

MANUAL OF  
**PATENT**  
**EXAMINING**  
**PROCEDURE**

3<sup>RD</sup> EDITION

Rev. 50



U.S. DEPARTMENT OF COMMERCE  
Patent and Trademark Office

REEL NUMBER 2

BOOK NUMBERS 72

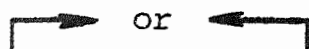
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MANUAL OF PATENT EXAMINING PROCEDURE  
Third Edition

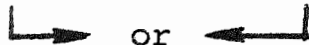
Instructions regarding Revision No. 50

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.



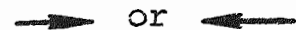
Line on which change begins.



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Opposite a blank space, indicates deletion of material.

The notation "[R-50]" 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>   |
|----------------|---|
| pages VI & VII | Updated checklist of pages.   |
| 402            | New procedure for changing power of attorney in a plurality of applications added.      |
| 502            | Paragraph relating to Issue Batch Numbers added.  |
| 510            | Matter on use of Public Search Room added.  |
| 512            | New section on Certificate of Mailing Practice added.                                   |
| 601.03         | New procedure for changing correspondence address in a plurality of applications added. |
| 707.05(a)      | Revised procedures for preparing and mailing copies of cited references added.          |
| 1401           | Citation of In Re Rowand added.   |
| 1401.04        | Procedure for transferring original patent between reissue applications added.          |
| 1403           | Section on disclaimers expanded.  |
| 1504           | Procedure for dealing with offensive matter in design applications added.               |
| Appendix I     | Trademarks, Aerojet, Butterfly, Dictaphone, Multigraph, Pyroceram and Wire-Wrap added.  |

| <u>Page No.</u> | <u>Rev. No.</u> | <u>Page No.</u> | <u>Rev. No.</u> |
|-----------------|-----------------|-----------------|-----------------|
| Title Page      | 50-50           | 78.1-78.2       | 50-50           |
| V-VI            | 46-50           | 81-82           | 50-50           |
| VII             | 50              | 85-86           | 50-50           |
| 23-24           | 50-50           | 125-126         | 50-50           |
| *24.1           | 50              | 203-204         | 50-35           |
| 31-32           | 50-50           | 217-218         | 50-50           |
| 32.1-32.2       | 50-50           | 218.1           | 50              |
| 32.3-32.4       | 47-50           | 229-230         | 50-50           |
| 32.5-32.6       | 50-50           | 231-232         | 48-50           |
| 32.7-32.8       | 50-50           | 232.1           | 50              |
| *32.9           | 50              | 233-234         | 50-50           |
| 34.1-34.2       | 50-50           | 234.1-234.2     | 50-50           |
| 34.3            | 50              | *234.3          | 50              |
| 45-46           | 50-50           | 235-236         | 50-50           |
| 46.1            | 50              | 237-238         | 50-50           |
| 47-48           | 50-50           | 247-248         | 50-50           |
| 48.1-48.2       | 50-50           | 249-250         | 50-50           |
| 48.3-48.4       | 50-50           | 251             | 50              |
| 48.5            | 50              |                 |                 |

\*Added page

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# MANUAL OF PATENT EXAMINING PROCEDURE

Original Third Edition, dated November 1961

Latest Revision October 1976



U.S. DEPARTMENT OF COMMERCE

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Rev. 50, Oct. 1976

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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  
Revision 49, July 1976  
Revision 50, October 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

DATE OF REVISIONS 30-30

All pages listed in other revisions have been revised

| Date      | Page | Date      |
|-----------|------|-----------|
| Jan 1975  | 43   | Jan 1975  |
| Apr 1975  | 44   | Apr 1975  |
| July 1975 | 45   | July 1975 |
| Oct 1975  | 46   | Oct 1975  |
| Jan 1976  | 47   | Jan 1976  |
| Apr 1976  | 48   | Apr 1976  |
| July 1976 | 49   | July 1976 |
| Oct 1976  | 50   | Oct 1976  |

# 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<br>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 50.

## DATES OF REVISIONS 35-50

All pages issued in other revisions have been revised.

| Rev. No. | Date      | Rev. No. | Date      |
|----------|-----------|----------|-----------|
| 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 | 47       | Jan. 1976 |
| 40       | Apr. 1974 | 48       | Apr. 1976 |
| 41       | July 1974 | 49       | July 1976 |
| 42       | Oct. 1974 | 50       | Oct. 1976 |

