

U.S. DEPARTMENT OF COMMERCE
U.S. Patent and Trademark Office
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MANUAL OF PATENT EXAMINING PROCEDURE
Eighth Edition

Instructions Regarding Revision No. 6

Appendix R has been updated to incorporate the following final rules:

- (1) Changes To Implement Priority Document Exchange Between Intellectual Property Offices, which became effective on January 16, 2007;
- (2) Changes To Facilitate Electronic Filing of Patent Correspondence, which became effective on January 23, 2007;
- (3) Changes To Eliminate the Disclosure Document Program, which became effective on February 1, 2007;
- (4) Revisions and Technical Corrections Affecting Requirements for *Ex Parte* and *Inter Partes* Reexamination, which became effective on May 16, 2007;
- (5) April 2007 Revision of Patent Cooperation Treaty Procedures, in particular, 37 CFR 1.57, 1.437, 1.465 and 1.497, which became effective on September 10, 2007; and
- (6) Revision of Patent Fees for Fiscal Year 2007, which became effective on September 30, 2007.

MPEP Chapters 700 and 2100 have been revised to incorporate the examination guidelines for determining obviousness under 35 U.S.C. 103 in view of the Supreme Court decision in *KSR International Co. v. Teleflex Inc.* MPEP Chapter 1800 has been revised to incorporate the amendments made to the Regulations under the PCT that took effect on April 1, 2007. MPEP Chapters 700, 1800 and 2100 have also been updated to reflect the final rules identified above. **The remaining Chapters of the MPEP will be updated to reflect the final rules identified above in the next revision (the 9th edition).**

This revision consists of replacement pages for the **Title Page** in the front of the Manual, **entire Chapters 700, 1800, 2100, Appendices II – List of Decisions Cited, L – Patent Laws, R – Patent Rules, T – Patent Cooperation Treaty, and AI – Administrative Instructions Under the PCT, and entire Index.**

Pages which have been printed in this revision are labeled as “**Rev. 6**” on the bottom. Sections of the Manual that have been changed by this revision are indicated by “[**R-6**]” after the section title. Additions to the text of the Manual are indicated by arrows (><) inserted in the text. Deletions are indicated by a single asterisk (*) where a single word was deleted and by two asterisks (**) where more than one word was deleted. The use of three or five asterisks in the body of the laws and rules indicates a portion of the law or rule that was not reproduced.

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

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

CHAPTER 700:

- 706.02 Revised to add a subsection to address reliance on admitted prior art in support of a rejection.
- 706.02(b) Revised to clarify that for purposes of overcoming a rejection under 35 U.S.C. 102(b), once the benefit claim under 35 U.S.C. 119(e) is perfected, the rejection must be reconsidered to determine whether the prior art still qualifies as prior art under 35 U.S.C. 102(b) or whether the prior art qualifies as prior art under 35 U.S.C. 102(a).
- 706.02(j) Revised to reflect examination guidelines for determining obviousness in view of the Supreme Court decision in *KSR International Co. v. Teleflex Inc.*
- 706.02(k) This section has been revised to clarify the meaning of a provisional rejection under 35 U.S.C. 102(e)/103.
- 706.02(l) Revised to clarify the meaning of 35 U.S.C. 102(f) or (g)/103.
- 706.02(l)(1) Revised to clarify the meaning of 35 U.S.C. 102(e)/103.
- 706.02(l)(2) Revised to clarify the meaning of 35 U.S.C. 102(e), (f), or (g)/103.
- 706.02(l)(3) Revised to clarify the meaning of 35 U.S.C. 102(e)/103.
- 706.07(a) Revised to clarify that an examiner cannot be expected to foresee whether or how an applicant will amend a claim to overcome a rejection except in very limited circumstances.
- 706.07(b) Revised to add discussion regarding final rejection in the action immediately subsequent to the filing of an RCE.
- 706.07(d) Revised to clarify that once the finality of an Office action has been withdrawn, the next Office action may be made final if the conditions set forth in MPEP § 706.07(a) are met.
- 706.07(e) Added reference to MPEP § 1207.03.
- 706.07(f) Advisory Action, Form PTOL-303 has been updated.
- 706.07(h) Revised to clarify that it would not be proper to make final a first Office action immediately after the filing of an RCE if the first Office action

