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1301 Substantially Allowable Case, Special [R-30]

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).

1302 Final Review and Preparation for Issue

1302.01 General Review of Disclosure [R-46]

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 § 601.01(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. An examiner's amendment should be prepared if the order of the claims is changed. See §§ 608.01(j), 608.01(n) and 1302.04(g).

The abstract should be checked for an adequate and clear statement of the disclosure. See § 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.

The Mail Room receipt date of all amendments should be reviewed to assure that they were timely filed.

1302.02 Requirement for a Rewritten Specification [R-24]

Whenever interlineations or cancellations have been made in the specification or amendments which would lead to confusion and mistake, the examiner 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-31]

Form POL-327 is used whenever an application has been placed in condition for allowance as a result of a communication from or an interview with applicant except where an examiner's amendment will be mailed promptly.

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 or examiner's amendment is necessary, it should be prepared and mailed before preparing the application for allowance. See § 714.13.

1302.04 Examiner's Amendments and Changes [R-46]

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 "Patent No. ----" to identify a patent which has been granted on a U.S. application referred to by serial number in the specification.
6. Entry of "abandoned", if a U.S. patent application referred to by serial number in the specification has become abandoned.
7. Entry of "now Defensive Publication No. T ----" following the filing date if a patent application referred to in the specification by serial number has been published as a Defensive Publication.
8. Other obvious minor grammatical errors such as misplaced or omitted commas, improper parentheses, quotation marks, etc.
9. 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 § 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 attorney or agent) 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.

The examiner's amendment practice may be used to make charges against deposit accounts

under special conditions. Such charges must not exceed \$50.00 for any one patent application.

An examiner's amendment can be used to make a charge against a deposit account, provided prior approval is obtained from the applicant, attorney or agent, in order to ex-

pedite the issuance of a patent on an application otherwise ready for allowance. When such an examiner's amendment is prepared the prior approval is indicated by identification of the name of the authorizing party, the date and type (personal or telephone) of authorization, the purpose for which the charge is made (drawing correction, additional claims, etc.), and the deposit account number. Further identifying data, if deemed necessary and requested by the attorney, should also be included in the examiner's amendment.

A change in the abstract may be made by examiner's amendment.

Where a reference to the parent application in an otherwise allowable rule 60 case has inadvertently been omitted by the applicant, the examiner should insert the required reference by examiner's amendment (see § 201.11).

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-892, a copy of which will be attached to examiner's amendment form POL-37.

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).

→ No other changes may be made by any person in any record of the Patent and Trademark Office without the written approval of the Commissioner of Patents and Trademarks.

→ 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 examiner's amendment is sent to applicant even if the application is already in the printer's hands. See § 1309.01.

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, *In re Willingham*, 127 USPQ 211, CCPA (1960).

In all instances, both before and after final

rejection, in which an application is placed in condition for allowance as by an interview or amendment, applicant should be notified promptly of this fact by means of form letter POL-327 or an examiner's amendment. [R-47]

1302.04(a) Title of Invention [R-24]

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 [R-24]

See §§ 821.01 and 821.02.

1302.04(d) Cancellation of Claim Lost in Interference [R-24]

See § 1109.02.

1302.04(e) Cancellation of Rejected Claims Following Appeal [R-24]

See §§ 1214.06, 1215.03, and 1215.04.

1302.04(f) Data of Copending Application Referred to Should Be Brought Up to Date [R-47]

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: "Patent No. ----." Where a referred to patent application has been published as a Defensive Publication, the examiner should enter "now Defensive Publication No. T—, —" following the filing date. They entry is to be initialed and dated 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, "abandoned" should be made in red ink, and initialed and dated by the examiner in the margin. A formal examiner's amendment is not required.

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-24]

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-47]

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 or declaration 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 to abandoned files, fill in label and send it to Abandoned Files Unit for attachment to the wrapper. If not forwarded, treat the same as pending case.

Abandoned:

If file has been forwarded fill in label and send it to Abandoned Files Unit for attachment to the wrapper. If not forwarded treat the same as pending case. Add ", now abandoned" by red ink and initialing to 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.

1302.08 Interference Search [R-24]

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-41]

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

To aid the Patent Issue Division and the printers, 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.

