

# Chapter 1300 Allowance and Issue

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## 1301 Substantially Allowable Case, Special

When an application is in condition for allowance, except as to matters of form, the case will be considered special and prompt action

taken to require correction of formal matters. See 710.02(b) paragraph (a).

## 1302 Final Review and Preparation for Issue

### 1302.01 General Review of Disclosure [R-18]

When an application is apparently ready for allowance, it should be reviewed by the Examiner to make certain that the whole case meets all formal requirements and particularly that the brief summary of the invention and the descriptive matter are confined to the invention to which the allowed claims are directed and that the language of the claims finds clear support or antecedent basis in the specification. Neglect to give due attention to these matters may lead to confusion as to the scope of the patent.

Frequently the invention as originally described and claimed was of much greater scope than that defined in the claims as allowed. Some or much of the subject matter disclosed may be entirely outside the bounds of the claims accepted by the applicant. In such case the Examiner should require the applicant to modify his brief summary of the invention and restrict his descriptive matter so as to be in harmony with the claims. However valuable for reference purposes the Examiner may consider the matter which is extraneous to the claimed invention, patents should be confined in their disclosures to the respective inventions patented. (Rule 71.) Of course enough background should be included to make the invention clearly understandable. See 608.01(d) and 608.01(e).

There should be clear support or antecedent basis in the specification for the terminology used in the claims. Usually the original claims follow the nomenclature of the specification; but sometimes in amending the claims or in adding new claims, applicant employs terms that do not appear in the specification. This may result in uncertainty as to the interpretation to be given such terms. See 608.01(o).

Where a copending application is referred to in the specification, the Examiner should ascertain whether it has matured into a patent or become abandoned and that fact or the patent number added to the specification.

The claims should be renumbered as required by Rule 126, and particular attention should be given to claims dependent on previous claims to see that the numbering is consistent. See 608.01(j) and 608.01(n).

The abstract should be checked for an adequate and clear statement of the disclosure. See section 608.01(b).

The title should also be checked. It should be as short and specific as possible. If a satisfactory title is not supplied by the applicant, the Examiner may change the title on or after allowance. See 606 and 606.01.

All pencil notes made by the Examiners must be erased when the case is passed to issue.

### 1302.01(a) Fee Exempt Application

See 607.01 for checking specification to assure presence of proper stipulation by applicant.

### 1302.02 Requirement for a Rewritten Specification [R-18]

Whenever interlineations or cancellations have been made in the specification or amendments which would lead to confusion and mistake, the Examiners should require the entire portion of specification affected to be rewritten before passing the case to issue. See Rule 125 in 608.01(q).

### 1302.03 Status Letter of Allowability, POL-327 [R-18]

This letter is used whenever an application under final rejection has been placed in condition for allowance as a result of a communication from or an interview with applicant.

The date of the communication or interview which resulted in the allowance and the name of the person with whom the interview, if any, was held should be included in the letter.

Immediately after determining that a POL 327 letter is necessary, the letter should be effected before preparing the application for allowance. See 714.13.

### 1302.04 Examiner's Amendments and Changes [R-18]

Except by formal amendment duly signed or as hereinafter provided, no corrections, erasures, or interlineations may be made in the body of written portions of the specification or any other paper filed in the application for patent. (See Rule 121.)

Correction of the following obvious errors and omissions only may be made with pen by the Examiner of the case who will then initial the sheet margin and assume full responsibility for the change. When correcting *originally filed* papers, clean red ink *must* be used (not blue or black ink).

1. Misspelled words.
2. Disagreement of a noun with its verb.
3. Inconsistent "case" of a pronoun.
4. Disagreement between a reference character as used in the description and on the drawing. The character may be corrected in the description but only when the Examiner is certain of the propriety of the change.
5. Entry of "now Patent No. ----" to identify a patent which has been granted on a U.S. application referred to by Serial No. in the specification.
6. Other obvious minor grammatical errors such as misplaced or omitted commas, improper parentheses, quotation marks, etc.
7. Obvious informalities in the application, other than the ones noted above, or of purely grammatical nature.