- includes a new ground of rejection. Added reference to MPEP § 1207.03. Form PTO/SB/30 has been updated.
- 707 Revised to add references to MPEP Chapter 2200 for *ex parte* reexamination proceedings and MPEP Chapter 2600 for *inter partes* reexamination proceedings. Office Action Summary, Form PTOL-326 has been updated.
- 707.05 Revised to change “priority” to “benefit/priority.”
- 707.13 Revised to indicate that for a returned Office action, if it was mailed to the correct correspondence address and it was addressed to an attorney or agent, the Office may send a letter along with a copy of the Office action to the first named inventor or assignee (if available) informing him or her of the returned action. The time period for reply to the Office action will be restarted to run from the mailing date of the letter informing applicant of the returned action.
- 708.02 Revised to indicate that a statement from a registered practitioner that he or she has evidence that the applicant is 65 years of age or older may be accepted as proof of applicant’s age for a petition to make special based on applicant’s age.
- 709 Form PTO/SB/37 has been updated.
- 710.06 Reference to a 1924 Commissioner’s Decision has been deleted.
- 711.01 Forms PTO/SB/24, PTO/SB/24A and PTO/SB/24B have been updated.
- 711.03(c) Revised to reflect amendments to 37 CFR 1.137. The showing required to establish nonreceipt of an Office communication has been revised. Forms PTO/SB/64, 64a, 64/PCT, 61, 61/PCT, 62 and 63 have been updated.
- 713.01 Applicant Initiated Interview Request Form, PTOL-413A has been updated.
- 713.02 Revised to indicate that an interview before the first Office action is encouraged where the examiner determines that such an interview would advance prosecution of the application.
- 714 Revised to include a discussion regarding amendments to the claims in a U.S. national stage application.
- 714.14 Form paragraph has been revised.
- 715.02 The spelling of *In re Dafano* has been corrected.

- 715.04 Added discussion regarding the situation where one or more of the named inventors of the subject matter of the rejected claim(s) (who had originally signed the declaration for patent application) is now unavailable to sign an affidavit/declaration under 37 CFR 1.131.
- 715.08 Revised to clarify that review of questions of formal sufficiency and propriety of affidavits/declarations filed under 37 CFR 1.131 is by way of a petition under 37 CFR 1.181.
- 716.01(d) Reference to MPEP § 2144.08 has been changed to MPEP § 2145 to reflect changes made in MPEP Chapter 2100.
- 716.06 The cite to *Dow Chem. Co. v. American Cyanamid Co.* has been corrected.
- 718 The reference to 37 CFR 1.131 has been deleted.
- 719.05 Discussion regarding services provided by the staff of Scientific and Technical Information Center (STIC) has been updated. Table 1 has been updated. STIC Search Request Form has been updated.
- 724.02 Revised to indicate that the standard for determining whether information should be expunged is whether the information is material to patentability.
- 724.04 Revised to indicate that the standard for determining whether information should be expunged is whether the information is material to patentability.
- 724.04(a) Revised to indicate that the standard for determining whether information should be expunged is whether the information is material to patentability.
- 724.04(b) Discussion regarding materials submitted under MPEP § 724.02 in a reissue application has been revised.
- 724.04(c) Discussion regarding materials submitted under MPEP § 724.02 in a reexamination proceeding has been revised.
- 724.05 Revised to indicate that the standard for determining whether information should be expunged is whether the information is material to patentability.
- 724.06 The phrase “important to a reasonable examiner in deciding whether to allow the application” has been deleted since the standard for determining whether information should be expunged is whether the information is material to patentability.

