Chapter 600 Parts, Form, and Content of Application

601 Content of Application

35 U.S.C. 111. Application for patent

Application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include (1) a specification as prescribed by section 112 of this title; (2) a drawing as prescribed by section113 of this title; and (3) an oath by the applicant as prescribed by section 115 of this title. The application must be accompanied by the fee required by law. The fee and oath may be submitted after the specification and any required drawing are

submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Commissioner. Upon failure to submit the fee and oath within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Commissioner that the delay in submitting the fee and oath was unavoidable. The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

37 CFR 1.51. General requisites of an application.

(a) Applications for patents must be made to the Commissioner of Patents and Trademarks. A complete application comprises:

(1) A specification, including a claim or claims, see §§ 1.71 to 1.77.

(2) An oath or declaration, see §§ 1.63 and 1.68.

(3) Drawings, when necessary, see §§ 1.81 to 1.88.

(4) The prescribed filing fee, see § 1.16.

(b) Applicants are encouraged to file an information disclosure statement, See §§ 1.97and 1.98.

(c) Applicants may desire and are permitted to file with, or in, the application an authorization to charge, at any time during the pendency of the application, any fees required under any of §§ 1.16 to 1.18 to a deposit account established and maintained in accordance with § 1.25.

GUIDELINES FOR DRAFTING A MODEL PATENT APPLICATION

The following guidelines illustrate the preferred layout and content of patent applications. These guidelines are suggested for the applicant's use.

Arrangement and Contents of the Specification

The following order of arrangement is preferable in framing the specification and, except for the title of the invention, each of the lettered items should be preceded by the headings indicated.

(a) Title of the Invention.

(b) Cross-References to Related Applications (if any).

(c) Statement as to Rights to Inventions Made Under Federally Sponsored Research and Development (if any).

(d) Background of the Invention.

1. Field of the Invention.

2. Description of Related Art Including Information Disclosed Under § 1.97 and § 1.98.

(e) Summary of the Invention.

(f) Brief Description of the Drawing.

(g) Description of the Preferred Embodiment(s).

(h) Claim(s).

(i) Abstract of the Disclosure (on a separate page).

Content

(a) *Title of the Invention*: (See 37 CFR 1.72(a).) The title of the invention should be placed at the top of the first page of the specification. It should be brief but technically accurate and descriptive preferably from two to seven words.

(b) *Cross-References to Related Applications*: (See 37 CFR 1.78 and MPEP § 201.11.)

(c) *Statement as to Rights to Inventions Made Under Federally Sponsored Research and Development (if any)*: (See MPEP § 310).

(d) *Background of the Invention:* The specification should set forth the Background of the Invention in two parts:

(1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions. The statement should be directed to the subject matter of the claimed invention. This item may also be titled "Technical Field".

(2) Description of the Related Art Including Information Disclosed Under 37 CFR 1.97and 1.98: A paragraph(s) describing to the extent practical the information known to the applicant, including references to specific documents where appropriate. Where applicable, the problems involved in the information disclosed which are solved by the applicant's invention, should be indicated. This item may also be titled "Background Information".

(e) *Summary of the Invention:* A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the art (and preferably indicated in the Background of the Invention). In chemical cases the summary should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention. This item may also be titled "Disclosure of Invention."

(f) *Brief Description of the Drawing(s):* A reference to and brief description of each Figure in the drawing(s) as set forth in 37 CFR 1.74.

(g) *Description of the Preferred Embodiment(s):* A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to adequately and accurately describe the invention. This item may also be titled "Best Mode for Carrying Out the Invention".

Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field to which the invention pertains, form a part of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a

person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

(h) *Claim(s)*: (See 37 CFR 1.75) A claim may be typed with the various elements subdivided in paragraph form. There may be plural indentations to further segregate subcombinations or related steps.

Reference characters corresponding to elements recited in the detailed description and the drawings may be used in conjunction with the recitation of the same element or group of elements in the claims. The reference characters, however, should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. The use of reference characters is to be considered as having no effect on the scope of the claims.

Claims should preferably be arranged in order of scope so that the first claim presented is the broadest. Where separate species are claimed, the claims of like species should be grouped together where possible and physically separated by drawing a line between claims or groups of claims. (Both of these provisions may not be practical or possible where several species claims depend from the same generic claim.) Similarly, product and process claims should be separately grouped. Such arrangements are for the purpose of facilitating classification and examination.

The form of claim required in 37 CFR 1.75(e) is particularly adapted for the description of improvement-type inventions. Such a claim is to be considered a combination claim and should be drafted with this thought in mind.

In drafting claims in accordance with 37 CFR 1.75(e), the preamble is to be considered to positively and clearly include all the elements or steps recited therein as a part of the claimed combination.

(i) *Abstract of the Disclosure:* (See 37 CFR 1.72(b) and MPEP § 608.01(b).)

Oath or Declaration

(See 37 CFR 1.63, 1.68, and 1.69.) Where one or more previously filed foreign applications are cited or mentioned in the oath or declaration, complete identifying data, including the application or serial number as well as the country and date of filing, should be provided.

THE APPLICATION

The specification must be filed in or translated into the English language and must be legibly typewritten, written, or printed in permanent ink or its equivalent in quality. See 37 CFR 1.52 and MPEP § 608.01.

The parts of the application may be included in a single document.

Determination of completeness of an application is covered in MPEP § 506 and § 601.01.

The specification and oath or declaration are secured together in a file wrapper, bearing appropriate identifying data including the serial number and filing date (MPEP § 717).

Note

Division applications, MPEP § 201.06.
Continuation applications, MPEP § 201.07.
Reissue applications, MPEP § 1401.
Design applications, MPEP Chapter 1500.
Plant applications, MPEP Chapter 1600.
Reexamination, MPEP Chapter 2200.

A model, exhibit, or specimen is not required as part of the application as filed, although it may be required in the prosecution of the application (37 CFR 1.91–1.93, MPEP § 608.03).

37 CFR 1.59. Papers of application with filing date not returned.

Papers in an application which has received a filing date pursuant to § 1.53 will not be returned for any purpose whatever. If applicants have not preserved copies of the papers, the Office will furnish copies at the usual cost of any application in which either the required basic filing fee (§ 1.16) or the processing and retention fee (§ 1.21(l)) has been paid. See § 1.618 for return of unauthorized and improper papers in interferences.

See, however, MPEP § 201.14(c) and § 604.04(a).

All applicants are requested to include a preliminary classification on newly filed patent applications. The preliminary classification, preferably class and subclass designations, should be identified in the upper right-hand corner of the letter of transmittal accompanying the application papers, for example "Proposed Class 2, subclass 129."

601.01 Complete Application

37 CFR 1.53. Serial number, filing date, and completion of application.

(a) Any application for a patent received in the Patent and Trademark Office will be assigned a serial number for identification purposes.

(b) The filing date of an application for patent filed under this section is the date on which: (1) A specification containing a description pursuant to § 1.71 and at least one claim pursuant to §1.75; and (2) any drawing required by §1.81(a), are filed in the Patent and Trademark Office in the name of the actual inventor or inventors as required by § 1.41. No new matter may be introduced into an application after its filing date (§1.118). If all the names of the actual inventor or inventors are not supplied when the specification and any required drawing are filed, the application will not be given a filing date earlier than the date upon which the names are supplied unless a petition with the fee set forth in §1.17(i)(1) is filed which sets forth the reasons the delay in

supplying the names should be excused. A continuation or divisional application (filed under the conditions specified in 35 U.S.C. 120 or 121 and § 1.78(a)) may be filed pursuant to this section, § 1.60 or § 1.62. A continuation-in-part application may be filed pursuant to this section or § 1.62.

(c) If any application is filed without the specification, drawing or name, or names, of the actual inventor or inventors required by paragraph (b) of this section, applicant will be so notified and given a time period within which to submit the omitted specification, drawing, name, or names, of the actual inventor, or inventors, in order to obtain a filing date as of the date of filing of such submission. A copy of the "Notice of Incomplete Application" form notifying the applicant should accompany any response thereto submitted to the Office. If the omission is not corrected within the time period set, the application will be returned or otherwise disposed of; the fee, if submitted, will be refunded less the handling fee set forth in § 1.21(n).

(d) If an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include the appropriate filing fee or an oath or declaration by the applicant, applicant will be so notified, if a correspondence address has been provided and given a period of time within which to file the fee, oath, or declaration and to pay the surcharge as set forth in § 1.16(e) in order to prevent abandonment of the application. A copy of the "Notice to File Missing Parts" form mailed to applicant should accompany any response thereto submitted to the Office. If the required filing fee is not timely paid, or if the processing and retention fee set forth in § 1.21(l) is not paid within one year of the date of mailing of the notification required by this paragraph, the application will be disposed of. No copies will be provided or certified by the Office of an application which has been disposed of or in which neither the required basic filing fee nor the processing and retention fee has been paid. The notification pursuant to this paragraph may be made simultaneously with any notification pursuant to paragraph (c) of this section. If no correspondence address is included in the application, applicant has two months from the filing date to file the basic filing fee, oath or declaration and to pay the surcharge as set forth in § 1.16(e) in order to prevent abandonment of the application; or, if no basic filing fee has been paid, one year from the filing date to pay the processing and retention fee set forth in § 1.21(l) to prevent disposal of the application.

(e) An application for a patent will not be placed upon the files for examination until all its required parts, complying with the rules relating thereto, are received, except that certain minor informalities may be waived subject to subsequent correction whenever required.

(f) The filing date of an international application designating the United States of America shall be treated as the filing date in the United States of America under PCT Article 11(3), except as provided in 35 U.S.C. 102(e).

37 CFR 1.53 relates to application serial numbers, filing dates, and completion of applications. 37 CFR 1.53(a) indicates that a serial number is assigned to any filed application for identification purposes, even if the application is incomplete or informal. 37 CFR 1.53(b) provides that a filing date is assigned to an application as of the date a specification containing a description and claim and any required drawing and the names of all inventors are filed in the Patent and Trademark Office. Failure to meet any of the requirements in 37 CFR 1.53(b) will result in the application being denied a filing date. The filing date to be accorded such an application is the date on which all of the requirements of 37 CFR 1.53(b) are met. Although the filing fee and oath or declaration can be submitted later, no amendments can be made to the specification or drawings which will introduce new matter. This practice is authorized by 35 U.S.C. 111 as amended by Pub. L. 97-247. 37 CFR 1.53(c) provides for notifying applicant of any application incomplete because the specification or drawing is missing and giving the applicant a time period to correct any omission. Applicant will also be notified if all the inventors are not named, such as by the use of "et al.". If the omission is not corrected within the time period given, the application will be returned or otherwise disposed of and a handling fee set forth in 37 CFR 1.21(n) will be retained from any refund of a filing fee. 37 CFR 1.53(d) provides that, where a filing date has been assigned to a filed specification and drawing, the applicant will be notified if a correspondence address has been provided and be given a period of time in which to file the missing fee, oath, or declaration and to pay the surcharge due in order to prevent abandonment of the application. The time period usually set is 1 month from the date of notification by the Patent and Trademark Office, but in no case less than 2 months after the date of filing of the application. This time period is subject to the provisions of 37 CFR 1.136(a).

If the required basic filing fee is not timely paid, or the processing and retention fee set forth in 37 CFR 1.21(l) is not paid within 1 year of the date of mailing of the notification, the application will be disposed of. No copies will be provided or certified by the Office of an application which has been disposed of or in which neither the required basic filing fee nor the processing and retention fee has been paid. The notification under 37 CFR 1.53(d) may be made simultaneously with any notification pursuant to paragraph (c) of 37 CFR 1.63. If no correspondence address is included in the application, applicant has 2 months from the filing date to file the fee, oath or declaration and to pay the surcharge as set forth in 37 CFR 1.16(e) in order to prevent abandonment of the application or one year from the filing date to pay the processing and retention fee set forth in 37 CFR 1.21(l) to prevent disposal of the application. 37 CFR 1.53(e) indicates that a patent application will not be forwarded for examination on the merits until all required parts have been received. 37 CFR 1.53(f) indicates that international applications filed under the Patent Cooperation Treaty which designate the United States of America are considered to have a United States filing date under PCT Article 11(3), except as provided in 35 U.S.C. 102(e), on the date the requirements of PCT Article 11(1) (i) to (iii) are met.

Effective February 27, 1983, in accordance with the provisions of 35 U.S.C. 111 and 37 CFR 1.53(b), a filing date is granted to an application for patent, which includes at least a specification containing a description pursuant to 37 CFR 1.71 and at least one claim pursuant to 37 CFR 1.75, and any drawing referred to in the specification or required by 37 CFR

1.81(a), which is filed in the Patent and Trademark Office and which names the actual inventor or inventors pursuant to 37 CFR 1.41(a). If an application which has been accorded a filing date does not include the appropriate filing fee or oath or declaration, applicant will be so notified and given a period of time within which to file the missing parts to complete the application and to pay the surcharge as set forth in 37 CFR 1.16(e) in order to prevent abandonment of the application.

Applicants should submit a copy of the notice(s) to file missing parts and the notice(s) of incomplete applications with the response submitted to the Patent and Trademark Office. Applicants should also include the application serial number on all correspondence to the Office. These measures will aid the Office in matching papers to applications, thereby expediting the processing of applications.

In order for the Office to so notify the applicant, a correspondence address must also be provided in the application. The address may be different from the Post Office address of the applicant. For example, the address of applicant's registered attorney or agent may be used as the correspondence address. If applicant fails to provide the Office with a correspondence address, the Office will be unable to provide applicant with notification to complete the application and to pay the surcharge as set forth in 37 CFR 1.16(e). In such a case, applicant will be considered to have constructive notice as of the filing date that the application must be completed within 2 months from the filing date before abandonment occurs per 37 CFR 1.53(d). This time period may be extended pursuant to 37 CFR 1.136.

The oath or declaration filed in response to such a notice under 37 CFR 1.53(d) must be executed by the inventors named on filing unless a petition for correction of inventorship complying with 37 CFR 1.48 is filed within the time period set.

The oath or declaration filed in response to such a notice must identify the specification and any amendment filed with the specification which is intended to be part of the original disclosure. If an amendment is filed with the oath or declaration filed after the filing date of the application, it may be identified in the oath or declaration but may not include new matter. No new matter may be included after the filing date of the application. See MPEP § 608.04(b). If the oath or declaration improperly refers to an amendment containing new matter, a supplemental oath or declaration will be required pursuant to 37 CFR 1.67(b), deleting the reference to the amendment containing new matter. If an amendment is filed on the same day that the application filed under 37 CFR 1.53 is filed and is referred to in the original oath or declaration filed with or after the application, it constitutes a part of the original application papers and the question of new matter is not considered. Similarly, if the application papers are altered prior to execution of the oath or declaration and the filing of the application, new matter is not a consideration since the alteration is considered as part of the original disclosure.

An amendment which adds additional disclosure filed with a request for a continuation-in-part application under 37 CFR 1.62 is automatically considered a part of the original disclosure of the application by virtue of the rule. Therefore, the oath or declaration filed in such an application must identify the amendment adding additional disclosure as one of the papers which the inventor(s) has "reviewed and understands" in order to comply with 37 CFR 1.63. If the original oath or declaration submitted in a continuation-in-part application filed under 37 CFR 1.62 does not contain a reference to the amendment filed with the request for an application under 37 CFR 1.62, the examiner must require a supplemental oath or declaration referring to the amendment.

37 CFR 1.63 requires that an oath or declaration identify the specification to which it is directed. Since filing dates are now granted on applications with the oath or declaration being filed later with a surcharge, the question has arisen as to what information must be supplied in the oath or declaration to identify the specification to which it is directed and to comply with the rule.

The declaration form suggested by the Office includes spaces for filling in the names of the inventors, title of invention, application serial number, filing date, foreign priority application information and United States priority application information. While this information should be provided, it is not essential that all of these spaces be filled in in order to adequately identify the specification in compliance with 37 CFR 1.63.

The following combinations of information supplied in an oath or declaration are acceptable as minimums for identifying a specification:

(1) name of inventor and application serial number;

(2) name of inventor, attorney docket number which was on the application as filed, and filing date of the application;

(3) name of inventor, title of invention and filing date;

(4) name of inventor, title of invention and reference to a specification which is attached to the oath or declaration at the time of execution and filed with the oath or declaration; or

(5) name of inventor, title of invention and accompanied by a statement by a registered attorney or agent that the application filed in the PTO is the application which the inventor executed by signing the oath or declaration.

If the oath or declaration is filed with an attached specification as indicated in item (4) above, it must be accompanied by a statement that the "attached" specification is a copy of the specification and any amendments thereto which were

filed in the Office in order to obtain a filing date for the application. Such statement must be a verified statement if made by a person not registered to practice before the Office.

Oaths or declarations which do not meet the requirements set forth above will not be accepted as complying with 37 CFR 1.63 for completing an application. Any variance from the above guidelines will only be considered upon the filing of a petition for waiver of the rules under 37 CFR 1.183 accompanied by a petition fee (37 CFR 1.17(h)). Supplemental oaths or declarations in accordance with 37 CFR 1.67 will be required in applications in which the oaths or declarations are not completely filled in but contain sufficient information to identify the specifications to which they apply as detailed above.

The periods of time within which applicant must complete the application may be extended under the provisions of 37 CFR 1.136. Applications which are not completed in a timely manner will be abandoned.

The following forms used by Application Branch to notify applicants of defects are reproduced on the following pages. "Notice to File Missing Parts of Application - Filing Date Granted" form PTO-1533; "Notice to File Missing Parts of Application - No Filing Date", form PTO-1532; "Notice of Informal Application" form PTO-152; "Notice of Incomplete Application", form PTO-1123; and "Notice of Incomplete Application Filed Pursuant to 37 CFR 1.60," form PTO-1534; "Notice to File Missing Parts of Application Filed under 37 CFR 1.60 Filing Date Granted" form PTO-1607; "Notice to File Missing Parts of Application Filed Under 37 CFR 1.60, No Filing Date," PTO-1608; "Notice of Improper FWC Filing under 37 CFR 1.62, No Filing Date Granted," PTO-457.

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE

DATE MAILED:

NOTICE TO FILE MISSING PARTS OF APPLICATION
FILING DATE GRANTED

An Application Number and Filing Date have been assigned to this application. However, the items indicated below are missing. The required items and fees identified below must be timely submitted ALONG WITH THE PAYMENT OF A SURCHARGE for items 1 and 3-6 only of $_____for large entities or $_____ for small entities who have filed a verified statement claiming such status. The surcharge is set forth in 37 CFR 1.16(e).

If all required items on this form are filed within the period set below, the total amount owed by applicant as a ☐ large entity, ☐ small entity (verified statement filed), is $_____.

Applicant is given ONE MONTH FROM THE DATE OF THIS LETTER, OR TWO MONTHS FROM THE FILING DATE of this application, WHICHEVER IS LATER, within which to file all required items and pay any fees required above to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

1. ☐ The statutory basic filing fee is: ☐ missing ☐ insufficient. Applicant as a ☐ large entity ☐ small entity, must submit $_____to complete the basic filing fee.

2. ☐ Additional claim fees of $_____as a ☐ large entity, ☐ small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due.

3. ☐ The oath or declaration:
   ☐ is missing.
   ☐ does not cover items omitted at time of execution.

   An oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date is required.

4. ☐ The oath or declaration does not identify the application to which it applies. An oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date, is required.

5. ☐ The signature to the oath or declaration is: ☐ missing; ☐ a reproduction; ☐ by a person other than the inventor or a person qualified under 37 CFR 1.42, 1.43, or 1.47. A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date, is required.

6. ☐ The signature of the following joint inventor(s) is missing from the oath or declaration:

   _____An oath or declaration listing the names of all inventors and signed by the omitted inventor(s), identifying this application by the above Application Number and Filing Date, is required.

7. ☐ The application was filed in a language other than English. Applicant must file a verified English translation of the application and a fee of $_____under 37 CFR 1.17(k), unless this fee has already been paid.

8. ☐ A $_____processing fee is required for returned checks. (37 CFR 1.21(m)).

9. ☐ Your filing receipt was mailed in error because check was returned without payment.

10. ☐ The application does not comply with the Sequence Rules. See attached Notice to Comply with Sequence Rules 37 CFR 1.821-1.825.

11. ☐ Other.

Direct the response and any questions about this notice to_____, Application Processing Division, Special Processing and Correspondence Branch (703) 308-1202.

A copy of this notice MUST be returned with the response.

FORM PTO-1533 (REV. 5-93)

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	RECEIPT DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE

DATE MAILED:

NOTICE TO FILE MISSING PARTS OF APPLICATION
NO FILING DATE

(Enclosure to Form PTO-1123)

Required items 1-9 below SHOULD be filed, with any items required on the "Notice of Incomplete Application" enclosed with this form. The filing date of this application will be the date of receipt of the items required on the "Notice of Incomplete Application." If items 1 and 3-6 below are submitted after the filing date, THE PAYMENT OF A SURCHARGE OF $_____ large entities or $_____ for small entities who have filed a verified statement 37 CFR 1.27 claiming such status will also be required. (37 CFR 1.16(e)).

The total amount owed by applicant as a ☐ large entity ☐ small entity (verified statement filed) is $_____.

1. ☐ The statutory basic filing fee is: ☐ missing ☐ insufficient. Applicant as a ☐ large entity ☐ small entity must submit $_____ to complete the basic filing fee.

2. ☐ Additional claim fees of $_____ as a ☐ large entity, ☐ small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due.

3. ☐ The oath or declaration:
☐ is missing.
☐ does not cover items required on "Notice of Incomplete Application."
An oath or declaration in compliance with 37 CFR 1.63, referring to the above Application Number and Receipt Date, is required.

4. ☐ The oath or declaration does not identify the application to which it applies. An oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Receipt Date, is required.

5. ☐ The signature to the oath or declaration is: ☐ missing; ☐ a reproduction; ☐ by a person other than the inventor or a person qualified under 37 CFR 1.42, 1.43, or 1.47. A properly signed oath or declaration in compliance with 37 CFR 1.63, referring to the above Application Number and Receipt Date, is required.

6. ☐ The signature of the following joint inventor(s) is missing from the oath or declaration: _____. An oath or declaration signed by the omitted inventor(s), identifying this application by the above Application Number and Receipt Date, is required.

7. ☐ A $_____processing fee is required for returned checks. (37 CFR 1.21(m)).

8. ☐ The application does not comply with the Sequence Rules. See attached Notice To Comply with Sequence Rules 37 CFR 1.821-1.825.

9. ☐ Other:

Direct the response and any questions about this notice to, Attention: Application Processing Division, Special Processing and Correspondence Branch.

A copy of this notice MUST be returned with the response.

_____
Application Processing Division
(703) 308-1202

FORM PTO-1532 (REV. 12-92)

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE

DATE MAILED:

NOTICE OF INFORMAL APPLICATION
(Attachment to Office Action)

This application does not conform with the rules governing applications for the reason(s) checked below. The period within which to correct these requirements and avoid abandonment is set in the accompanying Office action.

A. A new oath or declaration, identifying this application by the application number and filing date is required. The oath or declaration does not comply with 37 CFR 1.63 in that it:

1. ☐ does not identify the city and state or foreign country of residence of each inventor.
2. ☐ does not identify the citizenship of each inventor.
3. ☐ does not state whether the inventor is a sole or joint inventor.
4. ☐ does not state that the person making the oath or declaration:
   a. ☐ has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration.
   b. ☐ believes the named inventor or inventors to be the original and the first inventor or inventors of the subject matter which is claimed and for which a patent is sought.
   c. ☐ acknowledges the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.
5. ☐ does not identify the foreign application for patent or inventor's certificate on which priority is claimed pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application serial number, country, day, month, and year of its filing.
6. ☐ does not state that the person making the oath or declaration acknowledges the duty to disclose information which is material to patentability as defined in 37 CFR 1.56 which became available between the filing date of the prior application and filing date of the continuation-in-part application which discloses and claims subject matter in addition to that disclosed in the prior application (37 CFR 1.63(d)).
7. ☐ does not include the date of execution.
8. ☐ does not use permanent ink, or its equivalent in quality, as required under 37 CFR 1.52(a).
9. ☐ contains non-initialed alterations (See 37 CFR 1.52(c)).
10. ☐ Other:

B. Applicant is required to provide:

1. ☐ A statement signed by applicant giving his or her complete name. A full name must include at least one given name without abbreviation as required by (37 CFR 1.41(a)).
2. ☐ Proof of authority of the legal representative under 37 CFR 1.44.
3. ☐ An abstract in compliance with 37 CFR 1.72(b).
4. ☐ A statement signed by applicant giving his or her complete post office address (37 CFR 1.33(a)).
5. ☐ A copy of the specification written, typed, or printed in permanent ink, or its equivalent in quality as required by 37 CFR 1.52(a).
6. ☐ Other:

FORM PTO-152 (REV. 1-93)

PART 1-OFFICE COPY

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	RECEIPT DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.

[ ]

DATE MAILED:

NOTICE OF INCOMPLETE APPLICATION

A filing date has NOT been assigned to the above identified application papers for the reason(s) shown below.

1. ☐ The specification (description and claims):
   a. ☐ is missing
   b. ☐ has pages _____ missing
   c. ☐ does not include a written description of the invention.
   d. ☐ does not include at least one claim in compliance with 35 U.S.C. 112.

A complete specification in compliance with 35 U.S.C. 112 is required.

2. ☐ A drawing of Figure(s) _____ described in the specification is required in compliance with 35 U.S.C. 111.

3. ☐ A drawing of applicant's invention is required since it is necessary for the understanding of the subject matter of the invention in compliance with 35 U.S.C. 113.

4. ☐ The inventor's name(s) is missing. The full names of all inventors are required in compliance with 37 CFR 1.41.

5. ☐ Other:

All of the above-noted items, unless otherwise indicated, must be submitted within **TWO MONTHS** of the date of this notice or the application will be returned or otherwise disposed of. Any fee which has been submitted will be refunded less a $_____ handling fee. See 37 CFR 1.53(c).

The filing date will be the date of receipt of all items required above, unless otherwise indicated. Any assertions that the items required above were submitted, or are not necessary for a filing date, must be by a petition directed to the attention of the Office of the Assistant Commissioner for Patents accompanied by the $_____ petition fee (37 CFR 1.17(h)). If the petition states that the application is complete, a request for refund of the petition fee may be included in the petition.

Direct the response and any questions about this notice to, Attention:
Application Processing Division, Special Processing and Correspondence Branch.

A copy of this notice MUST be returned with the response.

Enclosed:

- ☐ "General Information Concerning Patents." See page _____
- ☐ Copy of a patent to assist applicant in making corrections.
- ☐ "Notice to File Missing Parts of Application," Form PTO-1532.
- ☐ Other: _____

_____
Application Processing Division
(703) 308-1202

FORM PTO-1123 (REV. 12-02)

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	RECEIPT DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE

[ ]

NOTICE OF INCOMPLETE APPLICATION FILED UNDER 37 CFR 1.60

A filing date has NOT been assigned since 37 CFR 1.60 has not been complied with for the reason(s) indicated below:

1. ☐ A copy of the specification (description and claims) filed in the parent application:
   a. ☐ is missing.
   b. ☐ has page(s)_____ missing.
   c. ☐ has the description of the invention missing.
   d. ☐ has claim(s)_____ missing.

2. ☐ A copy of the drawings as filed in the parent application is missing.

3. ☐ A copy of any amendments referred to in the oath or declaration filed to complete the parent application is missing.

4. ☐ A statement is missing that the application papers filed are a true copy of the prior application, and that no amendments referred to in the oath or declaration filed in the prior application introduced new matter. Such statement must be made by the applicant or applicant's attorney or agent and must be a verified statement if made by a person not registered to practice before the United States Patent and Trademark Office.

5. ☐ Other:

The filing date will be the date of receipt of the items required above unless otherwise indicated. Any assertions that the items required above were submitted, or explaining the delay in supplying the omitted items, must be by a petition directed to the attention of the Office of the Assistant Commissioner for Patents. Any such petition must be accompanied by the $_____ petition fee (37 CFR 1.17(i)(1)). If the petition states that the application is complete, a request for refund of the petition fee may be included in the petition.

All of the items noted above must be submitted within **TWO MONTHS** of the date of this notice, or the application will be returned upon request or otherwise disposed of.

Direct the response and any questions about this notice to, Attention: Application Processing Division, Special Processing and Correspondence Branch.

A copy of this notice MUST be returned with the response.

_____
Application Processing Division
(703) 308-1202

FORM PTO-1534 (REV. 12-92)

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO./TITLE

NOTICE TO FILE MISSING PARTS OF APPLICATION FILED UNDER 37 CFR 1.60 FILING DATE GRANTED

A filing date has been granted to this application filed under 37 CFR 1.60. However, the items indicated below are missing. The required items and fees identified below must be timely submitted ALONG WITH THE PAYMENT OF A SURCHARGE for items 1 and 3 of $_____ for large entities or $_____ for small entities who have complied with 37 CFR 1.28 (a). The surcharge is set forth in 37 CFR 1.16 (e).

If all required items on this form are filed within the period set below, the total amount owed by applicant as a ☐ large entity, ☐ small entity (verified statement filed), is $_____.

> **Applicant is given ONE MONTH FROM THE DATE OF THIS LETTER, OR TWO MONTHS FROM THE FILING DATE of this application, WHICHEVER IS LATER, within which to file all required items and pay any fees required above to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136 (a).**

1. ☐ **The statutory basic filing fee is: ☐ missing ☐ insufficient. Applicant as a ☐ large entity, ☐ small entity, must submit $_____ to complete the basic filing fee.**

2. ☐ **Additional claim fees of $_____ as a ☐ large entity ☐ small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due.**

3. ☐ **The application was filed under 37 CFR 1.60. The copy of the oath or declaration ☐ is missing ☐ does not show applicant(s) signature or an indication it was signed. A copy of the signed oath or declaration originally filed in the prior complete application is required.**

4. ☐ **OTHER:**

Direct the response and any questions about this notice to, Attention: Application Processing Division, Special Processing and Correspondence Branch.

A copy of this notice MUST be returned with the response.

_____

APPLICATION PROCESSING DIVISION
(703) 308-1202

FORM PTO-1607 (12-02)

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	RECEIPT DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO./TITLE

NOTICE TO FILE MISSING PARTS OF APPLICATION FILED UNDER 37 CFR 1.60
NO FILING DATE
(Attachment to Form PTO-1534)

In order to avoid payment by the applicant of the surcharge required if items 1 and 3 are filed after the filing date, the following items are also brought to the applicant's attention.

Required items 1-4 below SHOULD be filed, if possible, with any items required on the enclosed Notice of Incomplete Application form. If concurrent filing of all required items is not possible, items 1-4 below must be filed no later than two months from the filing date of this application. The filing date will be the date of receipt of the items required on the Notice of Incomplete Application. If items 1 and 3 below are submitted after the filing date THE PAYMENT OF A SURCHARGE OF $ _____ for large entities, or $_____ for small entities who have complied with 37 CFR 1.28 (a), is required. (37 CFR 1.16 (e)).

If all required items noted on this form and on the Notice of Incomplete Application are filed together, the total amount owed by applicant as a ☐ large entity ☐ small entity (verified statement filed) is $_____.

Applicant must file all the required items indicated below within TWO MONTHS from any filing date granted to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

1. ☐ **The statutory basic filing fee is: ☐ missing ☐ insufficient. Applicant as a ☐ large entity ☐ small entity must submit $_____ to complete the basic filing fee.**
2. ☐ **Additional claim fees of $_____ as a ☐ large entity, ☐ small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due.**
3. ☐ **The application was filed under 37 CFR 1.60. The copy of the oath or declaration ☐ is missing ☐ does not show applicant(s) signature or an indication it was signed. A copy of the signed oath or declaration originally filed in the prior complete application is required.**
4. ☐ **Other:**

Direct the response and any questions about this notice to, Attention: Application Processing Division, Special Processing and Correspondence Branch.

A copy of this notice MUST be returned with the response.

APPLICATION PROCESSING DIVISION
(703) 308-1202

FORM PTO-1608 (12-92)

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	RECEIPT DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE

NOTICE OF IMPROPER FWC FILING UNDER 37 CFR 1.62
NO FILING DATE GRANTED

The above identified application was deposited under 37 CFR 1.62 as a file wrapper continuing application but is improper and has not been granted a filing date for reasons shown below:

_____ 1. The application does not include the correct application number including filing date or series code of the prior application.

_____ 2 The application, which is not a continuation-in-part, was not filed by the same or less than all the inventors named in the prior application and no petition for correction of inventorship was filed.

_____ 3. The application, which is a continuation-in-part, does not identify the names of all the inventors (37 CFR 1.41(a)). The application uses "et al" but only one inventor was named in the prior application.

_____ 4 The filing date included a new specification or a copy of a specification from the prior application. See 37 CFR 1.62(e). A petition with the $_____fee set forth in 37 CFR 1.17(i)(1) with instructions to cancel the copy or specification may be filed if a filing date as of the receipt date noted above is desired.

_____ 5. The request does not include an original signature of the inventor(s), assignee of the entire interest, or registered attorney or agent.

_____ 6. The application was not filed before the payment of the issue fee, abandonment of, or termination of proceedings on the prior application:

_____ a) The issue fee was paid on the prior application on_____.
_____ b) The prior application was abandoned, or proceedings terminated on_____.
_____ c) The prior application was abandoned by the filing of application number _____ on_____ , under 37 CFR 1.62.

_____ 7. Other:

The filing date will be the date of receipt of the items required above unless otherwise indicated, provided the items are filed before the payment of the issue fee, abandonment of, or termination of proceedings on the prior application. Any assertions that the items required above were submitted or are not necessary for a filing date must be by a petition directed to the attention of the Office of the Assistant Commissioner for Patents. Any such petition must be accompanied by the $_____ fee (37CFR 1.17(h)). If the petition states that the application is complete, a request for refund of the petition fee may be included in the petition.

All of the above noted items and/or any petition must be submitted within **TWO MONTHS** of the date of this notice (37 CFR 1.81(f)) or the application will be returned upon request or abandoned and the fee, if submitted, will be refunded less the $ _____ handling fee (37 CFR 1.21(n)). **THIS TIME LIMIT MAY NOT BE EXTENDED PURSUANT TO 37 CFR 1.136.**

Direct the response and any questions about this notice to, Attention: Application Processing Division, Special Processing and Correspondence Branch.

A copy of this notice MUST be returned with the response.

_____
Application Processing Division
(703) 308-1202
FORM PTOL-457 (REV. 12-02)

601.02 Power of Attorney or Authorization of Agent

The attorney's or agent's full post office address (including ZIP code number) must be given in every power of attorney or authority of agent. The telephone number of the attorney or agent should also be included in the power. The prompt delivery of communications will thereby be facilitated.

Usually a power of attorney or authorization of agent is incorporated in the oath or declaration form. (See MPEP § 402)

601.03 Change of Correspondence Address

Where an attorney or agent of record (or applicant, if he or she is prosecuting the application *pro se*) changes his or her correspondence address, he or she is responsible for promptly notifying the Patent and Trademark Office of the new correspondence address (including ZIP Code number). The notification should also include his or her telephone number.

A separate notification must be filed in each application for which a person is intended to receive communications from the Office. In those instances where a change in the correspondence address of a registered attorney or agent is necessary in a plurality of applications, the notification filed in each application may be a reproduction of a properly executed, original notification. The original notice must either be sent to the Office of Enrollment and Discipline as notification to the Attorney's Roster of the change of address, or must be filed in one of the applications affected, provided that the notice includes an authorization for the public to inspect and copy the original notice in the event one of the applications containing a copy matures into a patent and the application containing the original paper is either pending or has become abandoned. The copies submitted in each affected application must identify where the original paper is located.

See MPEP § 711.03(c) for treatment of petitions to revive applications abandoned as a consequence of failure to timely receive an Office action addressed to the old correspondence address.

The required notification of change of correspondence address need take no particular form. However, it should be provided in a manner calling attention to the fact that a change of address is being made. Thus, the mere inclusion, in a paper being filed for another purpose, of an address which is different from the previously provided correspondence address, without mention of the fact that an address change is being made would not ordinarily be recognized or deemed as instructions to change the correspondence address on the file record.

The obligation (see 37 CFR 10.11) of a registered attorney or agent to notify the Attorney's Roster by letter of any change of his or her address for entry on the register is separate from the obligation to file a notice of change of address filed in individual applications. See MPEP § 402.

601.04 National Stage Requirements of the United States as a Designated Office

See MPEP Chapter 1800, especially MPEP § 1898.07(a) - § 1898.08(a) for requirements for entry into the national stage before the Designated Office or Elected Office under the Patent Cooperation Treaty (PCT).

602 Original Oath or Declaration

35 U.S.C. 25. Declaration in lieu of oath.

(a) The Commissioner may by rule prescribe that any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be under oath may be subscribed to by a written declaration in such form as the Commissioner may prescribe, such declaration to be in lieu of the oath otherwise required.

(b) Whenever such written declaration is used, the document must warn the declarant that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001).

35 U.S.C. 26. Effect of defective execution.

Any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be executed in a specified manner may be provisionally accepted by the Commissioner despite a defective execution, provided a properly executed document is submitted within such time as may be prescribed.

35 U.S.C. 115. Oath of the applicant.

The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority is proved by certificate of a diplomatic or consular officer of the United States, or apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States. Such oath is valid if it complies with the laws of the state or country where made. When the application is made as provided in the title by a person other than the inventor, the oath may be so varied in form that it can be made by him.

37 CFR 1.63. Oath or declaration.

(a) An oath or declaration filed under § 1.51(a)(2) as a part of an application must:

(1) Be executed in accordance with either § 1.66 or §1.68;

(2) Identify the specification to which it is directed;

(3) Identify each inventor and the residence and country of citizenship of each inventor; and

(4) State whether the inventor is a sole or joint inventor of the invention claimed.

(b) In addition to meeting the requirements of paragraph (a), the oath or declaration must state that the person making the oath or declaration,

(1) Has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration;

(2) Believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought; and

(3) Acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56.

(c) In addition to meeting the requirements of paragraphs (a) and (b) of this section, the oath or declaration in any application in which a claim for foreign priority is made pursuant to § 1.55 must identify the foreign application for patent or inventor's certificate on which priority is claimed, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month and year of its filing.

(d) In any continuation-in-part application filed under the conditions specified in 35 U.S.C. 120 which discloses and claims subject matter in addition to that disclosed in the prior copending application, the oath or declaration must also state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56, which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

37 CFR 1.68. Declaration in lieu of oath.

Any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be under oath may be subscribed to by a written declaration. Such declaration may be used in lieu of the oath otherwise required, if, and only if, the declarant is on the same document, warned that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon. The declarant must set forth in the body of the declaration that all statements made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true.

18 U.S.C. 1001. Statements or entries generally.

Whoever, in any matter within the jurisdiction of any department or agency of the United States knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be fined not more than $10,000 or imprisoned not more than five years, or both.

STATUTORY DECLARATIONS

Patent and Trademark Office personnel are authorized to accept a statutory declaration under 28 U.S.C. 1746 filed in the Patent and Trademark Office in lieu of an "oath" or declaration under 35 U.S.C. 25 and 37 CFR 1.68, provided that the statutory declaration otherwise complies with the requirements of law.

Section 1746 of Title 28 of the United States Code provides:

Whenever, under any law of the United States or under any rule, regulation, order, or requirement made pursuant to law, any matter is required to be supported, evidenced, established, or proved by sworn declaration, verification, certificate, statement, oath or affidavit, in writing of the person making the same (other than a deposition, or an oath of office, or an oath required to be taken before a specified official other than a notary public), such matter may, with like force and effect, be supported, evidenced, established, or proved by the unsworn declaration, certificate, verification, or statement, in writing of such person which is subscribed by him, as true under penalty of perjury, and dated, in substantially the following form:

[1] If executed without the United States:

"I declare (or certify, verify, or state) under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. Executed on (date).

(Signature)."

[2] If executed within the United States its territories, possessions, or commonwealths:

"I declare (or certify, verify, or state) under penalty of perjury that the foregoing is true and correct. Executed on (date).

(Signature)."

Oaths and declarations submitted in applications filed after May 1, 1975 must make reference to applications for inventor's certificates on which priority is claimed and any filed prior to the filing date of an application on which priority is claimed.

A 37 CFR 1.68 declaration need not be ribboned to the other papers, even if signed in a country foreign to the United States. When a declaration is used, it is unnecessary to appear before any official in connection with the making of the declaration. It must, however, since it is an integral part of the application, be maintained together therewith.

By statute, 35 U.S.C. 25, the Commissioner has been empowered to prescribe instances when a written declaration may be accepted in lieu of the oath for "any document to be filed in the Patent and Trademark Office".

The filing of a written declaration is acceptable in lieu of an original application oath that is informal.

If all foreign applications have been filed within 12 months of the U.S. filing date, applicant is required only to recite the first such foreign application of which priority is claimed, and it should be clear that the foreign application referred to is the first filed foreign application. The applicant is required to recite all foreign applications filed prior to the application on which priority is claimed. It is required to give the foreign serial number and name of the country or office in which filed, as well as the filing date of the first filed foreign application.

In the oath, the jurat must be filled out, and the word "sole" or "only" must appear if there is but one inventor, and "joint" if two or more inventors.

When joint inventors execute separate oaths or declarations, each oath or declaration should make reference to the fact that the affiant is a joint inventor together with each of the other inventors indicating them by name. This may be done by stating that he or she does verily believe himself or herself to be the original, first and joint inventor together with "A or A & B, etc." as the facts may be.

A seal is usually impressed on an oath. See MPEP § 604 and § 604.01 and 37 CFR 1.66. However, oaths executed in many states including Alabama, Louisiana, Maryland, Massachusetts, New Jersey, New York, Rhode Island, South Carolina, and Virginia need not be impressed with a seal.

