

Chapter 1700

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1701 Examiners Not To Express Opinion on Validity Nor Testify as Patent Experts

Inasmuch as public policy does not permit Examiners to decide, as judges in the Patent Office, questions upon which they have been retained to give opinions as expert witnesses in patent cases in the courts, every Examiner who shall testify as an expert in a patent case pending in any court will be dismissed, unless he shall have so testified involuntarily, upon compulsion by competent judicial authority, and without retainer or preparation.

Congress, in 35 U.S.C. 282, has endowed every patent granted by the Patent Office with a presumption of validity. Public policy demands that every employee of this Office refrain from expressing to any interested person any opinion or view as to the invalidity of any U.S. Patent. The question of validity or invalidity is exclusively a matter for the courts to determine. Each member of the examining corps is cautioned to be especially wary of any inquiry from any person outside the Patent Office (including any employee of another government agency), the answer to which might indicate that a particular patent should not have been issued.

Whenever an examiner is asked or subpoenaed to testify in a suit concerning a patent, trademark registration, or application for either, he is directed to report that fact *immediately* to the Solicitor.

Examiners are cautioned against answering inquiries from any person outside the Patent Office as to whether or not a certain reference was considered and, *a fortiori*, whether or not a claim would have been allowed over that reference. This applies to anything in the patented file, including the extent of the field of search and any entry relating thereto. The record of a patented file must speak for itself.

Practitioners can be of material assistance in this regard by refraining from making such inquiries of members of the examining staff. Answers to inquiries of this nature must of necessity be refused, and such refusal should be considered neither discourteous nor an expression of opinion as to validity.

Also, Examiners are reminded that, in view of the long established policy of the Patent Office to refuse to permit members of the staff of the Patent Office to testify in patent suits, they should, before allowing an application, determine that the written record is accurate and complete.

1702 Restrictions on Examiners Resigning From the Office

Extract from Rule 341. Registration of Attorney and Agents. (g) Former examiners. No person who has served in the examining corps of the Patent Office will be registered after termination of his services, nor, if registered before such service, be reinstated, unless he undertakes (1) not to prosecute or aid in any manner in the prosecution of any application pending in any examining division in which he served, on the date he left said division; and (2) not to prepare or prosecute nor to assist in any manner in the preparation or prosecution of any application of another filed within two years after the date he left such division, and assigned to such division, without the specific authorization of the Commissioner. Associated and related classes in other divisions may be required to be included in the undertaking or designated classes may be excluded. In case application for registration or reinstatement is made after resignation from the Office, the applicant will not be registered, or reinstated, if he has prepared or prosecuted, or assisted in the preparation or prosecution of any such application as indicated in this paragraph.

In the above rule, "examining division" is interpreted as synonymous with "examining group".

See also 309.

1703 The Official Gazette

The *Official Gazette* reports every Tuesday the patents, design patents and trademark registrations issued on that day. As to each patent, the following information is given:

(1) the name and (2) the city and state of residence of the applicant with the Post Office address in the case of unassigned patents, and (3) the same data for the assignee, if any, (4) the filing date, and (5) the serial number of the application, (6) the patent number, (7) the title of the invention, (8) the number of claims, (9) the class and subclass, (10) a selected figure of the drawing, if any, except in the case of a plant patent, and (11) a typical claim. In the case of a reissue patent there are published the additional data of the number and date of the original patent and original application; and in the case of a design patent the term of the patent.

Various trademark notices and publications are also included.

The *Gazette* includes a section devoted to reports of patent and trademark decisions and notices of a variety of matters; disclaimers, adjudicated patents, patent and trademark suits, certain adverse decisions in interferences, the condition of work in the Office, changes in rules, disbarment of attorneys, and notices to parties not reached by mail.

The patent and trademark decisions in this section include in particular those of the United States Court of Customs and Patent Appeals, the U.S. Supreme Court, and the U.S. Court of Appeals for the District of Columbia Circuit, and selected decisions of the Commissioner of Patents and Board of Appeals. These decisions constitute such important statements of the law that the notice and decision section is separately printed in leaflet form and is distributed to the Examiners.

