

Chapter 900 Prior Art, Classification, Search

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901 Prior Art [R-14]

Note 37 CFR 1.104(a) in >MPEP< § 707.

901.01 Canceled Matter in U.S. Patent Files

Canceled matter in the application file of a U.S. patent is not a proper reference as of the filing date under 35 U.S.C. 102(e), see *Ex parte Stalego*, 154 USPQ 52. However, matter canceled from the application file wrapper of a U.S. patent may be used as prior art as of the patent date in that it then constitutes prior public knowledge under 35 U.S.C. 102(a), *In re Lund et al*, 153 USPQ 625 (CCPA 1967).

901.02 Abandoned Applications [R-14]

37 CFR 1.108. Abandoned applications not cited.

Abandoned applications as such will not be cited as references except those which have **>been opened to inspection by the public following a defensive publication<.

Where an abandoned application is referred to in an issued U.S. patent, the disclosure of the application is incorporated by reference into the disclosure of the patent and is available to the public. See § 1.14(b).

In re Heritage, 1950 CD. 419, 86 USPQ 160 >(CCPA 1950)<, holds that where a patent refers to and relies upon the disclosure of a copending abandoned application, such disclosure is available as a reference. See also *In re Lund et al*<, 153 USPQ 625, *>(CCPA 1967).<

It has also been held that where the reference patent refers to a copending but abandoned application which discloses subject matter in common with the patent, the effective date of the reference as to the common subject matter is the filing date of the abandoned application. *Ex parte Clifford*, 49 USPQ 152 >(Bd. App. 1940)<; *Ex parte Peterson*, 63 USPQ 99 >(Bd. App. 1944)<; and *In re Switzer et al.*, 612 O.G. 11; 77 USPQ 156 >(CCPA 1948)<.

Published abstracts, abbreviations and defensive publications are references (>MPEP<§ 901.06(d)).

901.03 Pending Applications [R-14]

Except as provided in 37 CFR 1.11(b), pending U.S. applications are preserved in secrecy (37 CFR 1.14(a)) and are not available as references. However, claims in one application may be rejected on the claimed subject matter of a copending application of the same inventive entity. >See MPEP § 804.< For applications having a common assignee and different inventive entities claiming a single inventive concept see >MPEP< § 804.03.

Applications abandoned **>as Defensive Publications were< treated as pending applications for limited time periods regarding interferences and the filing of a continuing application. (See >MPEP< § 711.06.)

901.04 U.S. Patents [R-14]

The following different series of U.S. patents are being, or in the past have been issued. The date of patenting given on the face of each copy is the publication date and is the one usually cited. The filing date, in most instances also given on the face of the patent, is ordinarily the effective date as a reference (35 U.S.C. 102(e)).

X-Series. These are the approximately 10,000 patents issued between 1790 and July 4, 1836. They were not originally numbered, but have been arbitrarily assigned numbers in the sequence in which they were issued. The number should not be cited. When copies are ordered, the patentee's name and date of issue suffice for identification.

1836 Series. The mechanical, electrical, and chemical patents issued since 1836 and frequently designated as "utility" patents, are included in this series. A citation by number only is understood to refer to this series. This series comprises the bulk of all U.S. patents issued. Some U.S. patents issued in 1861 bear two numbers but only the larger number should be cited.

Reissue Series. Reissue patents (§ 1401) have been given a separate series of numbers preceded by "Re." In citing, the letters and the number must be given, e.g., Re 1776. The date that it is effective as a reference is the effective date of the original patent application, not the filing date of the reissue application.

Design reissue patents are numbered with the same number series as "utility" reissue patents. The letter prefix does however indicate them to be design reissues.

A.I. Series. From 1838 to 1861, patents covering an inventor's improvement on his own patented device were given a separate series of numbers preceded by "A.I." to indicate Additional Improvement. In citing, the letters and the number must be given, e.g., A.I. 113. About 300 such patents were issued.

Plant Patent Series. When the statutes were amended to provide for patenting certain types of plants (Chapter 1600) these patents were given a separate series of numbers. In citing, the letters "P.P." and the number must be given, e.g., P.P. 13.