The fact that applicant is entitled under 35 U.S.C. 120 to an earlier U.S. effective filing date is sometimes overlooked. To minimize this possibility, the statement that, "This is a division (continuation, continuation-in-part) of Application Serial No. ----, filed ----" should appear as the first sentence after the abstract except in the case of design applications where it should appear as set forth in Sec. 1503.01. Any such statements appearing elsewhere in the specification should be relocated. The clerk indicates the change for the printer in the appropriate margin when checking new applications for matters of form.

Other obvious informalities in the application may be corrected by the Examiner, but such corrections must be by a formal Examiner's Amendment, signed by the Primary Examiner, placed in the file, and a copy sent to the applicant. The changes specified in the amendment are entered by the clerk in the regular way.

The amendment or cancellation of claims by formal Examiner's Amendment is permitted when passing an application to issue where these changes have been authorized by applicant (or his representative) in a telephone or personal interview. The Examiner's Amendment should indicate that the changes were authorized, the date and type (personal or telephone) of interview, and with whom it was held.

A change in the abstract may be made by Examiner's Amendment.

If the specification contains (1) statements attempting to restrict the use of the abstract, or (2) restrictive statements or express limitations relating to the scope of the invention claimed, or appearing to restrict interpretation of the claims, such statements shall be cancelled by Examiner's Amendment.

Where a reference to the parent application in an otherwise allowable Rule 147 divisional case or streamlined continuation case has inadvertently been omitted by the applicant, the Examiner should insert the required reference by Examiner's Amendment (see 201.11).

No other changes may be made by any person in any record of this office without the written approval of the Commissioner of Patents.

References cited as being of interest by examiners when passing an application to issue will not be supplied to applicant. The references will be cited as usual on form PO-872, a copy of which will be attached to Examiner's Amendment form POI-87.

Where an application is ready for issue except for a slight defect in the drawing not involving change in structure, the Examiner will note in pencil on the drawing the addition or alteration to be made. He will also prepare an Examiner's Amendment indicating the changes made and send the drawing to the Draftsman for the required correction.

See also 608.02(w).

In reviewing the application all errors should be carefully noted. It is not necessary that the language be the best; it is, however, essential that it be clear in meaning, and free from errors in syntax. Any necessary Examiner's Amendment is usually made at the time a case is being prepared for issue by the Examiner. However, the need for such may not be noted until after the proof of the patent is read and the case is sent up to the Examiner with a "printer waiting" slip (Form PO-97). A copy of any formal amendment is sent to applicant even if the application is already in the printer's hands.

Examiners will not cancel claims on the basis of an amendment which argues for certain claims and, alternatively, purports to authorize their cancellation by the Examiner if other claims are allowed. [R-17]

#### 1302.04(a) Title of Invention

Where the title of the invention is not specific to the invention as claimed, see 606.01.

#### 1302.04(b) Cancellation of Non-Statutory Claim [R-17]

When a case is otherwise in condition for allowance the Examiner may cancel an obviously non-statutory claim such as one to "A device substantially as shown and described." Applicant should be notified of the cancellation of the claim by an Examiner's Amendment.

#### 1302.04(c) Cancellation of Claims to Non-Elected Invention

See 821.01 and 821.02.

#### 1302.04(d) Cancellation of Claim Lost in Interference

See 1109.02.

#### 1302.04(e) Cancellation of Rejected Claims Following Appeal

See 1214.06, 1215.03, and 1215.04.

#### 1302.04(f) Data of Copending Application Referred to Should Be Brought Up to Date [R-17]

Where a patent application which is ready for issue refers by serial number to a U.S.

application which has matured into a patent, the Examiner is authorized to enter the patent number without a formal Examiner's Amendment. This entry should be in the following form: "now Patent No. \_\_\_\_\_" This entry is to be initialed in the margin by the Examiner to fix responsibility for the same. The entry and the initials should be in red ink.

