

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. 7**

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

- April 2007 Revision of Patent Cooperation Treaty Procedures, in particular, 37 CFR 1.17, 1.445 and 1.452, which became effective on November 9, 2007.

MPEP Chapters 2200 and 2600 have been revised to incorporate the changes necessitated by the final rules entitled “Revisions and Technical Corrections Affecting Requirements for *Ex Parte* and *Inter Partes* Reexamination,” which became effective on May 16, 2007. MPEP Chapter 1800 has been updated to reflect changes to 37 CFR 1.17, 1.445 and 1.452, which became effective on November 9, 2007. In addition, the following MPEP Chapters have been revised: 600, 1400, and 2500.

This revision consists of replacement pages for the **Title Page** in the front of the Manual, **entire Chapters 600, 1400, 1800, 2200, 2500, 2600, Appendices II – List of Decisions Cited, 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. 7**” on the bottom. Sections of the Manual that have been changed by this revision are indicated by “[**R-7**]” 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 600:**

- 601           The Office of Initial Patent Examination (OIPE) has been changed to the Office of Patent Application Processing (OPAP).
- 601.01(c)    Revised to clarify that a provisional application filing fee is not required when filing a request to convert a nonprovisional application to a provisional application.
- 601.01(d)    The Office of Initial Patent Examination (OIPE) has been changed to the Office of Patent Application Processing (OPAP).
- 601.01(f)-(h) The Office of Initial Patent Examination (OIPE) has been changed to the Office of Patent Application Processing (OPAP).
- 601.02       Form PTO/SB/81 has been updated.
- 601.03       37 CFR 1.33(a) has been updated.
- 602           The declaration forms have been updated.
- 602.03       Form paragraph has been revised.
- 602.04(a)    The list of member countries that are parties to the Hague Convention has been deleted since users can obtain an up-to-date list by accessing the Internet website provided in this section.
- 602.05(a)    The Office of Initial Patent Examination (OIPE) has been changed to the Office of Patent Application Processing (OPAP).
- 603.01       The Office of Patent Publication has been changed to the Office of Data Management.
- 605.02       The Office of Initial Patent Examination (OIPE) has been changed to the Office of Patent Application Processing (OPAP).
- 605.03       The Office of Initial Patent Examination (OIPE) has been changed to the Office of Patent Application Processing (OPAP).
- 605.04(a)    Revised to clarify that where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration by combining the signature pages. Revised to clarify that the Office will require a new oath or declaration if any alterations made in

the application or the declaration are not initialed and dated. Reproduced form paragraph 6.05.02 has been replaced by form paragraph 6.02.01.

- 605.04(b)-(c) The Office of Initial Patent Examination (OIPE) has been changed to the Office of Patent Application Processing (OPAP).
- 605.04(f)-(g) The Office of Initial Patent Examination (OIPE) has been changed to the Office of Patent Application Processing (OPAP).
- 608.01 Revised to clarify that the written description portion of the specification must not contain drawings or flow diagrams and that a claim may incorporate by reference to a specific figure or table where there is no practical way to define the invention in words.
- 608.01(b) The Office of Initial Patent Examination (OIPE) has been changed to the Office of Patent Application Processing (OPAP).
- 608.01(f) The Office of Initial Patent Examination (OIPE) has been changed to the Office of Patent Application Processing (OPAP). Revised to clarify that if the drawings show Figures 1A, 1B, and 1C and the brief description of the drawings refers only to Figure 1, the examiner should object to the brief description and require applicant to provide a brief description of Figures 1A, 1B, and 1C.
- 608.01(g) Revised to add reference to 37 CFR 1.84(p).
- 608.01(m) The Office of Patent Publication has been changed to the Office of Data Management.
- 608.01(n) The Office of Initial Patent Examination (OIPE) has been changed to the Office of Patent Application Processing (OPAP).
- 608.01(v) Form paragraph 6.20 has been revised.
- 608.02 The Office of Initial Patent Examination (OIPE) has been changed to the Office of Patent Application Processing (OPAP).
- 608.02(b) The Office of Initial Patent Examination (OIPE) has been changed to the Office of Patent Application Processing (OPAP).
- 608.02(z) The Office of Patent Publication has been changed to the Office of Data Management.
- 608.05 The Office of Initial Patent Examination (OIPE) has been changed to the Office of Patent Application Processing (OPAP).

