

MANUAL OF
PATENT
EXAMINING
PROCEDURE



PROPERTY OF THE UNITED STATES GOVERNMENT

U. S. DEPARTMENT OF COMMERCE
Patent Office
Washington, D. C. 20231

MANUAL OF PATENT EXAMINING PROCEDURE
Third Edition

Instructions regarding Revision No. 35

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

The notation "[R-35]" in the attached pages appears either at the title or at the end of a section that has been revised.

Louis O. Maassel, Editor
Manual of Patent Examining Procedure

Particular attention is called to the following sections:

- 102 Entire section rewritten.
- 103 Paragraph added on access to abandoned applications contained in streamlined continuation applications.
- 201.14(c) Paragraph under heading "Application in Issue" rewritten.
- 501 Rule 1 added.
- 502 Rule 6 added and section revised as to hand delivery of papers.
- 503 Substantially revised.
- 505 Revised to indicate examining group may stamp date of receipt in Patent Office.
- 508.01 First paragraph rewritten.
- 508.03 New section on unmatched papers added.
- 601 Last three paragraphs added.
- 608 Second and third paragraphs on offensive language or drawings added.

- 608.01 Revised Rule 52 and new Rule 58 added.
- 608.01(i) Revised Rule 75 included. Revision is limited to addition of cross-reference to Rule 58(a) at end of paragraph 75(d) (1).
- 711.03(c) Sentence added to indicate that brief is due two months after granting of petition to revive which included a notice of appeal. Also last two paragraphs on "Timely Response" added.
- 714.01(a) Third paragraph added.
- 714.17 Last two paragraphs added.
- 714.22 Last paragraph added.
- 901.04 Portion on ICIREPAT identification numbers added.
- 903.08(b) Revised to indicate that SPE normally assigns new applications for examination.
- 903.08(d) First paragraph on "within the group" transfers added to assure that clerks will be notified.
- 1214.03 Extract of Rule 197 added and section revised.
- 1216 Material under heading "Service of Court Papers on Commissioner of Patents" added.
- Chptr. Entire chapter on "Design Patents" revised.
1500
- 1701 Revised to caution examiners not to comment on validity of patents.
- 1701.01 A new section added relating to testimony of examiners.
- 1704 Last four paragraphs added on practice of forwarding docket cards of allowed cases to Application Division.

All other changes are corrections in matters of clarification, terminology, capitalization or form.

List of replacement pages:

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44.1-blank	35	220.7-blank	35
46.1-blank	35	235-236	35-35
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*Added page

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MANUAL OF PATENT EXAMINING PROCEDURE
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Instructions regarding Revision No. 34

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

The notation "[R-34]" in the attached pages appears either at the title or at the end of a section that has been revised.

Louis O. Maassel, Editor
Manual of Patent Examining
Procedure

Particular attention is called to the following sections:

- 706.02 Paragraphs added on functional equivalence, indefinite limitations and minor capacity references.
- 706.02 (a) Last paragraph added.
- 706.03 (a) Citation of cases under "Printed Matter" and "Method of Doing Business" added.
- 706.03 (c) Numbered citations at end of section added.
- 706.03 (d) Last two paragraphs added.
- 706.03 (i) Citations to In re Worrest and In re Gustafson added.
- 706.03 (j) Last paragraph added.
- 706.03 (l) Third paragraph added.
- 706.03 (w) Substantially rewritten.
- 706.03 (y) Somewhat revised.
- 707 Instructions on preparing first action Form PO-1142 added.

- 803 Instructions on requiring restriction between different inventions claimed in a single Markush-type claim added.
- 902.03 (a) New patent index telephone practice added.
- 1216.01 Rule 301 amended to follow rule change of May 11, 1972 (899 O.G. 409).
- 1705 Section substantially rewritten.
- Appendix I Trademarks added: Amberlite, Banbury, Betalight, Flexwood, Footlets, Parkerizing, Static Mixer, Trav-O-lator, and Trigger.

All other changes are corrections in matters of clarification, terminology, capitalization or form.

