Chapter 600 Parts, Form and Content of Application

601 Content of Application [R-8]

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

Application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include (1) a specification as prescribed by section 112 of this title; (2) a drawing as prescribed by section 113 of this title; and (3) an oath by the applicant as prescribed by section 115 of this title. The application must be accompanied by the fee required by law. The fee and oath may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Commissioner. Upon failure to

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

37 CFR 1.51 General requisites of an application.

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

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

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

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

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

(b) Applicants are encouraged to file an information disclosure statement, See §§ 1.97 through 1.99.

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

GUIDELINES FOR DRAFTING A MODEL PATENT APPLICATION

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

Arrangement and Contents of the Specification

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

(a) Title of the Invention.

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

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

(d) Background of the Invention.

1. Field of the Invention.

2. Description of related art including information disclosed under §§ 1.97-1.99.

(e) Summary of the Invention.

(f) Brief Description of the Drawing.

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

(h) Claim(s).

(i) Abstract of the Disclosure.

Content

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

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

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

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

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

(2) Description of the related art including information disclosed under >37 CFR<* 1.97-1.99: A paragraph(s) describing to the extent practical the information known to the applicant, including references to specific documents where appropriate. Where applicable, the problems involved in the information disclosed which are solved by the applicant's invention, should be indicated. This item may also be titled "Background Information".

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

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

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

Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field to which the invention pertains, form a part of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

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

Reference characters corresponding to elements recited in the detailed description and the drawings may be used in conjunction with the recitation of the same element or group of elements in the claims. The reference characters, however,

should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. The use of reference characters is to be considered as having no effect on the scope of the claims.

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

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

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

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

Oath or Declaration

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

THE APPLICATION

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

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

Determination of completeness of an application is covered in >MPEP< § 506.

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

Note

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

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

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

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

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

The Patent and Trademark Office has initiated a program for expediting newly filed application papers through pre-examination steps. This program requires the cooperation of applicants in order to attain the desired result — a reduction in processing time.

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

This program is voluntary and the classification submitted will be accepted as advisory in nature. The final class and subclass assignment remains the responsibility of the Office.

601.01 Complete Application [R-8]

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

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

(b) The filing date of an application for patent is the date on which: (1) A specification containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75; and (2) Any drawing required by § 1.81(a), are filed in the Patent and Trademark Office >in the name of the actual inventor or inventors as required by § 1.41<. No new matter may be introduced into an application after its filing date (§ 1.118).

(c) If any application is filed without the specification or drawing required by paragraph (b) of this section, applicant will be so notified and given a time period within which to submit the omitted specification or drawing in order to obtain a filing date as of the date of filing of such submission. If the omission is not corrected within the time period set, the application will be returned or otherwise disposed of; the fee, if submitted, will be refunded less a $*>15<.00 handling fee.

(d) If an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include the appropriate filing fee or an oath or declaration by the applicant, applicant will be so notified >, if a correspondence address has been provided,< and given a period of time within which to file the fee, oath, or declaration and to pay the surcharge as set forth in § 1.16(e) in order to prevent abandonment of the application. >If the required filing fee is not timely paid, or if the processing and retention fee set forth in § 1.21(l) is not paid within one year of the date of mailing of the notification required by this paragraph, the application will be disposed of. No copies will be provided or certified by the Office of an application which has been disposed of or in which neither the required basic filing fee nor the processing and retention fee has been paid.< The notification pursuant to this paragraph may be made simultaneously with any notification pursuant to

paragraph (c) of this section. >If no correspondence address is included in the application, applicant has two months from the filing date to file the fee, oath or declaration and to pay the surcharge as set forth in § 1.16(e) in order to prevent abandonment of the application or one year from the filing date to pay the processing and retention fee set forth in § 1.21(l) to prevent disposal of the application.<

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

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

>37 CFR<* 1.53 relates to application serial numbers, filing dates and completion of applications. >37 CFR <* 1.53(a) indicates that a serial number is assigned to any filed application for identification purposes, even if the application is incomplete or informal. >37 CFR <* 1.53(b) provides that a filing date is assigned to an application as of the date a specification containing a description and claim and any required drawing >and the names of all inventors< are filed in the Patent and Trademark Office. >Failure to meet any of the requirements in 37 CFR 1.53(b) will result in the application being denied a filing date. The filing date to be accorded such an application is the date on which all of the requirements of 37 CFR 1.53(b) are met.< Although the filing fee and oath or declaration can be submitted later, no amendments can be made to the specification or drawings which will introduce new matter. This practice is authorized by 35 U.S.C. 111 as amended by Pub. L. 97-247. >37 CFR<* 1.53(c) provides for notifying applicant of any application incomplete because the specification or drawing is missing and giving the applicant a time period to correct any omission. >Applicant will also be notified if all the inventors are not named, such as by the use of "et al.".< If the omission is not corrected within the time period given, the application will be returned or otherwise disposed of and a handling fee of $*>15<.00 will be retained from any refund of a filing fee. >37 CFR< *1.53(d) provides that, where a filing date has been assigned to a filed specification and drawing, the applicant will be notified >if a correspondence address has been provided< and be given a period of time in which to file the missing fee, oath or declaration and to pay the surcharge due >in order to prevent abandonment of the application<. The time period usually set is one month from the date of notification by the Patent and Trademark Office, but in no case less than two months after the date of filing of the application. >This time period is subject to the provisions of 37 CFR 1.136(a).

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

Effective February 27, 1983, in accordance with the provisions of >35< U.S.C. 111 and 37 CFR 1.53(b), a filing date is granted to an application for patent, which includes at least a specification containing a description pursuant to 37 CFR 1.71 and at least one claim pursuant to 37 CFR 1.75, and any drawing referred to in the specification or required by 37 CFR 1.81(a), which is filed in the Patent and Trademark Office and which names the actual inventor or inventors pursuant to 37 CFR 1.41(a). If an application which has been accorded a filing date does not include the appropriate filing fee or oath or declaration, applicant will be so notified and given a period of time within which to file the missing parts to complete the application and to pay the surcharge as set forth in 37 CFR 1.16(e) in order to prevent abandonment of the application.

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

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

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

The oath or declaration filed in response to such a notice must identify the specification and any amendment filed with the specification >which is intended to be part of the original disclosure<. If an amendment is filed with the oath or declaration filed after the filing date of the application, it may be

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

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

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

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

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

(1) name of inventor and application serial number;

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

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

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

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

If the oath or declaration is filed with an "attached" specification as indicated in item (4) above, it must be accompanied by a statement that the "attached" specification is a copy of the specification and any amendments thereto which were filed in the Office in order to obtain a filing date for the application. Such statement must be a verified statement if made by a person not registered to practice before the Office.

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

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

The >following< forms used by Application >Branch< to notify applicants of defects are reproduced on the following pages. "Notice to File Missing Parts of Application - Filing Date Granted"' form PTO-1533; "Notice to File Missing Parts of Application - No Filing Date "; form PTO-1532, "Notice of Informal Application"' form PTO-152; "Notice of Incomplete Application", form PTO-1123, and "Notice of Incomplete Application filed Pursuant to 37 CFR 1.60"' form PTO-1534<.

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

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.

[ ]

DATE MAILED:

NOTICE TO FILE MISSING PARTS OF APPLICATION— FILING DATE GRANTED

A filing date has been granted to this application. However, the following parts are missing.

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

1. ☐ The statutory basic filing fee is: ☐ missing. ☐ insufficient. Applicant as a ☐ large entity, ☐ small entity, must submit $ _____ to complete the basic filing fee and MUST ALSO SUBMIT THE SURCHARGE AS INDICATED BELOW.
2. ☐ Additional claim fees of $ _____ as a ☐ large entity, ☐ small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due. NO SURCHARGE IS REQUIRED FOR THIS ITEM.
3. ☐ The oath or declaration:
   ☐ is missing.
   ☐ does not cover items omitted at the time of execution.

   An oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Serial Number and Filing Date is required. A SURCHARGE MUST ALSO BE SUBMITTED AS INDICATED BELOW.
4. ☐ The oath or declaration does not identify the application to which it applies. An oath or declaration in compliance with 37 CFR 1.63 identifying the application by the above Serial Number and Filing Date is required. A SURCHARGE MUST ALSO BE SUBMITTED AS INDICATED BELOW.
5. ☐ The signature to the oath or declaration is: ☐ missing; ☐ a reproduction; ☐ by a person other than the inventor or a person qualified under 37 CFR 1.42, 1.43, or 1.47. A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Serial Number and Filing Date is required. A SURCHARGE MUST ALSO BE SUBMITTED AS INDICATED BELOW.
6. ☐ The signature of the following joint inventor(s) is missing from the oath or declaration: _____. Applicant(s) should provide, if possible an oath or declaration signed by the omitted inventor(s), identifying this application by the above Serial Number and Filing Date. A SURCHARGE MUST ALSO BE SUBMITTED AS INDICATED BELOW.
7. ☐ The application was filed in a language other than English. Applicant must file a verified English translation of the application and a fee of $26.00 under 37 CFR 1.17(k), unless this fee has already been paid NO SURCHARGE UNDER 37 CFR 1.16(e) IS REQUIRED FOR THIS ITEM.
8. ☐ A $20.00 processing fee is required for returned checks. (37 CFR 1.21(m)).
9. ☐ Your filing receipt was mailed in error because check was returned.
10. ☐ Other:

A Serial Number and Filing Date have been assigned to this application. However, to avoid abandonment under 37 CFR 1.53(d), the missing parts and fees identified above in items 1 and 3-6 must be timely provided ALONG WITH THE PAYMENT OF A SURCHARGE OF $110.00 for large entities or $55.00 for small entities who have filed a verified statement claiming such status. The surcharge is set forth in 37 CFR 1.16(e). Applicant is given ONE MONTH FROM THE DATE OF THIS LETTER, OR TWO MONTHS FROM THE FILING DATE of this application, WHICHEVER IS LATER, within which to file all missing parts and pay any fees. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

Direct the response to, and any questions about, this notice to the undersigned, Attention: Application Branch.

A copy of this notice MUST be returned with response.

For Office Use Only	
☐ 102	☐ 202
☐ 103	☐ 203
☐ 104	☐ 204
☐ 105	☐ 205

For: Manager, Application Branch
(703) 557-3254

FORM PTO-1665 (REV 7-87)

OFFICE COPY

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

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.

[ ]

DATE MAILED:

NOTICE TO FILE MISSING PARTS OF APPLICATION— NO FILING DATE

(Attachment to Form PTO-1123)

In order to avoid payment by applicant of the surcharge required if items 1 and 3-6 are filed after the filing date the following items are also brought to applicant's attention at this time.

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

1. ☐ The statutory basic filing fee is: ☐ missing ☐ insufficient. Applicant as a ☐ large entity ☐ small entity must submit $_____ to complete the basic filing fee and MUST ALSO SUBMIT THE SURCHARGE, IF REQUIRED, AS INDICATED BELOW.

2. ☐ Additional claim fees of $_____ as a ☐ large entity, ☐ small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due. NO SURCHARGE IS REQUIRED FOR THIS ITEM.

3. ☐ The oath or declaration:
   ☐ is missing.
   ☐ does not cover items required on the "Notice of Incomplete Application".
   An oath or declaration in compliance with 37 CFR 1.63, referring to the above Serial Number and Receipt Date is required. A SURCHARGE, IF REQUIRED, MUST ALSO BE SUBMITTED AS INDICATED BELOW.

4. ☐ The oath or declaration does not identify the application to which it applies. An oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Serial Number and Receipt Date is required. A SURCHARGE, IF REQUIRED, MUST ALSO BE SUBMITTED AS INDICATED BELOW.

5. ☐ The signature to the oath or declaration is: ☐ missing; ☐ a reproduction; ☐ by a person other than the inventor or a person qualified under 37 CFR 1.42, 1.43, or 1.47. A properly signed oath or declaration in compliance with 37 CFR 1.63, referring to the above Serial Number and Recipt Date is required. A SURCHARGE, MUST ALSO BE SUBMITTED AS INDICATED BELOW.

6. ☐ The signature of the following joint inventor(s) is missing from the oath or declaration: _____. Applicant(s) should provide, if possible, an oath or declaration signed by the omitted inventor(s), identifying this application by the above Serial Number and Receipt Date. A SURCHARGE, IF REQUIRED, MUST ALSO BE SUBMITTED AS INDICATED BELOW.

7. ☐ A $20.00 processing fee is required for returned checks. (37 CFR 1.21(m)).

8. ☐ Other:

Required items 1-7 above SHOULD be filed, if possible, with any items required on the "Notice of Incomplete Application" enclosed with this form. If concurrent filing of all required items is not possible, items 1-7 above must be filed no later than two months from the filing date of this application. The filing date will be the date of receipt of the items required on the "Notice of Incomplete Application." If items 1 and 3-6 above are submitted after the filing date, THE PAYMENT OF A SURCHARGE OF $110.00 for large entities, or $55.00 for small entities who have filed a verified statement claiming such status, is required. (37 CFR 1.16(e)).

Applicant must file all the required items 1-7 indicated above within two months from any filing date granted to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

Direct the response to, and any questions about, this notice to the undersigned, Attention: Application Branch.

A copy of this notice MUST be returned with response.

For Office Use Only	
☐ 102	☐ 202
☐ 103	☐ 203
☐ 104	☐ 204
☐ 105	☐ 205

For: Manager, Application Branch
(703) [illegible]-3254

FORM PTO-1532 (REV. 7-87) OFFICE COPY

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

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.

[ ]

DATE MAILED:

NOTICE OF INFORMAL APPLICATION

(Attachment to Office Action)

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

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

1. ☐ was not executed in accordance with either 37 CFR 1.66 or 1.68.
2. ☐ does not identify the city and state or foreign country of residence of each inventor.
3. ☐ does not identify the citizenship of each inventor.
4. ☐ does not state whether the inventor is a sole or joint inventor.
5. ☐ does not state that the person making the oath or declaration:
   a. ☐ has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration.
   b. ☐ believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.
   c. ☐ acknowledges the duty to disclose information which is material to the examination of the application in accordance with 37 CFR 1.56(a).
6. ☐ does not identify the foreign application for patent or inventor's certificate on which priority is claimed pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application serial number, country, day, month, and year of its filing.
7. ☐ does not state that the person making the oath or declaration acknowledges the duty to disclose material information as defined in 37 CFR 1.56(a) which occurred between the filing date of the prior application and filing date of the continuation-in-part application which discloses and claims subject matter in addition to that disclosed in the prior application (37 CFR 1.63(d)).
8. ☐ does not include the date of execution.
9. ☐ does not use permanent ink, or its equivalent in quality, as required under 37 CFR 1.52(a) for the: ☐ signature ☐ oath/declaration.
10. ☐ contains non-initialed alterations (See 37 CFR 1.52(c) and 1.56).
11. ☐ does not contain the clause regarding "willful false statements..." as required by 37 CFR 1.68.
12. ☐ Other:

B. Applicant is required to provide:

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

FORM PTO-152 (REV. 4-87)

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

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.

DATE MAILED:

Notice of Incomplete Application

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

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

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

2. ☐ A drawing of Figure(s) _____ described in the specification is required in compliance with 35 U.S.C. 111.
3. ☐ A drawing of applicant's invention is required since it is necessary for the understanding of the subject matter of the invention in compliance with 35 U.S.C. 113.
4. ☐ The inventor's name(s) is missing. The full names of all inventors are required in compliance with 37 CFR 1.41.
5. ☐ Other:

All of the above-noted omissions, unless otherwise indicated, must be submitted within TWO MONTHS of the date of this notice or the application will be returned or otherwise disposed of. Any fee which has been submitted will be refunded less a $15.00 handling fee. See 37 CFR 1.53(c).

The filing date will be the date of receipt of all the items required above, unless otherwise indicated. Any assertions that the items required above were submitted, or are not necessary for a filing date, must be by way of a petition directed to the attention of the Office of the Assistant Commissioner for Patents accompanied by the $140.00 petition fee (37 CFR 1.17(h)). If the petition alleges that no defect exists, a request for refund of the petition fee may be included in the petition.

Direct the response to, and questions about, this notice to the undersigned, Attention: Application Branch.

A copy of this notice MUST be returned with response.

Enclosed:

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

For: Manager, Application Branch
(703) 557-3254

FORM PTO-1123 (REV. 7-87)

OFFICE COPY

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

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.

[ ]

DATE MAILED:

Notice of Incomplete Application Filed Pursuant to 37 CFR 1.60

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

1. ☐ A copy of the specification (description and claims) filed in the parent application:
   a. ☐ is missing.
   b. ☐ has page(s)_____missing.
   c. ☐ has the description of the invention missing.
   d. ☐ has claim(s)_____missing.
2. ☐ A copy of the oath or declaration filed in the parent application is missing.
3. ☐ The copy of the oath or declaration filed does not show applicant(s) signature or an indication on the oath or declaration that it was signed.
4. ☐ A copy of the drawings as filed in the parent application is missing.
5. ☐ A copy of any amendments referred to in the oath or declaration filed to complete the parent application is missing.
6. ☐ A statement that the application papers filed are a true copy of the prior application and that no amendments referred to in the oath or declaration filed to complete the prior application introduced new matter therein is missing. Such statement must be by the applicant or applicant's attorney or agent and must be a verified statement if made by a person not registered to practice before the United States Patent and Trademark Office.
7. ☐ Other:

The filing date will be the date of receipt of the items required above unless otherwise indicated. Any assertions that the items required above were submitted or are not necessary for a filing date must be by way of a petition directed to the attention of the Office of the Assistant Commissioner for Patents. Any such petition must be accompanied by the $140.00 petition fee (37 CFR 1.17(h)). If the petition alleges that no defect exists, a request for refund of the petition fee may be included in the petition.

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

Direct the response to, and questions about, this notice to the undersigned, Attention: Application Branch.

A copy of this notice MUST be returned with response.

For: Manager, Applica[illegible] Branch
(703) 557-3254

FORM PTO-1684 (REV. 7-87)

OFFICE COPY

601.02 Power of Attorney or Authorization of Agent [R-8]

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

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

601.03 Change of Correspondence Address [R-8]

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

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

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

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

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

601.04 National Stage Requirements of the United States as a Designated Office [R-8]

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

602 Original Oath or Declaration [R-8]

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

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

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

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

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

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

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

37 CFR 1.63 Oath or declaration.

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

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

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

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

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

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

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

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

(3) Acknowledges the duty to disclose information which is material to the examination of the application in accordance with § 1.56(a).

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

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

37 CFR 1.68 Declaration in lieu of oath.

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

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

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

>STATUTORY DECLARATIONS

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

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

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

{1} If executed without the United States:

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

(Signature)."

(2) If executed within the United States its territories, possessions, or commonwealths:

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

(Signature)."<

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

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

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

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

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

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

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

A seal is usually impressed on an oath. See >MPEP< §§ 604 and 604.01 and 37 CFR 1.66. However oaths executed in many states including Alabama, Louisiana, Maryland, Massachusetts, New Jersey, New York, Rhode Island, South Carolina and

Virginia need not be impressed with a seal.

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

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

¶ 6.05 Oath or Declaration Defective

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

The oath or declaration is defective because:

Examiner Note:

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

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

¶ 6.05.4 Sole or Joint Designation Omitted

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

Examiner Note:

This paragraph must be preceded by paragraph 6.05.

¶ 6.05.5 "Reviewed and Understands" Statement Omitted

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

Examiner Note:

This paragraph must be preceded by paragraph 6.05.

¶ 6.05.6 Original and First Omitted

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

Examiner Note:

This paragraph must be preceded by paragraph 6.05.

¶ 6.05.7 Duty of Disclosure Omitted

It does not state that the person making the oath or declaration acknowledges the duty to disclose information which is material to the examination of the application in accordance with 37 CFR 1.56(a).

Examiner Note:

This paragraph must be preceded by paragraph 6.05.

¶ 6.05.8 Identification of Foreign Applications Omitted

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

Examiner Note:

This paragraph must be preceded by paragraph 6.05.

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

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

Examiner Note:

This paragraph must be preceded by paragraph 6.05.

¶ 6.05.15 Not in Permanent Ink

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

Examiner Note:

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

2. This paragraph must be preceded by paragraph 6.05.

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

¶ 6.05.16 Non-Initialed Alterations

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

Examiner Note:

This paragraph must be preceded by paragraph 6.05.

¶ 6.05.17 Declaration Clause Omitted

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

Examiner Note:

This paragraph must be preceded by paragraph 6.05.<

602.01 Oath Cannot Be Amended [R-8]

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

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

Applicant may be so advised by using Form Paragraph 6.03.

¶ 6.03 Oath, Declaration Cannot Be Amended

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

body of the oath or declaration. See MPEP 602.01 and 602.02.

Examiner Note:

1.This paragraph is intended primarily for use in pro se applications.

2. Use Paragraph 6.05 and one or more of paragraphs 6.05.1 to 6.05.17 for a defective oath or declaration in a case where there is a power of attorney.

602.02 New Oath or Substitute for Original

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

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

602.03 Defective Oath or Declaration [R-8]

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

¶ 6.05 Oath or Declaration Defective

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

The oath or declaration is defective because:

Examiner Note:

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

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

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

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

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

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

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

¶ 6.46 Case Allowed, Substitute Declaration Needed

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

Examiner Note:

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

602.04 Foreign Executed Oath [R-8]

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

>Where the authority of the foreign officer is not certified, form paragraphs 6.05 and 6.05.13 may be used.

¶ 6.05 Oath or Declaration Defective

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

The oath or declaration is defective because:

Examiner Note:

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

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

¶ 6.05.13 Authority of Foreign Officer Not Certified

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

Examiner Note:

This paragraph must be preceded by paragraph 6.05.<

602.04(a) Foreign Executed Oath Is Ribboned to Other Application Papers [R-8]

37 CFR 1.66. Officers authorized to administer oaths.

*****

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

>Where the papers are not properly ribboned, use form paragraphs 6.05 and 6.05.14.

¶ 6.05 Oath or Declaration Defective

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

The oath or declaration is defective because:

Examiner Note:

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

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

¶ 6.05.14 No Ribbon Properly Attached

It does not have a ribbon properly attached.