- 608.05(a) The Office of Initial Patent Examination (OIPE) has been changed to the Office of Patent Application Processing (OPAP).
- 608.05(b) The Office of Patent Publication has been changed to the Office of Data Management.
- 609 Revised to add an alternative electronic signature method that may be used by the examiners to indicate whether the information listed in an IDS has been considered.
- 609.01 Revised to add reference to the alternative electronic signature method.
- 609.04(a) Revised subsection II on legible copies to be consistent with 37 CFR 1.98(a)(2).
- 609.05(a) Form paragraph 6.49.10 has been revised.
- 609.05(b) Revised to add discussion on the alternative electronic signature method.
- 609.07 Revised to update e-IDS submitted by EFS-Web.
- 609.08 Revised to add discussion on the alternative electronic signature method.

#### **CHAPTER 1400:**

- 1402 Revised to indicate that a reissue application in which the only error specified to support reissue is the failure to include one or more claims that is/are narrower than at least one of the existing patent claim(s) without an allegation that one or more of the broader patent claim(s) is/are too broad together with an amendment to such claim(s) does not meet the requirements of 35 U.S.C. 251.
- 1404 Revised to delete reference to the IFW Manual.
- 1406 Revised text to be consistent with 37 CFR 1.98(a)(2).
- 1410 Revised to indicate that effective July 9, 2007, reissue applications and “follow-on” papers may be submitted by EFS-Web. Form PTO/SB/50 has been updated.
- 1410.01 The Office of Initial Patent Examination (OIPE) has been changed to the Office of Patent Application Processing (OPAP).
- 1411 Revised to indicate that for reissue applications that are maintained in IFW, the “Final SPRE Review” form will be filled in at the appropriate

point to identify that a terminal disclaimer was filed in the application for the patent to be reissued and the form will be scanned into IFW.

- 1411.01 Revised to indicate that underlining and bracketing should not be used for changes made by a Certificate of Correction dated before the filing of the reissue application or dated during the pendency of the reissue application. If such changes are submitted improperly with underlining and brackets, the examiner will require correction by the applicant in the form of a replacement paragraph (or paragraphs) without such markings.
- 1412.02 Revised to add discussion of the Federal Circuit decision of *North American Container, Inc. v. Plastipak Packaging, Inc.* Discussion of the Board decision, *Ex Parte Eggert*, has been deleted. A new subsection V. directed to rebuttal by the reissue applicant to a recapture rejection has been added. The recapture-analysis flowchart has been revised.
- 1412.03 Revised to indicate that the filing of a reissue application to merely add combination claim(s) that require all the limitations of a subcombination claim, which subcombination claim was present in the original patent, would not provide an error that is correctable by reissue as defined by 35 U.S.C. 251. Revised to indicate that a statement that “the patent is wholly or partly inoperative by reason of claiming more or less than applicant had a right to claim” is not an unequivocal statement of an intent to broaden.
- 1412.04 Revised to clarify that a petition under 37 CFR 1.324 can be used to correct the inventorship of a patent, where appropriate.
- 1414 Revised to indicate that a statement of the error as “...the inclusion of claims 3-5 which were unduly broad...” and then canceling claims 3-5, would not be considered a sufficient error statement because applicant has not pointed out what the canceled claims lacked that the remaining claims contain. The Office of Initial Patent Examination (OIPE) has been changed to the Office of Patent Application Processing (OPAP). Forms PTO/SB/51 and PTO/SB/52 have been updated.
- 1414.01 Form PTO/SB/51S has been updated.
- 1415 Revised to indicate that the number of claims in the original patent is not relevant in determining the excess claims fee for a reissue application. Form PTO/SB/56 has been updated.
- 1415.01 Revised to indicate that only one maintenance fee is required for all the multiple reissue patents that replaced a single original patent. The maintenance fee must be directed to the latest reissue patent that has issued.

