 (1216 OG 74). The proposed policy is being adopted without change. The attached guidelines for citing electronic information have been revised.

### Discussion of Public Comments

Sixteen comments were received by the PTO in response to the request for comments. All comments have been fully considered. The comments generally support (1) the use of Internet e-mail for communications between applicant and the PTO, and (2) the use of the Internet to perform searches provided the confidentiality of pending patent applications is not compromised.

Comments concerning the patent provisions are addressed separately from the comments concerning the trademark provisions.

*(A) Comments Concerning the Patent Provisions*

*Comment 1:* One comment stated that Internet e-mail will have a very limited use in view of the fact that proposed Patent Article 5 limits the use of the Internet e-mail for communications that do not require a signature. It was suggested that the PTO establish an Extranet at its earliest convenience to which signed documents can be sent.

*Response:* The PTO will take the suggestion of establishing an "Extranet" under advisement. The PTO is actively planning other options such as digital signatures, digital certificates, encryption and public key/private key encryption.

*Comment 2:* One comment suggested that there should be no limitations as to the types of correspondence that may be communicated via Internet e-mail and that e-mail with message encryption with verifiable digital signatures should have the same weight as communications in paper or facsimile.

*Response:* The PTO is limiting the use of Internet e-mail to communications other than those under 35 U.S.C. 132 (responses to a notice of rejection) or which otherwise require a signature. The PTO is considering how to best handle electronic signatures and how to internally process e-mailed responses to a notice of rejection. Based on the experience gathered with the limited use of e-mail, and after further study and development, the PTO hopes in the future to accept the electronic filing of communications under 35 U.S.C. 132 and communications which otherwise require a signature.

*Comment 3:* One comment suggested that the use of e-mail should be expanded and urged the PTO to ensure that e-mail sent to it can be securely transmitted and reliably stored. An example of such expanded use would be the sending of draft claims to a patent examiner prior to a telephonic/personal interview.

*Response:* Communications via Internet e-mail are at the discretion of the applicant. If applicant wishes to communicate with the PTO on an unsecure medium, applicant is doing so at his/her own risk. Article 5 of the Patent Internet Usage Policy does not prohibit applicant from using the Internet e-mail to transmit draft claims to a patent examiner prior to a telephonic/personal interview. If applicant chooses to transmit a copy of the draft claims via Internet e-mail to the patent examiner prior to a telephonic/personal interview, applicant may do so. However, since the correspondence would contain information subject to the confidentiality requirement as set forth in 35 U.S.C. 122, the patent examiner will not respond to applicant's communication via Internet e-mail unless there is a written authorization by applicant in the application file record. The patent examiner may respond by telephone, or other appropriate means. A printed copy of the Internet e-mail communication will be made of record in the application file.

*Comment 4:* One comment suggested that some simple or routine correspondence of a non-confidential nature (e.g., interview scheduling requests, inquiries as to whether a document has been received by the examiner, inquiries as to an examiner's fax number, etc.) should be permitted without requiring an advance authorization form even though a serial number of a patent application may be included in the e-mail communications.

*Response:* A written authorization from applicant is required only where applicant's Internet e-mail correspondence to the PTO contains information subject to the confidentiality requirement of 35 U.S.C. 122 *and* applicant wishes the PTO to respond via Internet e-mail to applicant's correspondence. If applicant's e-mail correspondence to the patent examiner contains information subject to the confidentiality requirement of 35 U.S.C. 122 and there is no written authorization by applicant in the application file, the patent examiner may respond to applicant's e-mail correspondence by telephone, or other appropriate means (see Patent Internet Usage Policy Article 7).

*Comment 5:* One comment indicated that it would not be necessary for the PTO to confirm receipt of an e-mail communication from a sender since the sender can require a receipt from his/her e-mail system for any message sent. Several comments indicated that it would be desirable to receive an acknowledgment from the PTO of receipt of e-mail communications with attachments from applicant. One comment suggested a bounce-back acknowledgment with an attachment such that the sender can verify that the confirmation matches the transmission. Another comment suggested an automatic confirmation that a message was received by the PTO with a later confirmation that the file attachments are received and readable.

*Response:* The PTO will adopt work steps, develop in-house guidelines, and work with the Office of the Chief Information Officer in an effort to ensure that the acknowledgment of an e-mail communication together with a copy of an attachment containing the original transmission is sent back to the applicant upon receipt in the Office.

*Comment 6:* Several comments indicated that they do not foresee any problem with the deletion of the requirement for an express waiver of 35 U.S.C. 122 by the applicant before Internet e-mail may be used by PTO employees to reply to the applicant's e-mail correspondence where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified. The comments indicated that the requirement for a written authorization is preferable. One comment suggested that the authorization form should not include a statement that Internet communications are not secure.

*Response:* The authorization form set forth in Article 5 of the Patent Internet Usage Policy is a sample form suggested by the PTO that applicants may use to give the PTO written authorization to communicate with applicants via Internet e-mail. The PTO recommends that applicants use the suggested language. However, if applicants prefer to use their own authorization form, applicants may do so provided it is clear that applicants are giving the PTO written authorization to use Internet e-mail to respond to applicants' e-mail correspondence.

*Comment 7:* Several comments indicated that other appropriate means such as fax or telephone would be acceptable to respond to applicant's e-mail correspondence. One comment stated that the use of other means would not be acceptable where applicant requests the PTO to respond via e-mail.

*Response:* Article 7 of the Patent Internet Usage Policy requires all e-mail correspondence from applicant to be responded to by PTO personnel. Furthermore, Article 7 permits PTO personnel to respond to applicant's Internet e-mail correspondence by other appropriate means such as telephone, or by facsimile transmission. The use of the telephone or facsimile transmission to respond to applicant's e-mail correspondence appears to be just as effective as the use of Internet e-mail. The suggestion to require the PTO to use only Internet e-mail to respond to applicant's e-mail correspondence upon applicant's request has not been adopted since such a requirement would be unreasonable. PTO personnel should have the discretion to decide

what appropriate means he/she should use to respond to applicant's e-mail correspondence.

*Comment 8:* Several comments indicated that interviews are more effective when conducted in person or by telephone rather than by e-mail. The comments suggested that e-mail would be very useful to transmit proposed claims, or amendments to the patent examiner prior to an interview.

*Response:* Communications via Internet e-mail are at the discretion of applicants. Applicants may use Internet e-mail to transmit proposed claims, and/or proposed amendments to the patent examiner prior to an interview. Since applicants' e-mail correspondence would contain information subject to the confidentiality requirement of 35 U.S.C. 122, the patent examiner will not be able to respond to applicants' e-mail correspondence via Internet e-mail unless a written authorization from applicant is in the application file record.

*Comment 9:* One comment indicated that despite the lack of encryption, he would use e-mail almost exclusively if it were authorized since most matters are not of such confidential nature that security is an issue. Another comment indicated that without encryption and digital signature, use of Internet e-mail would be limited to non-substantive issues and non-confidential subject matter. Another comment indicated that Internet e-mail would be a convenient way to request, set up and confirm regular telephone interviews.