List of replacement pages:

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*76.1-76.2	34-34	247-248	34-34
*76.3	34	249-250	34-34
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Instructions regarding Revision No. 33

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The notation "[R-33]" in the attached pages appears either at the title or at the end of a section that has been revised.

Louis O. Maassel
Editor, Manual of Patent
Examining Procedure

Particular attention is called to the following sections:

- 201.06 Amended to indicate that a copy of the original oath should be included in a Rule 60 application. Form 54 was modified to include space for the anticipated classification (see notice of June 5, 1970; 875 O.G. 702). Classification to be based on claims in case after preliminary amendment.
- 201.08 Last sentence added.
- 608.02 Subsection on drawing symbols added. Instructions to return cases without needed drawings to Application Division added.
- 706 Discussion on Graham v. John Deere case added.
- 1101.01(b) Reference to Rule 78(b) changed to 78(c) and last sentence added.
- 1216.01 Time for filing transcript of record, petition and fee at C.C.P.A. updated to follow C.C.P.A. rules. Citation of In re Fisher and Continental Can Co. Inc. et al v. Schuyler added.

Index Completely updated.

All other changes are corrections in matters of terminology, capitalization or form.

List of replacement pages:

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Instructions regarding Revision No. 32

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

The notation "[R-32]" in the attached pages appears either at the title or at the end of a section that has been revised.

Louis O. Maassel
Editor, Manual of Patent
Examining Procedure

Particular attention is called to the following sections:

- | | |
|-----------------------------|--|
| 104 | Amended to include guidelines for giving access to files. |
| 608.02(c),
(h), (m), (q) | Incorporates instructions for processing new smaller size drawings. |
| 706.03(z) | Revised to follow CCPA view. |
| 707.01(a) &
707.02 | Material now appears in sections 1004 and 1005. |
| 804 | Explanation of basis for double patenting rejections added. |
| 903.10 | New section on duties of post classifiers. |
| Chapter
1000 | Rewritten to more specifically set forth the delegation of authority to handle various petitions and requests. |
| 1205 | Last paragraph added to indicate that applicant's notice of appeal is not acknowledged. |
| 1701 | Amended to include notice of March 16, 1972 on examiner testimony. |

List of replacement pages:

<u>Page No.</u>	<u>Rev. No.</u>	<u>Page No.</u>	<u>Rev. No.</u>
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*56.1-blank	32	161-162	32-32
67-68	32-31	*162.1-162.2	32-32
73-74	32-32	*162.3-blank	32
76.1-blank	(Removed)	169-170	32-32
77-78	32-32	173-174	32-32
88.1-blank	32	174.1-blank	32
90.1-90.2	32-32	209-210	32-32
90.3-blank	32	211-212	32-32
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106.1-blank	32	*244.1-blank	32
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MANUAL OF PATENT EXAMINING PROCEDURE
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Instructions regarding Revision No. 31

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 until prosecution of all applications under the program is concluded. The termination of this program was announced in the Notice of June 9, 1969; 864 O.G. 323. All other Change Notices have been incorporated into the Manual.

The notation "R-31" in the attached pages appears either at the title or at the end of a section that has been revised.

Louis O. Maassel
Editor, Manual of Patent
Examining Procedure

Particular attention is called to the following sections:

- 201.06 Form 54 has been modified to make it more complete.
- 203.08 Revised to incorporate the notice of November 24, 1971 (893 O.G. 810) on status inquiries.
- 203.08(a) A new section relating to Congressional and other Official inquiries.
- 506 Change in hours when the Application Branch Records Information Section is closed, i.e., 2:30 - 4:30.
- 604.04(a) Changed to indicate that a declaration may be filed to remedy an oath lacking authentication by a diplomatic or consular officer.
- 706.02 Indicates no effect is given to earlier filing dates granted under Public Law 92-34 relating to the Postal Emergency for prior art purposes.

1105.06 Last paragraph on page 186.1 added to indicate that certain dates should not be typed on interference motion decisions.

1401 Ex parte Scudder cited. This case held that the correction of misjoinder of inventors is a ground for reissue.

List of replacement pages:

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*Added page

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Instructions regarding Revision No. 30

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 until prosecution of all applications under the program is concluded. The termination of this program was announced in the Notice of June 9, 1969; 864 O.G. 323. All other Change Notices have been incorporated into the Manual.

