

MANUAL OF
PATENT
EXAMINING
PROCEDURE

ORIGINAL EDITION



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MANUAL OF PATENT EXAMINING PROCEDURE
Third Edition

Instructions Regarding Revision No. 18

The attached revised pages are replacements for those in the Manual having corresponding numbers, or additional pages to be placed in appropriate numerical sequence.

Change Notice 17-2, relating to the Trial Multiple Dependent Claim Practice should be retained since the subject matter has not been incorporated in the text of the Manual. All Change Notices of the 18 series have been incorporated into the Manual.

The notation "R-18" in the attached pages appears either at the title or at the end of a section that has been altered in any way. Where neither the beginning nor the end of a revised section appears on the revised page, the customary notation at the bottom of the page is the only indication of revision.

Louis O. Maassel, Editor
Manual of Patent Examining Procedure

Particular attention is called to the following alterations:

Section

- | | |
|-----------------|--|
| 107 | Last paragraph was added to indicate licensing notation practice. |
| 107.01
& 108 | Rewritten to include screening procedure of all new applications by Group 220. |
| 201.11 | Revised to indicate there is no limit to the number of successively filed continuing cases (Change Notice 18-2). |
| 201.13 | Revised to include current treaty and list of foreign countries. |
| 201.14(b) | Last paragraph added (Change Notice 18-5). |

Rewritten to include Change Notice 18-1.

- 103.03(b) Revised to include new application security screening procedure.
- 103.02 Paragraph numbered "4" amended to allow use of forms in "Accelerated Examination" applications.
- 114.13 Amended to indicate that the additional month granted after a first response to a final rejection is an extension of the shortened statutory period (Change Notice 18-5).
- 106.05(a) Incorporates Change Notice 17-5.
- 103.01(a) Amended to allow election of species requirement without a search on the merits (Change Notice 18-3).
- 901.01 Revised to indicate that canceled matter in a patent file may be used as prior public knowledge as of the patent date.

List to determine whether Revision 18 pages are complete.
(Note that a complete checklist of all pages of the Manual, including Revision 18 appears on pages vi and vii of this revision).

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Foreword

This Manual is published to provide Patent Office patent examiners, patent applicants, and representatives of patent applicants with a reference work on the practices and procedures relative to the prosecution of applications before the Patent Office. It contains instructions to examiners, as well as other material in the nature of information and interpretation, and outlines the current procedures which the examiners are required or authorized to follow in appropriate cases in the normal examination of applications.

Examiners will be governed by the applicable statutes, the Rules of Practice, decisions, and orders and instructions issued by the Commissioner and the Assistant Commissioners. Orders and Notices still in force which relate to the subject matter included in this Manual are incorporated in the text. Orders and Notices, or portions thereof, relating to the examiners' duties and functions which have been omitted or not incorporated in the text may be considered obsolete. Interference procedure not directly involving the Primary Examiner is not included in this Manual and, therefore, Orders and Notices relating thereto remain in force.

Subsequent changes in practice and other revisions will be incorporated in the form of substitute or additional pages for the Manual.

EDWARD J. BRENNER,
Commissioner.

Acknowledgments

Preparation of the text of the Third Edition was directed by Ernest A. Faller, Editor, under the supervision of Manuel C. Rosa, Director, Patent Examining Operation.

The Supervisory Examiners, Isaac G. Stone, Norman H. Evans, Burnham Yung Kwai, Sam Spintman, John S. Hull, Thomas F. Murphy, Harvey E. Kauffman and George A. Gorecki took an active part in this work, especially in rewriting Chapter 700.

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Suggestions for improving the form and content of the Manual are always welcome. They should be addressed to:

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Introduction

Constitutional Basis

The Constitution of the United States provides:

"**Art. 1, sec. 8.** The Congress shall have power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

Statutes

Pursuant to the foregoing provision of the Constitution, Congress has passed a number of statutes under which the Patent Office is organized and our patent system is established. The provisions of the statutes can in no way be changed or waived by the Patent Office. Prior to January 1, 1953, the law relating to patents consisted of various sections of the Revised Statutes of 1874, derived from the Patent Act of 1870 and numerous amendatory and additional acts. These statutes, as well as old Title 35 of the United States Code, were compiled and reprinted several times prior to January 1, 1953, in a pamphlet entitled "Patent Laws".

By an Act of Congress approved July 19, 1952, which came into effect on January 1, 1953, the patent laws were revised and codified. With certain exceptions applying to applications filed and patents issued before January 1, 1953, this law governs all cases in the Patent Office. The patent law is Title 35 of the United States Code, which contains 95 sections numbered from 1 to 293, with gaps in the numbering between various chapters of the title. In referring to a particular section of the new patent code the citation is given, for example, as, 35 U.S.C. 31. The current edition of the pamphlet "Patent Laws" reprints the patent code and some additional statutes. The pamphlet also contains tables showing where subject matter comparable to present title 35 may be found in prior statutes, and where subject matter of prior statutes will be found in new title 35.

Rules of Practice

One of the sections of the patent statute, namely, 35 U.S.C. 6, authorizes the Commis-

sioner of Patents, subject to the approval of the Secretary of Commerce, to establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office. These regulations are set forth in a Patent Office booklet entitled "Rules of Practice of the United States Patent Office in Patent Cases". The Rules of Practice have a long history, going back to pamphlets of general information to the public first issued in 1836. The content has been determined by history, tradition and other factors. Primarily the function of the Rules of Practice is to advise the public of the regulations which have been established in accordance with the statutes and which must be followed before the Office. But the Patent Office Rules of Practice have always additionally included, as numbered rules, informational material, copies of sections of the patent statutes, purely internal procedure, and the like. It goes without saying that the Rules of Practice govern the Examiners, as well as applicants and their attorneys.

Commissioner's Orders and Notices

From time to time, the Commissioner of Patents has issued Orders and Notices relating to various specific situations that have arisen in operating the Patent Office. Notices and circulars of information or instructions have also been issued by the Supervisory Examiners under authority of the Commissioner. Orders and Notices have served various purposes including directions to the examiners giving them instruction, information, interpretations and the like. Some may be for the information of the public, advising what the Office will do under specified circumstances.

Decisions

In addition to the statutory regulations, the actions taken by the Examiner in the examination of applications for patents are to a great extent governed by decisions on prior cases. Those dissatisfied with an Examiner's action may have it reviewed. In general, it may be stated that from that portion of the Examiner's action pertaining to objections on formal matters, a petition for review may be taken to the Commissioner of Patents (1002) and

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from that portion of the Examiner's action pertaining to the rejection of claims on the merits, an appeal may be taken to the Board of Appeals (1201). The distinction is set forth in Rules 181 and 191. The decision of the Commissioner on formal matters is final

but the decision of the Board of Appeals on questions passed on by it may be carried to the courts. See 1216. In citing decisions as authority for his actions, the Examiner should cite the decision in the manner set forth in 707.06.