Examiner Note:

This paragraph must be preceded by paragraph 6.05.<

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

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

The member countries that are parties to the Convention are:

Austria	Italy	Seychelles
Bahamas	Japan	Spain
Belgium	Lesotho	Suriname
Botswana	Liechtenstein	Swaziland
Cyprus	Luxembourg	Switzerland
Fiji	Malawi	Tonga
France	Malta	U.K. of Great Britain and N. Ireland
Germany, Fed. Rep. of	Mauritius	
Hungary	Netherlands	United States
Israel	Portugal	Yugoslavia

The Convention prescribes the following form for the apostille:

Model of Certificate

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

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

1. Country: .....

This public document

2. has been signed by .....
3. acting in the capacity of .....
4. bears the seal/stamp of .....

Certified

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

.....

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

602.05 Oath or Declaration — Date of Execution [R-8]

The time elapsed between the date of execution of the oath or declaration and the filing date of the application should be checked. **>A newly executed oath or declaration is required where the date of execution is more than three (3) months prior to the filing date of the application (international filing date in the case of an international application). If more than three

months have elapsed, the examiner must require< a new oath or declaration by using Form Paragraph 6.04.

¶ 6.04 Time Lapse Between Execution and Filing

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

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

Applicant may be notified by using Form Paragraph 6.05.

¶ 6.05 Oath or Declaration Defective

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

The oath or declaration is defective because:

Examiner Note:

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

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

¶ 6.05.10 Date of Execution Omitted

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

Examiner Note:

This paragraph must be preceded by paragraph 6.05.

602.05(a) Oath or Declaration in Division and Continuation Cases [R-8]

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

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

602.06 Non-English Oath or Declaration [R-8]

37 CFR 1.69 Foreign language oaths and declarations.

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

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

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

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

602.07 Oath or Declaration Filed in United States as a Designated Office [R-8]

>See MPEP § 1898.07(a)<**

603 Supplemental Oath or Declaration [R-8]

37 CFR 1.67. Supplemental oath or declaration.

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

(b) A supplemental oath or declaration meeting the requirements of § 1.63 must be filed: (1) When a claim is presented for matter originally shown or described but not substantially embraced in the statement or invention or claims originally presented; and (2) When an oath or declaration submitted in accordance with § 1.53(d) after the filing of the specification and any required drawings specifically and improperly refers to an amendment which includes new matter. No new matter may be introduced into an application after its filing date even if a supplemental oath or declaration is filed (§ 1.53(b); § 1.118). In proper cases the oath or declaration here required may be made on information and belief by an applicant other than inventor.

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

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

¶ 6.06 New Oath for Subject Matter not Originally Claimed

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

Examiner Note:

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

603.01 Supplemental Oath or Declaration Filed After Allowance [R-8]

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

604 Administration or Execution of Oath [R-8]

37 CFR 1.66. Officers authorized to administer oaths.

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

*****

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

604.01 Seal [R-8]

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

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

>¶ 6.05 Oath or Declaration Defective

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

The oath or declaration is defective because:

Examiner Note:

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

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

¶ 6.05.11 Notary Signature

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

Examiner Note:

This paragraph must be preceded by paragraph 6.05.

¶ 6.05.12 Notary Seal and Venue Omitted

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

Examiner Note:

This paragraph must be preceded by paragraph 6.05.<

604.02 Venue [R-8]

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

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

¶ 6.07 Lack of Venue

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

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

604.03 Notaries and Extent of Jurisdiction

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

COUNTY ONLY

Louisiana
Mississippi
Texas

VARIABLE JURISDICTION
(See explanatory paragraphs below)

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

STATEWIDE

All other states

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

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

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

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

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

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

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

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

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

604.03(a) Notarial Powers of Some Military Officers

Public Law 506 (81st Congress, Second Session) Article 136: (a) The following persons on active duty in the armed forces . . . shall have the general powers of a notary public and of a consul of the United States, in the performance of all notarial acts to be executed by members of any of the armed forces, wherever they may be, and by other persons subject to this code [Uniform Code of Military Justice] outside the continental limits of the United States:

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

(2) All law specialists;

(3) All summary courts-martial;

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

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

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

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

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

604.04 Consul [R-8]

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

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

jurisdiction of another official who, in turn, may certify as to the authority and jurisdiction of the officer before whom the oath is taken.

604.04(a) Consul-Omission of Certificate [R-8]

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

Form Paragraph 6.08 may be used to notify applicant.

¶ 6.08 Consul-Omission of Certificate

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

At the time of the next Office action the request for return of the oath, together with the application file and the copy of the oath, is submitted to the group director. If the request is approved by >the group director<*, the oath will be returned to the applicant by the examining group.

604.06 By Attorney in Case [R-8]

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

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

605 Applicant [R-8]

37 CFR 1.41 Applicant for patent.

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

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

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

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

37 CFR 1.45 Joint inventors.

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

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

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

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

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

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

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

For correction of inventorship, see >MPEP<§ 201.03.

37 CFR 1.46 Assigned inventions and patents.

In case the whole or a part interest in the invention or in the patent to be issued is assigned, the application must still be made or authorized to be made, and an oath or declaration signed, by the inventor or one of the persons mentioned in §§ 1.42, 1.43, or 1.47. However, the patent may be issued to the assignee or jointly to the inventor and the assignee as provided in § 1.334.

This section concerns filing by the actual inventor. If filed by other, see >MPEP<§ 409.03.

NOTE

Disposition of application by inventor, >MPEP< § 301. Inventor dead or insane, >MPEP< § 409.

605.01 Applicant's Citizenship [R-8]

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

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

¶ 6.05 Oath or Declaration Defective

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

The oath or declaration is defective because:

Examiner Note:

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

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

¶ 6.05.3 Citizenship Omitted

It does not identify the citizenship of the inventor.

Examiner Note:

This paragraph must be preceded by paragraph 6.05.<

605.02 Applicant's Residence [R-8]

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

>If the residence is not included in the oath or declaration as filed, the Application Branch will normally so indicate on a form PTO-152, "Notice of Informal Patent Application", so as to require a new declaration when the form is sent out with an Office action. If the examiner notes that the residence has not been included in the oath or declaration,Form Paragraph 6.05.2 should be used to notify the applicant.

¶ 6.05.2 Residence Omitted

It does not identify the city and state or foreign country of residence of each inventor.

Examiner Note:

This paragraph must be preceded by 6.05.<

605.03 Applicant's Post Office Address [R-8]

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

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

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

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

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

>¶ 6.09.1 Post Office Address Omitted

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

605.04 Applicant's Signature and Name [R-8]

37 CFR 1.64 Person making oath or declaration.

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

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

EXECUTION OF OATHS OR DECLARATIONS OF PATENT APPLICATIONS

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

rights it is appropriate to *emphasize the importance of proper execution and filing.

It is improper for an applicant to sign an oath or declaration which is not attached to or does not identify a specification and/or claims. See 37 CFR 1.56(c) which provides that

> "(a)ny application may be stricken from the files if:
> (1) An oath or declaration pursuant to § 1.63 is signed in blank;
> (2) An oath or declaration pursuant to § 1.63 is signed without review thereof by the person making the oath or declaration;
> (3) An oath or declaration pursuant § 1.63 is signed without review of the specification, including the claims, as required by § 1.63(b); or
> (4) The application papers filed in the Office are altered after the signing of an oath or declaration pursuant to § 1.63 referring to those application papers."

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

The provisions of 35 U.S.C. 363 for filing an international application under the Patent Cooperation Treaty (PCT) which designates the United States and thereby has the effect of a regularly filed United States national application, except as provided in 35 U.S.C. 102(e), are somewhat different than the provisions of 35 U.S.C. 111. The oath or declaration requirements for an international application before the Patent and Trademark Office are set forth in 35 U.S.C. 371(c)(4) and 37 CFR 1.>497<*.

37 CFR 1.52(c) states that "(n)o . . . alterations >in the application papers< are permissible after the signing of an oath or declaration referring to those application papers >(1.56(c))<. " It is improper for anyone, including counsel, to complete or otherwise alter application papers, including the oath or declaration, after the applicant has executed the same. >37 CFR<* 1.56(c) provides that

> "(a)ny application may be stricken from the files if: . . .
> (4) The application papers filed in the Office are altered after the signing of an oath or declaration pursuant to § 1.63 referring to those application papers."

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

>Any changes made in ink in the application or oath prior to signing must be initialed and dated by the applicants prior to execution of the oath or declaration. Form paragraph 6.02.1 may be used to call non-initialed and/or non-dated alterations to applicant's attention.

¶ 6.02.1 Non-initialed and/or non-dated Alterations in Application Papers

The application is objected to because of alterations which have not been initialed and/or dated as required by 37 CFR 1.52(c) and 1.56.

A properly executed affidavit or declaration signed by all the inventors identifying the alterations and stating when the unsigned and/or undated alterations were made is required.

If the alterations were made *before* the signing of the oath or declaration, the affidavit or declaration signed by all the inventors must so state.

If alterations were made *after* the signing of the oath or declaration, a full explanation and cancellation of such alterations is required.

Examiner Note:

If the affidavit or declaration reveals that the alterations were made after the signing of the oath or declaration, the application must immediately be forwarded without further action by the examiner to the Office of the Assistant Commissioner for Patents for review.<

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

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

FACSIMILE COPIES

From October 1, 1978 until February 27, 1983, the Office had accorded a filing date to facsimile or other reproduced copies of United States national patent applications meeting the requirements of 35 U.S.C. 111 as it then existed, even though the signature on the oath or declaration was only a copy.

Authority for this practice was found in 35 U.S.C. 26 as interpreted by the District Court decisions *Neergaard v. Dann*, Civil Action No. 76-536, December 20, 1976 (D.D.C.) and *Dietzel et al. v. Commissioner of Patents and Trademarks*, 200 USPQ 665 (D.D.C., 1976).

Since 35 U.S.C. 111 as amended by Public Law 97-247 and 37 CFR 1.53 now provide (since February 27, 1983) for the filing of the oath or declaration in a national patent application at a date later than the filing date of the application, such emergency situations should no longer arise >in national applications<. >Also, since<** 35 U.S.C. 371>(d) relating to the oath or declaration for entry into< ** the national phase in the United States under the Patent Cooperation Treaty >has been amended by Public Law 98-622, effective May 8, 1985 to provide for filing the oath or declaration after 20 months,< relief from the requirement for filing the oath or declaration >by the 20th month is no longer required<**.

The filing of facsimile or other reproduced copies of signatures on any papers required to be filed will not serve to meet any due date or to stop any period for response from running **. For example, the filing of a facsimile copy of an oath or declaration will not serve to stop a time period set in accordance with 37 CFR 1.53(d) from running so as to avoid the payment of extension fees pursuant to 37 CFR 1.136(a). A paper without an original signature will be considered to be unsigned **. The previous practice of accepting telegraphic amendments pending the filing of a properly signed confirmation of such telegraphic

amendment is also discontinued in view of the availability of the Certificate of Mailing practice provided by 37 CFR 1.8 and the ability to utilize 37 CFR 1.136(a) to obtain extensions of time.

It should be recognized that >the facsimile<* practice was intended for emergency situations to prevent loss of valuable rights and was not to be used routinely for filing applications.

Since February 28, 1983 facsimile or other reproduced copies may still be filed to obtain an application filing date but such copies will be treated as lacking a signature.

605.04(b) One Full Given Name Required [R-8]

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

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

No affidavit should be required.

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

>Form Paragraph 6.10 may be used.

¶ 6.10 Full Given Name Does Not Appear

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

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

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

605.04(c) * >Inventor< Changes Name [R-8]

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

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

605.04(d) Applicant Unable to Write

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

605.04(e) May Use Title With Signature

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

605.04(f) Signature on Joint Applications — Order of Names [R-8]

The order of names of joint patentees in the heading of the patent is taken from the order in which the typewritten names appear in the original oath or declaration. Care should therefore be exercised in selecting the preferred order of the typewritten names of the joint inventors, before filing, as requests for subsequent shifting of the names would entail changing numerous records in the Office. Since the particular order in which the names appear is of no consequence insofar as the legal rights of the joint applicants are concerned, no changes will be made except **>when a petition under 37 CFR 1.182 is granted. The petition should be directed to the attention of the Office of the Deputy Assistant Commissioner for Patents.The petition< to change the order of names must be signed by either the attorney or agent of record or all the applicants. It is suggested that all typewritten and signed names appearing in the application papers should be in the same order as the typewritten names in the oath or declaration.

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

605.04(g) >Correction of Inventorship<** [R-8]

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

605.05 Administrator, Executor, or Other Legal Representative [R-8]

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

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

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

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

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

605.06 Filing by Other Than Inventor [R-8]

See >MPEP< § 409.03.

>605.07 Joint Inventors [R-8]

35 U.S.C. 116 Inventors

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

* * * * *

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

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

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

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

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

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

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

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

Guidelines

37 CFR 1.45 Joint inventors.

* * *

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

If an application is filed with joint inventors, the examiner should assume that the subject matter of the various claims was commonly owned at the time the inventions covered therein were made, unless there is evidence to the contrary. If inventors of subject matter, not commonly owned at the time of the later invention, file a joint application, applicants have an obligation pursuant to 37 CFR 1.56 to point out the inventor and invention dates of each claim and the lack of common ownership at the time the later invention was made in order that the examiner may consider the applicability of 35 U.S.C. 102(f)/103 or 35 U.S.C. 102(g)/103. The examiner should assume, unless there is evidence to the contrary, that applicants are complying with their duty of disclosure. It should be pointed out that 35 U.S.C. 119 benefit may be claimed to any foreign application as long as the U.S. named inventor was the inventor of the foreign application invention and 35 U.S.C. 119 requirements are met. Where two or more foreign applications are combined to take advantage of the changes to 35 U.S.C. 103 or 35 U.S.C. 116, benefit as to each foreign application may be claimed if each complies with 35 U.S.C. 119 and the U.S. application inventors are the inventors of the subject matter of the foreign applications. For example,

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

606 Title of Invention [R-8]

37 CFR 1.72. >Title and abstract.<

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

*****

606.01 Examiner May Require Change in Title

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

¶ 6.11 Title of Invention Is Not Descriptive

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

Examiner Note:

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

This may result in slightly longer titles, but the loss in brevity

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

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

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

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

607 Filing Fee [R-8]

35 U.S.C. 41. Patent fees.

(a) The Commissioner shall charge the following fees:

1. On filing each application for an original patent, except in design or plant cases, $300; in addition, on filing or on presentation at any other time, $30 for each claim in independent form which is in excess of three, $10 for each claim (whether independent or dependent) which is in excess of twenty, and $100 for each application containing a multiple dependent claim. For the purpose of computing fees, a multiple dependent claim as referred to in section 112 of this title or any claim depending therefrom shall be considered as separate dependent claims in accordance with the number of claims to which reference is made. Errors in payment of the additional fees may be rectified in accordance with regulations of the Commissioner.

2. For issuing each original or reissue patent, except in design or plant cases, $500.

3. In design and plant cases:

a. On filing each design application, $125.

b. On filing each plant application, $200.

c. On issuing each design patent, $175.

d. On issuing each plant patent, $250.

4. On filing each application for the reissue of a patent, $300; in addition, on filing or on presentation at any other time, $30 for each claim in independent form which is in excess of the number of independent claims of the original patent, and $10 for each claim (whether independent or dependent) which is in excess of twenty and also in excess of the number of claims of the original patent. Errors in payment of the additional fees may be rectified in accordance with regulations of the Commissioner.

5. On filing each disclaimer, $50.

6. On filing an appeal from the examiner to the Board of >Patent< Appeals >and Interferences<, $115; in addition, on filing a brief in support of the appeal, $115, and on requesting an oral hearing >in the appeal< before the Board of >Patent< Appeals >and Interferences<, $100.

7. On filing each petition for the revival of an unintentionally abandoned application for a patent or for the unintentionally delayed payment of the fee for issuing each patent, $500, unless the petition is filed under sections 133 or 151 of this title, in which case the fee shall be $50.

8. For petitions for one-month extensions of time to take actions required by the Commissioner in an application:

a. On filing a first petition, $50.

b. On filing a second petition, $100.

c. On filing a third or subsequent petition, $200.

*****

>NOTE: UNDER 35 U.S.C. SUBSECTION 41(f), THE AMOUNTS OF THE FEES HAVE BEEN INCREASED BY RULE; SEE 37 CFR 1.16 - 1.21 FOR CURRENT FEE AMOUNTS. The Commissioner may change the fees by rule every three (3) years, starting in 1982, based on changes in the Consumers Price Index.<

37 CFR 1.16 National application filing fees.

(a) Basic fee for filing each application for an original patent, except design or plant cases:

By a small entity (§ 1.9(f)) ..... >$170.00<

By other than a small entity ..... >340.00<

(b) In addition to the basic filing fee in an original application, for filing or later presentation of each independent claim in excess of 3:

By a small entity (§ 1.9(f)) ..... >17.00<

By other than a small entity ..... >34.00<

(c) In addition to the basic filing fee in an original application, for filing or later presentation of each claim (whether independent or dependent) in excess of 20 (Note that § 1.75(c) indicates how multiple dependent claims are considered for fee calculation purposes.):

By a small entity (§ 1.9(f)) ..... >6.00<

By other than a small entity ..... >12.00<

(d) In addition to the basic filing fee in an original application, if the application contains, or is amended to contain, a multiple dependent claim(s), per application:

By a small entity (§ 1.9(f)) ..... >55.00<

By other than a small entity ..... >110.00<

(If the additional fees required by paragraphs (b), (c) and (d) are not paid on filing or on later presentation of the claims for which the additional fees are due, they must be paid or the claims cancelled by amendment, prior to the expiration of the time period set for response by the Office in any notice of fee deficiency.)

(e) Surcharge for filing the basic filing fee or oath or declaration on a date later than the filing date of the application:

By a small entity (§ 1.9(f)) ..... >55.00<

By other than a small entity ..... >110.00<

(f) For filing each design application:

By a small entity (§ 1.9(f)) ..... >70.00<

By other than a small entity ..... >140.00<

(g) Basic fee for filing each plant application:

By a small entity (§ 1.9(f)) ..... >110.00<

By other than a small entity ..... >220.00<

(h) Basic fee for filing each reissue application:

By a small entity (§ 1.9(f)) ..... >170.00<

By other than a small entity ..... >340.00<

(i) In addition to the basic filing fee in a reissue application, for filing or later presentation of each independent claim which is in excess of the number of independent claims in the original patent:

By a small entity (§ 1.9(f)) ..... >17.00<

By other than a small entity ..... >34.00<

(j) In addition to the basic filing fee in a reissue application, for filing or later presentation of each claim (whether independent or dependent) in excess of 20 and also in excess of the number of claims in the original patent, (Note that § 1.75(c) indicates how multiple dependent claims are considered for fee purposes.):

By a small entity (§ 1.9(f)) .....>6.00<
By other than a small entity .....>12.00<

(Note, see § 1.445 for international application filing and processing fees.).

The above wording of 35 U.S.C. 41 > came into force on October 1, 1982 < and >the fees set forth in< 37 CFR 1.16 >became effective on October 5, 1985 under 35 U.S.C. 41(f)< and *>are< effective *>for< all U.S. patent applications filed on and after that date >until changed<.

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

The fee amounts referred to in the next 3 paragraphs may be reduced by 50% if small entity status is established under 37 CFR 1.27.

When filing an application, a basic fee of >$340<* entitles applicant to present (20) claims including not more than (3) >claims< in independent form. If claims in excess of the above are included at the time of filing, an additional fee of $>34<* is required for each independent claim in excess of three, and a $>12<* fee for each claim in excess of twenty (20) claims (whether independent or dependent). The fee for proper multiple dependent claims is $>12<* for each dependency 37 CFR 1.75(c) and $>110<* per application containing a proper multiple dependent claim (in applications where a proper multiple dependent claim is presented for the first time after October 1, 1982. For an improper multiple dependent claim the fee is $>12<*.

Upon submission of an amendment (whether entered or not) affecting the claims, payment of the following additional fees is required in a pending application whether the application was filed before or after October 1, 1982:

$>34 <* for each independent claim pending in excess of 3 or the number of independent claims already paid for.

$>12<* for each claim pending in excess of 20 or the total number already paid for. A proper multiple dependent claim counts as one claim for each claim referred to. (It should be recognized that the basic $>340 < fee pays for twenty (20) claims, three of which may be independent, regardless of the number actually filed.)

The Application >Branch< has been authorized to accept all applications, otherwise acceptable, if the basic fee of $>340<* is submitted, and to require payment of the deficiency within a stated period upon notification of the deficiency.

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

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

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

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

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

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

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

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

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

See >MPEP< § 1415 for reissue application fees.

607.02 Returnability of Fees [R-8]

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

608 Disclosure [R-8]

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

If during the course of examination of a patent application, an examiner notes the use of language that could be deemed offensive to any race, religion, sex, ethnic group, or nationality, he or she should object to the use of the language as failing to comply with the Rules of Practice. >37 CFR< 1.3 proscribes the

presentation of papers which are lacking in decorum and courtesy. There is a further basis for objection in that the inclusion of such proscribed language in a Federal Government publication would not be in the public interest. Also, the inclusion in application drawings of any depictions or caricatures that might reasonably be considered offensive to any group should be similarly objected to, on like authority.

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

For design application practice see >MPEP< §1504.

608.01 Specification [R-8]

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

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

37 CFR 1.71 Detailed description and specification of the invention.

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

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

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

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

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

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

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

(c) Any interlineation, erasure, or cancellation or other alteration of the application papers filed must be made before the signing of any accompanying oath or declaration pursuant to § 1.63 referring to those application papers and should be dated and initialed or signed by the applicant on the same sheet of paper. No such alterations in the application papers are permissible after the signing of an oath or declaration referring to those application papers (§ 1.56(c)). After the signing of the oath or declaration referring to the application papers, amendments may only be made in the manner provided by §§1.121 and 1.123 through 1.125.

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

37 CFR 1.58 Chemical and mathematical formulas and tables.

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

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

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

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

when the papers are punched for insertion in a file wrapper.

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

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

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

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

¶ 6.32 Application on easily erasable paper

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

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

Examiner Note:

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

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

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

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

¶ 7.29 Disclosure Objected to, Minor Informalities

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

Examiner Note:

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

The specification does not require a date.

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

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

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

Form Paragraphs 6.29-6.31 should be used where appropriate.

¶ 6.29 Specification, Spacing of Lines

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

¶ 6.30 Numerous Grammatical Errors

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

¶ 6.31 Lengthy Specification, Jumbo Case

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

Examiner Note:

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

USE OF METRIC SYSTEM OF MEASUREMENTS IN PATENT APPLICATIONS

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

The initials S.I. stand for "Systeme International d'Unites", the French name for the International System of Units, a modernized metric system adopted in 1960 by the International

General Conference of Weights and Measures based on precise unit measurements made possible by modern technology.

