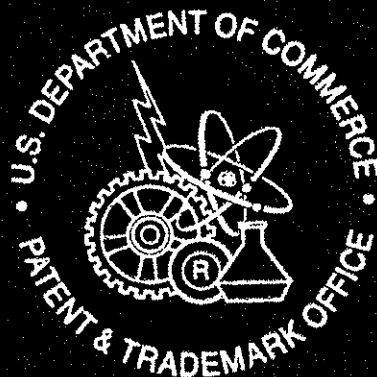


Manual of PATENT EXAMINING PROCEDURE



U.S. PATENT AND TRADEMARK OFFICE

PROPERTY OF THE UNITED STATES GOVERNMENT

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

MANUAL OF PATENT EXAMINING PROCEDURE
Seventh Edition

The enclosed is the Seventh Edition to the Manual of Patent Examining Procedure. The Manual has been revised extensively to incorporate the changes necessitated by the final rules, "Changes to Patent Practice and Procedure," which became effective as of December 1, 1997. Changes are highlighted on the following pages.

This Edition of the Manual was prepared with the assistance of the Senior Legal Advisors of the Special Program Law Office. Their efforts are greatly appreciated.

Magdalen Y. C. Greenlief, Editor
Manual of Patent Examining Procedure

July 1998

Particular attention is called to the changes in the following sections:

CHAPTER 100:

- 101 Revised to reflect amendment to 37 CFR 1.14.
- 102 Revised to reflect amendment to 37 CFR 1.14.
- 103 Revised to reflect amendment to 37 CFR 1.14, and to incorporate current procedures for obtaining a copy of a pending application that is incorporated by reference in a U.S. patent. Also revised to indicate that a continued prosecution application filed under 37 CFR 1.53(d) of a reissue application will not be announced in the *Official Gazette*.
- 105 Revised heading to read "Suspended or Excluded Practitioner Cannot Inspect."
- 106 Revised to state that any request to prevent an inventor from obtaining access to the application file should be submitted as a separate paper and should be directed to the Office of Petitions.
- 120 Revised to reflect amendments to 37 CFR 5.1, 5.2, 5.3, 5.4 and 5.5.
- 140 Revised to reflect amendments to 37 CFR 5.11, 5.12, 5.13, 5.14, 5.15, 5.18, 5.19 and 5.20.

CHAPTER 200:

- 201 Revised to delete the references to 37 CFR 1.60 and 1.62 since these rules were deleted effective December 1, 1997.
- 201.03 Rewritten to reflect amendment to 37 CFR 1.48. 37 CFR 1.48 does not apply to reissue applications. Correction of inventorship in an application, other than a reissue application, may be obtained by filing an appropriate petition under 37 CFR 1.48. Correction of inventorship may also be obtained by the

filing of a continuing application under 37 CFR 1.53 without the need for filing a petition under 37 CFR 1.48, either in the application containing the inventorship error or in the continuing application. 37 CFR 1.48(a) is directed to correction of inventorship in an application where the inventorship was improperly set forth in the executed oath or declaration filed in the application. 37 CFR 1.48(b) is directed at correcting the inventorship where the executed oath or declaration had correctly set forth the inventorship but due to prosecution of the application fewer than all of the currently named inventors are the actual inventors of the remaining claims. 37 CFR 1.48(c) is directed at correcting the inventorship where the executed oath or declaration had correctly set forth the inventorship but due to amendment of the claims to include previously unclaimed but disclosed subject matter, one or more inventors of the amended subject matter must be added to the current inventorship. 37 CFR 1.48(d) is directed at provisional applications where an inventor is to be added. 37 CFR 1.48(e) is directed at provisional applications where an inventor is to be deleted. 37 CFR 1.48(f) operates to automatically correct the inventorship upon filing of an executed oath or declaration under 37 CFR 1.63 in a nonprovisional application or upon filing of a cover sheet in a provisional application.

- 201.04(b) Revised to reflect amendment to 37 CFR 1.53(c).
- 201.06 Revised to indicate that effective December 1, 1997, 37 CFR 1.60 and 1.62 have been deleted and that a divisional application may be filed under 37 CFR 1.53(b) or 1.53(d).
- 201.06(a) Revised to indicate that 37 CFR 1.60 has been deleted effective December 1, 1997 and that the discussion of divisional-continuation practice under former 37 CFR 1.60 is being retained in the MPEP and that all references to the rules in this section are directed to the rules that were in effect prior to December 1, 1997. All continuation and divisional applications filed under 37 CFR 1.60 prior to December 1, 1997 will continue to be processed and examined under the procedures set forth in former 37 CFR 1.60.

- 201.06(b) Revised to indicate that 37 CFR 1.62 has been deleted effective December 1, 1997 and that the discussion of former 37 CFR 1.62 practice is being retained in the MPEP and that all references to the rules in this section are directed to the rules that were in effect prior to December 1, 1997. All continuation, divisional, and CIP applications filed under 37 CFR 1.62 prior to December 1, 1997 will continue to be processed and examined under the procedures set forth in former 37 CFR 1.62.
- 201.06(c) New section added to address the divisional-continuation practice under 37 CFR 1.53(b).
- 201.06(d) New section added to address the continued prosecution application (CPA) practice under 37 CFR 1.53(d).
- 201.07 Revised to indicate that a continuation application may be filed under 37 CFR 1.53(b) or 1.53(d).
- 201.08 Revised to indicate that a CIP application may only be filed under 37 CFR 1.53(b). A CIP application cannot be filed as a continued prosecution application under 37 CFR 1.53(d).
- 201.11 Revised to indicate that in a continued prosecution application (CPA), a specific reference in the first sentence of the specification following the title to a prior application assigned the same application number is not required and should not be made. A request for a CPA filed under 37 CFR 1.53(d) is itself the specific reference required by 35 U.S.C. 120 and 37 CFR 1.78(a)(2) to every application assigned the same application number identified in the request.
- 201.13 Revised to reflect amendment to 37 CFR 1.55(a). The list of countries for which 35 U.S.C. 119(a)-(d) priority is granted has been updated. Bahrain, Democratic Republic of the Congo, Equatorial Guinea, Sierra Leone, and Venezuela have been added. Revised to clarify when the Office is open for filing papers.

- 201.14(a) Revised to reflect amendment to 37 CFR 1.55(a).
- 202.01 Revised to reflect amendments to 37 CFR 1.78(a)(1) and (a)(2).
- 202.02 Revised to indicate that for applications with the 09 series code, the identifying data of the parent or prior applications appear on the PALM bib-data sheet rather than on the file wrapper.
- 202.03 Revised to indicate that for applications with the 09 series code, the information regarding the foreign priority claim appears on the PALM bib-data sheet rather than on the file wrapper.

CHAPTER 300:

- 302 Revised to reflect amendment to 37 CFR 3.11.
- 302.02 Revised to reflect amendment to 37 CFR 3.26. The requirement for verification of the English translation of assignment document has been deleted in view of the amendment to 37 CFR 1.4(d)(2).
- 302.03 Revised to reflect amendment to 37 CFR 3.21.
- 302.06 Revised to reflect amendment to 37 CFR 3.41.
- 302.07 Revised to reflect amendment to 37 CFR 3.31. 37 CFR 3.31(c) has been added to set forth the cover sheet content requirements for recording governmental interest.
- 302.08 Revised to reflect amendment to 37 CFR 3.27. A document required by Executive Order 9424 to be filed which does not affect title and is identified on the cover sheet must be mailed to the address set forth in 37 CFR 3.27(b).
- 303 Revised to indicate that examiners may obtain assignment information from PALM.
- 307.01 Revised to reflect amendment to 37 CFR 3.51.

- 319 This section has been deleted and the content has been incorporated into MPEP § 320.
- 320 Revised to indicate that examiners may obtain a title report by requesting a title report from Assignment Division or the assignment information may be obtained by the examiner through PALM.
- 323 Revised to delete the verification requirement of the statement setting forth how the error in a recorded assignment document occurred.
- 324 Revised to reflect amendment to 37 CFR 3.73(b). The requirement that the assignee must submit a statement specifying that the evidentiary documents have been reviewed and certifying that title is in the assignee seeking to take action has been deleted as unnecessary in view of the amendment to 37 CFR 1.4(d). Form PTO/SB/96, certificate under 37 CFR 3.73(b), and Form PTO-1619A and B, recordation form cover sheet - patents only, have been revised.

CHAPTER 400:

- 401 Revised to indicate that the presentation of papers to the PTO by any party including a *pro se* applicant constitutes a certification under 37 CFR 10.18(b) and that violations of 37 CFR 10.18(b)(2) may subject the party to sanctions under 37 CFR 10.18(c).
- 402 Revised to reflect amendment to 37 CFR 10.18.
- 403 Revised to reflect amendments to 37 CFR 1.33(a) and (b).
- 405 Revised to indicate that a change of correspondence address may not be signed by an attorney or agent not of record.
- 407 The title of this section has been changed to read "Suspended or Excluded Practitioner."

- 409.01 Revised to indicate that the death of an inventor terminates the power of attorney given by the deceased inventor and that a new power of attorney from the legal representative or assignees is necessary if the deceased inventor is the sole inventor or all powers of attorney in the application have been terminated.
- 409.01(b) Revised to indicate that if after reviewing the submitted proof of authority, the examiner determines that the authority to execute the oath or declaration on behalf of the deceased inventor does not lie with the person(s) who signed the oath or declaration, the application must be forwarded to the PCT Legal Office.
- 409.03 Revised to reflect amendment to 37 CFR 1.47 and to indicate that an application filed with a petition under 37 CFR 1.47 must be forwarded to the Special Program Law Office for decision before the application is sent to the Examining Group for examination. Revised to indicate that an application without an oath or declaration signed by all the inventors may be an incomplete application, therefore, an examiner should not mail an Office action in an application without an oath or declaration signed by all the inventors under 37 CFR 1.63 unless the application has been accorded status under 37 CFR 1.47.
- 409.03(b) Revised in indicate that where an application is executed by one other than the inventor, the declaration required by 37 CFR 1.63 must state the full name, residence, post office address and citizenship of the nonsigning inventor.
- 409.03(h) Revised to indicate that when papers deposited pursuant to 37 CFR 1.47 are found acceptable, the PTO will notify the nonsigning inventor, or the nonsigning legal representative where the inventor is deceased, of the filing of an application under 37 CFR 1.47.
- 409.03(j) Revised to indicate that an application filed under 37 CFR 1.47 can be published as a Statutory Invention Registration.
- 410 This section has been added to address representations to the PTO. 37 CFR 1.14(d)(2) has been amended to provide that the

presentation to the PTO (whether by signing, filing, submitting, or later advocating) of any paper by a party, whether a practitioner or nonpractitioner, constitutes a certification under 37 CFR 10.18(b), and that violations of 37 CFR 10.18(b)(2) may subject the party to sanctions under 37 CFR 10.18(c).