*Response:* The PTO is considering options such as encryption and digital signature to improve security of e-mail.

*Comment 10:* Several comments favor the use of digital signatures, digital certificates and encryption to improve security of e-mail. The different kinds of software recommended are public/private key encryption program PGP(®), Verisign ™, and S/MIME with digital certification. One comment suggested that the users be given an opportunity to comment on the alternatives considered by the PTO.

*Response:* The PTO is planning to use PKI technology to provide digital certificates and directory services to support both internal and external e-mail users.

*Comment 11:* Several comments favor the use of the Internet for searching and retrieving scientific and technical information in patent applications provided that the PTO ensures that the searches are conducted in a manner that does not compromise the confidentiality of patent applications.

*Response:* Because security issues concerning transmission and capture of search requests by unauthorized individuals have not yet been resolved, patent examiners are instructed to exercise good judgment and restrict their searches to non-specific patent application uses so as to ensure that the confidentiality of patent applications is not compromised. Patent Internet Usage Policy, Article 9, states that Internet search activities that could disclose proprietary information directed to a specific application, other than a reissue application or reexamination proceeding, are not permitted.

*(B) Comments Concerning the Trademark Provisions*

*Comment 1:* One comment indicated that a reply to an e-mail communication from the PTO which contained the original transmission would be desirable in order that the sender could verify that the content of the transmission received by the PTO matches the original transmission.

*Response:* The PTO will adopt work steps, develop in-house guidelines, and work with the Office of the Chief Information Officer in an effort to ensure that the acknowledgment of an e-mail response together with a copy of an attachment containing the original transmission is sent back to the applicant or applicant's attorney upon receipt in the PTO.

*Comment 2:* A concern was raised regarding the accuracy of the record with regard to the telephonic correspondence between the examining attorney and the applicant. It was suggested that the PTO employ a form of audio capture in order to store telephone conversations and that these electronic files could be made a part of the record.

*Response:* The intent of Article 10 was to allow the attorney in the PTO to respond to the communication in the most efficient and appropriate method depending upon the circumstances of the particular situation. Accuracy of the notes to the file regarding telephone conversations have not posed a problem in the past and the PTO is not planning to implement audio capture techniques in order to make recordings of telephone conversations a part of the official record.

*Comment 3:* One comment maintained that examiner's amendment that is issued electronically should only be done so after agreement on the issues have been reached between the examiner and the applicant or his/her attorney. Further, a hard copy of the amendment should be placed in the file.

*Response:* This is the current policy in the PTO. Examiner's amendments are only issued after agreement has been reached between the examining attorney and the applicant or his/her attorney. This policy will not change. As indicated in the policy statement, all Internet e-mail communications between the examining attorney and the applicant or his/her representative are to be printed as hard copy and inserted into the paper file. An examiner's amendment would be no exception to this policy. (See Trademark Internet Usage Policy, Article 8.)

*Comment 4:* One comment suggested that all actions issued by the PTO requiring a timely response by the applicant should always be mailed through the U.S. mail system, including those that were communicated to the applicant by e-mail.

*Response:* Sending an Office action by regular mail as well as by e-mail defeats a significant purpose that would be achieved by the use of e-mail. The use of e-mail to communicate with applicants is fast and eliminates the physical transfer of unnecessary paper. As many applicants and applicants' representatives do today with regular mail, procedures to record receipt of e-mail should be put in place. In this way, an applicant or his/her representative may use these established procedures to establish non-receipt of an e-mail Office action if the application is later abandoned for failure to respond to the Office action. Justification for revival of an application based on documentation of non-receipt of an Office action would be the same for e-mailed Office actions as it is today for Office actions mailed in regular mail. Therefore, it is unnecessary to send a hard copy of the e-mailed Office action through the regular mail. (See also TMEP Section 702.04(e)—Procedure for Filing by Fax)

*Comment 5:* One Comment suggested that e-mail responses from applicants that require verification through declaration or affidavit be required to provide an electronically reproduced signature or, if such signature cannot adequately be sent via the Internet, that such documents be sent by fax, regular mail or private package delivery.

*Response:* It would be quite acceptable for a signed declaration or affidavit to be received by e-mail in the PTO by means of a software package that allowed for viewing of the actual signed document. The PTO currently accepts original applications through its Trademark Electronic Application System (TEAS) with an electronic signature, i.e., any combination of alpha/numeric characters that has been specifically adopted to serve the function of the signature, preceded and followed by the forward slash (/). Similarly, an electronic signature

selected by the applicant would validate an affidavit or declaration submitted by e-mail in the course of examination of the application. Such an affidavit or declaration would be submitted as the body of or word processing attachment to the applicant's e-mail response.

*Comment 6:* One comment suggested advising applicants not to send confirming or follow-up hard paper copies of responses which are sent by e-mail. It was observed that such additional submissions could adversely delay prosecuting the trademark application.

*Response:* The PTO agrees with this suggestion and advises applicants to refrain from sending such "confirmation" copies of e-mail correspondence. This recommendation has also been announced concerning submissions by facsimile in which confirmation copies of faxed correspondence are discouraged. (See TMEP Section 702.04(e)—Procedure for Filing by Fax)

*Comment 7:* One comment questioned whether an additional form of communication with the PTO would result in increased administrative costs for the PTO and for customers of the PTO.

*Response:* The PTO would incur no additional costs in the administration of Internet communications. The PTO would utilize the systems and personnel already in place to process these communications. With regard to costs for customers of the PTO, non-participating customers would incur no indirect costs because the PTO has no need to raise fees to administer this system. Participating customers may or may not incur additional costs depending on their circumstances, but since this form of communication is purely at the option of the customer, the customer alone will decide whether the benefits of Internet communications justify any additional expense. Use of Internet e-mail is purely at the option of the applicant.

*Comment 8:* One comment indicated that foreseeable problems exist in that e-mail communications are more likely to contain errors than other submissions to the PTO, and that the users of this form of communication should bear a higher burden of proof and additional fees for correcting errors in e-mail communications.

*Response:* There is no basis for the PTO to presume that e-mail submissions are more likely to contain errors than other forms of communications. The PTO expects that applicants and their representatives would exhibit the same attention to the accuracy of their e-mail submissions as they would to submissions made using any other means. Furthermore, the PTO will not penalize customers who wish to use e-mail. Utilization of Internet communications will help the PTO become more technologically advanced and efficient. Additional burdens and fees for those cooperating with these efforts would be counterproductive; therefore, this suggestion will not be adopted.

*Comment 9:* One comment suggested that the PTO study, publish and request Comments on the e-TEAS electronic application system for the filing of trademark and service mark applications over the Internet.

