

MANUAL OF
PATENT
EXAMINING
PROCEDURE

3RD EDITION

Rev. 48



U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

REEL NUMBER 2

BOOK NUMBERS 57

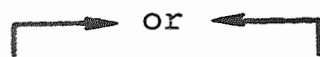
U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office
Washington, D. C. 20231

MANUAL OF PATENT EXAMINING PROCEDURE
Third Edition

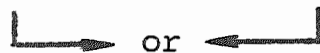
Instructions regarding Revision No. 48

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

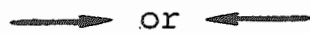
Arrows are printed in the margin of pages to indicate material changed, deleted, or added by this revision. Where insertion of new material results in shifting of unchanged material onto following pages, no arrows appear on such pages but the revision number is cited at the bottom of each page.



Line on which change begins.



Line on which change ends.



Line on which change both begins and ends.



Opposite a blank space, indicates deletion of material.

The notation "(R-48)" in the attached pages appears either at the title or at the end of a section that has been revised.

Louis O. Maassel
Editor, Manual of Patent
Examining Procedure

Particular attention is called to the following sections:

<u>Section</u>	<u>Change</u>
All	All rule citations are being changed to 37 Code of Federal Regulations designations.
102	New sub-section on status location information for Office personnel.
103	New sub-section on accessibility of non-final interference discovery opinions.
108 & 706.03(b)	Reference to ERDA added.
706.02 & 706.03(s)	35 U.S.C. 102(d) updated.
706.03(e)	Citation of In re Hughes added.
706.07(a)	Final rejection practice clarified.
707	Copies of revised forms PTOL-326 and PTO-1142 included.
707.05	Procedure added for citation of art from parent case where no art is cited in the continuing case. Revised form PTO-892 also includes revised procedure for citing a Defensive Publication and examples of citing a TVPP application and a Design Reissue.
1002.02(n)	New section relating to Board of Appeals clerk deciding petitions under 37 CFR 1.304.
1003	Item 15 amended to require director stamping of all copies of examiner's answers with new grounds. Item 19 added relating to withdrawal of appeal in a remanded case.
1004	A new item added requiring a primary examiner to sign a second action involving a previous restriction in a Markush-type claim.
1101.01	Exception added to 6 month filing date difference for interference is where the junior party has an earlier foreign filing date.
1216	Change in 37 CFR 1.304 added.

<u>Section</u>	<u>Change</u>
1308.03	Procedure for reopening prosecution of an application as a result of the Quality Review Program added.
1401	Note added that filing fee for a design re-issue application is 65 dollars.
1401.06	Note added as to handling of a certificate of correction in a reissue application.
1401.11	Note added on not renumbering patent claims in a reissue application.

List of replacement pages:

<u>Page No.</u>	<u>Rev. No.</u>	<u>Page No.</u>	<u>Rev. No.</u>
Title Page	48-48	140.1	48
3-4	48-48	162.1-162.2	48-48
4.1-4.2	48-48	162.3	48
4.3-4.4	48-48	163-164	48-48
5-6	48-48	165-166	48-48
66.1-66.2	48-48	166.1	48
67-68	34-48	183-184	48-48
69-70	48-48	220.1-220.2	48-48
70.1-70.2	48-48	220.3-220.4	48-48
71-72	48-48	220.5-220.6	48-48
72.1-72.2	48-48	220.7-220.8	48-48
75-76	48-48	227-228	48-48
76.1-76.2	48-48	228.1-228.2	48-48
76.3-76.4	48-48	*228.3	48
76.5-76.6	48-48	229-230	48-48
77-78	48-48	231-232	48-48
139-140	48-48	232.1	48

*Added page

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

Original Third Edition, dated November 1961

Latest Revision April 1976



U.S. DEPARTMENT OF COMMERCE • PATENT AND TRADEMARK OFFICE

Rev. 48, Apr. 1976

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

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

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

Inquiries relating to subscriptions should be directed to:

Superintendent of Documents
Customer's Service Department
P.O. Box 1533
Washington, D.C. 20013

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

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

The cost per page will be 30¢ (see 37 CFR 1.13(a), 1.21(b) and 1.21(t)).