CHAPTER 1800:

- 1803 Revised to reflect amendments to PCT Rule 20 and to reflect the addition of PCT Rule 49*ter*.
- 1805 Revised to include a discussion of the restoration of the right of priority under the in spite of due care standard in the International Bureau as receiving Office.
- 1810 Revised to include references to PCT Rules 4.18 and 20.6 and to indicate that in applications filed on or after April 1, 2007, if the application, on its initial receipt date, contained a priority claim and a proper incorporation by reference statement, the initial receipt date may be retained as the international filing date if a submitted correction was completely contained in the earlier application.
- 1817 Revised to update the list of PCT Contracting States and to update the list of European Patent Convention (EPC) countries for which only European patents are available if the PCT is used.
- 1824 Revised to reflect changes to the PCT Rules relating to the correction of obvious mistakes. Also revised to include a discussion of incorporation by reference.
- 1825 Revised to reflect amendments to 37 CFR 1.437 and to include a discussion of incorporations by reference under PCT Rules 4.18 and 20.6. Also revised in view of changes to the PCT Rules regarding rectifications.
- 1826 Revised to reflect amendments to PCT Rule 38 relating to proposed modifications of the abstract.
- 1827.01 New section added. Formerly MPEP § 1847.
- 1828 Revised to indicate that if the earlier application was filed with the U.S. Patent and Trademark Office, applicant may request the U.S. receiving Office (RO/US) to prepare and transmit the certified copy of the earlier application. Also revised in view of “Electronic Transfer of Priority Documents to the International Bureau,” 1322 O.G. 30 (September 4, 2007), to indicate that in international applications filed in the RO/US on or after August 31, 2007, the RO/US will electronically transmit the certified copy of the earlier application if the applicant has made a request in accordance with PCT Rule 17.1(b) and 37 CFR 1.451(b). Further revised in view of the O.G. Notice to indicate that in international applications filed on or after August 31, 2007, the USPTO has waived the fee set out in 37 CFR 1.19(b)(1)(iii)(A) for electronically providing a copy of the patent application as filed.

- 1828.01 New section added to address the restoration of the right of priority by the receiving Office under PCT Rule 26*bis*.3.
- 1836 The title of this section has been revised. Revised to reflect amendments to PCT Rule 91.
- 1843 Revised to reflect amendments to PCT Rule 43*bis*.1(b).
- 1843.01 Revised to reflect amendments to PCT Rule 64.1(b) relating to the definition of the relevant date for purposes of PCT Rule 64.1(a).
- 1843.03 Revised to correct a cross-reference to PCT Rule 66.1(e).
- 1843.05 Information relating to the deadline for submission of amendments to the claims under PCT Article 19 moved to MPEP § 1845.02.
- 1844 Revised to correct a cross-reference to PCT Rule 48.2(b) and to include a reference to PCT Rule 43.5(e).
- 1844.01 Revised to reflect changes to the PCT Rules and to reflect changes to Form PCT/ISA/210.
- 1845 Revised to reflect amendments to PCT Rule 43*bis*.1 and to include a reference to PCT Rule 66.1*bis*.
- 1845.01 Revised to reflect changes to Form PCT/ISA/237. Subsection V also revised for consistency with the Supreme Court decision in *KSR International Co. v. Teleflex Inc.*
- 1845.02 Revised to indicate that the mailing date on Form PCT/ISA/220 is important for the computation of the time limit for filing amendments to the claims under PCT Article 19 and for filing proposed modifications of, or comments on, the abstract. Also revised to indicate that in applications filed on or after January 1, 2004, the mailing date on Form PCT/ISA/220 may also establish the time limit for making a demand under PCT Rule 54*bis*.1 and the time limit for making Article 34 Amendments that will be ensured consideration by the examiner. Further revised to indicate that where a Notification of the Recording of a Change (Form PCT/IB/306) shows any changes in the applicant or address for correspondence effected under PCT Rule 92*bis*, the later address is used instead of the correspondence address given on the request (Form PCT/ISA/101). Form PCT/ISA/220 (January 2004) has been replaced with the updated (October 2005) form.
- 1847 Section deleted. With a revision to the title, the content of this section has been moved to new MPEP § 1827.01.

