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709 Suspension of Action [R-6]

37 CFR 1.103. Suspension of action by the Office.

(a) *Suspension for cause.* On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months. Any petition for suspension of action under this paragraph must also include:

(1) A showing of good and sufficient cause for suspension of action; and

(2) The fee set forth in § 1.17(g), unless such cause is the fault of the Office.

(b) *Limited suspension of action in a continued prosecution application (CPA) filed under § 1.53(d).* On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph in a continued prosecution application filed under § 1.53(d) for a period not exceeding three months. Any request for suspension of action under this paragraph must be filed with the request for an application filed under § 1.53(d), specify the period of suspension, and include the processing fee set forth in § 1.17(i).

(c) *Limited suspension of action after a request for continued application (RCE) under § 1.114.* On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph after the filing of a request for continued examination in compliance with § 1.114 for a period not exceeding three months. Any request for suspension of action under this paragraph must be filed with the request for continued examination under § 1.114, specify the period of suspension, and include the processing fee set forth in § 1.17(i).

(d) *Deferral of examination.* On request of the applicant, the Office may grant a deferral of examination under the conditions specified in this paragraph for a period not extending beyond three years from the earliest filing date for which a benefit is claimed under title 35, United States Code. A request for deferral of examination under this paragraph must include the publication fee set forth in § 1.18(d) and the processing fee set forth in § 1.17(i). A request for deferral of examination under this paragraph will not be granted unless:

(1) The application is an original utility or plant application filed under § 1.53(b) or resulting from entry of an interna-

tional application into the national stage after compliance with § 1.495;

(2) The applicant has not filed a nonpublication request under § 1.213(a), or has filed a request under § 1.213(b) to rescind a previously filed nonpublication request;

(3) The application is in condition for publication as provided in § 1.211(c); and

(4) The Office has not issued either an Office action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151.

(c) *Notice of suspension on initiative of the Office.* The Office will notify applicant if the Office suspends action by the Office on an application on its own initiative.

(f) *Suspension of action for public safety or defense.* The Office may suspend action by the Office by order of the Director if the following conditions are met:

(1) The application is owned by the United States;

(2) Publication of the invention may be detrimental to the public safety or defense; and

(3) The appropriate department or agency requests such suspension.

(g) *Statutory invention registration.* The Office will suspend action by the Office for the entire pendency of an application if the Office has accepted a request to publish a statutory invention registration in the application, except for purposes relating to patent interference proceedings under part 41, subpart D, of this title.

Suspension of action (37 CFR 1.103) should not be confused with extension of time for reply (37 CFR 1.136). It is to be noted that a suspension of action applies to an impending Office action by the examiner whereas an extension of time for reply applies to action by the applicant. In other words, the action cannot be suspended in an application which contains an outstanding Office action or requirement awaiting reply by the applicant. It is only the action by the examiner which can be suspended under 37 CFR 1.103.

Suspension of action under 37 CFR 1.103(a)-(d) at the applicant's request will cause a reduction in patent term adjustment accumulated (if any) under 37 CFR 1.703. The reduction is equal to the number of days beginning on the date a request for suspension of action was filed and ending on the date of the termination of the suspension. See 37 CFR 1.704(c)(1).

I. REQUEST BY THE APPLICANT

Request, 37 CFR Section	Requirement	Fee(s), 37 CFR Section	Maximum length of Suspension
1.103(a)	Petition with a showing of good and sufficient cause.	1.17(g)	6 months
1.103(b)	Request at the time of filing a CPA	1.17(i)	3 months
1.103(c)	Request at the time of filing an RCE	1.17(i)	3 months
1.103(d)	See below in “Deferral of Examination”	1.17(i)&1.18(d)	3 yrs. from earliest filing date for which a benefit is claimed under Title 35.

A. *Petition Under 37 CFR 1.103(a) With a Showing of Good and Sufficient Cause*

A request that action in an application be delayed will be granted only under the provisions of 37 CFR 1.103, which provides for “Suspension of Action.” A petition for suspension of action under 37 CFR 1.103(a) must:

- (A) be presented as a separate paper;
- (B) be accompanied by the petition fee set forth in 37 CFR 1.17(g);
- (C) request a specific and reasonable period of suspension not greater than 6 months; and
- (D) present good and sufficient reasons why the suspension is necessary.

If the requirements of 37 CFR 1.103(a) are not met, applicants should expect that their applications, whether new or amended, will be taken up for action by the examiner in the order provided in MPEP § 708, Order of Examination.

A petition for suspension of action to allow applicant time to submit an information disclosure statement will be denied as failing to present good and sufficient reasons, since 37 CFR 1.97 provides adequate recourse for the timely submission of prior art for consideration by the examiner.