Design Patents. Patents for designs (Chapter 1500) are issued under a separate series of numbers. In citing, the letter

"D" and the number must be given, e.g., D. 140,000.

Numbers for Identification of Bibliographic Data on the First Page of Patent and Like Documents (INID Numbers)

The purpose of INID Codes ("INID" is an acronym for "Internationally agreed Numbers for the Identification of Data") is to provide a means whereby the various data appearing on the first page of patent and like documents can be identified without knowledge of the language used and the laws applied. They are now used by most patent offices and have been applied to U.S. patents since Aug. 4, 1970. Some of the codes are not pertinent to the documents of a particular country and some which are may, in fact, not be used.

INID Codes and Minimum Required for the Identification of Bibliographic Data

(10) Document identification

°(11) Number of the document

°(12) Plain language designation of the kind of document

>°(13) Kind of document code according to WIPO Standard ST.16<

°°(19) WIPO *>Standard ST.3< code, or other identification, of the *>office< publishing the document

> Notes: (i) °° Minimum data element for patent documents only.

(ii) with the proviso that when data coded (11) and (13), or (19), (11) and (13), are used together and on a single line, category (10) can be used, if so desired.<

(20) Domestic filing data

°(21) Number(s) assigned to the application(s), e.g. "Numero d'enregistrement national", "AktENZEICHEN"

°(22) Date(s) of filing application(s)

°(23) Other date(s)**, including >date of filing complete specification following provisional specification and date of exhibition<

(24) Date from which industrial property rights may have effect

(25) Language in which the published application was originally filed

(26) Language in which the application is published

(30) Priority Data

°(31) Number(s) assigned to priority application(s)

°(32) Date(s) of filing of priority application(s)

°(33) **>WIPO Standard ST.3 Code identifying the national patent office allotting the priority application number or the organization allotting the regional priority application number; for international applications filed under the PCT, the code "WO" is to be used

(34) For priority filings under regional or international arrangements, the WIPO Standard ST.3 Code identifying at least one country party to the Paris Union for which the regional or international application was made<

Notes: >(i)< With the proviso that >when< data coded (31), (32) and (33) are used together and on a single line, category (30) can be used, if so desired. >If an ST.3 Code identifying a country for which a regional or international application was made is published, it should be identified as such using INID Code (34) and should be on a line separate from that of elements coded (31), (32) and (33) or (30).

(ii) The presentation of priority application numbers should be as recommended in WIPO Standards ST.10C and in ST.34.<

(40) Date(s) of making available to the public

°°(41) Date of making available to the public by viewing, or copying on request, an unexamined document, on which no grant has taken place on or before the said date

°°(42) Date of making available to the public by viewing, or

copying on request, an examined document, on which no grant has taken place on or before the said date

^{oo}(43) Date of publication by printing or similar process of an unexamined document, on which no grant has taken place on or before the said date

^{oo}(44) Date of publication by printing or similar process of an examined document on which no grant has taken place on or before the said date

^{oo}(45) Date of publication by printing or similar process of a document on which grant has taken place on or before the said date

(46) Date of publication by printing or similar process of the claim(s) only of a document

^{oo}(47) Date of making available to the public by viewing, or copying on request, a document on which grant has taken place on or before the said date

Note: ^{oo}Minimum data element for patent documents only, the minimum data requirement being met by indicating the date of making available to the public the document concerned

(50) Technical information

^o(51) International Patent Classification

(52) Domestic or national classification

(53) Universal Decimal Classification

^o(54) Title of the invention

(55) Keywords

(56) List of prior art documents, if separate from descriptive text

Note: Attention is drawn to WIPO Standard ST.14 in connection with the citation of references on the front page of patent documents and in search reports attached to patent documents.<

(57) Abstract or claim

(58) Field of search

(60) References to other legally related domestic patent documents including unpublished applications therefor

^o(61) Number and, if possible, filing date of the earlier application, or number of the earlier publication, or number of earlier granted patent, inventor's certificate, utility model or the like to which the present document is an addition

^o(62) Number and, if possible, filing date of the earlier application from which the present document has been divided out

^o(63) Number and filing date of the earlier application of which the present document is a continuation