FILING OF NON-ENGLISH LANGUAGE APPLICATIONS

37 CFR 1.52 Language, Paper, Writing, Margins.

*****

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

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

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

A subsequently filed verified English translation must contain the complete identifying data for the application in order to permit prompt association with the papers initially filed. Accordingly, it is strongly recommended that the original application papers be accompanied by a cover letter and a self-addressed return post card, each containing the following identifying data in English: (a) applicant's name(s); (b) title of invention; (c) number of pages of specification, claims, and sheets of drawings; (d) whether oath or declaration was filed and (e) amount and manner of paying the filing fee.

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

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

ILLUSTRATIONS IN THE SPECIFICATION

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

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

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

>APPLICATION FILED WITHOUT ALL PAGES OF SPECIFICATION

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

amendment cancelling from the specification all incomplete sentences and any claims which depend upon the omitted pages for disclosure and support. The petition requesting that the application be accepted without the omitted pages should be directed to the Office of the Assistant Commissioner for Patents and request relief under 37 CFR 1.182.

APPLICATION FILED WITHOUT AT LEAST ONE CLAIM

35 U.S.C. 111 requires that an application for patent should include, *inter alia*, "a specification as prescribed by section 112 of this title". Section 112 states that, "The specification shall contain a written description ... .and ... shall conclude with one or more claims ..." Also, the CAFC stated in *Litton Systems, Inc v. Whirlpool*, 221 USPQ 97, 105 (Fed. Cir. 1984) that:

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

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

608.01(a) Arrangement of Application [R-8]

37 CFR 1.77 Arrangement of application elements.

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

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

(b) (Reserved).

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

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

(d) Brief summary of the invention.

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

(f) Detailed description.

(g) Claim or claims.

(h) Abstract of the disclosure.

(i) Signed oath or declaration.

(j) Drawings.

NOTE

Design patent specification, >MPEP< § 1503.01.

Plant patent specification, >MPEP< § 1605.

Reissue patent specification, >MPEP< § 1411.

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

(a) Title of the Invention.

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

(c) Background of the Invention.

1. Field of the Invention.

2. Description of the related art including information disclosed under >37 CFR< 1.97-1.99.

(d) Summary of the Invention.

(e) Brief Description of the Drawing.

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

(g) Claim(s).

(h) Abstract of the Disclosure.

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

¶ 6.01 Arrangement of Specification

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

Arrangement of the Specification

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

(a) Title of the Invention.

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

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

(d) Background of the Invention.

1. Field of the Invention.

2. Description of Related Art including information disclosed under 37 CFR §§ 1.97-1.99.

(e) Summary of the Invention.

(f) Brief Description of the Drawing.

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

(h) Claim(s).

(i) Abstract of the Disclosure.

Examiner Note:

In this paragraph an introductory sentence will be necessary.

This paragraph is intended primarily for use in Pro Se applications.

¶ 6.02 Content of Specification

Content of Specification

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

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

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

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

(1) Field of the Invention: A statement of the field of art to which

the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions or the subject matter of the claimed invention. This item may also be titled "Technical Field".

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

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

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

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

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

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

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

Examiner Note:

In this paragraph an introductory sentence will be necessary.

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

608.01(b) Abstract of the Disclosure [R-8]

37 CFR 1.72(b). Title and abstract.

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

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

If the abstract contained in the application does not comply with the guidelines, the examiner should point out the defect to the applicant in the first Office action, or at the earliest point in the prosecution that the defect is noted, and require compliance with the guidelines. Since the abstract of the disclosure has been interpreted to be a part of the specification for the purpose of compliance with paragraph 1 of 35 U.S.C. 112 (*In re Armbruster*, 512 F.2d 676, 185 USPQ 152 (CCPA, 1975)), it would ordinarily be preferable that the applicant make the necessary changes to the abstract to bring it into compliance with the guidelines. See Form Paragraphs 6.13-6.16 (below).

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

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

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

GUIDELINES FOR THE PREPARATION OF PATENT ABSTRACTS

Background

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

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

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

Content

A patent abstract is a concise statement of the technical dis-

closure of the patent and should include that which is new in the art to which the invention pertains.

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

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

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

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

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

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

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

Language and Format

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

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

Responsibility

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

Sample Abstracts

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

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

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

¶ 6.12 Abstract Missing (Background)

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

Examiner Note:

For Pro Se applicant consider form paragraphs 6.14 - 6.16.

¶ 6.13 Abstract Objected to: Minor Informalities

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

Examiner Note:

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

¶ 6.14 Abstract of the Disclosure: Content

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

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

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

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

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

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

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

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

Examiner Note:

See paragraph 6.16.

¶ 6.15 Abstract of the Disclosure, Chemical Cases

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

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

¶ 6.16 Abstract of the Disclosure, Language

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

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

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

Examiner Note:

See also paragraph 6.14.

608.01(c) Background of the Invention [R-8]

The Background of the Invention ordinarily comprises two parts:

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

(2) Description of the related art including information disclosed under >37 CFR<* 1.97 -1.99: A paragraph(s) describing to the extent practical the state of the prior art or other information disclosed known to the applicant, including references to specific prior art or other information where appropriate. Where applicable, the problems involved in the prior art or other information disclosed which are solved by the applicant's invention should be indicated. See also >MPEP< §§ 608.01(a), 608.01(p) and 707.05(b).

608.01(d) Brief Summary of Invention [R-8]

37 CFR 1.73 Summary of the invention.

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

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

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

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

608.01(e) Reservation Clauses Not Permitted

37 CFR 1.79 Reservation clauses not permitted.

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

608.01(f) Brief Description of Drawings [R-8]

37 CFR 1.74 Reference to drawings.

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

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

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

608.01(g) Detailed Description of Invention [R-8]

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

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

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

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

USE OF SYMBOL "Ø" IN PATENT APPLICATION

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

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

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

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

608.01(h) Mode of Operation of Invention [R-8]

The best mode contemplated by the inventor of carrying out his >or her< invention must be set forth in the description. >See 35 U.S.C. 112. There is no statutory requirement for the disclo-

sure of a specific example. A patent specification is not intended nor required to be a production specification. *In re Gay*, 309 F2d 768, 135 USPQ 311 (CCPA 1962). The absence of a specific working example is not necessarily evidence that the best mode has not been disclosed, nor is the presence of one evidence that it has. *In re Honn*, 364 F2d 454, 150 USPQ 652 (CCPA 1966). In determining the adequacy of a best mode disclosure, only evidence of concealment (accidental or intentional) is to be considered. That evidence must tend to show that the quality of an applicant's best mode disclosure is so poor as to effectively result in concealment. *In re Sherwood*, 204 USPQ 537 (CCPA 1980).<**

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

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

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

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

608.01(i) Claims [R-8]

37 CFR 1.75 Claim(s).

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

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

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

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

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

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

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

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

NOTE

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

608.01(j) Numbering of Claims

37 CFR 1.126 Numbering of claims.

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

In a single claim case, the claim is not numbered. Form Paragraph 6.17 may be used to notify applicant.

¶ 6.17 Numbering of Claims, 37 CFR 1.126

The numbering of claims is not in accordance with 37 CFR 1.126. The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When claims are added, except when presented in accordance with 37 CFR § 1.121(b), they must be numbered consecu-

tively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

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

608.01(k) Statutory Requirement of Claims

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

608.01(l) Original Claims

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

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

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

608.01(m) Form of Claims [R-8]

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

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

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

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

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

The form of claim required in 37 CFR 1.75(e) is particularly adapted for the description of improvement type inventions. It is to be considered a combination claim. The preamble of this form of claim is considered to positively and clearly include all the elements or steps recited therein as a part of the claimed combination.

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

608.01(n) Dependent Claims [R-8]

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

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

MULTIPLE DEPENDENT CLAIMS

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

37 CFR 1.75 Claim(s)

* * * * *

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

* * * * *

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

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

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

¶7.45 Improper Multiple Dependent Claims

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

Examiner's Note:

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

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

ACCEPTABLE MULTIPLE DEPENDENT CLAIM WORDING

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

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

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

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

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

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

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

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

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

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

UNACCEPTABLE MULTIPLE DEPENDENT CLAIM WORDING

A. Claim does not refer back in the alternative only

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

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

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

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

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

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

B. Claim does not refer to a preceding claim

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

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

C. Reference to two sets of claims to different features

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

D. (Reference back to another multiple dependent claim)

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

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

Restriction Practice

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

*Handling of Multiple Dependent Claims by the Application *>Branch<*

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

calculation form PTO-875.

Handling of Multiple Dependent Claims by the Examining Group Clerical Staff

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

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

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

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

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

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

Handling of >Multiple< Dependent Claims by the Examiner

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

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

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

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

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

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

Example A

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

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

Example B

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

(All claims should be examined.)

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

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

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

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

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

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

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

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

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

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

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

Calculating Fees for Multiple Dependent Claims

Proper Multiple Dependent Claim

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

Improper Multiple Dependent Claim

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

Fee calculation example

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

Comments on Fee Calculation Example

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

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

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

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

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

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

Claim 7 — This claim is a multiple dependent claim since it refers to claims 4, 5 or 6. However, as can be seen by looking at the "2" in the "Dep." column opposite claim 4, claim 7 depends from a multiple dependent claim. This practice is improper under 35 U.S.C. 112 and >37 CFR<* 1.75(c). Following the

procedure for calculating fees for improper multiple dependent claims, a numeral "1" is placed in the "Dep." column with a circle drawn around it to alert the examiner that the claim is improper.

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

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

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

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

Calculation of Filing Fee >involving Dependent Claims<

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

>TREATMENT OF IMPROPER DEPENDENT CLAIMS<

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

>INFRINGEMENT TEST<

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

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

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

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

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

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

CLAIM FORM AND ARRANGEMENT

A singular dependent claim 2 could read as follows:

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

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

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

¶ 6.18 Series of Singular Dependent Claims

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

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

The numbering of dependent claims and the numbers of preceding claims referred to in dependent claims should be carefully checked when claims are renumbered upon allowance.

REJECTION AND OBJECTION

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

Form Paragraph 7.43 can be used to state the objection.

¶ 7.43 Objection to Claims, Allowable Subject Matter

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

608.01(o) Basis for Claim Terminology in Description [R-8]

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

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

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

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

¶ 7.44 Claimed Subject Matter not in Specification

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

608.01(p) Completeness [R-8]

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

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

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

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

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

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

A. GUIDELINES FOR CONSIDERING DISCLOSURES OF UTILITY IN DRUG CASES

General

These guidelines are set down to provide uniform handling of applications disclosing drug or pharmaceutical utility. They are intended to guide patent examiners and patent applicants as to criteria for utility statements. They deal with fundamental questions and are subject to revision and amendment if future case law indicates this to be necessary.

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

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

(2) The Patent and Trademark Office shall confine its examination of disclosure of utility to the application of patent law principles, recognizing that other agencies of the Government have been assigned the responsibility of assuring conformance to the standards established by statute for the advertisement,

use, sale or distribution of drugs. *In re Krimmel*, 48 CCPA 1116, 292 F.2d 948, 130 USPQ 215 (1961); *In re Hartop et al.*, 50 CCPA 780, 311 F.2d 249, 135 USPQ 419 (1962).

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

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

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

Any proof of a stated utility or safety required pursuant to these guidelines may be incorporated in the application as filed, or may be subsequently submitted by affidavit if and when required. The Patent and Trademark Office, in reaching its own independent decisions on questions of utility and how to use under 35 U.S.C. 101 and 112, **>may< avail itself of assistance and information from the Secretary of Health and Human Services as authorized by 21 U.S.C. 372(b), when necessary.

In accordance with the basic principles set forth above, the following procedures shall be followed in examining patent applications in the drug field with regard to disclosures relating to utility.

35 U.S.C. 101

Utility must be definite and in currently available form; (*Brenner v. Manson*, 383 U.S. 519, 148 USPQ 689) not merely for further investigation or research but commercial availability is not necessary. Mere assertions such as "therapeutic agents," (*In re Lorenz et al.*, 49 CCPA 1227, 305 F.2d 875, 134 USPQ 312; cf. *Ex parte Brockmann et al.*, 127 USPQ 57) "for pharmaceutical purposes," (*In re Diedrich*, 50 CCPA 1355, 318 F.2d 946, 138 USPQ 128) "biological activity," (*In re Kirk et al.*, 54 CCPA 1119, 153 USPQ 48; *Ex parte Lanham*, 135 USPQ 106) "intermediate," (*In re Joly et al.*, 54 CCPA 1159, 153 USPQ 45; *In re Kirk et al.*, 54 CCPA 1119; 153 USPQ 48) and for making further unspecified preparations are regarded as insufficient.

If the asserted utility of a compound is believable on its face to persons skilled in the art in view of the contemporary knowledge in the art, then the burden is upon the examiner to give adequate support for rejections for lack of utility under this section (*In re Gazave*, 54 CCPA 1524, 154 USPQ 92). On the other hand, incredible statements (*In re Citron*, 51 CCPA 852, 325 F.2d 248, 139 USPQ 516; *In re Oberweger*, 28 CCPA 749, 115 F.2d 826, 47 USPQ 455; *Ex parte Moore et al.*, 128 USPQ 8) or statements deemed unlikely to be correct by one skilled in the art (*In re Ruskin*, 53 CCPA 872, 354 F.2d 395, 148 USPQ 221; *In re Pottier*, 54 CCPA 1293, 153 USPQ 407; *In re Novak et al.*, 49 CCPA 1283, 306 F.2d 924, 134 USPQ 335. See also, *In re Irons*, 52 CCPA 938, 340 F.2d 974, 144 USPQ 351>; *Ex Parte Busse*, 1 USPQ 2d 1908<) in view of the contemporary knowledge in the art will require adequate proof on the part of applicants for patents.

Proof of utility under this section may be established by clinical or *in vivo* or *in vitro* data, or combinations of these, which would be convincing to those skilled in the art (*In re Irons*, 52 CCPA 938, 340 F.2d 924, 144 USPQ 351; *Ex parte Paschall*, 88 USPQ 131; *Ex parte Pennell et al.*, 99 USPQ 56; *Ex parte Ferguson*, 117 USPQ 229; *Ex parte Timmis*, 123 USPQ 581 >; Ex Parte Krepelka, 231 USPQ 746 (PO Bd. Pa. App & Inter. 1986), Ex Parte Chwang, 231 USPQ 751 (PO Bd.Pat.App. & Inter. 1986)<). More particularly, if the utility relied on is directed *solely* to the treatment of humans, evidence of utility, if required, must generally be clinical evidence, (*Ex parte Timmis*, 123 USPQ 581) although animal tests may be adequate where the art would accept these as appropriately correlated with human utility (*In re Hartop et al.*, 50 CCPA 780, 311 F.2d 249, 135 USPQ 419; *Ex parte Murphy*, 134 USPQ 134) >or where animal tests are coupled with other evidence, including clinical evidence and a structural similarity to compounds marketed commercially for the same indicated uses, (*In re Jolles*, 628 F2d 1322, 206 USPQ 885 (CCPA 1980))<. If there is no assertion of human utility, (*Blicke v. Treves*, 44 CCPA 753, 241 F..2d 718, 112 USPQ 472; *In re Krimmel*, 48 CCPA 1116, 292 F..2d 948, 130 USPQ 215; *In re Dodson*, 48 CCPA 1125, 292 F..2d 943, 130 USPQ 224; *In re Hitchings*, 52 CCPA 1141, 342 F..2d 80, 144 USPQ 637) or if there is an assertion of animal utility, (*In re Bergel et al.*, 48 CCPA 1102, 292 F.2d 955, 130 USPQ 206; *Ex parte Melvin*, 155 USPQ 47) operativeness for use on standard test animals is adequate for patent purposes.

>The Court in *Nelson v. Bowley*, 626 F.2d 853, 206 USPQ 881 (1980) stated that knowledge of pharmacological activity of any compound is obviously beneficial to the public and concluded that adequate proof of any such utility constitutes a showing of practical utility. Where the disclosed in vitro utility is supplemented by the similar in vitro and in vivo pharmacological activity of structurally similar compounds, the in vitro utility is sufficient to comply with the practical utility requirement of 35 U.S.C. 101. *Cross v. Iizuka*, 224 USPQ 739 (Fed. Cir. 1985).<

Exceptions exist with respect to the general rule relating to the treatment of humans. For example, compositions whose properties are generally predictable from a knowledge of their components, such as laxatives, antacids and certain topical preparations, require little or no clinical proof (*Ex parte Harrison et al.*, 129 USPQ 172; *Ex parte Lewin*, 140 USPQ 70).

Although absolute safety is not necessary to meet the utility requirement under this section, a drug which is not sufficiently safe under the conditions of use for which it is said be be effective will not satisfy the utility requirement (*In re Hartop et al.*, 50 CCPA 780, 311 F.2d 249, 135 USPQ 419; *In re Anthony*, 162 USPQ 594 (CCPA 1969); *In re Watson*, 186 USPQ 11

(CCPA 1975)). Proof of safety shall be required only in those cases where adequate reasons can be advanced by the examiner for believing that the drug is unsafe, and shall be accepted if it establishes a reasonable probability of safety.

35 U.S.C. 112

A mere statement of utility for pharmacological or chemotherapeutic purposes may raise a question of compliance with >35 U.S.C.<* 112, particularly "... as to enable any person skilled in the art to which it pertains ... to use the same." If the statement of utility contains within it a connotation of how to use, and/or the art recognizes that standard modes of administration are contemplated, >35 U.S.C.<* 112 is satisfied (*In re Johnson*, 48 CCPA 733, 282 F.2d 370, 127 USPQ 216; *In re Hitchings et al.*, 52 CCPA 1141, 342 F.2d 80, 144 USPQ 637). If the use disclosed is of such nature that the art is unaware of successful treatments with chemically analogous compounds, a more complete statement of how to use must be supplied than if such analogy were not present (*In re Mourea et al.*, 52 CCPA 1363, 345 F.2d 595, 145 USPQ 452; *In re Schmidt et al.*, 54 CCPA 1577, 153 USPQ 640). It is not necessary to specify the dosage or method of use if it is obvious to one skilled in the art that such information could be obtained without undue experimentation.

With respect to the adequacy of disclosure that a claimed genus possesses an asserted utility representative examples together with a statement applicable to the genus as a whole will ordinarily be sufficient if it would be deemed likely by one skilled in the art, in view of contemporary knowledge in the art, that the claimed genus would possess the asserted utility (*In re Oppenauer*, 31 CCPA 1248, 143 F.2d 974, 62 USPQ 297; *In re Cavallito et al.*, 48 CCPA 711, 282 F.2d 357, 127 USPQ 202; *In re Cavallito et al.*, 48 CCPA 720, 282 F.2d 363, 127 USPQ 206; *In re Schmidt*, 48 CCPA 1140, 293 F.2d 274, 130 USPQ 404; *In re Cavallito*, 49 CCPA 1335, 306 F.2d 505, 134 USPQ 370; *In re Surrey*, 54 CCPA 855, 370 F.2d 349, 151 USPQ 724; *In re Lund et al.*, 54 CCPA 1361, 153 USPQ 625)>; *In re Jolles*, 628 F.2d 1322, 206 USPQ 235 (CCPA 1980)<. Proof of utility will be required for other members of the claimed genus only in those cases where adequate reasons can be advanced by the examiner for believing that the genus as a whole does not possess the asserted utility. Conversely, a sufficient number of representative examples, if disclosed in the prior art will constitute a disclosure of the genus to which they belong.

In the case of mixtures including a drug as an ingredient, or mixtures which are drugs, or methods of treating a specific condition with a drug, whether old or new, a specific example should ordinarily be set forth, which should include the organism treated. In appropriate cases, such an example may be inferred from the disclosure taken as a whole and/or the knowledge in the art (e.g., gargle).

Where the claimed compounds are capable of several different utilities and one use is adequately described in accordance with these guidelines, additional utilities will be investigated for compliance with sections 101 and 112 only if not believable on their face to those of ordinary skill in the art in view of the contemporary knowledge of the art. Failure to meet these standards may result in a requirement to cancel such additional utilities (*Ex parte Lanhan*, 121 USPQ 223; *Ex parte Moore et al.*, 128 USPQ 8; *In re Citron*, 51 CCPA 852, 325 F.2d 248, 139 USPQ 516; *In re Gottlieb et al.*, 51 CCPA 1114, 328 F.2d 1016, 140 USPQ 665>; *In re Hozumi*, 226 USPQ 353 (Dir. Group 120, 1985)<).

B. INCORPORATION BY REFERENCE

An application as filed must be complete in itself in order to comply with 35 U.S.C. 112; however this does not bar incorporation by reference. *Ex parte Schwarze*, 151 USPQ 426 (Bd. of Appeals, 1966). An application for a patent when filed may incorporate "essential material" by reference to (1) a United States patent or (2) an allowed U.S. application, subject to the conditions set forth below. "Essential material" is defined as that which is necessary to (1) support the claims, or (2) for adequate disclosure of the invention (35 U.S.C. 112). "Essential material" may not be incorporated by reference to (1) patents or applications published by foreign countries or regional patent offices, to (2) non-patent publications, to (3) a U.S. patent or application which itself incorporates "essential material" by reference or to (4) a foreign application. See *In re Fouche*, 169 USPQ 429; 439 F.2d 1237 (CCPA 1971).

Nonessential subject matter may be incorporated by reference to (1) patents or application published by the United States or foreign countries or regional patent offices, (2) prior filed, commonly owned U.S. applications or (3) non-patent publications, for purposes of indicating the background of the invention or illustrating the state of the art.

The referencing application must include (1) an abstract, (2) a brief summary of the invention, (3) an identification of the referenced patent or application, (4) at least one view in the drawing in those applications admitting of a drawing, and (5) one or more claims. Particular attention should be directed to specific portions of the referenced patent or application.

Complete Disclosure Filed

If an application is filed with a complete disclosure, essential material may be cancelled by amendment and the *same* material substituted by reference to a patent or a pending and commonly owned allowed application in which the issue fee has been paid. The amendment must be accompanied by an affidavit or declaration executed by the applicant or his >or her< attorney or agent stating that the material cancelled from the application is the *same* material that has been incorporated by reference.