CHAPTER 500:

- 501 The title of the section has been revised to read: "Papers Received by Office of Initial Patent Examination." Revised to reflect amendment to 37 CFR 1.4.
- 502 Revised to indicate that a continued prosecution application (CPA) filed under 37 CFR 1.53(d) may be sent to the PTO by facsimile transmission. Only CPAs filed under 37 CFR 1.53(d) may be delivered in person to the examining groups, all other patent applications may be delivered in person to OIPE located at Crystal Plaza 2, 1B03 but not to the examining groups.
- 502.01 Revised to indicate that a CPA filed under 37 CFR 1.53(d) may be transmitted by facsimile transmission to the PTO. A CPA filed by facsimile transmission must include an authorization to charge the basic filing fee to a deposit account, or the application will be treated under 37 CFR 1.53(f) as having been filed without the basic filing fee. Where the PTO has no evidence of receipt of a CPA transmitted to the PTO by facsimile transmission, 37 CFR 1.6(f) requires that a petition be filed requesting that the CPA be accorded a filing date as of the date the CPA is shown to have been transmitted to and received in the PTO.
- 502.02 Revised to reflect amendment to 37 CFR 1.4(d).
- 503 Revised to include the series codes assigned to different applications and to indicate that a CPA filed under 37 CFR 1.53(d) will be assigned the application number of the prior application for identification purposes. Revised to indicate that OIPE will mail a filing receipt for each application filed which meets the minimum requirement to receive a filing date.

- 506 Revised to reflect amendment to 37 CFR 1.53. Filing dates are accorded to nonprovisional applications filed without the names of all the inventors, the basic filing fee and/or the oath or declaration. In such cases, a notice is mailed by OIPE requiring at least that the basic filing fee and the oath or declaration (which must include the names of all the inventors) be filed along with the surcharge.
- 506.02 Revised to indicate that the failure to identify the inventorship no longer raises a filing date issue.
- 507 The title of the section has been changed to read "Drafting Review Branch."
- 509.02 Revised to reflect amendments to 37 CFR 1.9(d) and (f) and to indicate that questions relating to size standards for a small business concern may be directed to the Small Business Administration.
- 509.03.1 Revised to reflect amendments to 37 CFR 1.27 and 1.28. The verification requirement of the small entity statement has been deleted in view of the amendment to 37 CFR 1.4(d)(2). Revised to clarify that status as a small entity must be specifically established in each application or patent in which the status is available and desired. Payment of the small entity basic statutory filing fee in a nonprovisional application which claims benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) of a prior application which has small entity status constitutes a reference in the nonprovisional application to the small entity statement in the prior application.
- 511 The addresses and telephone numbers of the Department of Commerce District Offices have been updated.
- 512 Revised to reflect amendment to 37 CFR 1.8 and to indicate that the certificate of mailing or transmission procedures and benefits under 37 CFR 1.8(a) are not applicable to the filing of a request

for a CPA. Revised to indicate that the statement required by 37 CFR 1.8(b)(3) is no longer required to be verified.

513 Revised to reflect amendments to 37 CFR 1.10(d) and (e).

CHAPTER 600:

601 Revised to reflect amendment to 37 CFR 1.51 and to indicate that except for the drawings, the application papers must have each page plainly written on only one side of a sheet of paper and that the sheets of paper must be the same size either 8 1/2 by 11 inches or DIN A4. Revised to indicate that the abstract must commence on a separate sheet. Revised to reflect amendment to 37 CFR 1.59 and to indicate that copies of an application will be provided by the PTO upon request and payment of the fee set forth in 37 CFR 1.19(b) unless the application has been disposed of.

601.01 Revised to reflect amendment to 37 CFR 1.53.

601.01(a) Revised to indicate that the procedure for filing a nonprovisional application is set forth in 37 CFR 1.53(b) and 1.53(d). 37 CFR 1.53(b) may be used to file any original, reissue, or substitute nonprovisional application and any continuing application, i.e., continuation, divisional, or continuation-in-part. Under 37 CFR 1.53(b), a filing date is assigned to a nonprovisional application as of the date a specification containing a description and claim and any necessary drawings are filed in the PTO. The requirement that the names of the actual inventors must be submitted at the time of filing of a nonprovisional application before the nonprovisional application can be accorded a filing date has been deleted. 37 CFR 1.53(d) may be used to file either a continuation or a divisional application, but not a continuation-in-part, of a prior nonprovisional application.

601.01(b) Revised to indicate that the procedure for filing a provisional application is set forth in 37 CFR 1.53(c). Under 37 CFR 1.53(c), a filing date is assigned to a provisional application as of the date the written description and any necessary drawings

are filed in the PTO. The requirement that the names of the actual inventors must be submitted at the time of filing of a provisional application before the provisional application can be accorded a filing date has been deleted.

- 601.03 Revised to indicate that change of correspondence address may not be signed by an attorney or agent not of record. Where the correspondence address was changed during the prosecution of the prior application, applicant is required to identify the correspondence address in the continuation or divisional application (37 CFR 1.63(d)(4)).
- 602 Revised to reflect amendment to 37 CFR 1.63.
- 602.04(a) Revised to update the list of member countries to the Hague Convention.
- 602.05 Revised to clarify that the PTO will not require a newly executed oath or declaration based on an oath or declaration which omitted the date of execution.
- 602.05(a) Revised to indicate that a continuation or divisional application filed under 37 CFR 1.53(b) may be filed with a copy of the oath or declaration from the prior nonprovisional application. If the copy of the oath or declaration is submitted after the filing date of the continuation or divisional application and an application number has been assigned to the continuation or divisional application, the cover letter accompanying the oath or declaration should identify the application number of the continuation or divisional application and applicant should also label the copy of the oath or declaration with the application number of the continuation or divisional application in the event that the cover letter is separated from the copy of the oath or declaration.
- 602.06 Revised to reflect amendment to 37 CFR 1.69(b).
- 603 Revised to reflect amendment to 37 CFR 1.67(b).
- 605 Revised to reflect amendment to 37 CFR 1.41(a) and to indicate that effective December 1, 1997, the requirement that the

name(s) of the inventor(s) be identified in the application papers in order to accord the application a filing date has been deleted. 37 CFR 1.41(a)(1) defines the inventorship of a nonprovisional application as that inventorship set forth in the oath or declaration filed to comply with the requirements of 37 CFR 1.63, except as provided for in 37 CFR 1.53(d)(3) and 1.63(d). Where no inventor(s) is named on filing, the Office requests that an alphanumeric identifier be submitted for the application.

- 605.03 Revised to indicate that an oath or declaration filed on or after December 1, 1997 must include the post office address of each inventor.
- 605.04(b) Revised to indicate that 37 CFR 1.63(a)(3) requires that each inventor be identified by full name, including the family name, and at least one given name without abbreviation together with any given name or initial in the oath or declaration.
- 607.02 Revised to reflect amendment to 37 CFR 1.26(a).
- 608.01 Revised to reflect amendment to 37 CFR 1.52 with regard to standards for application papers, e.g. paper size. The requirement that the English translation of the non-English language application papers be verified has been deleted (37 CFR 1.52(d)). The translation must be a literal translation and must be accompanied by a statement that the translation is accurate.
- 608.01(b) Revised to indicate that the abstract must commence on a separate sheet preferably following the claims, under the heading "Abstract of the Disclosure."
- 608.01(f) Revised to reflect amendment to 37 CFR 1.84.
- 608.01(j) Revised to reflect amendment to 37 CFR 1.126.
- 608.01(n) Revised to reflect amendment to 37 CFR 1.75(c).
- 608.01(q) Revised to reflect amendment to 37 CFR 1.125 and to indicate that a substitute specification is not permitted in a reissue application or in a reexamination proceeding. 37 CFR 1.125(a)

- applies to a substitute specification required by the Office. 37 CFR 1.125(b) applies to a substitute specification voluntarily filed by the application which must accompanied by a statement that the substitute specification includes no new matter and a mark-up copy of the substitute specification showing the matter being added to and the matter being deleted from the specification of record.
- 608.01(s) Revised to set forth the procedure for restoring canceled text in the specification and canceled claim(s).
- 608.01(v) Revised to reflect amendment to 37 CFR 1.71(d).
- 608.02 Revised to reflect amendment to 37 CFR 1.84. The PTO is *sua sponte* waiving the requirement of 37 CFR 1.84(b)(1)(ii) to the extent that only a single set of black and white photographs need be submitted with a petition to accept black and white photographs in lieu of drawings.
- 608.02(d) Revised to reflect amendments to 37 CFR 1.83(a) and (c).
- 608.02(p) Revised to reflect amendments to 37 CFR 1.121(a)(3)(i) and (ii).
- 608.03 Revised to reflect amendment to 37 CFR 1.91 and to indicate that models or exhibits are generally not admitted as part of an application or patent unless the requirements of 37 CFR 1.91 are satisfied.
- 608.03(a) Revised to indicate that models and exhibits may be presented for demonstration purposes during an interview and should be taken away by applicant or his/her attorney or agent at the conclusion of the interview. Any model or exhibit that is left with the examiner at the conclusion of the interview, which is not made part of the application or patent, may be disposed of at the discretion of the Office.
- 608.04 Revised to reflect amendment to 37 CFR 1.121(a)(6).
- 608.04(b) Revised to clarify that if the original executed oath or declaration was filed on the filing date of the application and the oath or declaration fails to refer to the preliminary amendment which

was included with the application papers on filing, the preliminary amendment will not be considered part of the original disclosure. Any request to treat the preliminary amendment as a part of the original disclosure is by way of a petition under 37 CFR 1.182.