*Response:* On November 1, 1997, the PTO began a pilot program accepting trademark and service mark applications over the Internet. Due to the success of the pilot, on October 1, 1998, the PTO opened this system, now known as e-TEAS, to the public. This system does not utilize e-mail communications, but instead requires that a particular form be completed on-line and submitted directly to a dedicated server. While the e-mail communications contemplated by the present policy are related to e-TEAS in that both involve communications over the Internet, the form and substance of these communications are quite different and often not comparable. On May 11, 1999, the PTO published a notice of proposed rulemaking and notice of hearing regarding the Trademark Law Treaty Implementation Act Changes. 64 Fed. Reg. 25223. In this notice, the PTO proposed formal rules to govern the electronic filing of trademark and service mark applications. The notice invites Comments from the public.

*Comment 10:* One comment indicated that confusion would occur concerning whether e-mail communications are informal communications or formal actions by the PTO or responses to actions, and that Trademark Articles 4 and 11 should better articulate how they should be differentiated. The comment suggested that formal e-mail communications be made of record in the application file and maintained in an electronic log. The Comment also questioned the PTO's procedures for maintaining paper and electronic copies of Internet e-mail correspondence and suggested greater specificity in creating procedures for this purpose.

*Response:* Trademark Articles 4 and 11 indicate that Internet e-mail may be used for formal communications, such as Office actions or responses to Office actions, or informal communications, such as communications similar to telephone or personal interviews. Trademark Articles 4, 8 and 11 indicate that all such communications, whether formal or informal, must be printed and placed in the application file and become a part of the formal record. All electronic communications received by the PTO will, at a minimum, be maintained on a schedule that is consistent with the PTO's current archival policies for paper records. Furthermore, while no schedule currently exists for the maintenance of e-mail correspondence, retention schedules are currently being developed for electronic records and will be in place in the near future. The PTO will develop guidelines for its employees to ensure that communications emanating from the PTO are clear as to whether a response is required as is done in all written communications. Similarly, the PTO will develop guidelines for determining whether a communication received from an applicant should be interpreted as responsive to an Office communication. Furthermore, while it will be incumbent upon the recipient to initially determine whether a communication is informal or not, the PTO's records will be complete and misunderstandings can be rectified in accordance with the remedies outlined in Trademark Article 9 regarding petitions to the Commissioner. If the applicant does not wish for informal communications to be placed in the application file, the option of telephone or personal interviews are still available. The PTO will not require an applicant to use Internet e-mail for any communications under any circumstances.

*Comment 11:* One comment indicated that the Internet should not be considered by the PTO as a proper source for information leading to refusals of trademark and service mark applications unless the examining attorney can show that the reference is publicly available in stable form from the date of its first publication.

*Response:* The Internet contains a great wealth of information of varying reliability and transience. Nevertheless, this information does exist and may be valuable in determining the registrability of a mark. The Trademark Trial and Appeal Board has considered the admissibility of Internet evidence in the context of an *inter partes* proceeding, and held that it is admissible and that the reliability of the information would be directed to the weight or probative value to be given to the evidence. *Raccioppi* v. *Apogee Inc.*, 47 USPQ 1368 (TTAB 1998). The PTO would be remiss in not utilizing this accepted, economical and efficient resource to gather some of the

information required to make proper judgments concerning the registrability of marks. In fact, a separate comment commended the PTO for utilizing the Internet as a research tool because of the potential cost savings of using this free and readily available source of information. The PTO will develop additional guidelines to ensure that examining attorneys provide applicants with adequate information to locate the document retrieved, in accordance with Trademark Article 12.

**I. Patent Internet Usage Policy**

*Introduction*

The Internet and its offspring, the World Wide Web (WWW), offer the PTO opportunities to (1) enhance operations by enabling Patent Examiners to locate and retrieve new sources of scientific and technical information, (2) communicate more effectively with our customers via advanced electronic mail (e-mail) and file transfer functions, and (3) more easily publish information of interest to the intellectual property community and the general public. This new technology offers low-cost, high speed, and direct communications capabilities upon which the PTO wishes to capitalize.

The organizations reporting to the Assistant Commissioner for Patents have special legal requirements that must be satisfied as part of the PTO's goal to make effective use of the Internet. Because security issues concerning transmission and capture of search requests by unauthorized individuals have not yet been resolved, Patent Examiners are to exercise good judgment and restrict their searches to nonspecific patent application uses.

*Purpose*

To establish a policy for use of the Internet by the Patent Examining Corps and other organizations within the PTO;

To address use of the Internet to conduct interview-like communications and other forms of formal and informal communications;

To publish guidelines for locating, retrieving, citing, and properly documenting scientific and technical information sources on the Internet;

To inform the public how the PTO intends to use the Internet; and

To establish a flexible Internet policy framework which can be modified, enhanced, and corrected as the PTO, the public, and customers learn to use, and subsequently integrate, new and emerging Internet technology into existing business infrastructures and everyday activities to improve the patent application, the examining, and granting functions.

*Article 1. Applicability*

This policy applies to members of the Patent Organization within the PTO, including contractors and consultants working with, or conducting activities in support of, the Patent Organization.

*Article 2. Scope*

This policy applies to activities associated with, or directly related to, use of the Internet via PTO-provided network connections, facilities, and services. This includes, but is not limited to, PTONet connections, Office of Chief Information Officer (OCIO)-provided PCs and workstations, and Internet provider services. This policy also applies to use of other non-PTO Internet access facilities and equipment that are used to conduct non-patent application specific work.

*Article 3. Conformance With Existing, PTO-Wide, Internet Use Policy*

This Internet Usage Policy supersedes the Interim Internet Usage Policy published in the Official Gazette on February 1997. The policy outlined in this document augments the existing PTO Internet Acceptable Use Policy as set forth in the Office Automation Services Guide. As such, this policy is an extension of current PTO office-wide Internet policy.

*Article 4. Confidentiality of Proprietary Information*

If security and confidentiality cannot be attained for a specific use, transaction, or activity, then that specific use, transaction, or activity shall **NOT** be undertaken/conducted.

All use of the Internet by Patent Organization employees, contractors, and consultants shall be conducted in a manner that ensures compliance with confidentiality requirements in statutes, including 35 U.S.C. 122, and regulations. Where a written authorization is given by the applicant for the PTO to communicate with the applicant via Internet e-mail, communications via Internet e-mail may be used.

Backup, archiving, and recovery of information sent or received via the Internet is the responsibility of individual users. The OCIO does not, and will not, as a normal practice, provide backup and recovery services for information produced, retrieved, stored, or transmitted to/from the Internet.

*Article 5. Communications via the Internet and Authorization*

Communications via Internet e-mail are at the discretion of the applicant.

Without a written authorization by applicant in place, the PTO will not respond via Internet e-mail to any Internet correspondence which contains information subject to the confidentiality requirement as set forth in 35 U.S.C. 122. A paper copy of such correspondence will be placed in the appropriate patent application.

The following is a sample authorization form which may be used by applicant:

"Recognizing that Internet communications are not secure, I hereby authorize the PTO to communicate with me concerning any subject matter of this application by electronic mail. I understand that a copy of these communications will be made of record in the application file."

A written authorization may be withdrawn by filing a signed paper clearly identifying the original authorization. The following is a sample form which may be used by applicant to withdraw the authorization:

"The authorization given on____ ___, to the PTO to communicate with me via the Internet is hereby withdrawn. I understand that the withdrawal is effective when approved rather than when received."