Issue Fee Paid

If an application incorporates essential material by reference to a U.S. patent or a pending and commonly owned allowed U.S. application for which the issue fee has been paid, applicant will be required prior to examination to furnish the Patent and Trademark Office with a copy of the referenced material together with an affidavit or declaration executed by the applicant or his>or her< attorney or agent stating that the copy consists of the *same* material incorporated by reference in the referencing

application. However, if a copy of a printed U.S. patent is furnished, no affidavit or declaration is required.

Issue Fee Not Paid

If an application incorporates essential material by reference to a pending and commonly owned application other than one in issue with the fee paid, applicant will be required prior to examination to amend the disclosure of the referencing application to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant or his >or her< attorney or agent stating the the amendatory material consists of the *same* material incorporated by reference in the referencing application.

Improper Incorporation

The filing date of any application wherein essential material is improperly incorporated by reference to a foreign application or patent or to a publication will not be affected because of the presence of such reference. In such a case, the applicant will be required to amend the disclosure to include the material incorporated by reference.**

¶ 6.19 Incorporation by Reference, Foreign Patent or Application

The incorporation of essential material by reference to a foreign application or foreign patent or to a publication inserted in the specification is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or applicant's attorney or agent, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. In re Hawkins, 486 F. 2d 569, 179 USPQ 157; In re Hawkins, 486 F. 2d 579, 179 USPQ 163; In re Hawkins, 486 F. 2d 577, 179 USPQ 167.

¶ 6.19.1 Improper Incorporation by Reference

The attempt to incorporate subject matter into this application by reference to [1] is improper because [2]

Examiner Note:

1. In bracket 1, identify the document such as a serial or patent number or other identification.

2. In bracket 2, give the reason why it is improper.<

The amendment must be accompanied by an affidavit or declaration executed by the applicant, or his >or her< attorney or agent, stating that the amendatory material consists of the *same* material incorporated by reference in the referencing application. *In re Hawkins*, 486 F. 2d 569, 179 USPQ 157; *In re Hawkins*, 486 F. 2d 579, 179 USPQ 163; *In re Hawkins*, 486 F. 2d 577, 179 USPQ 167, (CCPA, 1973).

Reliance upon a commonly assigned copending application by a different inventor may ordinarily be made for the purpose of completing the disclosure. See *In re Fried et al.*, 141 USPQ 27, 51-CCPA 1118 (1964), and *General Electric Company v. Brenner*, 407 F. 2d 1258, 159 USPQ 335 (CADC 1968).

Since a disclosure must be complete as of the filing date, subsequent publications or subsequently filed applications cannot be relied upon to establish a constructive reduction to practice.

C. DEPOSIT OF MICROORGANISMS >OR OTHER BIOLOGICAL MATERIAL<

Some inventions which are the subject of patent applications depend on the use of microorganisms >or other biological material< which must be described in the specification in accordance with 35 U.S.C. 112. No problem exists when the microorganisms >or other biological material< used are known and readily available to the public. When the invention depends on the use of a microorganism >or other biological material< which is not so known and readily available, applicants must take additional steps to comply with the requirements of >35 U.S.C.<* 112.

In re Argoudelis, et al., 168 USPQ 99 (CCPA, 1970), accepted a procedure for meeting the requirements of 35 U.S.C. 112. Accordingly, the Patent and Trademark Office will accept the following as complying with the requirements of >35 U.S.C.<* 112 for an adequate disclosure of the microorganism >or other biological material< required to carry out the invention:

(1) the applicant no later than the effective filing date of the application has made a deposit of a culture of the microorganism >or other biological material< in a depository affording permanence of the deposit and ready accessibility thereto by the public if a patent is granted, under conditions which assure (a) that access to the culture will be available during pendency of the patent application to one determined by the Commissioner to be entitled thereto under 37 CFR 1.14 and 35 U.S.C. 122, and (b) that all restrictions on the availability to the public of the culture so deposited will be irrevocably removed upon the granting of the patent;

(2) such deposit is referred to in the body of the specification as filed and is identified by deposit number, name and address of the depository, and the taxonomic description to the extent available is included in the specification; and

(3) the applicant or his assigns has provided assurance of permanent availability of the culture to the public through a depository meeting the requirements of (1). Such assurance may be in the form of an averment under oath or by declaration by the applicant to this effect.

>The Patent and Trademark Office will also accept the deposit of a suitable microorganism or other biological material made after the effective U.S. filing date of the application so long as the microorganism or other biological material is identified in the application as filed and a suitable deposit is made before the patent is granted, *In re Lundak*, 227 USPQ 90 (Fed. Cir. 1985). Unless applicants provide appropriate written assurances that a suitable deposit will be made in circumstances where it is considered to be necessary by the examiner, the examiner will make and maintain an appropriate rejection until a deposit is made, appropriate written assurances are provided, or it is determined that no deposit is required. Where appropriate written assurances are given, but no deposit has been made,

the examiner will make a requirement that a suitable deposit be made at the time of mailing the Notice of Allowance and Issue Fee Due, setting a time period for making the deposit. As noted in *Lundack*, an appropriate amendment to a pending application to identify the depository affording permanence to the deposit and the accession number for the deposit would not constitute new matter.

The requirement that applicants or their assigns provide assurances of permanent availability of the deposit is satisfied if the depository is contractually obligated to store the deposit for a reasonable time after expiration of the enforceable life of the patent. The Office will not insist on any particular period after expiration of the enforceable life of the patent. The enforceable life of the patent for this purpose is considered to be the original term of seventeen years plus six (6) years to cover the statute of limitations. Any deposit which is made under the Budapest Treaty will be for a term acceptable to the Office, unless the thirty years from the date of deposit will expire before the end of the enforceable life of the patent. With this one exception, any deposit made under the Budapest Treaty will meet all of the requirements for a suitable deposit except that assurances must also be provided that all restrictions on the availability to the public of the deposited microorganism or other biological material will be irrevocably removed upon the granting of the patent.<

A copy of the applicant's contract with the depository may be required by the examiner to be made of record as evidence of making the culture available under the conditions stated above.

D. SIMULATED OR PREDICTED TEST RESULTS OR PROPHETIC EXAMPLES

Simulated or predicted test results and prophetical examples (paper examples) are permitted in patent applications. Working examples correspond to work actually performed and may describe tests which have actually been conducted and results that were achieved. Paper examples describe the manner and process of making an embodiment of the invention which has not actually been conducted. Paper examples should not be represented as work actually done. No results should be represented as actual results unless they have actually been achieved. Paper examples should not be described using the past tense.

NOTE. — For problems arising from the designation of materials by trademarks and trade names, see >MPEP< § 608.01(v).

608.01(q) Substitute or Rewritten Specification [R-8]

37 CFR 1.125 Substitute specification.

If the number or nature of the amendments shall render it difficult to consider the case, or to arrange the papers for printing or copying, the examiner may require the entire specification, including the claims, or any part thereof, to be rewritten. A substitute specification may not be accepted unless it has been required by the examiner or unless it is clear to the examiner that acceptance of a substitute specification would facilitate processing of the application. Any substitute specification filed must be accompanied by a statement that the substitute specification includes no new matter. Such statement must be a verified statement if made by a person not registered to practice before the Office.

The specification is sometimes in such faulty English that a new specification is necessary; in such instances a new specification should be required.

Form Paragraph 6.28 may be used >where the specification is in faulty English<**.

¶ 6.28 Idiomatic English

A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52 (a and b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter. Such statement must be a verified statement if made by a person not registered to practice before the Office.

>Form Paragraph 6.28.1 may be used to require a substitute specification for reasons other than faulty English.

¶ 6.28.1 Substitute Specification

A substitute specification is required because [1]. The substitute specification filed must be accompanied by a statement that it contains no new matter. Such statement must be a verified statement if made by a person not registered to practice before the Office.

Examiner Note:

1. In bracket 1, insert clear and concise examples of why a new specification is required.
2. A new specification is required if the number or nature of the amendments render it difficult to consider the case or to arrange the papers for printing or copying, 37 CFR 1.125.
3. See also form paragraph 13.01 for partial rewritten specification.<

Under current practice, substitute specifications may be voluntarily filed by the applicant if **> desired<. A substitute specification will normally be accepted by the Office even if it has not been required by the examiner. Substitute specifications will be accepted if applicant submits therewith a ** marked-up copy *>which shows< the portions of the original specification which are being added and deleted and a statement that the substitute specification includes no new matter and that the substitute specification includes the same changes as are indicated in the **>marked-up copy of the< original specification >showing additions and deletions<. Such statement must be a verified statement if made by a person not registered to practice before the Office. Additions should be indicated by underlining and deletions should be indicated between brackets. Examiners may also require a substitute specification where it is considered to be necessary.

However, any substitute page of the specification, or entire specification, filed must be accompanied by **>a statement< indicating that no new matter was included. >The statement must be verified if made by a person not registered to practice before the Office.< There is no obligation on the examiner to make a detailed comparison between the old and the new speci-

fications for determining whether or not new matter has been added. If, however, an examiner becomes aware that new matter is present, objection thereto should be made.

The filing of a substitute specification rather than amending the original application has the advantage for applicants of eliminating the need to prepare an amendment of the specification. If word processing equipment is used by applicants, substitute specifications can be easily prepared. The Office receives the advantage of saving the time needed to enter amendments in the specification and a reduction in the number of printing errors.

A substitute specification should normally be entered. See >MPEP< § 714.20.

New matter in amendment, see >MPEP< § 608.04.

Application prepared for issue, see >MPEP< § 1302.02.

608.01(r) Derogatory Remarks About Prior Art in Specification

The applicant may refer to the general state of the art and the advance thereover made by his or her invention, but he or she is not permitted to make derogatory remarks concerning the inventions of others. Derogatory remarks are statements disparaging the products or processes of any particular person other than the applicant, or statements as to the merits or validity of applications or patents of another person. Mere comparison with the prior art are not considered to be disparaging per se.

608.01(s) Restoration of Canceled Matter [R-8]

Canceled text in the specification or a canceled claim can be restored only by presenting the canceled matter as a new insertion. See 37 CFR 1.124, >MPEP< § 714.24.

608.01(t) Use in Subsequent Application [R-8]

A reservation for a future application of subject matter disclosed but not claimed in a pending application will not be permitted in the pending application, 37 CFR 1.79, >MPEP< § 608.01(e).

While a specification cannot be transferred to another application, drawings may be transferred from a prior application to a later case by the same inventor if they are no longer needed in the prior application, note >MPEP< §§ 608.02(i) to 608.02(k).

608.01(u) Use of Formerly Filed Incomplete Application [R-8]

Parts of an incomplete application which have been retained by the Office may be used as part of a complete application if the missing parts are later supplied. See >MPEP< §§ 506 and 506.01.

608.01(v) Trademarks and Names >Used in Trade< [R-8]

The expressions "trademarks" and "names used in trade" as used below have the following meanings:

Trademark: a word, letter, symbol or device adopted by one manufacturer or merchant and used to identify and distinguish his >or her< product from those of others. It is a proprietary word pointing distinctly to the product of one producer.

Names Used in Trade: a nonproprietary name by which an article or product is known and called among traders or workers in the art, although it may not be so known by the public generally. Names used in trade do not point to the product of one producer, but they identify a single article or product irrespective of producer.

Names used in trade are permissible in patent applications if:

(1) Their meanings are established by an accompanying definition which is sufficiently precise and definite to be made a part of a claim, or

(2) In this country, their meanings are well known and satisfactorily defined in the literature.

Condition (1) or (2) must be met at the time of filing of the complete application.

TRADEMARKS

The relationship between a trademark and the product it identifies is sometimes indefinite, uncertain and arbitrary. The formula or characteristics of the product may change from time to time and yet it may continue to be sold under the same trademark. In patent specifications, every element or ingredient of the product should be set forth in positive, exact, intelligible language, so that there will be no uncertainty as to what is meant. Arbitrary trademarks which are liable to mean different things at the pleasure of manufacturers do not constitute such language. >*Ex Parte Kattwinkle*, 12 USPQ 11 (Bd. Apps. 1931).<

However, if the product to which the trademark refers is otherwise set forth in such language that its identity is clear the examiners are authorized to permit the use of the trademark if it is distinguished from common descriptive nouns by capitalization. If the trademark has a fixed and definite meaning it constitutes sufficient identification unless some physical or chemical characteristic of the article or material is involved in the invention. In that event as also in those cases where the trademark has no fixed and definite meaning, identification by scientific or other explanatory language is necessary.>*In re Gebauer-Fuelnegg*, 50 USPQ 125 (CCPA 1941).<

The matter of sufficiency of disclosure must be decided on an individual case by case basis. *In re Metcalfe and Lowe*, 161 USPQ 789; 869 O.G. 691 (CCPA 1969).

Where the identification of a trademark is introduced by amendment it must be restricted to the characteristics of the product known at the time the application was filed to avoid any question of new matter.

If proper identification of the product sold under a trademark, or a product referred to only by a name used in trade, is omitted from the specification and such identification is deemed

necessary under the principles set forth above, the examiner should hold the disclosure insufficient and reject on the ground of insufficient disclosure any claims based on the identification of the product merely by trademark or by the name used in trade. If the product cannot be otherwise defined, an amendment defining the process of its manufacture may be permitted. Such amendments must be supported by satisfactory showings establishing that the specific nature or process of manufacture of the product as set forth in the amendment was known at the time of filing of the application.

Although the use of trademarks having definite meanings is permissible in patent applications, the proprietary nature of the marks should be respected. Trademarks should be identified by capitalizing them and placing them between quotation marks. Every effort >should be< made to prevent their use in any manner which might adversely affect their validity as trademarks.

Form paragraph 6.20 may be used.

¶ 6.20 Trademarks and Their Use.

The use of the trademark [1] has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Examiner Note:

Capitalize the word in the bracket.

The examiner should not permit the use of language such as "the product X (a descriptive name) commonly known as Y (trademark)" since such language does not bring out the fact that the latter is a trademark. Language such as "the product X (a descriptive name) sold under the trademark Y" is permissible.

The use of a trademark in the title of an application should be avoided as well as the use of a trademark coupled with the word "type"; i.e., "Band-Aid type bandage."

The owner of a trademark may be identified in the specification.

Group directors should reply to all trademark misuse complaint letters and forward a copy to the editor of this manual.

See appendix I for a partial listing of trademarks and the particular goods to which they apply.

>Inclusion of Copyright or Mask Work Notice in Patents

Under current intellectual property laws, it is possible to obtain copyright protection or mask work protection as well as patent protection for certain designs and technologies. On occasion, an author/inventor considers it desirable to include a notice of copyright or mask work in a design or utility patent which discloses material on which copyright or mask work protection has previously been established.

The inclusion of a copyright or mask work notice in a patent that discloses material on which copyright or mask work protection has previously been established would serve to publicize and thereby protect the various intellectual property rights of the author/inventor. Furthermore, this publication would tend to protect the public by militating against an unintentional encroachment into these rights. The presence of an unrestricted copyright or mask work notice in a patent could have an inhibiting effect on public dissemination of the patent disclosure to the public. This possible effect would be contrary to the mission of the Patent and Trademark Office to disseminate knowledge and information by way of patent issuance, publication, and distribution. To avoid this effect, it is considered necessary to include an appropriate authorization of the author/inventor with any copyright or mask work notice appearing in a patent.

In light of these considerations, the Patent and Trademark Office will permit the inclusion of a copyright or mask work notice in a design or utility patent application, and thereby any patent issuing therefrom, which discloses material on which copyright or mask work protection has previously been established, under the following conditions:

(1) The copyright or mask work notice must be placed adjacent to the copyright or mask work material. Therefore, the notice may appear at any appropriate portion of the patent application disclosure, including the drawing. However, if appearing in the drawing, the notice must be limited to print size from 1/8 inch to 1/4 inch and must be placed within the "sight" of the drawing immediately below the figure representing the copyright or mask work material. If placed on a drawing in conformance with these provisions, the notice will not be objected to as extraneous matter under 37 CFR 1.84.

(2) The content of the notice must be limited to only those elements required by law. For example,"©1983 John Doe"(17 U.S.C. 401) and "*M* John Doe"(35 U.S.C.909) would be properly limited, and under current statutes, legally sufficient notices of copyright and mask work respectively.

(3) Inclusion of a copyright or mask work notice will be permitted only if the following authorization is included at the beginning (preferably as the first paragraph) of the specification to be printed for the patent:

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

(4) Inclusion of a copyright or mask work notice after a Notice of Allowance has been mailed will be permitted only if the criteria of 37 CFR 1.312 have been satisfied.

The inclusion of a copyright or mask work notice in a design or utility patent application, and thereby any patent issuing therefrom, under the conditions set forth above will serve to protect the rights of the author/inventor, as well as the public, and will serve to promote the mission and goals of the Patent and Trademark Office. Therefore, the inclusion of a copyright or mask work notice which complies with these conditions will be

permitted. However, any departure from these conditions may result in a refusal to permit the desired inclusion. If the authorization required under condition (3) above does not include the specific language "(t)he [copyright or mask work] owner has no objection to the facsimile reproduction by anyone of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent files or records,..." the notice will be objected to as improper by the examiner of the application. If the examiner maintains the objection upon reconsideration, a petition may be filed in accordance with 37 CFR 1.181.<

608.02 Drawing [R-8]

35 U.S.C. 113 Drawings.

The applicant shall furnish a drawing where necessary for the understanding of the subject matter to be patented. When the nature of such subject matter admits of illustration by a drawing and the applicant has not furnished such a drawing, the Commissioner may require its submission within a time period of not less than two months from the sending of a notice thereof. Drawings submitted after the filing date of the application may not be used (i) to overcome any insufficiency of the specification due to lack of an enabling disclosure or otherwise inadequate disclosure therein, or (ii) to supplement the original disclosure thereof for the purpose of interpretation of the scope of any claim.

37 CFR 1.81 Drawings required.

(a) The applicant for a patent is required to furnish a drawing of his invention where necessary for the understanding of the subject matter sought to be patented; this drawing must be filed with the application.

(b) Drawings may include illustrations which facilitate an understanding of the invention (for example, flow sheets in cases of processes, and diagrammatic views).

(c) Whenever the nature of the subject matter sought to be patented admits of illustration by a drawing without its being necessary for the understanding of the subject matter and the applicant has not furnished such a drawing, the examiner will require its submission within a time period of not less than two months from the date of the sending of a notice thereof.

(d) Drawings submitted after the filing date of the application may not be used to overcome any insufficiency of the specification due to lack of an enabling disclosure or otherwise inadequate disclosure therein, or to supplement the original disclosure thereof for the purpose of interpretation of the scope of any claim.

37 CFR 1.84 Standards for drawings.

(a) *Paper and ink.* Drawings must be made upon paper which is flexible, strong, white, smooth, nonshiny and durable. Two-ply or three-ply bristol board is preferred. The surface of the paper should be calendered and of a quality which will permit erasure and correction with India ink. India ink, or its equivalent in quality, is preferred for pen drawings to secure perfectly black solid lines. The use of white pigment to cover lines is not normally acceptable.

(b) *Size of sheet and margins.* The size of the sheets on which drawings are made may either be exactly 8 1/2 by 14 inches (21.6 by 35.6 cm.) or exactly 21.0 by 29.7 cm. (DIN size A4). All drawing sheets in a particular application must be the same size. One of the shorter sides of the sheet is regarded as its top.

(1) On 8 1/2 by 14 inch drawing sheets, the drawing must include a top margin of 2 inches (5.1 cm.) and bottom and side margins of 1/4 inch (6.4 mm.) from the edges, thereby leaving a "sight" precisely 8 by 11 3/4 inches (20.3 by 29.8 cm.). Margin border lines are not permitted. All work must be included within the "sight". The sheets may be provided with two 1/4 inch (6.4 mm.) diameter holes having their centerlines spaced 11/16 inch (17.5 mm.) below the top edge and 2 3/4 inches (7.0 cm.) apart, said holes being equally spaced from the respective side edges.

(2) On 21.0 by 29.7 cm. drawing sheets, the drawing must include a top margin of at least 2.5 cm., a left side margin of 2.5 cm., a right side margin of 1.5 cm., and a bottom margin of 1.0 cm. Margin border lines are not permitted. All work must be contained within a sight size not to exceed 17 by 26.2 cm.

(c) *Character of lines.* All drawings must be made with drafting instruments or by a process which will give them satisfactory reproduction characteristics. Every line and letter must be durable, black, sufficiently dense and dark, uniformly thick and well defined; the weight of all lines and letters must be heavy enough to permit adequate reproduction. This direction applies to all lines however fine, to shading, and to lines representing cut surfaces in sectional views. All lines must be clean, sharp, and solid. Fine or crowded lines should be avoided. Solid black should not be used for sectional or surface shading. Freehand work should be avoided wherever it is possible to do so.

(d) *Hatching and shading.* (1) Hatching should be made by oblique parallel lines spaced sufficiently apart to enable the lines to be distinguished without difficulty.

(2) Heavy lines on the shade side of objects should preferably be used except where they tend to thicken the work and obscure reference characters. The light should come from the upper left-hand corner at an angle of 45°. Surface delineations should preferably be shown by proper-shading, which should be open.

(e) *Scale.* The scale to which a drawing is made ought to be large enough to show the mechanism without crowding when the drawing is reduced in size to two-thirds in reproduction, and views of portions of the mechanism on a larger scale should be used when necessary to show details clearly; two or more sheets should be used if one does not give sufficient room to accomplish this end, but the number of sheets should not be more than is necessary.

(f) *Reference characters.* The different views should be consecutively numbered figures. Reference numerals (and letters, but numerals are preferred) must be plain, legible and carefully formed, and not be encircled. They should, if possible, measure at least one-eighth of an inch (3.2 mm.) in height so that they may bear reduction to one twenty-fourth of an inch (1.1 mm.); and they may be slightly larger when there is sufficient room. They should not be so placed in the close and complex parts of the drawing as to interfere with a thorough comprehension of the same, and therefore should rarely cross or mingle with the lines. When necessarily grouped around a certain part, they should be placed at a little distance, at the closest point where there is available space, and connected by lines with the parts to which they refer. They should not be placed upon hatched or shaded surfaces but when necessary, a blank space may be left in the hatching or shading where the character occurs so that it shall appear perfectly distinct and separate from the work. The same part of an invention appearing in more than one view of the drawing must always be designated by the same character, and the same character must never be used to designate different parts. Reference signs not mentioned in the description shall not appear in the drawing and vice versa.