- 609 Revised to reflect amendments to 37 CFR 1.97(c) – (e) and to clarify that examiners will consider information which has been considered by the Office in a parent application when examining (a) a continuation application filed under 37 CFR 1.53(b) or filed under former 37 CFR 1.60, (b) a divisional application filed under 37 CFR 1.53(b) or filed under former 37 CFR 1.60, or (c) a CIP application filed under 37 CFR 1.53(b), and a list of the information need not be submitted in the continuation, divisional, or CIP application unless application wishes to have the information printed on the patent. Revised to indicate that a first Office action will normally issue in a CPA (continuation) well within 3 months from the filing date of the CPA request. The submission of an IDS after the first Office action is mailed could delay prosecution. Therefore, applicants are encouraged to file any IDS in a CPA (especially continuation) as early as possible, preferably at the time of filing of the CPA request. The requirement that the statement under 37 CFR 1.97(e) be certified has been deleted.

CHAPTER 700:

- 703 Revised to indicate that the “General Information Concerning Patents” pamphlet is available from the PTO Web page.
- 706 37 CFR 1.106 has been deleted and replaced by 37 CFR 1.104(c). Revised to reflect amendment to 37 CFR 1.112.
- 706.02(a) Revised to clarify that despite changes to 37 CFR 1.6(a)(2) and 1.10 which permit the PTO to accord a filing date to an application as of the date of deposit as "Express Mail" with the U.S. Postal Service in accordance with 37 CFR 1.10 (e.g., a Saturday filing date), the rule changes do not affect applicant's concurrent right to defer the filing of an application until the next

business day when the last day for "taking any action" falls on a Saturday, Sunday, or Federal holiday.

- 706.02(l) 37 CFR 1.106 has been deleted and replaced by 37 CFR 1.104(c). Added discussion of holding in *OddzOn Products, Inc., v. Just Toys, Inc.* Revised to reflect amendment to 37 CFR 1.104(a)(5).
- 706.03(b) and 706.03(s) Revised to indicate that Licensing and Review is located in Group 3640.
- 706.07 Revised to reflect amendment to 37 CFR 1.113.
- 707 Revised to reflect amendment to 37 CFR 1.104.
- 707.05 37 CFR 1.107 has been deleted and replaced by 37 CFR 1.104(d).
- 708 37 CFR 1.101 has been deleted. Revised to indicate that the order of examination for each examiner is to give priority to reissue applications and to reexamination proceedings, with top priority to reissue applications in which litigation has been stayed and to reexamination proceedings involved in litigation.
- 710.01 Revised to reflect amendment to 37 CFR 1.135. 37 CFR 1.135(c) has been amended to change the practice of providing a non-statutory time limit during which an applicant may supply an omission to a previous reply. Under the new practice, the examiner may set a shortened statutory time period during which an applicant must supply the omission to the previous reply to avoid abandonment.
- 710.02(c) Rewritten to set forth the situations in which a specified time limit for taking an action is set.
- 710.02(d) Rewritten to list the differences between a shortened statutory period for reply and a specified time limit.

- 711.02(e) Revised to reflect amendment to 37 CFR 1.136 and to identify the change in practice with respect to petitions for extension of time. Applicants were previously required to file a petition (some writing that manifested an intent to obtain an extension of time) in reply to the Office action for which the extension was requested. 37 CFR 1.136(a)(3) has been amended to provide that certain actions by applicant, such as an authorization to charge all fees, will be treated as a constructive petition for extension of time in any concurrent or future reply requiring a petition for extension of time to be timely.
- 711 Revised to reflect amendment to 37 CFR 1.135.
- 711.03(c) This section has been rewritten and reformatted to set forth the procedures with respect to petitions to withdraw a holding of abandonment, petitions to revive an abandoned application or accept late payment of the issue fee, and petitions to revive an abandoned provisional application.
- 711.03(e) This section has been deleted and the content has been incorporated into MPEP § 711.03(c).
- 712 This section has been deleted and the content has been incorporated into MPEP § 711.03(c).
- 713.08 Revised to indicate that if the model or exhibit is merely used for demonstration purpose during the course of an interview and is not made part of the record (does not comply with 37 CFR 1.91), a full description as to what was demonstrated/exhibited must be made of record in the application.
- 714 37 CFR 1.115 has been deleted.
- 714.01 Revised to indicate that an amendment must be signed by a person having authority to prosecute the application and that an unsigned or improperly signed amendment will not be entered.
- 714.02 Revised to reflect amendment to 37 CFR 1.111(b).

- 714.03 Revised to reflect amendment to 37 CFR 1.135(c). 37 CFR 1.135(c) authorizes, but does not require, an examiner to give the applicant a new time period to supply an omission in a *bona fide* reply. The practice under 37 CFR 1.135(c) of giving applicant a time period to supply an omission does not apply after a final Office action.
- 714.09 Revised to indicate that any amendment canceling claims in order to reduce the filing fee should be filed with the application since only amendments canceling claims are entered before the filing fee is calculated.
- 714.12 Revised to reflect amendment to 37 CFR 1.116(a).
- 714.16 Revised to indicate that a supplemental reissue oath or declaration submitted after allowance is treated as an amendment under 37 CFR 1.312 because the correction of the patent which it provides is an amendment of the patent, even though no amendment is physically entered into the specification or claims.
- 714.22 Revised to reflect amendment to 37 CFR 1.121.
- 714.24 37 CFR 1.124 has been deleted.
- 715.05 Added discussion of *In re McGrew*.
- 715.07 Revised to indicate that exhibits must comply with the requirements of 37 CFR 1.91 to be entered into an application file. Exhibits that do not comply with the requirements of 37 CFR 1.91 will be disposed of or returned to application at the discretion of the Office.
- 716.01(d) Added discussion of *Richardson-Vicks, Inc. v. The Upjohn Co.*
- 719.01 Revised to indicate that pursuant to 37 CFR 1.59, certain documents may be returned to applicant if they were unintentionally submitted or contain proprietary information

which has not been made public and is not important to a decision of patentability.

719.02 Revised to indicate that if the examiner notices an error in any of the data originally entered on the file wrapper or on the PALM bib-data sheet, he/she should return the application to OIPE for correction, or for 09 series applications, have the technical support staff of the examining group enter the correction on the PALM database and print a new PALM bib-data sheet.

724.05 Revised heading to read "Petition To Expunge Information or Copy of Papers in Application File." This section has been rewritten to address petitions to expunge (a) information submitted under MPEP § 724.02, (b) information unintentionally submitted in an application, (c) information submitted in an incorrect application file, and (d) information forming part of the original disclosure.

724.06 Added to set forth the procedures for handling petitions to expunge.

CHAPTER 800:

803.01 Revised heading to read "Review by Examiner With At Least Partial Signatory Authority." Only examiners with permanent or temporary full signatory authority may sign final and non-final Office actions containing a final requirement for restriction, except that an examiner with temporary or permanent partial signatory authority has the authority to sign all non-final Office actions containing a final requirement for restriction.

804 Revised to indicate that a double patenting issue may raise a substantial new question of patentability of a claim of a patent and thus be addressed in a reexamination proceeding. If the issue of double patenting was not addressed during original prosecution, it may be considered during reexamination. Added discussion of holdings in *In re Berg* and *In re Emert* regarding whether a one-way obviousness test or a two-way obviousness test is needed in resolving the issue of double patenting.

- 804.02 Added discussion regarding reasons for insisting upon a terminal disclaimer to overcome a judicially-created double patenting rejection in a continuing application subject to a 20 year patent term.
- 819 Revised to indicate that where a CPA filed under 37 CFR 1.53(d) is a continuation and not a divisional, an express election made in the prior application in reply to a restriction requirement carries over to the CPA unless otherwise indicated by the applicant.

CHAPTER 900:

- 901.02 37 CFR 1.108 has been deleted.
- 901.05(a) The list of selected foreign language names and abbreviations for the United States of America has been updated.
- 901.05(b) The list of INID Codes has been updated.
- 903.02 Revised to indicate that the "Examiner Handbook to the U.S. Patent Classification System" can be accessed on the PTO Home Page.
- 903.07 Revised to indicate that when an application is ready for allowance, the original classification and the cross-references are placed on the issuing classification boxes on the face of the file wrapper or on the blue issue classification slip for 08 series and earlier applications.
- 903.08(d) Revised to modify the transfer process when there is a dispute as to classification issues.
- 905.01 This section directed to orders of photocopies of foreign documents from master microfilm reels has been deleted.

905.03 Revised to indicate that patented and abandoned files are ordered by means of the PALM video display or PALM intranet site.

CHAPTER 1000:

1001 37 CFR 1.352 has been deleted.

1001.01 Revised to clarify that a delegation of supervisory or higher level review authority over a matter carries with it the authority to decide the matter *ab initio*.

1002 Revised to reflect amendment to 37 CFR 1.182.

1002.01 Revised to clarify that the delegation of specific petitions and/or matters identified in the sections below to personnel with the patent examining group is at the discretion of the Group Director and any petition and/or matter so delegated may be decided by the Group Director.

1002.02(b) Revised to update list of petitions and requests decided by the Office of Petitions.

1002.02(c) Revised to update list of petitions and requests decided by Group Directors.

1002.02(c)(1) Revised to indicate that examining group 2200 has been changed to examining group 3640.

1002.02(c)(2) Revised to indicate that examining group 1800 has been changed to examining group 1600.

1002.02(c)(3) Revised to update list of petitions decided by the Director of Group 2900.

1002.02(d) Revised to update list of petitions and matters decided by Supervisory Patent Examiners.