- 1850 Revised to indicate the International Search and Preliminary Examination Guidelines can be obtained from a link on the Patent Examiner’s Toolkit. Subsection VI revised to list situations when claims are unsearchable under PCT Article 17(2)(b) and therefore not included in any of the inventions listed on Form PCT/ISA/206. Subsection VIII revised in view of PCT Rule 40.1(iii) to change “15 days” to “one month.” Subsection XIII revised to delete the discussion of a partial waiver of 37 CFR 1.475 and 1.499 *et seq.* in view of “Examination of Patent Applications Containing Nucleotide Sequences,” 1316 O.G. 122 (March 27, 2007).
- 1851 Revised to more accurately reproduce the list of two-letter country codes currently provided in WIPO Standard ST.3 Annex A, Section 1, and WIPO Standard ST.3, Annex B, Section 2.
- 1860 Revised to indicate written opinions established by the Korean Intellectual Property Organization are treated by the IPEA/US as the first written opinion of the International Preliminary Examining Authority.
- 1865 Revised to indicate the Demand for international preliminary examination may be submitted to the USPTO via the Internet (EFS-Web). Also revised to indicate the IPEA/US may be chosen as International Preliminary Examining Authority for U.S. residents and nationals if the KIPO served as ISA and the international application was filed in the U.S. Receiving Office or the International Bureau as receiving Office.
- 1870 Revised to include the correct title of PCT Rule 66.7.
- 1871 Revised to change “final report” to “international preliminary examination report.”
- 1871.01 Revised to change “final report” to “international preliminary examination report.”
- 1872 The title of this section has been revised. Also revised, in view of processing in the Image File Wrapper system, to delete references to “papers” and “the Search Copy file wrapper.”
- 1876 Revised to reflect changes to PCT Rule 91 and PCT Administrative Instruction Section 607.
- 1876.01 Revised to reflect changes to the PCT Rules and to the PCT Administrative Instructions.
- 1878 Revised to reflect changes to the PCT Rules and to Form PCT/IPEA/408. Subsection II revised to include a discussion of PCT Rule 66.7.

Subsections V and VI revised in view of “USPTO to Cease Supplying Paper Copies of Cited U.S. Patent References in International Applications,” 1320 O.G. 22 (July 3, 2007).

- 1878.01 Revised to include instructions for inserting classification information on the cover sheet consistent with the instructions included in MPEP § 1878 and MPEP § 1879. Subsection V also revised for consistency with the Supreme Court decision in *KSR International Co. v. Teleflex Inc.*
- 1878.01(a) Revised to reflect changes to PCT Rule 64.1(b) and to include references to Forms PCT/ISA/237 and PCT/IPEA/408.
- 1878.02 Revised to reflect changes to the PCT Rules and to change “final report” to “international preliminary examination report.”
- 1879 Revised to reflect changes to the PCT Rules and to include instructions for preparing revised Form PCT/IPEA/409 (April 2007). The Form PCT/IPEA/409 (April 2005) currently in the MPEP will be replaced by an updated form next time Chapter 1800 is revised. Form PCT/IPEA/409 (April 2007) is currently available from WIPO’s website at www.wipo.int/pct/en/forms/ipea/ipea409.pdf.
- 1879.04 Revised to reflect amendments to 37 CFR 1.14.
- 1893.01(c) Revised the discussion of national stage fees.
- 1893.01(e) Revised to reflect an amendment to 37 CFR 1.497(f)(1).
- 1893.03(c) Subsection I revised to include a discussion of restoration of a right of priority, emphasizing that in a U.S. national stage application, 35 U.S.C. 119(a) does not permit a priority period that exceeds 12 months. Subsection II revised to include an example of a copy of a certified priority document with a cover sheet indicating receipt by the International Bureau. Subsection II also revised to include a reference to 37 CFR 1.55(d).
- 1893.03(d) Revised to include references to 37 CFR 1.141-1.146. Also revised to include new form paragraph 18.22.
- 1893.03(e) Revised to reflect changes to the PCT Rules relating to rectification and incorporation by reference.
- 1895.01 Revised discussion on how to determine whether the requirement (37 CFR 1.78) for a specific reference to the earlier application has been satisfied when benefit under 35 U.S.C. 119(e), and/or benefit under 35 U.S.C. 120 and 365(c), is being claimed to an earlier filed national application (or

international application designating the U.S.) via an intermediate international application designating the U.S. Revised discussion of priority claims under 35 U.S.C. 119(a)-(d) to include a reference to 37 CFR 1.55(d).