Where a written authorization is given by the applicant, communications via Internet e-mail, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used. In such case, a printed copy of the Internet e-mail communications **MUST** be given a paper number, entered into the Patent Application Location and Monitoring System (PALM) and entered in the patent application file. A reply to an Office action may **NOT** be communicated by applicant to the PTO via Internet e-mail. If such a reply is submitted by applicant via Internet e-mail, a paper copy will be placed in the appropriate patent application file with an indication that the reply is **NOT ENTERED**.

PTO employees are **NOT** permitted to initiate communications with applicant via Internet e-mail unless there is a written authorization of record in the patent application by the applicant.

All reissue applications are open to public inspection under 37 CFR 1.11(a) and all papers relating to a reexamination proceeding which have been entered of record in the patent or reexamination file are open to public inspection under 37 CFR 1.11(d). PTO employees are **NOT** permitted to initiate communications with applicant in a reissue application or a patentee of a reexamination proceeding via Internet e-mail unless written authorization is given by the applicant or patentee.

*Article 6. Authentication of Sender by a Patent Organization Recipient*

The misrepresentation of a sender's identity (i.e., spoofing) is a known risk when using electronic communications. Therefore, Patent Organization users have an obligation to be aware of this risk and conduct their Internet activities in compliance with established procedures.

Internet e-mail must be initiated by a registered practitioner, or an applicant in a *pro se* application, and sufficient information must be provided to show representative capacity in compliance with 37 CFR 1.34. Examples of such information include the attorney registration number, attorney docket number, and patent application number.

*Article 7. Use of Electronic Mail Services*

Once e-mail correspondence has been received from the applicant, as set forth in Patent Article 4, such correspondence must be responded to appropriately. The Patent Examiner may respond to an applicant's e-mail correspondence by telephone, fax, or other appropriate means.

*Article 8. Interviews*

Internet e-mail shall **NOT** be used to conduct an exchange or communications similar to those exchanged during telephone or personal interviews unless a written authorization has been given under Patent Article 5 to use Internet e-mail. In such cases, a paper copy of the Internet e-mail contents **MUST** be made and placed in the patent application file as required by the Federal Records Act in the same manner as an Examiner Interview Summary Form is entered.

*Article 9. Internet Searching*

The ultimate responsibility for formulating individual search strategies lies with individual Patent Examiners, Scientific and Technical Information Center (STIC) staff, and anyone charged with protecting proprietary application data. When the Internet is used to search, browse, or retrieve information relating to a patent application, other than a reissue application or reexamination proceeding, Patent Organization users **MUST** restrict search queries to the general state of the art. Internet search, browse, or retrieval activities that could disclose proprietary information directed to a specific application, other than a reissue application or reexamination proceeding, are **NOT** permitted.

This policy also applies to use of the Internet as a communications medium for connecting to commercial database providers.

*Article 10. Documenting Search Strategies*

All Patent Organization users of the Internet for patent application searches shall document their search strategies in accordance with established practices and procedures as set forth in MPEP 719.05 subsection I.(F).

*Article 11. Citations*

All Patent Organization users of the Internet for patent application searches shall record their fields of search and search results in accordance with established practices and procedures as set forth in MPEP 719.05 subsection I.(F).

Subparagraph A

Internet document citations should include information which is normally included for reference documents (i.e., Form PTO–892). In addition, any information which would aid a future searcher in locating the document should be included in the citation. Guidelines for citing electronic information can be found as an attachment to this policy.

Subparagraph B

When a document found on the Internet is not the original publication, then the Patent Examiner or STIC staff shall pursue the acquisition of a copy of the originally published document or an original of the document or Web object in question for all references cited. Note: scanned images are considered to be a copy of the original publication. Electronic-only documents are original publications.

*Article 12. Professional Development*

The Internet is recognized as a tool for professional development. It may be useful for keeping informed of technological and legal developments in all art areas. For example, use of the Internet for keeping abreast of conferences, seminars, and for receiving mail from appropriate list servers is acceptable. This is consistent with the Department of Commerce's Internet Usage Policy.

*Article 13. Policy Guidance and Clarifications*

Within the Patent Organization, any questions regarding Internet usage policy should be directed to the user's immediate supervisor. Non-PTO personnel should direct their questions to the Office of the Deputy Assistant Commissioner for Patent Policy and Projects.

## II. Trademark Internet Usage Policy

### Introduction

The Internet and its offspring, the World Wide Web (WWW), offer the PTO opportunities to (1) enhance customer services by enabling attorney advisors (Trademarks) and other Trademark employees to locate and retrieve new sources of legal, scientific, commercial and technical information, (2) communicate more effectively with customers via electronic mail (e-mail) and file transfer functions, and (3) more easily publish information of interest to the intellectual property community and the general public.

This new technology offers low-cost, high speed, direct communication capabilities that the PTO wishes to leverage to the advantage of its customers.

The organizations reporting to the Assistant Commissioner for Trademarks have special legal requirements that must be satisfied as part of the PTO's goal to make effective use of the Internet and electronic commerce.

### Purpose

To establish a policy for use of the Internet by organizations reporting to the Assistant Commissioner for Trademarks, including: the Office of the Assistant Commissioner for Trademarks, the Trademark Examining Operation, Trademark Services, Trademark Program Control and the Trademark Assistance Center;

To address use of the Internet to conduct interview-like communications, and other forms of formal and informal communications;

To publish guidelines for locating, retrieving, citing, and properly documenting scientific, commercial and technical information sources on the Internet;

To inform the public how the PTO intends to use the Internet; and

To establish a flexible Internet policy framework which can be modified, enhanced, and corrected as the PTO, the public, and customers learn to use, and subsequently integrate, new and emerging Internet technology into existing business infrastructures and everyday activities to improve the trademark application, examination, and registration business processes.

*Article 1. Applicability*

This policy applies to members of Trademark Organization reporting to the Assistant Commissioner for Trademarks within the PTO, including contractors and consultants working with, or conducting activities in support of, the Trademark Organization. It does not

apply to members of the Trademark Trial and Appeal Board or contractors and consultants working with, or conducting activities in support of, the Trademark Trial and Appeal Board.

*Article 2. Scope*

This policy applies to activities associated with, or directly related to, use of the Internet via PTO-provided network connections, facilities, and services. This includes, but is not limited to, PTONet connections, Office of Chief Information Officer (OCIO)-provided PCs and workstations, and Internet provider services. This policy also applies to use of other non-PTO Internet access facilities and equipment that are used to conduct non-trademark application specific work.

*Article 3. Conformance With Existing, PTO-Wide, Internet Use Policy*

This Internet Usage Policy supersedes the Interim Internet Usage Policy published in the Official Gazette in February 1997. The policy outlined in this document augments the existing PTO Internet Acceptable Use Policy as set forth in the Office Automation Services Guide. As such, this policy is an extension of current PTO office-wide Internet policy.