- 1002.02(f) Revised to update list of petitions and matters decided by the Chief Administrative Patent Judge of the Board of Patent Appeals and Interferences.
- 1002.02(s) New section listing petitions and matters decided by the Special Program Examiners in the Patent Examining Groups.
- 1003 Revised to update list of matters submitted to Group Directors.
- 1004 Revised to update list of actions which require the attention of a primary examiner.
- 1005 Revised to update list of actions which may not be signed by an examiner with partial signatory authority.

CHAPTER 1100:

- 1101 Revised to indicate that examining groups 1800 and 2200 have been changed to examining groups 1600 and 3460 respectively.
- 1103 Revised to reflect amendment to 37 CFR 1.294(b).

CHAPTER 1200:

- 1205 Revised to reflect amendments to 37 CFR 1.191(a) and (b) and to clarify that a notice of appeal may be filed after any of the claims has been twice rejected, regardless of whether the claim(s) has/have been finally rejected. 37 CFR 1.191 has been amended to no longer require that the notice of appeal identify the rejected claim(s) appealed, or be signed since the requirements were considered to be redundant in view of the requirements of 37 CFR 1.192. Applicants are encouraged to continue to file notices of appeal which identify the appealed claims and are signed.
- 1206 Revised to reflect amendment to 37 CFR 1.192(a) and to clarify that the usual period of time in which appellant must file the appeal brief is 2 months from the date of appeal. The PTO date of receipt of the Notice of Appeal, and not the date indicated on

any Certificate of Mailing under 37 CFR 1.8, is the date from which the 2 month time period is measured. 37 CFR 1.192(c)(7) requires the appellant to perform 2 affirmative acts in the brief in order to have the separate patentability of a plurality of claims subject to the same rejection considered. Appellant must (a) state that the claims do not stand or fall together and (b) present arguments why the claims subject to the same rejection are separately patentable. Where appellant does neither, the claims will be treated as standing or falling together. Where appellant does one and not the other, appellant should be notified of the noncompliance as per 37 CFR 1.192(d).

1207

Revised to clarify that an amendment filed at any time after final rejection but before jurisdiction has passed to the Board may be entered upon or after the filing of an appeal brief provided that the amendment conforms with the requirements of 37 CFR 1.116. Amendments received after jurisdiction has passed to the Board should not be considered by the examiner unless remanded by the Board for such purpose. Revised to emphasize that a new amendment, new affidavit, or other new evidence must be submitted in a paper separate from the appeal brief and that entry of such new amendment, new affidavit, or other new evidence is not a matter of right. Also revised to indicate that the examiner's answer may withdraw the rejection of the claims, if appropriate. The examiner may also determine that it is necessary to reopen prosecution to enter a new ground of rejection.

1208

Revised to reflect amendment to 37 CFR 1.193 and to indicate that a new ground of rejection is no longer permitted in an examiner's answer. If a new ground of rejection is necessary, prosecution must be reopened. The examiner must obtain approval from the Supervisory Patent Examiner prior to reopening prosecution after an appeal.

1208.01

Revised to reflect amendment to 37 CFR 1.193(a)(2) which prohibits the entry of a new ground of rejection in an examiner's answer. However, if (1) an amendment under 37 CFR 1.116 proposes to add or amend one or more claims, (2) appellant was

advised in an advisory action that the amendment under 37 CFR 1.116 would be entered for purposes of appeal, and (3) the advisory action indicates which individual rejection(s) set forth in the action from which the appeal was taken would be used to reject the added or amended claim(s), then (1) the appeal brief must address the rejection(s) of the claim(s) added or amended, and (2) the examiner's answer may include the rejection(s) of the claim(s) added or amended.

- 1208.02 Revised heading to read "Reopening of Prosecution After Appeal." Revised to set forth the options available to appellant after reopening of prosecution. Appellant must (1) file a reply under 37 CFR 1.111 if the Office action is non-final, or (2) file a reply under 37 CFR 1.113 if the Office action is final, or (3) request reinstatement of the appeal.
- 1208.03 Revised to reflect amendment to 37 CFR 1.193(b) and to indicate that pursuant to 37 CFR 1.193(b)(1), appellant may file a reply brief as a matter of right within 2 months from the mailing date of the examiner's answer. The primary examiner may either acknowledge receipt and entry of the reply brief or reopen prosecution to respond to the reply brief. A supplemental examiner's answer is not permitted unless the application is remanded by the Board for such purposes.
- 1208.04 This section, which was directed to supplemental examiner's answer, has been deleted in view of the amendment to 37 CFR 1.193(b)(1).
- 1209 Revised to reflect amendment to 37 CFR 1.194.
- 1210.01 This section, "Order for Compliance," has been added to indicate that when the real party of interest is not explicitly set out in the brief, the Board may require the appellant to explicitly name the real party in interest.
- 1211 Revised to indicate that the Board may remand an application to the examiner to prepare a supplemental examiner's answer in response to a reply brief.

- 1211.02 This section has been added and the content of previous section 1212 has been incorporated therein.
- 1212 This section, "Board Requires Appellant to Address Matter," has been added to reflect amendment to 37 CFR 1.196(d).
- 1213 Revised to reflect amendment to 37 CFR 1.196(e) and to indicate that pursuant to 37 CFR 1.196(e), a decision of the Board which includes a remand will not be considered as a final agency decision in the case.
- 1213.01 Revised heading to read "Statement of Allowability by the Board" and to indicate that pursuant to 37 CFR 1.196(c), if the Board's decision includes an explicit statement that a claim may be allowed in amended form, appellant may amend the claim in conformity with the statement and the statement would be binding on the examiner in the absence of new prior art reference or grounds of rejection. The examiner should make certain that the amendment does in fact conform to the statement in the Board's decision.
- 1213.02 Revised heading to read "New Ground of Rejection by Board" and revised to reflect amendment to 37 CFR 1.196(b). Under 37 CFR 1.196(b), the Board may, in its decision, make a new rejection of one or more of any of the claims pending in the case, including claims which have been allowed by the examiner.
- 1213.03 Revised to indicate that decisions of the Board which are open to the public are being made available in electronic form on the PTO Web site.
- 1214 Revised to reflect amendment to 37 CFR 1.197(a).
- 1214.01 Revised to indicate that when the Board makes a new rejection under 37 CFR 1.196(b), the appellant has the option to request rehearing or submit an appropriate amendment of the rejected claims and/or a showing of facts relating to the claims so rejected.

- 1214.03 Revised heading to read "Rehearing" and revised to reflect amendment to 37 CFR 1.197(b). The term "rehearing" as used in 37 CFR 1.197(b) should not be interpreted as meaning that an appellant is entitled to an oral hearing on the request for rehearing, but only to a rehearing on the written record.
- 1215.04 Revised to indicate that an appeal will also be dismissed if an applicant fails to timely and fully reply to a notice of noncompliance with 37 CFR 1.192(c).

CHAPTER 1300:

- 1302.01 Added references to Federal Circuit and CCPA decisions.
- 1302.03 Revised heading to read "Notice of Allowability," and to indicate that in all instances, both before and after final rejection, in which an application is placed in condition for allowance, applicant should be notified promptly of the allowability of the claims by a Notice of Allowability PTOL-37.
- 1302.09 Revised to indicate that when preparing the application for issue, the examiner must review the information on the file wrapper label or the PALM bib-data sheet to make sure the information is current and up to date.
- 1302.14 37 CFR 1.109 has been deleted and replaced by 37 CFR 1.104(e).
- 1306 Revised to indicate that the amount of the issue fee due is determined by the fees set forth in 37 CFR 1.18 which are in effect as of the date of submission of payment of the issue fee. The amount due may differ from the amount indicated on the Notice of Allowance. Therefore, applicants are encouraged, at the time of submitting payment of the issue fee, to determine whether the amount of the issue fee due has changed.
- 1308 Revised to indicate that petitions to have an application withdrawn from issue before payment of the issue fee should be

directed to the Group Director of the examining group to which the application is assigned and petitions to have an application withdrawn from issue after payment of the issue fee should be directed to the Director of the Office of Patent Publication.

- 1309.01 Revised to add discussion regarding continued prosecution applications. To avoid confusion as to the term of any patent issuing on a CPA of an application filed prior to June 8, 1995, the PTO will include a notice on any patent issuing on a CPA, other than a reissue or a design patent, that the patent issued on a CPA and the patent is subject to the 20 year patent term set forth in 35 U.S.C. 154(a)(2) and (b).

CHAPTER 1400:

- 1400.01 Added section heading.
- 1402 Revised to indicate that there must be at least one error in the patent to provide grounds for reissue of the patent and that the error upon which a reissue is based must be one which causes the patent to be deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent.
- 1410 Revised to reflect amendment to 37 CFR 1.171.
- 1410.01 Revised to reflect amendment to 37 CFR 1.172(a) and to indicate that the assignee consenting to the filing of the reissue application must also establish its ownership in accordance with 37 CFR 3.73(b).
- 1411 Revised to indicate that after filing, the specification and claims in the reissue application must be amended in the manner set forth in 37 CFR 1.121(b).
- 1412.01 Added discussion of the holding in *In re Amos*.

- 1412.02 Added reference to recent Federal Circuit decision of *In re Clement*.
- 1412.04 Section added to address procedures for correction of inventorship in a patent.
- 1413 Revised to indicate that a box is provided on the Reissue Patent Application Transmittal Form which applicant may check to request a transfer of the drawings from the original patent file to the reissue application. Also revised to indicate that amendments to the drawings of a reissue application are governed by 37 CFR 1.121(b)(3).
- 1414 Revised to reflect amendment to 37 CFR 1.175.
- 1414.01 – 1414.05 These sections have been deleted in view of amendment to 37 CFR 1.175 and the content incorporated into MPEP § 1414.
- 1414.01 Section added to address supplemental reissue oath or declaration.
- 1415.01 Section added to address maintenance fees on the original patent.
- 1430 Revised to indicate that the filing of a continued prosecution application (CPA) under 37 CFR 1.53(d) of a reissue application will not be announced in the *Official Gazette*.
- 1441 Revised heading to read “Two-Month Delay Period; Protest in Reissue Applications” and to indicate the procedure for handling a protest submitted in a reissue application.
- 1442.02 Revised heading to read “Concurrent Litigation” and to indicate that where a reissue application is merged with a reexamination proceeding, the merged proceeding generally will not be stayed where there is litigation. In a merged reexamination/reissue proceeding, the reexamination will control because of the

statutory requirement that reexamination proceedings be conducted with special dispatch.