- 1896 Revised to include references to 37 CFR 1.55(d), 37 CFR 1.141-1.146, and 37 CFR 1.497(a)(2). Subsection VI revised to indicate that submissions to enter the U.S. national stage under 35 U.S.C. 371 may identify the specification (in the oath or declaration) by reference to “the international application number.”

CHAPTER 2100:

- 2106 Revised to add discussion of recent Federal Circuit decision.
- 2116.01 Revised for consistency with the Supreme Court decision in *KSR International Co. v. Teleflex Inc.*
- 2121 Revised to add discussion of recent Federal Circuit decision.
- 2122 Revised to add discussion of recent Federal Circuit decision.
- 2127 Added reference to U.S. patent application publications in the context of discussing when the subject matter of an abandoned application that is referred to in a later application may be relied upon in a 35 U.S.C. 102(e) rejection.
- 2129 Revised to explain that admissions regarding prior art can be relied upon for both anticipation and obviousness determinations, regardless of whether the admitted prior art would otherwise qualify as prior art under 35 U.S.C. 102.
- 2136.03 Revised to explain that, for prior art purposes, a U.S. patent or patent application publication that claims the benefit of an earlier filing date under 35 U.S.C. 120 of a prior nonprovisional application would be accorded the earlier filing date as its prior art date under 35 U.S.C. 102(e) provided the subject matter used in the rejection was disclosed in the earlier-filed application in compliance with 35 U.S.C. 112, first paragraph.
- 2141 Rewritten to incorporate examination guidelines for determining obviousness under 35 U.S.C. 103 after the Supreme Court decision in *KSR*.
- 2141.01 Revised to explain that admissions regarding prior art can be relied upon for both anticipation and obviousness determinations, regardless of

whether the admitted prior art would otherwise qualify as prior art under 35 U.S.C. 102.

- 2141.01(a) Revised for consistency with the Supreme Court decision in *KSR*.
- 2141.03 Revised for consistency with the Supreme Court decision in *KSR*.
- 2142 Revised for consistency with the Supreme Court decision in *KSR*.
- 2143 Revised for consistency with the Supreme Court decision in *KSR*, and to add several examples of obviousness determinations wherein the examples rely on different rationales.
- 2143.01 Revised for consistency with the Supreme Court decision in *KSR*.
- 2143.02 Revised to add discussion of the Supreme Court decision in *KSR*.
- 2143.03 Revised for consistency with the Supreme Court decision in *KSR*.
- 2144 Revised for consistency with the Supreme Court decision in *KSR*.
- 2144.02 Revised for consistency with the Supreme Court decision in *KSR*.
- 2144.03 Revised for consistency with the Supreme Court decision in *KSR*.
- 2144.04 Revised for consistency with the Supreme Court decision in *KSR*.
- 2144.06 Revised for consistency with the Supreme Court decision in *KSR*.
- 2144.08 Revised for consistency with the Supreme Court decision in *KSR*. Also revised to delete discussion regarding determining whether rebuttal evidence is sufficient to overcome a *prima facie* case of obviousness from this section, and to move the discussion to MPEP § 2145.
- 2144.09 Revised for consistency with the Supreme Court decision in *KSR*.
- 2145 Revised for consistency with the Supreme Court decision in *KSR* and to add discussion of recent Federal Circuit decisions. Also revised to add discussion, previously in MPEP § 2144.08, regarding determining whether rebuttal evidence is sufficient to overcome a *prima facie* case of obviousness.
- 2163.04 Revised to add discussion of recent Federal Circuit decision.
- 2173.05(b) Revised to add discussion of recent Federal Circuit decision.

- 2181 Revised to add discussion of recent Federal Circuit decision.
- 2185 Revised to add cite to recent Federal Circuit decision.