The notation "R-30" in the attached pages appears either at the title or at the end of a section that has been revised.

Louis O. Maassel
Editor, Manual of Patent
Examining Procedure

Particular attention is called to the following sections:

- | | |
|--------------|---|
| pp. vi & vii | Checklist of pages revised |
| 101 | Last three paragraphs added to indicate practice of furnishing drawings to bonded lithographers. |
| 303 | Note added that a certified copy of a patent application does not include assignment. |
| 402 | Section on power of attorney amplified to indicate current practice. |
| 405 | Section on papers filed by "attorney not of record" completely revised. |
| 408 | Paragraph added to indicate that attorneys acting in "representative capacity" can only be called for a telephone interview if telephone number is in a paper signed by applicant or attorney or agent of record. |

- 506 Last three paragraphs added.
- 509 A new section entitled "Payment of Fees."
- 714.13 & 1302.03 Instruction added that a POL-327 or examiner's amendment should be promptly mailed in all allowable cases.
- 901.06(a) Section on Scientific Library revised throughout.
- 1206 & 1208.01 Notice of April 26, 1971 on appeal briefs added.
- 1208.01 Last paragraph on filing supplemental examiner's answer added.

List of replacement pages:

<u>Page No.</u>	<u>Rev. No.</u>	<u>Page No.</u>	<u>Rev. No.</u>
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14.1-blank	30	139-140	30-30
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*30.1-blank	30	218.1-blank	30
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*32.3	30	223-224	30-30
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* Added page

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MANUAL OF PATENT EXAMINING PROCEDURE
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Instructions regarding Revision No. 29

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 until prosecution of all applications under the program is concluded. The termination of this program was announced in the Notice of June 9, 1969; 864 O.G. 323. All other Change Notices have been incorporated into the Manual.

The notation "R-29" in the attached pages appears either at the title or at the end of a section that has been revised.

Louis O. Maassel
Editor, Manual of Patent
Examining Procedure

Particular attention is called to the following sections:

- 101 Change in rule 14(a).
- 201.04 Covers new rule 60 practice.
- 201.07 Streamlined continuation program material deleted.
- 402 Change in rule 34.
- 402.05 Change in rule 36.
- 403 Includes revised rule 33.
- 601 Title and subject matter changed from "Petition" to "Content of Application" and includes change to rules 51 and 59.
- 605.04 Change in rule 57 on inventor's name requirements.
- 608.01 Change in rule 52(a).

(Over)

- 608.01(a) Change in rule 77(h).
- 608.01(i) Change in rule 75(d)(2).
- 608.01(p) Deposit of Microorganisms guidelines included.
- 608.02 Change in rule 84.
- 608.02(b) Change in rule 85.
- 709.01 Revised practice involving applications with overlapping claims, one application being in interference.
- 804.02 & Includes new rule 321(b).
1403
- 804.03 Includes new rule 78(c).
- 822 Change in rule 78(b).
- 1403 Includes form for terminal disclaimer to obviate a double patenting rejection.
- 1606 Change in rule 165(b).

List of replacement pages, all bearing Rev. No. 29:

Title page	53-54
3-4	54.1-blank (Eliminated)
4.1-4.2	55-56
7-8	57-58
8.1-blank (Eliminated)	71-72
9-10	72.1-72.2
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33-34	89-90
34.1-34.2	90.1-90.2
*34.3-blank	*90.3-blank
39-40	109-110
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43-44	119-120
44.1-blank	120.1-120.2
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* Added page

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MANUAL OF PATENT EXAMINING PROCEDURE
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Instructions regarding Revision No. 28

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 until prosecution of all applications under the program is concluded. The termination of this program was announced in the Notice of June 9, 1969; 864 O.G. 323. All other Change Notices have been incorporated into the Manual.

The notation "R-287" in the attached pages appears either at the title or at the end of a section that has been revised.