- 1443 Revised to indicate that on initial receipt of a reissue application, the examiner should inspect the submission under 37 CFR 1.172 as to documentary evidence of a chain of title from the original owner to the assignee to determine whether the consent required by 37 CFR 1.172 has been complied with.
- 1444 Revised to address review of the reissue oath or declaration by the examiner.
- 1447 This section has been deleted in view of amendment to 37 CFR 1.175.
- 1448 Revised to address admission or judicial determination of fraud, inequitable conduct, or violation of duty of disclosure in a reissue application.
- 1449.01 Revised to indicate that if an examiner becomes aware that a reissue application and a reexamination proceeding are both pending for the same patent, the examiner should inform the Group Special Program Examiner and the files for the reissue application and the reexamination are to be forwarded to the Office of the Deputy Assistant Commissioner for Patent Policy and Projects for a decision whether to merge the reissue and the reexamination, or stay one of the two.
- 1451 Rewritten to address continuation reissue applications in view of the decision by the Federal Circuit in *In re Graff*.
- 1453 Revised to reflect amendment to 37 CFR 1.121(b), manner of making amendments in reissue applications.
- 1454 Added section to address appeal brief for a reissue application.
- 1455 Rewritten to set forth the procedures to follow in the preparation of the reissue application for issue.

- 1481 Revised to reflect amendment to 37 CFR 1.324 and to identify situations when a certificate of correction can be used to correct mistakes.
- 1490 Revised to indicate that a terminal disclaimer filed in a parent application to obviate a double patenting rejection does carry over to a continued prosecution application (CPA) filed under 37 CFR 1.53(d). If applicant does not want the terminal disclaimer to carry over to the CPA, applicant must file a petition under 37 CFR 1.182 along with the required petition fee, requesting that the terminal disclaimer not be carried over to the CPA.

CHAPTER 1500:

- 1502 Revised to clarify that the subject matter claimed in a design patent application is the design embodied in or applied to an article of manufacture.
- 1503.01 Revised to reflect amendment to 37 CFR 1.154. Revised to indicate that any description of the nature and intended use of the design incorporated into the preamble will be printed on any issued patent absent an amendment deleting the description. Also revised to specify that the title must be in formal terms to the "ornamental design for the article (specifying name) as shown, or as shown or described," amendments to the title must have antecedent basis in the original disclosure, and any amendments to the language of the title should be made throughout the application. Revised to clarify that a characteristic features statement may not serve as a basis for determining patentability.
- 1503.02 Revised to reflect amendment to 37 CFR 1.152. Revised to indicate when it may be appropriate to include sectional views, and to clarify when a boundary line may be shown in broken lines. Also revised to specify that an amendment canceling surface indicia or reducing it to broken lines (or the submission of formal drawings or photographs omitting color) would be permitted if it is clear from the application that applicant had

possession of the basic design without the surface indicia (or color) at the time of filing of the application.

- 1504 Revised to indicate the action to be taken by the examiner once the examiner determines whether the claim satisfies the statutory requirements.
- 1504.01 Guidelines for examination of design patent applications for computer generated icons have been deleted and the content has been incorporated into new section 1504.01(a); the discussions of functionality vs. ornamentality and hidden in use have been deleted and the content has been incorporated into new section 1504.01(c); and the discussion of offensive subject matter has been deleted and the content has been incorporated into new section 1504.01(e).
- 1504.01(a) Added to incorporate guidelines for examination of design patent applications for computer generated icons. Guidelines revised to indicate that amendments to the written description will ordinarily be entered, however any new matter will be required to be canceled from the written description, drawings and/or claims.
- 1504.01(b) Added to discuss designs comprising multiple parts embodied in a single article.
- 1504.01(c) Added to discuss lack of ornamentality, including functionality versus ornamentality, hidden in use, establishing a *prima facie* basis for rejections under 35 U.S.C. 171 on the basis of a lack of ornamentality, rejections made under 35 U.S.C. 171, and evaluation of evidence submitted to overcome a rejection under 35 U.S.C. 171.
- 1504.01(d) Added to indicate that designs which simulate a well known or naturally occurring object or person lack the originality required by 35 U.S.C. 171.

- 1504.01(e) Added to indicate that the disclosure and claim of a design application which discloses offensive subject matter should be rejected as nonstatutory subject matter.
- 1504.02 Revised to clarify the standard for determining whether the claim meets the novelty requirement of 35 U.S.C. 102 in design patent applications. Also revised to indicate that while the experimental use exception to a statutory bar for public use or sale does not usually apply to design patents, experimentation directed to functional features of a product containing an ornamental design may negate what would otherwise be considered a public use. Further revised to indicate when rejections under 35 U.S.C. 102(d) as modified by 35 U.S.C. 172 should be made.
- 1504.03 Revised to clarify the standard for determining whether a *prima facie* case of obviousness has been established. Also revised discussion of applicant's rebuttal of the *prima facie* case.
- 1504.04 Rewritten to clarify the standard for determining whether the requirements of 35 U.S.C. 112, first and second paragraphs, have been met in design patent applications.
- 1504.05 Revised to indicate that if multiple embodiments are held to be patentably indistinct, any rejection of one embodiment over prior art will apply equally to all other embodiments. Also revised discussion of how multiple embodiments may be described, and how the examiner determines whether restriction must be required.
- 1504.06 Rewritten to clarify discussion of double patenting rejections in design patent applications.
- 1504.20 Revised to add language pertaining to the treatment of a continuation-in-part application which claims the benefit under 35 U.S.C. 120 of the filing date of an earlier application which in turn claims the benefit of a foreign application under 35 U.S.C. 119(a)-(d).

1512 Revised to indicate that it is improper to use a trademark alone or coupled with the word "type" in the title of a design, and to clarify the proper use of trademarks in the drawing disclosure of a design application.

CHAPTER 1600:

1604 Revised to add Plant Patent Application (35 U.S.C. 161) Declaration, Form PTO/SB/03.

1605 Revised to reflect amendment to 37 CFR 1.163.

1608 Revised to reflect amendment to 37 CFR 1.167.

1609 Revised description of the contents of a report from the Agricultural Research Service.

1610 Revised description of the contents of a report from the Agricultural Research Service. Revised to reflect amendment to 37 CFR 1.104.

1612 Revised to update states which are party to the UPOV Convention.

CHAPTER 1700:

1701.01 Revised to reflect redesignation of 15 CFR Part 15a as 15 CFR Part 15, Subpart B.

1703 Revised to indicate that the *Official Gazette* includes *inter alia* notices of 37 CFR 1.47 applications, registration of attorneys and agents, and reprimands, suspensions and exclusions of registered attorneys and agents.

1705 Rewritten to clarify the procedures for counting actions and the types of actions counted. Examiner's Case Action Worksheet, Form PTO-1472, has been added.

1730 Added to include sources for information about patents, trademarks, patent applications, and products and services offered by the Patent and Trademark Office, including the PTO's automated message system, web site, and help desk numbers.

CHAPTER 1800:

1805 Revised to indicate that when the international application is filed in the United States Receiving Office and the language in which the international application is filed is not accepted by the United States Receiving Office, or if the applicant does not have the requisite residence or nationality, the application may be forwarded to the International Bureau for processing.

1810 Revised to reflect amendment to 37 CFR 1.431.

1812 Revised order in which the elements of the international application are to be arranged, and numbering of the sheets in the international application.

1817 Updated list of PCT member states.

1817.01 Revised to reflect amendment to 37 CFR 1.432.

1819 Revised to reflect amendment to 37 CFR 1.104.

1820 Revised to reflect amendment to 37 CFR 1.425. Revised to indicate that a person may sign the international application on behalf of a legal entity if that person submits a statement that the person has the authority to do so. Also revised requirements for signing the request form on behalf of a nonsigning inventor.

1823 Revised to reflect amendments to PCT Administrative Instructions Sections 204 and 209, and 37 CFR 1.435.

1823.01 Revised to reflect amendment to PCT Rule 13^{bis}.

- 1823.02 Revised to reflect amendments to PCT Rule 5.2, PCT Rule 13^{ter}, and PCT Administrative Instructions Section 208. Revised to reflect current requirements for sequence listings.
- 1827 Revised to indicate that the basic, transmittal, and search fee payable is the basic, transmittal, and search fee in effect on the filing date of the international application.
- 1828 Revised to indicate when an applicant may correct or add a priority claim pursuant to PCT Rule 26^{bis}.1 and interim rules 37 CFR 1.451 and 1.465.
- 1848 Revised to reflect amendment to PCT Rule 13^{ter}.1 and PCT Administrative Instructions Section 513.
- 1851 Updated guidelines and examples for the citation of documents in the international search report as well as the Chapter II written opinion and final report. Updated the standard codes for the identification of different kinds of patent documents and the list of patent documents, past and currently published, and intended to be published in the future, as set forth in WIPO Standard ST.16. Also updated the country codes as set forth in WIPO Standard ST.3.
- 1852 Revised to reflect amendment to 37 CFR 1.104.
- 1857 Revised to reflect removal of 37 CFR 1.318. Also revised to indicate the PTO now receives published international applications on CD-ROM.
- 1862 Revised to reflect amendment to 37 CFR 1.416.
- 1864 Revised to reflect amendment to 37 CFR 1.480.
- 1864.01 Revised to reflect amendments to 37 CFR 1.485 and PCT Rules 54.2 and 66.8.
- 1864.02 Revised to reflect amendment to PCT Rule 54.