(g) *Symbols, legends.* Graphical drawing symbols and other labeled representations may be used for conventional elements when appropriate, subject to approval by the Office. The elements for which such symbols and labeled representations are used must be adequately identified in the specification. While descriptive matter on drawings is not permitted, suitable legends may be used, or may be required, in

proper cases, as in diagrammatic views and flowsheets or to show materials or where labeled representations are employed to illustrate conventional elements. Arrows may be required, in proper cases, to show direction of movement. The lettering should be as large as, or larger than, the reference characters.

(h) [Revoked]

(i) *Views.* The drawing must contain as many figures as may be necessary to show the invention; the figures should be consecutively numbered if possible in the order in which they appear. The figures may be plain, elevation, section, or prespective views, and detail views of portions of elements, on a larger scale if necessary, may also be used. Exploded views, with the separated parts of the same figure embraced by a bracket, to show the relationship or order of assembly of various parts are permissible. When necessary, a view of a large machine or device in its entirety may be broken and extended over several sheets if there is no loss in facility of understanding the view. Where figures on two or more sheets form in effect a single complete figure, the figures on the several sheets should be so arranged that the complete figure can be understood by laying the drawing sheets adjacent to one another. The arrangement should be such that no part of any of the figures appearing on the various sheets are concealed and that the complete figure can be understood even though spaces will occur in the complete figure because of the margins on the drawing sheets. The plane upon which a sectional view is taken should be indicated on the general view by a broken line, the ends of which should be designated by numerals corresponding to the figure number of the sectional view and have arrows applied to indicate the direction in which the view is taken. A moved position may be shown by a broken line superimposed upon a suitable figure if this can be done without crowding, otherwise a separate figure must be used for this purpose. Modified forms of construction can only be shown in separate figures. Views should not be connected by projection lines nor should centerlines be used.

(j) *Arrangement of views.* All views on the same sheet should stand in the same direction and, if possible, stand so that they can be read with the sheet held in an upright position. If views longer than the width of the sheet are necessary for the clearest illustration of the invention, the sheet may be turned on its side so that the top of the sheet with the appropriate top margin is on the right-hand side. One figure must not be placed upon another or within the outline of another.

(k) *Figure for Official Gazette.* The drawing should, as far as possible, be so planned that one of the views will be suitable for publication in the *Official Gazette* as the illustration of the invention.

(l) *Extraneous matter.* Identifying indicia (such as the attorney's docket number, inventor's name, number of sheets, etc.) not to exceed 2 3/4 inches (7.0 cm.) in width may be placed in a centered location between the side edges within three-fourths inch (19.1 mm.) of the top edge. Authorized security markings may be placed on the drawings provided they be outside the illustrations and are removed when the material is declassified. Other extraneous matter will not be permitted upon the face of a drawing.

(m) *Transmission of drawings.* Drawings transmitted to the Office should be sent flat, protected by a sheet of heavy binder's board, or may be rolled for transmission in a suitable mailing tube; but must never be folded. If received creased or mutilated, new drawings will be required. (See § 1.152 for design drawings, § 1.165 for plant drawings, and § 1.174 for reissue drawings.)

Drawings on paper are acceptable although bristol board is preferred. If drawings on paper are submitted, any corrections thereto involving deletion of material must be made in the form of replacement sheets since paper does not normally permit erasures to be made.

Good quality copies made on office copiers are acceptable if the lines are uniformly thick, black, and solid.

Drawings are currently accepted in two different formats. It is however required that all drawings in a particular application be the same size for ease of handling and reproduction.

Design patent drawings, 37 CFR 1.152, >MPEP< § 1503.02.

Plant patent drawings, 37 CFR 1.165, >MPEP< § 1606.

Reissue application drawings, >MPEP< §§ 608.02(k) and 1413.

Correction of drawings, >MPEP< § 608.02(p). Prints, preparation and distribution, >MPEP< §§ 508 and 608.02(m). Prints, return of drawings, >MPEP< § 608.02(y).

For pencil notations of classification and name or initials of assistant examiner to be placed on drawings see >MPEP< § 717.03.

The filing of a divisional or continuation case under the provisions of 37 CFR 1.60 (unexecuted case), does not obviate the need for formal drawings. See >MPEP< § 608.02(b).

DEFINITIONS

A number of different terms are used when referring to drawings in patent applications. The following definitions are used in this Manual.

Original drawings: The drawing submitted with the application when filed. It may be either a formal or an informal drawing.

Substitute drawing: A drawing filed later than the filing date of an application. Usually submitted to replace an original informal drawing.

Formal drawing: A drawing in a form that complies with 37 CFR 1.84. Formal drawings are stamped "approved" by the Draftsman. They may be either 8 1/2 by 14 inches or 21 by 29.7 cm. in size.

Informal drawing: A drawing which does not comply with the form requirements of 37 CFR 1.84. Drawings may be informal because they are not on the proper size sheets, the quality of the lines is poor, or for other reasons such as the size of reference elements. Such objections are made by the Draftsman on form PTO-948.

Drawing print: This term is used for the white paper print prepared by the >Micrographics<** Branch of the Office Services Divisions of all original drawings. The drawing prints contain the notation "Print of Drawing as originally filed" near the top. Drawing prints should be placed on the top on the right hand flap of the application file wrapper.

Interference print: This term is used to designate the copy prepared of the original drawings on colored, heavy weight card stock material. The interference prints are filed in file cabinets separate from the file wrappers and are used to make interference searches.

The following Form Paragraphs should be used when notifying applicants of drawing corrections.

¶ 6.38 Acknowledgment of Proposed Drawing Correction

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on [1] have been [2].

Examiner Note:

1. In bracket 2, insert either approved or disapproved.

2. If approved, either form paragraph 6.39 and 6.40 or 6.41 or 6.44 must follow.

3. If disapproved, an explanation must be provided.

¶ 6.39 PTO No Longer Makes Drawing Changes

The Patent and Trademark Office no longer makes drawing changes. 1017 OG 4. It is applicant's responsibility to ensure that the drawings are corrected. Corrections must be made in accordance with the instructions below.

Examiner Note:

This paragraph is to be used whenever the applicant has filed a request for the Office to make drawing changes. Form paragraph 6.40 must follow.

¶ 6.40 Information on How To Effect Drawing Changes

Information on How To Effect Drawing Changes

1. **Correction of Informalities** (Draftsman's objections on PTO-948). If order to correct any informalities in the drawings, applicant **MUST** comply with options (a) or (b) below. Failure to do so will result in **ABANDONMENT** of the application.

(a) Upon an indication of allowable subject matter, file new drawings with the changes incorporated herein. The art unit number, serial number and number of drawing sheets should be written on the reverse side of the drawings. Applicant may delay filing of the new drawings until receipt of the "Notice of Allowability" (PTOL-37). If delayed, the new drawings **MUST** be filed within the THREE MONTH shortened statutory period set for response in the "Notice of Allowability" (PTOL-37). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a). The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsman.

(b) Upon an indication of allowable subject matter, request a commercial bonded drafting firm to make the necessary corrections. Applicant may delay requesting correction until receipt of the "Notice of Allowability" (PTOL-37).

IF DELAYED A BONDED DRAFTSMAN MUST BE AUTHORIZED, THE CORRECTIONS EXECUTED AND THE CORRECTED DRAWINGS RETURNED TO THE OFFICE DURING THE THREE MONTH SHORTENED STATUTORY PERIOD SET FOR RESPONSE IN THE "NOTICE OF ALLOWABILITY" (PTOL-37). EXTENSIONS OF TIME MAY BE OBTAINED UNDER THE PROVISIONS OF 37 CFR 1.136(a).

2. **Corrections other than Informalities Noted by the Draftsman on the PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsman, **MUST** be made in the same manner as above except that, normally, a red ink sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

3. **Timing of Corrections**

Applicant is encouraged to correct drawings upon an indication of allowable subject matter. However, applicant is required to submit acceptable corrected drawings within the three month shortened statutory period set in the "Notice of Allowability" PTOL-37). Within that three month period, two weeks should be allowed for review by the Office of the correction. If a correction is determined to be unacceptable by the Office, applicant must arrange to have an acceptable correction re-submitted within the original three month period to avoid the necessity of obtaining an extension of time and of paying the extension fee. Therefore, applicant should file corrected drawings as soon as possible.

¶ 6.41 Reminder That PTO No Longer Makes Drawing Changes

Applicant is reminded that the Patent and Trademark Office no longer makes drawing changes and that it is applicant's responsibility to ensure that the drawings are corrected in accordance with the instructions set forth in paper no. [1], mailed on [2].

Examiner Note:

This paragraph is to be used when the applicant has been previously provided with information on how to effect drawing changes (i.e., either by way of form paragraph 6.40 or a PTO-1474 has been previously sent).

¶ 6.42 Reminder That Applicant Must Make Drawing Changes

Applicant is reminded that in order to avoid an abandonment of this application, the drawings must be corrected in accordance with the instructions set forth in paper no. [1] mailed on [2].

Examiner Note:

This paragraph is to be used when allowing the application and when applicant has previously been provided with information on how to effect drawing changes (i.e., by way of form paragraph 6.40 or a PTO- 1474 has been previously sent).

¶ 6.43 Drawings Contain Informalities, Application Allowed

The drawings filed on [1] are acceptable subject to correction of the informalities indicated on the attached Notice re Drawings, PTO-948. In order to avoid abandonment of this application, correction is required.

Examiner Note:

Use this paragraph when allowing the case, particularly at time of first action issue. Form paragraph 6.40 or 6.41 must follow.

¶ 6.44 Drawing Informalities Previously Indicated

In order to avoid abandonment, the drawing informalities noted in paper no. [1], mailed on [2], must now be corrected. Correction can only be effected in the manner set forth in the above noted paper.

Examiner Note:

Use this paragraph when allowing the case and applicant has previously been informed of informalities in the the drawings.

¶ 6.47 Examiner's Amendment Involving Drawing Changes

The following changes to the drawings have been approved by the Examiner and agreed upon by applicant: [1]. In order to avoid abandonment of the application, applicant must make the above agreed upon drawing changes.

Examiner Note:

1. In bracket 1, Insert the agreed upon drawing changes.

2. Form paragraphs 6.39 and 6.40 must follow.

DRAWING SYMBOLS

37 CFR 1.84(g) indicates that graphic drawing symbols and other labeled representations may be used for conventional elements where appropriate, subject to approval by the Office. Also, suitable legends may be used, or may be required, in proper cases.**

The publications >listed below< have been reviewed by the Office and the symbols therein are considered to be generally acceptable in patent drawings. Although the Office will not "approve" all of the listed symbols as a group because their use and clarity must be decided on a case-by-case basis, these publications may be used as guides when selecting graphic symbols. Overly specific symbols should be avoided. Symbols with unclear meanings should be labeled for clarification.

These publications are available from the American National Standards Institute Inc., 1430 Broadway, New York, New York 10018.

The publications reviewed are the following:

Y32.2-1970 Graphic Symbols for Electrical & Electronics Diagrams

Y32.10-1967 Graphic Symbols for Fluid Power Diagrams

Y32.11-1961 Graphic Symbols for Process Flow Diagrams in the Petroleum & Chemical Industries

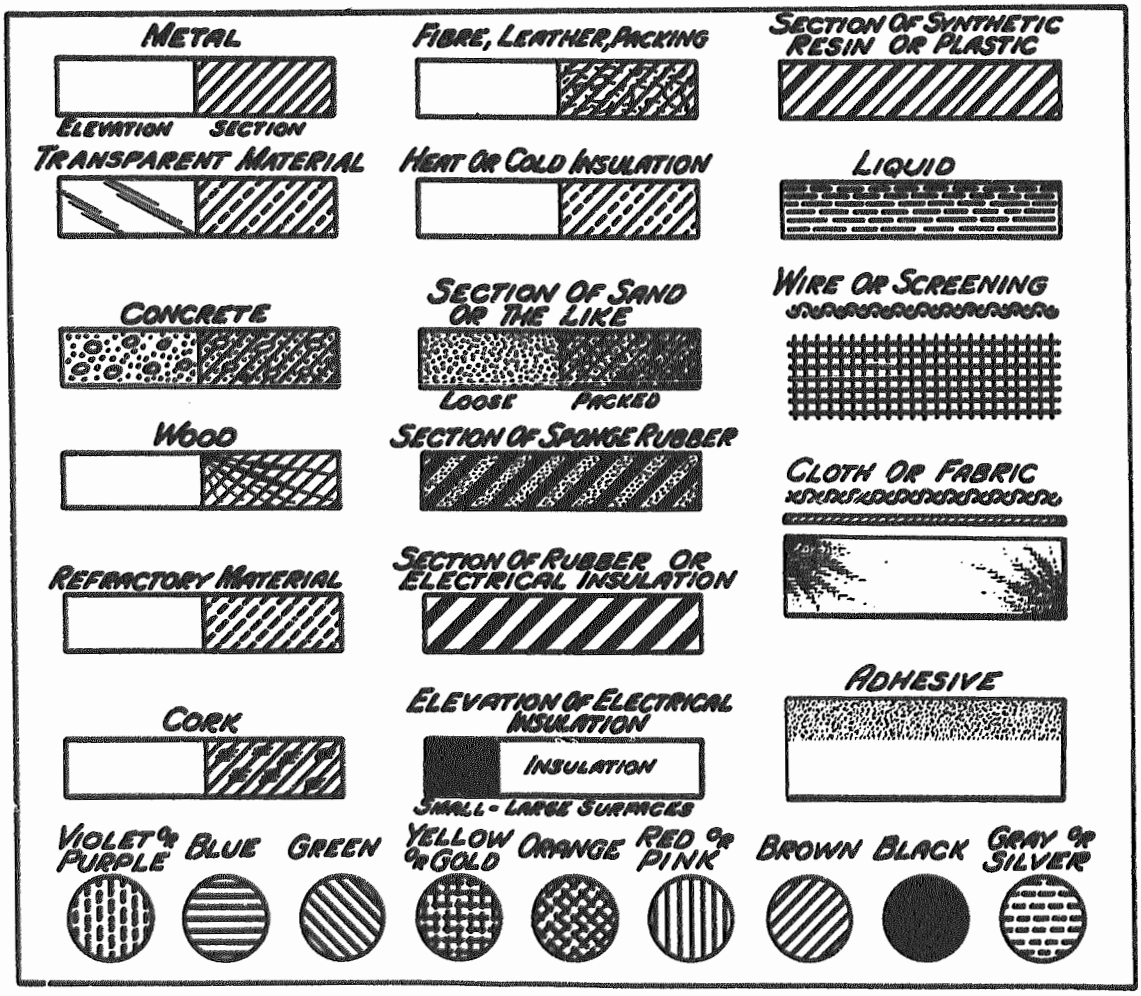
Y32.14-1962 Graphic Symbols for Logic Diagrams

Z32.2.3-1949 (R1953) Graphic Symbols for Pipe Fittings, Valves and Piping

Z32.2.4-1949 (R1953) Graphic Symbols for Heating, Ventilating & Air Conditioning

Z32.2.6-1950 Graphic Symbols for Heat-Power Apparatus

>The following symbols should be used to indicate various materials where the material is an important feature of the invention. The use of conventional symbols is very helpful in making prior art searches.<



APPLICATIONS FILED WITHOUT DRAWINGS

Applications filed without drawings are initially inspected to determine whether or not a drawing >is referred to in the specification, or if<, under the statute, >a drawing< is necessary before the >application<* can be given a filing date. Doubtful cases are referred to the supervisory primary examiner for decision as to the need for such a drawing. If, after an application without a drawing has been received in the >examining< group, it is clear that a drawing is required, the application should be returned to the Application >Branch<* along with a memorandum indicating that a drawing is required. It has long been the practice to accept a process case (that is, a case having only process or method claims) which is filed without a drawing. The same practice has been followed in composition cases. Other situations where drawings are usually not considered essential for a filing date are:

I. *Coated articles or products.* Where the invention resides solely in coating or impregnating a conventional sheet, e.g., paper or cloth, or an article of known and conventional character with a particular composition, the application containing claims to the coated or impregnated sheet or article, unless significant details of structure or arrangement are involved in the article claims.

II. *Articles made from a particular material or composition.* Where the invention consists in making an article of a particular material or composition, unless significant details of structure or arrangement are involved in the article claims.

III. *Laminated Structures.* Where the claimed invention involves only laminations of sheets (and coatings) of specified material unless significant details of structure or arrangement (other than the mere order of the layers) are involved in the article claims.

IV. *Articles, apparatus or systems where sole distinguishing feature is presence of a particular material.* Where the invention resides solely in the use of a particular material in an otherwise old article, apparatus or system recited broadly in the claims; for example,

a. Hydraulic system distinguished solely by the use therein of a particular hydraulic fluid;

b. Packaged sutures wherein the structure and arrangement of the package are conventional and the only distinguishing feature is the use of a particular fluid.

APPLICATIONS FILED WITHOUT ALL FIGURES OF DRAWINGS

Applications filed without all figures of drawing described in the specification are not given a filing date since they are "prima facie" incomplete. The filing date is the date on which the omitted figures are filed. See >MPEP §<* 601.01 If the oath or declaration for the application was filed prior to the submission of all figures of the drawing the submission of any omitted figures must be accompanied by a supplemental oath or declaration stating that the omitted figures accurately illustrate and are a part of applicant's invention. If the oath or declaration for the application was not filed prior to the submission of the omitted figures, the oath or declaration, when filed must include a specific reference to the figures originally omitted. If any applicant believes that omitted figures of an application are not necessary for an understanding of the subject matter sought to be patented, applicant may petition to have the application accepted without the omitted figures. Any such petition must be accompanied by the petition fee (37 CFR 1.17(h)) and an amendment cancelling from the specification all references to the omitted figures and any claims which depend upon the omitted figures for disclosure and support. Also, if the oath or declaration for the application was filed prior to the date of the amendment and petition, the amendment must be accompanied by a supplemental declaration by the applicant stating that the invention is adequately disclosed in, and *>a desire< to rely on, the application as thus amended for purposes of an original disclosure and filing date. If the oath or declaration for the application was not filed prior to the date of the petition and amendment, the oath or declaration, when filed, must include a specific reference to the amendment cancelling from the specification all references to the omitted figures and any claims which depend upon the omitted figures for disclosure and support. >The petition requesting that the application be accepted without the omitted drawing figures should be directed to the Office of the Assistant Commissioner for Patents and request relief under 37 CFR 1.182.<

ILLUSTRATION SUBSEQUENTLY REQUIRED

The acceptance of an application without a drawing does not preclude the examiner from requiring an illustration in the form of a drawing under >37 CFR< * 1.81(c) or >37 CFR<* 1.83(c). In requiring such a drawing, the examiner should clearly indicate that the requirement is made under >37 CFR<*1.81(c) or >37 CFR<* 1.83(c) and be careful not to state that he >or she< is doing so "because it is necessary for the understanding of the invention," as that might give rise to an erroneous impression as to the completeness of the application as filed. Examiners making such requirements are to specifically require, as a part of the applicant's next response, at least an ink sketch or permanent print of any drawing proposed in response to the requirement, even though no allowable subject matter is yet indicated. This will afford the examiner an early opportunity to determine the sufficiency of the illustration and the absence of new matter. See >37 CFR< 1.118 and >37 CFR< 1.81(d). The description should of course be amended to contain reference to the new illustration. This may obviate further correspondence where an amendment places the case in condition for allowance, except for the formal requirement relating to the drawing. In the event of a final determination that there is nothing patentable in the case, a formal drawing will not be required.

PHOTOGRAPHS

Photographs are not normally considered to be proper drawings. Photographs are acceptable for a filing date and are generally considered to be informal drawings. Photographs are only acceptable where they come within the special categories

set forth in the paragraph immediately below. Photolithographs of photographs are never acceptable. See *In re Taggart et al.*, 1957 C.D. 6, 725 O.G. 397 and *In re Myers*, 1959 C.D. 2, 738 O.G. 947.

SPECIAL CATEGORIES

The Patent and Trademark Office is willing to accept black and white photographs or photomicrographs (not photolithographs or other reproductions of photographs made by using screens) printed on sensitized paper in lieu of India ink drawings, to illustrate inventions which are incapable of being accurately or adequately depicted by India ink drawings restricted to the following categories: crystalline structures, metallurgical microstructures, textile fabrics, grain structures and ornamental effects. The photographs or photomicrographs must show the invention more clearly than they can be done by India ink drawings and otherwise comply with the rules concerning such drawings.

Such photographs to be acceptable must be made on photographic paper having the following characteristics which are generally recognized in the photographic trade: paper with a surface described as smooth; tint, white, or be photographs mounted on proper size bristolboard.

>See MPEP § 1503.02 for discussion of photographs used in design patent applications.<

COLOR DRAWINGS

Drawings >and photographs< in colors other than black do not come within the purview of 37 CFR 1.84. Unless the drawing requirements of 37 CFR 1.84 are waived, the Draftsman will not approve color drawings in a utility or design patent application. The examiner must object to the color drawings as being improper and require applicant either to cancel the drawings or to provide substitute black and white drawings.

Neither the examiner nor the Draftsman have the authority to waive or suspend drawing requirements to permit color drawings in utility and design applications. The applicant must file a petition under 37 CFR 1.183 with fee requesting acceptance of the color drawings and a waiver of the requirements of 37 CFR 1.84. The petition and the application file must be sent to the Deputy Assistant Commissioner for Patents for decision. Only if the petition is granted will the Draftsman be authorized to approve the color drawings as to form.

Where color drawings have been transferred from a prior application to a newly submitted application, applicant must renew the petition under 37 CFR 1.183 even though a similar petition was filed in the prior application. Until the renewed petition is granted, the examiner must object to the color drawings as being improper.

>Under 37 CFR 1.84, the drawings of a utility patent application must be in black and white. However, on occasion, color drawings may be appropriate. In this circumstance, the Patent and Trademark Office will entertain a petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.84 to the extent that color drawings on DIN size A4 sheets (21.0 by 29.7 cm.) will be accepted for the purposes and under the conditions set forth below.

The petition must be accompanied by five (5) sets of color drawings on DIN A4 sheets (21.0 by 29.7 cm.) for examination, copying and archival purposes.

In light of the substantial administrative and economic burden associated with printing a utility patent with color drawings, the patent copies which are printed at issuance of the patent will depict the drawings in black and white only. However, a set of color drawings will be attached to the Letters Patent. Moreover, copies of the patent with color drawings attached thereto will be provided by the Patent and Trademark Office upon special request and payment of the fee necessary to recover the actual costs associated therewith.