If the application referred to has become abandoned, the entry "and now abandoned" should be made by a formal Examiner's Amendment.

#### 1302.04(g) Identification of Claims [R-17]

To identify a claim, a formal Examiner's Amendment should refer to it by the original number and, if renumbered in the allowed application, also by the new number.

#### 1302.05 Correction of Drawing [R-17]

Where a case otherwise ready for issue requires correction of the drawing, the Examiner, before sending the file to the Draftsman, should attach thereto a slip indicating that the case is ready for allowance. Slight defects may be corrected on the Examiner's initiative as set forth in 608.02(w) and a formal Examiner's Amendment prepared.

Correction of some slight defects may be obviated, see 608.02—"Waiving of Corrections".

#### 1302.06 Prior Foreign Application

See 201.14(c) and 202.03.

#### 1302.07 Use of Retention Labels To Preserve Abandoned Companion Applications [R-17]

*Rule 14(b).* Except as provided in Rule 11(b) abandoned applications are likewise not open to public inspection, except that if an application referred to in a United States patent is abandoned and is available, it may be inspected or copies obtained by any person on written request, without notice to the applicant. Abandoned applications may be destroyed after twenty years from their filing date, except those to which particular attention has been called and which have been marked for preservation. Abandoned applications will not be returned.

Related applications referred to in patent specifications are preserved from destruction by a retention label (Form PO-150) which is attached to the outside of the file wrapper. The

Final Review Clerk of the Group prepares such a label for use as indicated below on each application (which has not become a patent) which is referred to in the specification or oath of the application ready for allowance (or in any Office letter therein).

If the case referred to is

**Still pending:**

Fill in and paste label on the face of the pending file wrapper in the space provided. Make no change in specification of the allowable application.

**Abandoned for failure to pay issue fee:**

If file has been forwarded fill in label and send it to Abandoned Files for attachment to the wrapper. If not forwarded treat the same as pending case. If the period for filing a petition for delayed payment has expired, make Examiner's Amendment adding "now abandoned" in the allowable application. If period has not expired, make no change in specification of the allowable application.

**Abandoned:**

If file has been forwarded fill in label and send it to Abandoned Files for attachment to the wrapper. If not forwarded treat the same as pending case. Make Examiner's Amendment, adding "now abandoned" in the allowable application.

**Already patented:**

No label is required. Insert patent number in specification if not already present. Formal Examiner's Amendment not necessary if this is only change.

**In issue:**

Fill in label. Make no change in the specification of the allowable application. Clip the label to the Serial Register card of the case in issue. If case in issue is abandoned or is withdrawn from issue, it is returned to the Group, where the Serial Register card is pulled. The label is attached at this time. If case in issue is patented, the label is destroyed when the card is pulled.

Examiners are reminded that only one retention label is necessary. Thus, if a retention label is already present, it is sufficient to merely add "et al." to the Serial Number cited thereon. [R-18]

**1302.08 Interference Search [R-17]**

Assuming that the case is found ready for issue, the Examiner makes an "interference search" and notes the date and class and subclasses searched in the file wrapper. To do this, he inspects all the pending prints and drawings

(or all the digests if the invention is not susceptible of illustration) in the relevant subclasses of the class in which the application is classified, and all other pertinent classes, whether in his group or elsewhere, in order to ascertain whether any other applicant is claiming substantially the same subject matter as is being allowed in the case in hand. When any of the drawings or digests shows such a condition to be likely, he examines the corresponding file.

If the search does not disclose any interfering application, the Examiner should prepare the case for issue.

**1302.09 Notations on File Wrapper [R-18]**

The Examiner preparing the application for issue fills out, in black ink, the appropriate spaces on the face of the file wrapper.

To aid workers in the Printing Office and the Issue and Gazette Branch, Examiners should write the class and subclass on the outside of the file wrapper as carefully and legibly as possible. Each numeral should be distinct and any decimal point should be shown clearly and in its proper position.