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

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

First Edition, November 1949
Revision 1, November 1950
Revision 2, December 1951
Revision 3, May 1952
Second Edition, November 1953
Revision 1, April 1955
Revision 2, June 1956
Revision 3, June 1957
Revision 4, July 1958
Third Edition, November 1961
Revision 1, January 1964
Revision 2, November 1964
Revision 3, January 1965
Revision 4, April 1965
Revision 5, July 1965
Revision 6, October 1965
Revision 7, January 1966
Revision 8, April 1966
Revision 9, July 1966
Revision 10, October 1966
Revision 11, January 1967
Revision 12, April 1967
Revision 13, July 1967
Revision 14, October 1967
Revision 15, January 1968
Revision 16, April 1968
Revision 17, July 1968
Revision 18, October 1968
Revision 19, January 1969

Revision 20, April 1969
Revision 21, July 1969
Revision 22, October 1969
Revision 23, January 1970
Revision 24, April 1970
Revision 25, July 1970
Revision 26, October 1970
Revision 27, January 1971
Revision 28, April 1971
Revision 29, July 1971
Revision 30, October 1971
Revision 31, January 1972
Revision 32, April 1972
Revision 33, July 1972
Revision 34, October 1972
Revision 35, January 1973
Revision 36, April 1973
Revision 37, July 1973
Revision 38, October 1973
Revision 39, January 1974
Revision 40, April 1974
Revision 41, July 1974
Revision 42, October 1974
Revision 43, January 1975
Revision 44, April 1975
Revision 45, July 1975
Revision 46, October 1975
Revision 47, January 1976
Revision 48, April 1976

Foreword

This Manual is published to provide Patent and Trademark Office patent examiners, applicants, attorneys, agents, and representatives of applicants with a reference work on the practices and procedures relative to the prosecution of patent applications before the Patent and Trademark Office. It contains instructions to examiners, as well as other material in the nature of information and interpretation, and outlines the current procedures which the examiners are required or authorized to follow in appropriate cases in the normal examination of a patent application.

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

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

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

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

Commissioner of Patents and Trademarks,
Editor, M.P.E.P.
Washington, D.C. 20231

Contents

	Page
Checklist of Pages.....	vi
Introduction.....	1
Chapter 100 Secrecy and Access.....	3
200 Types, Cross-Noting, and Status of Applications.....	7
300 Ownership and Assignment.....	21
400 Representative of Inventor or Owner.....	23
500 Receipt and Handling of Mail and Papers.....	31
600 Parts, Form and Content of Application.....	33
700 Examination of Applications.....	61
800 Restriction; Double Patenting.....	117
900 Prior Art, Classification, Search.....	137
1000 Matters Decided by Various Patent and Trademark Office Officials.....	159 ←
1100 Interference.....	163
1200 Appeal.....	209
1300 Allowance and Issue.....	221
1400 Correction of Patents.....	229
1500 Design Patents.....	235
1600 Plant Patents.....	239
1700 Miscellaneous.....	243
Appendix I Partial List of Trademarks.....	247
Appendix II List of Decisions Cited.....	253
Index.....	257

Checklist of Pages Needed To Form a Complete Set of the Third Edition as of Revision 46.

DATES OF REVISIONS 31 and 33-46

All pages issued in other revisions have been revised.

Rev. No.	Date	Rev. No.	Date
31	Jan. 1972	40	Apr. 1974
33	July 1972	41	July 1974
34	Oct. 1972	42	Oct. 1974
35	Jan. 1973	43	Jan. 1975
36	Apr. 1973	44	Apr. 1975
37	July 1973	45	July 1975
38	Oct. 1973	46	Oct. 1975
39	Jan. 1974		