If a claim is presented for matter not originally claimed or embraced in the original statement of invention in the specification a supplemental oath or declaration is required, 37 CFR 1.67, MPEP § 603.

The following form paragraphs may be used to indicate errors in the oath or declaration.

¶ *6.05 Oath or Declaration Defective*

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by Serial Number and filing date is required. See MPEP 602.01 and 602.02.

The oath or declaration is defective because:

Examiner Note:

1. One or more of the appropriate paragraphs 6.05.1 to 6.05.17 must follow this paragraph.

2. If none of the paragraphs apply, then an appropriate explanation of the defect should be given immediately following this paragraph.

¶ *6.05.4 Sole or Joint Designation Omitted*

It does not state whether the inventor is a sole or joint inventor of the invention claimed.

Examiner Note:

This paragraph must be preceded by paragraph 6.05.

¶ *6.05.5 "Reviewed and Understands" Statement Omitted*

It does not state that the person making the oath or declaration has reviewed and understands the contents of the specification, including claims, as amended by any amendment specifically referred to in the oath or declaration.

Examiner Note:

This paragraph must be preceded by paragraph 6.05.

¶ *6.05.6 Original and First Omitted*

It does not state that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

Examiner Note:

This paragraph must be preceded by paragraph 6.05.

¶ *6.05.7 Duty of Disclosure Omitted*

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

Examiner Note:

This paragraph must be preceded by paragraph 6.05.

¶ *6.05.8 Identification of Foreign Applications Omitted*

It does not identify the foreign application for patent or inventor's certificate on which priority is claimed pursuant to 37 CFR 1.55, and any foreign application having a date before that of the application on which priority is claimed, by specifying the application number, country, day, month and year of filing.

Examiner Note:

This paragraph must be preceded by paragraph 6.05.

¶ *6.05.9 Duty to Disclose in C-I-P Omitted*

It does not state that the person making the oath or declaration in a continuation-in-part application filed under the conditions specified in 35 U.S.C. 120 which discloses and claims subject matter in addition to that disclosed in the prior copending application, acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

Examiner Note:

This paragraph must be preceded by paragraph 6.05.

¶ *6.05.15 Not in Permanent Ink*

The[1] is not in permanent ink, or its equivalent in quality, as required under 37 CFR 1.52(a).

Examiner Note:

1. In bracket 1, insert either signature or oath/declaration.

2. This paragraph must be preceded by paragraph 6.05.

3. If other portions of the disclosure are not in permanent ink, use paragraph 6.32.

¶ *6.05.16 Non-Initialed Alterations*

Non-initialed alterations have been made to the oath or declaration (see 37 CFR 1.52(c) and 1.57).

Examiner Note:

This paragraph must be preceded by paragraph 6.05.

¶ *6.05.17 Declaration Clause Omitted*

The clause regarding "willful false statements ...." required by 37 CFR 1.68 has been omitted.

Examiner Note:

This paragraph must be preceded by paragraph 6.05.

602.01 Oath Cannot Be Amended

The wording of an oath or declaration cannot be amended altered or changed in any manner after it has been signed. If the wording is not correct or if all of the required affirmations have not been made, or if it has not been properly subscribed to, a new oath or declaration must be required. However, in some cases, a deficiency in the oath or declaration can be corrected by a supplemental paper and a new oath or declaration is not necessary.

For example, if the oath does not set forth evidence that the notary was acting within his or her jurisdiction at the time he or she administered the oath, a certificate of the notary that the oath was taken within his or her jurisdiction will correct the deficiency. See MPEP § 602 and § 604.02.

Applicant may be so advised by using Form Paragraph 6.03.

¶ *6.03 Oath, Declaration Cannot Be Amended*

A new oath or declaration is required because [1]. The wording of an oath or declaration cannot be amended. If the wording is not correct or if all of the required affirmations have not been made or if it has not been properly subscribed to, a new oath or declaration is required. The new oath or declaration must properly identify the application of which it is to form a part, preferably by Serial Number and filing date in the body of the oath or declaration. See MPEP § 602.01 and § 602.02.

Examiner Note:

1. This paragraph is intended primarily for use in pro se applications.
2. Use Paragraph 6.05 and one or more of paragraphs 6.05.1 to 6.05.17 for a defective oath or declaration in a case where there is a power of attorney.

602.02 New Oath or Substitute for Original

In requiring a new oath or declaration, the examiner should always give the reason for the requirement and call attention to the fact that the application of which it is to form a part must be properly identified in the body of the new oath or declaration, preferably by giving the serial number and the date of filing.

Where neither the original oath or declaration, nor the substitute oath or declaration is complete in itself, but the two taken together give all the required data, no further oath or declaration is needed.

602.03 Defective Oath or Declaration

In the first Office action the examiner must point out every deficiency in a declaration or oath and require that the same be remedied. Applicant may be informed of deficiencies in the declaration or oath by Form Paragraphs 6.05 and 6.05.1 - 6.05.17.

¶ *6.05 Oath or Declaration Defective*

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by Serial Number and filing date is required. See MPEP 602.01 and 602.02.

The oath or declaration is defective because:

Examiner Note:

1. One or more of the appropriate paragraphs 6.05.1 to 6.05.17 must follow this paragraph.
2. If none of the paragraphs apply, than an appropriate explanation of the defect should be given immediately following this paragraph.

However, when an application is otherwise ready for issue, an examiner with full signatory authority may waive the following minor deficiencies:

Minor deficiencies in the body of the oath or declaration where the deficiencies are self-evidently cured in the rest of the oath or declaration, as in an oath or declaration of plural inventors couched in plural terms except for use of "sole inventors" is asserted; *In re Searles,* 164 USPQ 623.

If the above is waived, the examiner with full signatory authority should write in the margin of the declaration or oath a notation such as "Reference to the sole inventor rather than joint inventors waived; Application ready for issue." and his or her initials and the date.

Of course, requirements of the statute; e.g., that the applicant state his or her citizenship or believes himself or herself to be the original and first inventor or that the oath be administered before a person authorized to administer oaths or that a declaration pursuant to 35 U.S.C. 25 or 28 U.S.C. 1746 contain the language required therein, cannot be waived.

If the defect cannot be waived, Form Paragraph 6.46 should be used when the application is allowable.

¶ *6.46 Case Allowed, Substitute Declaration Needed*

Applicant is now required to submit a substitute declaration or oath to correct the deficiencies set forth [1]. The substitute oath or declaration must be filed within the three month shortened statutory period set for response in the "NOTICE OF ALLOWABILITY" (PTOL-37). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a). Failure to timely file the substitute declaration (or oath) will result in ABANDONMENT of the application. The transmittal letter accompanying the declaration (or oath) should indicate the following in the upper right hand corner: Issue Batch Number, Date of the Notice of Allowance, and Serial Number.

Examiner Note:

In the bracket, insert appropriate information, e.g.,
in this communication –or–
in the Office action mailed———— –or–
in the PTO-152 attached to————.

602.04 Foreign Executed Oath

An oath executed in a foreign country must be properly authenticated. See MPEP § 604 and 37 CFR 1.66.

Where the authority of the foreign officer is not certified, Form Paragraphs 6.05 and 6.05.13 may be used.

¶ *6.05.13 Authority of Foreign Officer Not Certified*

It does not include an apostille, a consular certificate, or the position of authority of the officer signing an apostille or consular certificate, see 37 CFR 1.66(a).

Examiner Note:

This paragraph must be preceded by paragraph 6.05.

602.04(a) Foreign Executed Oath Is Ribboned to Other Application Papers

37 CFR 1.66. Officers authorized to administer oaths.

*****

(b) When the oath is taken before an officer in a country foreign to the United States, any accompanying application papers, except the drawings, must be attached together with the oath and a ribbon passed one or more times through all the sheets of the application, except the drawings, and the ends of said ribbon brought together under the seal before the latter is affixed and impressed, or each sheet must be impressed with the official seal of the officer before whom the oath is taken. If the papers as filed are not properly ribboned or each sheet impressed with the seal, the case will be accepted for examination, but before it is allowed, duplicate papers, prepared in compliance with the foregoing sentence, must be filed.

Where the papers are not properly ribboned, use Form Paragraphs 6.05 and 6.05.14.

¶ *6.05 Oath or Declaration Defective*

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by Serial Number and filing date is required. See MPEP 602.01 and 602.02.

The oath or declaration is defective because:

Examiner Note:

1. One or more of the appropriate paragraphs 6.05.1 to 6.05.17 must follow this paragraph.

2. If none of the paragraphs apply, then an appropriate explanation of the defect should be given immediately following this paragraph.

¶ *6.05.14 No Ribbon Properly Attached*

It does not have a ribbon properly attached.

Examiner Note:

This paragraph must be preceded by paragraph 6.05.

U.S. Accession to Hague Convention Abolishing the Requirement of Legalization for Foreign Public Documents

On Oct. 15, 1981, the Hague "Convention Abolishing the Requirement of Legalization for Foreign Public Documents" entered into force between the United States and thirty-eight foreign countries that are parties to the Convention. The Convention applies to any document submitted to the United States Patent and Trademark Office for filing or recording, which is sworn to or acknowledged by a notary public in any one of the member countries. The Convention abolishes the certification of the authority of the notary public in a member country by a diplomatic or consular officer of the United States and substitutes certification by a special certificate, or apostille, executed by an officer of the member country. Accordingly, the Office will accept for filing or recording a document sworn to or acknowledged before a notary public in a member country if the document bears, or has appended to it, an apostille certifying the notary's authority. The requirement for a diplomatic or consular certificate, specified in 37 CFR 1.66, will not apply to a document sworn to or acknowledged before a notary public in a member country if an apostille is used.

The member countries that are parties to the Convention are:

Antigua & Barbuda	Hungary	Panama
Argentina	Israel	Portugal
Austria	Italy	Seychelles
Bahamas	Japan	Spain
Belgium	Lesotho	Suriname
Botswana	Liechtenstein	Swaziland
Brunei	Luxembourg	Switzerland
Cyprus	Malawi	The Russian Federation
Fiji	Malta	Tonga
Finland	Marshall Islands	Turkey
France	Mauritius	U.K. of Great Britain and N. Ireland
Germany, Fed. Rep. of	Netherlands	United States
Greece	Norway	Yugoslavia

The Convention prescribes the following form for the apostille:

Model of Certificate

The certificate will be in the form of a square with sides at least 9 centimeters long

APOSTILLE
(Convention de La Haye du Oct. 5, 1961)

1. Country .....
This public document
2. has been signed by .....
3. acting in the capacity of .....
4. bears the seal/stamp of .....

Certified

5. at .....
6. the .....
7. by .....
8. No. .....
9. Seal/stamp: 10. Signature:

.....

Note that a declaration in lieu of application oath (37 CFR 1.68) need not be ribboned to the other papers. It must, however, be maintained together therewith.

602.05 Oath or Declaration — Date of Execution

The time elapsed between the date of execution of the oath or declaration and the filing date of the application should be checked. A newly executed oath or declaration is required where the date of execution is more than 3 months prior to the filing date of the application (international filing date in the case of the oath or declaration being filed in a PCT national stage application). If more than 3 months have elapsed, the examiner must require a new oath or declaration by using Form Paragraph 6.04.

¶ *6.04 Time Lapse Between Execution and Filing*

An unusual length of time has elapsed between the date of execution of the oath or declaration and the filing date of the application. The lapse of more than three (3) months is considered to be unreasonable. See MPEP 602.05.

If no date of execution appears, applicant is required to file either a new oath or declaration or a certificate from the notary giving the actual date when the oath or declaration was made.

Applicant may be notified by using Form Paragraph 6.05.

¶ *6.05 Oath or Declaration Defective*

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 167(a) identifying this application by Serial Number and filing date is required. See MPEP § 602.01 and § 602.02.

The oath or declaration is defective because:

Examiner Note:

1. One or more of the appropriate paragraphs 6.05.1 to 6.05.17 must follow this paragraph.

2. If none of the paragraphs apply, then an appropriate explanation of the defect should be given immediately following this paragraph.

¶ *6.05.10 Date of Execution Omitted*

It does not include the date of execution. A new oath will not be required if a certificate from the notary giving the actual date when the oath was made is supplied.

Examiner Note:

This paragraph must be preceded by paragraph 6.05.

602.05(a) Oath or Declaration in Division and Continuation Cases

Where the date of filing the application is not the date that determines the statutory 12-month period, as in divisional and continuation cases, it is immaterial, so far as concerns the acceptability of the oath or declaration, how long a time intervenes between the execution of the oath or declaration and the filing of the application.

When a divisional application is identical with the original application as filed, signing and execution of the oath or declaration in the divisional case may be omitted. (See 37 CFR 1.60 and 1.62, MPEP § 201.06(a).)

602.06 Non-English Oath or Declaration

37 CFR 1.69. Foreign language oaths and declarations.

(a) Whenever an individual making an oath or declaration cannot understand English, the oath or declaration must be in a language that such individual can understand and shall state that such individual understands the content of any documents to which the oath or declaration relates.

(b) Unless the text of any oath or declaration in a language other than English is a form provided or approved by the Patent and Trademark Office, it must be accompanied by a verified English translation, except that in the case of an oath or declaration filed under §1.63 the translation may be filed in the Office no later than two months from the date applicant is notified to file the translation.

37 CFR 1.69 requires that oaths and declarations be in a language which is understood by the individual making the oath or declaration; i.e., a language which the individual comprehends. If the individual comprehends the English language, he or she should preferably use it. If the individual cannot comprehend the English language, any oath or declaration must be in a language which the individual can comprehend. If an individual uses a language other than English for an oath or declaration, the oath or declaration must include a statement that the individual understands the content of any documents to which the oath or declaration relates. If the documents are in a language the individual cannot comprehend, the documents may be explained to him or her so that he or she is able to understand them.

The Office will accept a single non-English language oath or declaration where there are joint inventors, of which only some understand English but all understand the non-English language of the oath or declaration.

602.07 Oath or Declaration Filed in United States as a Designated Office

See MPEP § 1898.07(a)

603 Supplemental Oath or Declaration

37 CFR 1.67. Supplemental oath or declaration.

(a) A supplemental oath or declaration meeting the requirements of § 1.63 may be required to be filed to correct any deficiencies or inaccuracies present in an earlier filed oath or declaration.

(b) A supplemental oath or declaration meeting the requirements of § 1.63 must be filed: (1) When a claim is presented for matter originally shown or described but not substantially embraced in the statement or invention or claims originally presented; and (2) When an oath or declaration submitted in accordance with § 1.53(d) after the filing of the specification and any required drawings specifically and improperly refers to an amendment which includes

new matter. No new matter may be introduced into an application after its filing date even if a supplemental oath or declaration is filed (§ 1.53(b); § 1.118). In proper cases the oath or declaration here required may be made on information and belief by an applicant other than inventor.

(c) A supplemental oath or declaration meeting the requirements of § 1.63 must also be filed if the application was altered after the oath or declaration was signed or if the oath or declaration was signed: (1) In blank; (2) Without review thereof by the person making the oath or declaration; or (3) Without review of the specification, including the claims, as required by § 1.63(b)(1).

37 CFR 1.67 requires in the supplemental oath or declaration substantially all the data called for in 37 CFR 1.63 for the original oath or declaration. As to the purpose to be served by the supplemental oath or declaration, the examiner should bear in mind that it cannot be availed of to introduce new matter into an application.

A new oath may be required by using Form Paragraph 6.06.

¶ *6.06 New Oath for Subject Matter not Originally Claimed*

This application presents a claim for subject matter not originally claimed or embraced in the statement of the invention. [1] A supplemental oath or declaration is required under 37 CFR 1.67. The new oath or declaration must properly identify the application of which it is to form a part, preferably by Serial Number and filing date in the body of the oath or declaration. See MPEP 602.01 and 602.02.

Examiner Note:

Explain new claimed matter in bracket 1. The brief summary of the invention must be commensurate with the claimed invention and may be required to be modified. See MPEP 1302; 608.01(d) and 37 CFR 1.73.

603.01 Supplemental Oath or Declaration Filed After Allowance

Since the decision in *Cutter Co.* v. *Metropolitan Electric Mfg. Co.*, 275 F. 158 (CA 2 1921), many supplemental oaths and declarations covering the claims in the case have been filed after the case is allowed. Such oaths and declarations may be filed as a matter of right and when received they will be placed in the file by the Office of Publications, but their receipt will not be acknowledged to the party filing them. They should not be filed or considered as amendments under 37 CFR 1.312, since they make no change in the wording of the papers on file. See MPEP § 714.16.

604 Administration or Execution of Oath

37 CFR 1.66. Officers authorized to administer oaths.

(a) The oath or affirmation may be made before any person within the United States authorized by law to administer oaths. An oath made in a foreign country, may be made before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by a certificate of a diplomatic or consular officer of the United States, or by an apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States. The oath shall be attested in all cases in this and other countries, by the proper official seal of the officer before whom the oath or affirmation is made. Such oath or affirmation shall be valid as to execution if it complies with the laws of the State or country where made. When the person before whom the oath or affirmation is made in this country is not provided with a seal, his official character shall be established by competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal.

*****

See MPEP § 602.04(a) for foreign executed oath.

604.01 Seal

When the person before whom the oath or affirmation is made in this country is not provided with a seal, his or her official character shall be established by competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal, except as noted in MPEP § 604.03(a), in which situations no seal is necessary. When the issue concerns the authority of the person administering the oath, the examiner should require proof of authority. Depending on the jurisdiction, the seal may be either embossed or rubber stamped. The latter should not be confused with a stamped legend indicating only the date of expiration of the notary's commission.

See also MPEP § 602.04(a) on foreign executed oath and seal. In some jurisdictions, the seal of the notary is not required but the official title of the officer must be on the oath. This applies to Alabama, California (certain notaries), Louisiana, Maryland, Massachusetts, New Jersey, New York, Ohio, Puerto Rico, Rhode Island, South Carolina, and Virginia.

¶ *6.05 Oath or Declaration Defective*

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by its Serial Number and filing date is required. See MPEP 602.01 and 602.02.

The oath or declaration is defective because:

Examiner Note:

1. One or more of the appropriate paragraphs 6.05.1 to 6.05.17 must follow this paragraph.

2. If none of the paragraphs apply, then an appropriate explanation of the defect should be given immediately following this paragraph.

¶ *6.05.11 Notary Signature*

It does not include the notary's signature, or the notary's signature is in the wrong place.

Examiner Note:

This paragraph must be preceded by paragraph 6.05.

¶ *6.05.12 Notary Seal and Venue Omitted*

It does not include the notary's seal and venue.

Examiner Note:

This paragraph must be preceded by paragraph 6.05.

604.02 Venue

That portion of an oath or affidavit indicating where the oath is taken is known as the venue. Where the county and state in the venue agree with the county and state in the seal, no problem arises. If the venue and seal do not correspond in county and state, the jurisdiction of the notary must be determined from statements by the notary appearing on the oath, or from the listing at MPEP § 604.03. Venue and notary jurisdiction must correspond or the oath is improper. The oath should show on its face that it was taken within the jurisdiction of the certifying officer or notary. This may be given either in the venue or in the body of the jurat. Otherwise, a new oath or declaration, or a certificate of the notary that the oath was taken within his or her jurisdiction, must be required, *Ex parte Delavoye*, 1906 C.D. 320; 124 O.G. 626; *Ex parte Irwin*, 1928 C.D. 13; 367 O.G. 701.

Form Paragraph 6.07 may be used where the venue is not shown.

¶ *6.07 Lack of Venue*

The oath lacks the statement of venue. Applicant is required to furnish either a new oath or declaration in proper form, identifying the application by serial number and date of filing, or a certificate by the officer before whom the original oath was taken stating that the oath was executed within the jurisdiction of the officer before whom the oath was taken when the oath was administered. The new oath or declaration must properly identify the application of which it is to form a part, preferably by Serial Number and filing date in the body of the oath or declaration. See MPEP 602.01 and 602.02.

Where the seal and venue differ the appropriate statement on the "Notice of Informal Patent Application" form PTO-152 should be checked.

604.03 Notaries and Extent of Jurisdiction

The extent of the jurisdiction of the notaries in the various states is given below.

COUNTY ONLY

Louisiana
Mississippi
Texas

VARIABLE JURISDICTION
(See explanatory paragraphs below)

Alabama (a)
Florida (b)
Hawaii (c)
Iowa (d)
Kansas (e)
Kentucky (d)
Missouri (e)
Nebraska (a)
Ohio (f)
Tennessee (g)
Virginia (h)
West Virginia (d)

STATEWIDE

All other states:

(a) Alabama and Nebraska notaries are appointed for counties and for state at large.

(b) Florida notary commissions are customarily for state at large but may be restricted by commission to less than the state at large.

(c) In Hawaii it is generally limited to the judicial circuit.

(d) In Iowa, Kentucky and West Virginia it is limited to county for which appointed, but notary in any county may qualify and act as notary in any other county.

(e) The jurisdiction of Kansas and Missouri notaries is coextensive with county of appointment and adjoining counties.

(f) In Ohio, notaries other than attorneys are appointed by the Governor for a term of 5 years and have power to act only in county for which appointed. An attorney or any person certified by a judge of the court of common pleas of the county in which he resides as qualified for the duties of official stenographic reporter of such state, may, however, be commissioned for the entire state. The extent of jurisdiction is stated near the notary's signature.

(g) Tennessee notary publics commissioned in one county may file in county court of any other county and thereupon may exercise the function of his office in such other county. In such cases, however, the notary must attach to his or her certificate a statement that he or she is qualified in the county in which he or she acts. Notaries at large are commissioned by the Secretary of the State. Notary's signature must indicate that he or she is so qualified. Special seal is prescribed by the Secretary of State.

(h) In Virginia, notaries are limited to city or county for which appointed except that notary for city may act in county or city contiguous thereto, and a notary for a county may act in city contiguous thereto. Notaries may be appointed for two or more counties and cities or for the state at large.

The notary does not have to state when his or her commission expires but if he or she does so state, the oath should be inspected to determine whether or not the notary's commission had expired at the date of execution of the oath.

604.03(a) Notarial Powers of Some Military Officers

Public Law 506 (81st Congress, Second Session) Article 136: (a) The following persons on active duty in the armed forces . . . shall have the general powers of a notary public and

of a consul of the United States, in the performance of all notarial acts to be executed by members of any of the armed forces, wherever they may be, and by other persons subject to this code [Uniform Code of Military Justice] outside the continental limits of the United States:

(1) All judge advocates of the Army and Air Force;

(2) All law specialists;

(3) All summary courts-martial;

(4) All adjutants, assistant adjutants, acting adjutants, and personnel adjutants;

(5) All commanding officers of the Navy and Coast Guard;

(6) All staff judge advocates and legal officers, and acting or assistant staff judge advocates and legal officers; and

(7) All other persons designated by regulations of the armed forces or by statute.

(8) The signature without seal of any such person acting as notary, together with the title of his office, shall be *prima facie* evidence of his authority.

604.04 Consul

On Oct. 15, 1981, the "Hague Convention Abolishing the Requirement of Legalization for Foreign Public Documents" entered into force between the United States and 28 foreign countries that are parties to the Convention. See MPEP § 604.04(a).

When the oath is made in a foreign country not a member of the Hague Convention Abolishing the Requirement of Legalization for Foreign Public Documents, the authority of any officer other than a diplomatic or consular officer of the United States authorized to administer oaths must be proved by certificate of a diplomatic or consular officer of the United States. See 37 CFR 1.66, MPEP § 604. This proof may be through an intermediary; e.g., the consul may certify as to the authority and jurisdiction of another official who, in turn, may certify as to the authority and jurisdiction of the officer before whom the oath is taken.

604.04(a) Consul – Omission of Certificate

Where the oath is taken before an officer in a foreign country other than a diplomatic or consular officer of the United States and whose authority is not authenticated or accompanied with an apostille certifying the notary's authority (see MPEP § 602.04(a)), the application is nevertheless accepted for purposes of examination. The examiner, in the first Office action, should note this informality and require authentication of the oath by an appropriate diplomatic or consular officer, the filing of proper apostille, or a declaration (37 CFR 1.68).

Form Paragraph 6.08 may be used to notify applicant.

¶ *6.08 Consul–Omission of Certificate*

The oath is objected to as being informal. It lacks authentication by a diplomatic or consular officer of the United States; 37 CFR 1.66(a). This informality can be overcome either by forwarding the original oath to the appropriate officer for authentication or by filing a declaration (37 CFR 1.68), if applicant wishes to preserve the original filing date. If authentication is desired, applicant should request return of the oath for this purpose. Such request must be accompanied by an order for a copy of the oath to be retained in the file until the properly authenticated oath is returned. After the oath has been authenticated, it should be returned promptly to the Patent and Trademark Office. The new oath or declaration must properly identify the application of which it is to form a part, preferably by Serial Number and filing date in the body of the oath or declaration. See MPEP 602.01 and 602.02.

At the time of the next Office action, the request for return of the oath, together with the application file and the copy of the oath, is submitted to the Group Director. If the request is approved by the Group Director, the oath will be returned to the applicant by the examining group. A copy of the original oath will be retained in the file.

604.06 By Attorney in Case

The language of 37 CFR 1.66 and 35 U.S.C. 115 is such that an attorney in the case is not barred from administering the oath as notary. The Office presumes that an attorney acting as notary is cognizant of the extent of his or her authority and jurisdiction and will not knowingly jeopardize his or her client's rights by performing an illegal act. If such practice is permissible under the law of the jurisdiction where the oath is administered, then the oath is a valid oath.

The law of the District of Columbia prohibits the administering of oaths by the attorney in the case. If the oath is known to be void because of being administered by the attorney in a jurisdiction where the law holds this to be invalid, the proper action is to require a new oath or declaration and refer the file to the Office of Enrollment and Discipline. (*Riegger* v. *Beierl*, 1910 C.D. 12; 150 O.G. 826). See 37 CFR 1.66 and MPEP § 604.

605 Applicant

37 CFR 1.41. Applicant for patent.

(a) A patent must be applied for in the name of the actual inventor or inventors. Full names must be stated, including the family name and at least one given name without abbreviation together with any other given name or initial.

(b) Unless the contrary is indicated the word "applicant" when used in these sections refers to the inventor or joint inventors who are applying for a patent, or to the person mentioned in §§ 1.42, 1.43, or 1.47 who is applying for a patent in place of the inventor.

(c) Any person authorized by the applicant may file an application for patent on behalf of the inventor or inventors, but an oath or declaration for the application (§ 1.63) can only be made in accordance with § 1.64.

(d) A showing may be required from the person filing the application that the filing was authorized where such authorization comes into question.

37 CFR 1.45. Joint inventors.

(a) Joint inventors must apply for a patent jointly and each must make the required oath or declaration; neither of them alone, nor less than the entire number, can apply for a patent for an invention invented by them jointly, except as provided in § 1.47.

(b) Inventors may apply for a patent jointly even though

(2) Each inventor did not make the same type or amount of contribution, or

(3) Each inventor did not make a contribution to the subject matter of every claim of the application.

(c) If multiple inventors are named in an application, each named inventor must have made a contribution, individually or jointly, to the subject matter of at least one claim of the application and the application will be considered to be a joint application under 35 U.S.C. 116.

The rules (37 CFR 1.41(a) and 1.53(b)) clearly require that the name(s) of the inventor(s) be identified in the application papers in order to accord the application a filing date. Therefore, particular care should be exercised when filing an application without an executed oath or declaration to ensure that the names of all inventors are identified somewhere in the application. A good practice is to submit an oath or declaration form (whether signed or unsigned) identifying the names of all inventors in every application being filed. If all of the inventors are not named in the application papers; e.g., Jones et al, a "Notice of Incomplete Application" will be mailed to the applicant(s) indicating that no filing date has been granted and setting a period for submitting all of the names. The filing date will be the date of receipt of the names of all the inventors unless a petition is filed which sets forth the reasons the delay in supplying the names should be excused.

For correction of inventorship, see MPEP § 201.03.

37 CFR 1.46. Assigned inventions and patents.

In case the whole or a part interest in the invention or in the patent to be issued is assigned, the application must still be made or authorized to be made, and an oath or declaration signed, by the inventor or one of the persons mentioned in §§ 1.42, 1.43, or 1.47. However, the patent may be issued to the assignee or jointly to the inventor and the assignee as provided in § 3.81.

This section concerns filing by the actual inventor. If the application is filed by another, see MPEP § 409.03.

NOTE

Assignments of application by inventor, see MPEP § 301. Inventor dead or insane, see MPEP § 409.

605.01 Applicant's Citizenship

The statute (35 U.S.C. 115) requires an applicant to state his or her citizenship. Where an applicant is not a citizen of any country, a statement to this effect is accepted as satisfying the statutory requirement, but a statement as to citizenship applied for or first papers taken out looking to future citizenship in this (or any other) country does not meet the requirement.

Form Paragraphs 6.05 and 6.05.3 may be used to notify applicant that the applicant's citizenship is omitted.

¶ *6.05 Oath or Declaration Defective*

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by Serial Number and filing date is required. See MPEP 602.01 and 602.02.

The oath or declaration is defective because:

Examiner Note:

1. One or more of the appropriate paragraphs 6.05.1 to 6.05.17 must follow this paragraph.

2. If none of the paragraphs apply, then an appropriate explanation of the defect should be given immediately following this paragraph.

¶ *6.05.3 Citizenship Omitted*

It does not identify the citizenship of each inventor.

Examiner Note:

This paragraph must be preceded by paragraph 6.05.

605.02 Applicant's Residence

Applicant's place of residence, that is, the city and either state or foreign country, is required to be included in the oath or declaration for compliance with 37 CFR 1.63. In the case of an applicant who is in one of the U.S. Armed Services, a statement to that effect is sufficient as to residence. For change of residence, see MPEP § 717.02(b).

If the residence is not included in the oath or declaration as filed, the Application Branch will normally so indicate on a form PTO-152, "Notice of Informal Patent Application," so as to require a new declaration when the form is sent out with an Office action. If the examiner notes that the residence has not been included in the oath or declaration, Form Paragraph 6.05.2 should be used to notify the applicant if no post office address has been supplied.

¶ *6.05.2 Residence Omitted*

It does not identify the city and state or foreign country of residence of each inventor. As the post office address has been omitted, it must also be supplied ¶ *6.09.*

Examiner Note:

1. This paragraph must be preceded by paragraph 6.09.

2. If the post office address has been given, DO NOT use this paragraph; use ¶ 6.09.

If the post office address has been provided somewhere in the application papers, but no residence is included, Form Paragraph 6.09 should be used.

¶ *6.09 Residence Omitted*

Applicant's residence has been omitted from the papers. The city and state of applicant's post office address will be presumed to be the city and state

of the residence. If the above is incorrect, applicant should submit a statement as to place of residence no later than at the time of payment of the issue fee.

Examiner Note:

1. If both the post office address and residence are incomplete, not uniform or omitted, use paragraph 6.05.2.

2. Paragraph 6.09.1 should be used to notify applicant if only the post office address is incomplete or omitted.

605.03 Applicant's Post Office Address

Each applicant's post office address must be supplied on the oath or declaration, 37 CFR 1.33(a), if not stated elsewhere in the application. Applicant's post office address means that address at which he or she customarily receives his or her mail. Either applicant's home or business address is acceptable as the post office address. The post office address should include the ZIP Code designation.

When a township is listed in the applicant's address, a county name must also be given.

The object of requiring each applicant's post office address is to enable the Office to communicate directly with the applicant if desired; hence, the address of the attorney with instruction to send communications to applicant in care of the attorney is not sufficient.

In situations where an inventor does not execute the oath or declaration and the inventor is not deceased, such as in an application filed under 37 CFR 1.47, the inventor's most recent home address must be given to enable the Office to communicate directly with the inventor as necessary.

Where having given complete data as to residence, the applicant identifies his or her post office address only by street and number, it is assumed that the city and either state or foreign country of residence are the city and state of his or her post office address and no requirement for submission of the post office address will be made.

The "Notice of Informal Patent Application" attachment form PTO-152 or Form Paragraph 6.09.1 is used to notify applicant that the post office address is incomplete or omitted. Note 37 CFR 1.33(a).

¶ *6.09.1 Post Office Address Omitted*

Applicant has not given a post office address anywhere in the application papers as required by 37 CFR 1.33(a). A statement over applicant's signature providing a complete post office address is required.

605.04(a) Applicant's Signature and Name

37 CFR 1.64. Person making oath or declaration.

(a) The oath or declaration must be made by all of the actual inventors except as provided for in §§ 1.42, 1.43, or 1.47.

(b) If the person making the oath or declaration is not the inventor (§§ 1.42, 1.43, or 1.47), the oath or declaration shall state the relationship of the person to the inventor and, upon information and belief, the facts which the inventor is required to state.

EXECUTION OF OATHS OR DECLARATIONS OF PATENT APPLICATIONS

United States patent applications which have not been prepared and executed in accordance with the requirements of Title 35 of the United States Code and Title 37 of the Code of Federal Regulations may be abandoned. Although the statute and the rules have been in existence for many years, the Office continues to receive a number of applications which have been improperly executed and/or filed. Since the improper execution and/or filing of patent applications can ultimately result in a loss of rights, it is appropriate to emphasize the importance of proper execution and filing.

It is improper for an applicant to sign an oath or declaration which is not attached to or does not identify a specification and/or claims.

Attached does not necessarily mean that all the papers must be literally fastened. It is sufficient that the specification, including the claims, and the oath or declaration are physically located together at the time of execution. Physical connection is not required.

The provisions of 35 U.S.C. 363 for filing an international application under the Patent Cooperation Treaty (PCT) which designates the United States and thereby has the effect of a regularly filed United States national application, except as provided in 35 U.S.C. 102(e), are somewhat different than the provisions of 35 U.S.C. 111. The oath or declaration requirements for an international application before the Patent and Trademark Office are set forth in 35 U.S.C. 371(c)(4) and 37 CFR 1.497.

37 CFR 1.52(c) states that "(a)ny interlineation, erasure, cancellation or other alteration of the application papers filed should be made before the signing of any accompanying oath or declaration pursuant to § 1.63 referring to those application papers and should be dated and initialed or signed by the applicant on the same sheet of paper. Application papers containing alterations made after the signing of an oath or declaration referring to those application papers must be supported by a supplemental oath or declaration under § 1.67(c)."

In summary, it is emphasized that the application filed must be the application executed by the applicant and it is improper for anyone, including counsel, to alter, rewrite, or partly fill in any part of the application, including the oath or declaration, after execution of the oath or declaration by the applicant. This provision should particularly be brought to the attention of foreign applicants by their United States counsel since the United States law and practice in this area may differ from that in other countries.

605.04(b)

Any changes made in ink in the application or oath prior to signing should be initialed and dated by the applicants prior to execution of the oath or declaration. The Office will not consider whether non-initialed and/or nondated alterations were made before or after signing of the oath or declaration but will require a new oath or declaration. Form Paragraph 6.02.1 may be used to call non-initialed and/or non-dated alterations to applicant's attention.

¶ *6.02.1 Non-Initialed and/or Non-Dated Alterations in Application Papers*

The application is objected to because of alterations which have not been initialed and/or dated as required by 37 CFR 1.52(c). A properly executed oath or declaration which complies with 37 CFR 1.67(a) and identifies the application by serial number and filing date is required.

The signing and execution by the applicant of oaths or declarations in certain applications may be omitted, MPEP § 201.06 and § 201.07.

NOTE: For the signature on a response, see MPEP § 714.01 (a) to (e).

605.04(b) One Full Given Name Required

All applications which disclose the full first and last names with middle initial or name, if any, of the applicant at any place in the application papers will be received and considered as a sufficient compliance with 37 CFR 1.41.

When a *full given name* of the applicant does not appear either in the signature or elsewhere in the papers the examiner will, in the first Office action, require an amendment over applicant's signature supplying the omission, and will not pass the application to issue until the omission has been supplied unless a statement has been filed over the applicant's own signature setting forth that his or her name as signed contains at least one given name without abbreviation or what is in fact his or her full given name.

No affidavit should be required.

The requirement should be made only when all of the given names in the signature, or elsewhere in the papers, appear as mere initials or as what can be only an abbreviation of a name.

Form Paragraph 6.10 may be used.

¶ *6.10 Full Given Name Does Not Appear*

It appears that at least one full given name of applicant [1] is not present either in the signature or elsewhere in the papers. This application will not be passed to issue until the omitted name has been supplied or unless a statement has been supplied over the applicant's signature setting forth that the name as signed is the actual full name of applicant [2]. See MPEP 605.04.

One given name without abbreviation, together with any other given name or initial, must appear somewhere in the papers as filed. Otherwise, appropriate amendment is required. For example, if the applicant's full name is "John Paul Doe," either "John P. Doe" or "J. Paul Doe" is acceptable.

In an application where the name is typewritten with a *middle name* or *initial*, but the signature is without such middle name or initial, the typewritten version of the name will be used. A request to have the name changed to the signed version or any other corrections in the name of the inventor(s) will not be entertained, unless accompanied by a petition under 37 CFR 1.182 together with an appropriate petition fee. The petition should be directed to the attention of the Office of the Assistant Commissioner for Patents. Upon granting of the petition, the file should be sent to the Application Branch for correction of its records. If the application is assigned, it will be forwarded by the Application Branch to the Assignment Branch for a change in the Assignment record.

605.04(c) Inventor Changes Name

In cases where an inventor's name has been changed after the application has been filed and the inventor desires to change his or her name on the application, he or she must submit a petition under 37 CFR 1.182. The petition should be directed to the attention of the Office of the Assistant Commissioner for Patents. The petition must include an appropriate petition fee and an affidavit signed with both names and setting forth the procedure whereby the change of name was effected, or a certified copy of the court order.

If the petition is granted, the file should be sent to the Application Processing Division for change of name on the file wrapper and in the PALM data base. If the application is assigned, it will be forwarded by the Application Branch to the Assignment Branch for a change in the assignment record.

605.04(d) Applicant Unable to Write

If the applicant is unable to write, his or her mark as affixed to the oath or declaration must be attested to by a witness. In the case of the oath, the notary's signature to the jurat is sufficient to authenticate the mark.

605.04(e) May Use Title With Signature

It is permissible for an applicant to use a title of nobility or other title, such as "Dr", in connection with his signature. The title will not appear in the printed patent.

605.04(f) Signature on Joint Applications – Order of Names

The order of names of joint patentees in the heading of the patent is taken from the order in which the typewritten names appear in the original oath or declaration. Care should therefore be exercised in selecting the preferred order of the typewritten names of the joint inventors, before filing, as re-

quests for subsequent shifting of the names would entail changing numerous records in the Office. Since the particu-

quests for subsequent shifting of the names would entail changing numerous records in the Office. Since the particular order in which the names appear is of no consequence insofar as the legal rights of the joint applicants are concerned, no changes will be made except when a petition under 37 CFR 1.182 is granted. The petition should be directed to the attention of the Office of the Assistant Commissioner for Patents. The petition to change the order of names must be signed by either the attorney or agent of record or all the applicants. It is suggested that all typewritten and signed names appearing in the application papers should be in the same order as the typewritten names in the oath or declaration.

In those instances where the joint applicants file separate oaths or declarations, the order of names is taken from the order in which the several oaths or declarations appear in the application papers unless a different order is requested at the time of filing.

605.04(g) Correction of Inventorship

When a petition is granted approving a correction or a change in the order of the names of the inventors, or inventors are added or deleted under 37 CFR 1.48, the change should be noted in red ink in the left margin of the original oath or declaration. The notation should read "See Paper No. ____ for inventorship changes." The file should be sent to the Application Processing Division for correction on the file wrapper label and the PALM data base regarding the inventorship. A brief explanation on an "Application Branch Data Base Routing Slip" (available from the examining group clerical staff) should accompany the application file to the Application Branch.

605.05 Administrator, Executor, or Other Legal Representative

In an application filed by a legal representative of the inventor, the specification should not be written in the first person.

For prosecution by administrator or executor, see MPEP § 409.01(a).

For prosecution by heirs, see MPEP § 409.01(a) and § 409.01(d).

For prosecution by representative of legally incapacitated inventor, see MPEP § 409.02.

For prosecution by other than inventor, see MPEP § 409.03.

605.07 Joint Inventors

35 U.S.C. 116. Inventors

When an invention is made by two or more persons jointly, they shall apply for patent jointly and each make the required oath, except as otherwise provided in this title. Inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent. (Added November 8, 1984, Public Law 98)622, sec. 104(a), 98 Stat. 3384.)

35 U.S.C. 116, as amended by Public Law 98–622, recognizes the realities of modern team research. A research project may include many inventions. Some inventions may have contributions made by individuals who are not involved in other, related inventions.

35 U.S.C. 116 allows inventors to apply for a patent jointly even though

(i) they did not physically work together or at the same time,

(ii) each did not make the same type or amount of contribution, or

(iii) each did not make a contribution to the subject matter of every claim of the patent. Items (i) and (ii) adopt the rationale stated in decisions such as *Monsanto Co. v. Kamp*, 269 F. Supp. 818, 154 USPQ 259 (D.D.C. 1967).

Item (iii) adopts the rationale of cases such as *SAB Industrie AB v. Bendix Corp.*, 199 USPQ 95 (E.D. Va. 1978).

Like other patent applications, jointly filed applications are subject to the requirements of 35 U.S.C. 121 that an application be directed to only a single invention. If more than one invention is included in the application, the examiner may require the application to be restricted to one of the inventions. In such a case, a "divisional" application complying with 35 U.S.C. 120 would be entitled to the benefit of the earlier filing date of the original application.

It is possible that different claims of an application or patent may have different dates of inventions even though the patent covers only one independent and distinct invention within the meaning of 35 U.S.C. 121. When necessary, the Patent and Trademark Office or a court may inquire of the patent applicant or owner concerning the inventors and the invention dates for the subject matter of the various claims.