*Article 4. Correspondence Acceptable via the Internet*

Internet e-mail may be used to reply or respond to an examining attorney's Office Action, to reply or respond to a petitions attorney's 30-day letter, to reply or respond to a Post Registration Office Action, as well as to conduct informal communications regarding a particular application or registration with the appropriate Trademark Organization employee. If e-mail communication is initiated by the applicant or applicant's attorney, Office Actions, Priority Actions, Examiner's Amendments, petitions attorney's 30-day letters, and Post Registration Office Actions may be sent to the applicant via Internet e-mail or by telephone, fax, or other appropriate means. Readable attachments to Internet e-mail for such purposes as the submission of evidence, specimens, affidavits and declarations will be accepted.

*Article 5. Communications Not Acceptable via the Internet*

Internet e-mail or other Internet communications may **NOT** be used to file Trademark Applications, Amendments to Allege Use, Statements of Use, Requests for Extension of Time to File a Statement of Use, Section 8 affidavits, Section 9 affidavits, or Section 15 affidavits until such time as the PTO publishes electronic forms for these filings and they are made available on the Internet by the PTO. Internet e-mail may be used to submit specimens of use, but the Office will determine acceptability of the specimen(s) and if the specimens are found not to meet the standards for specimens of use, additional specimens will be required. Certified copies of foreign certificates will **NOT** be accepted via Internet e-mail. Internet e-mail may **NOT** be used for any correspondence with the Trademark Trial and Appeal Board.

*Article 6. Initiating Internet Communications*

Internet communications will **NOT** be initiated by the Trademark Organization unless it is authorized to do so by the applicant or by the applicant's attorney. Authorization for members of the Trademark Organization to communicate with applicant or applicant's attorney via Internet e-mail may be given by so indicating in the application submitted to the PTO or in any official written communication with the Trademark Organization. The authorization must include the Internet e-mail address to which all Internet e-mail is to be sent. Internet communications may also be initiated and authorized by applicant or applicant's attorney by telephone or by responding to an Office Action or other official communication via an Internet e-mail address indicated on the official correspondence.

*Article 7. Waivers and Authentication*

Applicants and their attorneys understand that the misrepresentation of a sender's identity is a known risk when using electronic communications. Therefore, Trademark Organization users have an obligation to be aware of this risk and conduct their Internet activities in compliance with established procedures.

Internet e-mail must be initiated and authorized by a practitioner, or the applicant in a pro se application. Sufficient information must be provided to show representative capacity in compliance with 37 CFR 2.17 and 10.14. In trademark cases, examples of such information would include signing a paper in practice before the PTO in a trademark case, attorney docket number, and trademark application serial number or registration number.

The Assistant Commissioner for Trademarks will waive 37 CFR 10.18 to the extent that it requires an original signature personally signed by a trademark practitioner in permanent ink on any correspondence filed with the PTO. Receipt of an Internet e-mail communication by the Trademark Organization from the address of applicant or applicant's attorney containing the /s/ notation in lieu of signature and which references a Trademark application serial number will be understood to constitute a certificate that:

1. The correspondence has been read by the applicant or practitioner;
2. The filing of the correspondence is authorized;
3. To the best of the applicant's or practitioner's knowledge, information, and belief, there is good ground to support the correspondence, including any allegations of improper conduct contained or alleged therein; and
4. The correspondence is not interposed for delay.

Applicants requesting to correspond with the Trademark Organization via the Internet should recognize that Internet communications might not be secure, and should understand that a copy of any and all communications received via the Internet will be placed in the file wrapper and become a permanent part of the record.

*Article 8. Office Procedures*

When authorized to do so, the Trademark Organization will send Office Actions and other official correspondence to the Internet e-mail address indicated by the applicant or applicant's attorney. A signed, paper copy of the outgoing correspondence will be associated with the trademark application file wrapper.

When communications are received by an examining attorney, or other appropriate Trademark Organization employee, the attorney or employee will immediately reply to the communication acknowledging receipt of the communication. The date the communication was received by the Trademark Organization that appears in the heading of the communication will constitute the receipt date within the PTO for purposes of time-sensitive communications unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the receipt date will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia. A paper copy of all Internet e-mail communications, including a copy of any and all attachments, will be associated with the trademark application file wrapper. A paper copy of any informal communications regarding a particular trademark application or registration will be associated with the file wrapper and become a part of the record.

*Article 9. Remedies*

When an application is held abandoned because a timely Internet e-mail communication was sent to and received by the Trademark Organization but was not timely associated with the application file wrapper, the abandoned application may be reinstated by the Trademark Organization. There is no fee for a request to reinstate such an application.

When an application is held abandoned because a timely Internet e-mail communication was sent to, but apparently not received by the Trademark Organization, applicant or applicant's attorney may petition the Commissioner to revive the abandoned application pursuant to 37 CFR 2.66 and TMEP §§ 1112.05(a), (b). In determining whether or not an Internet response was timely filed, the Commissioner may accept a copy of a signed certificate of transmission meeting the requirements of 37 CFR 1.8, a copy of the previously transmitted correspondence, and a statement attesting to the personal knowledge of timely transmission of the response. 37 CFR 1.8(b)(1), (2), and (3).

In all situations, the applicant or the applicant's attorney should promptly notify the Office after becoming aware that the application was abandoned because a communication was not timely associated with the file wrapper or was not received by the Office.

*Article 10. Use of Electronic Mail Services*

Once e-mail correspondence has been received from an applicant, as set forth in Trademark Article 6, such correspondence must be responded to appropriately. The Trademark Organization employee may respond to an applicant's Internet e-mail correspondence by telephone, fax, or other appropriate means.

*Article 11. Interviews*

Internet e-mail may be used to conduct an exchange of communications similar to those exchanged during telephone or personal interviews. In such cases, a paper copy of the Internet e-mail contents **MUST** be made and placed in the trademark application file wrapper.

*Article 12. Documenting Search Strategies*

All Trademark Organization users of the Internet for trademark application research shall document their search strategies in accordance with established practices and procedures as set forth in TMEP § 1106.07(a).

Subparagraph A

Any information, which would aid a future searcher in locating the document retrieved through Internet research, should be included in the citation. Guidelines for citing electronic information can be found as an attachment to this policy.

Subparagraph B

When a document found on the Internet is not the original publication, then the Trademark Examining Attorney or Trademark Library staff shall pursue the acquisition of a copy of the originally published document or an original of the document or Web object in question for all references cited. Note: scanned images are considered to be a copy of the original publication. Electronic-only documents are original publications.

*Article 13. Professional Development*

The Internet is recognized as a tool for professional development. It may be useful for keeping informed of technological and legal developments. For example, use of the Internet for keeping abreast of conferences, seminars, and for receiving mail from appropriate list servers is acceptable. This is consistent with the Department of Commerce's Internet Usage Policy.

*Article 14. Policy Guidance and Clarifications*

Within the Trademark Organization, any questions regarding the Internet usage policy should be directed to the user's immediate supervisor. Non-PTO personnel should direct their questions to the Office of the Assistant Commissioner for Trademarks.