Page	Revision No.	Page	Revision No.
Title Page (2 sides)	46-46	49-50	38-40
III	33	51-52	40-40
V-VI	46-46	52.1	40
VII	46	53-54	41-41
Introduction		54.1	41
1-2	41-41	55-56	44-44
Chapter 100		56.1	44
3-4	35-39	57-58	36-36
4.1-4.2	39-42	59-60	37-37
4.3	39	Chapter 700	
5-6	42-42	61-62	37-43
Chapter 200		63-64	43-43
7-8	39-39	64.1	43
9-10	39-40	65-66	31-33
10.1-10.2	39-39	66.1-66.2	34-34
10.3-10.4	41-41	67-68	34-34
11-12	46-46	69-70	40-40
13-14	46-46	70.1-70.2	40-40
14.1-14.2	46-46	71-72	40-40
15-16	39-39	72.1-72.2	40-40
16.1-16.2	43-39	73-74	34-32
17-18	31-36	74.1	34
19-20	44-44	75-76	43-43
20.1	44	76.1-76.2	43-43
Chapter 300		76.3-76.4	43-43
21-22	43-43	76.5	43
22.1	43	77-78	42-42
Chapter 400		78.1-78.2	45-45
23-24	46-46	79-80	45-45
25-26	41-41	81-82	36-36
27-28	37-37	83-84	36-31
29-30	37-37	85-86	31-31
30.1-30.2	37-37	87-88	39-39
30.3	37	88.1	39
Chapter 500		89-90	34-34
31-32	45-45	90.1-90.2	34-34
32.1-32.2	45-45	90.3	34
32.3-32.4	45-45	91-92	45-45
32.5-32.6	46-46	92.1	45
Chapter 600		93-94	45-45
33-34	45-45	94.1-94.2	45-45
34.1-34.2	44-45	94.3	45
34.3	45	95-96	37-37
35-36	44-44	96.1-96.2	41-41
37-38	31-31	97-98	46-46
38.1	31	98.1	43
39-40	35-35	99-100	36-39
41-42	35-35	101-102	39-39
43-44	46-46	102.1-102.2	39-36
44.1-44.2	46-46	102.3	39
45-46	41-41	103-104	41-41
46.1	44	105-106	41-41
47-48	38-38	106.1	41
48.1-48.2	38-38	107-108	35-35
48.3-48.4	39-39	108.1	35
48.5	39	109-110	34-42
		111-112	44-44
		112.1	44
		113-114	40-40
		115-116	42-42

Page	Revision No.	Page	Revision No.
116.1-116.2	42-43	Chapter 1200	
116.3-116.4	43-43	209-210	43-43
Chapter 800		211-212	41-41
117-118	45-45	213-214	42-42
119-120	45-45	214.1	42
120.1-120.2	45-45	215-216	42-42
120.3	45	216.1	46
121-122	45-45	217-218	46-46
123-124	45-45	218.1	46
125-126	45-45	219-220	46-28
127-128	45-45	220.1-220.2	46-46
129-130	45-45	220.3-220.4	46-46
131	45	220.5-220.6	46-46
133-134	45-45	220.7-220.8	46-46
135-136	45-38	Chapter 1300	
Chapter 900		221-222	46-46
137-138	35-35	222.1	46
138.1-138.2	35-35	223-224	41-41
139-140	44-44	225-226	41-41
140.1	44	226.1	41
141-142	45-30	227-228	43-43
143-144	45-45	228.1-228.2	43-43
145-146	46-46	Chapter 1400	
147-148	46-46	229-230	41-41
149	46	223-232	41-41
151-152	46-46	132.1	41
152.1	46	233-234	44-44
153-154	35-35	234.1-234.2	44-44
154.1-154.2	43-43	Chapter 1500	
154.3-154.4	43-43	235-236	35-35
155-156	36-46	237-238	35-46
157-158	46-46	Chapter 1600	
Chapter 1000		239-240	45-45
159-160	43-43	241-242	31-45
161-162	43-43	Chapter 1700	
162.1-162.2	43-43	243-244	40-40
162.3	43	244.1-244.2	46-46
Chapter 1100		244.3	46
163-164	31-31	245-246	46-46
165-166	33-33	246.1-246.2	46-46
166.1	33	Appendix I	
167-168	42-42	247-248	43-43
169-170	46-46	249-250	43-43
170.1	46	251	43
171-172	40-45	Appendix II	
172.1	45	253-254	36-36
173-174	40-40	255-256	36-36
174.1	43	Index	
175-176	36-40	257-258	44-44
176.1-176.2	43-43	259-260	44-44
177-178	42-42	261-262	44-44
179-180	42-42	263-264	44-44
181-182	45-45	265-266	44-44
182.1	45	267-268	44-44
183-184	40-40	269-270	44-44
185-186	43-43	271-272	44-44
186.1	43	273-274	44-44
187-188	31-31	275-276	44-44
189	40	277-278	44-44
191-192	omitted	279-280	44-44
193-194	40-40	281-282	44-44
194.1	40	283-284	44-44
195-196	38-38	285-286	44-44
197-198	38-38	287-288	44-44
199-200	37-37	289-290	44-44
201-202	42-42	291-292	44-44
203-204	35-35	293-294	44-44
205-206	omitted	295	44
207-208	omitted		

