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TERMINAL DISCLAIMER (WITH JOINT RESEARCH AGREEMENT ENFORCEMENT PROVISION) TO OBVIATE A PROVISIONAL NONSTATUTORY DOUBLE PATENTING REJECTION OVER A REFERENCE APPLICATION

Application Number:

Docket Number (Optional):

First Named Inventor:

Filing Date:

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 or a request for reconsideration is required. See MPEP §§ 706.07(e) and 714.13.

For each reference application listed below, the applicant,

owner of _____ percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application 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 applicant of the instant application waives the right to separately enforce any patent granted on the instant application and any patent granted on the reference application. The applicant of the instant application hereby agrees that any patent granted on the instant application shall be enforceable only for and during such period that any patent granted on the instant application and any patent granted on the reference application are not separately enforced. The waiver and this agreement run with any patent granted on the instant application and are binding upon the applicant of the instant application, its successors, or assigns.

In making the above disclaimer, the applicant does not disclaim the terminal part of the statutory term of any patent granted on the instant application 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.

Reference Application Number

Filing Date

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This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public, i.e., to prosecute a patent application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take **XX minutes** to complete, including gathering, preparing, and submitting the completed form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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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.**

Applicant 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 application 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 application 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 application 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 application 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.

Applicant hereby certifies that the specification of the instant application

1. ☐ as filed 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. ☐ Applicant 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. ☐ Applicant 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. ☐ Applicant 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). Applicant 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.**

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III. 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.

IV. Authorization for this terminal disclaimer - Check either box 1 or 2 below.

1. ☐ The undersigned is the applicant. If the applicant is an assignee, the undersigned is authorized to act on behalf of the assignee.
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.

Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. The United States Patent and Trademark Office (USPTO) collects the information in this record under authority of 35 U.S.C. 2. The USPTO's system of records is used to manage all applicant and owner information including name, citizenship, residence, post office address, and other information with respect to inventors and their legal representatives pertaining to the applicant's/owner's activities in connection with the invention for which a patent is sought or has been granted. The applicable Privacy Act System of Records Notice for the information collected in this form is COMMERCE/PAT-TM-7 Patent Application Files, available in the Federal Register at 78 FR 19243 (March 29, 2013), <https://www.govinfo.gov/content/pkg/FR-2013-03-29/pdf/2013-07341.pdf>.

Routine uses of the information in this record may include disclosure to: 1) law enforcement, in the event that the system of records indicates a violation or potential violation of law; 2) a federal, state, local, or international agency, in response to its request; 3) a contractor of the USPTO having need for the information in order to perform a contract; 4) the Department of Justice for determination of whether the Freedom of Information Act (FOIA) requires disclosure of the record; 5) a Member of Congress submitting a request involving an individual to whom the record pertains, when the individual has requested the Member's assistance with respect to the subject matter of the record; 6) a court, magistrate, or administrative tribunal, in the course of presenting evidence, including disclosures to opposing counsel in the course of settlement negotiations; 7) the Administrator, General Services Administration (GSA), or their designee, during an inspection of records conducted by GSA under authority of 44 U.S.C. 2904 and 2906, in accordance with the GSA regulations and any other relevant (i.e., GSA or Commerce) directive, where such disclosure shall not be used to make determinations about individuals; 8) another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)); 9) the Office of Personnel Management (OPM) for personnel research purposes; and 10) the Office of Management and Budget (OMB) for legislative coordination and clearance.

If you do not furnish the information requested on this form, the USPTO may not be able to process and/or examine your submission, which may result in termination of proceedings, abandonment of the application, and/or expiration of the patent.