**Attachment**

*Guidelines for Citing Electronic Resources*

The Standing Committee on Information Technologies (SCIT) of the World Intellectual Property Organization (WIPO) has revised WIPO Standard ST.14 "Recommendation for the Inclusion of References Cited in Patent Documents" to provide a standardized method for listing references cited in patent documents. Standard ST.14 is reproduced in its entirety below. Standard ST.14 became effective April 1, 1999, and will be included in future updates of the WIPO Handbook on Industrial Property Information and Documentation. Paragraph 13 of Standard ST.14 sets forth the method for citing electronic resources. The standard set forth in paragraph 13 of ST.14 was modeled after the guidelines provided by the International Organization for Standardization's established Standard ISO 690–2 "Information and documentation—Bibliographic references—Part 2: Electronic documents or parts thereof."

**Standard St.14—Recommendation for the Inclusion of References Cited in Patent Documents**

*Editorial Note Prepared by the International Bureau*

Articles published in scientific and technical journals often contain a certain number of references to earlier publications. Patent applications also very often contain (e.g., in the descriptions of the inventions) references to earlier patents or patent applications. In the course of the procedure for obtaining a patent, patent examiners cite one or several patent documents or other documents which describe similar or closely related technical solutions to the one described in a patent application being examined, in order to illustrate the prior art.

Some industrial property offices, but not all of them, bring these cited references to the attention of the general public, by including them in a published patent document. The present Recommendation is intended to generalize the use of printing on the patent document the "reference cited" during the patent examination procedure, to standardize the way in which the said references should be presented in the patent document and to recommend a preferred place, where the "references cited" should appear in a patent document.

*Revision Adopted by the SCIT Plenary at its Second Session on February 12, 1999*

Definitions

1. For the purposes of this Recommendation, the term "patents" includes such industrial property rights as patents for inventions, plant patents, design patents, inventors' certificates, utility certificates, utility models, patents of addition, inventors' certificates of addition, and utility certificates of addition.

2. For the purposes of this Recommendation, the expressions "patent applications" or "applications for patents" include applications for patents for inventions, plant patents, design patents, inventors' certificates, utility certificates, utility models, patents of addition, inventors' certificates of addition, and utility certificates of addition.

3. For the purposes of this Recommendation, the expression

"patent documents" includes patents for inventions, plant patents, design patents, inventors' certificates, utility certificates, utility models, patents of addition, inventors' certificates of addition, utility certificates of addition, and published applications therefor.

Background

4. Applications for patents are examined by a governmental authority or intergovernmental authority which, as a rule, is an industrial property office. A patent for invention is granted if the application complies with the formal requirements and, depending on whether and to what extent an "examination as to substance" is carried out, if the invention fulfills the substantive requirements of the respective patent law.

5. When patent applications are examined or search reports are established therefor, a certain number of patent documents and other documents might be cited as references to illustrate the prior art by the industrial property office (including a regional Office, and an International Searching Authority under the PCT).

References

6. References to the following Standards are of relevance to this Recommendation:

WIPO Standard ST.2 Standard Manner for Designating Calendar Dates by Using the Gregorian Calendar;

WIPO Standard ST.3 Recommended Standard on Two-Letter Codes for the Representation of States, Other Entities and Intergovernmental Organizations;

WIPO Standard ST.9 Recommendation Concerning Bibliographic Data on and Relating to Patents and SPCs;

WIPO Standard ST.16 Recommended Standard Code for the Identification of Different Kinds of Patent Documents;

International Standard ISO 4:1997 "Information and Documentation—Rules for the abbreviation of title words and titles of publications";

International Standard ISO 690:1987 "Documentation—Bibliographic references—Content, form and structure";

International Standard ISO 690-2:1997 "Information and documentation—Bibliographic references—Part 2: Electronic documents or parts thereof."

Recommendation

7. It is recommended that industrial property offices should include in their granted patents and in their published patent applications all relevant references cited in the course of a search or examination procedure.

8. It is recommended that the "List of references cited" be identified by INID code (56).

9. It is recommended that the "List of references cited" appear either

(a) On the first page of the patent document or

(b) In a search report attached to the patent document.

10. It is recommended that if the "List of references cited" appears in a search report attached to the patent document, (e.g., under the PCT procedure) this should be indicated on the first page of the patent document.

11. It is recommended that the documents in the "List of references cited" be organized in a sequence suitable to the users" needs, this sequence being clearly illustrated in the presentation of the said list. The following is an example of a sequence of documents cited:

(a) Domestic patent documents;

(b) Foreign patent documents;

(c) Non-patent literature.

In search reports, however, the documents may be cited in the order of their pertinence.

12. Identification of any document cited, and available in paper form or in a page-oriented presentation mode (e.g., facsimile, microform, etc.) shall be made by indicating the following elements in the order in which they are listed:

(a) *In the case of a patent document:*

(i) The industrial property office that issued the document, by the two-letter code (WIPO Standard ST.3);

(ii) The number of the document as given to it by the industrial property office that issued it (for Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document);

(iii) The kind of document, by the appropriate symbols as indicated on the document under WIPO Standard ST.16 or, if not indicated on that document, as provided in that Standard, if possible;

(iv) The name of the patentee or applicant (in capital letters and, where appropriate, abbreviated); [1] [3]

(v) The date of publication of the cited patent document (using four digits for a year designation according to the Gregorian Calendar) or, in case of a corrected patent document, the date of issuance of the corrected patent document as referred to under INID code (48) of WIPO Standard ST.9 and, if provided on the document, the supplementary correction code as referred to under INID code (15); [2]

(vi) Where applicable, the pages, columns, lines or paragraph numbers where the relevant passages appear, or the relevant figures of the drawings. [1]

The following examples illustrate the citation of a patent document according to paragraph (a), above:

*Example 1:* JP 10-105775 A (NCR INTERNATIONAL INC.) 24 April 1998, paragraphs [0026] to [0030].

*Example 2:* DE 3744403 A1 (JOSEK, A.) 1991.08.29, page 1, abstract.

*Example 3:* SE 504901 C2 (SWEP INTERNATIONAL AB) 1997-05-26, claim 1.

*Example 4:* US 5635683 A (MCDERMOTT, R. M. et al.) June 3, 1997, column 7, lines 21 to 40.

(b) In the case of a monograph or parts thereof, e.g., contributions to conference proceedings, etc.:

(i) The name of the author (in capital letters); [3] in the case of a contribution, the name of the author of the contribution;

(ii) In the case of a contribution, the title of the contribution followed by "In:";

(iii) The title of the monograph; in the case of a contribution, the designation of the editorship;

(iv) The number of the edition;

(v) The place of publication and the name of the publisher (where only the location of the publisher appears on the monograph, then that location shall be indicated as the place of publication; in the case of company publications, the name and postal address of the company); [1]

(vi) The year of publication, by four digits; [4]

(vii) Where applicable, the standard identifier and number assigned to the item, e.g., ISBN 2-7654-0537-9, ISSN 1045-1064. It should be noted that these numbers may differ for the same title in the print and electronic versions;

(viii) The location within the monograph by indicating the pages, columns, lines or paragraph numbers where the relevant passages appear, or the relevant figures of the drawings (where applicable). [1]

The following examples illustrate the citation of a monograph (Example 1), as well as of published conference proceedings (Example 2), according to paragraph (b), above:

*Example 1:* WALTON, Herrmann. Microwave Quantum Theory. London: Sweet and Maxwell, 1973, Vol.2, ISBN 5-1234-5678-9, pages 138 to 192, especially pages 146 to 148.