Introduction

Constitutional Basis

The Constitution of the United States provides:

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

Statutes

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

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

By an Act of Congress approved July 19, 1952, which came into effect on January 1, 1953, the patent laws were revised and codified into their present form. With certain exceptions applying to applications filed and patents issued before January 1, 1953, this law governs all cases in the Patent Office. The patent law is Title 35 of the United States Code, which contains 96 sections numbered from 1 to 293, with gaps in the numbering between various chapters of the title. In referring to a particular section of the patent code the citation is given, for example, as, 35 U.S.C. 31. The pamphlet "Patent Laws" (available from the Superintendent of Documents for 75 cents) reprints the patent code and some additional statutes.

35 U.S.C. 1 Establishment. The Patent Office shall continue as an office in the Department of Commerce, where records, books, drawings, specifications, and other papers and things pertaining to patents and to trademark registrations shall be kept and preserved, except as otherwise provided by law.

Rules of Practice

One of the sections of the patent statute, namely, 35 U.S.C. 6, authorizes the Commissioner of Patents, subject to the approval of the Secretary of Commerce, to establish regula-

tions, not inconsistent with law, for the conduct of proceedings in the Patent Office.

Rule 351. Amendments to rules will be published. All amendments to these rules will be published in the Official Gazette and in the Federal Register.

Rule 352. Publication of notice of proposed amendments. (a) Whenever required by law, and in other cases whenever practicable, notice of proposed amendments to these rules will be published in the Official Gazette and in the Federal Register. If not published with the notice, copies of the text will be furnished to any person requesting the same. All comments, suggestions, and briefs received within a time specified in the notice will be considered before adoption of the proposed amendments which may be modified in the light thereof.

(b) Oral hearings may be held at the discretion of the Commissioner.

These rules and the various amendments were published in the Federal Register. In the Federal Register and in the Code of Federal Regulations these rules are Part 1 of Title 37, Patents, Trademarks and Copyrights, and the individual rules, there called sections, are numbered with the Part number and a decimal point prefixed to the numbers to the rule number; thus section 1.33 in the Federal Register and the Code of Federal Regulations is the same as rule 33. A booklet entitled "37 Code of Federal Regulations," published by the Office of the Federal Register, contains all of the patent rules and forms, as well as trademark rules and forms and copyright rules. Persons desiring a copy of the patent rules should order a copy of "37 Code of Federal Regulations" from the Superintendent of Documents.

The primary function of the Rules of Practice is to advise the public of the regulations which have been established in accordance with the statutes and which must be followed before the Office. The Rules of Practice govern the examiners, as well as applicants and their attorneys.

Commissioner's Orders and Notices

From time to time, the Commissioner of Patents has issued Orders and Notices relating to various specific situations that have arisen in operating the Patent Office. Notices and circulars of information or instructions have also been issued by other Office Officials under authority of the Commissioner. Orders and

Notices have served various purposes including directions to the examiners giving them instruction, information, interpretations and the like. Some may be for the information of the public, advising what the Office will do under specified circumstances.