Guidelines

37 CFR 1.45. Joint inventors.

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(b) Inventors may apply for a patent jointly even though

(1) They did not physically work together or at the same time,

(2) Each inventor did not make the same type or amount of contribution, or

(3) Each inventor did not make a contribution to the subject matter of every claim of the application.

(c) If multiple inventors are named in an application, each named inventor must have made a contribution, individually or jointly, to the subject matter of at least one claim of the application and the application will be considered to be a joint application under 35 U.S.C. 116.

The significant features resulting from the amendments to 35 U.S.C. 116 by Public Law 98–622 are the following:

(1) The joint inventors do not have to separately "sign the application," but only need apply for the patent jointly and make the required oath by signing the same; this is a clarification, but not a change in current practice.

(2) Inventors may apply for a patent jointly even though "they did not work together or at the same time," thereby clarifying (a) that it is not necessary that the inventors physically work together on a project, and (b) that one inventor may "take a step at one time, the other an approach at different times." *(Monsanto Co.* v. *Kamp,* 269 F. Supp. 818, 154 USPQ 259 (D.D.C. 1967)).

(3) Inventors may apply for a patent jointly even though "each did not make the same type or amount of contribution," thereby clarifying the "fact that each of the inventors play a different role and that the contribution of one may not be as great as that of another does not detract from the fact that the invention is joint, if each makes some original contribution, though partial, to the final solution of the problem." *Monsanto Co. v. Kamp supra.*

(4) Inventors may apply for a patent jointly even though "each did not make a contribution to the subject matter of every claim of the patent."

(5) Inventors may apply for a patent jointly as long as each inventor made a contribution; i.e., was an inventor or joint inventor, of the subject matter of at least one claim of the patent; there is no requirement that all the inventors be joint inventors of the subject matter of any one claim.

(6) If an application by joint inventors includes more than one independent and distinct invention, restriction may be required with the possible result of a necessity to change the inventorship named in the application if the elected invention was not the invention of all the originally named inventors.

(7) The amendment to 35 U.S.C. 116 increases the likelihood that different claims of an application or patent may have different dates of invention; when necessary the Office or court may inquire of the patent applicant or owner concerning the inventors and the invention dates for the subject matter of the various claims.

See MPEP § 2186 under "Applications considered under 35 U.S.C. 103, second paragraph" for applications to be considered under 35 U.S.C. 116.

Pending applications will be permitted to be amended by complying with 37 CFR 1.48 to add claims to inventions by inventors not named when the application was filed as long as such inventions were disclosed in the application as filed since 37 CFR 1.48 permits correction of inventorship where the "correct inventor or inventors are not named in an application for patent through error without any deceptive intention on the part of the actual inventor or inventors." This is specially covered in 37 CFR 1.48(c).

Under 35 U.S.C. 116, an examiner may reject claims under 35 U.S.C. 102(f) only in circumstances where a named inventor is not the inventor of at least one claim in the application; no rejection under 35 U.S.C. 102(f) is appropriate if a named inventor made a contribution to the invention defined in any claim of the application.

Under 35 U.S.C. 116, considered in conjunction with 35 U.S.C. 103, second paragraph, a rejection may be appropriate under 35 U.S.C. 102(f)/103 where the subject matter; i.e., prior art, and the claimed invention was not owned by, or subject to an obligation of assignment to, the same person at the time the invention was made.

Applicants are responsible for correcting, and are required to correct, the inventorship in compliance with 37 CFR 1.48 when the application is amended to change the claims so that one (or more) of the named inventors is no longer an inventor of the subject matter of a claim remaining in the application.

In requiring restriction in an application filed by joint inventors, the examiner should remind applicants of the necessity to correct the inventorship pursuant to 37 CFR 1.48 if an invention is elected and the claims to the invention of one or more inventors are cancelled.

The examiner should not inquire of the patent applicant concerning the inventors and the invention dates for the subject matter of the various claims until *it becomes necessary* to do so in order to properly examine the application.

If an application is filed with joint inventors, the examiner should assume that the subject matter of the various claims was commonly owned at the time the inventions covered therein were made, unless there is evidence to the contrary. If inventors of subject matter, not commonly owned at the time of the later invention, file a joint application, applicants have an obligation pursuant to 37 CFR 1.56 to point out the inventor and invention dates of each claim and the lack of common ownership at the time the later invention was made in order that the examiner may consider the applicability of 35 U.S.C. 102(f)/103 or 35 U.S.C. 102(g)/103. The examiner should assume, unless there is evidence to the contrary, that applicants are complying with their duty of disclosure. It should be pointed out that 35 U.S.C. 119 benefit may be claimed to any foreign application as long as the U.S. named inventor was the inventor of the foreign application invention and 35 U.S.C. 119 requirements are met. Where two or more foreign applications are combined to take advantage of the

changes to 35 U.S.C. 103 or 35 U.S.C. 116, benefit as to each foreign application may be claimed if each complies with 35 U.S.C. 119 and the U.S. application inventors are the inventors of the subject matter of the foreign applications. For example:

> If Foreign Applicant A invents X and files a foreign application; Applicant B invents Y and files a separate foreign application. A + B combine inventions X + Y and file U.S. application to X + Y and claim 35 U.S.C. 119 benefit for both Foreign Applications:
>
> then 35 U.S.C. 119 Benefit will be Accorded for each Foreign Application if 35 U.S.C. 119 requirements are met.

606 Title of Invention

37 CFR 1.72. Title and abstract.

(a) The title of the invention, which should be as short and specific as possible, should appear as a heading on the first page of the specification, if it does not otherwise appear at the beginning of the application.

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606.01 Examiner May Require Change in Title

Where the title is not descriptive of the invention claimed, the examiner should require the substitution of a new title that is clearly indicative of the invention to which the claims are directed. Form Paragraph 6.11 may be used.

¶ *6.11 Title of Invention Is Not Descriptive*

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Examiner Note:

If a title is suggested by the Examiner, add after "directed": The following title is suggested:

This may result in slightly longer titles, but the loss in brevity of title will be more than offset by the gain in its informative value in indexing, classifying, searching, etc. If a satisfactory title is not supplied by the applicant, the examiner may change the title by examiner's amendment or by initialing, at the time of allowance.

If a change in title is the only change being made by the examiner at the time of allowance, a separate examiner's amendment need not be prepared. The change in title will be incorporated in the notice of allowance. This will be accomplished by placing an "X" in the designated box on the notice of allowance form and entering thereunder the title as changed by the examiner who should initial the face of the file wrapper.

However, if an examiner's amendment must be prepared for other reasons, any change in title will be incorporated therein.

Inasmuch as the words "improved," "improvement of," and "improvement in" are not considered as part of the title of an invention, the Patent and Trademark Office does not include these words at the beginning of the title of the invention.

607 Filing Fee

Patent application filing fees are set in accordance with 35 U.S.C.41 and are listed in 37 CFR 1.16.

See MPEP § 608.01(n) for multiple dependent claims.

When filing an application, a basic fee entitles applicant to present 20 claims including not more than 3 claims in independent form. If claims in excess of the above are included at the time of filing, an additional fee is required for each independent claim in excess of three, and a fee is required for each claim in excess of 20 claims (whether independent or dependent). Fees for a proper multiple dependent claim are calculated based on the number of claims to which the multiple dependent claim refers, 37 CFR 1.75(c), and a separate fee is required in each application containing a proper multiple dependent claim. For an improper multiple dependent claim, the fee charged is that charged for a single dependent claim.

Upon submission of an amendment (whether entered or not) affecting the claims, payment of fees for those claims in excess of the number previously paid for is required.

The Application Branch has been authorized to accept all applications, otherwise acceptable, if the basic fee is submitted, and to require payment of the deficiency within a stated period upon notification of the deficiency.

Amendments before the first action, or not filed in response to an Office action, presenting additional claims in excess of the number already paid for, not accompanied by the full additional fee due, will not be entered in whole or in part and applicant will be so advised. Such amendments filed in reply to an Office action will be regarded as not responsive thereto and the practice set forth in MPEP § 714.03 will be followed.

The additional fees, if any, due with an amendment are calculated on the basis of the claims (total and independent) which would be present, if the amendment were entered. The amendment of a claim, unless it changes a dependent claim to an independent claim or adds to the number of claims referred to in a multiple dependent claim, and the replacement of a claim by a claim of the same type, unless it is a multiple dependent claim which refers to more prior claims, do not require any additional fees.

For purposes of determining the fee due the Patent and Trademark Office, a claim will be treated as dependent if it contains reference to one or more other claims in the application. A claim determined to be dependent by this test will be entered if the fee paid reflects this determination.

Any claim which is in dependent form but which is so worded that it, in fact, is not a proper dependent claim, as for example it does not include every limitation of the claim on which it depends, will be required to be cancelled as not being a proper dependent claim; and cancelation of any further claim depending on such a dependent claim will be similarly required. The applicant may thereupon amend the claims to place them in proper dependent form, or may redraft them as independent claims, upon payment of any necessary additional fee.

After a requirement for restriction, nonelected claims will be included in determining the fees due in connection with a subsequent amendment unless such claims are cancelled.

An amendment canceling claims accompanying the papers constituting the application will be effective to diminish the number of claims to be considered in calculating the filing fees to be paid.

The additional fees, if any, due with an amendment are required prior to any consideration of the amendment by the examiner.

Money paid in connection with the filing of a proposed amendment will not be refunded by reason of the nonentry of the amendment. However, unentered claims will not be counted when calculating the fee due in subsequent amendments.

Amendments affecting the claims cannot serve as the basis for granting any refund.

See MPEP § 1415 for reissue application fees.

607.02 Returnability of Fees

All questions pertaining to the return of fees are referred to the Refund Section of the Accounting Division of the Office of Finance. No opinions should be expressed to attorneys or applicants as to whether or not fees are returnable in particular cases. Such questions may also be treated, to the extent appropriate, in decisions on petition decided by various Patent and Trademark Office officials.

608 Disclosure

In return for a patent, the inventor gives as consideration a complete revelation or disclosure of the invention for which protection is sought. All amendments or claims must find basis in the original disclosure, or they involve new matter. Applicant may rely for disclosure upon the specification with original claims and drawings, as filed. See 37 CFR 1.118 and MPEP § 608.04.

If during the course of examination of a patent application, an examiner notes the use of language that could be deemed offensive to any race, religion, sex, ethnic group, or nationality, he or she should object to the use of the language as failing to comply with the Rules of Practice. 37 CFR 1.3 proscribes the presentation of papers which are lacking in decorum and courtesy. There is a further basis for objection in that the inclusion of such proscribed language in a Federal Government publication would not be in the public interest. Also, the inclusion in application drawings of any depictions or caricatures that might reasonably be considered offensive to any group should be similarly objected to, on like authority.

The examiner should not pass the application to issue until such language or drawings have been deleted, or questions relating to the propriety thereof fully resolved.

For design application practice, see MPEP § 1504.

608.01 Specification

35 U.S.C. 22. Printing of papers filed.

The Commissioner may require papers filed in the Patent and Trademark Office to be printed or typewritten.

37 CFR 1.71. Detailed description and specification of the invention.

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

(d) A copyright or mask work notice may be placed in a design or utility patent application adjacent to copyright and mask work material contained therein. The notice may appear at any appropriate portion of the patent application disclosure. For notices in drawings, see § 1.84(o). The content of the notice must be limited to only those elements required by law. For example, "© 1983 John Doe" (17 U.S.C. 401) and "M John Doe" (17 U.S.C. 909) would be properly limited and, under current statutes, legally sufficient notices of copyright and mask work, respectively. Inclusion of a copyright or mask work notice will be permitted only if the authorization language set forth in paragraph (e) of this section is included at the beginning (preferably as the first paragraph) of the specification.

(e) The authorization shall read as follows:

A portion of the disclosure of this patent document contains material which is subject to {copyright or mask work} protection. The {copyright or mask work} owner has no objection to the facsimile reproduction by anyone of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent file or records, but otherwise reserves all {copyright or mask work} rights whatsoever.

Certain cross notes to other related applications may be made. References to foreign applications or to applications identified only by the attorney's docket number should be required to be cancelled. See 37 CFR 1.78 and MPEP § 202.01.

37 CFR 1.52. Language, paper, writing, margins.

(a) The application, any amendments or corrections thereto, and the oath or declaration must be in the English language except as provided for in § 1.69 and paragraph (d) of this section, or be accompanied by a verified translation of the application and a translation of any corrections or amendments into the English language. All papers which are to become a part of the permanent records of the Patent and Trademark Office must be legibly written, typed, or printed in permanent ink or its equivalent in quality. All of the application papers must be presented in a form having sufficient clarity and contrast between the paper and the writing, typing, or printing thereon to permit the direct production of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes. If the papers are not of the required quality, substitute typewritten or printed papers of suitable quality may be required.

(b) The application papers (specification, including claims, abstract, oath or declaration, and papers as provided for in §§ 1.42, 1.43, 1.47, etc.) and also papers subsequently filed, must be plainly written on but one side of the paper. The size of all sheets of paper should be 8 to 8 1/2 by 10 1/2 to 13 inches (20.3 to 21.6 cm. by 26.6 to 33.0 cm.) A margin of at least approximately 1 inch (2.5 cm.) must be reserved on the left-hand of each page. The top of each page of the application, including claims must have a margin of at least approximately 3/4 inch (2 cm.). The lines must not be crowded too closely together; typewritten lines should be 1 1/2 or double spaced. The pages of the application including claims and abstract should be numbered consecutively, starting with 1, the numbers being centrally located above or preferably, below, the text.

(c) Any interlineation, erasure, cancellation or other alteration of the application papers filed should be made before the signing of any accompanying oath or declaration pursuant to § 1.63 referring to those application papers and should be dated and initialed or signed by the applicant on the same sheet of paper. Application papers containing alterations made after the signing of an oath or declaration referring to those application papers must be supported by a supplemental oath or declaration under § 1.67(c). After the signing of the oath or declaration referring to the application papers, amendments may only be made in the manner provided by §§1.121 and 1.123 through 1.125.

(d) An application may be filed in a language other than English. A verified English translation of the non-English language application and the fee set forth in § 1.17(k) are required to be filed with the application or within such time as may be set by the Office.

37 CFR 1.58. Chemical and mathematical formulas and tables.

(a) The specification, including the claims, may contain chemical and mathematical formulas, but shall not contain drawings or flow diagrams. The description portion of the specification may contain tables; claims may contain tables only if necessary to conform to 35 U.S.C. 112 or if otherwise found to be desirable.

(b) All tables and chemical and mathematical formulas in the specification, including claims, and amendments thereto, must be on paper which is flexible, strong, white, smooth, nonshiny, and durable, in order to permit use as camera copy when printing any patent which may issue. A good grade of bond paper is acceptable; watermarks should not be prominent. India ink or its equivalent, or solid black typewriter should be used to secure perfectly black solid lines.

(c) To facilitate camera copying when printing, the width of formulas and tables as presented should be limited normally to 5 inches (12.7 cm.) so that it may appear as a single column in the printed patent. If it is not possible to limit the width of a formula or table to 5 inches (12.7 cm.), it is permissible to present the formula or table with a maximum width of 10 3/4 inches (27.3 cm.) and to place it sideways on the sheet. Typewritten characters used in such formulas and tables must be from a block (nonscript) type font or lettering style having capital letters which are at least 0.08 inch (2.1 mm.) high (elite type). Hand lettering must be neat, clean, and have a minimum character height of 0.08 inch (2.1 mm.). A space at least 1/4 inch (6.4 mm.) high should be provided between complex formulas and tables and the text. Tables should have the lines and columns of data closely spaced to conserve space, consistent with high degree of legibility.

In order that specifications may be expeditiously handled by the Office, page numbers should be placed at the center of the top or bottom of each page. It is a common practice and a commendable one, to consecutively number all the lines or every fifth line of each page. A top margin of at least 3/4 inch should be reserved on each page to prevent possible mutilation of text when the papers are punched for insertion in a file wrapper.

Applicants should make every effort to file patent applications in a form that is clear and reproducible. The Office may accept for filing date purposes papers of reduced quality but will require that acceptable copies be supplied for further processing. Typed, mimeographed, xeroprinted, multigraphed or non-smearing carbon copy forms of reproduction are acceptable.

Legibility includes ability to be photocopied and photomicrographed so that suitable reprints can be made. This requires a high contrast, with black lines and a white background. Gray lines and/or a gray background sharply reduce photo reproduction quality. Legibility of some application papers may become impaired due to abrasion or aging of the printed material during examination and ordinary handling of the file. It may be necessary to require that legible and permanent copies be furnished at later stages after filing, particularly when preparing for issue.

Some of the patent application papers received by the Patent and Trademark Office are copies of the original, ribbon copy. These are acceptable if, in the opinion of the Office, they are legible and permanent.

The paper used must have a surface such that amendments may be written thereon in ink. So-called "Easily Erasable" paper having a special coating so that erasures can be made more easily may not provide a "permanent" copy 37 CFR 1.52(a). If a light pressure of an ordinary (pencil) eraser removes the imprint, the examiner should, as soon as this becomes evident, notify applicant by use of Form Paragraph 6.32 that it will be necessary for applicant to order a copy of the specification and claims to be made by the Patent and Trademark Office at the applicant's expense for incorpo-

ration in the file. It is not necessary to return this copy to applicant for signature.

¶ *6.32 Application on Easily Erasable Paper*

The application papers are objected to because they are not a permanent copy as required by 37 CFR 1.52(a). Reference is made to [1].

Applicant is required either (1) to submit permanent copies of the identified parts or (2) to order a photocopy of the above identified parts to be made by the Patent and Trademark Office at applicant's expense for incorporation in the file. See MPEP 608.01.

Examiner Note:

In the "bracket" identify, 1) all of the specification; 2) pages of the specification; 3) claims; 4) oath, declaration; 5) etc.

See *In re Benson*, 1959 C.D. 5; 744 O.G. 353. Reproductions prepared by heat-sensitive, hectographic, or spirit duplication processes are also not satisfactory.

The specification is sometimes in such faulty English that a new specification is necessary, but new specifications encumber the record and require additional reading, and hence should not be required or accepted unless it is clear to the examiner that acceptance of a substitute specification would facilitate processing of the application. See 37 CFR 1.125.

Form Paragraph 7.29 may be used where the disclosure contains informalities.

¶ *7.29 Disclosure Objected to, Minor Informalities*

The disclosure is objected to because of the following informalities: [1] Appropriate correction is required.

Examiner Note:

Use this paragraph to point out minor informalities such as spelling errors, inconsistent terminology, numbering of elements, etc., which should be corrected. See paragraphs 6.28 to 6.32 for specific informalities.

The specification does not require a date.

If a newly filed application obviously fails to disclose an invention with the clarity required by 35 U.S.C. 112, revision of the application should be required. See MPEP § 702.01.

As the specification is never returned to applicant under any circumstances, the applicant should retain a line for line copy thereof, each line, preferably, having been consecutively numbered on each page. In amending, the attorney or the applicant requests insertions, cancellations, or alterations, giving the page and the line.

37 CFR 1.52(c) relating to interlineations and other alterations is strictly enforced. See *In re Swanberg*, 129 USPQ 364.

Form Paragraphs 6.29-6.31 should be used where appropriate.

¶ *6.29 Specification, Spacing of Lines*

The spacing of the lines of the specification is such as to make reading and entry of amendments difficult. New application papers with lines double spaced on good quality paper are required.

¶ *6.30 Numerous Grammatical Errors*

The specification is replete with grammatical and idiomatic errors too numerous to mention specifically. The specification should be revised carefully. Examples of such errors are: [1].

¶ *6.31 Lengthy Specification, Jumbo Case*

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Examiner Note:

This paragraph is applicable in so-called "Jumbo cases."

USE OF METRIC SYSTEM OF MEASUREMENTS IN PATENT APPLICATIONS

In order to minimize the necessity in the future for converting dimensions given in the English system of measurements to the metric system of measurements when using printed patents as research and prior art search documents, all patent applicants are strongly encouraged to use either (1) only metric (S.I.) units, or (2) English units together with their metric system equivalents when describing their inventions in the specifications of patent applications. This practice, however, is not being made mandatory at this time.

The initials S.I. stand for "Systeme International d' Unites," the French name for the International System of Units, a modernized metric system adopted in 1960 by the International General Conference of Weights and Measures based on precise unit measurements made possible by modern technology.

FILING OF NON-ENGLISH LANGUAGE APPLICATIONS

37 CFR 1.52. Language, Paper, Writing, Margins.

*****

(d) An application may be filed in a language other than English. A verified English translation of the non-English language application and the fee set forth in § 1.17(k) are required to be filed with the application or within such time as may be set by the Office.

The Patent and Trademark Office will accord a filing date to an application meeting the requirements of 35 U.S.C. 111 even though some or all of the application papers, including the written description and the claims, is in a language other than English and hence does not comply with 37 CFR 1.52.

A verified English translation of the non-English language papers, the filing fee, the oath or declaration, and fee set forth in 37 CFR 1.17(k) should either accompany the application papers or be filed in the Office within the time set by the Office.

A subsequently filed verified English translation must contain the complete identifying data for the application in order to permit prompt association with the papers initially filed. Accordingly, it is strongly recommended that the origi-

nal application papers be accompanied by a cover letter and a self-addressed return postcard, each containing the following identifying data in English: (a) applicant's name(s); (b) title of invention; (c) number of pages of specification, claims, and sheets of drawings; (d) whether oath or declaration was filed and (e) amount and manner of paying the filing fee.

The translation must be a literal translation verified as such by the translator and must be accompanied by a signed request from the applicant, his or her attorney or agent, ask ing that the verified English translation be used as the copy for examination purposes in the Office. If the verified English translation does not conform to idiomatic English and United States practice, it should be accompanied by a preliminary amendment making the necessary changes without the introduction of new matter prohibited by 35 U.S.C. 132. In the event the verified literal translation is not timely filed in the Office, the application will be regarded as abandoned.

It should be recognized that this practice is intended for emergency situations to prevent loss of valuable rights and should not be routinely used for filing applications. There are at least two reasons why this should not be used on a routine basis. First, there are obvious dangers to applicant and the public if he or she fails to obtain a correct literal translation. Second, the filing of a large number of applications under the procedure will create significant administrative burdens on the Office.

ILLUSTRATIONS IN THE SPECIFICATION

Graphical illustrations, diagrammatic views, flowcharts, and diagrams in the descriptive portion of the specification do not come within the purview of 37 CFR 1.58(a), which permits tables and chemical formulas in the specification in lieu of formal drawings. The examiner should object to such descriptive illustrations in the specification and request formal drawings in accordance with 37 CFR 1.81 when an application contains graphs in the specification.

Since the December 7, 1976,, issue of patents, all tables and mathematical equations and chemical formulas, or portions thereof, have been reproduced for printing by a computer process developed by the Data Base Contractor. Those portions of chemical formulas which cannot be reproduced by the process, such as dotted, curved, broken and wedge-shaped lines, must be drawn by hand on the photocomposed page. There are, however, some chemical structures which cannot be reproduced because they are either too complex or involve too many lines which cannot be generated by the computer process. The camera copy process, which is used to insert these types of structures onto the printed patent page, is both time consuming and costly to the Office. Because of the reduction factor and failure to comply with the guidelines set forth in 37 CFR 1.58 (a) and (b), the reproduction of these structures is often poor.

Therefore, the specification, including the claims, may contain chemical formulas and mathematical equations, but should not contain drawings or flow diagrams or diagrammatic views of chemical structures. The description portion of the specification may contain tables; claims may contain tables only if necessary to conform to 35 U.S.C. 112.

APPLICATION FILED WITHOUT ALL PAGES OF SPECIFICATION

Applications filed without all pages of the specification are not given a filing date since they are *prima facie* incomplete. The filing date is the date on which the omitted pages are filed. If the oath or declaration for the application was filed prior to the submission of all pages of specification,the submission of any omitted pages must be accompanied by a supplemental oath or declaration referring to the specification originally deposited, as amended to include the pages originally omitted. If the oath or declaration for the application was not filed prior to the submission of the omitted pages, the oath or declaration,when filed, must include a specific reference to the pages originally omitted. If any applicant believes that the omitted pages of the application are not necessary for an understanding of the subject matter sought to be patented, applicant may petition to have the application accepted without the omitted pages. Any petition must be accompanied by the petition fee (37 CFR 1.17(h)) and an amendment canceling from the specification all incomplete sentences and any claims which depend upon the omitted pages for disclosure and support and renumbering the pages present in consecutive order. Also, if the oath or declaration for the application was filed prior to the date of the amendment and petition, the amendment must be accompanied by a supplemental declaration by the applicant stating that the invention is adequately disclosed in, and a desire to rely on, the application as thus amended for purposes of an original disclosure and filing date. If the oath or declaration for the application was not filed prior to the date of the petition and amendment, the oath or declaration, when filed, must include a specific reference to the amendment cancelling from the specification all incomplete sentences and any claims which depend upon the omitted pages for disclosure and support. The petition requesting that the application be accepted without the omitted pages should be directed to the Office of the Assistant Commissioner for Patents and request relief under 37 CFR 1.182.

APPLICATION FILED WITHOUT AT LEAST ONE CLAIM

35 U.S.C. 111 requires that an application for patent should include, *inter alia*, "a specification as prescribed by sec-

tion 112 of this title". Section 112 states that "The specification shall contain a written description...and...shall conclude with one or more claims..." Also, the CAFC stated in *Litton Systems, Inc.* v. *Whirlpool*, 221 USPQ 97, 105 (Fed. Cir. 1984) that:

> "Both statute, 35 U.S.C. §111, and federal regulations, 37 CFR § 1.51, make clear the requirement that an application for a patent must include (1) a specification and claims,..." (emphasis original)

Therefore, a claim is clearly a statutory requirement for according a filing date to an application. 35 U.S.C. 171 makes 35 U.S.C. 112 applicable to design applications. Also, 35 U.S.C. 162 requires the specification in a plant patent application to contain a claim. Thus, any application filed without at least one claim is incomplete and not entitled to a filing date. If the application does not contain at least one claim, a "Notice of Incomplete Application" (form PTO-1123) will be mailed to the applicant(s) indicating that no filing date has been granted and setting a period for submitting a claim. The filing date will be the date of receipt of at least one claim. See *In re Mattson*, 208 USPQ 168 (Comm'r Pats 1980).

608.01(a) Arrangement of Application

37 CFR 1.77. Arrangement of application elements.

The elements of the application should appear in the following order:

(a) Title of the invention; or an introductory portion stating the name, citizenship, and residence of the applicant, and the title of the invention may be used.

(b) (Reserved).

(c)(1) Cross-reference to related applications, if any.

(2) Reference to a "microfiche appendix" if any. (See § 1.96(b)). The total number of microfiche and total number of frames should be specified.

(d) Brief summary of the invention.

(e) Brief description of the several views of the drawing, if there are drawings.

(f) Detailed description.

(g) Claim or claims.

(h) Abstract of the disclosure.

(i) Signed oath or declaration.

(j) Drawings.

NOTE

Design patent specification, MPEP § 1503.01.

Plant patent specification, MPEP § 1605.

Reissue patent specification, MPEP § 1411.

The following order of arrangement is preferable in framing the specification and, except for the title of the invention, each of the lettered items should be preceded by the headings indicated.

(a) Title of the Invention.

(b) Cross-References to Related Applications (if any).

(c) Background of the Invention.

1. Field of the Invention.

2. Description of the related art including information disclosed under 37 CFR 1.97and 1.98.

(d) Summary of the Invention.

(e) Brief Description of the Drawings.

(f) Description of the Preferred Embodiment(s).

(g) Claim(s).

(h) Abstract of the Disclosure.

Applicant (typically a *pro se*) may be advised of the proper arrangement by using Form Paragraph 6.01 or 6.02.

¶ *6.01 Arrangement of Specification*

The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

The following order or arrangement is preferred in framing the specification and, except for the title of the invention, each of the lettered items should be preceded by the headings indicated below.

(a) Title of the Invention.

(b) Cross-References to Related Applications (if any).

(c) Statement as to rights to inventions made under Federally-sponsored research and development (if any).

(d) Background of the Invention.

1. Field of the Invention.

2. Description of related art including information disclosed under 37 CFR §§ 1.97 and 1.98.

(e) Summary of the Invention.

(f) Brief Description of the Drawing.

(g) Description of the Preferred Embodiment(s).

(h) Claim(s).

(i) Abstract of the Disclosure.

Examiner Note:

In this paragraph an introductory sentence will be necessary.

This paragraph intended primarily for use in Pro Se applications.

¶ *6.02 Content of Specification*

Content of Specification

(a) Title of the Invention. (See 37 CFR § 1.72(a)). The title of the invention should be placed at the top of the first page of the specification. It should be brief but technically accurate and descriptive, preferably from two to seven words.

(b) Cross-References to Related Applications: See 37 CFR 1.78 and § 201.11 MPEP.

(c) Statement as to rights to inventions made under Federally sponsored research and development (if any): see § 310 MPEP.

(d) Background of the Invention: The specification should set forth the Background of the Invention in two parts:

(1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions or the subject matter of the claimed invention. This item may also be titled "Technical Field."

(2) Description of the Related Art: A description of the related art known to the applicant and including, if applicable, references to specific art related and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art".

(e) Summary: A brief summary or general statement of the invention as set forth in 37 CFR § 1.73. The summary is separate and distinct from the

abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

(f) Brief Description of the Drawing(s): A reference to and brief description of the drawings(s) as set forth in 37 CFR § 1.74.

(g) Description of the Preferred Embodiment(s): A description of the preferred embodiment(s) of the invention as required in 37 CFR § 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately.

This item may also be titled "Best Mode for Carrying Out the Invention." Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the speculation should refer to another patent or readily available publication which adequately describes the subject matter.

(h) Claim(s) (See 37 CFR 1.75) A claim may be typed with the various elements subdivided in paragraph form. There may be plural indentations to further segregate subcombinations or related steps.

(i) Abstract: A brief narrative of the disclosure as a whole in a single paragraph of 250 words or less.

Examiner Note:

In this paragraph an introductory sentence will be necessary.

This paragraph is intended primarily for use in Pro Se applications. See also "pro se" form paragraphs in Chapter 1700 of the Manual of Patent Examining Form Paragraphs.

608.01(b) Abstract of the Disclosure

37 CFR 1.72. Title and abstract.

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(b) A brief abstract of the technical disclosure in the specification must be set forth on a separate sheet, preferably following the claims under the heading Abstract of the Disclosure. The purpose of the abstract is to enable the Patent and Trademark Office and the public generally to determine quickly from a cursory inspection the nature and gist of the technical disclosure. The abstract shall not be used for interpreting the scope of the claims.

In all cases which lack an abstract, the examiner in the first Office action should require the submission of an abstract directed to the technical disclosure in the specification. See Form Paragraph 6.12 (below). Applicants may use either "Abstract" or "Abstract of the Disclosure" as a heading.

If the abstract contained in the application does not comply with the guidelines, the examiner should point out the defect to the applicant in the first Office action, or at the earliest point in the prosecution that the defect is noted, and require compliance with the guidelines. Since the abstract of the disclosure has been interpreted to be a part of the specification for the purpose of compliance with paragraph 1 of 35 U.S.C. 112 (*In re Armbruster*, 512 F2d 676, 185 USPQ 152 (CCPA, 1975)), it would ordinarily be preferable that the applicant make the necessary changes to the abstract to bring it into compliance with the guidelines. See Form Paragraphs 6.13–6.16 (below).

Responses to such actions requiring either a new abstract or amendment to bring the abstract into compliance with the guidelines should be treated under 37 CFR 1.111(b) practice like any other formal matter. Any submission of a new abstract or amendment to an existing abstract should be carefully reviewed for introduction of new matter, 35 U.S.C. 132, MPEP § 608.04.

Upon passing the case to issue, the examiner should see that the abstract is an adequate and clear statement of the contents of the disclosure and generally in line with the guidelines. The abstract shall be changed by the examiner's amendment in those instances where deemed necessary. This authority and responsibility of the examiner shall not be abridged by the desirability of having the applicant make the necessary corrections. For example, if the application is otherwise in condition for allowance except that the abstract does not comply with the guidelines, the examiner generally should make any necessary revisions by examiner's amendment rather than issuing an *Ex parte Quayle* action requiring applicant to make the necessary revisions.

Under current practice, in all instances where the application contains an abstract when sent to issue, the abstract will be printed on the patent.

GUIDELINES FOR THE PREPARATION OF PATENT ABSTRACTS

Background

The Rules of Practice in Patent Cases require that each application for patent include an abstract of the disclosure, 37 CFR 1.72(b).

The content of a patent abstract should be such as to enable the reader thereof, regardless of his or her degree of familiarity with patent documents, to ascertain quickly the character of the subject matter covered by the technical disclosure and should include that which is new in the art to which the invention pertains.

The abstract is not intended nor designated for use in interpreting the scope or meaning of the claims, 37 CFR 1.72(b).

Content

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains.

If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure.

If the patent is in the nature of an improvement in old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement.

In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or a use thereof.

If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following: (1) if a machine or apparatus, its organization and operation; (2) if an article, its method of making; (3) if a chemical compound, its identity and use; (4) if a mixture, its ingredients; (5) if a process, the steps. Extensive mechanical and design details of apparatus should not be given.

With regard particularly to chemical patents, for compounds or compositions, the general nature of the compound or composition should be given as well as the use thereof; e.g., "The compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics." Exemplification of a species could be illustrative of members of the class. For processes, the type reaction, reagents and process conditions should be stated, generally illustrated by a single example unless variations are necessary.

Language and Format

The abstract should be in narrative form and generally limited to a single paragraph within the range of 50 to 250 words. The abstract should not exceed 25 lines of text. Abstracts exceeding 25 lines of text should be checked to see that it does not exceed 250 words in length since the space provided for the abstract on the computer tape by the printer is limited. If the abstract cannot be placed on the computer tape because of its excessive length, the application will be returned to the examiner for preparation of a shorter abstract. The form and legal phraseology often used in patent claims, such as "means" and "said", should be avoided. The abstract should sufficiently describe the disclosure to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "This disclosure concerns," "The disclosure defined by this invention," "This disclosure describes," etc.

Responsibility

Preparation of the abstract is the responsibility of the applicant. Background knowledge of the art and an appreciation of the applicant's contribution to the art are most important in the preparation of the abstract. The review of the abstract, for compliance with these guidelines, with any necessary editing and revision on allowance of the application is the responsibility of the examiner.

Sample Abstracts

(1) A heart valve which has an annular valve body defining an orifice and a plurality of struts forming a pair of cages on opposite sides of the orifice. A spherical closure member is captively held within the cages and is moved by blood flow between open and closed positions in check valve fashion. A slight leak or backflow is provided in the closed position by making the orifice slightly larger than the closure member. Blood flow is maximized in the open position of the valve by providing an inwardly convex contour on the orifice-defining surfaces of the body. An annular rib is formed in a channel around the periphery of the valve body to anchor a suture ring used to secure the valve within a heart.

(2) A method for sealing whereby heat is applied to seal, overlapping closure panels of a folding box made from paperboard having an extremely thin coating of moisture-proofing thermoplastic material on opposite surfaces. Heated air is directed at the surfaces to be bonded, the temperature of the air at the point of impact on the surfaces being above the char point of the board. The duration of application of heat is made so brief, by a corresponding high rate of advance of the boxes through the air stream, that the coating on the reverse side of the panels remains substantially non-tacky. The bond is formed immediately after heating within a period of time for any one surface point less than the total time of exposure to heated air of that point. Under such conditions the heat applied to soften the thermoplastic coating is dissipated after completion of the bond by absorption into the board acting as a heat sink without the need for cooling devices.

(3) Amides are produced by reacting an ester of a carboxylic acid with an amine, using as catalyst an alkoxide of an alkali metal. The ester is first heated to at least 75° C. under a pressure of no more than 500 mm. of mercury to remove moisture and acid gases which would prevent the reaction, and then converted to an amide without heating to initiate the reaction.

¶ *6.12 Abstract Missing (Background)*

This application does not contain an Abstract of the Disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Examiner Note:

For Pro Se applicant consider Form Paragraphs 6.14 - 6.16.

¶ *6.13 Abstract Objected to: Minor Informalities*

The Abstract of the Disclosure is objected to because [1]. Correction is required. See MPEP 608.01(b).

Examiner Note:

In bracket 1, indicate the informalities that should be corrected. Use this paragraph for minor informalities such as the inclusion of legal phraseology, undue length, etc.

¶ *6.14 Abstract of the Disclosure: Content*

Applicant is reminded of the proper content of an Abstract of the Disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains.

If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure.

If the patent is in the nature of an improvement in an old apparatus, process, product or composition, the abstract should include the technical disclosure of the improvement.

In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof.

If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following: (1) if a machine or apparatus, its organization and operation; (2) if an article, its method of making; (3) if a chemical compound, its identity and use; (4) if a mixture, its ingredients; (5) if a process, the steps. Extensive mechanical and design details of apparatus should not be given.

Examiner Note:

See paragraph 6.16.

¶ *6.15 Abstract of the Disclosure, Chemical Cases*

Applicant is reminded of the proper content of an Abstract of the Disclosure.

In chemical patent abstracts, compounds or compositions, the general nature of the compound or composition should be given as well as its use, e.g., The compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics. Exemplification of a species could be illustrative of members of the class. For processes, the type reaction, reagents and process conditions should be stated, generally illustrated by a single example unless variations are necessary. Complete revision of the content of the abstract is required on a separate sheet.

¶ *6.16 Abstract of the Disclosure, Language*

Applicant is reminded of the proper language and format of an Abstract of the Disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said", should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Examiner Note:

See also paragraph 6.14.

608.01(c) Background of the Invention

The Background of the Invention ordinarily comprises two parts:

(1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions. The statement should be directed to the subject matter of the claimed invention.

(2) Description of the related art including information disclosed under 37 CFR 1.97 and 1.98: A paragraph(s) describing to the extent practical the state of the prior art or other information disclosed known to the applicant, including references to specific prior art or other information where appropriate. Where applicable, the problems involved in the prior art or other information disclosed which are solved by the applicant's invention should be indicated. See also MPEP § 608.01(a), § 608.01(p) and § 707.05(b).

608.01(d) Brief Summary of Invention

37 CFR 1.73. Summary of the invention.

A brief summary of the invention indicating its nature and substance, which may include a statement of the object of the invention, should precede the detailed description. Such summary should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed.

Since the purpose of the brief summary of invention is to apprise the public, and more especially those interested in the particular art to which the invention relates, of the nature of the invention, the summary should be directed to the specific invention being claimed, in contradistinction to mere generalities which would be equally applicable to numerous preceding patents. That is, the subject matter of the invention should be described in one or more clear, concise sentences or paragraphs. Stereotyped general statements that would fit one case as well as another serve no useful purpose and may well be required to be cancelled as surplusage, and, in the absence of any illuminating statement, replaced by statements that are directly in point as applicable exclusively to the case in hand.

The brief summary, if properly written to set out the exact nature, operation, and purpose of the invention, will be of material assistance in aiding ready understanding of the patent in future searches. See MPEP § 905.04. The brief summary should be more than a mere statement of the objects of the invention, which statement is also permissible under 37 CFR 1.73.

The brief summary of invention should be consistent with the subject matter of the claims. Note final review of application and preparation for issue, MPEP § 1302.

608.01(e) Reservation Clauses Not Permitted

37 CFR 1.79. Reservation clauses not permitted.

A reservation for a future application of subject matter disclosed but not claimed in a pending application will not be permitted in the pending application, but an application disclosing unclaimed subject matter may contain a reference to a later filed application of the same applicant or owned by a common assignee disclosing and claiming that subject matter.

608.01(f) Brief Description of Drawings

37 CFR 1.74. Reference to drawings.

When there are drawings, there shall be a brief description of the several views of the drawings and the detailed description of the invention shall refer to the different views by specifying the numbers of the figures, and to the different parts by use of reference letters or numerals (preferably the latter).

Application Branch will review the specification, including the brief description, prior to assigning a filing date to the application to ensure that all figures of drawings described in the specification are present. If the specification describes a figure which is not present in the drawings, Application Branch will mail a "Notice of Incomplete Application" (form PTO-1123), MPEP § 601.01, stating that the filing date of the application will be the date of receipt of the omitted figures. Therefore, it is important that all figures of drawings be correctly labelled and described in the brief description and elsewhere in the specification. See also, MPEP § 608.02.

The examiner should see to it that the figures are correctly described in the brief description of the drawing, that all section lines used are referred to, and that all needed section lines are used.

The specification must contain or be amended to contain proper reference to the existence of drawings executed in color as required by 37 CFR 1.84.

37 CFR 1.84. Standards for drawings.

(a) Drawings. There are two acceptable categories for presenting drawings in utility patent applications:

(1) Black ink. Black and white drawings are normally required India ink, or its equivalent that secures solid black lines, must be used for drawings, or

(2) Color. On rare occasions, color drawing may be necessary as the only practical medium by which to disclose the subject matter sought to be patented in a utility patent application or the subject matter of a statutory invention registration. The Patent and Trademark Office will accept color drawings in utility patent applications and statutory invention registrations only after granting a petition filed under this paragraph explaining why the color drawings are necessary. Any such petition must include the following:

(i) The appropriate fee set forth in § 1.17(h);

(ii) Three (3) sets of color drawings; and

(iii) The specification must contain the following language as the first paragraph in that portion of the specification relating to the brief description of the drawing:

"The file of this patent contains at least one drawing executed in color: Copies of this patent with color drawing(s) will be provided by the Patent and Trademark Office upon request and payment of the necessary fee."

If the language is not in the specification, a proposed amendment to insert the language must accompany the petition.

608.01(g) Detailed Description of Invention

A detailed description of the invention and drawings follows the general statement of invention and brief description of the drawings. This detailed description, required by 37 CFR 1.71, MPEP § 608.01, must be in such particularity as to enable any person skilled in the pertinent art or science to make and use the invention without involving extensive experimentation. An applicant is ordinarily permitted to use his or her own terminology, as long as it can be understood. Necessary grammatical corrections, however, should be required by the examiner, but it must be remembered that an examination is not made for the purpose of securing grammatical perfection.