Louis O. Maassel
Editor, Manual of Patent
Examining Procedure

Particular attention is called to the following sections:

- 101 Incorporates memorandum to Patent Office Personnel dated December 10, 1970, relating to confidentiality and accessibility of patent application papers.
- 502 Incorporates notice of March 5, 1971, relating to identification of application correspondence (855 O.G. 2).
- 503 Incorporates notice of March 10, 1971 relating to early notification of serial number (884 O.G. 970).

(Over)

- 901.06 Revised to include "Science Abstracts" handling.
- 1112.05 Revised form PO-880.
- Chapter
1200 Revised in view of amended Rule 192 and new
clerical procedures.
- 1208 Times for furnishing examiners'
1208.01 answers.

List of replacement pages, all bearing Rev. No. 28:

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5-6	213-214
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32.1-32.2	215-216
43-44	216.1-blank
44.1-blank	217-218
73-74	218.1-blank
74.1-blank	219-220
79-80	220.1-220.2
139-140	220.3-220.4
140.1-140.2	220.5-220.6
167-168	220.7-blank
177-178	253-254
179-180	255-blank

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MANUAL OF PATENT EXAMINING PROCEDURE
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Instructions regarding Revision No. 26

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 until prosecution of all applications under the program is concluded. The termination of this program was announced in the Notice of June 9, 1969; 864 O.G. 323. All other Change Notices up to and including 26-1 have been incorporated into the Manual.

The notation "R-26" in the attached pages appears either at the title or at the end of a section that has been altered in any way.

Page 186.1 issued in Revision No. 25 was erroneously numbered 168.1.

Louis O. Maassel
Editor, Manual of Patent
Examining Procedure

Particular attention is called to the following sections:

The checklist of pages has been updated.

- 201.06 Incorporates Notice of June 5, 1970 (875 O.G. 702) on notation of divisional application papers.
- 506 Revised incomplete and informal applications procedure.
- 608.01(p) Incorporation by reference portion revised to indicate that if a soft copy is furnished, no affidavit is required.
- 708.02 Entire petition to make special guidelines revised.
- 710.02(e) Indicates that Primary Examiners may grant first requests for extension of time up to the statutory limit.

(Over)

- 710.05 Sets forth new holidays, effective January 1, 1971.
- 713.01 States that Examiners are to avoid interruptions during interviews.
- 821.03 Indicates that an amendment canceling all claims to the elected species and presenting only claims drawn to the non-elected species is not entered.
- 903.03 Outlines new foreign patent classification procedure.
- 903.08(a) Revised application transfer procedure details & (d) included.
- 1208 Confidential memoranda to Board of Appeals practice ended. Incorporates Change Notice 26-1.
- 1706 Acknowledgment of Disclosure Document procedure included.
- Appendix Updated
I & II

List of replacement pages for Revision 26:

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7-8	26-26	154.3-blank	26
8.1-blank	26	186.1-blank	26
32.1-blank	26	195-196	26-26
48.3-48.4	26-26	197-198	26-26
49-50	26-21	215-216	26-26
87-88	26-26	216.1-blank	26
*88.1-blank	26	228.1-blank	26
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99-100	26-26	249-250	26-26
135-136	26-26	251-blank	26
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149-blank	26	255-blank	26

*Added sheet

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MANUAL OF PATENT EXAMINING PROCEDURE
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Instructions regarding Revision No. 25

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 until prosecution of all applications under the program is concluded. The termination of this program was announced in the Notice of June 9, 1969; 864 O. G. 323. All other Change Notices up to and including 25-1, have been incorporated into the Manual.

The notation "R-257" in the attached pages appears either at the title or at the end of a section that has been altered in any way.

Louis O. Maassel
Editor, Manual of
Patent Examining Procedure

Particular attention is called to the following sections:

Section

- | | |
|------------|---|
| 602.03 | Item #4 has been added to the list. |
| 608.02 (a) | Revised informal drawing procedure. |
| 702.01 | Incorporates a portion of the Notice of March 4, 1965 (812 O. G. 1295). |

(over)

Section

714.13, 715.09, 716 Incorporates Change Notice 25-1 on affidavit practice.

1105.01, 1105.06 States that the Examiner must include a basis for any conclusions in a motion decision.