^o(64) Number of the earlier publication which is "reissued"

(65) Number of a previously published patent document concerning the same application

Note: (i) Priority data should be coded in category (30)

> (ii) Code (65) is intended primarily for use by countries in which the national laws require that re-publication occurs at various procedural stages under different publication numbers and these numbers differ from the basic application numbers.<

(70) Identification of parties concerned with the document

^{oo}(71) Name(s) of applicant(s)

(72) Name(s) of inventor(s) if known to be such

^{oo}(73) Name(s) of grantee(s)

(74) Name(s) of attorney(s) or agent(s)

^{oo}(75) Name(s) of inventor(s) who is (are) also applicant(s)

^{oo}(76) Name(s) of inventor(s) who is (are) also applicant(s) and grantee(s)

Note: >(i)< ^{oo}For documents on which grant has taken place on or before the date of making available to the public, and gazette entries relating thereto, the minimum data requirement is met by indicating the grantee, and for other documents by indicating the applicant).

> (ii) <(75) and (76) are intended primarily for use by countries in which the national laws require that the inventor and applicant are normally the

same. In other cases (71) and (72) or (71), (72) and (73) should generally be used.

(80) Identification of date related to International Conventions other than the Paris Convention ^{oo}

(81) Designated State(s) according to the PCT^{oo}

> (83) Information concerning the deposit of microorganisms, e.g., under the Budapest Treaty<

(84) Designated contracting states under ^{oo}>regional patent conventions<

(85) Date of fulfillment of the requirements of article 22 and/or 39 of the PCT for introducing the national procedure according to PCT

(86) Filing data of the regional or PCT application, i.e. application ^{oo}>filing date, application number, and optionally, the language in which the published application was originally filed<

(87) Publication data of the regional or PCT application, i.e. publication ^{oo}>date, publication number, and optionally, the language in which the application is published<

(88) Date of deferred publication of the search report

(89) Document number, date of filing, and country of origin of the original document according to the CMEA Agreement on Mutual Recognition of Inventors' Certificates and other Documents of Protection for Inventions.

Note: (i) The codes (86) and (87) are intended to be used:

— on national documents when identifying one or more of the relevant filing data or publication data of a regional or PCT application, or

— on regional documents when identifying one or more of the relevant filing data or publication data of another regional or PCT application.

(ii) all data in code (86) should be presented together and preferably on a single line.

(iii) all data in code (87) should also be presented together and preferably on a single line.<^{oo}

901.05 Foreign Patent Documents [R-14]

In some countries, there is a delay between the date of the patent grant and the date of publication. Generally, a foreign patent should not be cited as a reference unless the examiner has seen the patent.

Citation data pertaining to those countries from which the most patent publications are received are given in the following sections. Additional information can be obtained from the Scientific ^{oo}>and Technical Information Center<.

A. FOREIGN PATENT MATERIAL

There are approximately 25 countries in which the specifications of patents are published in printed form, including those in which the specifications are so published before the patent is granted. Where an invention is patented in more than one country, a single copy is selected for placement in the examiners' search file. If the U.S. is one of the countries in the "family" of patents, none ^{oo}>of< the foreign "equivalents" are placed in the search file.

B. NOTES ON FOREIGN PATENT LAWS IN GENERAL

Some general information on foreign patent laws is given here, to summarize particular features which may be observed and to consider terminology used. Some additional details may be found under individual countries in Part F.

By way of contrast, it is first recalled that in the United States a number of different events all occur on the same day, the issue date. These events include: (1) a patent document, the "letters

patent," which grants and thereby creates the legal rights conferred by a patent, is executed and sent to the applicant; (2) the patent rights come into existence; (3) the patent rights can be exercised; (4) the specification of the patent becomes available to the public; (5) the prosecution papers become available to the public; (6) the specification is published in printed form; (7) an issue of an official journal, containing an announcement of the patent* and a claim<, is published. In most foreign countries various ones of these events occur on different days and some of them may never occur at all.

