

TERMINAL DISCLAIMER (WITH JOINT RESEARCH AGREEMENT ENFORCEMENT PROVISION) IN A PATENT OR PROCEEDING IN VIEW OF A REFERENCE APPLICATION																								
Application/Control Number:	Filing Date:	Patent Number:																						
First Named Inventor:	Docket Number (Optional):																							
Title of Invention:																								
Note: Filing of a terminal disclaimer does not obviate the requirement to respond to an outstanding Office action. To respond to a non-final action, a reply under 37 CFR 1.111 is required. To respond to a final action, a reply under 37 CFR 1.113 is required.																								
<p>For <u>each</u> reference application listed below, the patentee,</p> <p>_____</p> <p>_____</p> <p>_____</p> <p>_____</p> <p>,</p> <p>owner of _____ percent interest in the instant patent hereby disclaims, except as provided below, the terminal part of the statutory term of the instant patent which would extend beyond the expiration date of the full statutory term of any patent granted on the reference application, as the term of any patent granted on the reference application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the reference application. The patentee waives the right to separately enforce the instant patent and any patent granted on the reference application. The patentee agrees that the instant patent shall be enforceable only for and during such period that the instant patent and any patent granted on the reference application are not separately enforced. The waiver and this agreement run with instant patent and are binding upon the patentee, its successors, or assigns.</p> <p>In making the above disclaimer, the patentee does not disclaim the terminal part of the statutory term of the instant patent that would extend to the expiration date of the full statutory term of any patent granted on the reference application, "as the term of any patent granted on the reference application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the reference application," in the event that any such patent granted on the reference application: expires for failure to pay a maintenance fee; is held unenforceable; is found invalid by a court of competent jurisdiction; is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321; has all claims canceled by a reexamination certificate; is reissued; or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.</p> <table border="1"><thead><tr><th>Reference Application Number</th><th>Filing Date</th></tr></thead><tbody><tr><td>_____</td><td>_____</td></tr><tr><td>_____</td><td>_____</td></tr><tr><td>_____</td><td>_____</td></tr><tr><td>_____</td><td>_____</td></tr><tr><td>_____</td><td>_____</td></tr><tr><td>_____</td><td>_____</td></tr><tr><td>_____</td><td>_____</td></tr><tr><td>_____</td><td>_____</td></tr><tr><td>_____</td><td>_____</td></tr><tr><td>_____</td><td>_____</td></tr></tbody></table>			Reference Application Number	Filing Date	_____	_____	_____	_____	_____	_____	_____	_____	_____	_____	_____	_____	_____	_____	_____	_____	_____	_____	_____	_____
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I. Requirements to establish a joint research agreement (JRA) for each reference application identified in this terminal disclaimer

A. Statement under 37 CFR 1.104(c)(4)(ii)(A) or 37 CFR 1.104(c)(5)(ii)(A) as applicable. Check either box 1 or 2.

Patentee hereby certifies that a statement ("JRA statement") in accordance with 37 CFR 1.104(c)(4)(ii)(A) or 37 CFR 1.104(c)(5)(ii)(A)

1. ☐ was previously filed on _____.
2. ☐ is concurrently being submitted with this terminal disclaimer.

Note: For the requirements of the JRA statement, see either (1) 35 U.S.C. 102(c), 37 CFR 1.104(c)(4)(ii)(A) and MPEP 717.02(a)(II) if the instant patent is subject to the First-Inventor-to-File provision of the AIA; or (2) pre-AIA 35 U.S.C. 103(c)(2), 37 CFR 1.104(c)(5)(ii)(A), and MPEP 2146.02 if the instant patent is subject to 35 U.S.C. 102 in effect on March 15, 2013.

Example of a statement under 37 CFR 37 CFR 1.104(c)(4)(ii)(A):

The subject matter of U.S. Application No. XX,XXX,XXX [this is the reference identified in the terminal disclaimer] was developed and the claimed invention of the instant patent was made by or on behalf of one or more the parties to a joint research agreement, within the meaning of 35 U.S.C. 100(h) and 37 CFR 1.9(e), that was in effect on or before the effective filing date the claimed invention, and the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement.