In new applications, the mere inclusion in the transmittal form letter of a request that action be delayed cannot be relied upon to avoid immediate action in the application. However, applicant may consider filing a

request for deferral of examination under 37 CFR 1.103(d) (see below for the requirements). Applicants should be aware of the possibility of requesting suspension of action by the Office under 37 CFR 1.103(b) or (c) for a period not exceeding three months at the time of filing a continued prosecution application (CPA) under 37 CFR 1.53(d) if the application is a design application, or a request for continued examination (RCE) under 37 CFR 1.114. Note that effective July 14, 2003, CPA practice does not apply to utility and plant applications. Many Technology Center (TC) art units and examiners have short pendency to first action, and new applications may be taken up for action before preliminary amendments are filed in those applications. Where a preliminary amendment and petition to suspend action have been filed, it would be helpful to telephone the examiner in that regard to avoid having the amendment and the first Office action cross in the mail. The following form paragraphs should be used to notify the grant or denial of the petition under 37 CFR 1.103(a):

¶ 7.54 *Suspension of Action, Applicant’s Request*

Pursuant to applicant’s request filed on [1], action by the Office is suspended on this application under 37 CFR 1.103(a) for a period of [2] months. At the end of this period, applicant is required to notify the examiner and request continuance of prosecution or a further suspension. See MPEP § 709.

Examiner Note:

1. Maximum period for suspension is 6 months.

2. Only the Technology Center Director can grant second or subsequent suspensions. See MPEP § 1003. Such approval must appear on the Office letter.

¶ *7.56 Request for Suspension, Denied, Outstanding Office Action*

Applicant's request filed [1], for suspension of action in this application under 37 CFR 1.103(a), is denied as being improper. Action cannot be suspended in an application awaiting a reply by the applicant. See MPEP § 709.

A supplemental reply will be entered if it is filed within the period during which action is suspended by the Office under 37 CFR 1.103(a). See MPEP § 714.03(a) regarding supplemental reply.

B. Request for Suspension Under 37 CFR 1.103(b) or (c)

Applicants may request a suspension of action by the Office under 37 CFR 1.103(b) or (c) for a period not exceeding three months in a continued prosecution application (CPA) filed under 37 CFR 1.53(d) if the application is a design application, or in a continued examination (RCE) filed under 37 CFR 1.114. The request for suspension must be filed at the time of filing of the CPA or RCE.

A supplemental reply will be entered if it is filed within the period during which action is suspended by the Office under 37 CFR 1.103(c). See MPEP § 714.03(a) regarding supplemental reply.

1. Requirements

The Office will not grant the requested suspension of action unless the following requirements are met:

(A) the request must be filed with the filing of a design CPA or an RCE (applicants may use the check box provided on the transmittal form PTO/SB/29 or PTO/SB/30, or submit the request on a separate paper);

(1) if the request is filed with an RCE, the RCE must be in compliance with 37 CFR 1.114, i.e., the RCE must be accompanied by a submission and the fee set forth in 37 CFR 1.17(e). Note that the payment of the RCE filing fee may not be deferred and the request for suspension cannot substitute for the submission;

(2) if the request is filed with a CPA, a filing date must be assigned to the CPA;

(B) the request should specify the period of suspension in a whole number of months (maximum of 3 months). If the request specifies no period of suspension or a period of suspension that exceeds 3 months, the Office will assume that a 3-month suspension is requested; and

(C) the request must include the processing fee set forth in 37 CFR 1.17(i).

2. Missing Parts for the CPA (Filing Date Granted)

If the Office assigns a filing date to the design CPA, the request for suspension will be processed, even if the CPA was not accompanied by the CPA basic filing fee, the search fee, and the examination fee. The suspension request acts to suspend a first Office action by the examiner but will not affect the processing of the CPA for a missing part. The applicant will be given a notice that provides a time period of 2 months from the date of the notification to pay the CPA basic filing fee, the search fee, the examination fee, and the surcharge set forth in 37 CFR 1.16(f). Applicant must pay the CPA basic filing fee, the search fee, the examination fee, and the surcharge within 2 months to avoid the abandonment of the CPA. Pursuant to applicant's request for suspension, the action by the Office will be suspended on the CPA for the period requested by the applicant, starting on the filing date of the CPA.