Accordingly, the petition must also be accompanied by a proposed amendment to insert the following language as the first paragraph in the portion of the specification containing a brief description of the drawings:

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

It is anticipated that such a petition will be granted only when the Patent and Trademark Office has determined that a color drawing is the only practical medium by which to disclose in a printed utility patent the subject matter to be patented.

It is emphasized that a decision to grant the petition should be regarded as an indication that color drawings are necessary to comply with a statutory requirement. In this latter respect, clearly it is desirable to file any desired color drawings as part of the original application papers in order to avoid issues concerning statutory defects (e.g., lack of enablement under 35 U.S.C. 112 or new matter under 35 U.S.C. 132). The filing of the petition, however may be deferred until acceptable drawings are required by the examiner.

The petition should be directed to the attention of the Office of the Deputy Assistant Commissioner for Patents.<

NOTIFYING APPLICANT

If the original drawings are informal, but may be admitted for examination purposes the draftsman indicates on 2-part form, PTO-948, what the informalities are and whether they can be corrected or whether new drawings are required. In either case the informal drawings are accepted as satisfying the requirements of 37 CFR 1.51.

The examiners are directed to advise the applicants by way of form PTO-948 (see >MPEP< § 707.07(a)) in the first Office action of the conditions which the draftsman considers to render the drawing informal, and when indicated, that such drawing can be corrected so as to be acceptable. The examiner should not require new drawings because of their execution unless the necessity therefor has been indicated by the draftsman.

Drawing corrections should be made when the application is in issue unless the examiner requires correction at an earlier date.

If the examiner discovers a defect in the content of the drawing, the applicant should be notified by using a Form Paragraph where appropriate.

¶ 6.21 New Drawings, Competent Draftsman

New formal drawings are required in this application because [1]. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the Patent and Trademark Office no longer prepares new drawings.

¶ 6.22 Drawings Objected to

The drawings are objected to because [1]. Correction is required.

Examiner Note:

Follow with paragraph 6.27, if appropriate.

¶ 6.23 Subject Matter Admits of Illustration

The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81.

Examiner Note:

When requiring drawings before examination, use PTOL-90 form and set a two-month time period.

¶ 6.26 Informal Drawings Do Not Permit Examination

The informal drawings are not of sufficient quality to permit examination. Accordingly, new drawings are required in response to this Office action.

Examiner Note:

Use PTOL-90 form and set a 2-month time period.

¶ 6.27 Correction Held in Abeyance

Applicant is required to submit a proposed drawing correction in response to this Office action. However, correction of the noted defect will be deferred until the application is allowed by the examiner.

DRAWING REQUIREMENTS

**The first sentence of 35 U.S.C. 113 **> requires< a drawing to be submitted upon filing where such drawing is necessary for the understanding of the invention. In this situation the lack of a drawing renders the application incomplete and as such, the application cannot be given a filing date until the drawing is received. The second sentence of 35 U.S.C. 113 deals with the situation wherein a drawing is not necessary for the understanding of the invention but the case admits of illustration and no drawing was submitted on filing. The lack of the drawing in this situation does not render the application incomplete but rather is treated much in the same manner as an informality. The examiner should require such drawings in almost all such instances. Such drawings could be required during the processing of the application but do not have to be furnished at the time the application is filed. The applicant is allowed at least two months from the date of the letter requiring drawings to submit them.

Handling of Drawing Requirements Under the First Sentence of 35 U.S.C. 113

The Application >Branch<* examiner will make the initial decision in all new applications as to whether a drawing is "necessary" under the first sentence of 35 U.S.C. 113. A drawing will be considered "necessary" under the first sentence of 35 U.S.C. 113 in all cases where the drawing is referred to in the specification and one or more figures have been omitted.

The determination under 35 U.S.C. 113 (first sentence) as to when a drawing is necessary will be handled in the Application >Branch<* according to the following procedure. The Application >Branch<* formality examiners will make the initial determination whether or not drawings are required for the understanding of the subject matter of the invention. Mechanical and electrical cases which lack a drawing, but in which one appears to be needed for an understanding of the invention, will be referred to the Classification and Routing >Unit<* of the Application >Branch<* for advice. If the Classification and Routing >Unit<* cannot reach a prompt and decisive response, the application will be referred to the supervisory primary examiner for a determination. When drawings are required, the application is treated as incomplete and the applicant is so informed by the Application >Branch<*. The filing date will not be granted and applicant will be notified to complete the application (37 CFR 1.53). However, the practice with respect to chemical cases is that, unless a drawing or drawing figure is specifically referred to in the specification of the application, the application will initially be considered by the Application >Branch<* formality examiner as being complete and will be given a filing date. Only in those chemical cases wherein there is a reference in the specification to a drawing and no drawing was present on filing will a chemical application initially be held incomplete and denied a filing date. If a drawing is later furnished, a filing date may be granted as of the date of receipt of such drawing.

If an examiner feels that a filing date should not have been granted in an application because it does not contain drawings, the matter should be brought to the attention of the supervisory primary examiner (SPE) for review. If the SPE decides that drawings are required to understand the subject matter of the invention, the SPE should return the application to the Application >Branch<* with a >typed, signed and dated< memorandum requesting cancellation of the filing date and identifying the subject matter required to be illustrated.

608.02(a) New Drawing — When Required [R-8]

Utility and design patent applications should be taken up for the first Office action without a request for formal drawings unless the informal drawings are so unclear that they do not facilitate an understanding of the invention as to permit examination of the application. If at the time of the initial assignment of an application to an examiner's docket or if at the time the application is taken up for action the supervisory primary examiner believes the informal drawings to be of such a condition as

to not permit reasonable examination of the application, applicant should be required to immediately submit formal drawings by using a form PTO-1094. However, if the informal drawings do not permit examination and the supervisory primary examiner believes the drawings are of such a character as to render the application defective under 35 U.S.C. 112, examination should begin immediately with a requirement for formal drawings and a rejection of the claims as not being in compliance with 35 U.S.C. 112, first paragraph being made.

Formal drawings should be required when the application is allowed.

Form letter PTO-1094 should not accompany an examiner's action since forms PTOL-326 and 37 now provide items for requiring formal drawings.

Form Paragraph 6.45 may also be used to inform applicant that formal drawings are required.

¶ 6.45 Application Allowed, Formal Drawings Needed

Formal drawings are now required and must be filed within the three month shortened statutory period set for response in the "Notice of Allowability" (PTOL-37). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a). Failure to timely submit the drawings will result in **ABANDONMENT** of the application. The drawings should be submitted as a separate paper with a transmittal letter which is addressed to the Official Draftsman. The art unit number, serial number and number of drawing sheets should be written on the reverse side of the drawings.

Handling of Drawing Requirements Under the Second Sentence of 35 U.S.C. 113

35 U.S.C. 113 deals with the situation wherein the drawing is not necessary for the understanding of the invention, but the subject matter admits of illustration by a drawing and the applicant has not furnished a drawing. The lack of the drawing in this situation does not render the application incomplete but rather is treated as an informality. A filing date will be accorded with the original presentation of the papers, despite the absence of drawings. In these situations, a drawing or further illustration will normally be required by the examiner. This should be done prior to examination in a separate letter. The examiner should require additional drawings where appropriate as early as possible, since the possession of the additional drawings would facilitate the examination process. A letter requiring drawings may contain wording similar to the following:

> "The examiner has decided that the subject matter of this application admits of illustration by a drawing and that a drawing would facilitate the understanding of the subject matter disclosed. (Continue with a specific mention of those items of which drawings are desired.) Applicant is required to furnish a drawing under 37 CFR 1.81" (Incorporate in Office action or send a separate letter setting a two-month period for response.)

The applicant >should<* be given at least two months from the date of >a<* requirement to submit drawings >made in a separate letter<. If the requirement for drawings is included in an Office action, the time for supplying the additional drawings will be the same as the time for response to the Office action.

RECEIPT OF DRAWING AFTER THE FILING DATE

When a necessary additional illustration is small and may be added to the drawings on file, an additional sheet of drawing should not be required, but the examiner will ask that the proposed illustration be shown in a sketch, which showing will be transferred to one of the sheets of the drawings. If new matter is noticed by the examiner in a substitute or additional drawing the drawing should not be entered. It should be objected to as containing new matter. A new drawing without such new matter may be required if the examiner feels a drawing is needed under 37 CFR 1.81 or 1.83. The examiner's decision would be reviewable by petition to the Commissioner under 37 CFR 1.181. The decision on such a petition would be handled by the group director.

UNTIMELY FILED DRAWINGS

If a drawing is not timely received in response to a letter from the examiner which requires a drawing, the application becomes abandoned for failure to respond.

For the handling of additional, duplicate, or substitute drawing, see >MPEP< § 608.02(h).

608.02(b) Informal Drawings [R-8]

37 CFR 1.85. Informal drawings.

The requirements of § 1.84 relating to drawings will be strictly enforced. A drawing not executed in conformity thereto, if suitable for reproduction, may be admitted but in such case the drawing must be corrected or a new one furnished, as required.

In instances where the drawing is such that the prosecution can be carried on without the corrections, applicant is informed of the reasons why the drawing is objected to on Form PTO-948, and that the drawing is admitted for examination purposes only (see >MPEP< § 707.07(a)). To be fully responsive, an amendment must include a request for drawing corrections when the application is allowed or an appeal is filed. See >37 CFR<* 1.111(b).

INFORMAL DRAWINGS

To expedite filing, applicants sometimes submit applications with informal drawings. Such applications are accepted by Application >Branch<* for filing only, provided the informal drawings are readable and reproducible. Applicant is notified on form letter PTOL-1094 or by Form Paragraph 6.24 that formal drawings, in compliance with >37 CFR<* 1.84 will be required when the application is allowed. Form PTO-1094 will be used when the informal drawings are such as to render the application impractical to be examined.

¶ 6.24 Informal Drawings

This application has been filed with informal drawings which are

acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

HANDLING OF NEW DRAWINGS

In those situations where an application is filed with informal drawings, applicants are requested to wait until they receive their "Notice of Informal Drawings" form, PTO-1094 or the first Office action utilizing form PTOL-327 or PTOL-37 from the group art unit before submitting the formal drawings. The letter of transmittal accompanying the formal drawings should identify the group art unit indicated on form PTO-1094 or form PTOL-326. If the informal notification appears on form PTOL-37, the date of the mailing of the Notice of Allowance and Issue Fee as well as the Issue Batch Number must be given. Also, each sheet of drawing should include the serial number and group art unit in the upper right margin. In the past, some drawings have been misdirected because the group art unit indicated on the filing receipt was used rather than that indicated on the informal notice forms.

The draftsman is the judge of drawings, as to the execution of the same, and the arrangement of the views thereon, while the examiner is the judge as to the sufficiency of the showing. The drawings received with an application are inspected by the draftsman. If the drawing is satisfactory, he stamps on each sheet "Approved by Draftsman." See also >MPEP< § 608.02.

RECEIPT OF SUBSTITUTE DRAWINGS

If substitute drawings are timely filed, the clerk should immediately send the new substitute drawings with the file wrapper to the Draftsman for approval as to form.

If the application is allowed on the first action, the examiner should require formal drawings using form PTOL-37.

COMPARISON OF SUBSTITUTE DRAWINGS

In utility applications, the examination will normally be conducted using any informal drawings presented, the sufficiency of disclosure, as concerns the subject matter claimed, will be made by the examiner utilizing the informal drawings. ACCORDINGLY, IT IS APPLICANT'S RESPONSIBILITY TO SEE THAT NO NEW MATTER IS ADDED when submitting substitute drawings, since they will not normally be reviewed by an examiner. Of course, if the examiner notices new matter in the substitute drawings, appropriate action to have the new matter deleted should be undertaken.

>The Patent and Trademark Office no longer requires a $10 (ten dollar) comparison fee payment with the submission of formal sheets of drawings. <

608.02(c) Drawing Print Kept in File Wrapper [R-8]

The drawing prints must always be kept on top of the papers on the right side of the file wrapper so as to be visible upon opening the wrapper and to permit them to be easily detached.

Applications may be sent to issue or to the * Files *>Repository< without the original drawing, if any, if the drawing cannot be located. For >an< application sent to issue with missing drawings see >MPEP< § 608.02(z). For >abandoned< applications sent to **>the Files Repository<, a notation should be made on the "Contents" portion of the file wrapper that the drawings were missing.

Upon initial processing, the original drawings are placed in the center portion of the application file wrapper underneath the application papers by the **>Micrographics Branch<. The formal drawings should be retained in this position.

608.02(d) Complete Illustration in Drawings [R-8]

37 CFR 1.83. Content of drawing.

(a) The drawing must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g. a labeled rectangular box).

(b) When the invention consists of an improvement on an old machine the drawing must when possible exhibit, in one or more views, the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

(c) Where the drawings do not comply with the requirements of paragraphs (a) and (b) of this section, the examiner shall require such additional illustration within a time period of not less than two months from the date of the sending of a notice thereof. Such corrections are subject to the requirements of § 1.81(d).

Any structural detail that is of sufficient importance to be described should be shown in the drawing. (*Ex parte Good*, 1911 C.D. 43; 164 O.G. 739.)

Form Paragraph 6.36 should be used to require illustration.

¶ 6.36 Drawings Do Not Show Claimed Subject Matter

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the [1] must be shown or the feature should be cancelled from the claim. No new matter should be entered.

Examiner Note:

In bracket 1, insert the features that should be shown.

See also >MPEP< § 608.02(a).

608.02(e) Examiner Determines Completeness of Drawings

The examiner should see to it that the figures are correctly described in the brief description of the specification and that the reference characters are properly applied, no single reference character being used for two different parts or for a given part and a modification of such part. Every feature covered by the

claims must be illustrated, but there should be no superfluous illustrations.

608.02(f) Modifications in Drawings

Modifications may not be shown in broken lines on figures which show in solid lines another form of the invention. *Ex parte Badger*, 1901 C.D. 195; 97 O.G. 1596.

All modifications described must be illustrated, or the text canceled. (*Ex parte Peck*, 1901 C.D. 136; 96 O.G. 2409.) This requirement does not apply to a mere reference to minor variations nor to well-known and conventional parts.

608.02(g) Illustration of Prior Art [R-8]

Figures showing the prior art are usually unnecessary and should be canceled. *Ex parte Elliott*, 1904 C.D. 103; 109 O.G. 1337. However, where needed to understand applicant's invention, they may be retained if designated by a legend such as "Prior Art."

• > If the prior art figure is not labeled, the following paragraph may be used.

Figure [1] should be designated by a legend such as "Prior Art" in order to clarify what is applicant's invention. (see MPEP § 608.02(g)).<

608.02(h) Additional, Duplicate or Substitute Drawings [R-8]

When an amendment is filed stating that at the same time substitute or additional sheets of drawings are filed and such drawings have not been transmitted to the examining group, the docket clerk in the examining group should call the Application >Branch<* before entering the amendment to ascertain if the drawing was not received. In the next communication of the examiner the applicant is notified if the drawings have been received and whether or not the substitute or additional drawings have been entered in the application.

Additional and substitute drawings, together with the file wrapper, are routed through the Drafting >Branch<* where any defects in execution will be noted. If there are none, they will be stamped, "APPROVED BY DRAFTSMAN". When such drawings are considered by the examiner, it should be kept in mind that the "APPROVED" stamp applies only to the size and quality of paper, lines rough and blurred and other details of execution. ** The additional or substitute drawing sheets should be entered by the application clerk after approval by both the draftsman and the examiner.

The examiner should not overlook such factors as new matter, the necessity for the additional sheets and consistency with other sheets. Clerks will routinely "enter" all additional and substitute sheets on the file wrapper. Additional and substitute sheets of drawings are also indicated on the face of the file wrapper under the heading "Parts of application separately filed". If the examiner decides that the sheets should not be entered, applicant is so informed, giving the reasons. The entries made by the clerk will be marked "(N.E.)".

Form Paragraph 6.37 should be used to acknowledge corrected or substituted drawings.

¶ 6.37 Acknowledgment of Corrected or Substituted Drawings

The corrected or substitute drawings have been received on [1]. These drawings are [2].

Examiner Note:

1. In bracket 2, insert either — acceptable — or — not acceptable.
2. If not acceptable, an explanation must be provided.
3. If not acceptable because of informalities noted on the PTO-948, use form paragraph 6.43.

If an additional sheet of drawing is considered unnecessary and the original drawing requires alterations which are taken care of in the proffered additional sheet, the latter may be used in lieu of the usual sketch required in making the correction of the original drawing.

If an old, large size 10 inch by 15 inch drawing is to be transferred to an application filed after January 1, 1972, the drawing together with the file wrapper, should be forwarded to the Draftsman. He will cut down the size of the drawing and forward the case for preparation of prints. Only the Draftsman may cut the oversize drawings to size.

For return of drawing, see >MPEP< § 608.02(y).

608.02(i) Transfer of Drawings From Prior Applications [R-8]

37 CFR 1.88. Use of old drawings.

If the drawings of a new application are to be identical with the drawings of a previous application of the applicant on file in the Office, or with part of such drawings, the old drawings or any sheets thereof may be used if the prior application is, or is about to be, abandoned, or if the sheets to be used are canceled in the prior application. The new application must be accompanied by a letter requesting the transfer of the drawings, which should be completely identified.

Transfer of all drawings from a first pending application to another will be made only **>if the prior application is abandoned or is about to be abandoned. If the prior application has not already been abandoned and if a request to transfer all the drawings is not accompanied by a written declaration of abandonment of the pending application under 37 CFR 1.138, the request to transfer all the drawings will be treated as a request to abandon the pending application. A< written declaration of abandonment >may be worded by applicant so as to become effective only after the transfer of the drawings has taken place in order to insure copendency<.

NEWLY SUBMITTED APPLICATION

** When a new application is filed with a request to transfer drawings under *>37 CFR< 1.88, the application papers should include drawing prints to enable the Application >Branch<* to process the case before transfer of the formal drawings is effected.**

>The transfer of drawings to newly submitted applications that have not been forwarded to the examining group will be effected by the Application Branch if no drawing prints are filed and the application is otherwise entitled to receive a filing date. The transfer of the drawings between applications under 37 CFR 1.88 is processed in the examining groups if informal prints are filed with the application papers.<

The above practice applies to transfer of drawings from any application except where the issue fee has been paid in which case an express abandonment (>37 CFR<* 1.138) must be filed together with a **>petition to withdraw from issue under 37 CFR<* 1.313. >See MPEP § 1308.<

REQUEST FOR CHANGES TO THE DRAWINGS MADE IN PARENT APPLICATION

Transferred drawings will include all changes that have been physically made to the drawings at the time of transfer. Requests for changes that have not been previously made must be again requested. Accordingly, applicants should include a new detailed request to make necessary corrections when transferring drawings along with the transfer request.

When an application is sent to issue, any canceled sheet of drawing then in the case is placed on the bottom of the papers on the right hand flap of the file wrapper. Such canceled sheet is available for applicant's use in another application directed to its subject matter. It follows that, except as provided in >37 CFR<* 1.174, drawings printed in a patent may not be transferred to a subsequent case.

608.02(j) Transfer of Canceled Sheets of Drawings to Divisional Application [R-8]

In the case of a divisional application >filed under 35 U.S.C. 111 and 37 CFR 1.53<, if the drawing and descriptive matter pertaining thereto have been canceled from the parent case, the canceled sheet or sheets of drawing may be withdrawn and used as the original drawing of the divisional case. The sheets involved should be taken to the Drafting *>Branch< for erasure of the "CANCEL per" stamp.

608.02(k) Transfer of Drawings to Reissue [R-8]

In a reissue application, the prints of the original or patented drawing may be used for examination purposes, and the formal transfer of the original drawing to the reissue application made when the reissue application is ready for issue, *provided* no change whatever, even so much as the priming of a reference character, or correction of an obvious error, is made in the drawing. If there is to be any change whatsoever in the drawing, a new drawing for the reissue must be filed.

If there is more than one sheet of original drawing, a required change on any sheet will preclude the use of the original drawings which must be kept in the condition existing at the time of issue of the original patent. See >MPEP< § 1413.

Transfer of the drawing is made as set forth in >MPEP< § 608.02(i), notation thereof being entered on the file wrapper of the original application.

The letter of transmittal in a reissue application should request transfer of the drawings, if such transfer is desired.

608.02(m) Drawing Prints [R-8]

Preparation and distribution of drawing prints is discussed in >MPEP< § 508.

Prints are made of the drawings of an acceptable application. These prints are marked "Prints of drawing as originally filed" and are entered in the application, given a paper number and kept on top of the papers on the right side of the file wrapper, see >MPEP< § 717.01(b).

All prints and inked sketches subsequently filed to be part of the record are endorsed with the date of their receipt in the Office and given their appropriate paper number.

The print being thus an official paper in the record should not be marked or in any way altered. The original drawing, of course, should not be marked up by the examiner. Where, as in an electrical wiring case, it is desirable, to identify the various circuits by different colors, or in any more or less complex case, it is advantageous to apply legends, arrows or other indicia, and additional print for such use should be made or ordered by the examiner and placed unofficially in the file.

Prints remain in the file at all times except as provided in >MPEP< § 608.02(c).

INTERFERENCE PRINTS

A print on heavy weight, colored paper is prepared of each drawing in all applications having a filing date. This interference print on colored paper is in addition to the drawing print on white paper.

Primary examiners should place the classification and the name of the examiner on the interference print.

The interference prints are located above the white paper prints on the right hand portion of the file wrapper, when initially received in the examining group.

After the application has been classified and assigned to an examiner, the interference prints should be removed and placed in the drawing cabinets.

If an application has several sheets of drawings, the interference prints should be stapled together at their bottom edges before being filed. If the number of sheets of prints is too large to be stapled, a fastener should be placed through the holes at the top.

The time when the interference prints are removed from the drawing cabinets is determined by the group director.

The formal drawings remain in the file wrapper.

608.02(n) Duplicate Prints in Patentability Report Cases

In patentability report cases having drawings, the examiner

to whom the case is assigned should normally obtain a duplicate set of the interference prints of the drawing for filing in the group to which the case is referred.

When a case that has had patentability report prosecution is passed for issue or becomes abandoned, notification of this fact is given by the group having jurisdiction of the case to each group that submitted a patentability report. The examiner of each such reporting group notes the date of allowance or abandonment on his or her duplicate set of prints. At such time as these prints become of no value to the reporting group, they may be destroyed.