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).

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.

From January 1, 1968 to September 24, 1974, if an issuing application contained an abstract, the abstract was published in the Official Gazette instead of a claim. After October 1, 1974, claims appear in the Official Gazette.

Examiners, when preparing an application for issue, are to record the number of the claim selected for printing in the Official Gazette in the box labeled "PRINT CLAIM(S) :" on the inside left flap of the file wrapper above the "Index of Claims".

The claim or claims should be selected in accordance with the following instructions:

1. The broadest claim should be selected.
2. Examiners should ordinarily designate but one claim on each invention, although when a plurality of inventions are claimed in an application, additional claims up to a maximum of five may be designated for publication.
3. A dependent claim should not be selected unless the independent claim on which it depends is also printed.
4. In reissue applications, the broadest claim with changes or the broadest additional reissue claim should be selected for printing.

When recording this information in the box provided, the following items should be kept in mind:

1. Write the claim number clearly in black ink.
2. If multiple claims are selected, the claim numbers should be separated by commas.
3. The claim designated must be referred to by using the renumbered patent claim number rather than the original application claim number.

1302.10 Notations on Drawings and on Classification (Issue) Slip [R-52]

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 claim 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 margin.

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 Patent Issue Division. Under current practice, the clerk of the examining group does NOT enter any date when the case is "sent to issue". See §§ 903.07, 903.07(b) and 903.09 for notation to be applied to the Issue Classification Slip (Form PTO-270).

In all reissue applications, a horizontal line should be drawn through the middle of the "NAME" box. The applicant's name should be placed in the upper portion of the box and the number of the original patent which is being reissued should be placed in the lower portion of the box.

To ensure that both copies of the slip do not become separated from the file, examiners should affix the entire unit set to the inside left flap of the file wrapper by stapling it at the upper right hand corner, using one staple only in the space marked "cross references". It is not necessary to remove the carbon paper.

The Allowed Files Unit of the Patent Issue Division remove the original for use by Machine Operations Branch and leave the carbon copy in the file for use by the printer.

1302.11 Reference to Assignment Division [R-41]

The practice of referring certain applications to the Assignment Division when passing them to issue is no longer followed. See § 303.

1302.12 Listing of References [R-52]

All references which have been cited by the examiner during the prosecution, including those appearing in Board of Appeals decisions, and those submitted by applicant if they con-

form 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 pertinent art should be listed as usual on form PTO-892, a copy of which is attached to the examiner's amendment form PTOL-37. Such pertinent art is not sent to the applicant. 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 §§ 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 (PTO-892) in the application. All lists of references are maintained in the center section of the file wrapper.

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 § 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 PTO-892.

All copies of references placed in the file wrapper during prosecution, should be retained therein, when the allowed application is forwarded to the Office of Quality Review.

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.

1302.14 Reasons for Allowance [R-52]

37 CFR 1.109 Reasons for allowance. If the examiner believes that the record of the prosecution as a whole does not make clear his reasons for allowing a claim or claims, the examiner may set forth such reasoning. This shall be incorporated into an Office action rejecting other claims of the application or be the subject of a separate communication to the applicant. The applicant may file a statement commenting on the reasons for allowance within such time as may be specified by the examiner. Failure to file such a statement shall not give rise to any implication that the applicant agrees with or acquiesces in the reasoning of the examiner.

Reasons for Allowance

One of the primary purposes of Section 1.109 is to improve the quality and reliability of issued patents by providing a complete file history which should clearly reflect, as much as is reasonably possible, the reasons why the application was allowed. Such information facilitates evaluation of the scope and strength of a patent by the patentee and the public and may help avoid or simplify litigation of a patent.

The practice of stating the reasons for allowance is not new and the rule merely formalizes the examiner's existing authority to do so and provides applicants an opportunity to comment upon any such statement of the examiner.

It should be noted that the Rule is not mandatory on the examiner's part. But in meeting the need for the application file history to speak for itself, it is incumbent upon the examiner in exercising his responsibility to the public, to see that the file history is as complete as is reasonably possible.

When an application is finally acted upon and allowed, the examiner is expected to determine, at the same time, whether the reasons why the application is being allowed are evident from the record. In most cases, the examiner's reasons for allowing a claim or claims will be evident from the various Office actions and papers filed in the case.