- 1430 Revised to indicate that where a reissue application seeks to change the inventorship of a patent, the names of the inventors of record of the patent file are set forth in the announcement, not the filing receipt. The filing receipt sets forth the names of the inventors that the reissue application is seeking to make of record upon reissue of the patent. Revised to indicate that where a notice to file missing parts - filing date granted has been mailed by the Office for a reissue application, the reissue application will not necessarily be announced in the *Official Gazette* until all elements of the notice have been complied with.
- 1449.01 Revised to add guidance to address the situation where a reexamination certificate is to be issued for a patent, while a reissue application for the patent is pending and will not be merged with the reexamination.
- 1449.02 Revised to indicate that where a reissue application with an appropriate error as required by 35 U.S.C. 251 is filed to provoke an interference, the reissue oath/declaration must include an identification of the claims added to provoke the interference.
- 1450 Revised to clarify that for reissue applications of patents issued from a national stage application submitted under 35 U.S.C. 371, the restriction requirement should not be made under the PCT unity of invention standard because a reissue application is filed under 35 U.S.C. 251 and not under 35 U.S.C. 371.
- 1451 Revised to clarify that the mere fact an application purports to be a continuation or divisional of a parent reissue application does not make it a reissue application itself, because it is possible to file a 35 U.S.C. 111(a) continuing application of a reissue application. There must be an identification, on filing, that the application is a continuation reissue application, as opposed to a continuation of a reissue application. The Office of Initial Patent Examination (OIPE) has been changed to the Office of Patent Application Processing (OPAP).
- 1452 Revised to clarify that if a reissue application is merged with a reexamination proceeding, the filing of an RCE of the reissue application will normally not dissolve the merger, however, the Office may choose to dissolve the merger based on the individual facts and circumstances of the case, e.g., to promote the statutorily-mandated requirement for special dispatch in reexamination.
- 1455 Revised to delete references to reissue applications that are maintained in paper files.
- 1457 The Office of Initial Patent Examination (OIPE) has been changed to the Office of Patent Application Processing (OPAP).

- 1470 Information regarding accessing Public PAIR has been updated.
- 1485 The URL for accessing the image of a patent on the patent database has been updated. Form PTO/SB/44 has been updated.
- 1490 Revised to add discussion as to the interpretation of the phrase “earlier-filed” for purposes of making provisional ODP rejections in two or more pending applications. Revised to indicate that where the copending applications are filed on the same day, the provisional ODP rejection should be maintained in each of the applications until applicant overcomes the rejection by filing either a reply showing that the claims subject to the provisional ODP rejection are patentably distinct from each other or a terminal disclaimer in accordance with 37 CFR 1.321 in each of the pending applications. Forms PTO/SB/25 and PTO/SB/26 have been updated.

#### **CHAPTER 1800:**

- 1807 Revised to indicate the Customer Number practice set forth in MPEP § 403 may not be used in the international phase to appoint an agent or designate a correspondence address.
- 1808 Revised in view of 1329 OG 99 (April 8, 2008) to reflect revised procedures for handling requests to withdraw from representation. Also revised to indicate that in the international phase, an appointment of an agent may not be revoked by reference to a Customer Number.
- 1817 Revised to update the list of PCT Contracting States and the members of the European Patent Convention (EPC) regional patent system.
- 1817.02 Revised to reflect amendments to PCT Rule 4.11.
- 1819 Revised to reflect amendments to PCT Rule 4 and 37 CFR 1.445 and to add PCT Rule 12*bis*.
- 1845.01 Form paragraphs have been revised.
- 1850 Form paragraphs have been revised.
- 1852 Revised to reflect amendments to PCT Rules 4 and 41.
- 1878.01 Form paragraphs have been revised.
- 1879 Spelling of “further” was corrected in subsection VI and some text inadvertently omitted in Rev. 6 was re-inserted in subsection VII.



- 1893.03(d) Revised to indicate the sections of the MPEP relating to double patenting rejections (MPEP § 804), election and reply by applicant (MPEP § 818), and rejoinder of nonelected inventions (MPEP § 821.04) generally also apply to national stage applications submitted under 35 U.S.C. 371. Form paragraphs for restriction and election of species requirements have been revised.