a. Applicant. In most countries the owner of the prospective rights, derived from the inventor, may also apply for a patent in his own name as applicant; in a few, other persons may apply as well or be joined as co-applicants. Hence applicant is not synonymous with inventor, and the applicant may be a company. Some countries require the inventors' names to be given and regularly print them on the published copies; Other countries may sometime print the inventors' names, presumably when available or when requested to do so.

b. Application. The word application is commonly used to refer to the entire set of papers filed when seeking a patent. However, from the standpoint of strict statutory language in many laws, and this was once the case in the U.S. as well, the word application refers only to the paper, usually a printed form, in which a patent is requested. The application, in this sense, is to be "accompanied by" or have "attached" to it certain other papers, namely a specification, drawings when necessary and perhaps other papers.

c. Publication of pending applications. In general, pending applications are confidential until a patent is granted, or until a certain stage in the proceedings, or until a certain date, as may be specified in a particular law.

Some countries have adopted a practice of publishing pending applications, meaning the contents or documents of the application, at a certain time after filing, the applications being as yet unexamined or in process of examination. The applicant is given certain provisional rights on this publication.

This publication may take either of two forms. In some countries, a notice giving certain particulars is published in the official journal and thereafter any one may see the papers at the patent office or order copies. There is no printed publication of the specification, although an abstract may be published in printed form. In Australia, patents are microfilmed copies of applications, *In re Wyer*, 210 USPQ 790 (CCPA 1981).

Several other countries publish the specifications of pending applications in printed form at a specified time after filing. These documents, of course, constitute references as printed publications and whether or not a patent is subsequently granted becomes unimportant.

In dealing with foreign patent material, the words "published" and "publication" sometimes refer only to the opening for inspection and making copies of the papers and not to a printed publication. In what follows this will be pointed out when not apparent from the context.

d. Administrative systems. The administrative systems of issuing patents by a patent office vary from an inspection of the papers to determine if they are in proper form to an examination

of the merits on the basis of an extensive search of the prior art. The former are referred to as nonexamining or registration countries, although there could be a rejection on matters apparent on the face of the papers, such as that the subject matter is what we would call outside the statutory classes.

Of the examining countries (more appropriately pre-examining) the extent of the material searched varies. Only a few, possibly less than a dozen, include a substantial amount of foreign patent material and nonpatent publications, as well as their own patents, in their search files. Some countries specifically limit the search by rule to their own patents with very little or no additional material, or do so for lack of facilities. An increasing number require applicants to give information concerning references cited in corresponding applications filed in other countries.

e. Oppositions. Some< examining countries consider participation by the public as an inherent feature of their examining system. When an application is found to be allowable by the examiner, it is "published" for opposition. Then there is a period, usually 3 or 4 months, within which members of the public can oppose the grant of the patent; this could be any person or company**, or only one having an interest in some >countries<. The opposition is an *inter partes* proceeding and the opposer can ordinarily raise any ground on the basis of which a patent would be refused or held invalid, including any applicable references.

The publication for opposition, also referred to as laying open for opposition, may take the form of the publication of a notice in the official journal with the application, meaning the contents, being then open to public inspection and the obtaining of copies. Some countries, in addition, issue the specifications of the allowed applications in printed form at or about the same time and there is hence in these a printed publication which is available as a reference in the U.S.

f. The Patent. In the nonexamining countries, and in the examining countries if the applicant is successful, a patent is issued, or granted, or the invention becomes patented, in due course. Practices and terminology vary and in some there is no "letters patent" document which creates and grants the rights as in the U.S. In some countries the examiner grants the patent by signing the required paper. In a few countries nobody does anything, the patent standing granted by operation of law after certain events have occurred. The term "granting the patent" is used for convenience, but it should be noted that *35 U.S.C.< 102(a) and 102(b) ** do not use this terminology.

A list of granted patents is ordinarily published in the official journal, with an abstract or claims in some countries, but this is usually after the granting date.

Where the specifications of granted patents are issued in printed form, this seldom occurs simultaneously with the day of grant, but may occur a short time thereafter in some, or after several years in a few.

The term of a patent may vary in different countries, with respect to the number of years and the method of determining it. In some countries, it is a specified number of years after the date of grant but in many the patent expires a specified number of

years after the filing date even though the patent rights might not commence until a later date.