Examiners should give particular attention to whether an application file reasonably indicates the reasons for allowance when the application is being allowed in the first Office action, especially if prior art made of record in the file is very close to the claims; when an examiner withdraws a rejection for reasons not suggested by the applicant; when an applicant submits several arguments for allowing a claim and the examiner finds not all of them persuasive; and when the examiner allows a claim after remand from the Board of Appeals.

Most instances when the examiner finds a need to place in the file a statement of the reasons for allowing a claim or claims will come at the time of allowance. In such cases the examinee should (a) check box 6 on the form PTOL-37 marked "other" and indicate "see attached statement of reasons for allowance", and (b) attach thereto a separate form containing the examiner's statement of reasons for allowance. The same general procedure will be followed in connection with an examiner's amendment (PTOL-37) by indicating thereon "see attached statement of reasons for allowance" and attaching thereto the form containing the reasons for allowance. Such a statement should be either typewritten or neatly and legibly handwritten. The form should identify the application serial number and be clearly labeled "Statement of Reasons for Allowance". It should also specify that comments may be filed by the applicant on the statement and should preferably be submitted with the payment of the issue fee so as not to delay processing of the application and in any event no later than payment of the issue fee. Such comments will be entered in the application file by the Allowed Files Branch with an appropriate notation on the "Contents" list on the file wrapper.

In due course PTOL-327 and PTOL-37 will be revised and a new "Statement of Reasons for Allowance" form developed for attachment to the PTOL-327. "Statement of Reasons for Allowance" forms will be provided for use by examiners.

A statement may be sent applicant with other communications where appropriate but should be clearly labeled as a "Statement of Reasons for Allowance" and contain the other data indicated above.

Examiners are expected to prepare any statement of their reasons for allowance accurately and precisely so as not to place unwarranted interpretations, whether broad or narrow, on the claims. Where the examiner has a large number of reasons for allowing a claim, it may suffice to state only the major or important reasons, being careful to so couch the statement. For example, a statement might start: "The primary reason for the allowance of the claims is the inclusion of the limitation ----- in all the claims which is not found in the prior art references," with further amplification as necessary.

Stock paragraphs with meaningless or uninformative statements of the reasons for the allowance should not be used. The statement of reasons for allowance by the examiner is intended to provide information equivalent to that contained in a file in which the examiner's Office

actions and the applicant's responses make evident the examiner's reasons for allowing claims.

Examiners are urged to carefully carry out their responsibilities to see that the application file contains a complete and accurate picture of the Office's consideration of the patentability of the application.

Finally, comments made by applicants on the examiner's statement of reasons for allowance will not be returned to the examiner after their entry in the file and will not be commented upon by the examiner.

1303 Notice of Allowance [R-52]

37 CFR 1.311. Notice of allowance. If, on examination, it shall appear that the applicant is entitled to a patent under the law, a notice of allowance will be sent to him, his attorney or his agent, calling for the payment of a specified sum constituting the issue fee or a portion thereof, which shall be paid within three months from the date of the notice of allowance.

The appropriate form of notice of allowance is prepared and mailed, and the mailing date appearing thereon is stamped on the file wrapper by the Patent Issue Division.

1303.01 Amendment Received After Allowance [R-47]

If the amendment is filed under 37 CFR 1.312, see §§ 714.15 to 714.16(e). If the amendment contains claims copied from a patent, see § 1101.02(g).

ISSUE BATCH NUMBER

All papers filed by applicant in the Office after receiving the Notice of Allowance and before the time the Issue Fee Receipt is received should include the Issue Batch Number. The Issue Batch Number is printed on the Notice of Allowance form in box 4 in the lower left hand corner below the address. The Issue Batch Number consists of a capital letter followed by two digits, for example; "AO3", "D18", "F42", "J79". Any lower case letters before the Issue Batch Number should be ignored since they are the typist's initials. Use of the Issue Batch Numbers is important since the allowed applications are filed by these numbers.

Any paper filed after receiving the Issue Fee Receipt should include the indicated patent number rather than the Issue Batch Number. At this time in the processing, the Issue Batch Number is no longer useful since the application has been removed from the batch at the time the patent number was assigned.