*Example 2:* SMITH et al. 'Digital demodulator for electrical impedance imaging.' In: IEEE Engineering in Medicine & Biology Society, 11th Annual Conference. Edited by Y. Kim et al. New York: IEEE, 1989, Vol.6, p. 1744-5.

(c) *In the case of an article published in a periodical or other serial publication:*

(i) The name of the author (in capital letters); [3]

(ii) The title of the article (where appropriate, abbreviated or truncated) in the periodical or other serial publication;

(iii) The title of the periodical or other serial publication (abbreviations conforming to generally recognized international practice may be used, see Appendix 1 to this Standard);

(iv) The location within the periodical or other serial publication by indicating date of issue by four digits for the year designation, issue designation, pagination of the article (where year, month and day are available, the provisions of WIPO Standard ST.2 should be applied);

(v) Where applicable, the standard identifier and number assigned to the item, e.g., ISBN 2-7654-0537-9, ISSN 1045-1064. It should be noted that these numbers may differ for the same title in the print and electronic versions;

(vi) Where applicable, the relevant passages of the article and/or the relevant figures of the drawings.[1]

The following example illustrates the citation of an article published in a periodical or other serial publication according to paragraph (c), above:

*Example:* DROP, J.G. Integrated Circuit Personalization at the Module Level. IBM tech. dis. bull. October 1974, Vol.17, No.5, pages 1344 and 1345, ISSN 2345-6789.

(d) In the case of an abstract not published together with the full text document which serves as its basis:

The identification of the document containing the abstract, the abstract and the full text document shall be made on the basis of the bibliographic data available in respect thereof.

The following examples illustrate the citation of an abstract according to paragraph (d), above:

*Example 1:* Shetulov, D.I. Surface Effects During Metal Fatigue. Fiz.-Him. Meh. Mater. 1971, 7(29), 7-11 (Russ.). Columbus, OH, USA: Chemical abstracts, Vol. 75, No. 20, 15 November 1971, page 163, column 1, the abstract No. 120718k.

*Example 2:* JP 3-002404 A (FUDO). Patent abstracts of Japan, Vol. 15, No. 105 (M-1092), 1991.03.13 (abstract).

*Example 3:* SU 1374109 A (KARELIN, V. I.) 1988.02.15. (abstract), Soviet Patent Abstracts, Section E1, Week 8836, London: Derwent Publications Ltd., Class S, AN 88-255351.

13. Identification of an electronic document, e. g., retrieved from a CD-ROM, the Internet or from an online database accessible outside the Internet, shall be made in the manner indicated in subparagraphs 12(a), (b), (c), and (d), above, as far as possible and completed, as suggested in the items below.

Attention is drawn to the following items which are modeled after guidelines provided by the International Organization for Standardization's established Standard ISO 690-2 "Information and documentation—Bibliographic references—Part 2: Electronic documents or parts thereof." These items should be provided in the locations indicated:

(i) Type of medium in square brackets [ ] after the title of the publication or the designation of the host document, e.g., [online] [CD-ROM] [disk]. If desired, the type of publication (e.g. monograph, serial, database, electronic mail) may also be specified in the type of medium designator;

(ii) Date when the document was retrieved from the electronic media in square brackets, following the date of publication [retrieved on 1998-03-04];

(iii) Identification of the source of the document using the words "Retrieved from" and its address where applicable; this item will precede the citation of the relevant passages;

(iv) Specific passages of the text could be indicated if the format of the document includes pagination or an equivalent internal referencing system, or by their first and last words.

Office copies of an electronic document should be retained if the same document may not be available for retrieval in the future. This is especially important for sources such as the Internet and online databases.

If an electronic document is also available in paper form or in a page-oriented presentation mode (see paragraph 12, above) it does not need to be identified as an electronic document, unless it is considered desirable or useful to do so.

The following examples illustrate citations of electronic documents:

*Examples 1-4:* Documents retrieved from online databases outside the Internet

*Example 1:* SU 1511467 A (BRYAN MECH) 1989-09-30 (abstract) World Patents Index [online]. London, U.K.: Derwent Publications, Ltd. [retrieved on 1998-02-24]. Retrieved from: Questel/Orbit, Paris, France. DW9016, Accession No. 90-121923.

*Example 2:* Dong, X. R. 'Analysis of patients of multiple injuries with AIS-ISS and its clinical significance in the evaluation of the emergency managements', Chung Hua Wai Ko Tsa Chih, May 1993, Vol. 31, No. 5, pages 301-302. (abstract) Medline [online]. Bethesda, MD, USA: United States National Library of Medicine [retrieved on 24 February 1998]. Retrieved from: Dialog Information Services, Palo Alto, CA, USA. Medline Accession no. 94155687, Dialog Accession No. 07736604.

*Example 3:* Jensen, B. P. 'Multilayer printed circuits: production and application II'. Electronik, June-July 1976, No. 6-7, pages 8, 10, 12, 14, 16. (abstract) INSPEC [online]. London, U.K.: Institute of Electrical Engineers [retrieved on 1998-02-24]. Retrieved from: STN International, Columbus, Ohio, USA. Accession No. 76:956632.

*Example 4:* JP 3002404 (TAMURA TORU) 1991-03-13 (abstract). [online] [retrieved on 1998-09-02]. Retrieved from: EPO PAJ Database.

*Examples 5-11:* Documents retrieved from the Internet

*Example 5:* (Entire Work—Book or Report) Wallace, S., and Bagherzadeh, N. Multiple Branch and Block Prediction. Third International Symposium on High-Performance Computer Architecture [online], February 1997 [retrieved on 1998-05-20]. Retrieved from the Internet:<URL: http://www.eng.uci.edu/comp.arch/papers-wallace/hpca3-block.ps>.

*Example 6:* (Part of Work—chapter or equivalent designation) National Research Council, Board on Agriculture, Committee on Animal Nutrition, Subcommittee on Beef Cattle Nutrition. Nutrient Requirements of Beef Cattle [online]. 7th revised edition. Washington, DC: National Academy Press, 1996 [retrieved on 1998-06-10]. Retrieved from the Internet: <URL: http://www2.nap.edu/htbin/docpage/title=Nutrient+Requirements+of+Beef+Cattle%3A+Seventh+Revised+Edition%2C+1996&dload=0&path= /ext5/extra&name=054265%2 Erdo&docid=00805F50FEb%3A840052612&colid=4%7C6%7C41&start=38> Chapter 3, page 24, table 3-1.

