

MANUAL OF
**PATENT
EXAMINING
PROCEDURE**

3RD EDITION

Rev. 47



U.S. DEPARTMENT OF COMMERCE
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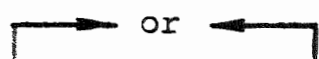
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MANUAL OF PATENT EXAMINING PROCEDURE
Third Edition

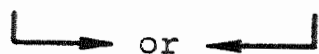
Instructions regarding Revision No. 47

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-47]" 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

Change Notice Series No. 46-1 of December 10, 1975 may be removed from the Manual since it has been incorporated into the Manual by this revision.

Particular attention is called to the following sections:

| <u>Section</u> | <u>Change</u> |
|----------------|------------------------------------------------------------------------------------------------------------------------|
| 301.01 | Rule 12 revised. |
| 402.01 | Incorporates Change Notice 46-1 on hand delivery. |
| 406 | Wording of suggested paragraph revised and notice re death of attorney included at the end. |
| 502 | Incorporates Change Notice 46-1. |
| 509 | Rule 21 added as revised and rule 25 revised. |
| 608.01 | Sub-section on filing of non-English language applications added. |
| 710.01(a) | Clarification as to computation of extensions of time and 30 day periods. |
| 710.02(e) | Incorporates Change Notice 46-1 and adds material on extension of time. |
| 714.13 | Sub-section on Time for Response rewritten. |
| 1105.03 | Clarification of section relating to granting of motions to add counts. |
| 1212 | Clarification as to when Board of Appeals remands cases. |
| 1214.01 | Ability of Board of Appeals to remand application with an added record in a response to a rule 196(b) rejection added. |
| 1214.03 | Rule 197(b) revised. |
| 1214.07 | Clarified as to who considers petitions for reopening after a Board of Appeals decision. |
| 1303.01 | Sub-section on Issue Batch Number added. |
| 1309 | Notice on printing of assignee's names added. |
| Appendix II | List of Decisions Cited updated. |

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* 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

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

Rev. 47, Jan. 1976

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- Revision 3, May 1952

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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

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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.

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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.