## **CHAPTER 2200:**

- 2203 Revised to clarify that “any person” as set forth in 35 U.S.C. 301 includes real parties in interest to the patent owner or requester.
- 2204 Revised to add reference to 37 CFR 1.501.
- 2205 Revised to clarify the explanation requirement of 35 U.S.C. 301.
- 2206 Revised to clarify when a citation qualifies for entry under 37 CFR 1.501.
- 2207 Revised to add discussion regarding litigation papers and decisions from litigations that may be entered in the patent file.
- 2209 Revised to indicate that “litigation tactics” are not tolerated in reexamination proceedings and that parties are expected to adhere to the provisions of 37 CFR 10.18(b) throughout the course of a reexamination proceeding.
- 2210 Revised to update 37 CFR 1.510(f).
- 2213 Revised to update 37 CFR 1.510(f). Revised to clarify that an attorney or agent representing a requester in a reexamination proceeding must be a registered patent practitioner.
- 2214 Revised to clarify that the request must identify each substantial new question of patentability raised and each proposed ground of rejection. Revised to indicate that an application data sheet cannot be submitted in a reexamination proceeding. Form PTO/SB/57 has been updated.
- 2216 Revised to add discussion of the Supreme Court decision in *KSR*.
- 2217 Revised to add a chart to illustrate rejections based on 35 U.S.C. 102(g)(2) in a reexamination proceeding.
- 2218 Revised to indicate that the requirement for copies of U.S. patents and U.S. patent application publications (37 CFR 1.510(b)(3)) relied upon or referred to in a reexamination request has been waived. Revised to

indicate that it is not required and parties are not permitted to submit copies of copending reexamination proceedings and applications in a reexamination request.

- 2220 Revised to indicate that where service was not possible after a reasonable effort to do so, requester must submit a duplicate copy of the request papers to the Office together with a cover letter including an explanation of what effort was made to effect service and why that effort was not successful. The cover letter should be clearly worded to avoid the possibility of the Office erroneously charging a duplicate filing fee.
- 2222 Revised to update 37 CFR 1.33(c). Form PTO/SB/82 has been deleted and replaced by form PTO/SB/81.
- 2223 Form PTO/SB/83 has been updated.
- 2224 Revised to indicate that effective July 9, 2007, the Office began accepting requests for reexamination and “follow on” papers submitted by EFS-Web. Revised to indicate that the certificate of mailing and transmission procedures set forth in 37 CFR 1.8 may be used to file any paper in an *ex parte* reexamination, except for a request for reexamination and a corrected/replacement request for reexamination.
- 2225 Revised to indicate that if untimely papers filed before an order for reexamination, are entered in the patent file prior to discovery of the impropriety, such papers will be expunged from the record.
- 2229 The Office of Publication has been changed to the Office of Data Management.
- 2232 Revised to indicate that non-patent literature in a reexamination file is not available for viewing by members of the public.
- 2232.01 The title of this section has been revised.
- 2234 Revised to update 37 CFR 1.530(k).
- 2235 The Office of Publication has been changed to the Office of Data Management.
- 2238 Revised to indicate that reexamination fees are based on full cost recovery and it is essential that all time expended on reexamination activities be reported accurately.
- 2240 Revised to indicate that in order for a second or subsequent request for reexamination to be granted, the second or subsequent requester must

independently provide a substantial new question of patentability which is different from that raised in the pending reexamination for the claims in effect at the time of the determination (37 CFR 1.515(a)).