In all instances where the application contains an abstract when sent to issue, the abstract will be published in the Official Gazette instead of a claim. In these cases the Examiner should strike through the words "Print claim(s)" on the file wrapper. See 608.01(b).

In applications containing no abstract, Examiners should ordinarily designate but one claim on each invention to be published in the Official Gazette in connection with each original or reissued patent. The broadest claim should be selected. When a plurality of inventions are claimed in an application, additional claims to a maximum of five may be designated for publication.

Spaces are provided on the file wrapper for identifying data of a prior abandoned application for which the instant application is a Substitute, and for the parent application(s) and prior foreign application(s) meeting the requirements of the Statutes.

The class and subclass and the name of the Examiner which are written in pencil on the file wrapper should correspond to the class and subclass in which the patent will issue and to the name of the Examiner preparing the application for issue.

See 202.02 for notation as to parent or prior U.S. application to be placed on file wrapper.

See 202.03 for notation as to foreign patent application to be placed on file wrapper.

See 1302.13 for name of Examiner.

### 1302.10 Notations on Drawings and on Classification (Issue) Slip [R-18]

The class and subclass and the name of the Assistant Examiner which have been written in pencil in the upper lefthand corner of the drawing should not be erased. See 717.08.

On the margin of the first sheet of drawing, the Examiner indicates in black ink in the spaces provided by the Draftsman's stamp the figure which he selects for printing in the Official Gazette and also the final official classification of the case. Ordinarily a single figure is selected for printing. This figure should be consistent with the portion of the application to be printed in the Official Gazette. The numerals should fill as much of the space provided as feasible.

If the selected figure is not on the first sheet, the Examiner should indicate it also on the sheet where it does appear. If there is no figure illustrative of or helpful in understanding the claimed invention, no figure need be selected. "None" may be written after "O.G. Fig." If, through inadvertence, the stamped legend for O.G. Fig. and class and subclass appears within the margin of the drawing, the Examiner, should make the notations *outside* of the margins.

The only date entered on the front of the drawings is the date of mailing of the Notice of Allowance, which is done by the Issue and Gazette Branch. Under current practice, the Clerk of the Examining Group does NOT enter any date when the case is "sent to issue". See 903.07 and 903.07(b) for notation to be applied to the Classification Slip (Form PO-270).

### 1302.11 Reference to Assignment Branch

The practice of referring certain applications to the Assignment Branch when passing them to issue is no longer followed since title searches are automatically made in all applications after payment of the issue fee. See 303.

### 1302.12 Listing of References [R-18]

All references which have been cited during the prosecution, including those appearing in Board of Appeals decisions, and those submitted by applicant if they conform to the requirements set forth in 707.05(b) or 708.02, will be printed in the patent.

At time of allowance, the Examiner may cite pertinent art in an Examiner's Amendment. Such citation of art is important in the case of continuing applications where significant prior art is often of record in the parent case. In the rare instance where no art is cited in a continuation application, all the references cited during the prosecution of the parent application will be listed at allowance for printing in the patent. See sections 707.05 and 707.05(a).

When preparing an application for allowance, the "final review" clerk will verify that there is at least one list of references (PO-892) in the application. All lists of references are maintained in the center section of the file wrapper with the first being on top.

In the first action after termination of an interference, the Examiner should make of record in each application all references not already of record which were pertinent to any motions to dissolve and which were discussed in the decision on motion.

In any case, otherwise ready for issue, in which the erroneous citation has not been formally corrected in an official paper, the Examiner is directed to correct the citation by an Examiner's Amendment. See section 707.05(g).

Any new reference cited when the case is in issue, under the practice of 1308.01, should be added by way of a PO-892.