608.02(o) Dates Entered on Drawing [R-8]

The Incoming Mail Section (mail room) stamp and the "Corrected" stamp applied by the Drafting >Branch<* are impressed on the back of the drawings. If the drawings are filed in the Examining Group, the group receipt date stamp should be applied to the back of the drawing near the top.

Approval of the Drafting >Branch<* is indicated by a legend associated with the "O.G. Fig. Cl.... Sub...." stamp on the front of each sheet.

608.02(p) Correction of Drawings [R-8]

37 CFR1.123 Amendments to the drawing.

No change in the drawing may be made except by permission of the Office. Permissible changes in the construction shown in any drawing may be made only by bonded draftsmen, at applicant's expense, or by the submission of substitute drawings by applicant. A sketch in permanent ink showing proposed changes, to become part of the record, must be filed for approval by the examiner **>and should be a separate paper<.

NOTE. — Correction is deferrable, see >MPEP< § 608.02(b), correction at allowance and issue, see >MPEP< § 608.02(w) and >MPEP §< 1302.05.

A canceled figure may be reinstated. An amendment should be made to the specification adding the brief description if a canceled figure is reinstated.

608.02(q) Conditions Precedent to Amendment of Drawing [R-8]

No alterations will be permitted unless required by an examiner's letter in each case, or proposed in writing by applicant or his or her attorney or agent. In either case the alterations or corrections as indicated in the sketches filed with the request of the applicant or his or her attorney or agent must be given written approval by the examiner before the drawing is corrected.

Correction of Informalities (Draftsman's objections on PTO-948)

>Form paragraph 6.40 (reproduced in MPEP § 608.02) and form PTO-1474, "Information on how to effect drawing changes" and the back page of PTOL-37 the "Notice of allowability" provide detailed information on how to effect drawing changes.<

In order to correct any informalities in the drawings, applicants *MUST* comply with options (a) or (b) below. Failure to do so will result in *ABANDONMENT* of the application.

(a) File new drawings with the changes incorporated therein. Applicant may delay filing of the new drawings until the application is allowed by the examiner. If delayed, the new drawings *MUST* be filed within the ** period set for >response<** in the >"NOTICE OF ALLOWABILITY" (PTOL-37)<. ** The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsman and which indicates the following in the upper right hand corner:

Date of the Notice of >Allowability<*
Issue Batch Number
Serial Number

(b) Request a commercial bonded drafting firm to make the necessary corrections.

A BONDED DRAFTSMAN MUST BE AUTHORIZED, THE CORRECTIONS EXECUTED AND THE CORRECTED DRAWINGS RETURNED TO THE OFFICE DURING THE THREE MONTH ** PERIOD SET IN THE "NOTICE OF >ALLOWABILITY" (PTOL-37<.) EXTENSIONS OF THE THREE MONTH PERIOD >MAY BE OBTAINED UNDER THE PROVISIONS OF 37 CFR 1.136(a)<**.

Corrections Other Than Informalities Noted by the Draftsman on the PTO-948

All changes to the drawings, other than informalities noted by the Draftsman, *MUST* be made in the same manner as above except that, if delayed option (a) is selected, normally, a sketch of the changes to be incorporated into the new drawings *MUST* be approved by the examiner before the application will be allowed. If option (b) is selected, normally, applicants must submit, in duplicate, a separate paper containing a sketch of the proposed changes before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

608.02(r) Separate Letter to Draftsman [R-8]

Any proposal by the applicant for amendment of the drawing to cure defects must be embodied in a *separate* letter. Otherwise the case, unless in other respects ready for issue, cannot be corrected, and applicant must be so advised in the next action by the examiner.

NOTE. — Changes which may require sketches, >MPEP< § 608.02(v).

608.02(t) Cancelation of Figures

Cancelation of one or more figures which do not occupy entire sheets of the drawings is done by the clerk in the

examining group who encloses a figure and its legend with a red ink line. No portion of the figure itself should be crossed by the red line. The words "CANCEL per" and the date of the amendment directing the cancelation or the date that substitute sheets are filed should be written in red ink within the red line. Cancelation of an entire sheet of drawings is done by stamping the words "CANCEL per" in the top right corner of the drawing. Canceled drawing sheets should be placed at the bottom of the papers on the right fold of the file wrapper.

When the cancelation of some of the figures from one sheet of drawings has left the remaining figures with an inartistic arrangement, the draftsmen should be consulted as to whether the remaining figures should be transferred to other sheets already in the case or shown in additional drawings. Cancelation of a figure may necessitate renumbering of the remaining figures.

608.02(u) Changing Name of Attorney on Drawing Forbidden

Writing upon the drawings the names of attorneys subsequently appointed, so as to make it appear that their names were present when the drawings were originally filed, is prohibited.

This prohibition applies also where a drawing filed when names were permitted is transferred from one case to another having a different attorney.

608.02(v) Drawing Changes Which Require Sketches

When changes are to be made in the drawing itself, other than mere changes in reference characters, designations of figures, or inking over lines pale and rough, a print or pen-and-ink sketch showing such changes in red ink must be filed. Ordinarily, broken lines may be changed to full without a sketch.

Sketches filed by an applicant and used for correction of the drawing will not be returned. All such sketches must be in ink or permanent prints.

608.02(w) Drawing Changes Which May Be Made Without Applicant's Sketch

Where an application is ready for issue except for a slight defect in the drawing not involving change in structure, the examiner will prepare a letter indicating the change to be made and note in pencil on the drawing the addition or alteration to be made.

The correction must be made by a bonded draftsman at applicant's expense.

As a guide to the examiner the following corrections are illustrative of those that may be made by penciling in the change on the drawing, without a sketch:

1. Adding two or three reference characters or exponents.
2. Changing one or two numerals or figure ordinals. *Garrett v. Cox*, 110 USPQ 52, 54 (CCPA 1956)
3. Removing superfluous matter.
4. Adding or reversing directional arrows.
5. Changing Roman Numerals to Arabic Numerals to agree with specification.
6. Adding section lines or brackets, where easily executed.
7. Changing lead lines.
8. Correcting misspelled legends.

608.02(x) Disposition of Orders for Amendment of Drawing [R-8]

Where the correction of the drawing is approved by the examiner the application and drawing are forwarded to the >Office of Publications<** along with the Notice of Allowance.

CORRECTION NOT APPROVED

Where the correction is not approved, for example, because the proposed changes are erroneous, or involve new matter or (although otherwise proper) do not include all necessary corrections, the case and request for correction of drawing are not approved. The examiner's reasons for not approving the corrections to the drawing should be set forth in the next Office action.

608.02(y) Return of Drawing [R-8]

If there is a formal drawing in the case, non-entered drawings (except those originally filed) that have been finally denied admission will be returned to the applicant only at applicant's request.

A request for return of non-entered drawings must be filed within a reasonable time; otherwise the drawing may be disposed of at the discretion of the Commissioner.

When a drawing is to be returned, the file, the examiner's letter stating that the drawing is being returned, and the drawing are taken to the Drafting >Branch<* where the letter will be stamped and the drawing returned. The letter is mailed by the examining group.

Before drawings are returned, prints are made and put in the application file.

608.02(z) Allowable Applications Needing Drawing Corrections or Formal Drawings [R-8]

Allowable applications can be turned in for counting and forwarding to the >Office of Publications<** without the drawings having been corrected. When sending allowed applications to the >Office of Publications<** which require drawing corrections, use yellow tag form PTO-1364 to indicate the Official Gazette figure and the classification. The approved formal drawings requiring correction should be placed as the top papers in the center fold of the file wrapper. The drawing correction instructions should be stapled to the inside left flap of the file wrapper over the area having the search information. Care should be taken to make certain that the corrections have been approved by the examiner. Such approval should be made by the

examiner prior to counting the allowance of the application.

The yellow tag procedure normally should be used only where drawing corrections are involved. The yellow tag procedure may be used where the draftsman has objected to the drawing because of an informality such as improper shading or pale lines and has indicated that this can be corrected.

The yellow tag procedure should not normally be used in other situations where the drawings have not been approved by the draftsman unless the examiner is quite sure that the draftsman will approve the new drawings or in the situation where the application was examined utilizing an informal drawing and the request for formal drawings was not made until the Notice of *>Allowability< was mailed. The yellow tag procedure should not be used in design applications where the drawings have not been approved by the draftsman because of shading problems which can arise. If the substitute drawings are not approved by the draftsman, the application should be promptly taken up for action by the examiner.

To: DRAFTING BRANCH via OFFICE OF PUBLICATIONS
Return to: OFFICE OF PUBLICATIONS
Room 2-6C30

Serial no. _____
O.G. Fig. _____

Class _____ Subclass _____

PTO-1364 U.S. DEPT. of COMM. Pat. & TM Office

APPLICATIONS HAVING LOST DRAWINGS

A yellow tag is to be attached to the file wrapper and a "Drawing Missing" memo is to be stapled to the front of the file wrapper. The Notice of *>Allowability< is verified, and printed using PALM III and the Notice is mailed to the applicant.

The application is then forwarded to Licensing and Review or the Allowed Files >and Assembly < Branch of the >Office of Publications<**, as appropriate, using the PALM III transaction code after the application has been revised for issue.

UTILITY PATENT APPLICATIONS RECEIVING FORMAL DRAWINGS AFTER THE NOTICE OF *>ALLOWABILITY<

Where substitute drawings are received in utility patent applications examined with informal drawings and the Notice of *>Allowability< was mailed prior to the receipt of the substitute drawings, the clerk should enter the substitute drawings into the application and forward the application to the Allowed Files >and Assembly< Branch of the >Office of Publications<** via Licensing and Review, if appropriate, using the yellow tag procedure. Submission to the examiner is not necessary unless an amendment accompanies the drawings which changes the specification, such as where the description of figures is added or canceled.

BORROWING FILES FROM DRAFTING >BRANCH<*

Allowed files requiring drawing corrections are sent to the draftsman from the >Office of Publications<**. At times examiners have >a< need to borrow these applications. When borrowing applications, examining corps personnel must submit a request to the >Office of Publications<**.

*>37 CFR< 1.312 AMENDMENTS

In handling >37 CFR<* 1.312 amendments, the examining corps should process drawings canceled in the normal manner. If there are corrections to the drawing,** >approval, if appropriate, is indicated by the examiner on form PTOL-271 in conjunction with form paragraph 6.48, the paragraph sets the appropriate period for effecting the approved drawing change.

¶ 6.48 Drawing Changes in 312 Amendment

Applicant is hereby given one month from the date of this letter or until the expiration of the period set in the Notice of Allowance (PTOL-85) or Notice of Allowability (PTOL-37), whichever is longer, within which the corrections to the drawings must be executed by a bonded commercial draftsman and the corrected drawings (or the substitute or additional sheet(s) of drawing(s) returned to the Office.

Examiner Note:

Use with 312 amendment notice where there is a drawing correction proposed or requested.

Formal drawings may be required in an allowed application by using form paragraph 6.25 in an Office action.

¶ 6.25 Formal Drawings Required, Application Allowed

The application having been allowed, formal drawings are required in response to this Office action.<

608.03 Models, Exhibits, Specimens

35 U.S.C. 114. Models, specimens.

The Commissioner may require the applicant to furnish a model of convenient size to exhibit advantageously the several parts of his invention.

When the invention relates to a composition of matter, the Commissioner may require the applicant to furnish specimens or ingredients for the purpose of inspection or experiment.

37 CFR 1.91. Models not generally required as part of application or patent.

Models were once required in all cases admitting a model, as a part of the application, and these models became a part of the record of the patent. Such models are no longer generally required (the description of the invention in the specification, and the drawings, must be sufficiently full and complete, and capable of being understood, to disclose the invention without the aid of a model), and will not be admitted unless specifically called for.

37 CFR 1.92. Model or exhibit may be required.

A model, working model, or other physical exhibit, may be required if deemed necessary for any purpose on examination of the application.

With the exception of cases involving perpetual motion, a model is not ordinarily required by the Office to demonstrate the operativeness of a device. If operativeness of a device is questioned, the applicant must establish it to the satisfaction of the examiner, but he >or she< may choose his >or her< own way of so doing.

A physical exhibit, not to be part of the case, is generally not refused except when bulky or dangerous.

37 CFR 1.93. Specimens.

When the invention relates to a composition of matter, the applicant may be required to furnish specimens of the composition, or of its ingredients or intermediates, for the purpose of inspection or experiment.

608.03(a) Handling of Models, Exhibits and Specimens [R-8]

All models and exhibits received in the Patent and Trademark Office should be taken to the examining group assigned the related application for examination. The receipt of all models and exhibits must be properly recorded on the "Contents" portion of the application file wrapper.

A label indicating the application serial number, filing date, and attorney's name and address should be attached to the model or exhibit so that is is clearly identified and easily returned after prosecution of the application is closed, if return is requested.

If the model or exhibit is too large to be kept in the examining group during prosecution of the application, it should not be accepted.

37 CFR 1.94. Return of models, exhibits or specimens.

Models, exhibits, or specimens in applications which have become abandoned, and also in other applications on conclusion of the prosecution, may be returned to the applicant upon demand and at his expense, unless it be deemed necessary that they be preserved in the Office. Such physical exhibits in contested cases may be returned to the parties at their expense. If not claimed within a reasonable time, they may be disposed of at the discretion of the Commissioner.

When a model is to be returned a letter should be written to applicant by the examining group stating that it is being returned under separate cover and the model should be forwarded with a copy of the letter and an address label to the Outgoing >-Incoming< Mail Branch for wrapping and return.

NOTE. — Disposition of exhibits which are part of the record, >MPEP< § 715.07(d).

Models, exhibits and specimens may be presented to the Office for purposes of interview and taken away by the attorney at the end of the interview. See >MPEP< § 713.08.

NOTE. — Plant specimens, >MPEP< § 1607, 37 CFR 1.166.

37 CFR 1.95. Copies of exhibits.

Copies of models or other physical exhibits will not ordinarily be furnished by the Office, and any model or exhibit in an application or patent shall not be taken from the Office except in the custody of an employee of the Office specially authorized by the Commissioner.

608.04 New Matter [R-8]

37 CFR 1.118. Amendment of disclosure.

(a) No amendment shall introduce new matter into the disclosure of an application after filing date of the application (§ 1.53(b)). All amendments to the specification, including the claims, and the drawings filed after the filing date of the application must conform to at least one of them as it was at the time of the filing of the application. Matter not found in either, involving a departure from or an addition to the original disclosure, cannot be added to the application after its filing date even though supported by an oath or declaration in accordance with § 1.63 or § 1.67 filed after the filing date of the application.

(b) If it is determined that an amendment filed after the filing date of the application introduces new matter, claims containing new matter will be rejected and deletion of the new matter in the specification and drawings will be required even if the amendment is accompanied by an oath or declaration in accordance with § 1.63 or § 1.67.

In establishing a disclosure applicant may rely not only on the specification and drawing as filed but also on the original claims if their content justifies it. Note >MPEP< § 608.01(l).

While amendments to the specification and claims involving new matter are ordinarily entered, such matter is required to be canceled from the descriptive portion of the specification, and the claims affected are rejected >under 35 U.S.C. 112, first paragraph<.

>When the new matter is introduced into the specification, the amendment should be objected to under 35 U.S.C. 132 (35 U.S.C. 251 if a reiisue application) and a requirement made to cancel the new matter - clearly identified by the examiner. If the new matter has been entered into the claims or affects the scope of the claims, the claims affected should be rejected under 35 U.S.C. 112, first paragraph, because the new matter is not described in the application as originally filed.<

A "new matter" amendment of the drawing is ordinarily not entered. Neither is an additional or substitute sheet containing "new matter" even though stamped APPROVED by the Draftsman and provisionally entered by the clerk. See >MPEP< § 608.02(h).

The examiner's holding of new matter may be petitionable or appealable, >MPEP< § 608.04(c).

NOTE. — New matter in reissue application, >MPEP< § 1411.02. New matter in substitute specification, >MPEP< § 714.20.

608.04(a) Matter Not in Original Specification, Claims or Drawings

Matter not in the original specification, claims or drawings is usually new matter. Depending on circumstances such as the adequacy of the original disclosure, the addition of inherent characteristics such as chemical or physical properties, a new structural formula or a new use may be new matter. See *Ex parte Vander Wal et al.*, 1956 C.D. 11; 705 O.G. 5 (physical properties), *Ex parte Fox*, 1960 C.D. 28; 761 O.G. 906 (new formula) and *Ex parte Ayers et al.*, 108 USPQ 444 (new use). For rejection of claim involving new matter see >MPEP< § 706.03(o).

NOTE. — Completeness of disclosure, >MPEP< § 608.01(p); Trademarks and trade names, >MPEP< § 608.01(v).

608.04(b) New Matter by Preliminary Amendment [R-8]

An amendment is sometimes filed along with the filing of the application. Such amendment does not enjoy the status as part of the original disclosure >in an application filed under 37 CFR 1.53< unless it is referred to in the oath or declaration filed therewith ** > Once an oath or declaration is submitted in an application filed under 37 CFR 1.53 identifying the papers which the inventor(s) has "reviewed and understands" as required by 37 CFR 1.63, the original disclosure of the application is defined and cannot be altered merely by filing of a subsequent oath or declaration referring to different papers. Accordingly, if the application is filed without an executed oath or declaration pursuant to 37 CFR 1.53(b), the original oath or declaration submitted later than the filing date must refer to the preliminary amendment filed along with the application in order for such amendment to enjoy the status as part of the original disclosure. Otherwise, its< test as to involving new matter is the same as though filed on a subsequent date.**

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

608.04(c) Review of Examiner's Holding of New Matter

Where the new matter is confined to amendments to the specification, review of the examiner's requirement for cancellation is by way of petition. But where the alleged new matter is introduced into or affects the claims, thus necessitating their rejection on this ground, the question becomes an appealable one, and should not be considered on petition even though that new matter has been introduced into the specification also. 37 CFR 1.181 and 1.191 afford the explanation of this seemingly inconsistent practice as affecting new matter in the specification.

608.05 Deposit of Computer Program Listings [R-8]

37 CFR 1.96 Submission of computer program listings.

Descriptions of the operation and general content of computer program listings should appear in the description portion of the specification. A computer program listing for the purpose of these rules is defined as a print-out that lists in appropriate sequence the instructions, routines, and other contents of a program for a computer. The program listing may be either in machine or machine-independent (object or source) language which will cause a computer to perform a desired procedure or task such as solve a problem, regulate the flow of work in a computer, or control or monitor events. Computer program listings may be submitted in patent applications in the following forms:

(a) *Material which will be printed in the patent.* If the computer program listing is contained on 10 printout pages or less, it must be submitted either as drawings or as part of the specification.

(1) *Drawings.* The listing may be submitted in the manner and complying with the requirements for drawings as provided in § 1.84. At least one figure numeral is required on each sheet of drawing.

(2) *Specification.* (i) The listing may be submitted as part of the specification in accordance with the provisions of § 1.52, at the end of the description but before the claims.

(ii) The listing may be submitted as part of the specification in the form of computer printout sheets (commonly 14 by 11 inches in size) for use as "camera ready copy" when a patent is subsequently printed. Such computer printout sheets must be original copies from the computer with dark solid black letters not less than 0.21 cm high, on white, unshaded and unlined paper, the printing on each sheet must be limited to an area 9 inches high by 13 inches wide, and the sheets should be submitted in a protective cover. When printed in patents, such computer printout sheets will appear at the end of the description but before the claims and will usually be reduced about 1/2 in size with two printout sheets being printed as one patent specification page. Any amendments must be made by way of submission of a substitute sheet if the copy is to be used for camera ready copy.

(b) *As an appendix which will not be printed.* If a computer program listing printout is 11 or more pages long, applicants may submit such listing in the form of microfiche, referred to in the specification (see § 1.77(c)(2)). Such microfiche filed with a patent application is to be referred to as a "microfiche appendix." The "microfiche appendix" will not be part of the printed patent. Reference in the application to the "microfiche appendix" should be made at the beginning of the specification at the location indicated in § 1.77(c)(2). Any amendments thereto must be made by way of revised microfiche. All computer program listings submitted on paper will be printed as part of the patent.

(1) *Availability of appendix.* Such computer program listings on microfiche will be available to the public for inspection, and paper or microfiche copies thereof will be separately available for purchase, after a patent based on such an application is granted or the application is otherwise made publicly available.

(2) *Submission requirements.* Computer-generated information submitted as an appendix to an application for patent shall be in the form of microfiche in accordance with the standards set forth in the following American National (ANSI) or National Micrographics Association (NMA) Standards (Note: As new editions of these standards are published, the latest shall apply):

ANSI PH 1.28-1976-Specifications for Photographic Film for Archival records, Silver-Gelatin Type, on Cellulose Ester Base.

ANSI PH 1.41-1976 Specifications for Photographic Film for Archival Records, Silver-Gelatin Type, on Polyester Base.

NMA-MSI (1971) Quality Standards for Computer Output Microfilm.

ANS1/NMA MS2 (1978) Format and Coding Standards for Computer Output Microfilm.

NMA MS5 (ANSI PH 5.9-1975) Microfiche of Documents.

ANSI PH 2.19 (1959)-Diffuse Transmission Density.

except as modified or clarified below:

(i) Either Computer-Output-Microfilm (COM) output or copies of photographed paper copy may be submitted. In the former case, NMA standards MS1 and MS2 apply; in the latter case, standard MS5 applies.

(ii) Film submitted shall be first generation (camera film) negative appearing microfiche (with emulsion on the back side of the film when viewed with the images right reading).

(iii) Reduction ratio of microfiche submitted should be 24:1 or a similar ratio where variation from said ratio is required in order to fit the documents into the image area of the microfiche format used.

(iv) Film submitted shall have a thickness of at least .005 inches (0.13 mm) and not more than .009 inches (0.23 mm) for either cellulose acetate base or polyester base type.

(v) Both microfiche formats A1 (98 frames, 14 columns x 7 rows) and A3 (63 frames, 9 columns x 7 rows) which are described in NMA standard MS2 (A1 is also described in MS5) are acceptable for use in preparation of microfiche submitted.

(vi) At least the left-most 1/3 (50 mm x 12 mm) of the header or title area of each microfiche submitted shall be clear or positive appearing so that the Patent and Trademark Office can apply serial number and filing date thereto in an eye-readable form. The middle portion of the header shall be used by applicant to apply an eye-readable application identification such as the title and/or the first inventor's name. The attorney's docket number may be included. The final right-hand portion of the microfiche shall contain sequence information for the microfiche, such as 1 of 4, 2 of 4, etc.