| Page                 | Revision No. | Page        | Revision No. |
|----------------------|--------------|-------------|--------------|
| Title Page (2 sides) | 50-50        | 48.3-48.4   | 50-50        |
| III                  | 47           | 48.5        | 50           |
| V-VI                 | 46-50        | 49-50       | 38-40        |
| VII                  | 50           | 51-52       | 40-40        |
| Introduction         |              | 52.1        | 40           |
| 1-2                  | 49-49        | 53-54       | 41-41        |
| Chapter 100          |              | 54.1        | 41           |
| 3-4                  | 48-48        | 55-56       | 44-44        |
| 4.1-4.2              | 48-48        | 56.1        | 44           |
| 4.3-4.4              | 48-48        | 57-58       | 36-36        |
| 5-6                  | 48-48        | 59-60       | 37-37        |
| Chapter 200          |              | Chapter 700 |              |
| 7-8                  | 49-49        | 61-62       | 37-43        |
| 9-10                 | 49-49        | 63-64       | 43-43        |
| 10.1-10.2            | 49-49        | 64.1        | 43           |
| 10.3-10.4            | 49-49        | 65-66       | 49-49        |
| 11-12                | 46-46        | 66.1-66.2   | 49-49        |
| 13-14                | 46-46        | 66.3        | 49           |
| 14.1-14.2            | 46-46        | 67-68       | 34-48        |
| 15-16                | 49-49        | 69-70       | 48-48        |
| 16.1-16.2            | 49-49        | 70.1-70.2   | 48-48        |
| 17-18                | 31-36        | 71-72       | 48-48        |
| 19-20                | 44-44        | 72.1-72.2   | 48-48        |
| 20.1                 | 44           | 73-74       | 49-49        |
| Chapter 300          |              | 74.1        | 49           |
| 21-22                | 47-47        | 75-76       | 48-48        |
| 22.1                 | 47           | 76.1-76.2   | 48-48        |
| Chapter 400          |              | 76.3-76.4   | 49-49        |
| 23-24                | 50-50        | 76.5-76.6   | 48-48        |
| 24.1                 | 50           | 77-78       | 48-48        |
| 25-26                | 47-49        | 78.1-78.2   | 50-50        |
| 27-28                | 47-47        | 79-80       | 49-49        |
| 29-30                | 49-49        | 81-82       | 50-50        |
| 30.1-30.2            | 49-49        | 83-84       | 36-31        |
| 30.3                 | 49           | 85-86       | 50-50        |
| Chapter 500          |              | 87-88       | 39-39        |
| 31-32                | 50-50        | 88.1        | 39           |
| 32.1-32.2            | 50-50        | 89-90       | 47-47        |
| 32.3-32.4            | 47-50        | 90.1-90.2   | 47-47        |
| 32.5-32.6            | 50-50        | 90.3-90.4   | 47-47        |
| 32.7-32.8            | 50-50        | 91-92       | 45-45        |
| 32.9                 | 50           | 92.1        | 45           |
| Chapter 600          |              | 93-94       | 45-45        |
| 33-34                | 45-45        | 94.1-94.2   | 45-45        |
| 34.1-34.2            | 50-50        | 94.3        | 45           |
| 34.3                 | 50           | 95-96       | 49-49        |
| 35-36                | 44-44        | 96.1-96.2   | 49-49        |
| 37-38                | 49-49        | 97-98       | 46-46        |
| 38.1                 | 49           | 98.1        | 43           |
| 39-40                | 35-35        | 99-100      | 49-49        |
| 41-42                | 49-49        | 101-102     | 39-39        |
| 43-44                | 46-46        | 102.1-102.2 | 47-47        |
| 44.1-44.2            | 47-47        | 102.3       | 47           |
| 45-46                | 50-50        | 103-104     | 41-41        |
| 46.1                 | 50           | 105-106     | 41-41        |
| 47-48                | 50-50        | 106.1       | 41           |
| 48.1-48.2            | 50-50        | 107-108     | 35-35        |
|                      |              | 108.1       | 49           |
|                      |              | 109-110     | 34-42        |
|                      |              | 111-112     | 44-44        |
|                      |              | 112.1       | 44           |