### 1302.13 Signing [R-18]

The Primary Examiner and the Assistant Examiner involved in the allowance of an application will print or stamp their names on the file wrapper in place of their signatures. Each Examiner shall place his initials after his printed or stamped name. A Primary Examiner who prepares an application for issue himself prints or stamps his name and initials the file wrapper *only* in the "Primary Examiner" space. A line should be drawn through the "Assistant Examiner" box to make it clear that the absence of a name in the box was not an oversight.

Only the names of the Primary Examiner and the Assistant Examiner appearing on the face of the application file wrapper will be listed in the printed patent.

### 1303 Notice of Allowance

The appropriate form of notice of allowance is used and the mailing date appearing thereon is stamped on the file wrapper by the Issue and Gazette Branch.

**1303.01 Amendment Received After Allowance**

If the amendment is filed under Rule 312, see 714.15 to 714.16(e). If the amendment contains claims copied from a patent, see 1101.02(g).

**1303.02 Undelivered**

In case a notice of allowance is returned, and a new notice is sent (see 707.13), the date of sending the notice must be changed in the file to agree with the date of such remailing.

**1303.03 Not Withheld Due to Death of Inventor**

The notice of allowance will not be withheld due to death of the inventor if the executor or administrator has not intervened. See 409.01 (f).

**1304 Withholding From Issue of "Secrecy Order" Cases**

"Secrecy Order" cases are not sent to issue even when all of the claims have been allowed. Instead of mailing an ordinary notice of allowance a D-10 Notice is sent. See 107.02.

If the "Secrecy Order" in a case is withdrawn after the D-10 notice is mailed, the case should then be treated like an ordinary application in condition for allowance.

**1304.01 Amendments After D-10 Notice**

For amendments received after D-10 Notice, see 107.02.

**1305 Jurisdiction [R-18]**

Jurisdiction of the application remains with the Primary Examiner until the notice of allowance is mailed by the Issue and Gazette Branch. However, the Examiner may make Examiner's amendments correcting obvious errors, as, when brought to the attention of the Examiner by the printer, and also may admit amendments under Rule 312 which are confined to matters of form in specification or claims, or to the cancellation of a claim or claims. The Examiner's action on other amendments under Rule 312 consists of a recommendation to the Commissioner.

To regain jurisdiction over the case, the Examiner must write a letter to the Commissioner requesting it. See sections 1112.04, 1308, and 1308.02.

Once the patent has been granted, the Patent Office can take no action concerning it except as provided in 35 U.S.C. 135 and 35 U.S.C. 251 through 256. See chapter 1400.

**1306 Public Law 690 Cases**

See 201.16.

**1307 Change in Classification of Cases Which Are in Issue**

See 903.07

**1308 Withdrawal From Issue [R-18]**

*Rule 318. Withdrawal from issue.* After the notice of allowance of an application is sent, the case will not be withdrawn from issue except by approval of the Commissioner, and if withdrawn for further action on the part of the Office, a new notice of allowance will be sent if the application is again allowed.

When the issue fee or that portion thereof specified in the notice of allowance has been paid, and the patent to be issued has received its date and number, the application will not be withdrawn from issue on account of any mistake or change of purpose of the applicant, his attorney or his agent, nor for the purpose of enabling the inventor to procure a foreign patent, nor for any other reasons except mistake on the part of the Office, or because of fraud or illegality in the application, or for interference. Express abandonment of the application (rule 138) may not be recognized by the Office unless it is actually received by appropriate officials in time to act thereon before the date of issue.

If the applicant wishes to have the case withdrawn from issue, he must petition the Commissioner. Withdrawal is permitted only for the reasons stated in the rule. For withdrawal procedure by Examiner see 1308.02.

**1308.01 Rejection After Allowance [R-18]**

A claim noted as allowable shall thereafter be rejected only with the approval of the Primary Examiner. Great care should be exercised in authorizing such rejection. See section 706.04.