The reference characters must be properly applied, no single reference character being used for two different parts or for a given part and a modification of such part. In the latter case, the reference character, applied to the given part, with a prime affixed may advantageously be applied to the modification. Every feature specified in the claims must be illustrated, but there should be no superfluous illustrations.

The description is a dictionary for the claims and should provide clear support or antecedent basis for all terms used in the claims. See 37 CFR 1.75, MPEP § 608.01(i), § 608.01(o), and § 1302.01.

NOTE. — Completeness, MPEP § 608.01(p).

USE OF SYMBOL "Phi" IN PATENT APPLICATION

The Greek letter "Phi" has long been used as a symbol in equations in all technical disciplines. It further has special uses which include the indication of an electrical phase or clocking signal as well as an angular measurement. The recognized symbols for the upper and lower case Greek Phi characters, however, do not appear on most typewriters. This apparently has led to the use of a symbol composed by first striking a zero key and then backspacing and striking the "cancel" or "slash" key to result in Ø, an approximation of accepted symbols for the Greek character Phi. In other instances, the symbol is composed using the upper or lower case letter "O" with the "cancel" or "slash" superimposed thereon by backspacing, or it is simply handwritten in a variety of styles. These expedients result in confusion because of the variety of type sizes and styles available on modern typewriters.

In recent years, the growth of data processing has seen the increasing use of this symbol ("O") as the standard representation of zero. The "slashed" or "cancelled" zero is used to indicate zero and avoid confusion with the upper case letter "O" in both text and drawings.

Thus, when the symbol "Ø" in one of its many variations, as discussed above, appears in patent applications being prepared for printing, confusion as to the intended meaning of the symbol arises. Those (such as examiners, attorneys, and applicants) working in the art can usually determine the intended meaning of this symbol because of their knowledge of the subject matter involved, but editors preparing these applications for printing have no such specialized knowledge and confusion arises as to which symbol to print. The result, at the very least, is delay until the intended meaning of the symbol can be ascertained.

Since the Office does not have the resources to conduct a technical editorial review of each application before printing, and in order to eliminate the problem of printing delays associated with the usage of these symbols, any question about the intended symbol will be resolved by the editorial staff of the Office of Publications by printing the symbol "Ø" whenever that symbol is used by the applicant. Any Certificate of Correction necessitated by the above practice will be at the patentee's expense (37 CFR 1.323) because the intended symbol was not accurately presented by the Greek upper or lower case Phi letters (Ø,ø) in the patent application.

608.01(h) Mode of Operation of Invention

The best mode contemplated by the inventor of carrying out his or her invention must be set forth in the description. see 35 U.S.C. 112. There is no statutory requirement for the disclosure of a specific example. A patent specification is not intended nor required to be a production specification, *In re Gay,* 309 F2d 768, 135 USPQ 311 (CCPA 1962). The absence of a specific working example is not necessarily evidence that the best mode has not been disclosed, nor is the presence of one evidence that it has, *In re Honn,* 364 F2d 454, 150 USPQ, 652 (CCPA 1966). In determining the adequacy of a best mode disclosure, only evidence of concealment (accidental or intentional) is to be considered. That evidence must tend to show that the quality of an applicant's best mode disclosure is so poor as to effectively result in concealment; *In re Sherwood,* 204 USPQ 537 (CCPA 1980).

The question of whether an inventor has or has not disclosed what he or she feels is his or her best mode is a question separate and distinct from the question of sufficiency of the disclosure, *In re Gay,* 135 USPQ 311 (CCPA 1962); *In re Glass,* 181 USPQ 31 (CCPA 1974). See 35 U.S.C. 112 and 37 CFR 1.71(b). *Sylgab Steel & Wire Corp.* v. *Imoco-Gateway Corp.*, 357 F. Supp. 657, 178 USPQ 22 (N.D. Ill. 1973); *H. K. Porter Co., Inc.* v. *Gates Rubber Co.*, 187 USPQ 692, 708, (D. Colo. 1975).

If the best mode contemplated by the inventor at the time of filing the application is not disclosed, such defect cannot be cured by submitting an amendment seeking to put into the specification something required to be there when the application was originally filed, *In re Hay,* 534 F2d 917, 189 USPQ 790 (CCPA 1976). Any proposed amendment of this type should be treated as new matter.

Patents have been held invalid in cases where the patentee did not disclose the best mode known to him. See *Flick-Reedy Corp.* v. *Hydro-Line Manufacturing Co.*, 351 F.2d 546, 146 USPQ 694 (CA 7 1965), cert. denied, 383 U.S. 958, 148 USPQ 771 (1966); *Indiana General Corp.* v. *Krystinel Corp.*, 297 F. Supp. 427. 161 USPQ 82 (S.D.N.Y. 1969), affirmed, 421 F.2d 1033, 164 USPQ 321 (CA 2 1970); *Dale Electronics, Inc.* v. *R.C.L. Electronics, Inc.*, 488 F.2d 382, 180 USPQ 235 (CA 1 1973); *Union Carbide Corp.* v. *Borg-Warner Corp.*, 550 F.2d 355, 193 USPQ 1 (CA 6 1977); *Reynolds Metals Co.* v. *Acorn Building Components Inc.*, 548 F.2d 155, 163, 192 USPQ 737 (CA 6 1977).

NOTE. — Completeness, MPEP § 608.01(p).

608.01(i) Claims

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

(b) More than one claim may be presented provided they differ substantially from each other and are not unduly multiplied.

(c) One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application. Any dependent claim which refers to more than one other claim ("multiple dependent claim") shall refer to such other claims in the alternative only. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. For fee calculation purposes under § 1.16, a multiple dependent claim will be considered to be that number of claims to which direct reference is made therein. For fee calculation purposes, also, any claim depending from a multiple dependent claim will be considered to be that number of claims to which direct reference is made in that multiple dependent claim. In addition to the other filing fees, any original application which is filed with, or is amended to include, multiple dependent claims must have paid therein the fee set forth in § 1.16(d). Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of each of the particular claims in relation to which it is being considered.

(d)(1) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See § 1.58(a).)

(2) See §§ 1.141 to 1.146 as to claiming different inventions in one application.

(e) Where the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order, (1) a preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known, (2) a phrase such as "wherein the improvement comprises," and (3) those elements, steps and/or relationships which constitute that portion of the claimed combination which the applicant considers as the new or improved portion.

(f) If there are several claims, they shall be numbered consecutively in Arabic numerals.

(g) All dependent claims should be grouped together with the claim or claims to which they refer to the extent possible.

NOTE

Numbering of Claims, MPEP § 608.01(j).
Form of Claims, MPEP § 608.01(m).
Dependent claims, MPEP § 608.01(n).
Examination of claims, MPEP § 706.
Claims in excess of fee, MPEP § 714.10.

608.01(j) Numbering of Claims

37 CFR 1.126. Numbering of claims.

The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled the remaining claims must not be renumbered. When claims are added, except when presented in accordance with § 1.121(b), they must be numbered by the applicant consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not). When the application is ready for allowance, the examiner, if necessary, will renumber the claims consecutively in the order in which they appear or in such order as may have been requested by applicant.

In a single claim case, the claim is not numbered.

Form Paragraph 6.17 may be used to notify applicant.

¶ *6.17 Numbering of Claims, 37 CFR 1.126*

The numbering of claims is not in accordance with 37 CFR 1.126. The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When claims are added, except when presented in accordance with 37 CFR § 1.121(b), they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims [1] have been renumbered [2], respectively.

608.01(k) Statutory Requirement of Claims

35 U.S.C. 112 requires that the applicant shall particularly point out and distinctly claim the subject matter which he or she regards as his or her invention. The portion of the application in which he or she does this forms the claim or claims. This is an important part of the application, as it is the definition of that for which protection is granted.

608.01(l) Original Claims

In establishing a disclosure, applicant may rely not only on the description and drawing as filed but also on the original claims if their content justifies it.

Where subject matter not shown in the drawing or described in the description is claimed in the case as filed, and such original claim itself constitutes a clear disclosure of this subject matter, then the claim should be treated on its merits, and requirement made to amend the drawing and description to show this subject matter. The claim should not be attacked either by objection or rejection because this subject matter is lacking in the drawing and description. It is the drawing and description that are defective; not the claim.

It is, of course, to be understood that this disclosure in the claim must be sufficiently specific and detailed to support the necessary amendment of the drawing and description.

608.01(m) Form of Claims

While there is no set statutory form for claims, the present Office practice is to insist that each claim must be the object of a sentence starting with "I (or we) claim", "The invention claimed is" (or the equivalent). If, at the time of allowance, the quoted terminology is not present, it is inserted by the clerk. Each claim begins with a capital letter and ends with a period. Periods may not be used elsewhere in the claims except for abbreviations. A claim may be typed with the various elements subdivided in paragraph form.

There may be plural indentations to further segregate subcombinations or related steps. In general, the printed patent copies will follow the format used but printing difficulties or expense may prevent the duplication of unduly complex claim formats.

Reference characters corresponding to elements recited in the detailed description and the drawings may be used in conjunction with the recitation of the same element or group of elements in the claims. The reference characters, however, should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. The use of reference characters is to be considered as having no effect on the scope of the claims.

Many of the difficulties encountered in the prosecution of patent applications after final rejection may be alleviated if each applicant includes, at the time of filing or no later than the first response, claims varying from the broadest to which he or she believes he or she is entitled to the most detailed that he or she is willing to accept.

Claims should preferably be arranged in order of scope so that the first claim presented is the broadest. Where separate species are claimed, the claims of like species should be grouped together where possible and physically separated by drawing a line between claims or groups of claims. (Both of these provisions may not be practical or possible where several species claims depend from the same generic claim.) Similarly, product and process claims should be separately grouped. Such arrangements are for the purpose of facilitating classification and examination.

The form of claim required in 37 CFR 1.75(e) is particularly adapted for the description of improvement-type inventions. It is to be considered a combination claim. The preamble

of this form of claim is considered to positively and clearly include all the elements or steps recited therein as a part of the claimed combination.

For rejections not based on prior art, see MPEP § 706.03.

608.01(n) Dependent Claims

37 CFR 1.75(c) reads as follows for applications filed prior to January 24, 1978:

(c) When more than one claim is presented, they may be placed in dependent form in which a claim may refer back to and further restrict a single preceding claim. Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.

MULTIPLE DEPENDENT CLAIMS

37 CFR 1.75(c) reads as follows for applications filed on and after January 24, 1978.

37 CFR 1.75. Claim(s).

*****

(c) one or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application. Any dependent claim which refers to more than one other claim (multiple dependent claim) shall refer to such other claims in the alternative only. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. For fee calculation purposes under § 1.16, a multiple dependent claim will be considered to be that number of claims to which direct reference is made therein. For fee calculation purposes, also, any claim depending from a multiple dependent claim will be considered to be that number of claims to which direct reference is made in that multiple dependent claim. In addition to the other filing fees, any original application which is filed with, or is amended to include, multiple dependent claims must have paid therein the fee set forth in § 1.16(d). Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of each of the particular claims in relation to which it is being considered.

*****

Generally, a multiple dependent claim is a dependent claim which refers back in the alternative to more than one preceding independent or dependent claim.

The second paragraph of 35 U.S.C. 112 has been revised in view of the multiple dependent claim practice introduced by the Patent Cooperation Treaty. Thus, 35 U.S.C. 112 authorizes multiple dependent claims in applications filed on and after January 24, 1978, as long as they are in the alternative form (e.g., "A machine according to claims 3 or 4, further comprising — "). Cumulative claiming (e.g.,"A machine according to claims 3 and 4, further comprising —") is not permitted. A multiple dependent claim may refer in the alternative to only one set of claims. A claim such as "A device as in claims 1, 2, 3, or 4, made by a process of claims 5, 6, 7, or 8" is improper. Section 112 allows reference to only a particular claim. Furthermore, a multiple dependent claim may not serve as a basis for any other multiple dependent claim, either directly or indirectly. These limitations help to avoid undue confusion in determining how many prior claims are actually referred to in a multiple dependent claim.

A multiple dependent claim which depends from another multiple dependent claim should be objected to by using Form Paragraph 7.45.

¶ *7.45 Improper Multiple Dependent Claims*

Claim [1] objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim [2]. See MPEP 608.01(n). Accordingly, [3] has not been further treated on the merits.

Examiner's Note:

1. In bracket 2, insert "should refer to other claims in the alternative only" and/or, "cannot depend from any other multiple dependent claim.4"
2. Use this paragraph rather than 35 U.S.C. 112, fifth paragraph.
3. In bracket 3, insert "the claim has or these claims have."

Assume each claim example given below is from a different application.

ACCEPTABLE MULTIPLE DEPENDENT CLAIM WORDING

Claim 5. A gadget according to claims 3 or 4, further comprising —

Claim 5. A gadget as in any one of the preceding claims, in which —

Claim 3. A gadget as in either claim 1 or claim 2, further comprising —

Claim 4. A gadget as in claim 2 or 3, further comprising –

Claim 16. A gadget as in claims 1, 7, 12, or 15, further comprising —

Claim 5. A gadget as in any of the preceding claims, in which —

Claim 8. A gadget as in one of claims 4–7, in which —

Claim 5. A gadget as in any preceding claim, in which —

Claim 10. A gadget as in any of claims 1–3 or 7–9, in which —

Claim 11. A gadget as in any one of claims 1, 2, or 7–10 inclusive, in which —

UNACCEPTABLE MULTIPLE DEPENDENT CLAIM WORDING

A. Claim does not refer back in the alternative only

Claim 5. A gadget according to claim 3 and 4, further comprising —

Claim 9. A gadget according to claims 1–3, in which —

Claim 9. A gadget as in claims 1 or 2 and 7 or 8, which —

Claim 6. A gadget as in the preceding claims in which —

Claim 6. A gadget as in claims 1, 2, 3, 4 and/or 5, in which —

Claim 10. A gadget as in claims 1–3 or 7–9, in which —

B. Claim does not refer to a preceding claim

Claim 3. A gadget as in any of the following claims, in which ——

Claim 5. A gadget as in either claim 6 or claim 8, in which ——

C. Reference to two sets of claims to different features

Claim 9. A gadget as in claim 1 or 4 made by the process of claims 5, 6, 7, or 8, in which ——

D. (Reference back to another multiple dependent claim)

Claim 8. A gadget as in claim 5 (claim 5 is a multiple dependent claim) or claim 7, in which ——

35 U.S.C. 112 indicates that the limitations or elements of each claim incorporated by reference into a multiple dependent claim must be considered separately. Thus, a multiple dependent claim, as such, does not contain all the limitations of all the alternative claims to which it refers, but rather contains in any one embodiment only those limitations of the particular claim referred to for the embodiment under consideration. Hence, a multiple dependent claim must be considered in the same manner as a plurality of single dependent claims.

Restriction Practice

For restriction purposes, each embodiment of a multiple dependent claim is considered in the same manner as a single dependent claim. Therefore, restriction may be required between the embodiments of a multiple dependent claim. Also, some embodiments of a multiple dependent claim may be held withdrawn while other embodiments are considered on their merits.

Handling of Multiple Dependent Claims by the Application Branch

The Application Division is responsible for verifying whether multiple dependent claims filed with the application are in proper alternative form, that they depend only upon prior independent or single dependent claims and also for calculating the amount of the filing fee. A new form, PTO-1360, has been designed to be used in conjunction with the current fee calculation form PTO-875.

Handling of Multiple Dependent Claims by the Examining Group Clerical Staff

The examining group clerical staff is responsible for verifying compliance with the statute and rules of multiple dependent claims added by amendment and for calculating the amount of any additional fees required. This calculation should be performed on form PTO-1360.

There is no need for a group clerk to check the accuracy of the initial filing fee since this has already been verified by the Application Branch when granting the filing date.

If a multiple dependent claim (or claims) is added in an amendment without the proper fee, either by adding references to prior claims or by adding a new multiple dependent claim, the amendment should not be entered until the fee has been received. In view of the requirements for multiple dependent claims, no amendment containing new claims or changing the dependency of claims should be entered before checking whether the paid fees cover the costs of the amended claims. The applicant, or his or her attorney or agent, should be contacted to pay the additional fee. Where a letter is written in an insufficient fee situation, a copy of the multiple dependent claim fee calculation, form PTO-1360, should be included for applicant's information.

If an application filed prior to October 1, 1982, is amended on or after October 1, 1982, to include a proper multiple dependent claim for the first time, the fee set forth in § 1.16(d) must be paid.

If such an application contained a proper multiple dependent claim prior to October 1, 1982, the fee set forth in § 1.16(d) does not apply.

Where the group clerk notes that the reference to the prior claims is improper in an added or amended multiple dependent claim, a notation should be made in the left margin next to the claim itself and the number 1, which is inserted in the "Dep. Claim" column of that amendment on form PTO-1360, should be circled in order to call this matter to the examiner's attention.

Handling of Multiple Dependent Claims by the Examiner

Should any multiple dependent claim be in an application filed prior to January 24, 1978 or include a claim association or claim structure that violates any of the prohibitions, the claim should be objected to as not being in proper form as required by 37 CFR 1.75 in the next Office action. Such an improper claim need not be further treated on the merits.

Public Law 94-131, the implementing legislation for the Patent Cooperation Treaty amended 35 U.S.C. 112 to state that "a claim in dependent form shall contain a reference to a claim *previously set forth*." The requirement to refer to a previous claim had existed only in 37 CFR 1.75(c) before.

The following procedures are to be followed by examiners when faced with claims which refer to numerically succeeding claims:

If any series of dependent claims contains a claim with an improper reference to a numerically following claim which cannot be understood, the claim referring to a following claim should normally be objected to and not treated on the merits.

However, in situations where a claim refers to a numerically following claim and the dependency is clear, both as presented and as it will be renumbered at issue, all claims should be examined on the merits and no objection as to form need be made. In such cases, the examiner will renumber the claims into proper order at the time the application is allowed. (See example B, below).

Any unusual problems should be brought to the supervisor's attention.

Example A

(Claims 4 and 6 should be objected to as not being understood and should not be treated on the merits.)

1. Independent
2. Dependent on claim 5
3. Dependent on claim 2
4. ". . . as in any preceding claim"
5. Independent
6. Dependent on claim 4

Example B

NOTE: Parenthetical numerals represent the claim numbering for issue should all claims be allowed.

(All claims should be examined.)

1. (1) Independent
2. (5) Dependent on claim 5 (4)
3. (2) Dependent on claim 1 (1)
4. (3) Dependent on claim 3 (2)
5. (4) Dependent on either claim 1 (1) or claim 3 (2)

The following practice is followed by patent examiners when making reference to a dependent claim — either singular or multiple:

1. When identifying a singular dependent claim which does not include a reference to a multiple dependent claim, either directly or indirectly, reference should be made only to the number of the dependent claim.

2. When identifying the embodiments included within a multiple dependent claim, or a singular dependent claim which includes a reference to a multiple dependent claim, either directly or indirectly, each embodiment should be identified by using the number of the claims involved, starting with the highest, *to the extent necessary* to specifically identify each embodiment.

3. When all embodiments included within a multiple dependent claim or a singular dependent claim which includes a reference to a multiple dependent claim, either directly or indirectly, are subject to a common rejection, objection or requirement, reference may be made only to the number of the dependent claim.

The following table illustrates the current practice where each embodiment of each claim must be treated on an individual basis:

Claim No.	Claim dependency	Identification	
		All claims	Approved practice
1	Independent	1	1
2	Depends from 1	2/1	2
3	Depends from 2	3/2/1	3
4	Depends from 2 or 3	4/2/1	4/2
		4/3/2/1	4/3
5	Depends from 3	5/3/2/1	5
6	Depends from 2, 3, or 5	6/2/1	6/2
		6/3/2/1	6/3
		6/5/3/2/1	6/5
7	Depends from 6	7/6/2/1	7/6/2
		7/6/3/2/1	7/6/3
		7/6/5/3/2/1	7/6/5

When all embodiments in a multiple dependent claim situation (claims 4, 6, and 7 above) are subject to a common rejection, objection, or requirements, reference may be made to the number of the individual dependent claim only. For example, if 4/2 and 4/3 were subject to a common ground of rejection, reference should be made only to claim 4 in the statement of that rejection.

The provisions of 35 U.S.C.132 require that each Office action make it explicitly clear what rejection, objection and/or requirement is applied to each claim embodiment.

Calculation of Fees When Multiple Dependent Claims Are Presented, Use of Form PTO–1360

To assist in the computation of the fees for multiple dependent claims, a separate "Multiple Dependent Claim Fee Calculation Sheet," form PTO–1360, has been designed for use with the current "Patent Application Fee Determination Record", form PTO–875. Form PTO–1360 will be placed in the file wrapper by the Application Branch where multiple dependent claims are in the application as filed. If multiple dependent claims are not included upon filing, but are later added by amendment, the examining group clerical staff will place the form in the file wrapper. If there are multiple dependent claims in the application, the total number of independent and dependent claims for fee purposes will be calculated on form PTO–1360 and the total number of claims and number of independent claims is then placed on form PTO–875 for final fee calculation purposes.

Calculating Fees for Multiple Dependent Claims

Proper Multiple Dependent Claim

35 U.S.C. 41(a), provides that claims in proper multiple dependent form may not be considered as single dependent claims for the purpose of calculating fees. Thus, a multiple dependent claim is considered to be that number of dependent claims to which it refers. Any proper claim depending directly or indirectly from a multiple dependent claim is also considered as the number of dependent claims as referred to in the multiple dependent claim from which it depends.

Improper Multiple Dependent Claim

If any multiple dependent claim is improper, Application Branch may indicate that fact by placing an encircled numeral "1" in the "Dep. Claims" column of form PTO-1360. The fee for any improper multiple dependent claim, whether it is defective for either not being in the alternative form or for being directly or indirectly dependent on a prior multiple dependent claim, will only be one, since only an objection to the form of such a claim will normally be made. This procedure also greatly simplifies the calculation of fees. Any claim depending from an improper multiple dependent claim will also be considered to be improper and be counted as one dependent claim.

Fee calculation example

Claim No.		*Ind.*	*Dep.*
1.	Independent	1	
2.	Dependent on claim 1		1
3.	Dependent on claim 2		1
4.	Dependent on claim 2 or 3		2
5.	Dependent on claim 4		2
6.	Dependent on claim 5		2
7.	Dependent on claim 4, 5 or 6		①
8.	Dependent on claim 7		①
9.	Independent	1	
10.	Dependent on claim 1 or 9		2
11.	Dependent on claims 1 and 9		①
	Total	2	13

Comments on Fee Calculation Example

Claim 1 — This is an independent claim; therefore, a numeral "1" is placed opposite claim number 1 in the "Ind." column.

Claim 2 — Since this is a claim dependent on a single independent claim, a numeral "1" is placed opposite claim number 2 of the "Dep." column.

Claim 3 — Claim 3 is also a single dependent claim, so a numeral "1" is placed in the "Dep." column.

Claim 4 — Claim 4 is a proper multiple dependent claim. It refers directly to two claims in the alternative, namely, claim 2 *or* 3. Therefore, a numeral "2" to indicate direct reference to two claims is placed in the "Dep." column opposite claim number 4.

Claim 5 — This claim is a singularly dependent claim depending from a multiple dependent claim. For fee calculation purposes, such a claim is counted as being that number of claims to which direct reference is made in the multiple dependent claim from which it depends. In this case, the multiple dependent claim number 4 it depends from counts as 2 claims; therefore, claim 5 also counts as 2 claims. Accordingly, a numeral "2" is placed opposite claim number 5 in the "Dep." column.

Claim 6 — Claim 6 depends indirectly from a multiple dependent claim 4. Since claim 4 counts as 2 claims, claim 6 also counts as 2 dependent claims. Consequently, a numeral "2" is placed in the "Dep." column after claim 6.

Claim 7 — This claim is a multiple dependent claim since it refers to claims 4, 5, or 6. However, as can be seen by looking at the "2' in the "Dep.' column opposite claim 4, claim 7 depends from a multiple dependent claim. This practice is improper under 35 U.S.C. 112 and 37 CFR 1.75(c). Following the procedure for calculating fees for improper multiple dependent claims, a numeral "1" is placed in the "Dep." column with a circle drawn around it to alert the examiner that the claim is improper.

Claim 8 — Claim 8 is improper since it depends from an improper claim. If the base claim is in error, this error cannot be corrected by adding additional claims depending therefrom. Therefore, a numeral "1" with a circle around it is placed in the "Dep." column.

Claim 9 — Here again we have an independent claim which is always indicated with a numeral "1" in the "Ind." column opposite the claim number.

Claim 10 — This claim refers to two independent claims in the alternative. A numeral "2" is, therefore, placed in the "Dep." column opposite claim 10.

Claim 11 — Claim 11 is a dependent claim which refers to two claims in the conjunctive ("1" *and* "9") rather than in the alternative ("1" *or* "9"). This form is improper under 35 U.S.C. 112 and 37 CFR 1.75(c). Accordingly, since claim 11 is improper, an encircled number "1" is placed in the "Dep." column opposite Claim 11.

Calculation of Filing Fee Involving Dependent Claims

After the number of "Ind." and "Dep." claims are noted on form PTO-1360, each column is added. In this example, there are 2 independent claims and 13 dependent claims or a total of 15 claims. The number of independent and total claims can then be placed on form PTO-875 and the fee calculated.

TREATMENT OF IMPROPER DEPENDENT CLAIMS

The initial determination, for fee purposes, as to whether a claim is dependent must be made by persons other than examiners; it is necessary, at that time, to accept as dependent virtually every claim which refers to another claim, without determining whether there is actually a true dependent relationship. The initial acceptance of a claim as a dependent claim does not, however, preclude a subsequent holding by the examiner that a claim is not a proper dependent claim. Any claim which is in dependent form but which is so worded that it, in fact is not, as, for example, it does not include every limitation of the claim on which it depends, will be required to be *cancelled* as not being a proper dependent claim; and cancelation of any further claim depending on such a dependent claim will be similarly required. The applicant may thereupon amend the claims to place them in proper dependent form, or may redraft them as independent claims, upon payment of any *necessary* additional fee.

INFRINGEMENT TEST

The test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. 112, fourth paragraph) or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim.

A dependent claim does not lack compliance with 35 U.S.C. 112, fourth paragraph, simply because there is a question as to (1) the significance of the further limitation added by the dependent claim, or (2) whether the further limitation in fact changes the scope of the dependent claim from that of the claim from which it depends. The test for a proper dependent claim under the fourth paragraph of 35 U.S.C. 112 is whether the dependent claim includes every limitation of the claim from which it depends. The test is not one of whether the claims differ in scope.

Thus, for example, if claim 1 recites the combination of elements A, B, C, and D, a claim reciting the structure of claim 1 in which D was omitted or replaced by E would not be a proper dependent claim, even though it placed further limitations on the remaining elements or added still other elements.

Examiners are reminded that a dependent claim is directed to a combination including everything recited in the base claim and what is recited in the dependent claim. It is this combination that must be compared with the prior art, exactly as if it were presented as one independent claim.

The fact that a dependent claim which is otherwise proper might relate to a separate invention which would require a separate search or be separately classified from the claim on which it depends would not render it an improper dependent claim, although it might result in a requirement for restriction.

The fact that the independent and dependent claims are in different statutory classes does not, in itself, render the latter improper. Thus, if claim 1 recites a specific product, a claim for the method of making the product of claim 1 in a particular manner would be a proper dependent claim since it could not be infringed without infringing claim 1. Similarly, if claim 1 recites a method of making a product, a claim for a product made by the method of claim 1 could be a proper dependent claim. On the other hand, if claim 1 recites a method of making a specified product, a claim to the product set forth in claim 1 would not be a proper dependent claim if the product might be made in other ways. Note, that since 37 CFR 1.75(c) requires the dependent claim to further limit a preceding claim, this rule does not apply to product-by-process claims.

CLAIM FORM AND ARRANGEMENT

A singular dependent claim 2 could read as follows:

2. The product of claim 1 in which . . .

A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a *dependent* claim should not be separated therefrom by any claim which does not also depend from said "dependent claim." It should be kept in mind that a dependent claim may refer back to any preceding independent claim. These are are the only restrictions with respect to the sequence of claims and, in general, applicant's sequence should not be changed. See MPEP § 608.01(j). Applicant may be so advised by using Form Paragraph 6.18.

¶ *6.18 Series of Singular Dependent Claims*

A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See § 608.01(n) MPEP.

During prosecution, the order of claims may change and be in conflict with the requirement that dependent claims refer to a preceding claim. Accordingly, the numbering of dependent claims and the numbers of preceding claims referred to in dependent claims should be carefully checked when claims are renumbered upon allowance.

If the base claim has been cancelled, a claim which is directly or indirectly dependent thereon should be rejected as incomplete. If the base claim is rejected, the dependent claim should be objected to rather than rejected, if it is otherwise allowable.

Form Paragraph 7.43 can be used to state the objection.

¶ *7.43 Objection to Claims, Allowable Subject Matter*

Claim [1] objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

608.01(o) Basis for Claim Terminology in Description

The meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import; and in mechanical cases, it should be identified in the descriptive portion of the specification by reference to the drawing, designating the part or parts therein to which the term applies. A term used in the claims may be given a special meaning in the description. No term may be given a meaning repugnant to the usual meaning of the term.

Usually the terminology of the original claims follows the nomenclature of the specification, but sometimes in amending the claims or in adding new claims, new terms are introduced that do not appear in the specification. The use of a confusing variety of terms for the same thing should not be permitted.

New claims and amendments to the claims already in the case should be scrutinized not only for new matter but also for new terminology. While an applicant is not limited to the nomenclature used in the application as filed, yet, whenever by amendment of his claims, he or she departs therefrom, he or she should make appropriate amendment of the specification so as to have therein clear support or antecedent basis for the new terms appearing in the claims. This is necessary in order to insure certainty in construing the claims in the light of the specification, *Ex parte Kotler* 1901 C.D. 62; 95 O.G. 2684. See 37 CFR 1.75, MPEP § 608.01(i) and § 1302.01.

The specification should be objected to if it does not provide proper antecedent basis for the claims by using Form Paragraph 7.44.

¶ *7.44 Claimed Subject Matter Not in Specification*

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP 608.01(o). Correction of the following is required: [1]

608.01(p) Completeness

Newly filed applications obviously failing to disclose an invention with the clarity required are discussed in MPEP § 702.01.

A disclosure in an application, to be complete, must contain such description and details as to enable any person skilled in the art or science to which the invention pertains to make and use the invention as of its filing date, *In re Glass*, 492 F.2d 1228; 181 USPQ 31 (CCPA 1974).

While the prior art setting may be mentioned in general terms, the essential novelty, the essence of the invention, must be described in such details, including proportions and techniques, where necessary, as to enable those persons skilled in the art to make and utilize the invention.

Specific operative embodiments or examples of the invention must be set forth. Examples and description should be of sufficient scope as to justify the scope of the claims. Markush claims must be provided with support in the disclosure for each member of the Markush group. Where the constitution and formula of a chemical compound is stated only as a probability or speculation, the disclosure is not sufficient to support claims identifying the compound by such composition or formula.

A complete disclosure should include a statement of utility. This usually presents no problem in mechanical cases. In chemical cases, varying degrees of specificity are required.

A disclosure involving a new chemical compound or composition must teach persons skilled in the art how to make the compound or composition. Incomplete teachings may not be completed by reference to subsequently filed applications.

A. GUIDELINES FOR EXAMINATION OF APPLICATIONS FOR COMPLIANCE WITH THE UTILITY REQUIREMENT OF 35 U.S.C. 101

The following guidelines establish the policies and procedures to be followed by examiners when examining applications for compliance with the utility requirement of 35 U.S.C. 101. The guidelines also address issues that may arise during examination of applications claiming protection for inventions in the field of biotechnology and human therapy.

Guidelines

Examiners must adhere to the following procedures when examining applications for compliance with 35 U.S.C. 101:

1. Determine what the applicant has claimed as his or her invention. This is done to:

   a. ensure that applicant has claimed statutory subject matter (e.g., a process, a machine, a composition or a manufacture); and

b. ascertain what the invention is for purposes of determining whether it is "useful".

2. Review the specification and claims to determine if the applicant has disclosed or asserted any credible utility for the claimed invention.

   a. If the applicant has asserted that the claimed invention is useful for any particular purpose and that assertion would be considered credible by a person of ordinary skill in the art, the examiner should not impose a rejection based on 35 U.S.C. 101. Credibility is to be assessed from the perspective of one of ordinary skill in the art in view of any evidence of record (e.g., data, statements, opinions, references, etc.) that is relevant to the applicant's assertions.

   b. If the applicant has not asserted that the claimed invention is useful for a particular purpose but such a use would be readily apparent to a person of ordinary skill in the art, the examiner should not impose a rejection under 35 U.S.C 101.

3. If the applicant has not asserted any credible utility for the claimed invention and a utility would not be readily apparent to one of ordinary skill in the art, the examiner should reject the claims under 35 U.S.C. 101. To be considered appropriate by the Office, a rejection under 35 U.S.C. 101 must include the following elements:

   a. A *prima facie* showing that the claimed invention has no utility. A *prima facie* showing of no utility must establish that it is more likely than not that a person of ordinary skill in the art would not consider credible any utility for the claimed invention that has been asserted by the applicant. Where no utility has been asserted in the disclosure, the *prima facie* showing must support a finding that a person of ordinary skill would not be able to ascertain any use for the claimed invention. A *prima facie* showing must contain:

      i. a well-reasoned statement by the examiner that clearly sets forth the reasoning used in reaching his or her conclusions;

      ii. support for factual findings relied upon by the examiner in reaching his or her conclusions; and

      iii. support for conclusions of the examiner that evidence provided by the applicant to support an asserted utility would not be considered persuasive to a person of ordinary skill in the art.

   b. Evidence that supports any factual assertions relied upon by the examiner in establishing the *prima facie* showing. Whenever possible, the examiner must provide documentary evidence that supports the factual basis of a *prima facie* showing of no utility (e.g., scientific or technical journals, excerpts from treatises or books or U.S. or foreign patents). If documentary evidence is not available, the examiner should note this fact and specifically explain the scientific basis for his or her conclusions.

4. A rejection under 35 U.S.C. 101 should not be maintained if an asserted utility for the claimed invention would be considered credible by a person of ordinary skill in the art in view of all evidence of record.

   Once a *prima facie* showing of no utility has been properly established, the applicant bears the burden of rebutting it. The applicant can do this by amending the claims, by providing reasoning or arguments or by providing evidence in the form of a declaration under 37 CFR 1.132 or a printed publication, that rebuts the *prima facie* showing. Once a response has been received by the examiner, he or she should review the original disclosure, any evidence relied on in establishing the *prima facie* showing, any claim amendments and any new reasoning or evidence provided by the applicant in support of an asserted utility. It is essential that the examiner recognize, fully consider and respond to each substantive element of any response to a rejection under 35 U.S.C. 101.

Examiners are reminded that they must treat as true credible statements made by an applicant or a declarant in the specification or in a declaration provided under 37 CFR 1.132, unless they can show that one of ordinary skill in the art would have a rational basis to doubt the truth of such statements. Thus, not accepting the opinion of a qualified expert that is based on an appropriate factual record would clearly be improper.

Drug Cases

The following two basic principles shall be followed in considering matters relating to the adequacy of disclosure of utility in drug cases:

(1) The same basic principles of patent law which apply in the field of chemical arts shall be applicable to drugs, and

(2) The Patent and Trademark Office shall confine its examination of disclosure of utility to the application of patent law principles, recognizing that other agencies of the Government have been assigned the responsibility of assuring conformance to the standards established by statute for the advertisement, use, sale or distribution of drugs; *In re Krimmel*, 292 F.2d 948, 130 USPQ 215 (CCPA 1961); *In re Hartop et al.*, 311 F.2d 249, 135 USPQ 419 (CCPA 1962).

A drug is defined by 21 U.S.C. 321(g).

> The term "drug" means (A) articles recognized in the official United States Pharmacopeia, official Homeopathic Pharmacopeia of the United States, or official National Formulary, or any supplement to any of them; and (B) articles intended for use in the diagnosis, cure, mitigation, treatment, or prevention of disease in man or other animals; and (C) articles (other than food) intended to affect the structure or any function of the body of man or other animals; and (D) articles intended for use as a component of any articles specified in clause (A), (B), or (C); but does not include devices or their components, parts, or accessories.

In addition, compositions adapted to be applied to or used by human beings; e.g., cosmetics, dentifrices, mouthwashes, etc., may be treated in the same manner as drugs subject to the conditions stated.

Overview of Legal Precedent Governing Utility Requirement

1. General Principles Governing Utility Rejections

The Office must examine each application to ensure compliance with the utility requirement of 35 U.S.C. 101. In discharging this obligation, however, examiners must keep in mind several general principles that control application of the utility requirement.

As interpreted by the Federal courts, the utility requirement has two purposes. First, 35 U.S.C. 101 defines which categories of inventions are eligible for patent protection. An invention that is not a machine, an article of manufacture, a composition or a process cannot be patented. See *Diamond v. Chakrabarty*, 447 U.S. 303, 206 USPQ 193 (1980); *Diamond v. Diehr*, 450 U.S. 175, 209 USPQ 1 (1981). Second, 35 U.S.C. 101 serves to ensure that patents are granted only on those inventions which are "useful". This second purpose has a Constitutional footing; Article I, Section 8 of the Constitution authorizes Congress to provide exclusive rights to inventors to promote the "useful arts." See *Carl Zeiss Stiftung v. Renishaw PLC*, 945 F.2d 1173, 20 USPQ2d 1094 (Fed. Cir. 1991). Thus, to satisfy the requirements of 35 U.S.C 101, an applicant must claim an invention that is statutory subject matter and must show that the claimed invention is "useful" for some purpose, either explicitly or implicitly. Application of this latter requirement is the focus of these guidelines.

a. "Real world value" requirement

To satisfy 35 U.S.C. 101, an invention must be "useful". The Court of Customs and Patent Appeals (CCPA) and other courts have used the term "practical utility" as one measure of this concept. As the court stated in *Nelson v. Bowler*:

> "Practical utility" is a shorthand way of attributing "real-world" value to claimed subject matter. In other words, one skilled in the art can use a claimed discovery in a manner which provides some immediate benefit to the public. *Nelson v. Bowler*, 626 F.2d 853, 856, 206 USPQ 881, 883 (CCPA 1980).

Examiners must be careful not to interpret the phrase "immediate benefit to the public" or similar formulations in other cases (*See, e.g., Brenner v. Manson*, 383 U.S. 519, 534–535, 148 USPQ 689, 695 (1966)) to mean that products or services based on the claimed invention must be "currently available" to the public in order to satisfy 35 U.S.C 101. Rather, the examiner should accept as sufficient any reasonable use that an applicant has identified for the invention that can be viewed as providing a public benefit.

b. Wholly inoperative inventions; "incredible" utility

An invention that is inoperative (e.g., the invention does not operate to produce the results claimed by the patent applicant) is not a "useful" invention in the meaning of the patent law. *See, e.g., Newman v. Quigg*, 877 F.2d 1575, 1581, 11 USPQ2d 1340, 1345 (Fed. Cir. 1989); *In re Harwood*, 390 F.2d 985, 989, 156 USPQ 673, 676 (CCPA 1968). However, as the Federal Circuit has stated, "[t]o violate § 101 the claimed device must be totally incapable of achieving a useful result." *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 24 USPQ2d 1401, 1412 (Fed. Cir. 1992). *See also, E.I. du Pont De Nemours and Co. v. Berkley and Co.*, 620 F.2d 1247, 1260 n.17, 205 USPQ 1, 10 n.17 (8th Cir. 1980). If an invention is only partially successful in achieving a useful result, a rejection of the claimed invention as a whole under 35 U.S.C. 101 is not appropriate. In such cases, a rejection under 35 U.S.C. 112 may be appropriate. *See In re Gardner*, 475 F.2d 1389, 177 USPQ 396 (CCPA 1973), *reh'g denied*, 480 F.2d 879 (CCPA 1973); *In re Marzocchi*, 439 F.2d 220, 169 USPQ 367 (CCPA 1971).

Cases decided by a federal court in which a claimed invention was held to lack utility under 35 U.S.C. 101 because it was "inoperative" have been rare. Uniformly, in these cases, the utility asserted by the applicant was "incredible in the light of

knowledge of the art, or factually misleading" when considered by the examiner. *In re Citron*, 325 F.2d 248, 253, 139 USPQ 516, 520 (CCPA 1963). Examples include: an inventionasserted to change the taste of food using a magnetic field (*Fregeau v. Mossinghoff*, 776 F.2d 1034, 227 USPQ 848 (Fed. Cir. 1985)), a perpetual motion machine (*Newman v. Quigg*, 877 F.2d at 1581, 11 USPQ2d at 1340), a method for increasing the energy output of fossil fuels upon combustion through exposure to a magnetic field (*In re Ruskin*, 354 F.2d 395, 148 USPQ 221 (CCPA 1966)), uncharacterized compositions for curing cancer (*In re Citron*, 325 F.2d 248, 139 USPQ 516 (CCPA 1963)) and a method of restoring hair growth (*In re Ferens*, 417 F.2d 1072, 139 USPQ 609 (CCPA 1969)). In view of the rare nature of such cases, examiners should not label an asserted utility "incredible" unless it is clearly appropriate to do so.

c. Therapeutic or Pharmacological Utility

Inventions asserted to have utility in the treatment of human or animal disorders are subject to the same legal requirements for utility as inventions in any other field of technology. *In re Chilowsky*, 229 F.2d 457, 461–462, 108 USPQ 321, 325 (CCPA 1956); *In re Gazave*, 379 F.2d 973, 978, 154 USPQ 92, 96 (CCPA 1967). As such, pharmacological or therapeutic inventions that provide any "immediate benefit to the public" satisfy 35 U.S.C. 101.