- 2242 Revised to add reference to the Supreme Court decision in *KSR*. Revised to indicate that in order for a second or subsequent request for reexamination to be granted, the second or subsequent requester must independently provide a substantial new question of patentability which is different from that raised in the pending reexamination for the claims in effect at the time of the determination (37 CFR 1.515(a)).
- 2249 Revised to update 37 CFR 1.530(a).
- 2250 Revised to update 37 CFR 1.530(k). Revised to indicate that in those rare instances where a concluded post-patent proceeding changes the patent while the reexamination proceeding is pending, amendments will be made relative to the patent, as revised by the concluded proceeding, and 37 CFR 1.530(i) is waived to that extent. The subsection on examples has been revised to add the re-presentation of original patent claims.
- 2250.02 Revised to update 37 CFR 1.530(l).
- 2250.03 Revised to update 37 CFR 1.20(c)(3).
- 2254 Revised to update 37 CFR 1.550(d).
- 2256 Revised to be consistent with 37 CFR 1.98(a)(2).
- 2257 Revised to indicate that the reexamination request must provide a listing of the patents and printed publications in accordance with 37 CFR 1.98.
- 2258 Revised to add a chart to illustrate rejections based on 35 U.S.C. 102(g)(2) in a reexamination proceeding. Form paragraph 22.03 has been revised.
- 2262 Revised to add discussion of current procedure which permits the examiner to indicate in the Office action that a discussion with the patent owner's representative may result in agreement whereby the reexamination proceeding may be placed in condition for issuing a NIRC and that the examiner will telephone the patent owner's representative in about 2 weeks.
- 2266 Revised to update 37 CFR 1.550(d). Revised to indicate that an application data sheet is an improper paper in a reexamination proceeding.
- 2266.01 Revised to add x-reference to MPEP § 2281.

- 2267 Revised to indicate that where an inappropriate paper has been scanned into IFW of the reexamination proceeding before discovery of the inappropriate nature of the paper, the paper will be marked as “non-public” and “closed” so that the paper does not appear in the active IFW record with the other active papers that comprise the public record of the reexamination proceeding.
- 2268 Revised to update 37 CFR 1.137.
- 2271 Revised to add x-reference to the final rejection practice set forth in MPEP § 706.07(a).
- 2272 Revised to add discussion of the filing of a petition under 37 CFR 1.181 where the patent owner is of the opinion that a final rejection is improper or premature, or that an amendment submitted after final rejection complies with 37 CFR 1.116 but the examiner improperly refused entry of such an amendment.
- 2280 Revised to add discussion of 37 CFR 1.98(a)(2).
- 2281 Revised to indicate that it is permitted for a paralegal or legal instruments examiner (or support staff) to telephone a requester to discuss a request that fails to comply with the filing date requirements for filing a reexamination request because there is no reexamination proceeding yet.
- 2282 Revised to add discussion regarding litigation papers and decisions from litigations that may be entered in the patent file.
- 2283 Revised to update 37 CFR 1.565(c) and the discussion regarding merger of multiple copending reexamination proceedings.
- 2285 Revised to update 37 CFR 1.565(d) and the discussion regarding conduct of merged reissue application and reexamination proceeding.
- 2286 Revised to add discussion of two Federal Circuit decisions involving reexamination proceedings where the court affirmed the Office’s rejections even though parallel district court proceeding upheld the claims as valid and infringed.
- 2287 The Office of Publication has been changed to the Office of Data Management. Revised to indicate that if a patent expires during the pendency of a reexamination proceeding for that patent, all amendments to the patent claims and all claims added during the reexamination proceeding must be withdrawn.

- 2287.01 New section has been added directed to examiner consideration of submissions after a NIRC.
- 2288 Revised to update 37 CFR 1.570.
- 2294 Revised to add discussion regarding what to do with a reexamination file in which the reexamination proceeding has been terminated.
- 2295 The Office of Publication has been changed to the Office of Data Management.

**CHAPTER 2500:**

- 2501 Revised to indicate that 35 U.S.C. 41(b) as reproduced in this section has been extended through fiscal year 2008. The Office of Initial Patent Examination has been changed to the Office of Patent Application Processing.
- 2504 Revised to clarify that only one maintenance fee is required for all the multiple reissue patents that replaced the single original patent.
- 2510 Revised to indicate that maintenance fee payment cannot be submitted by using EFS-Web. The mailing address for submitting maintenance fee payments and correspondence related to maintenance fees has been updated.
- 2515 Revised to clarify that the maintenance fee transmittal form should be used when submitting maintenance fees by mail or by facsimile transmissions.
- 2542 The Office of Initial Patent Examination has been changed to the Office of Patent Application Processing.
- 2560 The Office of Initial Patent Examination has been changed to the Office of Patent Application Processing.
- 2570 Instructions regarding how to access maintenance fee status information over the Internet have been updated.
- 2590 Revised to add discussion regarding auto-processing of petitions to accept unintentionally delayed payment of a maintenance fee in an expired patent submitted by EFS-Web.
- 2595 Forms PTO/SB/45 and PTO/SB/47 have been updated.