Most countries require the payment of annual or periodic fees to maintain a patent in force. These may start a few years after filing, and increase each year. If not paid within the time allowed the patent lapses and is no longer in force.

C. STATUTORY BASIS: *35 U.S.C. 102 (a) and (b)

*35 U.S.C. 102(a) provides that a patent cannot be obtained if "the invention was . . . patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant . . ." while *35 U.S.C. 102(b) provides that a patent cannot be obtained if "the invention was patented or described in a printed publication in this or a foreign country . . . more than one year prior to the date of the application for patent in the United States." The common phrase in these two quotations "patented or described in a printed publication in this or a foreign country" refers to two different things and can be separated as follows:

1. "patented . . . in this or a foreign country"
2. "described in a printed publication in this or a foreign country."

These are two different sources of references, namely (1) *foreign patents* (we are not concerned with U.S. patents here) and (2) *printed publications*, which can be used for finding anticipation under *35 U.S.C. 102 or for finding obviousness in view of *35 U.S.C. 103.

The published specifications of foreign patents with which we are concerned have a dual aspect; they are printed publications, and at the same time they represent foreign patents. There may be, and usually are, two different effective dates for reference purposes, one the effective date when used as a printed publication, and the other the effective date when used as a foreign patent. (The term "effective date" is here used to indicate the date we consider the document effective for the purpose we intend to use it; the same date may have little or no significance in the country of origin.) When used as printed publications everything disclosed in the specification is available for use, and the laws under which they were issued are irrelevant. When used as foreign patents some matters disclosed in the specification might not be available for use (see below), and complexities of foreign laws may arise in interpretation and in determining the effective date.

Excluding the U.S. and the extremely few, if any, which act similarly, three categories of countries can be distinguished.

1. Countries in which the specification is issued in printed form *before* the patent is granted. These include those countries which so publish the specifications at the time of publishing for opposition, and those countries which so publish the specifications of pending applications a certain time after filing. Probably the majority of specifications now received and placed in the search files are of these kinds. Since there is a printed publication of earlier date, the date (and also whether or not) the patent is granted becomes irrelevant. Where the specification is printed again when the patent is granted, the later copies are sometimes no longer placed in the search files. The specification of the patent might differ from the previously published specification

in some instances, but normally this would consist only in a narrowing of the claims with possibly a corresponding reduction of the specification. The application, the specification of which was issued in printed form, may be still pending or may have become abandoned; these facts are immaterial to the use of the printed specification as a printed publication.

2. Countries in which the specification is issued in printed form *only after* the patent is granted. Where the printed publication date is early enough for all purposes the fact of patenting is not important. But since the patenting date is earlier, the foreign patent can be used as a patent when the printed publication date is not early enough or has been overcome by an affidavit under 37 CFR 1.131. The effective date as a patent may be the actual date the patent was granted or some date which has been established for this purpose. In some countries the specification is issued in printed form so soon after the patent is granted that the question of establishing the earlier patenting date has not even arisen.

3. Countries in which the specification is *not issued in printed form*. These form the majority from the standpoint of the number of countries, but form a small minority with respect to the proportion of patents issued. Occasionally one is called to an examiner's attention, as in a motion to dissolve an interference; these can only be considered as patents and treated in the same manner as would be patents of group 2 countries above when a copy is obtained before the specification was printed.

The basis for using a foreign patent *as a patent* is the expression in the statute "patented . . . in . . . a foreign country" which has been quoted above. Hence it is the subject matter which has been patented in the foreign country which is the reference and not necessarily everything disclosed in the specification. Suppose the specification of the patent discloses two separate and distinct devices, A and B, and all the claims are restricted to A; the disclosure of B in the specification cannot be referred to at all. An extreme example like this is not apt to occur, and in the normal case that comes before the examiner there is little or no difference between the disclosure and what is patented. It is not always necessary for details relied upon to be specifically recited in the claims of the foreign patent since it is not the claims which is the reference but, in the language of the statute, the invention that has been patented. Once having determined what subject matter is available in the foreign patent for reference purposes, it can be used for anticipation or as a basis for determining obviousness, but any remaining subject matter must be blocked out of consideration. Office practice is illustrated by *In re Fuge*, 124 USPQ 105, 1960 C.D. 73 >(CCPA 1959)< and *Ex parte Ovist et al.*, 152 USPQ 709 >(Bd. App. 1963)<. Infringement suit decisions are *Reeves Bros. Inc. v. U.S. Laminating Corp.*, 157 USPQ 235 (**>E.D.N.Y.< 1968) and *The Bendix Corp et al. v. Balax, Inc.* 164 USPQ 485 (**>7th Cir.< 1970). There are still, however, a number of matters that need clarification and the result for some situations can only be determined when they arise.