Courts have repeatedly found that the mere identification of a pharmacological activity of a compound relevant to an asserted pharmacological use provides an "immediate benefit to the public" and thus satisfies 35 U.S.C. 101. *Nelson v. Bowler*, 626 F.2d 853, 206 USPQ 881 (CCPA 1980); *In re Jolles*, 628 F.2d 1322, 206 USPQ 885 (CCPA 1980); *Cross v. Iizuka*, 753 F.2d 1040, 224 USPQ 739 (Fed. Cir. 1985).

Similarly, courts have found utility despite the fact that an application is at a very early stage in the development of a pharmaceutical product or therapeutic regimen based on a claimed pharmacological or bioactive compound or composition. *Cross v. Iizuka*, 753 F.2d 1040, 224 USPQ 739 (Fed. Cir. 1985). Accordingly, examiners should not construe 35 U.S.C. 101, under the logic of "practical" utility or otherwise, as requiring an applicant to demonstrate that a therapeutic agent based on a claimed invention is a safe or fully effective drug for humans. *See, e.g., In re Sichert*, 566 F.2d 1154, 196 USPQ 209 (CCPA 1977); *In re Hartop*, 311 F.2d 249, 135 USPQ 419 (CCPA 1962); *In re Anthony*, 414 F.2d 1383, 162 USPQ 594 (CCPA 1969); *In re Watson*, 517 F.2d 465, 186 USPQ 11 (CCPA 1975).

These general principles are equally applicable to situations where an applicant has claimed a process for treating a human or animal disorder. In such cases, the asserted utility is usually clear – the invention is asserted to be useful in treating the particular disorder. If the asserted utility is credible, there is no basis for an examiner to challenge such a claim on the grounds that it lacks utility under 35 U.S.C. 101.

2. Procedural Considerations Related to Utility Rejections

a. The claimed invention is the focus of the utility requirement.

As noted above, the claimed invention is the focus of the assessment of whether an applicant has satisfied the utility requirement of 35 U.S.C. 101. Statements made by the applicant in the specification or incident to prosecution of the application before the Office cannot, standing alone, be the basis for a rejection under 35 U.S.C. 101. *See, e.g., Raytheon v. Roper*, 724 F.2d 951, 958, 220 USPQ 592 (Fed. Cir. 1983), cert. denied, 469 U.S. 835 (1984); *Tol-O-Matic Inc. v. Proma Produkt-Und Mktg. Gesellschaft m.b.h.*, 945 F.2d 1546, 1553, 20 USPQ2d 1332, 1338 (Fed. Cir. 1991). Examiners should be especially careful not to read into a claim unclaimed results, limitations or embodiments of an invention. *See, e.g., In re Krimmel*, 292 F.2d 948, 130 USPQ 215 (CCPA 1961). Doing so can inappropriately change the relationship of an asserted utility to the claimed invention and raise issues not relevant to examination of that claim.

It is common for an applicant to identify several uses for an invention, particularly where the invention is a product (e.g., a machine, an article of manufacture or a composition of matter). However, irrespective of the category of invention (e.g., product or process), an applicant need only disclose one credible utility for the claimed invention to satisfy 35 U.S.C. 101. ,*See, e.g., In re Gottlieb*, 328 F.2d 1016, 1019, 140 USPQ 665, 668 (CCPA 1964). If one asserted utility is credible, utility for the claimed invention as a whole is established. *See, e.g., In re Gottlieb*, 328 F.2d 1016, 1019, 140 USPQ 665, 668 (CCPA 1964); *In re Malachowski*, 530 F.2d 1042, 189 USPQ 432 (CCPA 1976); *Hoffman v. Klaus*, 9 USPQ2d 1657 (Bd. Pat. App. & Inter. 1988).

b. Is there an asserted or readily apparent utility for the claimed invention?

After identifying what the claimed invention is, the examiner should review the specification to ascertain if there are any statements asserting that the claimed invention is useful for any particular purpose. A complete disclosure should include a statement which identifies a specific utility for the invention. Such statements can be detailed statements of why an invention is believed to be useful by the applicant. They can also take the form of more general assertions of useful applications of the invention.

Some degree of specificity is needed in identifying utility. For example, a statement that a composition has an unspecified "biological activity" without any explanation of why the composition with that activity would be considered useful should not be viewed as a specific assertion of utility. *In re Kirk*, 376 F.2d 936, 153 USPQ 48 (CCPA 1967); *In re Joly*, 376 F.2d 906, 153 USPQ 45 (CCPA 1967).

If the examiner cannot find any statements asserting utility for the claimed invention in the specification, he or she should then query whether a utility would be readily apparent to a person of ordinary skill from either the disclosure or from the characteristics of the invention. The result of this initial evaluation determines the next step for the examiner in the review for compliance with utility.

i. An asserted utility creates a presumption of utility.

An applicant's assertion of utility creates a presumption of utility that will be sufficient, in most cases, to satisfy the utility requirement of 35 U.S.C. 101. *See, e.g., In re Jolles*, 628 F.2d 1322, 206 USPQ 885 (CCPA 1980); *In re Irons*, 340 F.2d 974, 144 USPQ 351 (CCPA 1965); *In re Langer*, 503 F.2d 1380, 183 USPQ 288 (CCPA 1974); *In re Sichert*, 566 F.2d 1154, 1159, 196 USPQ 209, 212-213 (CCPA 1977). A specification which contains a disclosure of utility which corresponds in scope to the subject matter sought to be patented must be taken as sufficient to satisfy the utility requirement of 35 U.S.C. 101 for the entire claimed subject matter unless there is a reason for one skilled in the art to question the objective truth of the statement of utility or its scope. *In re Langer*, 503 F.2d 1380, 1391, 183 USPQ 288, 297 (CCPA 1974).

To overcome this presumption, the examiner must establish that it is more likely than not that one of ordinary skill in the art would doubt the truth of the statement of utility. The evidentiary standard used throughout *ex parte* examination is a preponderance of the evidence. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Corkill*, 771 F.2d 1496, 1500, 226 USPQ 1005, 1008 (Fed. Cir. 1985). A preponderance of the evidence exists when it suggests that it is more likely than not that the assertion in question is true. *Herman v. Huddleston*, 459 U.S. 375, 390 (1983). In other words, the examiner must show that the asserted utility is not credible.

ii. When is an asserted utility not "credible"?

Compliance with 35 U.S.C. 101 is a question of fact. *Raytheon v. Roper*, 724 F.2d at 956, 220 USPQ at 596. Where an applicant has specifically asserted an invention has a particular utility, that assertion cannot simply be dismissed by an examiner as being "wrong", even when the examiner may believe the assertion is not accurate beyond a reasonable doubt. Rather, the examiner must determine if the assertion of utility is credible. If it is, the examiner should not reject the claimed invention under 35 U.S.C. 101.

To assess credibility, the examiner should determine if one of ordinary skill in the art would consider the assertions of the applicant to have any reasonable scientific basis. If they do, they should not be challenged as not being credible. Only where they do not (e.g., if the assertion is "incredible in view of contemporary knowledge"), should the examiner challenge the statement as not being credible. In making credibility determinations, the examiner must consider the full record of evidence related to the asserted utility, including any data and reasoning provided by the applicant in the specification and any references cited by the applicant to support utility. The examiner must also consider information that is generally known in the art regarding the asserted utility.

In general, rejections under 35 U.S.C. 101 have been sustained by Federal courts only where the applicant asserted a utility that could only be true if it violated a scientific principle, such as the second law of thermodynamics, or a law of nature, or was wholly inconsistent with contemporary knowledge in the art. *In re Gazave*, 379 F.2d 973, 154 USPQ 92, 96 (CCPA 1967). The phrase "incredible utility" has come to be associated with such cases. "Incredible utility", however, is a conclusion, not a starting point for analysis under 35 U.S.C. 101. A conclusion that an asserted utility is "incredible" thus can be reached only after the examiner has evaluated both the assertions of the applicant regarding utility and any evidentiary basis for those assertions. An examiner should be particularly careful not to start with the presumption that an asserted utility is, per se, "incredible" and then proceed to base a rejection under 35 U.S.C. 101 on that presumption.

Special care should be taken when assessing the credibility of an asserted therapeutic utility for a claimed invention. In such cases, a previous lack of success in treating a disease or condition, or absence of a proven animal model for testing the effectiveness of drugs for treating a disorder in humans, should not, standing alone, serve as a basis for challenging the asserted utility under 35 U.S.C 101.

iii. No statement of utility for the claimed invention in the specification does not negate utility.

Occasionally, an applicant will not explicitly state in the specification or otherwise assert a specific utility for the claimed invention. In such cases, if a person of ordinary skill would recognize a utility for the claimed invention if provided with the specification at the time of its filing, no rejection under 35 U.S.C. 101 should be imposed. *In re Folkers*, 344 F.2d 970, 145 USPQ 390 (CCPA 1965). For example, if an applica-

tion teaches the cloning and characterization of the nucleotide sequence of a well-known protein such as insulin, and those skilled in the art at the time of filing knew that insulin had a well-established use, it would be improper to reject the claimed invention as lacking utility under 35 U.S.C. 101.

c. Initial burden is on the examiner to establish *prima facie* case and provide evidentiary support thereof.

To properly reject a claimed invention under 35 U.S.C. 101, the examiner must (a) make a *prima facie* showing that the claimed invention lacks utility, and (b) provide a sufficient evidentiary basis for factual assumptions relied upon in establishing the *prima facie* showing. *In re Gaubert*, 524 F.2d 1222, 1224, 187 USPQ 664, 666 (CCPA 1975). If the examiner cannot develop a proper *prima facie* case and provide evidentiary support for a rejection under 35 U.S.C. 101, a rejection on this ground should not be imposed. *See, e.g., In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *See also, Fregeau v. Mossinghoff*, 776 F.2d 1034, 227 USPQ 848 (Fed. Cir. 1985); *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984).

The *prima facie* showing must be set forth in a well-reasoned statement. In the statement, the examiner must articulate sound reasons why a person of ordinary skill in the art would conclude that it is more likely than not that an asserted utility is not credible or that one of ordinary skill in the art would not recognize utility for the claimed invention if unstated. The statement should specifically identify the scientific basis of the examiner's conclusions. The statement must also explain why any evidence of record that supports the asserted utility would not be persuasive to one of ordinary skill.

In addition to the statement setting forth the *prima facie* showing, the examiner must provide evidentiary support for the *prima facie* case. In most cases, the examiner can and should provide documentary evidence (e.g., articles in scientific journals or excerpts from patents or scientific treatises) that supports his or her factual conclusions. Only when documentary evidence is not readily available should the examiner attempt to satisfy the Office's requirement for evidentiary support for a factual basis of the *prima facie* showing solely through an explanation of relevant scientific principles.

It is imperative that examiners use specificity in setting forth an initial rejection under 35 U.S.C 101 and support their factual conclusions. For example, the examiner should explain why any *in vitro* or *in vivo* data supplied by the applicant would not be reasonably predictive of an asserted therapeutic utility from the perspective of a person of ordinary skill in the art. By using specificity, the examiner will enable the applicant to identify the assumptions made by the examiner in setting forth the rejection and will be able to address those assumptions properly.

d. Evidentiary requests by an examiner to support an asserted utility.

As the courts have recognized, in appropriate situations the Office may require an applicant to substantiate an asserted utility for a claimed invention. *See, e.g., In re Pottier*, 376 F.2d 328, 330, 153 USPQ 407, 408 (CCPA 1967); *In re Jolles*, 628 F.2d at 1327, 206 USPQ at 890; *In re Citron*, 325 F.2d 248, 139 USPQ 516 (CCPA 1963); *In re Novak*, 306 F.2d 924, 928, 134 USPQ 335, 337 (CCPA 1962). However, requests for additional evidence should be imposed rarely, and only if necessary to support the scientific credibility of the asserted utility (e.g., if the asserted utility is not consistent with the evidence of record and current scientific knowledge). As the court stated in *In re Isaacs*, "it is clearly improper for the examiner to make a demand for further test data, which as evidence would be essentially redundant and would seem to serve for nothing except perhaps to unduly burden the applicant." *In re Isaacs*, 347 F.2d 887, 890, 146 USPQ 193, 196 (CCPA 1965). Whenever possible, examiners should identify the nature of evidence which, if provided, would be persuasive in establishing the credibility of an asserted utility.

e. Consideration of a response to a *prima facie* rejection for lack of utility.

Once a *prima facie* showing of no utility has been properly established, the applicant bears the burden of rebutting it. *In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. The applicant can do this by amending the claims, by providing reasoning or arguments or by providing evidence in the form of a declaration under 37 CFR 1.132 or a printed publication, that rebuts the *prima facie* showing. New evidence provided by an applicant must be relevant to the issues raised in the rejection. For example, declarations in which conclusions are set forth without establishing a nexus between those conclusions and the supporting evidence, or which merely express opinions, may be of limited probative value with regard to rebutting a *prima facie* case. *In re Grunwell*, 609 F.2d 486, 203 USPQ 1055 (CCPA 1979); *In re Buchner*, 929 F.2d 660, 18 USPQ2d 1331 (Fed. Cir. 1991). Once a response has been received by the examiner, he or she should review the original disclosure, any evidence relied on in establishing the *prima facie* showing, any claim amendments and any new reasoning or evidence provided by the applicant in support of an asserted utility. If the record as a whole would make it more likely than not that the asserted utility for the claimed invention would be considered credible by a person of ordinary skill in the art, the examiner should not maintain the rejection. See *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). If the examiner con-

cludes otherwise, he or she should maintain the rejection under 35 U.S.C. 101. It is essential that the examiner recognize, fully consider and respond to each substantive element of any response to a rejection under 35 U.S.C. 101.

f. Evaluation of evidence related to utility.

There is no predetermined amount or character of evidence that must by provided by an applicant to support an asserted utility, therapeutic or otherwise. Rather, the character and amount of evidence needed to support an asserted utility will vary depending on what is claimed, *Ex parte Ferguson*, 117 USPQ 229 (Bd. App. 1957), and whether the asserted utility appears to contravene established scientific principles and beliefs. *In re Gazave*, 379 F.2d at 978, 154 USPQ at 96; *In re Chilowsky*, 229 F.2d at 462, 108 USPQ at 325. Furthermore, the applicant does not have to provide evidence sufficient to establish that an asserted utility is true "beyond a reasonable doubt". *In re Irons*, 340 F.2d at 978, 144 USPQ at 354. Nor must an applicant provide evidence such that it establishes an asserted utility as a matter of statistical certainty. *Nelson v. Bowler*, 626 F.2d 853, 856–857, 206 USPQ 881, 883–884 (CCPA 1980) (A rigorous correlation is not necessary when the test is reasonably predictive of the response). Instead, evidence will be sufficient if, considered as a whole, it leads a person of ordinary skill in the art to conclude that the asserted utility is more likely than not true.

3. Special considerations for asserted therapeutic or pharmacological utilities.

The Federal courts have consistently reversed rejections by the Office asserting a lack of utility under 35 U.S.C. 101 for inventions claiming a pharmacological or therapeutic utility where an applicant has provided evidence supporting such utility. In view of this, examiners should be particularly careful in their review of evidence provided in support of an asserted therapeutic or pharmacological utility.

a. A reasonable correlation between evidence and asserted utility is sufficient.

As a general matter, evidence of pharmacological or other biological activity of a compound will be relevant to an asserted therapeutic use if there is a reasonable correlation between the activity in question and the asserted utility. *Cross v. Iizuka*, 753 F.2d 1040, 224 USPQ 739 (Fed. Cir. 1985); *In re Jolles*, 628 F.2d 1322, 206 USPQ 885 (CCPA 1980); *Nelson v. Bowler*, 626 F.2d 853, 206 USPQ 881 (CCPA 1980). The applicant does not have to prove that there is a statistically proven correlation between characteristics of a compound and the asserted use; nor does the applicant have to provide actual evidence of success in treating humans where such a utility is asserted.

b. Structural similarity to useful products.

The courts have on several occasions found evidence of structural similarity to known compounds with particular therapeutic or pharmacological uses as supporting therapeutic utility of a newly claimed compound. *In re Jolles*, 628 F.2d 1322, 206 USPQ 885 (CCPA 1980). Such evidence, when provided by an applicant in support of an assertion of utility, should be given appropriate weight in determining whether one skilled in the art would find the asserted utility credible.

c. Data from *in vitro* and animal testing is generally sufficient to support therapeutic utility.

Data generated using *in vitro* assays and testing in animals almost invariably will be sufficient to support an asserted therapeutic or pharmacological utility. The CCPA has sustained rejections under 35 U.S.C. 101 for a claimed therapeutic utility in only two instances. *In re Citron*, 325 F.2d at 253, 139 USPQ at 520 (therapeutic utility for uncharacterized biological extract not supported or scientifically credible); *In re Buting*, 418 F.2d 540, 543, 163 USPQ 689, 690 (CCPA 1969) (confusing lack of enablement under 35 U.S.C. 112 for range of species claimed for lack of utility of claimed invention as a whole under 35 U.S.C. 101 because record did not establish a credible basis for the assertion that the single class of compounds in question would be useful in treating disparate types of cancers). In contrast, in the vast majority of cases where 35 U.S.C. 101 was the basis of a rejection, the courts have relied on a varying combination of data from *in vitro* and animal testing and from structural similarities to known compounds to find credible an asserted utility. *See, e.g., Cross v. Iizuka*, 753 F.2d 1040, 224 USPQ 739 (Fed. Cir. 1985); *In re Jolles*, 628 F.2d 1322, 206 USPQ 885 (CCPA 1980); *Nelson v. Bowler*, 626 F.2d 853, 856, 206 USPQ 881, 883 (CCPA 1980); *In re Gazave*, 379 F.2d 973, 154 USPQ 92 (CCPA 1967); *In re Hartop*, 311 F.2d 249, 135 USPQ 419 (CCPA 1962); *In re Krimmel*, 292 F.2d 948, 130 USPQ 215 (CCPA 1961). In no case has a Federal court required an applicant to support an asserted utility with data from human clinical trials.

If an applicant provides data from *in vitro* and animal tests to support an asserted utility, the examiner should determine if the tests, including the test parameters and choice of animal, would be viewed by one skilled in the art as being reasonably predictive of the asserted utility. *See, e.g., Ex parte Maas*, 9 USPQ2d 1746 (Bd. Pat. App. & Inter. 1987); *Ex parte Balzarini*, 21 USPQ2d 1892 (Bd. Pat. App. & Inter. 1991). If so, and the data supplied is consistent with the asserted utility, the examiner should not maintain the rejection under 35 U.S.C. 101. This approach is to be followed not only in cases where

there are art-recognized animal models for assessing utility in human disease and treatment, but also where no such validation of a specific test has been performed. Thus, if one skilled in the art would accept the animal tests as being reasonably predictive of utility in humans, they should be considered sufficient to support the credibility of the asserted utility. *See, e.g., In re Hartop*, 311 F.2d 249, 135 USPQ 419 (CCPA 1962); *In re Krimmel*, 292 F.2d 948, 130 USPQ 215 (CCPA 1961); *Ex parte Krepelka*, 231 USPQ 746 (Bd. Pat. App. & Inter. 1986). Examiners should be careful not to find evidence unpersuasive simply because no animal model for the human disease condition had been established prior to the filing of the application. *See, e.g., In re Chilowsky*, 229 F.2d at 461, 108 USPQ at 325; *In re Wooddy*, 331 F.2d 636, 639, 141 USPQ 518, 520 (CCPA 1964).

d. Human clinical data.

There is no decisional law that requires an applicant to provide data from human clinical trials to establish utility for an invention related to treatment of human disorders, even with respect to situations where no art-recognized animal models existed for the human disease encompassed by the claims. *Ex parte Balzarini*, 21 USPQ2d 1892 (Bd. Pat. App. & Inter. 1991) (Human clinical data is not required to demonstrate the utility of the claimed invention, even though those skilled in the art might not accept other evidence to establish the efficacy of the claimed therapeutic compositions and the operativeness of the claimed methods of treating humans). Examiners should not impose on applicants the unnecessary burden of providing evidence from human clinical trials. Examiners should note that before a drug can enter human clinical trials, the sponsor (e.g., often the applicant) must establish a sufficient basis to those especially skilled in the art (e.g., the Food and Drug Administration) that the drug will be effective to some degree in treating the stated disorder. Thus, as a general rule, if an applicant has initiated human clinical trials for a product or process used for treating an indication, the subject of that trial has met the burden of being reasonably predictive of utility.

e. Safety and efficacy considerations.

The examiner must confine his or her examination, for purposes of utility, to compliance with the statutory requirements of the patent law. Other agencies of the government have been assigned the responsibility of ensuring conformance to standards established by statute for the advertisement, use, sale or distribution of drugs. Thus, while an applicant may on occasion need to provide evidence to show that an invention will work as claimed, it is improper for an examiner to request evidence of safety in the treatment of humans, or regarding the degree of effectiveness. *See In re Sichert*, 566 F.2d 1154, 196 USPQ 209 (CCPA 1977); *In re Hartop*, 311 F.2d 249, 135 USPQ 419 (CCPA 1962); *In re Anthony*, 414 F.2d 1383, 162 USPQ 594 (CCPA 1969); *In re Watson*, 517 F.2d 465, 186 USPQ 11 (CCPA 1975); *In re* 292 F.2d 948, 130 USPQ 215 (CCPA 1961); *Ex parte Jovanovics*, 211 USPQ 907 (Bd. App. 1981).

f. Treatment of specific disease conditions.

Claims directed to a method of treating or curing a disease for which there have been no previously successful treatments or cures warrant careful review for compliance with 35 U.S.C. 101. The credibility of an asserted utility for treating a human disorder may be more difficult to establish where current scientific understanding suggests that such a task would be impossible. Such a determination has always required a good understanding of the state of the art at the time of the invention. *See, e.g., In re Jolles*, 628 F.2d 1322, 206 USPQ 885 (CCPA 1980); *In re Buting*, 418 F.2d 540, 163 USPQ 689 (CCPA 1969); *Ex parte Stevens*, 16 USPQ2d 1379 (Bd. Pat. App. & Inter. 1990); *Ex parte Busse*, 1 USPQ2d 1908 (Bd. Pat. App. & Inter. 1986); *Ex parte Krepelka*, 231 USPQ 746 (Bd. Pat. App. & Inter. 1986); *Ex parte Jovanovics*, 211 USPQ 907 (Bd. App. 1981). The mere fact that there is no known cure for a disease, however, should not serve as the basis of an examiner's conclusion that such an invention lacks utility. Rather, the examiner should only reject the claims under 35 U.S.C. 101 if he or she can establish a *prima facie* case that the asserted utility is not credible.

In such cases, the examiner should carefully review what is being claimed by the applicant. An assertion that the claimed invention is useful in treating a symptom of an incurable disease may be considered scientifically credible by a person of ordinary skill in the art on the basis of a fairly modest amount of evidence or support. In contrast, an assertion that the claimed invention will be useful in "curing" the disease may require a significantly greater amount of evidentiary support to be considered scientifically credible by a person of ordinary skill in the art. *In re Sichert*, 566 F.2d 1154, 196 USPQ 209 (CCPA 1977); *In re Jolles*, 628 F.2d 1322, 206 USPQ 885 (CCPA 1980). See also, *Ex parte Ferguson*, 117 USPQ 229 (Bd. App. 1957).

In these cases, it is important to note that the Food and Drug Administration has promulgated regulations that enable a party to conduct clinical trials for drugs used to treat life threatening and severely-debilitating illnesses, even where no alternative therapy exists. See 21 CFR §§ 312.80-88. Implicit in these regulations is the recognition that experts qualified to evaluate the effectiveness of therapeutics can and often do find a sufficient basis to conduct clinical trials of drugs for "incurable" or previously untreatable illnesses. Thus, affi-

davit evidence from experts in the art indicating that there is a rea-sonable expectation of success, supported by sound reasoning, should be sufficient to establish that such a utility is credible.

35 U.S.C. 112

A mere statement of utility for pharmacological or chemotherapeutic purposes may raise a question of compliance with 35 U.S.C. 112, particularly "... as to enable any person skilled in the art to which it pertains ... to use the same." If the statement of utility contains within it a connotation of how to use, and/or the art recognizes that standard modes of administration are contemplated, 35 U.S.C. 112 is satisfied (*In re Johnson*, 282 F.2d 370, 127 USPQ 216 (CCPA 1960); *In re Hitchings et al.*, 342 F.2d 80, 144 USPQ 637 (CCPA 1965)). If the use disclosed is of such nature that the art is unaware of successful treatments with chemically analogous compounds, a more complete statement of how to use must be supplied than if such analogy were not present (*In re Mourea et al.*, 145 USPQ 452 (CCPA 1965); *In re Schmidt et al.*, 153 USPQ 640 (CCPA 1967)). It is not necessary to specify the dosage or method of use if it is obvious to one skilled in the art that such information could be obtained without undue experimentation. For example, if one of ordinary skill, based on knowledge of compounds having similar physiological or biological activity would be able to discern without undue experimentation an appropriate dosage or method of use, this will be sufficient to satisfy 35 U.S.C. 112.

With respect to the adequacy of disclosure that a claimed genus possesses an asserted utility, representative examples together with a statement applicable to the genus as a whole will ordinarily be sufficient if it would be deemed likely by one skilled in the art, in view of contemporary knowledge in the art, that the claimed genus would possess the asserted utility (*In re Oppenauer*, 143 F.2d 974, 62 USPQ 297 (CCPA 1944); *In re Cavallito et al.*, 282 F.2d 357, 127 USPQ 202 (CCPA 1960); *In re Cavallito et al.*, 282 F.2d 363, 127 USPQ 206 (CCPA 1960); *In re Schmidt*, 293 F.2d 274, 130 USPQ 404 (CCPA 1961); *In re Cavallito*, 306 F.2d 505, 134 USPQ 370 (CCPA 1962); *In re Surrey*, 370 F.2d 349, 151 USPQ 724 (CCPA 1966); *In re Lund et al.*, 153 USPQ 625 (CCPA 1967); *In re Jolles*, 628 F.2d 1322, 206 USPQ 235 (CCPA 1980)). Proof of utility will be required for other members of the claimed genus only in those cases where adequate reasons can be advanced by the examiner that would establish that a person of ordinary skill would conclude that the genus as a whole does not possess the asserted utility. Conversely, a sufficient number of representative examples, if disclosed in the prior art will constitute a disclosure of the genus to which they belong.

In the case of mixtures including a drug as an ingredient, or mixtures which are drugs, or methods of treating a specific condition with a drug, whether old or new, a specific example should ordinarily be set forth, which should include the organism treated. In appropriate cases, such an example may be inferred from the disclosure taken as a whole and/or the knowledge in the art (e.g., gargle).

Where the claimed compounds are capable of several different utilities and one use is adequately described in accordance with these guidelines, additional utilities will be investigated for compliance with 35 U.S.C. 101 and 112 only if not believable on their face to those of ordinary skill in the art in view of the contemporary knowledge of the art. Normally, a requirement to cancel such additional utilities will not be made (*Ex parte Lanhan*, 121 USPQ 223 (Bd. App. 1958); *Ex parte Moore et al.*, 128 USPQ 8 (Bd App. 1960); *In re Citron*, 325 F.2d 248, 139 USPQ 516 (CCPA 1963); *In re Gottlieb et al.*, 328 F.2d 1016, 140 USPQ 665 (CCPA 1964), *In re Hozumi*, 226 USPQ 353 (Dir. Group 120, 1985)).

B. INCORPORATION BY REFERENCE

The Commissioner has considerable discretion in determining what may or may not be incorporated by reference in a patent application. *General Electric Co. v. Brenner*, 407 F.2d 1258, 159 USPQ 335 (D.C. Cir. 1968). The following is the manner in which the Commissioner has elected to exercise that discretion. Section 1 provides the guidance for incorporation by reference in applications which are to issue as U.S. patents. Section 2 provides guidance for incorporation by reference in benefit applications; i.e., those domestic (35 U.S.C. 120) or foreign (35 U.S.C. 119) applications relied on to establish an earlier effective filing date.

1. Review of Applications Which Are To Issue As Patents.

An application as filed must be complete in itself in order to comply with 35 U.S.C. 112. Material nevertheless may be incorporated by reference, *Ex parte Schwarze*, 151 USPQ 426 (Bd App. 1966). An application for a patent when filed may incorporate "essential material" by reference to (1) a U.S. patent or (2) an allowed U.S. application in which the issue fee has been paid, subject to the conditions set forth below. "Essential material" is defined as that which is necessary to (1) describe the claimed invention, (2) provide an enabling disclosure of the claimed invention, or (3) describe the best mode (35 U.S.C. 112). In any application which is to issue as a U.S. patent, essential material may not be incorporated by reference to (1) patents or applications published by foreign countries or a regional patent office, (2) non-patent publications, (3) a U.S.

patent or application which itself incorporates "essential material" by reference, or (4) a foreign application. See *In re Fouche*, 439 F.2d 1237, 169 USPQ 429 (CCPA 1971).

Nonessential subject matter may be incorporated by reference to (1) patents or applications published by the United States or foreign countries or regional patent offices, (2) prior filed, commonly owned U.S. applications, or (3) non-patent publications. Nonessential subject matter is subject matter referred to for purposes of indicating the background of the invention or illustrating the state of the art.

In addition to other requirements for an application, the referencing application should include an identification of the referenced patent, application, or publication. Particular attention should be directed to specific portions of the referenced document where the subject matter being incorporated may be found.

Complete Disclosure Filed

If an application is filed with a complete disclosure, essential material may be cancelled by amendment and may be substituted by reference to a U.S. patent or pending application in which the issue fee has been paid. The amendment must be accompanied by an affidavit or declaration signed by the applicant, or a practitioner representing the applicant, stating that the material cancelled from the application is the same material that has been incorporated by reference.

Issue Fee Paid

If an application incorporates essential material by reference to a U.S. patent or a pending and commonly owned allowed U.S. application for which the issue fee has been paid, applicant may be required prior to examination to furnish the Office with a copy of the referenced material together with an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the copy consists of the same material incorporated by reference in the referencing application. However, if a copy of a printed U.S. patent is furnished, no affidavit or declaration is required.

Issue Fee Not Paid

If an application incorporates essential material by reference to a pending and commonly owned application other than one in which the issue fee has been paid, applicant will be required to amend the disclosure of the referencing application to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating the amendatory material consists of the same material incorporated by reference in the referencing application.

Improper Incorporation

The filing date of any application wherein essential material is improperly incorporated by reference to a foreign application or patent or to a publication will not be affected because of the reference. In such a case, the applicant will be required to amend the specification to include the material incorporated by reference. The following form paragraphs may be used.

¶ *6.19 Incorporation by Reference, Foreign Patent or Application*

The incorporation of essential material by reference to a foreign application or foreign patent or to a publication inserted in the specification is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. *In re Hawkins*, 486 F. 2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F. 2d 579, 179 USPQ 163 (CCPA 1973); *In re Hawkins*, 486 F. 2d 577, 179 USPQ 167 (CCPA 1973).

¶ *6.19.1 Improper Incorporation by Reference*

The attempt to incorporate subject matter into this application by reference to [1] is improper because [2]

Examiner Note:

1. In bracket 1, identify the document such as serial or patent number or other identification.

2. In bracket 2, give reason why it is improper.

The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); *In re Hawkins*, 486 F.2d 577, 179 USPQ 167, (CCPA 1973).

Reliance on a commonly assigned copending application by a different inventor may ordinarily be made for the purpose of completing the disclosure. See *In re Fried*, 329 F.2d 323, 141 USPQ 27, (CCPA 1964), and *General Electric Co. v. Brenner*, 407 F.2d 1258, 159 USPQ 335 (D.C. Cir 1968).

Since a disclosure must be complete as of the filing date, subsequent publications or subsequently filed applications cannot be relied on to establish a constructive reduction to practice or an enabling disclosure as of the filing date. *In re Glass*, 492 F.2d 1228, 181 USPQ 31 (CCPA 1974); In *re Scarbrough*, 500 F.2d 560, 182 USPQ 298 (CCPA 1974); *White Consolidated Industries, Inc. v. Vega Servo-Control, Inc.*, 713 F.2d 788, 218 USPQ 961 (Fed. Cir. 1983).

2. Review of Applications Which Are Relied on To Establish an Earlier Effective Filing Date.

The limitations on the material which may be incorporated by reference in U.S. patent applications which are to

issue as U.S. patents do not apply to applications relied on only to establish an earlier effective filing date under 35 U.S.C. 119 or 35 U.S.C. 120. The reason for incorporation by reference practice with respect to applications which are to issue as U.S.patents is to provide the public with a patent disclosure which minimizes the public's burden to search for and obtain copies of documents incorporated by reference which may not be readily available. Through the Office's incorporation by reference policy, the Office ensures that reasonably complete disclosures are published as U.S. patents

The same policy concern does not apply where the sole purpose for which an applicant relies on an earlier U.S. or foreign application is to establish an earlier filing date. Incorporation by reference in the earlier application of (1) patents or applications published by foreign countries or regional patent offices, (2) nonpatent publications, (3) a U.S. patent or application which itself incorporates"essential material" by reference, or (4) a foreign application, is not critical in the case of a "benefit" application.

When an applicant, or a patent owner in a reexamination or interference, claims the benefit of the filing date of an earlier application which incorporates material by reference, the applicant or patent owner may be required to supply copies of the material incorporated by reference. For example, an applicant may claim the benefit of the filing date of a foreign application which itself incorporates by reference another earlier filed foreign application. If necessary, due to an intervening reference, applicant should be required to supply a copy of the earlier filed foreign application, along with an English language translation. A review can then be made of the foreign application and all material incorporated by reference to determine whether the foreign application discloses the invention sought to be patented in the manner required by the first paragraph of 35 U.S.C. 112 so that benefit may be accorded, *In re Gosteli*, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989).

C. SIMULATED OR PREDICTED TEST RESULTS OR PROPHETIC EXAMPLES

Simulated or predicted test results and prophetical examples (paper examples) are permitted in patent applications. Working examples correspond to work actually performed and may describe tests which have actually been conducted and results that were achieved. Paper examples describe the manner and process of making an embodiment of the invention which has not actually been conducted. Paper examples should not be represented as work actually done. No results should be represented as actual results unless they have actually been achieved. Paper examples should not be described using the past tense.

NOTE. For problems arising from the designation of materials by trademarks and trade names, see MPEP § 608.01(v).

608.01(q) Substitute or Rewritten Specification

37 CFR 1.125. Substitute specification.

If the number or nature of the amendments shall render it difficult to consider the case, or to arrange the papers for printing or copying, the examiner may require the entire specification, including the claims, or any part thereof, to be rewritten. A substitute specification may not be accepted unless it has been required by the examiner or unless it is clear to the examiner that acceptance of a substitute specification would facilitate processing of the application. Any substitute specification filed must be accompanied by a statement that the substitute specification includes no new matter. Such statement must be a verified statement if made by a person not registered to practice before the Office.

The specification is sometimes in such faulty English that a new specification is necessary; in such instances, a new specification should be required.

Form Paragraph 6.28 may be used in where the specification is in faulty English.

¶ *6.28 Idiomatic English*

A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52 (a and b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter. Such statement must be a verified statement if made by a person not registered to practice before the Office.

Form Paragraph 6.28.1 may be used to require a substitute specification for reasons other than faulty English.

¶ *6.28.1 Substitute Specification*

A substitute specification is required because [1]. The substitute specification filed must be accompanied by a statement that it contains no new matter. Such statement must be a verified statement if made by a person not registered to practice before the Office.

Examiner Note:

1.In bracket 1, insert clear and concise examples of why a new specification is required.

2.A new specification is required if the number or nature of the amendments render it difficult to consider the case or to arrange the papers for printing or copying, 37 CFR 1.125.

3.See also form paragraph 13.01 for partial rewritten specification.

Under current practice, substitute specifications may be voluntarily filed by the applicant if desired. A substitute specification will normally be accepted by the Office even if it has not been required by the examiner. Substitute specifications will be accepted if applicant submits therewith a marked-up copy which shows the portions of the original specification which are being added and deleted and a statement that the substitute specification includes no new matter and that the substitute specification includes the same changes as are indicated in the marked-up copy of the original specification

showing additions and deletions. Such statement must be a verified statement if made by a person not registered to practice before the Office. Additions should be clearly indicatedin the marked-up copy such as by underlining, and deletions should be indicated between brackets. Examiners may also require a substitute specification where it is considered to be necessary.

However, any substitute page of the specification, or entire specification, filed must be accompanied by a a statement indicating that no new matter was included. The statement must be verified if made by a person not registered to practice before the Office. There is no obligation on the examiner to make a detailed comparison between the old and the new specifications for determining whether or not new matter has been added. If, however, an examiner becomes aware that new matter is present, objection thereto should be made.

The filing of a substitute specification rather than amending the original application has the advantage for applicants of eliminating the need to prepare an amendment of the specification. If word processing equipment is used by applicants, substitute specifications can be easily prepared. The Office receives the advantage of saving the time needed to enter amendments in the specification and a reduction in the number of printing errors.

A substitute specification should normally be entered. See MPEP § 714.20.

New matter in amendment, see MPEP § 608.04.

Application prepared for issue, see MPEP § 1302.02.

608.01(r) Derogatory Remarks About Prior Art Specification

The applicant may refer to the general state of the art and the advance thereover made by his or her invention, but he or she is not permitted to make derogatory remarks concerning the inventions of others. Derogatory remarks are statements disparaging the products or processes of any particular person other than the applicant, or statements as to the merits or validity of applications or patents of another person. Mere comparison with the prior art are not considered to be disparaging, per se.

608.01(s) Restoration of Cancelled Matter

Cancelled text in the specification or a cancelled claim can be restored only by presenting the cancelled matter as a new insertion. See 37 CFR 1.124, MPEP § 714.24.

608.01(t) Use in Subsequent Application

A reservation for a future application of subject matter disclosed but not claimed in a pending application will not be permitted in the pending application, 37 CFR 1.79, MPEP § 608.01(e).

No part of a specification can normally be transferred to another application. Drawings may be transferred to another application only upon the granting of a petition filed under the provisions of 37 CFR 1.182.

608.01(u) Use of Formerly Filed Incomplete Application

Parts of an incomplete application which have been retained by the Office may be used as part of a complete application if the missing parts are later supplied. See MPEP § 506 and § 506.01.

608.01(v) Trademarks and Names Used in Trade

The expressions "trademarks" and "names used in trade" as used below have the following meanings:

Trademark: a word, letter, symbol, or device adopted by one manufacturer or merchant and used to identify and distinguish his or her product from those of others. It is a proprietary word pointing distinctly to the product of one producer.

Names Used in Trade: a nonproprietary name by which an article or product is known and called among traders or workers in the art, although it may not be so known by the public, generally. Names used in trade do not point to the product of one producer, but they identify a single article or product irrespective of producer.

Names used in trade are permissible in patent applications if:

(1) Their meanings are established by an accompanying definition which is sufficiently precise and definite to be made a part of a claim, or

(2) In this country, their meanings are well-known and satisfactorily defined in the literature.

Condition (1) or (2) must be met at the time of filing of the complete application.

TRADEMARKS

The relationship between a trademark and the product it identifies is sometimes indefinite, uncertain, and arbitrary. The formula or characteristics of the product may change from time to time and yet it may continue to be sold under the same trademark. In patent specifications, every element or ingredient of the product should be set forth in positive, exact, intelligible language, so that there will be no uncertainty as to what is meant. Arbitrary trademarks which are liable to mean different things at the pleasure of manufacturers do not constitute such language; *Ex Parte Kattwinkle,* 12 USPQ 11 (Bd. Apps. 1931).

However, if the product to which the trademark refers is, otherwise, set forth in such language that its identity is clear, the examiners are authorized to permit the use of the trademark if it is distinguished from common descriptive nouns by capitalization. If the trademark has a fixed and definite meaning, it constitutes sufficient identification unless some physical or chemical characteristic of the article or material is involved in the invention. In that event, as also in those cases where the trademark has no fixed and definite meaning, identification by scientific or other explanatory language is necessary; *In re Gebauer-Fuelnegg,* 50 USPQ 125 (CCPA 1941).

The matter of sufficiency of disclosure must be decided on an individual case-by-case basis, *In re Metcalfe and Lowe,* 161 USPQ 789; 869 O.G. 691 (CCPA 1969).

Where the identification of a trademark is introduced by amendment, it must be restricted to the characteristics of the product known at the time the application was filed to avoid any question of new matter.

If proper identification of the product sold under a trademark, or a product referred to only by a name used in trade, is omitted from the specification and such identification is deemed necessary under the principles set forth above, the examiner should hold the disclosure insufficient and reject on the ground of insufficient disclosure any claims based on the identification of the product merely by trademark or by the name used in trade. If the product cannot be otherwise defined, an amendment defining the process of its manufacture may be permitted. Such amendments must be supported by satisfactory showings establishing that the specific nature or process of manufacture of the product as set forth in the amendment was known at the time of filing of the application.

Although the use of trademarks having definite meanings is permissible in patent applications, the proprietary nature of the marks should be respected. Trademarks should be identified by capitalizing them and placing them between quotation marks. Every effort should be made to prevent their use in any manner which might adversely affect their validity as trademarks.

Form Paragraph 6.20 may be used.

¶ *6.20 Trademarks and Their Use.*

The use of the trademark [1] has been noted in this application. It should be capitalized and placed between quotation marks wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Examiner Note:

Capitalize the word in the bracket.

The examiner should not permit the use of language such as "the product X (a descriptive name) commonly known as Y (trademark)" since such language does not bring out the fact that the latter is a trademark. Language such as "the product X (a descriptive name) sold under the trademark Y" is permissible.

The use of a trademark in the title of an application should be avoided as well as the use of a trademark coupled with the word "type"; i.e., "Band-Aid type bandage."