3. Improper RCE or CPA (No Filing Date Granted)

If the CPA or the RCE is improper (e.g., a filing date was not accorded in the CPA or the RCE was filed without a submission or the RCE fee), the Office will not recognize the request for suspension, and action by the Office will not be suspended. A notice of improper CPA or RCE will be sent to applicant as appropriate. The time period set in the previous Office communication (e.g., a final Office action or a notice of allowance) continues to run from the mailing date of that communication. If applicant subsequently files another RCE, the request for suspension should be resubmitted to ensure that the Office processes the request for suspension properly. The request for suspension of action will not be processed until the Office accords a filing date to the CPA or receives a proper RCE in compliance with 37 CFR 1.114.

4. Improper Request for Suspension

If the CPA or the RCE is properly filed, but the request for suspension is improper (e.g., the request for suspension was filed untimely or without the processing fee set forth in 37 CFR 1.17(i)), action by the Office will not be suspended on the application. The Office will process the CPA or RCE and place the application on the examiner's docket. The examiner will notify the applicant of the denial of the request in the next Office communication using the following form paragraph:

¶ 7.56.01 *Request for Suspension of Action under 37 CFR 1.103, Denied*

Applicant's request filed [1], for suspension of action in this application under 37 CFR 1.103(b) or (c) is denied as being improper. The request was (1) not filed at the time of filing a CPA or RCE, and/or (2) not accompanied by the requisite fee as set forth in 37 CFR 1.17(i). See MPEP § 709.

Examiner Note:

In bracket 1, insert the filing date of the request for suspension of action.

5. Proper Request for Suspension

If the CPA or the RCE and the request for suspension of action are proper, the Office's technical support staff will process the CPA or RCE, and the request for suspension of action. A notification of the approval of the request for suspension will be sent to the applicant. The application will be placed in suspension status until the end of the suspension period. The suspension request acts to suspend a first Office action by the examiner. Once the suspension period has expired, the application will be placed on the examiner's docket for further prosecution.

C. *Request for Deferral of Examination Under 37 CFR 1.103(d)*

In new applications, applicants may request a deferral of examination under 37 CFR 1.103(d) for a period not extending beyond three years from the earliest filing date for which a benefit is claimed under 35 U.S.C. 119(a)-(d), (e), (f), 120, 121, or 365. The request must be filed before the Office issues an Office action under 35 U.S.C. 132 or a notice of allowance in the application. The suspension will start on the day that the Office grants the request for deferral of examination. Once the deferral of examination has been granted, the application will not be taken up

for action by the examiner until the suspension period expires. For example, if an applicant files a request for deferral of examination under 37 CFR 1.103(d) for the maximum period permitted under the rule in an application that claims priority of a foreign application filed 1/3/00, the action by the Office on the application will be suspended and the application will automatically be placed in a regular new case status on the examiner's docket on 1/4/03 (36 months from the effective filing date of the application, i.e., 1/3/00).

1. Requirements

Form PTO/SB/37 (reproduced at the end of this section) may be used to submit a request for deferral of examination under 37 CFR 1.103(d).

A request for deferral of examination under 37 CFR 1.103(d) must include:

- (A) a period of suspension, in a whole number of months, not extending beyond three years from the earliest effective filing date (if the request includes no period of suspension or a period that exceeds the maximum period permitted under the rule, i.e., beyond 3 years from the earliest effective filing date, the Office will assume that the maximum period is requested);
- (B) the publication fee set forth in 37 CFR 1.18(d); and
- (C) the processing fee set forth in 37 CFR 1.17(i).

The Office will not grant a deferral of examination unless the following conditions are met:

- (A) the application must be
 - (1) an original utility or plant application filed under 37 CFR 1.53(b) **or**
 - (2) an application resulting from entry of an international application into the national stage after compliance with 37 CFR 1.495 (the application cannot be a design application, a reissue application, or a CPA under 37 CFR 1.53(d));
- (B) the application must be filed on or after November 29, 2000 (the effective date of the eighteen month publication provisions of the AIPA);
- (C) the applicant has not filed a nonpublication request under 37 CFR 1.213(a), **or** if a nonpublication request has been filed in the application, the applicant must file a request under 37 CFR 1.213(b) to rescind a previously filed nonpublication request (see the second check box on the form PTO/SB/37);

(D) the application must be in condition for publication as provided in 37 CFR 1.211(c) (if the application has been forwarded to the Technology Center by the Office of Initial Patent Examination (OIPE), the application can be assumed to be in condition for publication); and

(E) the Office has not issued either an Office action under 35 U.S.C. 132 (e.g., a restriction, a first Office action on the merits, or a requirement under 37 CFR 1.105) or a notice of allowance under 35 U.S.C. 151.

2. Improper Request

If the request is improper, the following form paragraphs may be used to notify the applicant of the denial of the request:

¶ 7.56.02 Request for Deferral of Examination under 37 CFR 1.103(d), Denied

Applicant's request filed on [1], for deferral of examination under 37 CFR 1.103(d) in the application is denied as being improper. [2]

See MPEP § 709.