| Page         | Revision No. | Page         | Revision No. |
|--------------|--------------|--------------|--------------|
| 113-114      | 40-40        | Chapter 1200 |              |
| 115-116      | 42-42        | 209-210      | 43-43        |
| 116.1-116.2  | 42-43        | 211-212      | 41-41        |
| 116.3-116.4  | 43-43        | 213-214      | 42-42        |
| Chapter 800  |              | 214.1        | 49           |
| 117-118      | 45-45        | 215-216      | 42-42        |
| 119-120      | 45-45        | 216.1        | 46           |
| 120.1-120.2  | 45-45        | 217-218      | 50-50        |
| 120.3        | 45           | 218.1        | 50           |
| 121-122      | 45-45        | 219-220      | 47-47        |
| 123-124      | 45-45        | 220.1-220.2  | 48-48        |
| 125-126      | 50-50        | 220.3-220.4  | 48-48        |
| 127-128      | 45-45        | 220.5-220.6  | 48-48        |
| 129-130      | 45-45        | 220.7-220.8  | 48-48        |
| 131          | 45           | Chapter 1300 |              |
| 133-134      | 45-45        | 221-222      | 46-46        |
| 135-136      | 45-38        | 222.1        | 46           |
| Chapter 900  |              | 223-224      | 47-47        |
| 137-138      | 35-35        | 225-226      | 47-47        |
| 138.1-138.2  | 35-35        | 226.1        | 47           |
| 139-140      | 48-48        | 227-228      | 48-48        |
| 140.1        | 48           | 228.1-228.2  | 48-48        |
| 141-142      | 45-30        | 228.3        | 48           |
| 143-144      | 45-45        | Chapter 1400 |              |
| 145-146      | 46-46        | 229-230      | 50-50        |
| 147-148      | 46-46        | 231-232      | 48-50        |
| 149          | 46           | 232.1        | 50           |
| 151-152      | 46-46        | 233-234      | 50-50        |
| 152.1        | 46           | 234.1-234.2  | 50-50        |
| 153-154      | 35-35        | 234.3        | 50           |
| 154.1-154.2  | 43-43        | Chapter 1500 |              |
| 154.3-154.4  | 43-43        | 235-236      | 50-50        |
| 155-156      | 36-46        | 237-238      | 50-50        |
| 157-158      | 46-46        | 234.3        | 50           |
| Chapter 1000 |              | Chapter 1600 |              |
| 159-160      | 43-43        | 239-240      | 45-47        |
| 161-162      | 43-43        | 241-242      | 31-45        |
| 162.1-162.2  | 48-48        | Chapter 1700 |              |
| 162.3        | 48           | 243-244      | 49-49        |
| Chapter 1100 |              | 244.1-244.2  | 49-49        |
| 163-164      | 48-48        | 244.3        | 46           |
| 165-166      | 48-48        | 245-246      | 46-46        |
| 166.1        | 48           | 246.1-246.2  | 46-46        |
| 167-168      | 42-42        | Appendix I   |              |
| 169-170      | 46-46        | 247-248      | 50-50        |
| 170.1        | 46           | 249-250      | 50-50        |
| 171-172      | 40-45        | 251          | 50           |
| 172.1        | 45           | Appendix II  |              |
| 173-174      | 40-40        | 253-254      | 47-47        |
| 174.1        | 43           | 255-256      | 47-47        |
| 175-176      | 36-40        | 256.1        | 47           |
| 176.1-176.2  | 43-43        | Index        |              |
| 177-178      | 42-42        | 257-258      | 44-44        |
| 179-180      | 42-42        | 259-260      | 44-44        |
| 181-182      | 45-45        | 261-262      | 44-44        |
| 182.1        | 45           | 263-264      | 44-44        |
| 183-184      | 48-48        | 265-266      | 44-44        |
| 185-186      | 43-43        | 267-268      | 44-44        |
| 186.1        | 43           | 269-270      | 44-44        |
| 187-188      | 49-49        | 271-272      | 44-44        |
| 189          | 40           | 273-274      | 44-44        |
| 191-192      | omitted      | 275-276      | 44-44        |
| 193-194      | 40-47        | 277-278      | 44-44        |
| 194.1        | 40           | 279-280      | 44-44        |
| 195-196      | 38-38        | 281-282      | 44-44        |
| 197-198      | 38-38        | 283-284      | 44-44        |
| 199-200      | 37-37        | 285-286      | 44-44        |
| 201-202      | 42-42        | 287-288      | 44-44        |
| 203-204      | 50-35        | 289-290      | 44-44        |
| 205-206      | omitted      | 291-292      | 44-44        |
| 207-208      | omitted      | 293-294      | 44-44        |
|              |              | 295          | 44           |

# Introduction

## Constitutional Basis

The Constitution of the United States provides:

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

## Statutes

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

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

By an Act of Congress approved July 19, 1952, which came into effect on January 1, 1953, the patent laws were revised and codified into 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 and Trademark 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) reprints the patent code and some additional statutes.

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

## Rules of Practice

One of the sections of the patent statute, namely, 35 U.S.C. 6, authorizes the Commissioner of Patents and Trademarks subject to the

approval of the Secretary of Commerce, to establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office.

*37 CFR 1.351. Amendments to rules will be published.* All amendments in this part will be published in the Official Gazette and in the Federal Register.

*37 CFR 1.352. Publication of notice of proposed amendments.* (a) Whenever required by law, and in other cases whenever practicable, notice of proposed amendments in this part 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 and Trademarks has issued Orders and Notices relating to various specific situations that have arisen in operating the Patent and Trademark Office. Notices and circulars of in-

formation 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 and Trademarks (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 37 CFR 1.181 and 1.191. In citing decisions as authority for his actions, the examiner should cite the decision in the manner set forth in § 707.06.

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

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

*Guide for Patent Draftsmen.* Patent and Trademark Office requirements for patent drawings with illustrations.

*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.

*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 and Trademark Office's Examining Corps. Subscription service includes basic manual, quarterly revisions, and change notices.

*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.

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