The owner of a trademark may be identified in the specification.

Group directors should reply to all trademark misuse complaint letters and forward a copy to the editor of this manual.

See Appendix I for a partial listing of trademarks and the particular goods to which they apply.

INCLUSION OF COPYRIGHT OR MASK WORK NOTICE IN PATENTS

37 CFR 1.71 Detailed description ...

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(d) A copyright or mask work notice may be placed in a design or utility patent application adjacent to copyright and mask work material contained therein. The notice may appear at any appropriate portion of the patent application disclosure. For notices in drawings, see 1.84(s). The content of the notice must be limited to only those elements required by law. For example, "©1983 John Doe" (17 U.S.C. 401) and "*M* John Doe" (17 U.S.C. 909) would be properly limited and, under current statutes, legally sufficient notices of copyright and mask work, respectively. Inclusion of a copyright or mask work notice will be permitted only if the authorization language set forth in paragraph (e) of this section is included at the beginning (preferably as the first paragraph) of the specification.

(e) The authorization shall read as follows:

A portion of the disclosure of this patent document contains material which is subject to (copyright or mask work) protection. The (copyright or mask work) owner has no objection to the facsimile reproduction by anyone of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent file or records, but otherwise reserves all (copyright or mask work) rights whatsoever.

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37 CFR 1.84 Standards for drawings

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(5)(s) Copyright or Mask Work Notice. A copyright or mask work notice may appear in the drawing, but must be placed within the sight of the drawing immediately below the figure representing the copyright or mask work material and be limited to letters having a print size of .32 cm. to .64 cm. (1/8 to 1/4 inches) high. The content of the notice must be limited to only those elements provided for by law. For example, "©1983 John Doe" (17 U.S.C. 401) and "M* John Doe" (17 U.S.C. 909) would be properly limited and, under current statues, legally sufficient notices of copyright and mask work, respectively. Inclusion of a copyright or mask work notice will be permitted only if the authorization language set forth in § 1.71(e) is included at the beginning (preferably as the first paragraph) of the specification.

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The Patent and Trademark Office will permit the inclusion of a copyright or mask work notice in a design or utility patent application, and thereby any patent issuing therefrom,which discloses material on which copyright or mask work protection has previously been established, under the following conditions:

(1) The copyright or mask work notice must be placed adjacent to the copyright or mask work material. Therefore, the notice may appear at any appropriate portion of the patent application disclosure, including the drawing. However, if appearing in the drawing, the notice must comply with 37 CFR 1.84(s). If placed on a drawing in conformance with these provisions, the notice will not be objected to as extraneous matter under 37 CFR 1.84.

(2) The content of the notice must be limited to only those elements required by law. For example, "©1983 John Doe"(17 U.S.C. 401) and "M John Doe"(35 U.S.C. 909) would be properly limited, and under current statutes, legally sufficient notices of copyright and mask work respectively.

(3) Inclusion of a copyright or mask work notice will be permitted only if the following authorization in 37 CFR 1.71(e) is included at the beginning (preferably as the first paragraph) of the specification to be printed for the patent:

> A portion of the disclosure of this patent document contains material which is subject to [copyright or mask work] protection. The [copyright or mask work] owner has no objection to the facsimile reproduction by any one of the patent disclosure, as it appears in the Patent and Trademark Office patent files or records, but otherwise reserves all [copyright or mask work] rights whatsoever.

(4) Inclusion of a copyright or mask work notice after a Notice of Allowance has been mailed will be permitted only if the criteria of 37 CFR 1.312 have been satisfied.

The inclusion of a copyright or mask work notice in a design or utility patent application, and thereby any patent issuing therefrom, under the conditions set forth above will serve to protect the rights of the author/inventor, as well as the public, and will serve to promote the mission and goals of the Patent and Trademark Office. Therefore, the inclusion of a copyright or mask work notice which complies with these conditions will be permitted. However, any departure from these conditions may result in a refusal to permit the desired inclusion. If the authorization required under condition (3) above does not include the specific language "(t)he [copyright or mask work] owner has no objection to the facsimile reproduction by anyone of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent files or records,..." the notice will be objected to as improper by the examiner of the application. If the examiner maintains the objection upon reconsideration, a petition may be filed in accordance with 37 CFR 1.181.

608.02 Drawing

35 U.S.C. 113. Drawings.

The applicant shall furnish a drawing where necessary for the understanding of the subject matter to be patented. When the nature of such subject matter admits of illustration by a drawing and the applicant has not furnished such a drawing, the Commissioner may require its submission within a time period of not less than two months from the sending of a notice thereof. Drawings submitted after the filing date of the application may not be used (i) to overcome any insufficiency of the specification due to lack of an enabling disclosure or otherwise inadequate disclosure therein, or (ii) to supplement the original disclosure thereof for the purpose of interpretation of the scope of any claim.

37 CFR 1.81. Drawings required in patent application.

(a) The applicant for a patent is required to furnish a drawing of his or her invention where necessary for the understanding of the subject matter sought to be patented; this drawing , or a high quality copy thereof, must be filed with the application. Since corrections are the responsibility of the applicant, the original drawing(s) should be retained by the applicant for any necessary future correction.

(b) Drawings may include illustrations which facilitate an understanding of the invention (for example, flow sheets in cases of processes, and diagrammatic views).

(c) Whenever the nature of the subject matter sought to be patented admits of illustration by a drawing without its being necessary for the understanding of the subject matter and the applicant has not furnished such a drawing, the examiner will require its submission within a time period of not less than two months from the date of the sending of a notice thereof.

(d) Drawings submitted after the filing date of the application may not be used to overcome any insufficiency of the specification due to lack of an enabling disclosure or otherwise inadequate disclosure therein, or to supplement the original disclosure thereof for the purpose of interpretation of the scope of any claim.

37 CFR 1.84. Standards for drawings.

(a) Drawings. There are two acceptable categories for presenting drawings in utility patent applications:

(1) Black ink. Black and white drawings are normally required. India ink, or its equivalent that secures solid black lines, must be used for drawings, or

(2) Color. On rare occasions, color drawings may be necessary as the only practical medium by which to disclose the subject matter sought to be patented in a utility patent application or the subject matter of a statutory invention registration. The Patent and Trademark Office will accept color drawings in utility patent applications and statutory invention registrations only after granting a petition filed under this paragraph explaining why the color drawings are necessary. Any such petition must include the following:

(i) The appropriate fee set forth in § 1.17(h);

(ii) Three (3) sets of color drawings; and

(iii) The specification must contain the following language as the first paragraph in that portion of the specification relating to the brief description of the drawing:

"The file of this patent contains at least one drawing executed in color. Copies of this patent with color drawing(s) will be provided by the Patent and Trademark Office upon request and payment of the necessary fee."

If the language is not in the specification, a proposed amendment to insert the language must accompany the petition.

(b Photographs.

(1) Black and white. Photographs are not ordinarily permitted in utility and design patent applications. However, the Office will accept photographs in utility and design patent applications only after granting a petition filed under this paragraph which requests that photographs be accepted. Any such petition must include the following:

(i) The appropriate fee set forth in § 1.17(h); and

(ii) Three (3) sets of photographs.

Photographs must either be developed on double weight photographic paper or be permanently mounted on bristol board. The photographs must be of sufficient quality so that all details in the drawing are reproducible in the printed patent.

(2) Color. Color photographs will be accepted in utility patent applications if the conditions for accepting color drawings have been satisfied. See paragraph (a)(2) of this section.

(c) Identification of drawings. Identifying indicia, if provided, should include the application number or the title of the invention, inventor's name, docket number (if any), and the name and telephone number of a person to call if the Office is unable to match the drawings to the proper application. This information should be placed on the back of each sheet of drawings a minimum distance of 1.5 cm. (5/8 inch) down from the top of the page.

(d) Graphic forms in drawings. Chemical or mathematical formulae, tables, and waveforms may be submitted as drawings and are subject to the same requirements as drawings. Each chemical or mathematical formula must be labeled as a separate figure, using brackets when necessary, to show that information is properly integrated. Each group of waveforms must be presented as a single figure, using a common vertical axis with time extending along the horizontal axis. Each individual waveform discussed in the specification must be identified with a separate letter designation adjacent to the vertical axis.

(e) Type of paper. Drawings submitted to the Office must be made on paper which is flexible, strong, white, smooth, nonshiny, and durable. All sheets must be free from cracks, creases, and folds. Only one side of the sheet shall be used for the drawing. Each sheet must be reasonably free from erasures and must be free from alterations, overwritings, and interlineations. Photographs must either be developed on double weight photographic paper or be permanently mounted on bristol board. See paragraph (b) of this section for other requirements for photographs.

(f) Size of paper. All drawing sheets in an application must be the same size. One of the shorter sides of the sheet is regarded as its top. The size of the sheets on which drawings are made must be:

(1) 21.6 cm. by 35.6 cm. (8 1/2 by 14 inches),

(2) 21.6 cm. by 33.1 cm. (8 1/2 by 13 inches),

(3) 21.6 cm. by 27.9 cm. (8 1/2 by 11 inches), or

(4) 21.0 cm. by 29.7 cm. (DIN size A4).

(g) Margins. The sheets must not contain frames around the sight; i.e., the usable surface. The following margins are required:

(1) On 21.6 cm. by 35.6 cm. (8 1/2 by 14 inch) drawing sheets, each sheet must include a top margin of 5.1 cm. (2 inches), and bottom and side margins of .64 cm. (1/4 inch) from the edges, thereby leaving a sight no greater than 20.3 cm. by 29.8 cm. (8 by 11 3/4 inches).

(2) On 21.6 cm. by 33.1 cm. (8 1/2 by 13 inch) drawing sheets, each sheet must include a top margin of 2.5 cm. (1 inch) and bottom and side margins of .64 cm. (1/4 inch) from the edges, thereby leaving a sight no greater than 20.3 cm. by 29.8 cm. (8 by 11 3/4 inches).

(3) On 21.6 cm. by 27.9 cm. (8 1/2 by 11 inch) draw- ing sheets, each sheet must include a top margin of 2.5 cm. (1 inch) and bottom and side margins of .64 cm. (1/4 inch) from the edges, thereby leaving a sight no greater than 20.3 cm. by 24.8 cm. (8 by 9 3/4 inches).

(4) On 21.0 cm. by 29.7 cm. (DIN size A4) drawing sheets, each sheet must include a top margin of at least 2.5 cm., a left side margin of 2.5 cm., a right side margin of 1.5 cm., and a bottom margin of 1.0 cm., thereby leaving a sight no greater than 17.0 cm. by 26.2 cm.

(h) Views. The drawing must contain as many views as necessary to show the invention. The views may be plan, elevation, section, or perspective views. Detail views of portions of elements, on a larger scale if necessary, may also be used. All views of the drawing must be grouped together and arranged on the sheet(s) without wasting space, preferably in an upright position, clearly separated from one another, and must not be included in the sheets containing the specifications, claims, or abstract. Views must not be connected by projection lines and must not contain center lines. Waveforms of electrical signals may be connected by dashed lines to show the relative timing of the waveforms.

(1) Exploded views. Exploded views, with the separated parts embraced by a bracket, to show the relationship or order of assembly of various parts are permissible. When an exploded view is shown in a figure which is on the same sheet as another figure, the exploded view should be placed in brackets.

(2) Partial views. When necessary, a view of a large machine or device in its entirety may be broken into partial views on a single sheet, or extended over several sheets if there is no loss in facility of understanding the view. Partial views drawn on separate sheets must always be capable of being linked edge to edge so that no partial view contains parts of another partial view. A smaller scale view should be included showing the whole formed by the partial views and indicating the positions of the parts shown. When a portion of a view is enlarged for magnification purposes, the view and the enlarged view must each be labeled as separate views.

(i) Where views on two or more sheets form, in effect, a single complete view, the views on the several sheets must be so arranged that the complete figure can be assembled without concealing any part of any of the views appearing on the various sheets.

(ii) A very long view may be divided into several parts placed one above the other on a single sheet. However, the relationship between the different parts must be clear and unambiguous.

(3) Sectional views. The plane upon which a sectional view is taken should be indicated on the view from which the section is cut by a broken line. The ends of the broken line should be designated by Arabic or Roman numerals corresponding to the view number of the sectional view, and should have arrows to indicate the direction of sight. Hatching must be used to indicate section portions of an object, and must be made by regularly spaced oblique parallel lines spaced sufficiently apart to enable the lines to be distinguished without difficulty. Hatching should not impede the clear reading of the reference characters and lead lines. If it is not possible to place reference characters outside the hatched area, the hatching may be broken off wherever reference characters are inserted. Hatching must be at a substantial angle to the surrounding axes or principal lines, preferably 45°. A cross section must be set out and drawn to show all of the materials as they are shown in the view from which the cross section was taken. The parts in cross section must show proper material(s) by hatching with regularly spaced parallel oblique strokes, the space between strokes being chosen on the basis of the total area to be hatched. The various parts of a cross section of the same item should be hatched in the same manner and should accurately and graphically indicate the nature of the material(s) that is illustrated in cross section. The hatching of juxtaposed different elements must be angled in a different way. In the case of large areas, hatching may be confined to an edging drawn around the entire inside of the outline of the area to be hatched. Different types of hatching should have different conventional meanings as regards the nature of a material seen in cross section.

(4) Alternate position. A moved position may be shown by a broken line superimposed upon a suitable view if this can be done without crowding; otherwise, a separate view must be used for this purpose.

(5) Modified forms. Modified forms of construction must be shown in separate views.

(i) Arrangement of views. One view must not be placed upon another or within the outline of another. All views on the same sheet should stand in the same direction and, if possible, stand so that they can be read with the sheet held in an upright position. If views wider than the width of the sheet are necessary for the clearest illustration of the invention, the sheet may be turned on its side so that the top of the sheet, with the appropriate top margin to be used as the heading space, is on the right- hand side. Words must appear in a horizontal, left-to-right fashion when the page is either upright or turned so that the top becomes the right side, except for graphs utilizing standard scientific convention to denote the axis of abscissas (of X) and the axis of ordinates (of Y).

(j) View for *Official Gazette*. One of the views should be suitable for publication in the *Official Gazette* as the illustration of the invention.

(k) Scale.

(1) The scale to which a drawing is made must be large enough to show the mechanism without crowding when the drawing is reduced in size to two-thirds in reproduction. Views of portions of the mechanism on a larger scale should be used when necessary to show details clearly. Two or more sheets may be used if one does not give sufficient room. The number of sheets should be kept to a minimum.

(2) When approved by the examiner, the scale of the drawing may be graphically represented. Indications such as "actual size" or "scale 1/2" on the drawings, are not permitted, since these lose their meaning with reproduction in a different format.

(3) Elements of the same view must be in proportion to each other, unless a difference in proportion is indispensable for the clarity of the view. Instead of showing elements in different proportion, a supplementary view may be added giving a larger-scale illustration of the element of the initial view. The enlarged element shown in the second view should be surrounded by a finely drawn or "dot-dash" circle in the first view indicating its location without obscuring the view.

(l) Character of lines, numbers, and letters. All drawings must be made by a process which will give them satisfactory reproduction characteristics. Every line, number, and letter must be durable, clean, black (except for color drawings), sufficiently dense and dark, and uniformly thick and well-defined. The weight of all lines and letters must be heavy enough to permit adequate reproduction. This requirement applies to all lines however fine, to shading, and to lines representing cut surfaces in sectional views. Lines and strokes of different thicknesses may be used in the same drawing where different thicknesses have a different meaning.

(m) Shading. The use of shading in views is encouraged if it aids in understanding the invention and if it does not reduce legibility. Shading is used to indicate the surface or shape of spherical, cylindrical, and conical elements of an object. Flat parts may also be lightly shaded. Such shading is preferred in the case of parts shown in perspective, but not for cross sections. See paragraph (h)(3) of this section. Spaced lines for shading are preferred. These lines must be thin, as few in number as practicable, and they must contrast with the rest of the drawings. As a substitute for shading, heavy lines on the shade side of objects can be used except where they superimpose on each other or obscure reference characters. Light should come from the upper left corner at an angle of 45°. Surface delineations should preferably be shown by proper shading. Solid black shading areas are not permitted, except when used to represent bar graphs or color.

(n) Symbols. Graphical drawing symbols may be used for conventional elements when appropriate. The elements for which such symbols and labeled representations are used must be adequately identified in the specification. Known devices should be illustrated by symbols which have a universally recognized conventional meaning and are generally accepted in the art. Other symbols which are not universally recognized may be used, subject to approval by the Office, if they are not likely to be confused with existing conventional symbols, and if they are readily identifiable.

(o) Legends. Suitable descriptive legends may be used, or may be required by the Examiner, where necessary for understanding of the drawing, subject to approval by the Office. They should contain as few words as possible.

(p) Numbers, letters, and reference characters.

(1) Reference characters (numerals are preferred), sheet numbers, and view numbers must be plain and legible, and must not be used in association with brackets or inverted commas, or enclosed within outlines, e.g., encircled. They must be oriented in the same direction as the view so as to avoid having to rotate the sheet. Reference characters should be arranged to follow the profile of the object depicted.

(2) The English alphabet must be used for letters, except where another alphabet is customarily used, such as the Greek alphabet to indicate angles, wavelengths, and mathematical formulas.

(3) Numbers, letters, and reference characters must measure at least .32 cm. (1/8 inch) in height. They should not be placed in the drawing so as to interfere with its comprehension. Therefore, they should not cross or mingle with the lines. They should not be placed upon hatched or shaded surfaces. When necessary, such as indicating a surface or cross section, a reference character may be underlined and a blank space may be left in the hatching or shading where the character occurs so that it appears distinct.

(4) The same part of an invention appearing in more than one view of the drawing must always be designated by the same reference character, and the same reference character must never be used to designate different parts.

(5) Reference characters not mentioned in the description shall not appear in the drawings. Reference characters mentioned in the description must appear in the drawings.

(q) Lead lines. Lead lines are those lines between the reference characters and the details referred to. Such lines may be straight or curved and should be as short as possible. They must originate in the immediate proximity of the reference character and extend to the feature indicated. Lead lines must not cross each other. Lead lines are required for each reference character except for those which indicate the surface or cross section on which they are placed. Such a reference character must be underlined to make it clear that a lead line has not been left out by mistake. Lead lines must be executed in the same way as lines in the drawing. See paragraph (l) of this section.

(r) Arrows. Arrows may be used at the ends of lines, provided that their meaning is clear, as follows:

(1) On a lead line, a freestanding arrow to indicate the entire section towards which it points;

(2) On a lead line, an arrow touching a line to indicate the surface shown by the line looking along the direction of the arrow; or

(3) To show the direction of movement.

(s) Copyright or Mask Work Notice. A copyright or mask work notice may appear in the drawing, but must be placed within the sight of the drawing immediately below the figure representing the copyright or mask work material and be limited to letters having a print size of .32 cm. to .64 cm. (1/8 to 1/4 inches) high. The content of the notice must be limited to only those elements provided for by law. For example, " ©1983 John Doe" (17 U.S.C. 401) and "*M* John Doe" (17 U.S.C. 909) would be properly limited and, under current statutes, legally sufficient notices of copyright and mask work, respectively. Inclusion of a copyright or mask work notice will be permitted only if the authorization language set forth in § 1.71(e) is included at the beginning (preferably as the first paragraph) of the specification.

(t) Numbering of sheets of drawings. The sheets of drawings should be numbered in consecutive Arabic numerals, starting with 1, within the sight as defined in paragraph (g) of this section. These numbers, if present, must be placed in the middle of the top of the sheet, but not in the margin. The numbers can be placed on the right-hand side if the drawing extends too close to the middle of the top edge of the usable surface. The drawing sheet

numbering must be clear and larger than the numbers used as reference characters to avoid confusion. The number of each sheet should be shown by two Arabic numerals placed on either side of an oblique line, with the first being the sheet number and the second being the total number of sheets of drawings, with no other marking.

(u) Numbering of views.

(1) The different views must be numbered in consecutive Arabic numerals, starting with 1, independent of the numbering of the sheets and, if possible, in the order in which they appear on the drawing sheet(s). Partial views intended to form one complete view, on one or several sheets, must be identified by the same number followed by a capital letter. View numbers must be preceded by the abbreviation "FIG." Where only a single view is used in an application to illustrate the claimed invention, it must not be numbered and the abbreviation "FIG." must not appear.

(2) Numbers and letters identifying the views must be simple and clear and must not be used in association with brackets, circles, or inverted commas. The view numbers must be larger than the numbers used for reference characters.

(v) Security markings. Authorized security markings may be placed on the drawings provided they are outside the sight, preferably centered in the top margin.

(w) Corrections. Any corrections on drawings submitted to the Office must be durable and permanent.

(x) Holes. The drawing sheets may be provided with two holes in the top margin. The holes should be equally spaced from the respective side edges, and their center lines should be spaced 7.0 cm. (2 3/4 inches) apart. (See § 1.152 for design drawings, § 1.165 for plant drawings, and § 1.174 for reissue drawings.)

Drawings in compliance with 37 CFR 1.84 prior to its revision will be acceptable and in compliance with 37 CFR 1.84, as revised, effective Oct. 1, 1993.

Drawings on paper are acceptable although bristol board is preferred. Corrections thereto must be made in the form of replacement sheets since the Office does not release drawings for correction. See 37 CFR 1.85.

Good quality copies made on office copiers are acceptable if the lines are uniformly thick, black, and solid. Facsimile copies of drawings however, are not acceptable (37 CFR 1.6(d)(4)).

Drawings are currently accepted in four different size formats. It is, however, required that all drawings in a particular application be the same size for ease of handling and reproduction.

Design patent drawings, 37 CFR 1.152, MPEP § 1503.02.

Plant patent drawings, 37 CFR 1.165, MPEP § 1606.

Reissue application drawings, MPEP § 608.02(k) and § 1413.

Correction of drawings, MPEP § 608.02(p). Prints, preparation and distribution, MPEP § 508 and § 608.02(m). Prints, return of drawings, MPEP § 608.02(y).

For pencil notations of classification and name or initials of assistant examiner to be placed on drawings, see MPEP § 717.03.

The filing of a divisional or continuation case under the provisions of 37 CFR 1.60 (unexecuted case) does not obviate the need for formal drawings. See MPEP § 608.02(b).

DEFINITIONS

A number of different terms are used when referring to drawings in patent applications. The following definitions are used in this Manual.

Original drawings: The drawing submitted with the application when filed. It may be either a formal or an informal drawing.

Substitute drawing: A drawing filed later than the filing date of an application. Usually submitted to replace an original informal drawing.

Formal drawing: A drawing in a form that complies with 37 CFR 1.84. Formal drawings are stamped "approved" by the Draftsman.

Informal drawing: A drawing which does not comply with the form requirements of 37 CFR 1.84. Drawings may be informal because they are not on the proper size sheets, the quality of the lines is poor, or for other reasons such as the size of reference elements. Such objections are made by the Draftsman on form PTO-948.

Drawing print: This term is used for the white paper print prepared by the Micrographics Branch of the Office Services Divisions of all original drawings. The drawing prints contain the notation Print of Drawing as originally filed near the top. Drawing prints should be placed on the top on the right-hand flap of the application file wrapper.

Interference print: This term is used to designate the copy prepared of the original drawings filed in file cabinets separate from the file wrappers and are used to make interference searches.

The following Form Paragraphs should be used when notifying applicants of drawing corrections.

¶ *6.38 Acknowledgment of Proposed Drawing Correction*

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on [1] have been [2].

Examiner Note:

1. In bracket 2, insert either approved or disapproved.
2. If approved, either form paragraph 6.39 and 6.40 or 6.41 or 6.44 must follow.
3 If disapproved, an explanation must be provided.

¶ *6.39 PTO No Longer Makes Drawing Changes*

The Patent and Trademark Office no longer makes drawing changes. 1017 OG 4. It is applicant's responsibility to ensure that the drawings are corrected. Corrections must be made in accordance with the instructions below.

Examiner Note:

This paragraph is to be used whenever the applicant has filed a request for the Office to make drawing changes. Form paragraph 6.40 must follow.

6.40 Information on How To Effect Drawing Changes

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities — 37 C.F.R. § 1.85; 1097 OG 36

IN APPLICATIONS FILED **BEFORE** JANUARY 1, **1989** OPTION (a) OR (b) MAY BE USED IN ORDER TO CORRECT ANY INFORMALITY IN THE DRAWING.

IN APPLICATIONS FILED **AFTER** JANUARY 1, **1989** ONLY OPTION (a) **MAY BE USED AFTER** JANUARY 1, **1991** ONLY OPTION (a) MAY BE USED REGARDLESS OF FILING DATE.

(a) File new drawings with the changes incorporated therein. The art unit number, serial number and number of drawing sheets should be written on the reverse side of the drawings. Applicant may delay filing of the new drawings until receipt of the "Notice of Allowability" (PTOL-37). If delayed, the new drawing **MUST** be filed within the **THREE MONTH** shortened statutory period set for response in the "Notice of Allowability" (PTOL-37). Extensions of time may be obtained under the provisions of 37 C.F.R. §1.136(a). The drawing should be filed as a separate paper with a transmittal letter addressed to the Official Draftsman.

(b) Request a commercial bonded drafting firm to make the necessary corrections. A bonded draftsman must be authorized, the corrections executed and the corrected drawings returned to the Office during the **THREE MONTH** shortened statutory period set for response in the "Notice of Allowability" (PTOL-37). Extensions of time may be obtained under the provisions of 37 C.F.R. §1.136(a).

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the three month shortened statutory period set in the "Notice of Allowability" (PTOL-37). Within that three month period, two weeks should be allowed for review by the Office of the correction. If a correction is determined to be unacceptable by the Office, applicant must arrange to have an acceptable correction re-submitted within the original three month period to avoid the necessity of obtaining an extension of time and of paying the extension fee. Therefore, applicant should file corrected drawings as soon as possible.

Failure to take corrective action within the set (or extended) period will result in **ABANDONMENT** of the application.

2. Corrections other than Informalities Noted by Draftsman on the PTO-948.

All changes to the drawings, other than informalities noted by the Draftsman, **MUST** be made in the same manner as above except that, normally, a red ink sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

¶ *6.41 Reminder That PTO No Longer Makes Drawing Changes*

Applicant is reminded that the Patent and Trademark Office no longer makes drawing changes and that it is applicant's responsibility to ensure that the drawings are corrected in accordance with the instructions set forth in paper no. [1], mailed on [2].

Examiner Note:

This paragraph is to be used when the applicant has been previously provided with information on how to effect drawing changes (i.e., either by way of form paragraph 6.40 or a PTO-1474 has been previously sent).

¶ *6.42 Reminder That Applicant Must Make Drawing Changes*

Applicant is reminded that in order to avoid an abandonment of this application, the drawings must be corrected in accordance with the instructions set forth in paper no. [1] mailed on [2].

Examiner Note:

This paragraph is to be used when allowing the application and when applicant has previously been provided with information on how to effect drawing changes (i.e., by way of form paragraph 6.40 or a PTO- 1474 has been previously sent).

¶ *6.43 Drawings Contain Informalities, Application Allowed*

The drawings filed on [1] are acceptable subject to correction of the informalities indicated on the attached Notice re Drawings, PTO-948. In order to avoid abandonment of this application, correction is required.

Examiner Note:

Use this paragraph when allowing the case, particularly at time of first action issue. Form paragraph 6.40 or 6.41 must follow.

¶ *6.44 Drawing Informalities Previously Indicated*

In order to avoid abandonment, the drawing informalities noted in paper no. [1], mailed on [2], must now be corrected. Correction can only be effected in the manner set forth in the above noted paper.

Examiner Note:

Use this paragraph when allowing the case and applicant has previously been informed of informalities in the the drawings.

¶ *6.47 Examiner's Amendment Involving Drawing Changes*

The following changes to the drawings have been approved by the Examiner and agreed upon by applicant: [1]. In order to avoid abandonment of the application, applicant must make the above agreed upon drawing changes.

Examiner Note:

1. In bracket 1, Insert the agreed upon drawing changes.
2. Form paragraphs 6.39 and 6.40 must follow.

DRAWING SYMBOLS

37 CFR 1.84(n) indicates that graphic drawing symbols and other labeled representations may be used for conventional elements where appropriate, subject to approval by the Office. Also, suitable legends may be used, or may be required, in proper cases.

The publications listed below have been reviewed by the Office and the symbols therein are considered to be generally acceptable in patent drawings. Although the Office will not "approve" all of the listed symbols as a group because their use and clarity must be decided on a case-by-case basis, these publications may be used as guides when selecting graphic symbols. Overly specific symbols should be avoided. Symbols with unclear meanings should be labeled for clarification.

These publications are available from the American National Standards Institute Inc., 11 West 42nd Street, New York, New York 10036.

608.02

The publications reviewed are the following:

Y32.2–1970 Graphic Symbols for Electrical & Electronics Diagrams

Y32.10–1967 Graphic Symbols for Fluid Power Diagrams

Y32.11–1961 Graphic Symbols for Process Flow Diagrams in the Petroleum & Chemical Industries

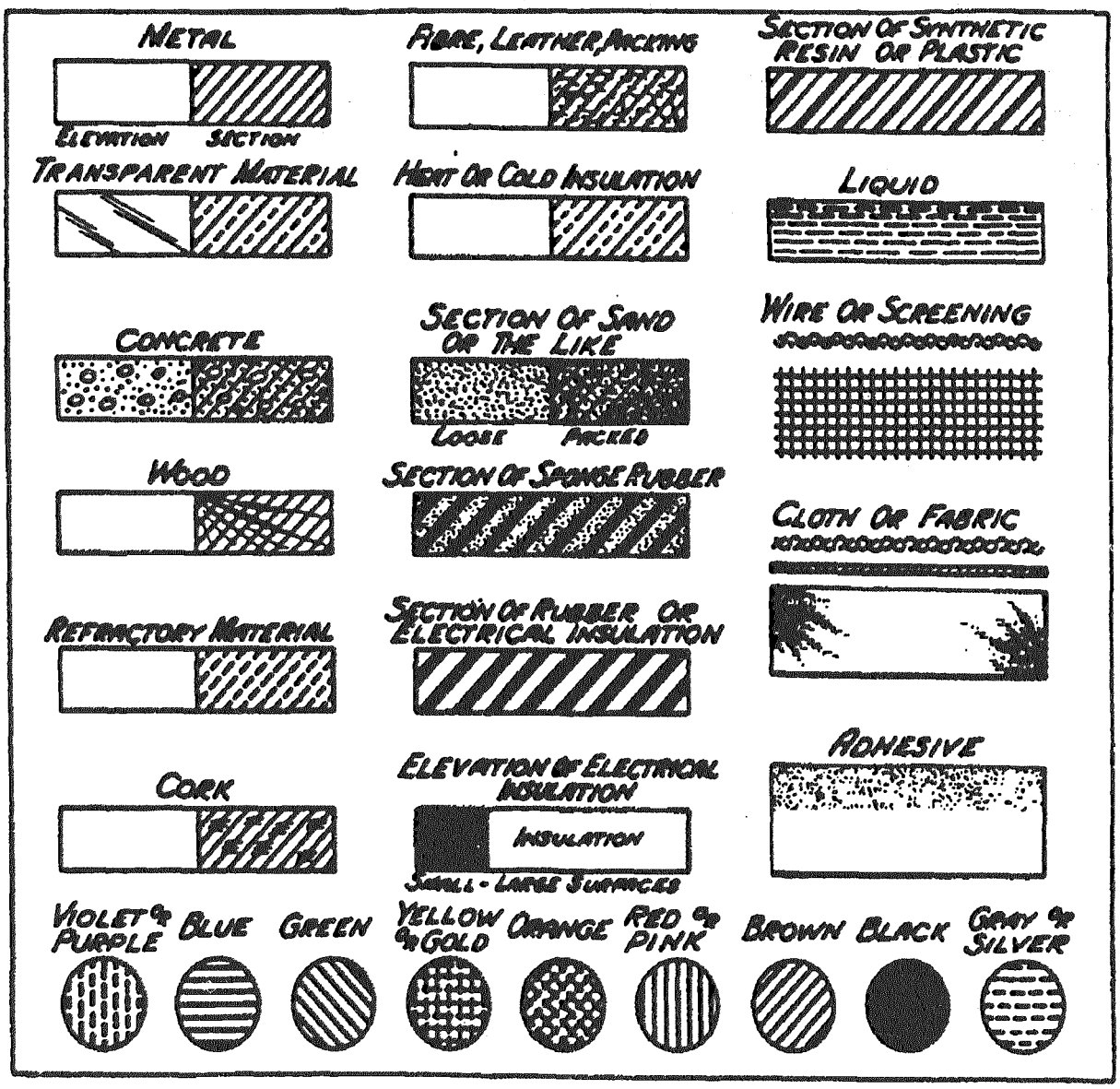
Y32.14–1962 Graphic Symbols for Logic Diagrams

Z32.2.3–1949 (R1953) Graphic Symbols for Pipe Fittings, Valves and Piping

Z32.2.4–1949 (R1953) Graphic Symbols for Heating, Ventilating & Air Conditioning

Z32.2.6–1950 Graphic Symbols for Heat-Power Apparatus

The following symbols should be used to indicate various materials where the material is an important feature of the invention. The use of conventional features is very helpful in making prior art searches.



APPLICATIONS FILED WITHOUT DRAWINGS

Applications filed without drawings are initially inspected to determine whether or not a drawing is referred to in the specification, and if, under the statute, a drawing is necessary before the application can be given a filing date. Doubtful cases are referred to the supervisory primary examiner for decision as to the need for such a drawing. If, after an application without a drawing has been received in the examining group, it is clear that a drawing is required, the application should be returned to the Application Branch along with a memorandum indicating that a drawing is required. It has long been the practice to accept a process case (that is, a case having only process or method claims) which is filed without a drawing. The same practice has been followed in composition cases. Other situations where drawings are usually not considered essential for a filing date are:

I. *Coated articles or products.* Where the invention resides solely in coating or impregnating a conventional sheet; e.g., paper or cloth, or an article of known and conventional character with a particular composition, the application containing claims to the coated or impregnated sheet or article, unless significant details of structure or arrangement are involved in the article claims.

II. *Articles made from a particular material or composition.* Where the invention consists in making an article of a particular material or composition, unless significant details of structure or arrangement are involved in the article claims.

III. *Laminated structures.* Where the claimed invention involves only laminations of sheets (and coatings) of specified material unless significant details of structure or arrangement (other than the mere order of the layers) are involved in the article claims.

IV. *Articles, apparatus or systems where sole distinguishing feature is presence of a particular material.* Where the invention resides solely in the use of a particular material in an otherwise old article, apparatus or system recited broadly in the claims; for example,

a. Hydraulic system distinguished solely by the use therein of a particular hydraulic fluid;

b. Packaged sutures wherein the structure and arrangement of the package are conventional and the only distinguishing feature is the use of a particular fluid.

APPLICATIONS FILED WITHOUT ALL FIGURES OF DRAWINGS

Applications filed without all figures of drawing described in the specification are not given a filing date since they are "*prima facie*" incomplete. The filing date is the date on which the omitted figures are filed. See MPEP § 601.01. If the oath or declaration for the application was filed prior to the submission of all figures of the drawing, the submission of any omitted figures must be accompanied by a supplemental oath or declaration stating that the omitted figures accurately illustrate and are a part of applicant's invention. If the oath or declaration for the application was not filed prior to the submission of the omitted figures, the oath or declaration, when filed, must include a specific reference to the figures originally omitted. If any applicant believes that omitted figures of an application are not necessary for an understanding of the subject matter sought to be patented, applicant may petition to have the application accepted without the omitted figures. Any such petition must be accompanied by the petition fee (37 CFR 1.17(h)) and an amendment cancelling from the specification all references to the omitted figures and any claims which depend upon the omitted figures for disclosure and support. Also, if the oath or declaration for the application was filed prior to the date of the amendment and petition, the amendment must be accompanied by a supplemental declaration by the applicant stating that the invention is adequately disclosed in, and a desire to rely on, the application as thus amended for purposes of an original disclosure and filing date. If the oath or declaration for the application was not filed prior to the date of the petition and amendment, the oath or declaration, when filed, must include a specific reference to the amendment canceling from the specification all references to the omitted figures and any claims which depend upon the omitted figures for disclosure and support. The petition requesting that the application be accepted without the omitted drawing figures should be directed to the Office of the Assistant Commissioner for Patents and request relief under 37 CFR 1.182.

Frequently, applications are filed containing drawings with several views of the invention where the views are labeled using a number-letter combination; for example, the drawings may contain figures labeled "Fig. 1B", and "Fig. 1C", but the specification describes a "Fig. 1A". In virtually all of these cases, there is no "Figure 1" missing. Instead, the reference in the specification to the figure is a typographical error, that is, the specification should read "Figures 1A-1C" instead of "Figure 1". Application Division will not treat an application as being incomplete if a figure which is referred to in the specification by a particular number cannot be located among the drawings, if the drawings contain at least one figure labeled with that particular number in combination with a letter. For example, an application will not be treated as incomplete if "Figure 1" is mentioned in the specification (in either the brief or detailed description), but the drawings contain figures labeled "Fig. 1A", "Fig. 1B, etc. The error which exists in the specification should be corrected, however.

Application Division will treat an application as incomplete in all other instances where a drawing figure is mentioned in the specification, but the figure is not present in the drawings filed.

ILLUSTRATION SUBSEQUENTLY REQUIRED

The acceptance of an application without a drawing does not preclude the examiner from requiring an illustration in the form of a drawing under 37 CFR 1.81(c) or 37 CFR 1.83(c). In requiring such a drawing, the examiner should clearly indicate that the requirement is made under 37 CFR 1.81(c) or 37 CFR 1.83(c) and be careful not to state that he or she is doing so "because it is necessary for the understanding of the invention," as that might give rise to an erroneous impression as to the completeness of the application as filed. Examiners making such requirements are to specifically require, as a part of the applicant's next response, at least an ink sketch or permanent print of any drawing proposed in response to the requirement, even though no allowable subject matter is yet indicated. This will afford the examiner an early opportunity to determine the sufficiency of the illustration and the absence of new matter. See 37 CFR 1.118 and 37 CFR 1.81(d). The description should of course be amended to contain reference to the new illustration. This may obviate further correspondence where an amendment places the case in condition for allowance, except for the formal requirement relating to the drawing. In the event of a final determination that there is nothing patentable in the case, a formal drawing will not be required.

BLACK AND WHITE PHOTOGRAPHS

37 CFR 1.84. Standards for drawings.

*****

(b) Photographs.

(1) Black and white. Photographs are not ordinarily permitted in utility and design patent applications. However, the Office will accept photographs in utility and design patent applications only after granting a petition filed under this paragraph which requests that photographs be accepted. Any such petition must include the following:

(i) The appropriate fee set forth in § 1.17(h); and

(ii) Three (3) sets of photographs.

Photographs must either be developed on double weight photographic paper or be permanently mounted on bristol board. The photographs must be of sufficient quality so that all details in the drawing are reproducible in the printed patent.

(2) Color. Color photographs will be accepted in utility patent applications if the conditions for accepting color drawings have been satisfied. See paragraph (a)(2) of this section.

*****

Photographs are not normally considered to be proper drawings. Photographs are acceptable for a filing date and are generally considered to be informal drawings. Photographs may be acceptable as formal drawings when a petition filed under the provisions of 37 CFR 1.84 (b) is granted. The petition must be accompanied by the fee set forth in 37 CFR 1.17 (h) and three (3) sets of the photographs in question. Photolithographs of photographs are never acceptable. See *In re Taggart et al.*, 1957 C.D. 6,725 O.G. 397 and *In re Myers*, 1959 C.D. 2, 738 O.G. 947.

PETITIONABLE SUBJECT MATTER

The Patent and Trademark Office is willing to accept photographs or photomicrographs (not photolithographs or other reproductions of photographs made by using screens) printed on sensitized paper in lieu of India ink drawings, to illustrate inventions which are incapable of being accurately or adequately depicted by India ink drawings; e.g., crystalline structures, metallurgical microstructures, textile fabrics, grain structures and ornamental effects. The photographs or photomicrographs must show the invention more clearly than they can be done by India ink drawings and otherwise comply with the rules concerning such drawings.

Such photographs to be acceptable must be made on photographic paper having the following characteristics which are generally recognized in the photographic trade: double weight paper with a surface described as smooth; tint, white, or be photographs mounted on proper size bristol board.

See MPEP § 1503.02 for discussion of photographs used in design patent applications.

COLOR DRAWINGS OR COLOR PHOTOGRAPHS

37 CFR 1.84. Standards for drawings.

(a) Drawings. There are two acceptable categories for presenting drawings in utility patent applications:

*****

(2) Color. On rare occasions, color drawings may be necessary as the only practical medium by which to disclose the subject matter sought to be patented in a utility patent application or the subject matter of a statutory invention registration. The Patent and Trademark Office will accept color drawings in utility patent applications and statutory invention registrations only after granting a petition filed under this paragraph explaining why the color drawings are necessary. Any such petition must include the following:

(i) The appropriate fee set forth in § 1.17(h);

(ii) Three (3) sets of color drawings; and

(iii) The specification must contain the following language as the first paragraph in that portion of the specification relating to the brief description of the drawing:

"The file of this patent contains at least one drawing executed in color. Copies of this patent with color drawing(s) will be provided by the Patent and Trademark Office upon request and payment of the necessary fee."

If the language is not in the specification, a proposed amendment to insert the language must accompany the petition.

(b) Photographs.

*****

(2) Color. Color photographs will be accepted in utility patent applications if the conditions for accepting color drawings have been satisfied. See paragraph (a)(2) of this section.

*****

Limited use of color drawings in utility patent applications is provided for in 37 CFR 1.84(a)(2) and (b)(2). Unless a petition is filed and granted, the Draftsman will not approve color drawings or color photographs in a utility or design patent application. The examiner must object to the color drawings or color photographs as being improper and require applicant either to cancel the drawings or to provide substitute black and white drawings.