1303.02 Undelivered [R-24]

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 [R-24]

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 [R-24]

"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 [R-24]

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

1305 Jurisdiction [R-52]

Jurisdiction of the application remains with the primary examiner until the notice of allowance is mailed by the Patent Issue Division. 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 37 CFR 1.312 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 § 1.312 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 §§ 1112.04, 1308, and 1308.02.

Once the patent has been granted, the Patent and Trademark 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 Issue Fee [R-51]

35 U.S.C. 41 (a) 2. For issuing each original or re-issue patent, except in design cases, \$100; in addition, \$10 for each page (or portion thereof) of specification as printed, and \$2 for each sheet of drawing.

35 U.S.C. 151. If it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant. The notice shall specify a sum, constituting the issue fee or a portion thereof, which shall be paid within three months thereafter.

Upon payment of this sum the patent shall issue, but if payment is not timely made, the application shall be regarded as abandoned.

Any remaining balance of the issue fee shall be paid within three months from the sending of a notice thereof, and, if not paid, the patent shall lapse at the termination of this three-month period. In calculating the amount of a remaining balance, charges for a page or less may be disregarded.

If any payment required by this section is not timely made, but is submitted with the fee for delayed payment and the delay in payment is shown to have been unavoidable, it may be accepted by the Commissioner as though no abandonment or lapse had ever occurred.

37 CFR 1.314. Issuance of patent. If payment of the issue fee or that portion thereof specified in the notice of allowance is timely made, the patent will issue in regular course.

The Office has discontinued the practice of estimating the number of printed pages of specification in advance of printing. Instead, a Base Issue Fee is due three months from the date of the Notice of Allowance. The amount of the Base Issue Fee is shown on the Notice of Allowance and consists of \$100 plus \$10 for the first page of printed specification plus \$2 for each sheet of drawing.

The Office calculates the balance of issue fee due, after payment of the Base Issue Fee specified by the Notice of Allowance, at the rate of \$10 a page, as provided in 35 U.S.C. 41, for each printed page of specification (including claims) for which payment has not previously been received. As the Base Issue Fee includes a \$10 charge for one printed page of specification, a Balance of Issue Fee is due for each patent which consists of more than one printed page. A "page" consists of one side of a printed sheet containing any amount of specification (including claims). A notification of the Balance of Issue Fee Due is mailed in each such case along with the original patent grant.

Applicants and their attorneys or agents are urged to use the special fee transmittal forms provided with the Notice of Allowance and the Notice of Balance of Issue Fee Due when submitting their payments.

The payment of the balance of issue fee due may be simplified by using a Patent and Trademark Office Deposit Account for such a fee. A statement, in duplicate, at the time of payment of the minimum issue fee, indicating that applicant's or attorney's Deposit Account may be billed for the balance of the issue fee will be considered as sufficient authorization to make such a payment.

The above mentioned fees will be accepted from the applicant, assignee, or a registered attorney or agent, either of record or under 37 CFR 1.34(a).

1307 Change in Classification of Cases Which Are in Issue [R-24]

See § 903.07

1308 Withdrawal From Issue [R-48]

37 CFR 1.313. Withdrawal from issue. (a) 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.

(b) 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.

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-51]

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 § 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 re-

jecting 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 37 CFR 1.312 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. After the letter is mailed, the file wrapper should be retained by the examiner to prevent inadvertent issuance of the patent.

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 Patent Issue Division 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 [R-22]

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.

1308.03 Quality Review Program for Examined Patent Applications [R-48]

The Quality Review Program which was instituted in the Office on April 1, 1974 is now a permanent part of the patent examining operation.

The purpose of the program is to evaluate and continuously monitor the quality of the product of the patent examining process and to assist in determining where substantive and procedural adjustments in the patent examination process are appropriate.

The program involves randomly selecting a sample of allowed applications from each of the Art Units in the Patent Examining Corps before the applications are forwarded to the Patent Issue Division for mailing of the "Notice of Allowance." The quality review is conducted by Patentability Review Examiners and is concerned with three major aspects of the patent examining process, namely:

- (1) patentability of the allowed claims in view of the prior art of record or other reasons determined by the Review Examiners;
- (2) compliance with current examining practices and procedures; and
- (3) correctness of the field of search and the classification of each application.