## **CHAPTER 2600:**

- 2602 Revised to update 37 CFR 1.902.
- 2609 Revised to indicate that “litigation tactics” are not tolerated in reexamination proceedings and that parties are expected to adhere to the provisions of 37 CFR 10.18(b) throughout the course of a reexamination proceeding.
- 2610 Revised to update 37 CFR 1.915.
- 2612 Revised to add discussion regarding challenging the accuracy of a certification submitted under 37 CFR 1.915(b)(7).
- 2613 Revised to update 37 CFR 1.915(c). Revised to clarify that an attorney or agent representing a requester in a reexamination proceeding must be a registered patent practitioner.
- 2614 Revised to update 37 CFR 1.915(c). Revised to clarify that the request must identify each substantial new question of patentability raised and each proposed ground of rejection. Revised to indicate that where service was not possible after a reasonable effort to do so, requester must submit a duplicate copy of the request papers to the Office together with a cover letter including an explanation of what effort was made to effect service and why that effort was not successful. The cover letter should be clearly worded to avoid the possibility of the Office erroneously charging a duplicate filing fee. Revised to indicate that an application data sheet cannot be submitted in a reexamination proceeding. Form PTO/SB/58 has been updated.
- 2616 Revised to add discussion of the Supreme Court decision in *KSR*.
- 2617 Revised to add a chart to illustrate rejections based on 35 U.S.C. 102(g)(2) in a reexamination proceeding. Revised to indicate that an admission made outside the record of the file or the court record may be admitted pursuant to MPEP § 2686.
- 2618 Revised to indicate that the requirement for copies of U.S. patents and U.S. patent application publications (37 CFR 1.915(b)(4)) relied upon or referred to in a reexamination request has been waived. Revised to indicate that it is not required and parties are not permitted to submit copies of copending reexamination proceedings and applications in a reexamination request.
- 2620 Revised to indicate that where service was not possible after a reasonable effort to do so, requester must submit a duplicate copy of the request

papers to the Office together with a cover letter including an explanation of what effort was made to effect service and why that effort was not successful. The cover letter should be clearly worded to avoid the possibility of the Office erroneously charging a duplicate filing fee.

- 2622 Revised to update 37 CFR 1.33(c). Revised to add x-reference to MPEP § 324 regarding establishing an assignee's right to take action when submitting a power of attorney. Form PTO/SB/82 has been deleted and replaced by form PTO/SB/81.
- 2623 Form PTO/SB/83 has been updated.
- 2624 Revised to indicate that effective July 9, 2007, the Office began accepting requests for reexamination and "follow on" papers submitted by EFS-Web. Revised to indicate that the certificate of mailing and transmission procedures set forth in 37 CFR 1.8 may be used to file any paper in an *inter partes* reexamination, except for a request for reexamination and a corrected/replacement request for reexamination.
- 2625 Revised to update 37 CFR 1.902.
- 2629 The Office of Publication has been changed to the Office of Data Management.
- 2632 Revised to indicate that non-patent literature in a reexamination file is not available for viewing by members of the public.
- 2632.01 The title of this section has been revised.
- 2635 The Office of Publication has been changed to the Office of Data Management.
- 2638 Revised to indicate that reexamination fees are based on full cost recovery and it is essential that all time expended on reexamination activities be reported accurately.
- 2640 Revised to update 37 CFR 1.923. Revised to indicate that in order for a second or subsequent request for reexamination to be granted, the second or subsequent requester must independently provide a substantial new question of patentability which is different from that raised in the pending reexamination for the claims in effect at the time of the determination (37 CFR 1.923. Revised to add x-references to MPEP § 2686.01 and MPEP § 2283.
- 2642 Revised to add reference to the Supreme Court decision in *KSR*. Revised to indicate that in order for a second or subsequent request for

reexamination to be granted, the second or subsequent requester must independently provide a substantial new question of patentability which is different from that raised in the pending reexamination for the claims in effect at the time of the determination (37 CFR 1.923).