- 1865 Revised to indicate that effective July 1, 1998, if a Demand is filed with the USPTO and the USPTO is not competent as the International Preliminary Examining Authority, the USPTO may forward the Demand to the International Bureau which will forward it to a competent International Preliminary Examining Authority. Also corrected address for filing demands in the European Patent Office, and added Brazil to the list of countries for which the IPEA/US will serve as the International Preliminary Examining Authority.
- 1867 Revised to reflect amendment to 37 CFR 1.481. Added language discussing the time limit for paying the preliminary examination fee and the handling fee.
- 1868 Revised to reflect amendment to PCT Rule 60.
- 1871 Revised to reflect amendment to PCT Rule 62.
- 1875 Revised to reflect amendment to 37 CFR 1.488.
- 1876 Revised description of which forms examiners should use to notify applicants of errors in the international application.
- 1877 Revised to reflect amendment to PCT Rule 13^{ter}.1.
- 1878 Revised to reflect amendment to 37 CFR 1.484.
- 1878.01 Revised to reflect amendment to PCT Rule 64.
- 1878.02 Revised to reflect amendments to PCT Rule 66 and 37 CFR 1.485.
- 1879.01 Revised to reflect amendment to PCT Rule 69.2 regarding the time limit for international preliminary examination.
- 1893.01 Revised to reflect amendment to 37 CFR 1.494.

- 1893.01(a) Revised to indicate the “Sequence Listing” need not be translated if it complies with PCT Rule 12.1(d) and the description complies with PCT Rule 5.2(b).
- 1893.01(b) Revised to reflect amendment to 37 CFR 1.495.
- 1893.01(b)(1) Revised to indicate the “Sequence Listing” need not be translated if it complies with PCT Rule 12.1(d) and the description complies with PCT Rule 5.2(b).
- 1893.01(d) Revised to indicate the “Sequence Listing” need not be translated if it complies with PCT Rule 12.1(d) and the description complies with PCT Rule 5.2(b).
- 1893.01(e) Revised to specify that to avoid the need to submit a supplemental oath or declaration, the oath or declaration must comply with 37 CFR 1.63.
- 1893.03(e) Revised to indicate that if the PCT pamphlet is published in English, applicant need not submit a copy of the international application, and the PTO will use the pamphlet as published for the national stage examination under 35 U.S.C. 371.
- 1893.03(g) Revised to indicate that the examiner is not required to list the documents cited in the international search report on a PTO-892.
- 1895.01 Revised to clarify the processing of national stage applications prior to examination.
- 1896 Revised to indicate the filing date of a 35 U.S.C. 111(a) application is the date when the PTO receives a specification, claim, and any drawings.

CHAPTER 1900:

- 1901 Revised to reflect amendment to 37 CFR 1.291(c).
- 1901.04 Revised to indicate that protests filed in a reissue application related to a patent involved in a pending interference proceeding

should be referred to the Office of the Deputy Assistant Commissioner for Patent Policy and Projects before considering the protest and acting on the application.

- 1901.06 Revised to delete information relating to protests filed on or before December 8, 1981. Also revised to reflect amendment to 37 CFR 1.291(c).
- 1901.07 Revised to reflect amendment to 37 CFR 1.291(c) which provides for a second or subsequent submission in the form of additional prior art. Also revised to specify that the Office does not serve copies of Office actions or other documents mailed by the Office on protestors.
- 1901.07(a) Heading changed to "Filing of Multiple Papers Relating to Same Issues," and section rewritten to reflect amendment to 37 CFR 1.291(c). The content of former MPEP § 1901.07(a) pertaining to service of copies in protests filed after December 8, 1981 has been incorporated in MPEP § 1901.07, and the content of former MPEP § 1901.07(a) pertaining to service of copies in protests filed on or before December 8, 1981 has been deleted.
- 1901.07(b) This section has been deleted and the content thereof has been incorporated in MPEP § 1901.07.
- 1902-1904 These sections which pertained to protests filed on or before December 8, 1981 have been deleted.
- 1906 Deleted information pertaining to protests filed prior on or before December 8, 1981.
- 1907 Deleted information pertaining to protests filed on or before December 8, 1981.

CHAPTER 2000:

- 2001.06(b) Added discussion of *Environ Prods., Inc. v. Total Containment, Inc.* and *Critikon, Inc. v. Becton Dickinson Vascular Access, Inc.*

- 2004 Revised discussion of information that might be deemed to be prior art under 35 U.S.C. 102(f) and (g), and added citation to *Molins PLC v. Textron Inc.*
- 2012 Added language specifying that the examiner is not to make any investigation as to the lack of deceptive intent requirement in reissue applications, and that applicant's statement in the reissue oath or declaration is dispositive except in special circumstances such as an admission or judicial determination of deceptive intent.
- 2014 Revised to indicate that questions of fraud, inequitable conduct, or violation of duty of disclosure discovered during reexamination proceedings will be noted by the examiner in an Office action without further comment.
- 2022.05 Revised to reflect amendment to 37 CFR 1.175.

CHAPTER 2100:

- 2111 Added discussion of *In re Morris*.
- 2112 Added discussion of *In re Schreiber*.
- 2127 Revised to reflect deletion of 37 CFR 1.108. Also revised to clarify when an abandoned application referred to in a prior art U.S. patent can be relied upon under 35 U.S.C. 102(e).
- 2133 Revised to indicate that although the PTO is permitted to accord a filing date to an application as of the date of deposit as "Express Mail" with the U.S. Postal Service, this does not affect applicant's right to defer the filing of an application until the next business day when the last day of the 1-year grace period falls on a Saturday, Sunday, or Federal holiday.
- 2135.01 Revised to indicate that although the PTO is permitted to accord a filing date to an application as of the date of deposit as "Express Mail" with the U.S. Postal Service, this does not affect

applicant's right to defer the filing of an application until the next business day when the last day of the 1-year grace period falls on a Saturday, Sunday, or Federal holiday.

- 2136.03 Revised to clarify that where a U.S. application filed under 35 U.S.C. 111(a) claims the benefit of the filing date of a copending PCT international application under 35 U.S.C. 120, its effective filing date as a reference under 35 U.S.C. 102(e) is the international filing date as defined by 35 U.S.C. 363.
- 2138.05 Added discussion of *Estee Lauder, Inc. v. L'Oreal S.A.*
- 2144.05 Added discussion of *In re Geisler*.
- 2145 Added discussion of *In re Geisler*. Also added discussion of proceeding contrary to accepted wisdom as evidence of nonobviousness.
- 2163.05 Added discussion of *The Gentry Gallery, Inc. v. The Berkline Corp.*
- 2181 Added discussion of *O.I. Corp. v. Tekmar Corp.*
- 2182 Added discussion of *B. Braun Medical, Inc. v. Abbott Labs.*
- 2185 Added citation of *In re Dossel*.

CHAPTER 2200:

- 2210 Revised to reflect amendment to 37 CFR 1.510.
- 2217 Revised discussion of double patenting in light of *In re Lonardo*.
- 2232 Revised to clarify when reexamination files are not accessible by the public.
- 2234 Revised to reflect amendments to 37 CFR 1.121 and 1.530.

- 2238 Revised to indicate time reporting procedure for Special Program Examiners and paralegals.
- 2239 Revised to identify the Deputy Assistant Commissioner for Patent Policy and Projects as the deciding official for an Office initiated reexamination.
- 2240 Revised to clarify that patent owner's remedy, where a second or subsequent request for reexamination was filed during reexamination for purposes of harassment, is by way of petition under 37 CFR 1.182.
- 2242 Revised discussion of determining the presence of a "substantial new question of patentability" in light of recent Federal Circuit decision in *In re Portola Packaging Inc.*
- 2244 Revised to indicate limitations in the examiner's ability to consider prior art in light of recent Federal Circuit decisions in *In re Recreative Technologies* and *In re Portola Packaging Inc.*
- 2246 Revised to clarify the points that should be addressed in an examiner's decision ordering reexamination and to provide further clarification regarding petitions to vacate an order granting reexamination in light of the decisions in *In re Recreative Technologies* and *In re Portola Packaging Inc.*
- 2247 Removed examples of decisions on requests for reexamination to new MPEP § 2247.01 for clarification.
- 2249 Revised to reflect amendment to 37 CFR 1.520.
- 2250 Revised to reflect amendments to 37 CFR 1.121 and 1.530.
- 2250.01 Revised to reflect amendment to 37 CFR 1.530.
- 2253 Revised to reflect amendment to 37 CFR 1.530.
- 2254 Revised to reflect amendment to 37 CFR 1.550, and deletion of 37 CFR 1.105-1.109, 1.115 and 1.117-1.119.

- 2258 Revised: (1) discussion of previously considered prior art patents or printed publications in light of *In re Portola Packaging Inc.*; (2) discussion of double patenting rejections in light of *In re Lonardo*; (3) to reflect amendment to 37 CFR 1.104 and deletion of 37 CFR 1.106; and (4) to clarify Office procedure regarding the issuance of a Certification of Correction for correction of inventorship during reexamination.
- 2260 Revised to reflect amendment to 37 CFR 1.104.
- 2264 Revised to clarify Office procedure relating to the mailing of Office actions in a reexamination proceeding.
- 2266 Revised to indicate patent owner's obligation to serve a copy of any response to the third party requester, to indicate that patent owner will normally be given a period of 2 months to respond to an Office action under 37 CFR 1.550(c), to clarify the effect of patent owner's failure to file a timely and appropriate response, and to delete material relating to Rule 1.131 and 1.132 affidavit practice.
- 2266.01 Added to provide procedure regarding handling of submissions that are not fully responsive to non-final Office actions.
- 2266.02 Added to provide procedure regarding handling of submissions that are complete but defective, i.e., an "informal submission."
- 2266.03 Added to provide clarification regarding service of papers in a reexamination proceeding.
- 2268 Revised to identify the Deputy Assistant Commissioner for Patent Policy and Projects as the deciding official for an Office initiated reexamination.
- 2271 Revised to reflect amendment to 37 CFR 1.53.