The Quality Review Program also provides for the re-search of some of the allowed applications in the sample.

If, during the quality review process, it is determined that one or more claims of a reviewed application are clearly unpatentable, the prosecution of the application will be reopened. Only those applications wherein the prosecution has been reopened will reflect in the record that a quality review has taken place.

When prosecution is reopened as a result of the patentability aspect of the quality review, a copy of the Patentability Review form, "Quality Review—Part II," should be included with the Office action. The Office action itself should be consistent with, and include the substance of, the proposed rejection(s) set forth in the Patentability Review form.

In any application where prosecution is reopened as a result of the patentability aspect of the quality review the Office action should contain an opening paragraph such as:

"Pursuant to a Quality Review of this application, prosecution is reopened on claims _____ which are considered unpatentable for the reasons indicated below:"

When the Office action includes a rejection of *claims in addition* to the claims in the Patentability Review form, the action should contain not only the above quoted paragraph, but also a second paragraph such as:

"In addition, on further consideration of the claims in this application, prosecution is also reopened on claims _____ which are considered unpatentable for the reasons set forth below:"

are considered unpatentable for the reasons set forth below:

1309 Issue of Patent [R-52]

The files of allowed cases (not patented files) are kept in the Patent Issue Division, arranged in the batch number order. When the Issue fee is paid within the time allowed by law, the file is given a patent number and date, after which it is sent for printing of the specification. A bond paper copy of the drawing and specification is ribboned and sealed in the Patent Issue Division and finally signed.

See § 1303.01 for explanation of "Issue Batch Number."

PATENT PRINTING PRIORITY

The applications placed in the weekly formulation of an issue set aside for printing will be selected according to the following priorities:

1. Allowed cases which were made special by the Commissioner (including those under the Special Examining Procedure).
2. Allowed cases that have a U.S. effective filing date more than five years old.
3. Allowed reissue applications.
4. Allowed applications having an effective filing date earlier than that required for declaring an interference with a copending application claiming the same subject matter.
5. Allowed application of a party involved in a terminated interference.
6. Allowed applications in which the applicant has filed a request in the nature of a petition setting forth his reasons for advancing the printing date.
7. Allowed applications ready for printing and not covered by any of the six preceding categories. The selection of cases in the involved category will be by chronological sequence based on the date the issue fee was paid.

To ensure that any application falling within the scope of the categories outlined above and identified by numbers 1 to 5 receives special treatment the examiners should staple on the file wrapper a tag entitled "Special in Patent Issue Division." The special tag, PTO-1101, may be obtained from the group clerk. The examiner shall print directly on the tag the recitation "In Patent Issue Division" and the appropriate printing category outlined above. The application is then forwarded to Patent Issue Division.

The personnel in Patent Issue Division will then set the tagged cases aside and make a notation on all copies of the Notice of Allowance to

be mailed that further processing of this application will be "special."

In cases falling in category No. 6, the request must be filed after the Notice of Allowance has been received and no later than the date the issue fee is paid. The request must be directed to the Head of the Patent Issue Division.

35 U.S.C. 2. Seal. The Patent and Trademark Office shall have a seal with which letters patent, certificates of trademark registrations, and papers issued from the Office shall be authenticated.

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 and Trademark Office, and shall be signed by the Commissioner or have his signature placed thereon and attested by an officer of the Patent and Trademark Office designated by the Commissioner, and shall be recorded in the Patent and Trademark Office.

35 U.S.C. 154. Contents and term of patent. Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, for the term of seventeen years, subject to the payment of issue fees as provided for in this title, of the right to exclude others from making, using, or selling the invention throughout the United States, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof.

PRINTING PRACTITIONERS' NAMES ON PATENTS

The Office has adopted the following procedure for printing a firm name, the names of up to three registered patent practitioners, or no practitioner's name on the patent.

The Notice of Allowance form, PTOL-85, has been redesigned in part to provide a space on PTOL-85b, the Base Issue Fee Transmittal form, for the person submitting the base issue fee to indicate, for printing, the names of up to three registered patent attorneys and agents or, alternatively, the name of a single firm which has as a member at least one registered patent attorney or agent. If the person submitting the base issue fee desires that no practitioner's name be printed on the patent, the space provided on the revised Base Issue Fee Transmittal form should be left blank. If no name is given, no name will be printed.