*Example 7:* (Electronic Serial—articles or other contributions) Ajtai. Generating Hard Instances of Lattice Problems. Electronic Colloquium on Computational Complexity, Report TR96-007 [online], [retrieved on 1996-01-30]. Retrieved from the Internet <URL: ftp://ftp.eccc.uni-trier.de/pub/eccc/reports/1996/TR96-007/index.html>.

*Example 8:* (Electronic bulletin boards, message systems, and discussion lists—Entire System) BIOMET-L (A forum for the Bureau of Biometrics of New York) [online]. Albany (NY): Bureau of Biometrics, New York State Health Department, July, 1990 [retrieved 1998-02-24]. Retrieved from the Internet: <listserv@health.state.ny.us>, message: subscribe BIOMET-L your real name.

*Example 9:* (Electronic bulletin boards, message systems, and discussion lists—Contributions) PARKER, Elliott. 'Re: citing electronic journals'. In PACS-L (Public Access Computer Systems Forum) [online]. Houston (TX): University of Houston Libraries, November 24, 1989; 13:29:35 CST [retrieved on 1998-02-24]-Retrieved from the Internet: <URL:telnet://bruser@a.cni.org>.

*Example 10:* (Electronic mail) 'Plumb design of a visual thesaurus'. The Scout Report [online]. 1998, vol. 5 no. 3 [retrieved on 1998 05 18]. Retrieved from Internet electronic mail: <listserv@cs.wisc.edu>, subscribe message: info scout-report. ISSN: 1092-3861.

*Example 11:* (Product Manual/Catalogue or other information obtained from a Web-site) Corebuilder 3500 Layer 3 High-function Switch. Datasheet [online]. 3Com Corporation, 1997 [retrieved on 1998-02-24].

Retrieved from the Internet: <URL: www.3com.com/products/dsheets/400347.html>.

*Examples 12 and 13:* Documents retrieved from CD-ROM products

*Example 12:* JP 0800085 A (TORAY IND INC), (abstract), 1996-05-31. In: Patent Abstracts of Japan [CD-ROM].

*Example 13:* Hayashida, O. et al.: Specific molecular recognition by chiral cage-type cyclophanes having leucine, valine, and alanine residues. In: Tetrahedron 1955, Vol. 51 (31), p. 8423-36. In: CA on CD [CD-ROM]. Columbus, OH: CAS. Abstract 124:9350.

14. It is recommended that any document (reference) referred to in paragraph 7 above, and cited in the search report should be indicated by the following letters or a sign to be placed next to the citation of the said document (reference):

(a) *Categories indicating cited documents (references) of particular relevance:*

Category "X": The claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone;

Category "Y": The claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art.

(b) *Categories indicating cited documents (references) of other relevant prior art:*

Category "A": Document defining the general state of the art which is not considered to be of particular relevance;

Category "D": Document cited by the applicant in the application and which document (reference) was referred to in the course of the search procedure. Code "D" should always be accompanied by one of the categories indicating the relevance of the cited document;

Category "E": Earlier patent document as defined in Rule 33.1(c) of the Regulations under the PCT, but published on or after the international filing date;

Category "L": Document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (the reason for citing the document shall be given);

Category "O": Document referring to an oral disclosure, use, exhibition or other means;

Category "P": Document published prior to the filing date (in the case of the PCT, the international filing date) but later than the priority date claimed in the application. Code "P" should always be accompanied by one of the categories "X," "Y" or "A;"

Category "T": Later document published after the filing date (in the case of the PCT, the international filing date) or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention;

Category "&": Document being a member of the same patent family or document whose contents have not been verified by the search examiner but are believed to be substantially identical to those of another document which the search examiner has inspected.

15. The list of cited documents (references) given in the search report should indicate, conforming to the generally recognized practice of the International Searching Authorities under the Patent Cooperation Treaty, the respective claim(s) of the patent application to which the citation is considered to be relevant.

16. The category codes referred to in paragraph 14, above, are intended primarily for use in the context of search reports accompanying published patent applications. However, if industrial property offices wish to indicate the relevance of cited documents (references) listed on the first page of a published patent application, they should print the category codes in parentheses, immediately after each citation.

**Note:** Further detailed information on definitions of terms used in this Standard or on the inclusion of references cited can be found in International Standard ISO 690:1987, "Documentation—Bibliographic References—Content, Form and Structure." Guidance for the abbreviation of titles of articles can be obtained through International Standard ISO 4:1997, "Information and Documentation—Rules for the Abbreviation of Title Words and Titles of Publications."

Examiners are encouraged to speak to a PTO librarian or technical information specialist when they find that crucial elements to the citation are lacking in their records.

The information specialist will work with the examiner to verify dates, authors, and other elements as needed.

**Notes:**

1. These elements are to be indicated only in a search report.

2. The elements of item (v), having relevance to a corrected patent document, should be indicated together with the other data referred to under subparagraph 12(a)(i) to (iii).

3. Where a surname can be identified, forenames or initials should follow the surname. Such surnames and initials should be given in capital letters.

4. When the year of publication coincides with the year of the application or of the priority claim, the month and, if necessary, the day of publication of a monograph or parts thereof should be indicated in accordance with the provisions set out in WIPO Standard ST.2.

Dated: June 14, 1999.

**Q. Todd Dickinson,**

*Acting Assistant Secretary of Commerce and Acting Commissioner of Patents and Trademarks.*

[FR Doc. 99-15696 Filed 6-18-99; 8:45 am]

**BILLING CODE 3510-16-P**

## DEPARTMENT OF DEFENSE

### Office of the Secretary

### Meeting of the President's Security Policy Advisory Board Action Notice

**SUMMARY:** The President's Security Policy Advisory Board has been established pursuant to Presidential Decision Directive/NSC-29, which was signed by President on September 16, 1994.

The Board will advise the President on proposed legislative initiatives and executive orders pertaining to U.S. security policy, procedures and practices as developed by the U.S. Security Policy Board, and will function as a federal advisory committee in accordance with the provisions of Pub. L. 92-463, the "Federal Advisory Committee Act."

The President has appointed from the private sector, three of five Board members each with a prominent background and expertise related to security policy matters. General Larry Welch, USAF (Ret.) will chair the Board. Other members include: Rear Admiral Thomas Brooks, USN (Ret.) and Ms. Nina Stewart.

The next meeting of the Advisory Board will be held on June 28, 1999 at 1400 hrs at the Hyatt Regency on the Mall, 1300 Nicollet Mall—Rm Nicollet A, Minneapolis, MN. The meeting will be open to the public.

This notice is submitted late because of Agenda changes and unexpected leave taken by the staff support specialist.

For further information please contact Mr. Bill Isaacs, telephone: 703-602-0815.

Dated: June 15, 1999.

**L.M. Bynum,**

*Alternate OSD Federal Register Liaison Officer, Department of Defense.*

[FR Doc. 99-15594 Filed 6-18-99; 8:45 am]

**BILLING CODE 5001-10-M**