Under 37 CFR 1.84(a)(2) and (b)(2), the applicant must file a petition with fee requesting acceptance of the color drawings or color photographs. The petition is decided in the Office of the Group Director.

Where color drawings or color photographs are filed in a continuing application, applicant must renew the petition under 37 CFR 1.84(a)(2) and (b)(2) even though a similar petition was filed in the prior application. Until the renewed petition is granted, the examiner must object to the color drawings or color photographs as being improper.

In light of the substantial administrative and economic burden associated with printing a utility patent with color drawings or color photographs, the patent copies which are printed at issuance of the patent will depict the drawings in black and white only. However, a set of color drawings or color photographs will be attached to the Letters Patent. Moreover, copies of the patent with color drawings or color photographs attached thereto will be provided by the Patent and Trademark Office upon special request and payment of the fee necessary to recover the actual costs associated therewith.

Accordingly, the petition must also be accompanied by a proposed amendment to insert the following language as the first paragraph in the portion of the specification containing a brief description of the drawings:

> The file of this patent contains at least one drawing executed in color. Copies of this patent with color drawing(s) will be provided by the Patent and Trademark Office upon request and payment of the necessary fee.

It is anticipated that such a petition will be granted only when the Patent and Trademark Office has determined that a color drawing or color photograph is the only practical medium by which to disclose in a printed utility patent the subject matter to be patented.

It is emphasized that a decision to grant the petition should not be regarded as an indication that color drawings or color photographs are necessary to comply with a statutory requirement. In this latter respect, clearly it is desirable to file any desired color drawings or color photographs as part of the original application papers in order to avoid issues concerning statutory defects (e.g., lack of enablement under 35 U.S.C. 112 or news matter under 35 U.S.C. 132). The filing of the petition, however, may be deferred until acceptable formal drawings are required by the examiner.

NOTIFYING APPLICANT

If the original drawings are informal but may be admitted for examination purposes, the draftsman indicates on a 2-part form, PTO-948, what the informalities are and that new corrected drawings are required. In either case, the informal drawings are accepted as satisfying the requirements of 37 CFR 1.51.

The examiners are directed to advise the applicants by way of form PTO-948 (see MPEP § 707.07(a)) in the first Office action of the conditions which the draftsman considers to render the drawing informal.

Drawing corrections should be made when the application is in issue unless the examiner requires correction at an earlier date.

If the examiner discovers a defect in the content of the drawing, the applicant should be notified by using a Form Paragraph, where appropriate.

¶ *6.21 New Drawings, Competent Draftsman*

New formal drawings are required in this application because [1]. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the Patent and Trademark Office no longer prepares new drawings.

¶ *6.22 Drawings Objected To*

The drawings are objected to because [1]. Correction is required.

Examiner Note:

Follow with paragraph 6.27, if appropriate.

¶ *6.23 Subject Matter Admits of Illustration*

The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81.

Examiner Note:

When requiring drawings before examination, use POL-90 form and set a two-month time period.

¶ *6.24. Informal Drawings*

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

¶ *6.24.1 Photographs and Color Drawings, Petition Required*

The drawings are considered to be informal because they fail to comply with 37 CFR § 1.84 (a)(1) which requires black and white drawings using India ink or its equivalent.

Photographs and color drawing are acceptable only for examination purposes unless a petition filed under 37 CFR § 1.84 (a)(2) or (b)(1) is granted permitting their use as formal drawings. In the event applicant wishes to use the drawings currently on file as formal drawings, a petition must be filed for

acceptance of the photographs or color drawings as formal drawings. Any such petition must be accompanied by the appropriate fee as set forth in 37 CFR § 1.17 (h), three sets of drawings or photographs, as appropriate, and, if filed under the provisions of 37 CFR § 1.84 (a)(2), an amendment to the first paragraph of the brief description of the drawings section of the specification which states:

> "The file of this patent contains at least one drawing executed in color. Copies of this patent with color drawing(s) will be provided by the Patent and Trademark Office upon request and payment of the necessary fee."

Color photographs will be accepted if the conditions for accepting color drawings have been satisfied.

Examiner Note:

This form paragraph should be used after form paragraph 6.24 only if the application contains photographs or color drawings as the drawings required by 37 CFR § 1.81.

¶ *6.26 Informal Drawings Do Not Permit Examination*

The informal drawings are not of sufficient quality to permit examination. Accordingly, new drawings are required in response to this Office action.

Examiner Note:

Use PTOL-90 form and set a 2-month time period.

¶ *6.27 Correction Held in Abeyance*

Applicant is required to submit a proposed drawing correction in response to this Office action. However, execution of the noted defect will be deferred until the application is allowed by the examiner.

DRAWING REQUIREMENTS

The first sentence of 35 U.S.C. 113 requires a drawing to be submitted upon filing where such drawing is necessary for the understanding of the invention. In this situation, the lack of a drawing renders the application incomplete and, as such, the application cannot be given a filing date until the drawing is received. The second sentence of 35 U.S.C. 113 deals with the situation wherein a drawing is not necessary for the understanding of the invention, but the case admits of illustration and no drawing was submitted on filing. The lack of the drawing in this situation does not render the application incomplete but rather is treated much in the same manner as an informality. The examiner should require such drawings in almost all such instances. Such drawings could be required during the processing of the application but do not have to be furnished at the time the application is filed. The applicant is allowed at least 2 months from the date of the letter requiring drawings to submit them.

Handling of Drawing Requirements Under the First Sentence of 35 U.S.C. 113

The Application Branch examiner will make the initial decision in all new applications as to whether a drawing is "necessary" under the first sentence of 35 U.S.C. 113. A drawing will be considered necessary under the first sentence of 35 U.S.C. 113 in all cases where the drawing is referred to in the specification and one or more figures have been omitted.

The determination under 35 U.S.C. 113 (first sentence) as to when a drawing is necessary will be handled in the Application Branch according to the following procedure. The Application Branch formality examiners will make the initial determination whether or not drawings are required for the understanding of the subject matter of the invention. Mechanical and electrical cases which lack a drawing, but in which one appears to be needed for an understanding of the invention, will be referred to the Classification and Routing Unit of the Application Branch for advice. If the Classification and Routing Unit cannot reach a prompt and decisive response, the application will be referred to the supervisory primary examiner for a determination. When drawings are required, the application is treated as incomplete and the applicant is so informed by the Application Branch. The filing date will not be granted and applicant will be notified to complete the application (37 CFR 1.53). However, the practice with respect to chemical cases is that, unless a drawing or drawing figure is specifically referred to in the specification of the application, the application will initially be considered by the Application Branch formality examiner as being complete and will be given a filing date. Only in those chemical cases wherein there is a reference in the specification to a drawing and no drawing was present on filing will a chemical application initially be held incomplete and denied a filing date. If a drawing is later furnished, a filing date may be granted as of the date of receipt of such drawing.

If an examiner feels that a filing date should not have been granted in an application because it does not contain drawings, the matter should be brought to the attention of the supervisory primary examiner (SPE) for review. If the SPE decides that drawings are required to understand the subject matter of the invention, the SPE should return the application to the Application Branch with a typed, signed, and dated memorandum requesting cancellation of the filing date and identifying the subject matter required to be illustrated.

608.02(a) New Drawing — When Required

Utility and design patent applications should be taken up for the first Office action without a request for formal drawings unless the informal drawings are so unclear that they do not facilitate an understanding of the invention as to permit examination of the application. If at the time of the initial assignment of an application to an examiner's docket, or if at the time the application is taken up for action, the supervisory primary examiner believes the informal drawings to be of such a condition as to not permit reasonable examination of the application, applicant should be required to immediately sub-

mit formal drawings. However, if the informal drawings do not permit examination and the supervisory primary examiner believes the drawings are of such a character as to render the application defective under 35 U.S.C. 112, examination should begin immediately with a requirement for formal drawings and a rejection of the claims as not being in compliance with 35 U.S.C. 112, first paragraph, being made.

Formal drawings should be required when the application is allowed.

Forms PTOL-326 and 37 now provide items for requiring formal drawings.

Form Paragraph 6.45 may also be used to inform applicant that formal drawings are required.

¶ *6.45 Application Allowed, Formal Drawings Needed*

Formal drawings are now required and must be filed within the 3-month shortened statutory period set for response in the Notice of Allowability (PTOL-37). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a). Failure to timely submit the drawings will result in **ABANDONMENT** of the application. The drawings should be submitted as a separate paper with a transmittal letter which is addressed to the Official Draftsman. The art unit number, serial number, and number of drawing sheets should be written on the reverse side of the drawings.

Handling of Drawing Requirements Under the Second Sentence of 35 U.S.C. 113

35 U.S.C. 113 deals with the situation wherein the drawing is not necessary for the understanding of the invention, but the subject matter admits of illustration by a drawing and the applicant has not furnished a drawing. The lack of the drawing in this situation does not render the application incomplete but rather is treated as an informality. A filing date will be accorded with the original presentation of the papers, despite the absence of drawings. In these situations, a drawing or further illustration will normally be required by the examiner. This should be done prior to examination in a separate letter. The examiner should require additional drawings, where appropriate, as early as possible since the possession of the additional drawings would facilitate the examination process. A letter requiring drawings may contain wording similar to the following:

> The examiner has decided that the subject matter of this application admits of illustration by a drawing and that a drawing would facilitate the understanding of the subject matter disclosed. (Continue with a specific mention of those items of which drawings are desired.) Applicant is required to furnish a drawing under 37 CFR 1.81 (Incorporate in Office action or send a separate letter setting a 2-month period for response.)

The applicant should be given at least 2 months from the date of a requirement to submit drawings made in a separate letter. If the requirement for drawings is included in an Office action, the time for supplying the additional drawings will be the same as the time for response to the Office action.

RECEIPT OF DRAWING AFTER THE FILING DATE

If new matter is noticed by the examiner in a substitute or additional drawing, the drawing should not be entered. It should be objected to as containing new matter. A new drawing without such new matter may be required if the examiner feels a drawing is needed under 37 CFR 1.81 or 1.83. The examiner's decision would be reviewable by petition to the Commissioner under 37 CFR 1.181. The decision on such a petition would be handled by the group director.

UNTIMELY FILED DRAWINGS

If a drawing is not timely received in response to a letter from the examiner who requires a drawing, the application becomes abandoned for failure to respond.

For the handling of additional, duplicate, or substitute drawing, see MPEP § 608.02(h).

608.02(b) Informal Drawings

37 CFR 1.85. Corrections to drawings.

(a) The requirements of § 1.84 relating to drawings will be strictly enforced. A drawing not executed in conformity thereto, if suitable for reproduction, may be admitted for examination but in such case a new drawing must be furnished.

(b) The Patent and Trademark Office will not release drawings in applications having a filing date after January 1, 1989, or any drawings from any applications after January 1, 1991, for purposes of correction. If corrections are necessary, new corrected drawings must be submitted within the time set by the Office.

(c) When corrected drawings are required to be submitted at the time of allowance, the applicant is required to submit acceptable drawings within three months from the mailing of the "Notice of Allowability." Within that three-month period, two weeks should be allowed for review of the drawings by the Drafting Branch. If the Office finds that correction is necessary, the applicant must submit a new corrected drawing to the Office within the original three-month period to avoid the necessity of obtaining an extension of time and paying the extension fee. Therefore, the applicant should file corrected drawings as soon as possible following the receipt of the Notice of Allowability. The provisions with respect to obtaining an extension of time relates only to the late filing of corrected drawings. The time limit for payment of the issue fee is a fixed three-month period which cannot be extended as set forth in 35 U.S.C. 151.

In instances where the drawing is such that the prosecution can be carried on without the corrections, applicant is informed of the reasons why the drawing is objected to on Form PTO-948 or in an examiner's action, and that the drawing is admitted for examination purposes only (see MPEP § 707.07(a)). To be fully responsive, an amendment must include a request for drawing corrections when the application is allowed or an appeal is filed. See 37 CFR 1.111(b).

INFORMAL DRAWINGS

To expedite filing, applicants sometimes submit applications with informal drawings. Such applications are accepted

by Application Branch for filing only, provided the informal drawings are readable and reproducible. Applicant is notified on Form PTO-948 or in an Office action that formal drawings, in compliance with 37 CFR 1.84 will be required when the application is allowed. Form Paragraph 6.24 may be used for this purpose.

¶ *6.24 Informal Drawings*

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

This form paragraph may be followed by Form Paragraph 6.24.1 if applicable.

Alternatively, the examiner may check the appropriate box on the OFFICE ACTION SUMMARY, PTOL-326.

HANDLING OF NEW DRAWINGS

In those situations where an application is filed with informal drawings, applicants are requested to wait until they receive their "Notice of Draftsman's Patent Drawing Review" form, PTO-948 or the first Office action utilizing form PTOL-326 or PTOL-37 from the group art unit before submitting the formal drawings. The letter of transmittal accompanying the formal drawings should identify the group art unit indicated on form PTO-948 or form PTOL-326. If the informal notification appears on form PTOL-37, the date of the mailing of the Notice of Allowance and Issue Fee as well as the Issue Batch Number must be given. Also, each sheet of the drawing should include the serial number and group art unit in the upper right margin. In the past, some drawings have been misdirected because the group art unit indicated on the filing receipt was used rather than that indicated on the informal notice forms.

The draftsman is the judge of drawings, as to the execution of the same, and the arrangement of the views thereon, while the examiner is the judge as to the sufficiency of the showing. The drawings received with an application are inspected by the draftsman. If the drawing is satisfactory, he or she stamps on each sheet "Approved by Draftsman" and checks the approved box on Form PTO-948. See also MPEP § 608.02.

RECEIPT OF SUBSTITUTE DRAWINGS

If substitute drawings are timely filed, the clerk should immediately send the new substitute drawings with the file wrapper to the Draftsman for approval as to form.

If the application is allowed on the first action, the examiner should require formal drawings using form PTOL-37.

COMPARISON OF SUBSTITUTE DRAWINGS

In utility applications, the examination will normally be conducted using any informal drawings presented. The sufficiency of disclosure, as concerns the subject matter claimed, will be made by the examiner utilizing the informal drawings. IT IS APPLICANT'S RESPONSIBILITY TO SEE THAT NO NEW MATTER IS ADDED when submitting substitute drawings since they will not normally be reviewed by an examiner. Of course, if the examiner notices new matter in the substitute drawings, appropriate action to have the new matter deleted should be undertaken.

608.02(c) Drawing Print Kept in File Wrapper

The drawing prints must always be kept on top of the papers on the right side of the file wrapper so as to be visible upon opening the wrapper and to permit them to be easily detached.

Applications may be sent to issue or to the Files Repository without the original drawing, if any, if the drawing cannot be located. For an application sent to issue with missing drawings, see MPEP § 608.02(z). For abandoned applications sent to the Files Repository, a notation should be made on the Contents portion of the file wrapper that the drawings were missing.

Upon initial processing, the original drawings are placed in the center portion of the application file wrapper underneath the application papers by the Micrographics Branch. The formal drawings should be retained in this position.

608.02(d) Complete Illustration in Drawings

37 CFR 1.83. Content of drawing.

(a) The drawing must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g. a labeled rectangular box).

(b) When the invention consists of an improvement on an old machine the drawing must when possible exhibit, in one or more views, the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

(c) Where the drawings do not comply with the requirements of paragraphs (a) and (b) of this section, the examiner shall require such additional illustration within a time period of not less than two months from the date of the sending of a notice thereof. Such corrections are subject to the requirements of § 1.81(d).

Any structural detail that is of sufficient importance to be described should be shown in the drawing, (*Ex parte Good*, 1911 C.D. 43; 164 O.G. 739.)

Form Paragraph 6.36 should be used to require illustration.

¶ *6.36 Drawings Do Not Show Claimed Subject Matter*

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the [1] must be shown or the feature should be cancelled from the claim. No new matter should be entered.

608.02(e)

Examiner Note:

In bracket 1, insert the features that should be shown.

See also MPEP § 608.02(a).

608.02(e) Examiner Determines Completeness of Drawings

The examiner should see to it that the figures are correctly described in the brief description of the specification and that the reference characters are properly applied, no single reference character being used for two different parts or for a given part and a modification of such part, but there should be no superfluous illustrations.

608.02(f) Modifications in Drawings

Modifications may not be shown in broken lines on figures which show in solid lines another form of the invention. *Ex parte Badger,* 1901 C.D. 195; 97 O.G. 1596.

All modifications described must be illustrated, or the text cancelled. (*Ex parte Peck*, 1901 C.D. 136; 96 O.G. 2409.) This requirement does not apply to a mere reference to minor variations nor to well-known and conventional parts.

608.02(g) Illustration of Prior Art

Figures showing the prior art are usually unnecessary and should be cancelled, *Ex parte Elliott,* 1904 C.D. 103; 109 O.G. 1337. However, where needed to understand applicant's invention, they may be retained if designated by a legend such as "Prior Art."

If the prior art figure is not labeled, the following paragraph may be used.

Figure [1] should be designated by a legend such as Prior Art in order to clarify what is applicant's invention. (See MPEP § 608.02(g)).

608.02(h) Additional, Duplicate, or Substitute Drawings

When an amendment is filed stating that at the same time substitute or additional sheets of drawings are filed and such drawings have not been transmitted to the examining group, the docket clerk in the examining group should call the Application Branch before entering the amendment to ascertain if the drawing was not received. In the next communication of the examiner, the applicant is notified if the drawings have been received and whether or not the substitute or additional drawings have been entered in the application.

Additional and substitute drawings, together with the file wrapper, are routed through the Drafting Branch where any defects in execution will be noted. If there are none, they will be stamped, "APPROVED BY DRAFTSMAN." When such drawings are considered by the examiner, it should be kept in mind that the "APPROVED" stamp applies only to the size and quality of paper, lines rough and blurred, and other details of execution. The additional or substitute drawing sheets should be entered by the application clerk after approval by both the draftsman and the examiner.

The examiner should not overlook such factors as new matter, the necessity for the additional sheets and consistency with other sheets. Clerks will routinely enter all additional and substitute sheets on the file wrapper. Additional and substitute sheets of drawings are also indicated on the face of the file wrapper under the heading "Parts of application separately filed." If the examiner decides that the sheets should not be entered, applicant is so informed, giving the reasons. The entries made by the clerk will be marked "(N.E.)."

Form Paragraph 6.37 may be used to acknowledge corrected or substituted drawings.

¶ *6.37 Acknowledgment of Corrected or Substituted Drawings*

The corrected or substitute drawings have been received on [1]. These drawings are [2].

Examiner Note:

1. In bracket 2, insert either – acceptable – or – not acceptable.
2. If not acceptable, an explanation must be provided.
3. If not acceptable because of informalities noted on the PTO-948, use Form Paragraph 6.43.

Alternatively, PTOL-326 OFFICE ACTION SUMMARY, includes a block for acknowledgment of corrected or substitute drawings.

If an additional sheet of drawing is considered unnecessary and the original drawing requires alterations which are taken care of in the proffered additional sheet, the latter may be used in lieu of the usual sketch required in making the correction of the original drawing.

For return of drawing, see MPEP § 608.02(y).

608.02(i) Transfer of Drawings From Prior Applications

Transfer of drawings from a first pending application to another will be made only upon the granting of a petition filed under 37 CFR 1.182 which must set forth a hardship situation requiring such transfer of drawings.

608.02(m) Drawing Prints

Preparation and distribution of drawing prints is discussed in MPEP § 508.

Prints are made of the drawings of an acceptable application. These prints are marked "Prints of drawing as originally filed" and are entered in the application, given a paper num-

ber, and kept on top of the papers on the right side of the file wrapper, see MPEP § 717.01(b).

All prints and inked sketches subsequently filed to be part of the record are endorsed with the date of their receipt in the Office and given their appropriate paper number.

The print being thus an official paper in the record should not be marked or in any way altered. The original drawing, of course, should not be marked up by the examiner. Where, as in an electrical wiring case, it is desirable to identify the various circuits by different colors, or in any more or less complex case, it is advantageous to apply legends, arrows, or other indicia, an additional print for such use should be made or ordered by the examiner and placed unofficially in the file.

Prints remain in the file at all times except as provided in MPEP § 608.02(c).

INTERFERENCE PRINTS

A print is prepared of each drawing in all applications having a filing date. This interference print is in addition to the drawing print on white paper.

Primary examiners should place the classification and the name of the examiner on the interference print.

The interference prints are located above the drawing prints on the right-hand portion of the file wrapper when initially received in the examining group.

After the application has been classified and assigned to an examiner, the interference prints should be removed and placed in the drawing cabinets.

If an application has several sheets of drawings, the interference prints should be stapled together at their bottom edges before being filed. If the number of sheets of prints is too large to be stapled, a fastener should be placed through the holes at the top.

The time when the interference prints are removed from the drawing cabinets is determined by the group director.

The drawings filed by applicant remain in the file wrapper.

608.02(n) Duplicate Prints in Patentability Report Cases

In patentability report cases having drawings, the examiner to whom the case is assigned should normally obtain a duplicate set of the interference prints of the drawing for filing in the group to which the case is referred.

When a case that has had patentability report prosecution is passed for issue or becomes abandoned, notification of this fact is given by the group having jurisdiction of the case to each group that submitted a patentability report. The examiner of each such reporting group notes the date of allowance or abandonment on his or her duplicate set of prints. At such time as these prints become of no value to the reporting group, they may be destroyed.

608.02(o) Dates Entered on Drawing

The Incoming Mail Section (mail room) stamp and the "Corrected" stamp applied by the Drafting Branch are impressed on the back of the drawings. If the drawings are filed in the Examining Group, the group receipt date stamp should be applied to the back of the drawing near the top.

Approval of the Drafting Branch is indicated by a legend associated with the "O.G. Fig. Cl.... Sub...." stamp on the front of each sheet.

608.02(p) Correction of Drawings

37 CFR 1.123. Amendments to the drawing.

No change in the drawing may be made except with permission of the Office. Permissible changes in the construction shown in any drawing may be made only by the submission of a substitute drawing by applicant. A sketch in permanent ink showing proposed changes, to become part of the record, must be filed for approval by the examiner and should be a separate paper.

NOTE.—Correction is deferrable, see MPEP § 608.02(b); correction at allowance and issue, see MPEP § 608.02(w) and MPEP § 1302.05.

A cancelled figure may be reinstated. An amendment should be made to the specification adding the brief description if a cancelled figure is reinstated.

608.02(q) Conditions Precedent to Amendment of Drawing

No alterations will be permitted unless required by an examiner's letter in each case or proposed in writing by applicant or his or her attorney or agent. In either case, the alterations or corrections as indicated in the sketches filed with the request of the applicant or his or her attorney or agent must be given written approval by the examiner before the drawing is corrected.

Correction of Informalities (Draftsman's Objections on PTO-948)

Form Paragraph 6.40 (reproduced in MPEP § 608.02) and form PTO-1474, "Information on How to Effect Drawing Changes," the back page of the PTO-948, and the back page of PTOL-37, the "Notice of Allowability" provide detailed information on how to effect drawing changes.

In order to correct any informalities in the drawings, applicants *MUST* comply with (a) below. Failure to do so will result in *ABANDONMENT* of the application.

(a) File new drawings with the changes incorporated therein. Applicant may delay filing of the new drawings until the application is allowed by the examiner. If delayed, the

new drawings *MUST* be filed within the period set for response in the "NOTICE OF ALLOWABILITY" (PTOL-37). The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsman which indicates the following in the upper right-hand corner:

Date of the Notice of Allowability
Issue Batch Number
Serial Number

Corrections Other Than Informalities Noted by the Draftsman on the PTO-948

All changes to the drawings, other than informalities noted by the Draftsman, *MUST* be made in the same manner as above except that, normally, a sketch of the changes to be incorporated into the new drawings *MUST* be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

608.02(r) Separate Letter to Draftsman

Any proposal by the applicant for amendment of the drawing to cure defects must be embodied in a *separate* letter. Otherwise the case, unless in other respects ready for issue, cannot be corrected, and applicant must be so advised in the next action by the examiner.

NOTE:—Changes which may require sketches, MPEP § 608.02(v).

608.02(t) Cancellation of Figures

Cancellation of one or more figures which do not occupy entire sheets of the drawings is done by the clerk in the examining group who encloses a figure and its legend with a red ink line. No portion of the figure itself should be crossed by the red line. The words "CANCEL per" and the date of the amendment directing the cancellation or the date that substitute sheets are filed should be written in red ink within the red line. Cancellation of an entire sheet of drawings is done by stamping the words "CANCEL per" in the top right corner of the drawing. Cancelled drawing sheets should be placed at the bottom of the papers on the right fold of the file wrapper.

When the cancellation of some of the figures from one sheet of drawings has left the remaining figures with an inartistic arrangement, the draftsmen should be consulted as to whether the remaining figures should be transferred to other sheets already in the case or shown in additional drawings. Cancellation of a figure may necessitate renumbering of the remaining figures.

608.02(v) Drawing Changes Which Require Sketches

When changes are to be made in the drawing itself, other than mere changes in reference characters, designations of figures, or inking over lines pale and rough, a print or pen-and-ink sketch must be filed showing such changes in red ink or with the changes otherwise highlighted. Ordinarily, broken lines may be changed to full without a sketch.

Sketches filed by an applicant and used for correction of the drawing will not be returned. All such sketches must be in ink or permanent prints.

608.02(w) Drawing Changes Which May Be Made Without Applicant's Sketch

Where an application is ready for issue except for a slight defect in the drawing not involving change in structure, the examiner will prepare a letter indicating the change to be made and note in pencil on the drawing the addition or alteration to be made.

The correction must be made at applicant's expense.

As a guide to the examiner, the following corrections are illustrative of those that may be made by penciling in the change on the drawing without a sketch:

1. Adding two or three reference characters or exponents.
2. Changing one or two numerals or figure ordinals. *Garrett* v. *Cox*, 110 USPQ 52, 54 (CCPA 1956)
3. Removing superfluous matter.
4. Adding or reversing directional arrows.
5. Changing Roman Numerals to Arabic Numerals to agree with specification.
6. Adding section lines or brackets, where easily executed.
7. Changing lead lines.
8. Correcting misspelled legends.

608.02(x) Disposition of Orders for Amendment of Drawing

Where the correction of the drawing is approved by the examiner, the application and drawing are forwarded to the Office of Publications along with the Notice of Allowance.

CORRECTION NOT APPROVED

Where the correction is not approved, for example, because the proposed changes are erroneous, or involve new

matter or (although otherwise proper) do not include all necessary corrections, the case and request for correction of drawing are not approved. The examiner's reasons for not approving the corrections to the drawing should be set forth in the next Office action.

608.02(y) Return of Drawing

If there is a formal drawing in the case, non-entered drawings (except those originally filed) that have been finally denied admission will be returned to the applicant only at applicant's request.

A request for return of nonentered drawings must be filed within a reasonable time; otherwise, the drawing may be disposed of at the discretion of the Commissioner.

When a drawing is to be returned, the file, the examiner's letter stating that the drawing is being returned, and the drawing are taken to the Drafting Branch where the letter will be stamped and the drawing returned. The letter is mailed by the examining group.

Before drawings are returned, prints are made and put in the application file.

608.02(z) Allowable Applications Needing Drawing Corrections or Formal Drawings

Allowable applications can be turned in for counting and forwarding to the Office of Publications without the drawings having been corrected. When sending allowed applications to the Office of Publications which require drawing corrections, use yellow tag form PTO-1364. The approved formal drawings requiring correction should be placed as the top papers in the center fold of the file wrapper. The drawing correction instructions should be stapled to the inside left flap of the file wrapper over the area having the search information. Care should be taken to make certain that the corrections have been approved by the examiner. Such approval should be made by the examiner prior to counting the allowance of the application.

The yellow tag procedure normally should be used only where drawing corrections are involved. The yellow tag procedure must be used where the draftsman has objected to the drawing because of an informality such as improper shading or pale lines and has indicated that this can be corrected.

The yellow tag procedure should not normally be used in other situations where corrected drawings have been filed but have not been approved by the draftsman unless the examiner is quite sure that the draftsman will approve the new drawings or in the situation where the application was examined utilizing an informal drawing and the request for formal drawings was not made until the Notice of Allowability was mailed. The yellow tag procedure should not be used in design applications where the drawings have not been approved by the draftsman because of shading problems which can arise. If the substitute drawings are not approved by the draftsman, the application should be promptly taken up for action by the examiner.

To: DRAFTING BRANCH via OFFICE of PUBLICATIONS
Return to: OFFICE OF PUBLICATIONS
Room 2-6C30

Serial no. _____
O.G. Fig. _____

Class _____ Subclass _____

PTO-1364 U.S. DEPT. of COMM. Pat. & TM Office

APPLICATIONS HAVING LOST DRAWINGS

A yellow tag is to be attached to the file wrapper and a "Drawing Missing" memo is to be stapled to the front of the file wrapper. The Notice of Allowability is verified and printed using PALM III, and the Notice is mailed to the applicant.

The application is then forwarded to Licensing and Review or the Allowed Files and Assembly Branch of the Office of Publications, as appropriate, using the PALM III transaction code after the application has been revised for issue.

UTILITY PATENT APPLICATIONS RECEIVING FORMAL DRAWINGS AFTER THE NOTICE OF ALLOWABILITY

Where substitute drawings are received in utility patent applications examined with informal drawings and the Notice of Allowability was mailed prior to the receipt of the substitute drawings, the clerk should enter the substitute drawings into the application and forward the application to the Allowed Files and Assembly Branch of the Office of Publications via Licensing and Review, if appropriate, using the yellow tag procedure. Submission to the examiner is not necessary unless an amendment accompanies the drawings which changes the specification, such as where the description of figures is added or cancelled.

BORROWING FILES FROM DRAFTING BRANCH

Allowed files requiring drawing corrections are sent to the draftsman from the Office of Publications. At times, examiners have a need to borrow these applications. When borrowing applications, examining corps personnel must submit a request to the Office of Publications.

608.03

37 CFR 1.312 AMENDMENTS

In handling 37 CFR 1.312 amendments, the examining corps should process drawings cancelled in the normal manner. If there are corrections to the drawing, approval, if appropriate, is indicated by the examiner on form PTOL-271 in conjunction with form paragraph 6.48; the paragraph sets the appropriate period for effecting the approved drawing change.

¶ *6.48 Drawing Changes in 312 Amendment*

Applicant is hereby given one month from the date of this letter or until the expiration of the period set in the Notice of Allowance (PTOL-85) or Notice of Allowability (PTOL-37), whichever is longer, to file corrected drawings.

Examiner Note:

Use with 312 amendment notice where there is a drawing correction proposal or requested.

Formal drawings may be required in an allowed application by using Form Paragraph 6.25 in an Office action or by checking the appropriate box on Form letter PTOL-37.

¶ *6.25 Formal Drawings Required, Application Allowed*

The application having been allowed, formal drawings are required in response to this Office action.

608.03 Models, Exhibits, Specimens

35 U.S.C. 114. Models, specimens.

The Commissioner may require the applicant to furnish a model of convenient size to exhibit advantageously the several parts of his invention.

When the invention relates to a composition of matter, the Commissioner may require the applicant to furnish specimens or ingredients for the purpose of inspection or experiment.

37 CFR 1.91. Models not generally required as part of application or patent.

Models were once required in all cases admitting a model, as a part of the application, and these models became a part of the record of the patent. Such models are no longer generally required (the description of the invention in the specification, and the drawings, must be sufficiently full and complete, and capable of being understood, to disclose the invention without the aid of a model), and will not be admitted unless specifically called for.

37 CFR 1.92. Model or exhibit may be required.

A model, working model, or other physical exhibit, may be required if deemed necessary for any purpose on examination of the application.

With the exception of cases involving perpetual motion, a model is not ordinarily required by the Office to demonstrate the operativeness of a device. If operativeness of a device is questioned, the applicant must establish it to the satisfaction of the examiner, but he or she may choose his or her own way of so doing.

A physical exhibit, not to be part of the case, is generally not refused except when bulky or dangerous.

37 CFR 1.93. Specimens.

When the invention relates to a composition of matter, the applicant may be required to furnish specimens of the composition, or of its ingredients or intermediates, for the purpose of inspection or experiment.

608.03(a) Handling of Models, Exhibits, and Specimens

All models and exhibits received in the Patent and Trademark Office should be taken to the examining group assigned the related application for examination. The receipt of all models and exhibits must be properly recorded on the "Contents" portion of the application file wrapper.

A label indicating the application serial number, filing date, and attorney's name and address should be attached to the model or exhibit so that is is clearly identified and easily returned after prosecution of the application is closed, if return is requested.

If the model or exhibit is too large to be kept in the examining group during prosecution of the application, it should not be accepted.

37 CFR 1.94. Return of models, exhibits or specimens.

Models, exhibits, or specimens in applications which have become abandoned, and also in other applications on conclusion of the prosecution, may be returned to the applicant upon demand and at his expense, unless it be deemed necessary that they be preserved in the Office. Such physical exhibits in contested cases may be returned to the parties at their expense. If not claimed within a reasonable time, they may be disposed of at the discretion of the Commissioner.

When a model is to be returned, a letter should be written to applicant by the examining group stating that it is being returned under separate cover, and the model should be forwarded with a copy of the letter and an address label to the Outgoing-Incoming Mail Branch for wrapping and return.

NOTE. — Disposition of exhibits which are part of the record, MPEP § 715.07(d).

Models, exhibits, and specimens may be presented to the Office for purposes of interview and taken away by the attorney at the end of the interview. See MPEP § 713.08.

NOTE.—Plant specimens, MPEP § 1607, 37 CFR 1.166.

37 CFR 1.95. Copies of exhibits.

Copies of models or other physical exhibits will not ordinarily be furnished by the Office, and any model or exhibit in an application or patent shall not be taken from the Office except in the custody of an employee of the Office specially authorized by the Commissioner.

608.04 New Matter

37 CFR 1.118. Amendment of disclosure.

(a) No amendment shall introduce new matter into the disclosure of an application after filing date of the application (§ 1.53(b)). All amendments to the specification, including the claims, and the drawings filed after the filing date of the application must conform to at least one of them as it was at the time of the filing of the application. Matter not found in either, involving a

departure from or an addition to the original disclosure, cannot be added to the application after its filing date even though supported by an oath or declaration in accordance with § 1.63 or § 1.67 filed after the filing date of the application.

(b) If it is determined that an amendment filed after the filing date of the application introduces new matter, claims containing new matter will be rejected and deletion of the new matter in the specification and drawings will be required even if the amendment is accompanied by an oath or declaration in accordance with § 1.63 or § 1.67.

In establishing a disclosure, applicant may rely not only on the specification and drawing, as filed but also on the original claims if their content justifies it. Note MPEP § 608.01(l).

While amendments to the specification and claims involving new matter are ordinarily entered, such matter is required to be cancelled from the descriptive portion of the specification, and the claims affected are rejected under 35 U.S.C. 112, first paragraph.

When new matter is introduced into the specification, the amendment should be objected to under 35 U.S.C. 132 (35 U.S.C. 251 if a reissue application) and a requirement made to cancel the new matter - clearly identified by the examiner. If the new matter has been entered into the claims or affects the scope of the claims, the claims affected should be rejected under 35 U.S.C. 112, first paragraph, because the new matter is not described in the application as originally filed.

A "new matter" amendment of the drawing is ordinarily not entered; neither is an additional or substitute sheet containing "new matter" even though stamped APPROVED by the Draftsman and provisionally entered by the clerk. See MPEP § 608.02(h).

The examiner's holding of new matter may be petitionable or appealable, MPEP § 608.04(c).

NOTE—New matter in reissue application, MPEP § 1411.02. New matter in substitute specification, MPEP § 714.20.

608.04(a) Matter Not in Original Specification, Claims, or Drawings

Matter not in the original specification, claims, or drawings is usually new matter. Depending on circumstances such as the adequacy of the original disclosure, the addition of inherent characteristics such as chemical or physical properties, a new structural formula or a new use may be new matter. See *Ex parte Vander Wal, et al.*, 1956 C.D. 11; 705 O.G. 5 (physical properties), *Ex parte Fox*, 1960 C.D. 28; 761 O.G. 906 (new formula) and *Ex parte Ayers, et al.*, 108 USPQ 444 (new use). For rejection of claim involving new matter, see MPEP § 706.03(o).

NOTE—Completeness of disclosure, MPEP § 608.01(p); Trademarks and tradenames, MPEP § 608.01(v).

608.04(b) New Matter by Preliminary Amendment

An amendment is sometimes filed along with the filing of the application. Such amendment does not enjoy the status as part of the original disclosure in an application filed under 37 CFR 1.53 unless it is referred to in the oath or declaration filed therewith. Once an oath or declaration is submitted in an application filed under 37 CFR 1.53 identifying the papers which the inventor(s) has "reviewed and understands" as required by 37 CFR 1.63, the original disclosure of the application is defined and cannot be altered merely by filing of a subsequent oath or declaration referring to different papers. If the application is filed without an executed oath or declaration pursuant to 37 CFR 1.53(b), the original oath or declaration submitted later than the filing date must refer to the preliminary amendment filed along with the application in order to comply with 37 CFR 1.63.

An amendment which adds additional disclosure filed with a request for a continuation-in-part application under 37 CFR 1.62 is automatically considered a part of the original disclosure of the application by virtue of the rule. Therefore, the oath or declaration filed in such an application must identify the amendment adding additional disclosure as one of the papers which the inventor(s) has "reviewed and understands" in order to comply with 37 CFR 1.63. If the original oath or declaration submitted in a continuation-in-part application filed under 37 CFR 1.62 does not contain a reference to the amendment filed with the request for an application under 37 CFR 1.62, the examiner must require a supplemental oath or declaration referring to the amendment.

608.04(c) Review of Examiner's Holding of New Matter

Where the new matter is confined to amendments to the specification, review of the examiner's requirement for cancelation is by way of petition. But where the alleged new matter is introduced into or affects the claims, thus necessitating their rejection on this ground, the question becomes an appealable one, and should not be considered on petition even though that new matter has been introduced into the specification also. 37 CFR 1.181 and 1.191 afford the explanation of this seemingly inconsistent practice as affecting new matter in the specification.

608.05 Deposit of Computer Program Listings

37 CFR 1.96. Submission of computer program listings.

Descriptions of the operation and general content of computer program listings should appear in the description portion of the specification. A computer program listing for the purpose of these rules is defined as a

print-out that lists in appropriate sequence the instructions, routines, and other contents of a program for a computer. The program listing may be either in machine or machine-independent (object or source) language which will cause a computer to perform a desired procedure or task such as solve a problem, regulate the flow of work in a computer, or control or monitor events. Computer program listings may be submitted in patent applications in the following forms:

(a) *Material which will be printed in the patent.* If the computer program listing is contained on 10 printout pages or less, it must be submitted either as drawings or as part of the specification.

(1) *Drawings.* The listing may be submitted in the manner and complying with the requirements for drawings as provided in § 1.84. At least one figure numeral is required on each sheet of drawing.

(2) *Specification.* (i) The listing may be submitted as part of the specification in accordance with the provisions of § 1.52, at the end of the description but before the claims.

(ii) The listing may be submitted as part of the specification in the form of computer printout sheets (commonly 14 by 11 inches in size) for use as camera ready copy when a patent is subsequently printed. Such computer printout sheets must be original copies from the computer with dark solid black letters not less than 0.21 cm high, on white, unshaded and unlined paper, the printing on each sheet must be limited to an area 9 inches high by 13 inches wide, and the sheets should be submitted in a protective cover. When printed in patents, such computer printout sheets will appear at the end of the description but before the claims and will usually be reduced about 1/2 in size with two printout sheets being printed as one patent specification page. Any amendments must be made by way of submission of a substitute sheet if the copy is to be used for camera ready copy.

(b) *As an appendix which will not be printed.* If a computer program listing printout is 11 or more pages long, applicants may submit such listing in the form of microfiche, referred to in the specification (see § 1.77(c)(2)). Such microfiche filed with a patent application is to be referred to as a microfiche appendix. The microfiche appendix will not be part of the printed patent. Reference in the application to the microfiche appendix should be made at the beginning of the specification at the location indicated in § 1.77(c)(2). Any amendments thereto must be made by way of revised microfiche. All computer program listings submitted on paper will be printed as part of the patent.

(1) *Availability of appendix.* Such computer program listings on microfiche will be available to the public for inspection, and microfiche copies thereof will be available for purchase with the file wrapper and contents, after a patent based on such an application is granted or the application is otherwise made publicly available.

(2) *Submission requirements.* Computer-generated information submitted as an appendix to an application for patent shall be in the form of microfiche in accordance with the standards set forth in the following American National (ANSI) or National Micrographics Association (NMA) Standards (Note: As new editions of these standards are published, the latest shall apply):

ANSI PH 1.28-1976-Specifications for Photographic Film for Archival records, Silver-Gelatin Type, on Cellulose Ester Base.

ANSI PH 1.41-1976 Specifications for Photographic Film for Archival Records, Silver-Gelatin Type, on Polyester Base.

NMA-MSI (1971) Quality Standards for Computer Output Microfilm.

ANS1/NMA MS2 (1978) Format and Coding Standards for Computer Output Microfilm.

NMA MS5 (ANSI PH 5.9-1975) Microfiche of Documents.

ANSI PH 2.19 (1959)-Diffuse Transmission Density.

except as modified or clarified below:

(i) Either Computer-Output-Microfilm (COM) output or copies of photographed paper copy may be submitted. In the former case, NMA standards MS1 and MS2 apply; in the latter case, standard MS5 applies.

(ii) Film submitted shall be first generation (camera film) negative appearing microfiche (with emulsion on the back side of the film when viewed with the images right reading).

(iii) Reduction ratio of microfiche submitted should be 24:1 or a similar ratio where variation from said ratio is required in order to fit the documents into the image area of the microfiche format used.

(iv0 Film submitted shall have a thickness of at least .005 inches (0.13 mm) and not more than .009 inches (0.23 mm) for either cellulose acetate base or polyester base type.