This procedure is intended to solve various problems encountered since the practice of recognizing firms was discontinued. While some slight additional effort on the part of the attorney or agent is thus involved if he desires to have a printed entry on the patent, the following advantages are provided by the new procedure: (1) it permits printing firm names on patents even though firms are no longer registered with or recognized by the Office in new

applications; (2) it allows the names of those individuals who actually performed the work of preparing and prosecuting the application to appear on the printed patent; and (3) it grants an attorney or agent the option of not having his name appear on the printed patent.

ASSIGNMENT PRINTED ON PATENT

The Issue Fee Transmittal Form portion (PTOL-85b) of the Notice of Allowance as revised in December 1969 and May 1973, provides a space (item 2) for assignment data which should be completed in order to comply with 37 CFR 1.334. Unless an assignee's name and address are identified in item 2 of the Issue Fee Transmittal Form PTOL-85b, the patent will issue to the applicant. Assignment data printed on the patent will be based solely on the information so supplied.

A request for correction of error arising from incomplete or erroneous information furnished in item 2 of PTOL-85b will not be granted as a matter of course and will be subject to adherence to all the requirements of 37 CFR 1.323.

ASSIGNEE NAMES

Only the first appearing name of an assignee will be printed on the patent where multiple names for the *same* party are identified on the Base Issue Fee Transmittal form, PTOL-85b. Such multiple names may occur when both a legal name and an "also known as" or "doing business as" name is also included. This printing practice will not, however, affect the practice of recording assignments with the Office in the Assignment Division. The assignee entry on form PTOL-85b should still be completed to indicate the assignment data as recorded in the Office. For example, the assignment filed in the Office and therefore the PTOL-85b assignee entry might read "Smith Company doing business as (d.b.a.) Jones Company." The assignee entry on the printed patent will read "Smith Company."

Various officials including the head of the Patent Issue Division have been designated as attesting officer to attest to the name of the Commissioner. The assistant head of the Patent Issue Division acts as attesting officer in the absence or unavailability of the head of the Division.

1309.01 "Printer Waiting" Cases [R-48]

When the printer finds an apparent error in an application, the file is returned to the Office with an attached "Printer Waiting" slip noting the supposed error.

The Patent Issue Division forwards such "printer waiting" applications to the Office of Quality Review (OQR) at periodic intervals throughout each working day. The applications are recorded in OQR for control purposes and then hand carried by a messenger from OQR with a control list to the group director's secretary. The secretary acts as a control center in each examining group and forwards the applications to the examiner by the appropriate route. The application should be taken up and acted on immediately and returned to the group director's secretary within 24 hours (excluding weekends and holidays). Either necessary corrective action should be taken or an indication should be made that the application is considered to be correct as it stands.

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 § 1802.04.

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 telephoned immediately, and the error is corrected by amendment under 37 CFR 1.312.

The applications are picked up from the secretary's office by the messenger from OQR and returned to OQR for processing and then returned to the Patent Issue Division for forwarding to the printer. **THESE APPLICATIONS SHOULD NOT BE MAILED TO THE PATENT ISSUE DIVISION OR TO THE OQR.**

1309.02 Protest Against Issue [R-52]

37 CFR 1.291. *Protests and prior art citations by public.* (a) Protests against pending applications will be acknowledged and referred to the examiner having charge of the subject matter involved. A protest specifically identifying the application to which the protest is directed will be entered in the application file and, if timely submitted and accompanied by a copy of each prior art document relied upon, will be considered by the examiner.

(b) Citations of prior art and any papers related thereto may be entered in the patent file after a patent has been granted, at the request of a member of the public or the patentee. Such citations and papers will be entered without comment by the Patent and Trademark Office.

(c) Protests and prior art citations by the public and any accompanying papers should either (1) reflect that a copy of the same has been served upon the applicant or patentee or upon his attorney or agent of

record; or (2) be filed with the Office in duplicate in the event service is not possible.