1704 Records Kept in Examining Groups

The principal records kept in the examining groups are two sets of cards, Form PO-205 which are arranged numerically and Form PO-206, of which those awaiting action are arranged by individual examiners. Each card contains data concerning the applications that have been assigned to the groups, identified by name of applicant, title of invention, serial number and filing date. Notation of attorneys is also made. Each set of cards also shows the name of the examiner to whom the examination is entrusted or the assigned docket designation and the class and subclass considered most pertinent for examination, the successive actions taken, and finally the patenting or abandonment or transfer of the case.

Miscellaneous records are also kept relating to matters such as cases on appeal, cases involved in interference, patentability report cases temporarily in or out of the groups,

cases involving classification questions and applications or references charged out.

1705 Examiner's Work Report and Actions To Be Counted Thereon

All reporting of examiner's production, docket, and time activities is on a bi-weekly basis corresponding to the period covered by the Time and Attendance Reports, PO-516.

Data Processing Branch makes the following reports for each art unit:

Examiner's Bi-Weekly Docket Activity Report, PO-290 (rev.)—This report covers information regarding the new and amended applications awaiting action. The information is from the PO-690 (rev.) prepared by the clerk and from PO-526 Case Disposition Record Cards prepared by the examiner.

Examiner's Bi-Weekly Time and Activity Report, PO-912—This report is based on the examiner's Case Action Record, Case Action correction, Case Disposition, and Substitution Cards, PO-525, PO-531, PO-532 and PO-533, respectively.

Examiners are directed to count all cases in which actions have been prepared (that is, the actions that have been written in long hand or dictated) irrespective of whether they have been typed or mailed. The dates of the various desks shall be advanced and reported as the actions are counted. The oldest dates of the group reported shall not be advanced except as the actions are mailed.

The following only are counted as actions:

1. Regular actions in new and amended cases.

2. One action for each application which consists only in suggesting claims for interference and one for each application in declaring each interference.

3. Examiner's statements in answer to petitions from his actions.

4. Examiner's answers on appeals.

5. Decisions on motions in interference.

6. Letters advising of entry or nonentry of amendment after final action.

7. Letter advising applicant that express abandonment has taken place and the file will be sent to the Abandoned Files Unit in due course.

8. Declaration or redeclaration of an interference.

By "regular" action is meant rejections, including requirements for restriction; letters or allowances by the Examiner as the result of the examination of a new application or the reconsideration or reexamination of an amended application; requirements for formal changes or corrections; actions of the Exam-

iner applying or carrying into effect final decisions in interference, either on motions or on priority; actions on cases remanded by an appellate tribunal for reconsideration in view of affidavits or proposed further amendments by appellants. Where more than one amendment is filed in any case before it is reached for consideration of the first of such amendments, only one action will be counted in connection with all such amendments.

The following should not be counted as actions: Examiner's Amendments; supplemental actions citing additional references or correcting the data of references of record; letters acknowledging receipt of communications (new or supplemental oaths, orders for corrections of drawings, etc.), which do not bring the application up for action; letters stating that the Notice of Allowance will be sent in due course (Sec. 1207) and answers to petitions to revive or to make cases special, amendments under Rule 312, and to status letters. Transfers of individual cases and patentability reports are not counted as actions, but credit is given for the time spent.

Examiners are expected to make a reasonably careful examination of applications when they are first received to determine the proper classification before entering them on the register.

Non-Examining time is listed on Examiner's Periodic Record of "Other" Time PO-690E (rev.). Examiners should check this in order to make sure that they are properly credited with such time.

1710 U.S.-German Search Exchange

The German and U.S. Patent Offices have initiated a continuing program for exchanging search results in cases where applications for the same inventions are filed in both countries.

In general, the plan provides that where an application is filed in the U.S. and LATER a corresponding application claiming U.S. priority is filed in Germany (U.S. origin application), the U.S. search results are sent to the German Patent Office after the first action on the merits. Conversely, the U.S. Patent Office receives a list of references cited by the German examiner in his action on an application filed first in Germany and later in the U.S. (German origin application).