- 2272 Revised to reflect amendment to 37 CFR 1.53 and to indicate Office practice relating to time periods to supply an omission in a *bona fide* response or to correct an informal submission.
- 2273 Revised to reflect amendments to 37 CFR 1.191 and 1.17 and to indicate procedure where a defective notice of appeal has been filed.
- 2274 Revised to indicate : (1) that failure to file appeal fee within permissible time will result in dismissal of the appeal; (2) that a copy of the appeal brief must be served on the third party requester and the number of copies required in a merged proceeding; (3) the required form of appealed claims; and (4) procedure for handling a defective appeal brief.
- 2275 Revised to reflect amendment to 37 CFR 1.193, and to indicate that a supplemental examiner's answer is not permitted, unless the case has been remanded by the Board for such purposes.
- 2281 Revised to indicate that interviews with the patent owner regarding substantive matters prior to the first Office action will be permitted only where the examiner initiates the interview for the purpose of providing an amendment which will make the claims patentable.
- 2282 Revised to clarify that where a submission is not limited to bare notice of the prior or concurrent proceedings in which a patent undergoing reexamination was or is involved, the submission will be returned by the Office.
- 2283 Revised the guidelines which should be followed when two requests for reexamination directed to a single patent have been filed. Added language describing the prosecution stage, after merger. Also revised to indicate that the Group Director may delegate the decision whether to merge reexamination proceedings to the group Special Program Examiner in certain circumstances.

- 2285 Added language indicating that if applicant/patent owner files a continued prosecution reissue application, whereby the existing reissue application is considered to be expressly abandoned, this will most likely result in the dissolution of the merged proceeding, a stay of the CPA reissue application, and separate, continued prosecution of the reexamination proceeding.
- 2286 Revised to indicate that if all claims are finally held invalid or unenforceable, the Group Director will vacate the reexamination and the reexamination will be terminated. Also revised to indicate that procedural reviews to ensure conformance with Office litigation policy may be delegated by the Group Director to the group Special Program Examiner.
- 2287 Revised the internal procedures related to the review of the Notice of Intent to Issue Reexamination Certificate (NIRC) after the NIRC has been prepared by the examiner. Added language discussing examiner's amendments, and indicating that any examiner's amendment must comply with the requirements of 37 CFR 1.530(d). Added language discussing the requirement for reasons for patentability and/or confirmation.
- 2289 Rewritten to describe the current monitoring and review process for reexamination cases.
- 2290 Revised to clarify that any new claims will be printed in the reexamination certificate completely in italics, and any amended claims will be printed in the certificate with italics and bracketing indicating the amendments thereto.
- 2295 Added to provide guidance for the processing and examination of a reexamination request filed on a patent for which a reexamination certificate has already issued.
- 2296 Added to list PTO forms used in reexamination actions and processing.

CHAPTER 2300:

- 2300.01 Revised to indicate that the chapter has been limited to information concerning those aspects of an interference which are within the jurisdiction of, or are relevant to, the examiner. The chapter does not include the procedure which is followed before the Board during the interference. Persons seeking information concerning that procedure should consult the text of the pertinent rules, 37 CFR 1.601 to 1.688, the notices of rulemaking and accompanying comments adopting those rules as well as notices amending those rules and the comments therein. Revised to indicate current rules and notices published in the *Federal Register* and *Official Gazette* that are applicable to interference procedure before the Board.
- 2300.02 Revised to limit information to that relevant to the examiner.
- 2301.01 Revised to clarify Office practice where there is a common assignee.
- 2301.02 Revised to reflect amendment to 37 CFR 1.601.
- 2301.03 Deleted as not relevant to the examiner.
- 2302 Revised to reflect amendment to 37 CFR 1.602.
- 2303 Revised to reflect amendment to 37 CFR 1.603. Information about nonelected subject matter moved to new MPEP § 2303.01.
- 2303.01 Added for clarity. Contains information removed from MPEP § 2303.
- 2304 Revised to reflect amendment to 37 CFR 1.604.
- 2305 Revised to reflect amendment to 37 CFR 1.605.
- 2306 Revised to reflect amendment to 37 CFR 1.606.
- 2306.01 Added. Corresponds to former MPEP § 2308.03.

- 2307 Revised to reflect amendment to 37 CFR 1.607 and to include a discussion of compliance with 35 U.S.C. 135(b).
- 2307.02 Revised by removing discussion of case law relating to 35 U.S.C. 135(b) to MPEP § 2307 for clarity.
- 2307.04 Revised to indicate that authorization from the Deputy Assistant Commissioner for Patent Policy and Projects is required where the patent is involved in a reexamination proceeding and to delete reference to patentee notification as not relevant to the examiner.
- 2307.05 Revised to indicate notification by the examiner to the Deputy Assistant Commissioner for Patent Policy and Projects is required where applicant fails to identify the patent.
- 2308 Revised to reflect amendment to 37 CFR 1.608.
- 2308.02 Revised to update case law citations.
- 2308.03 This section was deleted, and the information therein moved to new MPEP § 2306.01 for clarity.
- 2309 Revised to reflect amendment to 37 CFR 1.609.
- 2309.02 Revised to include information on the preparation of an examiner's statement under 37 CFR 1.609(b).
- 2309.04 Deleted as not relevant to the examiner.
- 2309.06 Revised to reflect amendment to 37 CFR 5.3.
- 2310 Deleted as not relevant to the examiner.
- 2311 Revised to reflect amendment to 37 CFR 1.611 and to limit information to that relevant to the examiner.

- 2312 Revised to indicate files accessible by the public, and to delete reference to 37 CFR 1.612 as not relevant to the examiner.
- 2313 Deleted as not relevant to the examiner.
- 2314 Revised to reflect amendment to 37 CFR 1.614.
- 2315 Revised to reflect amendment to 37 CFR 1.615.
- 2316-2333 Deleted as not relevant to the examiner.
- 2333.01 Revised section number to § 2333.
- 2333.02-
2339 Deleted as not relevant to the examiner.
- 2340 Revised to reflect amendment to 37 CFR 1.640 and to delete information relating to motions before the Board as not relevant to the examiner.
- 2341 Revised to reflect amendment to 37 CFR 1.641.
- 2342 Revised to reflect amendment to 37 CFR 1.642.
- 2343-2357 Deleted as not relevant to the examiner.
- 2358 Revised to reflect amendment to 37 CFR 1.658 and to delete material not relevant to the examiner.
- 2359 Revised to reflect amendment to 37 CFR 1.659.
- 2360 Revised to reflect amendment to 37 CFR 1.660 and to delete material not relevant to the examiner.
- 2361 Revised to reflect amendment to 37 CFR 1.661.
- 2362 Deleted as not relevant to the examiner.
- 2363 Revised to reflect amendment to 37 CFR 1.664.

- 2363.03 Revised to reflect amendment to 37 CFR 1.663.
- 2364.01 Revised to include procedure for examiners for handling of amendments relating to applications involved in an interference.
- 2365 Revised to reflect amendment to 37 CFR 1.665.
- 2366 – 2390 Deleted as not relevant to the examiner.

CHAPTER 2400:

- 2405 Revised to include a current listing of International Depository Authorities.
- 2406 Revised to reflect amendment to 37 CFR 1.804(b).
- 2407 Revised to reflect amendment to 37 CFR 1.805(c).
- 2410.02 Revised to reflect reorganization of the Examining Groups.
- 2421.01 Revised to reflect applicability of new sequence rules, published in the *Federal Register*, 63 FR 29620 (June 1, 1998) and in the *Official Gazette*, 1211 OG 82 (June 23, 1998), to most new applications filed on or after July 1, 1998.
- 2422 Revised to reflect amendment to 37 CFR 1.821.
- 2422.01 Revised to reflect amendments to 37 CFR 1.821 and 1.822.
- 2422.06 Revised to remove the verification requirement for the statement required by 37 CFR 1.821(f).
- 2422.07 Revised to reflect amendments to 37 CFR 1.821, i.e., that the Office will provide a “period of time” (rather than one month) within which applicant must comply with the requirements of 37 CFR 1.821(b) through (f); and removal of the verification requirement for statements required under 37 CFR 1.821(f)-(h).

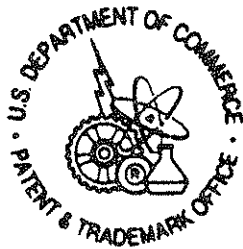
- 2422.08 Revised to reflect amendment to 37 CFR 1.821.
- 2423 Revised to reflect amendment to 37 CFR 1.822.
- 2423.01 Revised to reflect amendment to 37 CFR 1.822.
- 2423.02 Revised to reflect amendment to 37 CFR 1.822.
- 2423.03 Revised to reflect amendment to 37 CFR 1.822.
- 2424 Revised to reflect amendment to 37 CFR 1.823.
- 2424.01 Revised to reflect amendment to 37 CFR 1.823.
- 2424.02 Revised to reflect amendment to 37 CFR 1.823.
- 2424.03 Revised to reflect amendment to 37 CFR 1.823.
- 2425 Revised to reflect amendment to 37 CFR 1.824
- 2426 Revised to reflect amendment to 37 CFR 1.825.
- 2428 Revised to reflect amendment to 37 CFR 1.821.
- 2429 Revised to reflect amendments to 37 CFR 1.823 and 1.824.
- 2430 Revised to provide additional information about the PatentIn program.
- 2431 Revised sample sequence listing to reflect amendment to 37 CFR Appendix A to Subpart G to Part 1.
- 2432 Deleted as no longer applicable in view of amendment to 37 CFR 1.823.
- 2433 Deleted as no longer applicable in view of amendment to 37 CFR 1.823.

CHAPTER 2500:

- 2501 Revised maintenance fees to reflect amendment to 37 CFR 1.20. Replaced “Patent Maintenance Division” with “Status and Entity Division.”
- 2515 Revised to reflect amendment to 37 CFR 1.366.
- 2550 Revised to remove the verification requirement for the statement of small entity status.
- 2580 Revised to reflect amendment to 37 CFR 1.377.
- 2590 Revised to reflect amendment to 37 CFR 1.378. Replaced case law citations directed to the “unavoidable delay” standard with a reference to MPEP § 711.03(c), which discusses the “unavoidable delay” standard.
- 2591 Revised to include “importation” among the intervening rights provided by 35 U.S.C. 41(c)(2).
- 2592 Revised to reflect updated forms.
- 2595 Added section for forms related to maintenance fee payments and fee addresses.