A party properly obtaining a knowledge of an application pending in the Office may file a protest against the issue of a patent upon it and may therein call attention to any facts within his knowledge which, in his opinion, would make the grant of a patent improper. He does not, however, thereby obtain the right to argue the question before the tribunals of the Office. The question of patentability has been uniformly looked upon as *ex parte* in character. It is a question between the applicant and the Office on behalf of the public, and no one member of the public can be recognized as having such an interest in the grant of a patent as to entitle him to contest the matter any further than to call attention to matters which he considers bars. The Office will consider facts called to its attention, but will not give the protestant a hearing as a matter of right. *Carey v. The New Home Sewing Machine Co.*, 1901 C.D. 165; 97 O.G. 1171.

When a protest is filed against the issuance of a patent it should be directed to the group director who will refer it to the examiner. After consideration by the examiner, the examiner's decision on the protest is reported to the group director.

Section 1.291 (a) provides that public protests against pending applications will be entered in the application file and will, if they meet stated requirements, be considered by the examiner. To guarantee consideration by the examiner protests must be accompanied by copies of prior art documents relied upon, although protests without copies will not necessarily be ignored. This is similar to the requirement of § 1.98 that copies of patents and publications accompany prior art statements. Section 1.291 does not contemplate permitting a protester to participate as a party in further proceedings. In the case of applications available to the public, such as reissue applications, the protester may file papers rebutting statements made by the applicant. The examiner at his discretion may request a protester to submit additional written information or may provide extra time for comments by a protester to be filed.

To ensure consideration by the examiner, all protests must be timely submitted. Protests will generally be considered timely submitted if they are filed before final rejection or allowance of the application by the examiner. The consideration given to protests filed after final rejection or allowance of the application by the examiner will depend upon the relevance of the prior art documents submitted and the point in time at

which they are submitted. Obviously, if the prior art documents anticipate or clearly render obvious one or more claims they will not knowingly be ignored. It must be recognized, however, that the likelihood of consideration by the examiner decreases as the patent date approaches. Accordingly, protests must be filed early in order to ensure their consideration.

Section 1.291 (a) applies to pending applications. All protests will be referred to the examiner having charge of the subject matter involved.

Section 1.291 (b) permits persons to submit prior art citations or copies of prior art after a patent has been granted. In such an instance, both the citations and the related papers are to be entered without comments. The material submitted is not examined by the Office but is available to members of the public inspecting Office records.

Materials submitted to the Office under § 1.291 are to be served upon the applicant, patentee, attorney or agent when possible. The term "patentee" is used in its ordinary sense as defined in 35 USC 100 (d). If service is not possible, materials are to be submitted in duplicate so that the Office can attempt to send the duplicate copy.

The following procedures will be observed under sections 1.291 (b) and (c):

- 1) Only in those instances where it has not been possible to serve protest papers upon the applicant, attorney or agent should duplicates of the papers submitted be provided. In this case the appropriate examining group will attempt to get the duplicate copy to the applicant, attorney or agent. However, every effort should be made by the protester to effect service.
- 2) Citations of prior art and any papers related thereto may be entered in the file after a patent has been granted by submitting them to the attention of the Record Room, where they will be entered without comment by the Office. If after diligent effort it has not been possible to serve the prior art citations and related papers on the patentee, his attorney or agent, duplicate copies should be submitted in which case the Record Room will attempt to get the duplicate copy to the owner of record.
- 3) To ensure consideration by the examiner, protests should be timely submitted, i.e., before final rejection or allowance. Consideration of protests filed after final rejection or allowance will depend upon the relevance of the prior art documents and the point in time at which they are submitted. Documents

which clearly anticipate or render obvious one or more claims will not knowingly be ignored. If protests are not timely submitted or if they fail to comply with section 1.291(a) as to the submission of a copy of each prior art document relied upon, they will be acknowledged and referred to the examiner having charge of the subject matter involved for entry in the application file and such consideration as seems warranted.

In each instance where an examiner considers but does not cite on form PTO-892 specific prior art referred to in a protest, the examiner will place a notation in the protest paper adjacent to the reference which will include his or her initials and the term "checked."

Additional future guidelines as to protest procedures may be developed after gaining experience with the new practice.

37 CFR 1.291 gives recognition to the value of written protests in avoiding the issuance of invalid patents.