1109.02 Discussion of interference estoppel has been added.

List of replacement pages for Revision 25:

<u>Page</u>	<u>Rev. No.</u>	<u>Page</u>	<u>Rev. No.</u>
Title Page	25-25	171-172	25-25
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16.1-blank	25	180.1-blank	(Eliminated)
34.1-34.2	25-25	181-182	25-25
35-36	25-25	182.1-blank	(Eliminated)
53-54	25-25	183-184	25-25
54.1-blank	25	185-186	25-25
61-62	25-25	*186.1-blank	25
63-64	25-25	193-194	25-25
77-78	25-25	194.1-blank	25
101-102	25-25	203-blank	25
102.1-102.2	25-25	219-220	25-25
102.3	25	220.1-220.2	25-25
107-108	25-25	220.3-220.4	25-25
108.1-blank	25	220.5-220.6	25-25
111-112	25-25	220.7-blank	25
113-114	25-25	229-230	25-25
123-124	25-25	231-232	25-25
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*Added sheet

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MANUAL OF PATENT EXAMINING PROCEDURE
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Instructions regarding Revision No. 24

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 until prosecution of all applications under the program is concluded. The termination of this program was announced in the Notice of June 9, 1969; 864 O.G. 323. All other Change Notices have been incorporated into the Manual.

The notation "R-247" in the attached pages appears either at the title or at the end of a section that has been altered in any way.

Louis O. Maassel
Editor, Manual of Patent
Examining Procedure

Particular attention is called to the following sections:

Section

- | | |
|--------|--|
| 201.13 | New paragraph on Inventors' Certificates. |
| 502 | Handling of hand-delivered papers. |
| 503 | Incorporates notice of February 2, 1970 on early notification of serial number. |
| 608.01 | Incorporates notice of January 28, 1970 on photocopies of applications. |
| 708.02 | Incorporates notice of January 29, 1970 on granting special status to applications to inventions which enhance the quality of the environment. |

- 711.03(c) Incorporates Change Notice 24-1 on petition to revive practice clarification.
- 903.08(d) Revised application transfer procedure.
- 904.01(d),
904.02 Revised guidelines on conducting the search.
- 1302.04 Incorporates Change Notice 24-2 on examiners' amendments with charges against deposit accounts.
- 1306 Incorporates notice of February 4, 1970 on calculation of issue fees.

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Patent Office
Washington, D. C. 20231

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Third Edition

Instructions regarding Revision No. 23

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 until prosecution of all applications under the program is concluded. The termination of this program was announced in the Notice of June 9, 1969; 864 O.G. 323. All other Change Notices have been incorporated into the Manual.

The notation "R-23" in the attached pages appears either at the title or at the end of a section that has been altered in any way.

Louis O. Maassel
Editor, Manual of Patent
Examining Procedure

Particular attention is called to the following sections:

Section

203.08	Duty of Inquiry by applicant
710.02(e)	Hand delivery of request for extension of time
711.03(c)	Petition to revive practice
714.13	Prosecution after final rejection
901.06(d)	Defensive Publication numbers

(Over)

Rev. 23, Jan. 1970

903.03 Foreign patent retention practice
903.08(a) & (d) Application transfer procedure
903.09 International Classification of Patents
905.02 Soft copy order notations for UXR's
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Washington, D. C. 20231

MANUAL OF PATENT EXAMINING PROCEDURE
Third Edition

Instructions regarding Revision No. 22

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 until prosecution of all applications under the program is concluded. The termination of this program was announced in the Notice of June 9, 1969; 864 O.G. 323. All other Change Notices have been incorporated into the Manual.

The notation "R-22" 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 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:

<u>Section</u>	
201.07	Incorporates Change Notice 22-2
409.03	Revised to reflect current Rule 47 practice
602	Includes revised Rule 68 and 18 U.S.C. 1001
608.01(b)	Revised in view of Change Notice 22-1
608.01(g)	
608.01(o)	
1302.04	
608.01(p)	Incorporates "Guidelines for Considering Disclosures of Utility in Drug Cases" notice of March 19, 1968.