- 2656 Revised to be consistent with 37 CFR 1.98(a)(2).
- 2657 Revised to indicate that the reexamination request must provide a listing of the patents and printed publications in accordance with 37 CFR 1.98.
- 2658 Form paragraph has been revised.
- 2666 Revised discussion regarding supplemental response to an Office action in an *inter partes* reexamination proceeding. Revised to indicate that an application data sheet is an improper paper in a reexamination proceeding.
- 2666.01 Revised to update 37 CFR 1.530(f) and (l).
- 2666.04 Revised to update 37 CFR 1.20(c).
- 2666.05 Revised to add discussion regarding circumstances where the patent owner files a response to an Office action and the page length of the response exceeds the page length set forth in 37 CFR 1.943(b). Revised discussion regarding when new prior art can be submitted with comments.
- 2666.07 Revised to indicate that if a patent owner's response to an Office action on the merits that is served on a third party requester is received by the third party requester more than 5 business days after the date of service set forth on the certificate of service, the third party requester may submit a verified statement, specifying the date of the actual receipt, as an attachment to the third party requester's comments and the Office will treat the date of actual receipt to be the date of service for purposes of 35 U.S.C. 314(b)(2).
- 2666.10 Revised to update 37 CFR 1.957(b).
- 2667 Revised to indicate that where an inappropriate paper has been scanned into IFW of the reexamination proceeding before discovery of the inappropriate nature of the paper, the paper will be marked as "non-public" and "closed" so that the paper does not appear in the active IFW record with the other active papers that comprise the public record of the reexamination proceeding. Revised to indicate that the provisions of 37 CFR 1.943(c) are waived to the extent that the table of contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the 30 page limit required by 37 CFR 1.943(c). Revised to indicate that after an opposition



to any patent owner petition is filed by a third party requester, any further paper in opposition/rebuttal/response to the third party opposition paper will not be considered and will be returned.

- 2668 Revised to update 37 CFR 1.137
- 2671.01 Form paragraph has been revised.
- 2671.02 Form paragraph has been revised.
- 2672 Revised to indicate that if the patent owner's submission of comments under 37 CFR 1.951(a) addresses issues not already raised in the action closing prosecution (ACP), the comments will be returned as improper. If the comments have been scanned into the IFW for the reexamination proceeding before the discovery of the impropriety, they should be expunged from the record, with notification being sent to the party that submitted the comments.
- 2673.02 Revised to update 37 CFR 1.953(b) and (c).
- 2685 Revised to indicate that the Office (paralegal or legal instruments examiner or support staff) may, in its sole discretion, telephone a party as to matter of completing or correcting the record of a file, where the subject matter discussed does not go to the merits of the reexamination proceeding (e.g., calls to obtain a certificate of service). Revised to indicate that it is permitted for a paralegal or legal instruments examiner (or support staff) to telephone a requester to discuss a request that fails to comply with the filing date requirements for filing a reexamination request because there is no reexamination proceeding yet.
- 2686 Revised to add discussion regarding court decision papers that may be entered in a reexamination file.
- 2686.01 Revised to update 37 CFR 1.989(a) and the discussion regarding merger of multiple copending reexamination proceedings.
- 2686.03 Revised to update 37 CFR 1.991 and 1.997 and the discussion regarding conduct of merged reissue application and reexamination proceeding.
- 2686.04 Revised to add discussion of two Federal Circuit decisions involving reexamination proceedings where the court affirmed the Office's rejections even though parallel district court proceeding upheld the claims as valid and infringed.
- 2687 The Office of Publication has been changed to the Office of Data Management. Revised to indicate that if a patent expires during the

pendency of a reexamination proceeding for that patent, all amendments to the patent claims and all claims added during the reexamination proceeding must be withdrawn.

- 2687.01 Revised to add x-reference to MPEP § 2656.
- 2688 Revised to update 37 CFR 1.997.
- 2694 Revised to add discussion regarding what to do with a reexamination file in which the reexamination proceeding has been terminated.