Manual of PATENT EXAMINING PROCEDURE

Original Seventh Edition, July 1998



U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

The Patent and Trademark Office does not handle the sale of the Manual, distribution of notices and revisions, or change of address of those on the subscription list. Correspondence relating to existing subscriptions should be sent to the Superintendent of Documents at the following address:

Superintendent of Documents
Mail List Section
Washington, DC 20402

Telephone: 202-512-2267

Inquiries relating to purchasing the Manual should be directed to:

Superintendent of Documents
United States Government Printing Office
Washington, DC 20402

Telephone: 202-512-1800

Orders for reproduced copies of individual replacement pages or of previous revisions of the Manual should be sent to the following address:

Commissioner of Patents and Trademarks
Attention: Certification Branch
Washington, DC 20231

Telephone: 1-800-972-6382
or 703-308-9726

Previous editions and revisions of the Manual are available on microfilm in the Public Search Room.

The Manual is available on CD-ROM and on diskette from:

U.S. Patent and Trademark Office
Office of Electronic Information Products and Services
Washington, DC 20231

Telephone: 703-306-2600

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

Telephone: 703-308-9660

Additions to the text of the Manual are indicated by arrows (><) inserted in the text. Deletions are indicated by a single asterisk (*) where a single word was deleted and by two asterisks (**) where more than one word was deleted. The use of three or five asterisks in the body of the laws and rules indicates a portion of the law or rule which was not reproduced.

First Edition, November 1949
Second Edition, November 1953
Third Edition, November 1961
Fourth Edition, June 1979
Fifth Edition, August 1983
Sixth Edition, January 1995
Seventh Edition, July 1998

Foreword

This Manual is published to provide Patent and Trademark Office patent examiners, applicants, attorneys, agents, and representatives of applicants with a reference work on the practices and procedures relative to the prosecution of patent applications before the Patent and Trademark Office. It contains instructions to examiners, as well as other material in the nature of information and interpretation, and outlines the current procedures which the examiners are required or authorized to follow in appropriate cases in the normal examination of a patent application. The Manual does not have the force of law or the force of the rules in Title 37 of the Code of Federal Regulations.

A separate manual entitled "Trademark Manual of Examining Procedure" is published by the Patent and Trademark Office as a reference work for trademark cases.

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

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

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

Box MPEP
Assistant Commissioner for Patents
Washington, D.C. 20231

Table of Contents

<i>Chapter</i>	<i>Page</i>
Introduction	1
100 Secrecy, Access, National Security and Foreign Filing	100-1
200 Types, Cross-Noting, and Status of Application	200-1
300 Ownership and Assignment	300-1
400 Representative of Inventor or Owner	400-1
500 Receipt and Handling of Mail and Papers	500-1
600 Parts, Form, and Content of Application	600-1
700 Examination of Applications	700-1
800 Restriction in Applications Filed Under 35 U.S.C. 111; Double Patenting ...	800-1
900 Prior Art, Classification, Search	900-1
1000 Matters Decided by Various Patent and Trademark Office Officials	1000-1
1100 Statutory Invention Registration (SIR)	1100-1
1200 Appeal	1200-1
1300 Allowance and Issue	1300-1
1400 Correction of Patents	1400-1
1500 Design Patents	1500-1
1600 Plant Patents	1600-1
1800 Patent Cooperation Treaty	1800-1
1900 Protest	1900-1
2000 Duty of Disclosure	2000-1
2100 Patentability	2100-1
2200 Citation of Prior Art and Reexamination of Patents	2200-1
2300 Interference Proceedings Under Public Law 98-622	2300-1
2400 Biotechnology	2400-1
2500 Maintenance Fees	2500-1
Appendix II List of Decisions Cited	A-7
Appendix L Patent Laws	L-1
Appendix R Patent Rules	R-1
Appendix T Patent Cooperation Treaty	T-1
Appendix AI PCT Administrative Instructions Under the PCT	AI-1
Appendix P Paris Convention	P-1
Index	I-1

Introduction

Constitutional Basis

The Constitution of the United States provides:

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

Statutes

Pursuant to the provision of the Constitution, Congress has over the years passed a number of statutes under which the Patent and Trademark Office is organized and our patent system is established. The provisions of the statutes can in no way be changed or waived by the Patent and Trademark Office.

Prior to January 1, 1953, the law relating to patents consisted of various sections of the Revised Statutes of 1874, derived from the Patent Act of 1870 and numerous amendatory and additional acts.

By an Act of Congress approved July 19, 1952, which came into effect on January 1, 1953, the patent laws were revised and codified into substantially its present form. The patent law is Title 35 of the United States Code which governs all cases in the Patent and Trademark Office. In referring to a particular section of the patent code the citation is given, for example, as, 35 U.S.C. 31. Title 35 of the United States Code is reproduced in Appendix L of the Manual of Patent Examining Procedure (MPEP).

35 U.S.C. 1. Establishment.

The Patent and Trademark Office shall continue as an office in the Department of Commerce, where records, books, drawings, specifications, and other papers and things pertaining to patents and to trademark registrations shall be kept and preserved, except as otherwise provided by law.

Rules

One of the sections of the patent statute, namely, 35 U.S.C. 6, authorizes the Commissioner of Patents and Trademarks, subject to the approval of the Secretary of Commerce, to establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office.

These regulations or rules and amendments thereto are published in the Federal Register and in the Official Gazette. In the Federal Register and in the Code of Fed-

eral Regulations the rules pertaining to patents are in Parts 1, 3, 5, and 10 of Title 37, Patents, Trademarks, and Copyrights. In referring to a particular section of the rules the citation is given, for example, as 37 CFR 1.31. A booklet entitled “Code of Federal Regulations, Title 37, Patents, Trademarks, and Copyrights,” published by the Office of the Federal Register, contains all of the patent rules as well as trademark rules and copyright rules. Persons desiring a copy of this booklet should order a copy from the Superintendent of Documents.

The primary function of the rules is to advise the public of the rules which have been established in accordance with the statutes and which must be followed before the Office. The rules govern the examiners, as well as applicants and their attorneys and agents. The rules pertaining to patent practice appear in the MPEP as Appendix R.

Commissioner’s Orders and Notices

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

Decisions

In addition to the statutes and rules, the actions taken by the examiner in the examination of applications for patents are to a great extent governed by decisions on prior cases. Applicants dissatisfied with an examiner’s action may have it reviewed. In general, that portion of the examiner’s action pertaining to objections on formal matters may be reviewed by petition to the Commissioner of Patents and Trademarks (see MPEP § 1002), and that portion of the examiner’s action pertaining to the rejection of claims on the merits may be reviewed by appeal to the Board of Patent Appeals and Interferences (see MPEP § 1201). The distinction is set forth in 37 CFR 1.181 and 1.191. In citing decisions as authority for his or her actions, the examiner should cite the decision in the manner set forth in MPEP § 707.06.

Publications Available from Superintendent of Documents

The following is a partial list of patent related publications available from the Superintendent of Documents. Orders should be addressed and remittances made payable to Superintendent of Documents, U. S. Government Printing Office, Washington, DC 20402.

Official Gazette of the United States Patent and Trademark Office—Patents. The official journal of the Patent and Trademark Office relating to patents. Issued each Tuesday, simultaneously with the weekly issuance of patents, it contains a selected figure of the drawings and a claim of each patent granted, indexes of patents, lists of patents available for license or sale, and general information such as orders, notices, changes in rules, and changes in classification.

Annual Indexes. An index of the patents issued each year is published in two volumes, one an alphabetical index of patentees and the other an index by subject matter of inventions. The two parts are sold separately. Price varies from year to year, depending upon size of the publication. An annual index of Trademarks contains an alphabetical index of trademark registrants, registration numbers, dates published, classification of goods for which registered, and decisions published during the calendar year. Price varies from year to year, depending upon size of the publication.

Guide for the Preparation of Patent Drawings. Contains selected rules of practice relating to patent drawings and interpretations of those rules, including examples of patent drawings.

Manual of Classification. A looseleaf volume listing the numbers and descriptive titles of the more than 300 classes and 95,000 subclasses used in the subject classification of patents, with an index to the classifications. Substitute and additional pages, which are included in the subscription service, are issued from time to time.

General Information Concerning Patents. Contains a vast amount of general information concerning the application for and granting of patents, expressed in nontechnical language for the layman. Multiple copies available from Superintendent of Documents.

Manual of Patent Examining Procedure. A looseleaf manual which serves primarily as a detailed reference work on patent examining practice and procedure for the Patent and Trademark Office's Examining Corps including statutes, rules, treaties, etc. Subscription service includes basic manual, revisions, and change notices.

Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office. An alphabetically and a geographically arranged listing of patent attorneys and agents registered to practice before the U. S. Patent and Trademark Office.

Code of Federal Regulations, Title 37, Patents, Trademarks, and Copyrights. Compilation including the rules of practice of the U. S. Patent and Trademark Office.

Publications Available From the Patent and Trademark Office

Orders should be addressed to Commissioner of Patents and Trademarks, Washington, D.C. 20231. Remittances should be made payable to Commissioner of Patents and Trademarks. Postage stamps, Superintendent of Documents coupons or other Government coupons are not acceptable in payment of Patent and Trademark Office fees (except as set forth in 37 CFR 1.24).

Basic Facts About Patents. Brief nontechnical answers to questions most frequently asked about Patents.

Guide to Filing a Patent Application. Brief technical description of the required parts of a patent application.

Patents. Copies of the specification and drawings of all patents are available at three dollars each. When ordering, identify the patent by the patent number, or give full name of the inventor and approximate date of issuance of the patent.

Classification Definitions. Contain the changes in classification of patents as well as definitions of new and revised classes and subclasses. Price is based upon size of publication.

For a current list of Patent and Trademark Office (PTO) publications and the sources from which these publications are available, contact the PTO General Information Services Division at 1-800-786-9199 or 703-308-4357.

See MPEP § 1730 for additional information sources.