Example of a statement under 37 CFR 37 CFR 1.104(c)(5)(ii)(A):

The subject matter of U.S. Application No. XX,XXX,XXX [this is the reference identified in the terminal disclaimer] was developed and the claimed invention of the instant patent was made by or on behalf of the parties to a joint research agreement, within the meaning of 35 U.S.C. 100(h) and 37 CFR 1.9(e), which was in effect on or before the date the claimed invention was made, and the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement.

B. Specification discloses parties to the JRA. See 37 CFR 1.104(c)(4)(ii)(B) or 37 CFR 1.104(c)(5)(ii)(B). Check either box 1, 2, or 3.

Patentee hereby certifies that the specification of the instant patent

1. ☐ discloses the names of the parties to the JRA.
2. ☐ was previously amended on _____ to disclose the names of the parties to the JRA.
3. ☐ is concurrently being amended to disclose the names of the parties to the JRA.

C. Fee in 37 CFR 1.17(i)(1) for amendment under 37 CFR 1.71(g)(1) to name parties to the JRA. Check either box 1, 2, or 3.

1. ☐ Patentee hereby certifies that the fee set forth in 37 CFR 1.17(i)(1) is not required because the specification as filed discloses the names of the parties to the JRA, and no untimely amendment under 37 CFR 1.71(g)(1) was filed to name different or additional parties to the JRA.
2. ☐ Patentee hereby certifies that the fee set forth in 37 CFR 1.17(i)(1) as required by 37 CFR 1.71(g)(2) for an untimely amendment naming the parties to the JRA was paid on _____.
3. ☐ Patentee hereby certifies that the fee set forth in 37 CFR 1.17(i)(1) is not required because the amendment naming the parties to the JRA was filed within one of the time periods set forth in 37 CFR 1.71(g)(2).

Note: A certificate of correction may be required if the amendment was filed after the date the issue fee was paid. See 37 CFR 1.71(g)(3).

II. Whether each reference application identified in this terminal disclaimer is prior art. Check either box 1 or 2.

37 CFR 1.321(d) requires that the reference that the nonstatutory double patenting is based upon is not commonly owned and was disqualified as prior art as set forth in either 37 CFR 1.104(c)(4)(ii) or (c)(5)(ii). Patentee hereby certifies that

1. ☐ each reference application identified in this terminal disclaimer is not commonly owned and is prior art under 35 U.S.C. 102(a)(2) or pre-AIA 35 U.S.C. 102(e), (f), or (g) before any prior art exceptions are considered.
2. ☐ at least one reference application identified in this terminal disclaimer is **NOT** prior art under 35 U.S.C. 102(a)(2) or under pre-AIA 35 U.S.C. 102(e), (f), or (g) before any prior art exceptions are considered. **A petition under 37 CFR 1.183 requesting waiver of the prior art requirement in 37 CFR 1.321(d) is concurrently filed with this terminal disclaimer.**

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

III. Check either box 1, 2, or 3 below, as appropriate.

1. ☐ The current ownership was established by the filing of a statement under 37 CFR 3.73 during prosecution of the application that issued as the instant patent.
2. ☐ The instant patent was issued from an application filed on or after September 16, 2012, and the current patent owner was the applicant under 37 CFR 1.46.
3. ☐ A statement under 37 CFR 3.73 is attached herewith. Form PTO/SB/96 or PTO/AIA/96, as appropriate, may be used.

IV. A terminal disclaimer fee is required for each terminal disclaimer filed. Check either box 1 or 2 below.

1. ☐ The terminal disclaimer fee under 37 CFR 1.20(d) is included.
2. ☐ The terminal disclaimer fee under 37 CFR 1.20(d) was previously paid.

NOTE: If the terminal disclaimer fee under 37 CFR 1.20(d) has been increased since the fee was previously paid, then applicant must pay the difference between the increased fee and the amount previously paid.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on form PTO-2038.

V. Authorization for this terminal disclaimer - Check either box 1 or 2 below, if appropriate:

1. ☐ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.
2. ☐ The undersigned is an attorney or agent of record. Reg. No. _____

I hereby acknowledge that any willful false statements made are punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.

_____ Signature	_____ Date
_____ Typed or printed name	_____ Telephone number
_____ Title	

NOTE: Submit multiple forms if more than one signature is required, see below.*

☐ *Total of _____ forms are submitted.

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