Decisions

In addition to the statutory regulations, the actions taken by the examiner in the examination of applications for patents are to a great extent governed by decisions on prior cases. Applicants dissatisfied with an examiner's action may have it reviewed. In general, that portion of the examiner's action pertaining to objections on formal matters may be reviewed by petition to the Commissioner of Patents (see § 1002) and that portion of the examiner's action pertaining to the rejection of claims on the merits, may be reviewed by appeal to the Board of Appeals (see § 1201). The distinction is set forth in rules 181 and 191. In citing decisions as authority for his actions, the examiner should cite the decision in the manner set forth in § 707.06.

Publications Available from Superintendent of Documents

Orders should be addressed and remittances made payable to Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

Patent Official Gazette. The official journal of the Patent Office relating to patents. Issued each Tuesday, simultaneously with the weekly issuance of patents, it contains a selected figure of the drawings and an abstract of each patent granted, indexes of patents, list of patents available for license or sale, and general information such as orders, notices, changes in rules, and changes in classification. Annual subscription \$211.00 (\$52.75 additional for foreign mailing). Single copy \$4.10.

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

Guide for Patent Draftsmen. Patent Office requirements for patent drawings with illustrations. Price 30 cents.

Manual of Classification. A loose-leaf volume listing the numbers and descriptive titles of the more than 300 classes and 66,000 subclasses used in the subject classification of patents, with an index to the classifications. Substitute and additional pages, which are included in the subscription service, are issued from

time to time. Subscription \$30.50 (\$7.75 additional for foreign mailing).

Manual of Patent Examining Procedure. A loose-leaf manual which serves primarily as a detailed reference work on patent examining practice and procedure for the Patent Office's Examining Corps. Subscription service includes basic manual, quarterly revisions, and change notices. Subscription \$19.50 (\$5.00 additional for foreign mailing).

Patents and Inventions—An Information Aid to Inventors. The purpose of this publication is to aid inventors in deciding whether to apply for patents, in obtaining patent protection, and in promoting their inventions. Price 20 cents.

Patents: Spur to American Progress. Focuses on the functioning of the patent system, outlining its purpose and practices and charting the "how-to" path to patents. It illustrates how the system nurtures discovery of data and devices on which the American partnership of inventor, industry, and the public builds prosperity. This publication is one of the U.S. Department of Commerce's "Know Your Economic ABC's" series. Price 35 cents.

The Story of the United States Patent Office. Cites important events in the development of the United States patent system and lists chronologically inventions having important effects on the economy. Price 35 cents.

Patent Laws. Compilation of patent laws in force. Price 75 cents.

Patent Attorneys and Agents Registered to Practice Before The U.S. Patent Office. An alphabetically and a geographically arranged listing of patent attorneys and agents registered to practice before the U.S. Patent Office. Price \$2.85.

Publications Available From the Patent Office

Orders should be addressed to U.S. Department of Commerce, Patent Office, Washington, D.C. 20231. Remittances should be made payable to Commissioner of Patents. Postage stamps, Superintendent of Documents coupons or other Government coupons are not acceptable in payment of Patent Office fees.

Q & A About Patents. Brief, non-technical answers to questions most frequently asked about patents. Free.

Q & A About Plant Patents. Same as above for plant patents. Free.

General Information Concerning Patents. Contains a vast amount of general information concerning the application for and granting of patents, expressed in non-technical language for the layman. Single copy free. Multiple copies available from Superintendent of Documents, 45 cents each.

Patents. Copies of the specification and drawings of all patents are available at 50 cents each, except design patents. Design patents are 20 cents each. When ordering, identify the patent by the patent number, or give full name of the inventor and approximate date of issuance of the patent.

Classification Definitions. Contain the changes in classification of patents as well as definitions of new and revised classes and sub-classes. Price is based upon size of publication, minimum price 10 cents.

Weekly Class Sheets. Lists showing classification of each patent in the weekly issue of the *Patent Official Gazette*. Annual subscription, \$5.