When a new reference is discovered, which obviously is applicable to one or more of the allowed claims in an application in issue, and where a sufficient portion of the statutory period for payment of the issue fee remains, the Examiner is authorized to enter a letter informing applicant of the proposal of requesting withdrawal from issue for the purpose of

rejecting the claim or claims as fully met by, or obviously unpatentable over the new reference. The letter should apply the reference in detail and should also set a time limit (within such statutory period), within which applicant may respond by way of argument or amendment under Rule 312 to overcome the reference and avoid the necessity for withdrawal from issue. Such a letter, with the reference and file, should be submitted to the Group Director before mailing.

If insufficient time remains to carry out the above, or if no response is received, or if a response is filed and it fails to overcome the reference, or if the above appears fruitless, a letter is addressed to the Group Director, requesting that the application be withdrawn from issue for the purpose of applying the new reference. This letter should cite the reference, and, if need be, briefly state its application. The letter should be submitted with the reference and the file wrapper. Upon approval of this request, the letter is taken to the Issue and Gazette Branch and the application is stamped "Withdrawn" over the name stamp and initials of the Primary Examiner. It is then returned to the group from which it came; the withdrawal from the issue is entered on the register, and the application is thus restored to its former status as a pending application awaiting action by the Examiner. The Examiner at once writes a letter in the case stating that the application has been withdrawn from issue, citing the new reference, and rejecting the claims met thereby.

The letter is given a paper number and placed in the file.

If the Examiner's proposed action is not approved, the letter requesting withdrawal from issue should not be placed in the file.

### 1308.02 For Interference Purposes

It may be necessary to withdraw a case from issue for reasons connected with an interference. For the procedure to be followed see 1101.01(o) and 1112.04.

### 1309 Issue of Patent [R-18]

The files of allowed cases (not patented files) are kept in the Issue and Gazette Branch, arranged in the serial number order. When the Issue fee is paid within the time allowed by law, the file is given a patent number and date. The file then goes to the Assignment Branch for examination as to assignments after which it is sent to the Government Printing Office for printing of the specification. A bond

paper copy of the drawing and specification is ribboned and sealed in the Issue and Gazette Branch and finally signed.

**35 U.S.C. 153. How issued.** Patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Commissioner or have his signature placed thereon and attested by an officer of the Patent Office designated by the Commissioner, and shall be recorded in the Patent Office.

In accordance with the Commissioner's Notice of July 2, 1952 (661 O.G. 13) various officials including the head of the Issue and Gazette Branch have been designated as attesting officer to attest to the name of the Commissioner. The assistant head of the Issue and Gazette Branch acts as attesting officer in the absence or unavailability of the head of the branch.

### 1309.01 "Printer Waiting" Cases [R-18]

After printing of the specification the proof is read by employees of the Government Printing Office. Where apparent error is found, the file with the proof is transmitted to the Examiner, attention being called on an attached "printer waiting" slip to the supposed errors.

All "printer waiting" cases must receive immediate attention and be returned to the Issue and Gazette Branch as soon as possible (preferably within three hours).

If the Examiner concurs in the criticisms, the errors should, if possible, be corrected in clean red ink and initialed or be corrected by Examiners' amendment. See section 1302.04.

If the required correction cannot be cured by Examiner's amendment, the application may have to be withdrawn from issue. This may sometimes be avoided if the attorney or his representative is in Washington. In such cases, he should be called in immediately, and the error may perhaps be corrected by amendment under Rule 312.

If the Examiner finds the specification correct as it stands, he endorses the slip to that effect.

After correction or checking, the application file and proof should be promptly returned to the Issue and Gazette Branch.

### 1309.02 Protest Against Issue [R-18]

**Rule 291. Protests to the grant of a patent.** The patent statutes do not provide for opposition to the



grant of a patent on the part of the public. Protests to the grant of a patent are ordinarily merely acknowledged, and filed after being referred to the examiner having charge of the subject matter involved for his information.

When a protest is filed against the issuance of a patent the same shall, after consideration by the Examiner, be forwarded to the Group Director and shall not be entered in the file of the application to which it refers.