(v) Both microfiche formats A1 (98 frames, 14 columns x 7 rows) and A3 (63 frames, 9 columns x 7 rows) which are described in NMA standard MS2 (A1 is also described in MS5) are acceptable for use in preparation of microfiche submitted.

(vi) At least the left-most 1/3 (50 mm x 12 mm) of the header or title area of each microfiche submitted shall be clear or positive appearing so that the Patent and Trademark Office can apply serial number and filing date thereto in an eye-readable form. The middle portion of the header shall be used by applicant to apply an eye-readable application identification such as the title and/or the first inventor's name. The attorney's docket number may be included. The final right-hand portion of the microfiche shall contain sequence information for the microfiche, such as 1 of 4, 2 of 4, etc.

(vii) Additional requirements which apply specifically to microfiche of filmed paper copy:

(A) The first frame of each microfiche submitted shall contain a standard test target which contains five NBS Micro-copy Resolution Test Charts (No. 1010A), one in the center and one in each corner. See illustration on page 2 of NMA Recommended Practice MS104, Inspection and Quality Control of First Generation Silver Halide Microfilm. See also paragraph 7 of NMA-MS5.

(B) The second frame of each microfiche submitted must contain a fully descriptive title and the inventor's name as filed.

(C) The pages or lines appearing on the microfiche frames should be consecutively numbered.

(D) Pagination of the microfiche frames shall be from left to right and from top to bottom.

(E) At a reduction of 24:1 resolution of the original microfilm shall be at least 120 lines per mm (5.0 target) so that reproduction copies may be expected to comply with provisions of paragraph 7.1.4 of NMA Standard MS5.

(F) Background density of negative appearing camera master microfiche of filmed paper documents shall be within the range of 0.9 to 1.2 and line density should be no greater than 0.08. The density shall be visual diffuse density as measured using the method described in ANSI Standard PH 2.19.

(G) An index, when included, should appear in the last frame (lower right hand corner when data is right-reading) of each microfiche. See NMA-MS5, paragraph 6.6.

(viii) Microfiche generated by Computer Output Microfilm (COM).

(A) Background density of negative-appearing COM-generated camera master microfiche shall be within the range of 1.5 to 2.0 and line density should be no greater than 0.2. The density shall be visual diffuse density as described in ANSI PH2.19.

(B) The first frame of each microfiche submitted should contain a resolution test frame in conformance with NMA standard MS1.

(C) The second frame of each microfiche submitted must contain a fully descriptive title and the inventor's name as filed.

(D) The pages or lines appearing on the microfiche frames should be consecutively numbered.

(E) It is preferred that pagination of the microfiche frames be from left to right and top to bottom but the alternative, i.e., from top to bottom and from left to right, is also acceptable.

(F) An index, when included, should appear on the last frame (lower right hand corner when data is right reading) of each microfiche.

(G) Amendment of microfiche must be made by way of replacement microfiche.

Special procedures for presentation of computer program listings in the form of microfiche in U.S. national patent applications are set forth in 37 CFR 1.96. Use of microfiche is desirable in view of the number of computer program listings being submitted as part of the disclosure in patent applications. Such listings are often several hundred pages in length. By filing and publishing such computer program listings on microfiche rather than on paper, substantial cost savings can result to the applicants, the public, and the Patent and Trademark Office.

BACKGROUND

A computer program listing, as used in these rules, means the printout that lists, in proper sequence, the instructions, routines, and other contents of a program for a computer. The listing may be either in machine or machine-independent (object or source) programming language which will cause a computer to perform a desired task, such as solving a problem, regulating the flow of work in computer, or controlling or monitoring events. The general description of the computer program listing will appear in the specification while computer program listing may appear either directly or as a microfiche as appendix to the specification and be incorporated into the specification by reference.

DISCUSSION OF THE BACKGROUND AND MAJOR ISSUES INVOLVED

The provisions of 37 CFR 1.52 and 1.84 for submitting specifications and drawings on paper have been found suitable for most patent applications. However, when lengthy computer program listings must be disclosed in a patent application in order to provide a complete disclosure, use of paper copies can become burdensome.

The cost of printing long computer programs in patent documents is also very expensive to the Patent and Trademark Office.

In the past, all disclosures forming part of a patent application were presented on paper with the exception of microorganisms. Under 37 CFR 1.96, several different methods for submitting computer program listings, including the use of microfiche, are set forth.

Relatively short computer program listings (10 pages or less) must be submitted on paper and will be printed as part of the patent. If the computer program listing is 11 or more pages in length, it may be submitted on either paper or microfiche, although microfiche is preferred.

Copies of publicly available computer program listings are available from the Patent and Trademark Office on paper and on microfiche at the cost set forth in 37 CFR 1.19(a)(5) and (6).

OTHER INFORMATION

The micrographic standards referred to in 37 CFR 1.96(b)(2) may be obtained from either the National Micrographic Association, 8719 Colesville Road, Silver Spring, Maryland, 20910 or the American National Standards Institute, 1430 Broadway, New York, New York 10018.

The effect of 37 CFR 1.96 is that if a computer program listing (printout) is 11 or more pages long, the applicant may submit such listing in the form of microfiche. Relatively short computer program listings (10 pages or fewer) must be submitted on paper and will be printed as part of the patent, as in the past. When the computer program listing is 11 or more pages in length, it may be submitted on either paper or microfiche, although microfiche is preferred. A microfiche filed with a patent application will be referred to as a "Microfiche Appendix," and will be identified as such on the front page of the patent but will not be part of the printed patent. "Microfiche Appendix," denotes the total microfiche, whether only one or two or more. One microfiche is equivalent to a maximum of either 63 (9x7) or 98 (14x7) frames (pages), or less.

The face of the file jacket will bear a label to denote that a Microfiche Appendix is included in the application. A statement must be included in the specification to the effect that a microfiche appendix is included in the application. The specification entry must appear at the beginning of the specification immediately following any cross-reference to related applications, 37 CFR 1.77(c)(2). The patent front page and the *Official Gazette* entry will both contain information as to the number of microfiche and frames of computer program listings appearing in the microfiche appendix.

When an application containing microfiche is received in the Correspondence and Mail Division, a special pocket will be affixed to the center section of the inside of the file wrapper underneath all papers, and the microfiche inserted therein. The application file will then proceed on its normal course, and when it reaches the Application Branch, a label which sticks up above the file wrapper will be placed at the center section of the face of the wrapper. When the application file reaches the Micrographics Division, the Microfiche Appendix label will be placed on the face of the file wrapper. When the Allowed Files and Assembly Branch of the Office of Publications receives the application file, the person placing the patent number on the face of the file, upon seeing the Microfiche Appendix label, will give the file to the Supervisor who will call Micrographics Division and give the serial number and

patent number, and request copies of the microfiche. Micrographics Division personnel will then put the patent number on the microfiche(s), making certain each microfiche is the most recent, and numbering each correctly; e.g., 1 of 1, 1 of 2, etc Upon completion, two copies will be produced and provided to Allowed and Assembly Branch Files — one for the grant head and one for the file wrapper.

At the time of assembly, the Microfiche Appendix will be placed inside the grant head behind the patent grant for eyeletting, ribboning, and mailing to the patentee/attorney. During the signing of the grant heads by the Attesting Officer, the patent will be checked to assure proper assembly prior to mailing.

609 Information Disclosure Statement

37 CFR 1.97. Filing of information disclosure statement.

(a) In order to have information considered by the Office during the pendency of a patent application, an information disclosure statement in compliance with § 1.98 should be filed in accordance with this section.

(b) An information disclosure statement shall be considered by the Office if filed:

(1) Within three months of the filing date of a national application;

(2) Within three months of the date of entry of the national stage as set forth in § 1.491 in an international application; or

(3) Before the mailing date of a first Office action on the merits, whichever event occurs last.

(c) An information disclosure statement shall be considered by the Office if filed after the period specified in paragraph (b) of this section, but before the mailing date of either:

(1) A final action under § 1.113 or

(2) A notice of allowance under § 1.311,

whichever occurs first, provided the statement is accompanied by either a certification as specified in paragraph (e) of this section or the fee set forth in § 1.17(p).

(d) An information disclosure statement shall be considered by the Office if filed after the mailing date of either:

(1) A final action under § 1.113 or

(2) A notice of allowance under § 1.311,

whichever occurs first, but before payment of the issue fee, provided the statement is accompanied by:

(i) A certification as specified in paragraph (e) of this section,

(ii) A petition requesting consideration of the information disclosure statement, and

(iii) The petition fee set forth in § 1.17(i)(1).

(e) A certification under this section must state either:

(1) That each item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the statement, or

(2) That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to the knowledge of the person signing the certification after making reasonable inquiry, was known to any individual designated in § 1.56(c) more than three months prior to the filing of the statement.

(f) No extensions of time for filing an information disclosure statement are permitted under § 1.136. If a bona fide attempt is made to comply with § 1.98, but part of the required content is inadvertently omitted, additional time may be given to enable full compliance.

(g) An information disclosure statement filed in accordance with this section shall not be construed as a representation that a search has been made.

(h) The filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in § 1.56(b).

(i) Information disclosure statements, filed before the grant of a patent, which do not comply with this section and § 1.98 will be placed in the file, but will not be considered by the Office.

37 CFR 1.98. Content of information disclosure statement.

(a) Any information disclosure statement filed under § 1.97 shall include:

(1) A list of all patents, publications or other information submitted for consideration by the Office;

(2) A legible copy of :

(i) Each U.S. and foreign patent;

(ii) Each publication or that portion which caused it to be listed; and

(iii) All other information or that portion which caused it to be listed, except that no copy of a U.S. patent application need be included; and

(3) A concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from the specification or incorporated therein.

(b) Each U.S. patent listed in an information disclosure statement shall be identified by patentee, patent number and issue date. Each foreign patent or published foreign patent application shall be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application. Each publication shall be identified by author (if any), title, relevant pages of the publication, date and place of publication.

(c) When the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications may be submitted without copies of the other patents or publications provided that a statement is made that these other patents or publications are cumulative. If a written English-language translation of a non-English language document, or portion thereof, is within the possession, custody or control of, or is readily available to any individual designated in § 1.56(c), a copy of the translation shall accompany the statement.

(d) A copy of any patent, publication or other information listed in an information disclosure statement is not required to be provided if it was previously cited by or submitted to the Office in a prior application, provided that the prior application is properly identified in the statement and relied upon for an earlier filing date under 35 U.S.C. 120.

Applicants and other individuals substantively involved with the preparation and/or prosecution of a patent application have a duty to submit to the Office information which is material to patentability as defined in 37 CFR 1.56. These individuals also may want the Office to consider information for a variety of other reasons; e.g., without first determining whether the information meets any particular standard of materiality, or because another patent office considered the information to be relevant in a counterpart or related patent application filed in another country, or to make sure that the examiner has an opportunity to consider the same informa-

tion that was considered by the individuals that were substantively involved with the preparation or prosecution of a patent application.

An information disclosure statement filed in accordance with the provisions of 37 CFR 1.97 and 1.98 provides the procedure available to an applicant to submit information to the Office so that the information will be considered by the examiner assigned to the application. The requirements for the content of a statement have been simplified in the new rules which became effective on March 16, 1992, to encourage individuals associated in a substantive way with the filing and prosecution of a patent application to submit information to the Office so the examiner can determine its relevance to the claimed invention. The procedures for submitting an information disclosure statement under the new rules are designed to encourage individuals to submit information to the Office promptly.

In order to have information considered by the Office during the pendency of a patent application, an information disclosure statement in compliance with 37 CFR 1.98 as to content must be filed in accordance with the procedural requirements of 37 CFR 1.97. The requirements as to content are discussed in A below. The requirements based on the time of filing the statement are discussed in B below. Examiner handling of information disclosure statements is discussed in C below.

The Office has set forth the minimum requirements for information to be considered in 37 CFR 1.97 and 1.98. Once the minimum requirements are met, the examiner has an obligation to consider the information. These rules provide certainty for the public by defining the requirements for submitting information to the Office so that the Office will consider information before a patent is granted. Information submitted to the Office that does not comply with the requirements of 37 CFR 1.97 and 1.98 will not be considered by the Office but will be placed in the application file.

The filing of an information disclosure statement shall not be construed as a representation that a search has been made. 37 CFR 1.97(g). There is no requirement that an applicant for a patent make a patentability search. Further, the filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in 37 CFR 1.56(b). 37 CFR 1.97(h). See MPEP § 706.02(b) regarding admissions by applicant.

Multiple information disclosure statements may be filed in a single application, and they will be considered, provided each is in compliance with the appropriate requirements. Use of form PTO–1449, "Information Disclosure Citation," is encouraged as a means to provide the required list of information. See C(2) below.

Information which is cited or submitted to the Office in the parent application of a file wrapper continuing application under 37 CFR 1.62 will be part of the file before the examiner and need not be resubmitted in the continuing application to have the information considered and listed on the patent. Likewise, the examiner will consider information cited or submitted to the Office in a parent application when examining a continuing application which is not a file wrapper continuing application, and a list of the information need not be submitted in the continuing application unless applicant desires the information to be printed on the patent.

The examiner will consider the documents cited in the international search report in a PCT national stage application, when the Form PCT/DO/EO/903 indicates that both the international search report and the copies of the documents are present in the national stage file. In such a case, the examiner should consider the documents from the international search report and indicate by a statement in the first Office action that the information has been considered. There is no requirement that the examiner list the documents on a PTO–892 form.

A. CONTENT

An information disclosure statement must comply with the provisions of 37 CFR 1.98 as to content in order to be considered by the Office. Each information disclosure statement must comply with the applicable provisions of A(1), A(2), and A(3) below.

A (1) Each information disclosure statement must include a list of all patents, publications, or other information submitted for consideration by the Office.

37 CFR 1.98(b) requires that each U.S. patent listed in an information disclosure statement be identified by patentee, patent number, and issue date. Each foreign patent or published foreign patent application must be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application. Each publication must be identified by author (if any), title, relevant pages of the publication, date and place of publication. The date of publication supplied must include at least the month and year of publication, except that the year of publication (without the month) will be accepted if the applicant points out in the information disclosure statement that the year of publication is sufficiently earlier than the ef–

fective U.S. filing date and any foreign priority date so that the particular month of publication is not in issue. The place of publication refers to the name of the journal, magazine, or other publication in which the information being submitted was published.

To comply with this requirement, the list may not be incorporated into the specification but must be submitted in a separate paper. A separate list is required so that it is easy to confirm that applicant intends to submit an information disclosure statement and because it provides a readily available checklist for the examiner to indicate which identified documents have been considered. A copy of a separate list will also provide a simple means of communication to applicant to indicate the listed documents that have been considered and those listed documents that have not been considered. Use of form PTO-1449, Information Disclosure Citation, is encouraged. See C(2) below.

A (2) In addition to the list, each information disclosure statement must also include a legible copy of:

(i) Each U.S. and foreign patent;

(ii) Each publication or that portion which caused it to be listed; and

(iii) All other information or that portion which caused it to be listed, except that no copy of a U.S. patent application need be included.

There are exceptions to this general rule that a copy must be provided. First, 37 CFR 1.98(d) states that a copy of any patent, publication, or other information listed in an information disclosure statement is not required to be provided if it was previously cited by or submitted to the Office in a prior application, provided that the prior application is properly identified in the statement and relied on for an earlier filing date under 35 U.S.C. 120. The examiner will consider information cited or submitted to the Office in a prior application relied on under 35 U.S.C. 120. This exception to the requirement for copies of information does not apply to information which was cited in an international application under the Patent Cooperation Treaty. If the information cited or submitted in the prior application was not in English, a concise explanation of the relevance of the information to the new application is not required unless the relevance of the information differs from its relevance as explained in the prior application. See A(3) below.

Second, 37 CFR 1.98(c) states that when the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications may be submitted without copies of the other patents or publications provided that a statement is made that these other patents or publications are cumulative. The examiner will then consider only the patent or publication of which a copy is submitted and will so indicate on the list or form PTO-1449 submitted; e.g., by crossing out the listing of the cumulative information.

37 CFR 1.98(c) further states that if a written English language translation of a non-English language document, or portion thereof, is within the possession, custody or control of, or is readily available to any individual designated in 37 CFR 1.56(c), a copy of the translation shall accompany the statement. Translations are not required to be filed unless they have been reduced to writing and are actually translations of what is contained in the non-English language information. If no translation is submitted, the examiner will consider the information in view of the concise explanation and insofar as it is understood on its face; e.g., drawings, chemical formulas, English language abstracts, in the same manner that non-English language information in Office search files is considered by examiners in conducting searches.

A (3) Each information disclosure statement must further include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from the specification or incorporated therein.

The requirement for a concise explanation of relevance is limited to information that is not in the English language. The explanation required is limited to the relevance as understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information at the time the information is submitted to the Office. If a translation of the information into English is submitted with the foreign language information, no concise explanation is required. An English-language equivalent application may be submitted to fulfill this requirement if it is, in fact, a translation of a foreign language application being listed in an information disclosure statement. There is no requirement for the translation to be verified. Submission of an English language abstract of a reference which does not deal with its relevance to the invention will not fulfill the requirement for a concise explanation. Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation

of which portion of the reference is particularly relevant, to which claims it applies, or merely an "X", "Y", or "A" indication on a search report. The requirement for a concise explanation of non-English language information would not be satisfied by a statement that a reference was cited in the prosecution of a parent, related, or copending United States application.

The concise explanation may indicate that a particular figure or paragraph of the patent or publication is relevant to the claimed invention. It might be a simple statement pointing to similarities between the item of information and the claimed invention. It is permissible but not necessary to discuss differences between the cited information and the claims.

Applicants may, if they wish, provide a concise explanation of why English-language information is being submitted and how it is understood to be relevant. Concise explanations are helpful to the Office, particularly where documents are lengthy and complex and applicant is aware of a section that is highly relevant to patentability or where a large number of documents are submitted and applicant is aware that one or more are highly relevant to patentability.

B. TIME FOR FILING

The procedure and requirements for submitting an information disclosure statement are linked to four stages in the processing of a patent application: (1) within 3 months of filing, or before first Office action, whichever is later; (2) after the period in (1), but before final Office action or a Notice of Allowance, whichever is earlier; (3) after the period in (2) but on or before the date the issue fee is paid; and (4) after the period in (3) and up to the time the patent application can be effectively withdrawn from issue. The procedures and requirements apply to applications filed under 35 U.S.C. 111 (utility), 161 (plants), 171 (designs), and 251 (reissue), as well as international applications entering the national stage under 35 U.S.C. 371.

The requirements based on the time when the information disclosure statement is filed are summarized as follows.

Time when IDS is filed	37 CFR 1.97 Requirements
(1) Within 3 months of filing or before first Office action on the merits, whichever is later.	None (always considered).
(2) After (1) but before final action or notice of allowance.	Certification or 1.17(p) fee.
(3) After final action or notice of allowance and before payment of issue fee	Certification, petition, and petition fee.

B (1) Statement filed BEFORE first action on the merits or within three (3) months of actual filing date (37 CFR 1.97(b)).

An information disclosure statement will be considered by the examiner if filed:

(i) within 3 months of the filing date of a national application;

(ii) within 3 months of the date of entry of the national stage as set forth in 37 CFR 1.491 in an international application; or

(iii) before the mailing date of a first Office action on the merits,

whichever event occurs last. A statement filed within this period requires neither a fee nor a certification of prompt filing.

The term "national application" includes continuing applications (continuations, divisions, continuations-in-part) so 3 months will be measured from the actual filing date of an application as opposed to the effective filing date of a continuing application.

All information disclosure statements that comply with the content requirements of 37 CFR 1.98 and are filed within three months of the filing date will be considered by the examiner, regardless of whatever else has occurred in the examination process up to that point in time. Thus, in the rare instance that a final Office action or a notice of allowance is prepared and mailed prior to a date which is 3 months from the filing date, any information contained in a complete information disclosure statement filed within that 3-month window will be considered by the examiner.

Likewise, an information disclosure statement will be considered if it is filed later than 3 months after the filing date but before the mailing date of a first Office action on the merits. An action on the merits means an action which treats the patentability of the claims in an application, as opposed to only formal or procedural requirements. An action on the merits would, for example, contain a rejection or indication of allowability of a claim or claims rather than just a restriction requirement (37 CFR 1.142) or just a requirement for additional fees to have a claim considered (37 CFR 1.16(d)). Thus, if an application was filed on January 1 and the first Office action on the merits was not mailed until 6 months later on July 1, the examiner would be required to consider any proper information disclosure statement filed prior to July 1.

An information disclosure statement will be considered to have been filed on the day it was received in the Office, or on an earlier date of mailing if accompanied by a properly executed certificate of mailing or facsimile transmission under 37 CFR 1.8, or Express Mail certificate under 37 CFR 1.10.

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An Office action is mailed on the date indicated in the Office action.

B (2) Statement filed after B(1), but BEFORE mailing of final action or notice of allowance (37 CFR 1.97(c)).

An information disclosure statement will be considered by the examiner if filed after the period specified in B(1) above, but before (not on the same day as) the mailing date of either

a final action under 37 CFR 1.113; e.g., final rejection or notice of allowability, or

a notice of allowance under 37 CFR 1.311,

whichever occurs first, provided: (1) the statement is accompanied by either a certification as specified in 37 CFR 1.97(e) or (2) the fee set forth in 37 CFR 1.17(p). If a final action or notice of allowance is mailed in an application and later withdrawn, the application will be considered as not having had a final action or notice of allowance mailed for purposes of considering an information disclosure statement.

An *Ex parte Quayle* action is not a final action under 37 CFR 1.113 as referred to in 37 CFR 1.97. Therefore, an information disclosure statement filed after an *Ex parte Quayle* action, but before mailing of a notice of allowance, must comply with the provisions of 37 CFR 1.97 (c) rather than those of 37 CFR 1.97 (d). However, where an *Ex parte Quayle* action is issued after a final rejection which has not been withdrawn, any information disclosure statement filed after the *Ex parte Quayle* action must comply with the provisions of 37 CFR 1.97(d).

(i) If information submitted during the period set forth in 37 CFR 1.97(c) with a certification is used in a new ground of rejection on unamended claims, the next Office action will not be made final since in this situation it is clear that applicant has submitted the information to the Office promptly after it has become known and the information is being submitted prior to a final determination on patentability by the Office. The information submitted with a certification can be used in a new ground of rejection and the next Office action made final, however, if the new ground of rejection was necessitated by amendment of the application by applicant. Where the information is submitted during this period with a fee, the examiner may use the information submitted; e.g., printed publication or evidence of public use, and make the next Office action final whether or not the claims have been amended, provided that no other new ground of rejection which was not necessitated by amendment to the claims is introduced by the examiner. See MPEP § 706.07(a). If a new ground of rejection is introduced that is neither necessitated by an amendment to the claims nor based on the information submitted with the fee set forth in 37 CFR 1.17(p), the Office action shall not be made final.

(ii) A certification under 37 CFR 1.97(e) must state either

(a) that each item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the statement, or

(b) that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to the knowledge of the person signing the certification after making reasonable inquiry, was known to any individual designated in 37 CFR 1.56(c), more than three months prior to the filing of the statement.

A certification can contain either of two statements. One statement is that each item of information in an information disclosure statement was cited in a communication, such as a search report, from a patent office outside the U.S. in a counterpart foreign application not more than 3 months prior to the filing date of the statement. Under this certification, it does not matter whether any individual with a duty of disclosure actually knew about any of the information cited before receiving the search report. The date on the communication by the foreign patent office begins the 3-month period in the same manner as the mailing of an Office action starts a 3-month shortened statutory period for response. If the communication contains two dates, the mailing date of the communication is the one which begins the 3-month period. The date which begins the 3-month period is not the date the communication was received by a foreign associate or the date it was received by a U.S. registered practitioner. Likewise,the statement will be considered to have been filed on the date the statement was received in the Office, or on an earlier date of mailing or transmission if accompanied by a properly executed certificate of mailing or facsimile transmission under 37 CFR 1.8, or Express Mail certificate under 37 CFR 1.10.

The term counterpart foreign patent application means that a claim for priority has been made in either the U.S. application or a foreign application based on the other, or that the disclosures of the U.S. and foreign patent applications are substantively identical (e.g., an application filed in the European Patent Office claiming the same U.K. priority as claimed in the U.S. application).

Communications from foreign patent offices in foreign applications sometimes include a list of the family of patents corresponding to a particular patent being cited in the communication. The family of patents may include a United

States patent or other patent in the English language. Some applicants submit information disclosure statements to the PTO which list and include copies of both the particular patent cited in the foreign patent office communication and the related United States or other English language patent from the family list. Since this is to be encouraged, the United States or other English language patent will be construed as being cited by the foreign patent office for purposes of a certification under 37 CFR 1.97(e)(1). The examiner should consider the United States or other English language patent if 37 CFR 1.97 and 1.98 are complied with.

If an information disclosure statement includes a copy of a dated communication from a foreign patent office which clearly shows that the statement is being submitted within 3 months of the date on the communication, the copy will be accepted as the required communication. It will be assumed, in the absence of evidence to the contrary, that the communication was for a counterpart foreign application.

In the alternative, a certification can be made if no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to the knowledge of the person signing the certification after making reasonable inquiry, neither was it known to any individual having a duty to disclose more than 3-months prior to the filing of the statement.

The phrase "after making reasonable inquiry" makes it clear that the individual making the certification has a duty to make reasonable inquiry regarding the facts that are being certified. The certification can be made by a registered practitioner who represents a foreign client and who relies on statements made by the foreign client as to the date the information first became known. A registered practitioner who receives information from a client without being informed whether the information was known for more than 3 months, however, cannot make the certification without making reasonable inquiry. For example, if an inventor gave a publication to the attorney prosecuting an application with the intent that it be cited to the Office, the attorney should inquire as to when that inventor became aware of the publication and should not submit a certification under 37 CFR 1.97(e)(2) to the Office until a satisfactory response is received. The certification can be based on present, good faith knowledge about when information became known without a search of files being made.

Certification need not be in the form of an oath or a declaration under 37 CFR 1.68. Certification by a registered practitioner or any other individual that the statement was filed within the 3-month period of either first citation by a foreign patent office or first discovery of the information will be accepted as dispositive of compliance with this provision in the absence of evidence to the contrary. For example, a certification could read as follows:

> "I hereby certify that each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than 3 months prior to the filing of this statement.", or
>
> "I hereby certify that no item of information in the Information Disclosure Statement filed herewith was cited in a communication from a foreign patent office in a counterpart foreign application or, to my knowledge after making reasonable inquiry, was known to any individual designated in 37 CFR 1.56(c) more than 3 months prior to the filing of this Information Disclosure Statement."

An information disclosure statement may include two lists and two certifications, similar to the above examples, in situations where some of the information listed was cited in a communication from a foreign patent office not more than 3 months prior to filing the statement and some was not, but was not known more than 3 months prior to filing the statement.

A copy of the foreign search report need not be submitted with the certification, but an individual may wish to submit an English-language version of the search report to satisfy the requirement for a concise explanation where non-English language information is cited. The time at which information was known to any individual designated in 37 CFR 1.56(c) is the time when the information was discovered in association with the application even if awareness of the materiality came later. The Office wishes to encourage prompt evaluation of the relevance of information and to have a date certain for determining if a certification can properly be made. A statement on information and belief would not be sufficient. Examiners should not remind or otherwise make any comment about an individual's duty of candor and good faith, but questions about the adequacy of any certification received in writing by the Office should be directed to the Office of the Assistant Commissioner for Patents.

B(3) Statement Filed After B(2), but Prior to Payment of Issue Fee (37 CFR 1.97(d)).

An information disclosure statement will be considered by the examiner if filed on or after the mailing date of either a final action under 37 CFR 1.113 or a notice of allowance under 37 CFR 1.311, whichever occurs first, but before or simul-

taneous with payment of the issue fee, provided the statement is accompanied by:

(i) a certification as specified in 37 CFR 1.97(e) (see the discussion in B(2)(ii) above),

(ii) a petition requesting consideration of the information disclosure statement, and

(iii) the petition fee set forth in 37 CFR 1.17(i)(1).

These requirements are appropriate in view of the late stage of prosecution when the information is being submitted; i.e., after the examiner has reached a final determination on the patentability of the claims presented for examination. The petition should be directed to the Group Director of the examining group handling the application. The petition need do nothing more than request consideration of the information being submitted. Payment of the petition fee (37 CFR 1.17(i)(1)) and submission of the appropriate certification 37 CFR 1.97(e)) are the essential elements for having information considered at this advanced stage of prosecution, assuming the content requirements of 37 CFR 1.98 are satisfied.

The requirements of 37 CFR 1.97 provide for consideration by the Office of information which is submitted within a reasonable time; i.e., within 3 months after an individual designated in 37 CFR 1.56(c) becomes aware of the information or within 3 months of the information being cited in a communication from a foreign patent office in a counterpart foreign application. This undertaking by the Office to consider information would be available throughout the pendency of the application until the point where the patent issue fee was paid. If an applicant chose not to comply, or could not comply, with the requirements of 37 CFR 1.97(d), a continuing application could be filed to have the information considered by the examiner. The parent application could be permitted to become abandoned by not paying the issue fee required in the Notice of Allowance, for example, or by the filing of a file wrapper continuing application under 37 CFR 1.62. It would not be proper to make final a first Office action in the continuing application if the information submitted is used in a new ground of rejection.

B(4) Statement Filed After Payment of Issue Fee.

After the issue fee has been paid on an application, it is impractical for the Office to attempt to consider newly submitted information. Information disclosure statements filed after payment of the issue fee in an application will not be considered but will merely be placed in the application file. See C below. The application may be withdrawn from issue at this point, however, pursuant to 37 CFR 1.313(b)(5) so that the information can be considered in a continuing application. In this situation, a file wrapper continuing application under 37 CFR 1.62 could be filed even though the issue fee had already been paid. The Office will consider the filing of a petition under 37 CFR 1.313(b)(5) as sufficient grounds to waive the requirement that an application under 37 CFR 1.62 be filed before payment of the issue fee. Alternatively, for example, a petition pursuant to 37 CFR 1.313(b)(3) could be filed if applicant states that one or more claims are unpatentable. This statement that one or more claims are unpatentable over the information must be unequivocal. A statement that a serious question as to patentability of a claim has been raised, for example, would not be acceptable to withdraw an application from issue under 37 CFR 1.313(b)(3).

If an application has been withdrawn from issue under one of the provisions of 37 CFR 1.313(b)(1)–(4), it will be treated as though no notice of allowance had been mailed and the issue fee had not yet been paid with regard to the time for filing information disclosure statements. Petitions under 37 CFR 1.313(b) should be directed to the Office of Petitions in the Office of the Assistant Commissioner for Patents.

B(5) Extensions of Time (37 CFR 1.97(f))

No extensions of time for filing an information disclosure statement are permitted under 37 CFR 1.136(a) or (b). If a bona fide attempt is made to comply with the content requirements of 37 CFR 1.98, but part of the required content is inadvertently omitted, additional time may be given to enable full compliance.

C. EXAMINER HANDLING OF INFORMATION DISCLOSURE STATEMENTS

Information disclosure statements will be reviewed for compliance with the requirements of 37 CFR 1.97 and 1.98 as discussed in A and B above. Applicant will be notified of compliance and non-compliance with the rules as discusse below.

C(1) Noncomplying statements

Pursuant to 37 CFR 1.97(i), submitted information, filed before the grant of a patent, which does not comply with 37 CFR 1.97 and 1.98 will be placed in the file, but will not be considered by the Office. Information submitted after the grant of a patent must comply with 37 CFR 1.501.

(i) If an information disclosure statement does not comply with the requirements based on the time of filing the statement as discussed in B above, including the requirements for fees and/or certification, the statement will be placed in the application file, but none of the information will be considered by the examiner. The examiner may use Form Paragraph 6.49 which is reproduced below to inform applicant that the information has not been considered. Applicant may then file

a new information disclosure statement or correct the deficiency in the previously filed statement, but the date that the new statement or correction is filed will be the date of the statement for purposes of determining compliance with the requirements based on the time of filing the statement (37 CFR 1.97).

The examiner should write "not considered" on an information disclosure statement where none of the information listed complies with the requirements; e.g., no copies of listed items submitted. If none of the information listed on a PTO-1449 form is considered, a diagonal line should also be drawn in pencil across the form and the form placed on the right side of the application file to instruct the printer not to list the information on the face of the patent if the application goes to issue. The paper containing the disclosure statement or list will be placed in the record in the application file. The examiner will inform applicant that the information has not been considered and the reasons why by using form paragraph 6.49. If the improper citation appears as part of another paper; e.g., an amendment, which may be properly entered and considered, the portion of the paper which is proper for consideration will be considered.

¶ *6.49 Information Disclosure Statement Not Considered*

The information disclosure statement filed [1] fails to comply with the provisions of MPEP 609 because [2]. It has been placed in the application file, but the information referred to therein has not been considered as to the merits.

Examiner Note:

See MPEP § 609 for situations where use of this paragraph would be appropriate.

(ii) If an information disclosure statement complies with the requirements based on the time of filing the statement as discussed in B above, including the requirements for fees/or certification, but part of the content requirements as discussed in A above has been inadvertently omitted, the examiner may set a one-month time period to correct the omission. Form paragraph 6.51 may be used for this purpose.

¶ *6.51 Time Limit for Completing Information Disclosure Statement*

The Information Disclosure Statement filed on [1] does not comply with the requirements of 37 CFR 1.98 because [2]. Since the submission appears to be bona fide, but through an apparent oversight or inadvertence failed to comply with the necessary requirements, applicant is required to complete the statement within a time limit of one month from the date of this letter. NO EXTENSION OF THIS TIME LIMIT MAY BE GRANTED UNDER EITHER 37 CFR 1.136(a) OR (b). Failure to comply with this notice will result in the Information Disclosure Statement being placed in the application file with the non-complying information not being considered.

Examiner Note:

This practice does not apply where there has been a deliberate omission of some necessary part of an information disclosure statement or where the requirements based on the time of filing the statement as set forth in 37 CFR 1.97 have not been complied with.

If a statement fails to comply with requirements as discussed in this section for an item of information, that item of information in the statement will not be considered and a line should be drawn through the citation to show that it has not been considered. However, other items of information that do comply with all the requirements will be considered by the examiner.

If information is listed in the specification rather than in a separate paper, or if the other content requirements as discussed in A above are not complied with, the examiner will notify applicant in the next Office action that the information has not been considered. It should be noted, however, that no copy of a U.S. patent application is required to be submitted. See A(2)(iii) above. Where a U.S. patent application is properly cited on a separate list, the examiner should obtain access to that file within the Office.

C (2) Complying Statements

The information contained in information disclosure statements which comply with both the content requirements as discussed in A above and the requirements based on the time of filing the statement as discussed in B above will be considered by the examiner.

Applicants, patent owners, reexamination requesters, protestors, and others are encouraged to use form PTO-1449), "Information Disclosure Citation," when preparing an information disclosure statement. A copy of this form is reproduced in this section to indicate how the form should be completed. This form will enable persons to comply with the requirement to list each item of information being submitted and to provide the Office with a uniform listing of citations and with a ready way to indicate that information has been considered. Examiners must consider all citations submitted in conformance with the rules and this section and their initials when placed adjacent to the considered citations on the list or in the boxes provided on a form PTO-1449 provides a clear record of which citations have been considered by the Office. The examiner must also fill in his or her name and the date the information was considered in blocks at the bottom of the PTO-1449 form. If the citations are submitted on a list other than on a form PTO-1449, the examiner may write "all considered" and his or her initials to indicate that all citations have been considered. If any of the citations are considered, a copy of the submitted list or form PTO-1449, as reviewed by the examiner, will be returned to the applicant with the next communication. Those citations not considered by the examiner will have a line drawn through the citation and any citations considered will have the examiner's initials

adjacent thereto. The original copy of the list or form PTO-1449 will be entered into the application file. The copy returned to applicant will serve both as acknowledgement of receipt of the information disclosure statement and as an indication as to which references were considered by the examiner. Forms PTO-326 and PTOL-37 include a box to indicate the attachment of form PTO-1449.

Information which complies with requirements as discussed in this section but which is in a non-English language will be considered in view of the concise explanation submitted (A(3) above) and insofar as it is understood on its face; e.g., drawings, chemical formulas, in the same manner that non-English language information in Office search files is considered by examiners in conducting searches. The examiner need not have the information translated unless it appears to be necessary to do so. The examiner will indicate that the non-English language information has been considered in the same manner as consideration is indicated for information submitted in English. The examiner should not require that a translation be filed by applicant. The examiner should not make any comment such as that the non-English language information has only been considered to the extent understood, since this fact is inherent.

Since information is required to be submitted in a separate paper listing the citations rather than in the specification, there is no need to mark All checked or Checked in the margin of a specification containing citations.

If a statement fails to comply with requirements as discussed in this section for an item of information, a line should be drawn through the citation to show that it has not been considered. The other items of information listed that do comply with the rules and this section will be considered by the examiner and will be appropriately initialed.

C (3) Documents Submitted As Part of Applicant's Response to Office Action

Occasionally, documents are submitted and relied on by an applicant when responding to an Office action. These documents may be relied on by an applicant, for example, to show that an element recited in the claim is operative or that a term used in the claim has a recognized meaning in the art. Documents may be in any form but are typically in the form of an affidavit, declaration, patent, or printed publication.

To the extent that a document is submitted as evidence directed to an issue of patentability raised in an Office action, and the evidence is timely presented, applicant need not satisfy the requirements of 37 CFR 1.97 and 1.98 in order to have the examiner consider the information contained in the document relied on by applicant. In other words, compliance with the information disclosure rules is not a threshold requirement to have information considered when submitted by applicant to support an argument being made in a response to an Office action.

At the same time, the document supplied and relied on by applicant as evidence need not be processed as an item of information that was cited in an information disclosure statement. The record should reflect whether the evidence was considered, but listing on a form (e.g., PTO-892 or PTO-1449) and appropriate marking of the form by the examiner is not required.

For example, if applicant submits and relies on three patents as evidence in response to the first Office action and also lists those patents on a PTO-1449 along with two journal articles, but does not file a certification or $200 fee, it would be appropriate for the examiner to indicate that the teachings relied on by applicant in the three patents have been considered, but to line through the citation of all five documents on the PTO-1449 and to inform applicant that the information disclosure statement did not comply with 37 CFR 1.97(c).

D. INFORMATION PRINTED ON PATENT

A citation listed on form PTO-1449 and considered by the examiner in accordance with this section will be printed on the patent. A citation listed in a separate paper, equivalent to but not on form PTO-1449, and considered by the examiner in accordance with this section will be printed on the patent if the list is on a separate sheet which is clearly identified as an information disclosure statement and the list lends itself to easy capture of the necessary information by the Office printing contractor; i.e., each item of information is listed on a single line, the lines are at least double-spaced from each other, the information is uniform in format for each listed item, and the list includes a column for the examiner's initials to indicate that the information was considered. If a U.S. patent application serial number is listed on a PTO-1449 form or its equivalent and the examiner considers the information and initials the form, the serial number will be printed on the patent.

Applicants may wish to list U.S. patent application serial numbers on other than a form PTO-1449 format to avoid the serial numbers of pending applications being published on the patent. If a citation is not printed on the patent but has been considered by the examiner in accordance with this section, the patented file will reflect that fact as noted in C(2) above.

PTO/SB/08 (2-92)

Sheet 1 of 4

Form PTO-1449

INFORMATION DISCLOSURE CITATION IN AN APPLICATION

(Use several sheets if necessary)

Docket Number (Optional)	Application Number
32210	07/123,456
Applicant C. Benson, et al	
Filing Date 1-2-91	**Group Art Unit** 3401

U.S. PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
JD.	3 7 0 3 4 4 5	11-72	Tew	418	61	
JD.	3 9 9 4 0 0 0	6-75	Reitter	418	61	
JD.	3 6 9 4 5 0 9	1-71	Sarich	418	61	
JD.	4 3 2 5 7 7 7	5-90	Wolfe	418	63	

FOREIGN PATENT DOCUMENTS

	DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	Translation YES	Translation NO
~~———~~	~~2 3 8 5 4 0~~	~~06-75~~	~~France~~				
JD.	1 1 3 7 7 2 9	06-65	Federal Republic of Germany	418	63	X	
JD.	9 1 4 1	08-79	European Patent Office				
JD.	WO80/0 1 8 7 1	09-80	PCT International				
JD.	5 0 - 3 1 0 6	11-79	Japan	260	424		X

OTHER DOCUMENTS *(Including Author, Title, Date, Pertinent Pages, Etc.)*

JD.	Kovach, et al "Simple Precision RC Oscillator," IBM Tech. Disclosure Bulletin Vol. 16, No. 10.
	3/74, p.p. 3174-3175
~~———~~	~~Tiers, J. Am. Chem. Soc. 825513 (1960)~~

EXAMINER	DATE CONSIDERED
J. Doe	Sept. 30, 1991

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to the applicant.

PTO/SB/ 08 (2-92) Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

620.06 Correction of File Wrapper Label

It is sometimes necessary to return applications to the Application Branch for correction of the file wrapper label. Instances where such a return is necessary include:

1. Correction of Inventorship such as changes in the order of the names or a change in the name of an inventor, granted by petition, and additions or deletions of inventors under 37 CFR 1.48. See MPEP 605.04(g).

2. Correction of the Filing Date.

3. Correction concerning prior U.S. applications which have serial number errors. See MPEP § 202.02.

4. Correction of application type, for example, where an application is filed under 37 CFR 1.60 but is not shown as such on the file wrapper.

The application must be sent to the Application Branch for correction of the file wrapper label and should be accompanied by an Application Branch Data Base Routing Slip with an explanation of the correction to be made.

All other corrections are performed in the examining group. For example, changes to the title, power of attorney, and correspondence address may be made with red ink.