(vii) Additional requirements which apply specifically to microfiche of filmed paper copy:

(A) The first frame of each microfiche submitted shall contain a standard test target which contains five NBS Micro-copy Resolution Test Charts (No. 1010A), one in the center and one in each corner. See illustration on page 2 of NMA Recommended Practice MS104, Inspection and Quality Control of First Generation Silver Halide Microfilm. See also paragraph 7 of NMA-MS5.

(B) The second frame of each microfiche submitted must contain a fully descriptive title and the inventor's name as filed.

(C) The pages or lines appearing on the microfiche frames should be consecutively numbered.

(D) Pagination of the microfiche frames shall be from left to right and from top to bottom.

(E) At a reduction of 24:1 resolution of the original microfilm shall be at least 120 lines per mm (5.0 target) so that reproduction copies may be expected to comply with provisions of paragraph 7.1.4 of NMA Standard MS5.

(F) Background density of negative appearing camera master microfiche of filmed paper documents shall be within the range of 0.9 to 1.2 and line density should be no greater than 0.08. The density shall be visual diffuse density as measured using the method described in ANSI Standard PH 2.19.

(G) An index, when included, should appear in the last frame (lower right hand corner when data is right-reading) of each microfiche. See NMA-MS5, paragraph 6.6.

(viii) Microfiche generated by Computer Output Microfilm (COM).

(A) Background density of negative-appearing COM-generated camera master microfiche shall be within the range of 1.5 to 2.0 and line density should be no greater than 0.2. The density shall be visual diffuse density as described in ANSI PH2.19.

(B) The first frame of each microfiche submitted should contain a resolution test frame in conformance with NMA standard MS1.

(C) The second frame of each microfiche submitted must contain a fully descriptive title and the inventor's name as filed.

(D) The pages or lines appearing on the microfiche frames should be consecutively numbered.

(E) It is preferred that pagination of the microfiche frames be from left to right and top to bottom but the alternative, i.e., from top to bottom and from left to right, is also acceptable.

(F) An index, when included, should appear on the last frame (lower right hand corner when data is right reading) of each microfiche.

(G) Amendment of microfiche must be made by way of replacement microfiche.

** Special procedures for presentation of computer program listings in the form of microfiche in >U.S. national< patent applications >are set forth in 37 CFR 1.96<. Use of microfiche is desirable in view of the number of computer program listings being submitted as part of the disclosure in patent applications. Such listings are often several hundred pages in length. By filing and publishing such computer program listings on microfiche rather than on paper, substantial cost savings can result to the applicants, the public, and the Patent and Trademark Office.

BACKGROUND

A computer program listing, as used in these rules, means the printout that lists, in proper sequence, the instructions, routines, and other contents of a program for a computer. The listing may be either in machine or machine-independent (object or source) programming language which will cause a computer to perform a desired task, such as solving a problem, regulating the flow of work in computer, or controlling or monitoring events. The general description of the computer program listing will appear in the specification while computer program listing may appear either directly or as a microfiche as appendix to the specification and be incorporated into the specification by reference.

DISCUSSION OF THE BACKGROUND AND MAJOR ISSUES INVOLVED

The provisions of 37 CFR 1.52 and 1.84 for submitting specifications and drawings on paper have been found suitable for most patent applications. However, when lengthy computer program listings must be disclosed in a patent application in order to provide a complete disclosure, use of paper copies can become burdensome.

The cost of printing long computer programs in patent documents is also very expensive to the Patent and Trademark Office.

In the past, all disclosures >forming< part of a patent application were presented on paper with the exception of microorganisms. Under >37 CFR<* 1.96, several different methods for submitting computer program listings, including the use of microfiche are set forth.

Relatively short computer program listings (10 pages or less) must be submitted on paper and will be printed as part of the patent. If the computer program listing is 11 or more pages in length, it may be submitted on either paper or microfiche, although microfiche is preferred.

Copies of publicly available computer program listings >are<* available from the Patent and Trademark Office ** on paper >and on microfiche at the cost set forth in 37 CFR 1.19(a)(5) and (6).<**

OTHER INFORMATION

The micrographic standards referred to in >37 CFR<* 1.96(b)(2) may be obtained from either the National Micrographic Association, 8719 Colesville Road, Silver Spring, Maryland, 20910 or the American National Standards Institute, 1430 Broadway, New York, New York 10018.

The effect of >37 CFR<* 1.96 is that if a computer program listing (printout) is 11 or more pages long, the applicant may submit such listing in the form of microfiche. Relatively short computer program listings (10 pages or less) must be submitted on paper and will be printed as part of the patent, as in the past. When the computer program listing is 11 or more pages in length, it may be submitted on either paper or microfiche, although microfiche is preferred. A microfiche filed with a patent application will be referred to as a "Microfiche Appendix," and will be identified as such on the front page of the patent, but will not be part of the printed patent. "Microfiche Appendix," denotes the total microfiche, whether only one, or two or more. One microfiche is equivalent to a maximum of either 63 (9x7) or 98 (14x7) frames (pages), or less.

The face of the file jacket will bear a label to denote that a Microfiche Appendix is included in the application. A statement must be included in the specification to the effect that a microfiche appendix is included in the application. The specification entry must appear at the beginning of the specification immediately following any cross reference to related applications, 37 CFR 1.77(c)(2). The patent front page and the Official Gazette entry will both contain information as to the number of microfiche and frames of computer program listings appearing in the microfiche appendix.

When an application containing microfiche is received in the ** Correspondence >and Mail Division<, a special pocket will be affixed to the center section of the inside of the file wrapper underneath all papers, and the microfiche inserted therein. The application file will then proceed on its normal course, and when it reaches the Application >Branch<, a label which sticks up above the file wrapper will be placed at the center section of the face of the wrapper. When the application file reaches the **>Micrographics< Division, the Microfiche Appendix label will be placed on the face of the file wrapper. When the Allowed Files >and Assembly Branch<* of ** >the Office of Publications< receives the application file, the person placing the patent number on the face of the file, upon seeing the Microfiche Appendix label, will give the file to the Supervisor who will call **>Micrographics< Division and give the serial number and patent number, and request copies of the microfiche. **>Micrographics< Division personnel will then put the patent number on the microfiche(s), making certain each microfiche is the most recent, and numbering each correctly, e.g., 1 of 1, 1 of 2, etc. Upon completion, two copies will be produced and provided to Allowed >and Assembly Branch< Files — one for the grant head and one for the file wrapper.

At the time of assembly, the Microfiche Appendix will be placed inside the grant head behind the patent grant for eyeletting, ribboning, and mailing to the patentee/attorney. During the signing of the grant heads by the Attesting Officer, the patent will be checked to assure proper assembly prior to mailing.

609 Information Disclosure Statement

37 CFR 1.97 Filing of information disclosure statement.

(a) As a means of complying with the duty of disclosure set forth in § 1.56, applicants are encouraged to file an information disclosure statement at the time of filing the application or within the later of three months after the filing date of the application or two months after applicant receives the filing receipt. If filed separately, the disclosure statement should, in addition to the identification of the application, include the Group Art Unit to which the application is assigned as indicated on the filing receipt. The disclosure statement may either be separate from the specification or may be incorporated therein.

(b) A disclosure statement filed in accordance with paragraph (a) of this section shall not be construed as a representation that a search has been made or that no other material information as defined in § 1.56(a) exists.

37 CFR 1.98 Content of information disclosure statement.

(a) Any disclosure statement filed under § 1.97 or § 1.99 shall include: (1) A listing of patents, publications or other information; and (2) A concise explanation of the relevance of each listed item. The disclosure statement shall be accompanied by a copy of each listed patent or publication or other item of information in written form or of at least the portions thereof considered by the person filing the disclosure statement to be pertinent. All United States patents listed should be identified by their patent numbers, patent dates and names of the patentees. Each foreign published application or patent should be cited by identifying the country or office which issued it, the document number and publication date indicated on the document. Each printed publication should be identified by author (if any), title of the publication, pages, date and place of publication.

(b) When two or more patents or publications considered material are substantially identical, a copy of a representative one may be included in the statement and others merely listed. A translation of the pertinent portions of foreign language patents or publications considered material should be transmitted if an existing translation is readily available to the applicant.

37 CFR 1.99 Updating of information disclosure statement.

If prior to issuance of a patent an applicant, pursuant to his or her duty of disclosure under § 1.56, wishes to bring to the attention of the Office additional patents, publications or other information not previously submitted, the additional information should be submitted to the Office with reasonable promptness. It may be included in a supplemental information disclosure statement or may be incorporated into other communications to be considered by the examiner. Any transmittal of additional information shall be accompanied by explanations of relevance and by copies in accordance with the requirements of § 1.98.

*>37 CFR< 1.97 through 1.99 provide an ideal mechanism for complying with the duty of disclosure under 37 CFR 1.56. The statements should be submitted in accordance with the following guidelines:

(1) Information disclosure statements should be submitted at the time of filing the application or within the later of three

months after the filing date of the application or two months after applicant receives the filing receipt so that it is available to the examiner when the first Office action is prepared. If filed separately, the information disclosure statement should include the Group Art Unit to which the application is assigned as indicated on the filing receipt. Information disclosure statements may be separate from the specification or incorporated therein. The statement shall serve as a representation that the person preparing it has included therein what he or she believes to be the closest prior art or other information of which he or she is aware and shall not be construed as a representation that no better art exists or that a search has been made. If the first action in the application is received prior to three months after filing of the application and no information disclosure statement has been submitted, the information disclosure statement may be submitted with the response to the first action and be considered timely.

(2) The statement shall include a listing of the patents, publications or other information which the preparer of the statement wishes to cite and a concise explanation of the relevance of each listed item. Copies of the pertinent portions of all listed documents shall be supplied along with the statement, both when incorporated into the specification and when filed separately. If two or more patents or publications considered material are substantially identical, a copy of a representative one shall be included with the statement and others may merely be listed with an indication *>as to< which are considered to be substantially identical.

Where the applicant has submitted copies of information in accordance with these guidelines in a prior application or the Office has cited the information in applicant's prior application, reference to the submission in the prior application will be sufficient for the continuing application as far as the copies are concerned. As far as the statement per se is concerned, the relevance of the information to the claimed subject matter must be indicated if it differs from its relevance as explained in the prior application.

(3) A translation of the pertinent portions of foreign language patents or publications considered material should be transmitted if an existing translation is readily available to the applicant. It will be sufficient, however, to transmit an equivalent English language patent or publication so long as it is identified as an equivalent.

(4) If prior to the issuance of a patent an applicant, pursuant to his >or her< duty of disclosure under 37 CFR 1.56, wishes to bring to the attention of the Office additional patents, publications or other information not previously submitted, the additional information should be submitted to the Office with reasonable promptness. It may be included in a supplemental information disclosure statement or may be incorporated into other communications to be considered by the examiner. Any transmittal of additional information shall be accompanied by explanations of relevance and by copies in accordance with the requirements aforementioned. The transmittal should include a statement explaining why the information was not earlier submitted. All information disclosure statements submitted in accordance with these guidelines will be considered by the examiner.

Where related or corresponding patent applications have been filed in other countries, information may be cited by the patent offices of those other countries in connection with the examination of the applications filed there. Where information is cited by those other patent offices while the U.S. application is pending, citations which are material to examination in this country and known to any of the individuals covered by >37 CFR<* 1.56 must be called to the attention of this Office.

**>Applicants are advised that< no assurance can be given that cited patents or other information not submitted in accordance with these guidelines will be considered by the examiner.

After the claims have been indicated as allowable by the examiner, e.g., by the mailing of an Ex parte Quayle action, a Notice of Allowability (PTOL-327), an Examiner's Amendment (PTOL-37), or a Notice of Allowance (PTOL-85), any citations submitted will be placed in the file.

Since prosecution has ended, however, such submissions will not ordinarily be considered by the examiner unless the citation is accompanied by:

***(a)* A proposed amendment cancelling or further restricting at least one independent claim and narrowing the scope of protection sought;**

***(b)* A timely affidavit under 37 CFR 1.131 with respect to the material cited; or**

***(c)* A statement by the applicant or his attorney or agent that, in the judgment of the person making the statement, the information cited**

(1) raises a serious question as to the patentability of the claimed subject matter, or

(2) is closer than that of record, or

(3) is material to the examination of the application as defined in 37 CFR 1.56(a) and is filed with an explanation as to why the information disclosure statement was not earlier presented e.g., information recently cited in a corresponding foreign patent application.

≥After all claims have been indicated as allowable, there is no duty on the part of the examiner to consider any citation which does not conform to the listed requirements. <

If the material is submitted for consideration after the issue fee has been paid, it must, in addition to meeting the requirements of the previous paragraph, also be accompanied by a petition under 37 CFR 1.>312(b)<* with appropriate fee >and showing of good and sufficient reasons why the submission was not earlier submitted<. Such a petition, if granted, would result in review of the art by the examiner and possible entry of the material.

>Situations, which arise prior to all the claims being indicated as allowable, require the exercise of discretion as to what submissions, which are not submitted in accordance with 37 CFR 1.97 - 1.99, will be considered. Any transmittal of additional information prior to issuance of a patent (information transmitted after the later of three months after the filing date of the application or two months after receipt of the filing receipt) should include a statement explaining why the information was not earlier submitted. Information submitted late in the prosecution which does not include such an explanatory statement is not

required to be considered by the examiner.<

Where the information disclosure statement is *submitted in conformance* with 37 CFR 1.98 and this section in either the specification or in a separate paper, the examiner must list all the citations on a form PTO-892 which is part of the next regular Office action following receipt of the information disclosure statement if it is not listed on a form PTO-1449. In addition, the appropriate space in the left-hand column >of form PTO-892< must be checked to indicate that a copy of the document is not being furnished. Since the properly cited documents are listed on form PTO-892, there is no need to mark "All checked" or "Checked" in the margin of the specification or in the separate paper containing the citations. In situations where an applicant submits an information disclosure statement which does *not fully* comply with the guidelines of this section, e.g., the statement contains a listing of documents but fails to include an explanation of the relevance of *all* of the listed items or does not include copies of all listed information or some of the items are deficient for other reasons, the examiner must consider and list on the form PTO-892 *each* document which fully complies with the guidelines and treat noncomplying items in accordance with (1) and (2) of the following paragraph. If citations submitted in conformance with 37 CFR 1.98 and this section are reviewed by a supervisor for any purpose and the handling thereof by the examiner is found deficient in the above respects, that supervisor will require correction before the allowance of the application. If the application is sampled in the Quality Review Program after allowance and it is found that the examiner has not listed all of the citations which fully >comply<* with the guidelines on the PTO-892, it will be returned to the examiner, via the group director, for immediate correction. See also >MPEP< §§ 707.05(b) and 717.05, item c2.

Where information disclosure statements >not listed on a form PTO-1449< are *not submitted in conformance* with the guideline in this section, the examiner *must*, for all those documents which have been considered but not listed on the form PTO-892, (1) mark "Checked" and place his or her initials beside each citation or (2) where all the documents cited on a given page have been considered, mark "All checked" and place his or her initials in the left-hand margin beside the citations.

37 CFR 1.98(a) calls only for a concise explanation of the relevance of each listed item. This may be nothing more than identification of the particular figure or paragraph of the patent or publication which has some relation to the claimed invention. It might be a simple statement pointing to similarities between the item of information and the claimed invention. It is permissible but not necessary to discuss differences between the cited information and the claims. It is thought that the explanation of relevance will be useful to the examiner and should not be significantly burdensome for the applicant to prepare. A statement to the effect that an item is listed because it was cited during the prosecution of a counterpart foreign application and is not considered material to the examination of the U.S. application is to be considered as satisfying the concise explanation requirement of 37 CFR 1.98(a).

>37 CFR<*1.98 requires a copy of each patent or publication cited, including U.S. patents, or of at least the portions thereof considered to be pertinent (>37 CFR<* 1.98(a)) to accompany the information disclosure statement. Substantial time and effort often is needed to locate a document in the Office's files. Since the person submitting the information disclosure statement generally has available a copy of the item being cited, it is believed that expense and effort can be minimized by having that person supply the copy in all cases.

>Submissions that are expressly made as material information under 37 CFR 1.56 must be accompanied by a copy of each foreign patent document, non-patent publication or other non-patent item of information in written form or by a statement that the copy is not in the possession of the person making the disclosure. Pursuant to 37 CFR 1.56(j), applicant will be given a period of time within which to file any omitted copy or statement. This procedure should be followed if the submission is made before the claims are allowed or if the requirements set out above are met after the claims are allowed.

If the cited foreign art cited in the specification is not readily available to the examiner, applicant may be requested to provide a copy by using form paragraph 6.50.

¶ 6.50 Citation of foreign art

To insure proper consideration, applicant should provide the examiner with a copy of the foreign art cited in the specification because it is not readily available to the examiner.<

INFORMATION CITED ON FORM PTO-1449

Applicants, patent owners, reexamination requesters, protesters and others are encouraged to use form PTO-1449, "Information Disclosure Citation," when preparing a statement under 37 CFR 1.97-1.99. A copy of the form is reproduced in this section to indicate how the form should be completed. This form will enable persons to provide the Office with a uniform listing of citations.

While the filing of information disclosure statements is voluntary, the procedure is governed by the guidelines of this Section and 37 CFR 1.97 through 1.99. To be considered a proper information disclosure statement, form PTO-1449 must be accompanied by an explanation of relevance of each listed item, a copy of each listed patent or publication or other item of information and a translation of the pertinent portions of foreign documents (if an existing translation is readily available to the applicant) (37 CFR 1.98(a)), and should be submitted in a timely manner. **

Examiners must consider all citations submitted in conformance with 37 CFR 1.98 and this section and place their initials adjacent the citations in the boxes provided on the form. Examiners should also initial citations not in conformance with the guidelines which may have been considered. A citation may be considered by the examiner for any reason whether or not the citation is in full conformance with the guidelines. A line should be drawn through a citation if it is not in conformance with the guidelines *and* has not been considered. A copy of the submitted form, as reviewed by the examiner, should be returned to the applicant with the next communication. The original copy of the form will be entered into the application file together with any

Sheet 1 of 4

Form PTO-1449 (REV. 8-83) U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE

INFORMATION DISCLOSURE CITATION

(Use several sheets if necessary)

ATTY. DOCKET NO.	SERIAL NO.
32210	967,858
APPLICANT C. Benson, et al	
FILING DATE 6-15-79	**GROUP** 340

U.S. PATENT DOCUMENTS

*EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
JOE		3 7 0 3 3 4 4	11-72	Tew	418	61	
JOE		3 7 0 3 3 4 4	07-74	Reirter	----------		
JOE		3 7 0 3 3 4 4	10-76	Sarich	418	61	
		~~3 7 9 8 7 1 2~~	~~08-76~~	~~Wolfe~~	~~418~~	~~63~~	

FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION YES	TRANSLATION NO
		~~2 28 5 4 6~~	~~06-75~~	~~France~~				
JOE		1 1 37 7 2 9	06-65	Federal Rep. of Germany	418	63	X	
JOE		9 1 4 1	08-79	European Pat. Office				
JOE		WO 80/01871	09-80	PCT International				
JOE		5 0 - 3 1 0 6	11-79	Japan	260	424		X

OTHER DOCUMENTS *(Including Author, Title, Date, Pertinent Pages, Etc.)*

JOE Kovach, et al, "Simple Precision RC Oscillator," IBM Tech. Disclosure Bulletin, Vol. 16, No. 10, 3/74-p.p. 3174-3175

~~Tiers, J. Am. Chem. Soc. 825513 (1960)~~

EXAMINER	DATE CONSIDERED
J. R. Edwards	May 27, 1987

*EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

PTO-892 form, on top of the center portion of the file. The copy returned to applicant will serve both as an acknowledgment of receipt of the information disclosure statement and as an indication of which references, if any, were considered by the examiner.

Each citation on form PTO-1449 initialed by the examiner will be printed on the issued patent in the same manner as documents cited by the examiner on form PTO-892 >and therefore the examiner should complete all the information on form PTO-1449 if it has not been correctly completed as submitted. If the information as to class and subclass is not indicated by the applicant, the examiner should either insert the relevant classification information or place a line in the space provided for classification information<.

Forms PTO-326 and PTOL-37 have been revised and now include a box to indicate the attachment of Form PTO-1449.

>Where an information disclosure statement or citation of prior art is received in a pending application and the examiner finds that such disclosure statement or citation is not proper under the guidelines and rules referred to above, the examiner will place the paper containing the disclosure statement or citation in the record in the application file, but need not consider the improperly cited information nor mark "checked" beside the citation. The examiner will inform applicant that the information has not been considered by using form paragraph 6.49. If the citation appears as a part of another paper, e.g., an amendment, which may be properl;y entered and considered, the portion of the paper which is proper for consideration will be considered.<

¶ 6.49 Information Disclosure Statement Not Considered.

The information disclosure statement filed [1] fails to comply with the provisions of MPEP 609 because [2]. It has been placed in the application file, but the information referred to therein has not been considered as to the merits and will not be cited on the patent as a result of this information disclosure statement or prior art citation. Applicant is advised that the filing of the above-noted paper may not satisfy the duty of disclosure requirement of 37 CFR 1.56 insofar as any material information is referenced in the above-noted paper.

Examiner Note:

1. See MPEP 609 for situations where use of this paragraph would be appropriate.

2. For information disclosure statements filed after payment of the issue fee that lack either the petition or fee required under 37 CFR 1.312(b), use form paragraph 13.09 instead of this paragraph.

>620.06 Correction of File Wrapper Label [R-8]

It is sometimes necessary to return applications to the Application Branch for correction of the file wrapper label. Instances where such a return is necessary include:

1. Correction of Inventorship such as changes in the order of the names or a change in the name of an inventor, granted by petition, and additions or deletions of inventors under 37 CFR 1.48.

2. Correction of the Filing Date.

3. Correction concerning prior U.S. applications which have serial number errors. See MPEP § 202.02

4. Correction of application type, for example, where an application is filed under 37 CFR 1.60 but is not shown as such on the file wrapper.

The application must be sent to the Application Branch for correction of the file wrapper label and should be accompanied by an Application Branch Data Base Routing Slip with an explanation of the correction to be made.

All other corrections are performed in the examining group. For example, changes to the title, power of attorney, and correspondence address.<