Examiner Note:

1. In bracket 1, insert the filing date of the request for deferral of examination.
2. In bracket 2, insert the reason(s) for denying the request. For example, if appropriate insert --The applicant has not filed a request under 37 CFR 1.213(b) to rescind the previously filed nonpublication request--; --A first Office action has been issued in the application--; or --Applicant has not submitted a request for voluntary publication under 37 CFR 1.221--.

3. Proper Request

A supervisory patent examiner's approval is required for the grant of a deferral of examination in an application. If the request is proper, the following form paragraph may be used to notify applicant that the request for deferral has been granted:

¶ 7.54.01 Request for Deferral of Examination under 37 CFR 1.103(d), Granted

Applicant's request filed on [1], for deferral of examination under 37 CFR 1.103(d) in the application has been approved. The examination of the application will be deferred for a period of [2] months.

Examiner Note:

1. In bracket 1, insert the filing date of the request for deferral of examination.
2. In bracket 2, insert the number of months for the deferral.

D. Termination of Suspension of Action

Once the request for suspension of action under 37 CFR 1.103 has been approved, action on the application will be suspended until the suspension period has expired, unless the applicant submits a request for termination of the suspension of action prior to the end of the suspension period. The request for termination of a suspension of action will be effective when an appropriate official of the Office takes action thereon. If the request for termination properly identifies the application and the period of suspension has not expired when the Office acts on the request, the Office will terminate the suspension and place the application on the examiner's docket. An acknowledgment should be sent to the applicant using the following form paragraph:

¶ 7.54.02 Request for Termination of a Suspension of Action, Granted

Applicant's request filed on [1], for termination of a suspension of action under 37 CFR 1.103, has been approved. The suspension of action has been terminated on the date of mailing this notice.

Examiner Note:

In bracket 1, insert the filing date of the request for termination of the suspension of action.

II. AT THE INITIATIVE OF THE OFFICE

Suspension of action at the initiative of the Office should be avoided, if possible, because such suspension will cause delays in examination, will increase pendency of the application, and may lead to a shortening of the effective patent term or, conversely, patent term extension, or adjustment, due to the suspension. Once a suspension of action has been initiated, it should be terminated immediately once the reason for initiating the suspension no longer exists, even if the suspension period has not expired.

37 CFR 1.103(e) provides that the Office will notify applicant if the Office suspends action in an application on its own initiative. Every suspension of action initiated by the Office will be limited to a time period of a maximum of 6 months. An examiner may grant an initial suspension of Office action on his or her own initiative, as in MPEP § 709.01 and MPEP Chapter 2300, for a maximum period of 6 months. A notification of suspension must be mailed to the applicant for each Office-initiated suspension of action, even for second or subsequent suspensions, and must include a suspension period (a maximum of 6

months). When the suspension period has expired, the examiner should take up action on the application or evaluate all possibilities for giving an action on the merits. For example, if a reference is still not available after waiting for six months, the examiner should try to find another source for the information or update the search to find another reference that can be used to make a rejection. If, in an extraordinary circumstance, a second or subsequent suspension is necessary, the examiner must obtain the TC director's approval (see MPEP § 1003) and prepare another suspension notification with a suspension period (a maximum of 6 months). The notification for a second or subsequent suspension must be signed by the TC Director.

Suspension of action under 37 CFR 1.103(f) is decided by the TC Director of work group 3640.

The following form paragraphs should be used in actions relating to suspension of action at the initiative of the Office.

¶ 7.52 *Suspension of Action, Awaiting New Reference*

A reference relevant to the examination of this application may soon become available. *Ex parte* prosecution is SUSPENDED FOR A PERIOD OF [1] MONTHS from the mailing date of this letter. Upon expiration of the period of suspension, applicant should make an inquiry as to the status of the application.

Examiner Note:

1. Maximum period for suspension is six months.
2. The TC Director must approve all second or subsequent suspensions, see MPEP § 1003.
3. The TC Director's signature must appear on the letter granting any second or subsequent suspension.

¶ 7.53 *Suspension of Action, Possible Interference*

All claims are allowable. However, due to a potential interference, *ex parte* prosecution is SUSPENDED FOR A PERIOD OF [1] MONTHS from the mailing date of this letter. Upon expiration of the period of suspension, applicant should make an inquiry as to the status of the application.

Examiner Note:

1. Maximum period for suspension is six months.
2. The TC Director must approve all second or subsequent suspensions, see MPEP § 1003.
3. The TC Director's signature must appear on the letter granting any second or subsequent suspension.