The Office of Patent Services, primarily through the newly set up Foreign Exchange Section, is responsible for processing all matters in connection with the exchange program in cooperation with the examining Groups.

1710.01 U.S. Origin Applications

The German Patent Office will identify German applications which refer to a prior application for patent in the U.S. for the same invention, and request a search report from the U.S. This request is on a printed sheet (blue), designated by them as Form B, which gives the serial number of the U.S. application, and the Application Number of the German application.

The Foreign Exchange Section of Special Services receives and processes the forms. Where the application has been disposed of or has already received an action on the merits, the Foreign Exchange Section will prepare from the files the list of citations for the German office. If the U.S. application has not yet been acted on, a printed Notice is placed in the inside left section of the file jacket to advise the Examiner and the Examining Group that the search results will be furnished Germany when the action is written. This Notice also contains information to assist the Group in handling such cases.

The application will be acted on by the examiner when its regular turn is reached except that if it is over 24 months old or when it becomes 24 months old, it is to be made "Special" for the purpose of the first action, or if it is "Special" for some other reason.

When preparing the first action on the merits which contains reference citations, the examiner, when filling out PO-892, Notice of References Cited, will check the box at the bottom marked "Foreign Exchange" and will detach the Notice and include it in the folder with PO-892 which is forwarded to the Reference Order Center.

If the first action on the merits does not cite any references, or if the application is being passed to issue on the first action, the clerk will check the appropriate place on the Notice and return it to the Foreign Exchange Section.

1710.02 German Origin Applications

In the case of a U.S. application which refers to a prior German application for the same invention, German search results are requested by the Foreign Exchange Section when the U.S. applications are received in Application Branch. A form, PO-952, identifying the U.S. and German applications is completed and forwarded to the German Patent Office. At the same time, a Notice containing information to assist the Group in handling the application is inserted in the left inside section of the file jacket to advise the Group that search results may be expected.

In addition to the newly filed applications, cases already pending are included in the program. The Foreign Exchange Section will identify and locate applications in the Group, insert a copy of the Notice in the file, and send a request for search results on PO-952 to the German Patent Office.

If the examiner notices an application in which there is a prior filed German application but which has not been marked by placing therein the Notice, he may in his own discretion request the German search results through the Foreign Exchange Section, if there is sufficient time before the case is to be reached for action.

The search report, on Form PO-952 (Form A), when received from Germany, together with copies of any references cited, will be forwarded to the Examining Group to be placed in the file, by the Foreign Exchange Section.

Normally, the search report is expected to be received before the U.S. application is reached for action in regular course. If it is not in the file of the application when it is reached for action, an inquiry may be made of the Foreign Exchange Section to ascertain if it has been received and is in process. But otherwise examination of the application is not to be deferred to await a search report. If one is received after the examiner's action, the references are to be considered in the same manner as references being considered for citation in the second action.

When the Examiner is acting on a case in which a search report citing references has been received from Germany (copies of the references will have been placed in the file), he is to proceed with his own search and examination of the application in the usual manner, but taking advantage of any assistance furnished by the

references cited by the German examiner; for example, features or anticipations adequately supplied need not be searched for again. The references cited by the German examiner, as well as any additional ones found, are to be considered, and if pertinent, cited and used in the usual manner. References should not be cited merely because they have been listed by the German Patent Office.

As indicated in the joint report published at 838 OG 1225-6, May 23, 1967, an exchange at the present time cannot completely replace the necessity for each office to conduct its own search. In particular, it should be noted that a U.S. patent which issued after the German filing date, but which has an earlier filing date, cannot be used as a reference in the German case and that the German examiner presumably will not have searched such patents, assuming that they had reached Germany. Hence, particular attention should be paid to searching recent U.S. patents. Also, the German examiner searches according to a classification system developed along principles somewhat different from the U.S. classification, and references in related or analogous arts are not used to the same extent as here.

In recording the field of search on the file jacket, the examiner should indicate in the usual manner those sub-classes in which he has made his usual search; where he has found it necessary to make only a partial or updating search, the listing of the sub-classes thus searched should be so marked.

The search report and the Notice are removed from the file when the application is disposed of and retained in the Foreign Exchange Section.