(Over)

Rev. 22, Oct. 1969

- 905.01 Incorporates notice of August 21, 1969 on orders for copies of foreign patents
- 1101.02 Revised to reflect current interference practice
- 1712 New section on U.S.-Swedish Search Exchange

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MANUAL OF PATENT EXAMINING PROCEDURE
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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 Rewritten to include screening procedure of all
& 108 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).

- 706.03 Rewritten to include Change Notice 18-1.
- 706.03(b) Revised to include new application security screening procedure.
- 708.02 Paragraph numbered "4" amended to allow use of forms in "Accelerated Examination" applications.
- 714.13 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 18-6).
- 806.05(a)- Incorporates Change Notice 17-5.
(c)
- 808.01(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.

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*Added page

MANUAL OF
P A T E N T
E X A M I N I N G
P R O C E D U R E

Original Third Edition, dated November 1961

Latest Revision January 1973



U.S. DEPARTMENT OF COMMERCE • PATENT OFFICE

Rev. 35, Jan. 1973

The Patent Office does not handle the sale of the Manual, distribution of notices and revisions or change of address of those on the subscription list.

Correspondence relating to any of the above items should be sent to the Superintendent of Documents at the following address:

Superintendent of Documents
Mail List Section
P.O. Box 1533
Washington, D.C. 20013

Orders for individual replacement pages not amounting to a complete revision of the Manual should be sent to the following address:

Commissioner of Patents
Washington, D.C. 20231
Attn: Customer Services Division

The cost per page will be 30¢ (see rules 13(a), 21(b), and 21(t) Rules of Practice).

Charges may be made to deposit accounts if the requestor is an account holder in good standing at the time the request is received. Checks or money orders should be made payable to the Commissioner of Patents. Requests must identify the specific pages required and the number of copies of each page.

Employees of the Patent Office should direct their requests for the Manual, replacement pages, notices, and revisions to the Scientific Library.

First Edition, November 1949	Revision 14, October 1967
Revision 1, November 1950	Revision 15, January 1968
Revision 2, December 1951	Revision 16, April 1968
Revision 3, May 1952	Revision 17, July 1968
Second Edition, November 1953	Revision 18, October 1968
Revision 1, April 1955	Revision 19, January 1969
Revision 2, June 1956	Revision 20, April 1969
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Foreword

This Manual is published to provide Patent Office examiners, applicants, attorneys, agents, and representatives of 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 application.

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.

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

Commissioner of Patents,
Washington, D.C. 20231

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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 provision of the Constitution, Congress has over the years 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.

By an Act of Congress approved July 19, 1952, which came into effect on January 1, 1953, the patent laws were revised and codified into their present form. 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 96 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 patent code the citation is given, for example, as, 35 U.S.C. 31. The pamphlet "Patent Laws" (available from the Superintendent of Documents for 35 cents) reprints the patent code and some additional statutes.

Rules of Practice

One of the sections of the patent statute, namely, 35 U.S.C. 6, authorizes the Commissioner 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 rules are set forth in a Patent Office booklet entitled "Rules of Practice of the United States Patent Office in Patent Cases" (available from the Superintendent of Documents for 55 cents). These rules and the various amendments were published in the Federal Register. In the Federal Register and in the Code of Federal Regulations these rules are Part 1 of Title 37, Patents, Trademarks and Copyrights, and the individual rules, there called sections, are numbered with the Part number and a decimal point prefixed to the numbers to the rule number; thus section 1.33 in the Federal Register and the Code of Federal Regulations is the same as rule 33. 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. 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 other Office Officials 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. Applicants dissatisfied with an Examiner's action may have it reviewed. In general, that portion of the Examiner's action pertaining to

MANUAL OF PATENT EXAMINING PROCEDURE

objections on formal matters may be reviewed by petition to the Commissioner of Patents (see § 1002) and that portion of the Examiner's action pertaining to the rejection of claims on the merits, may be reviewed by appeal to the Board

of Appeals (see § 1201). The distinction is set forth in Rules 181 and 191. In citing decisions as authority for his actions, the Examiner should cite the decision in the manner set forth in § 707.06.