D. GENERAL INFORMATION

a. Copies of Printed Specifications. The Patent and Trade-

mark Office receives, through the *Scientific and Technical Information Center<, copies of the printed specifications of patents, and of applications, from nearly all the countries which issue them in printed form. This is by exchange arrangements with the countries involved. Practice has changed in recent years with respect to the number of copies received, the type of records kept, and distribution of the copies. Most important, one copy of each invention is classified **and placed in the search files. Copies >received< from nearly all of the countries are so handled, all foreign language patent documents now being accompanied by an English language abstract.

Where the specification is printed twice, once during the application stage and again after the patent has been granted, only the first printing is in general placed in the search files. The second printing ordinarily does not vary from the first as to disclosure. If it does the variations normally would be deletions to correspond to reduction in the scope of the claims or perhaps to a requirement for restriction.

b. Unprinted Foreign Patents. Copies of specifications of patents of countries which do not issue them in printed form are of course not received. Occasional ones may come before the examiner; these may be supplied by applicants or cited in a motion to dissolve an interference.

When requested to do so, the Scientific *and Technical Information Center< will attempt to obtain a copy of an unprinted patent from the patent office of the country. In particular, official copies of Belgian patents can be obtained prior to the time they are issued; the *Scientific and Technical Information Center< will ask that the date of granting and the date the specification was available to the public be endorsed on the copy. The original is retained by the *Scientific and Technical Information Center< and a copy made for the examiner. The *Scientific and Technical Information Center< keeps a file of copies of unprinted patents which it has acquired. This file is checked before any request is made to the foreign patent office.

c. Official Patent Journals. Most countries issue an official patent journal, corresponding in general to the Official Gazette of the U.S. Patent and Trademark Office. In some both patent and trademark matters are included, while some countries have a separate journal for trademarks. These official patent journals may have the word Journal, Bulletin, Gazette, Record or an equivalent word, in their title and the official titles otherwise vary. The term official journal will be used here in referring to these publications broadly. Some countries do not have a special official patent journal but utilize a general government journal which mainly includes other matters.

Bound sets of the official journals are shelved in the *Scientific and Technical Information Center< adjacent the numerical patent collection of the particular country. Official journals are received from some countries which do not issue printed patent specifications; these are shelved in a different location.

Some countries issue annual indexes containing various lists relating to patents issued during the year, and other information. These are shelved adjacent the official journal of the country.

d. Translations. Examiners may request translators in the **>Translation Branch< of the *Scientific and Technical

Information Center< to assist them orally or with written translations of any specifications in languages with which the examiner is not familiar. See *MPEP< § 901.06(a) and >§< 903.03. Alternative versions of specifications, in English or other languages known to the examiner, can sometimes be found; see below.

e. Abstracting Services. The official journals of a few countries include abstracts of the disclosures of the patents announced or applications published. Separate classified abstracts, called abridgments, are published in Great Britain; the *Scientific and Technical Information Center< has a set of these abridgments.

Many technical abstracting publications include patent literature; the most notable of these is Chemical Abstracts. The annual indexes of Chemical Abstracts include, in addition to the subject matter index, an author index in which the patentee's and inventor's names appear, and patent number lists; corresponding patents of different countries are identified.

Specifications of unprinted, or as yet unprinted, patents may be included in some of these abstracting services.

f. Data on Printed Copies. Besides the text of the specification, and the drawing if any, the printed copies carry a certain amount of information concerning the patent and the application in a heading or on a special top page. Significant items, particularly dates, are referred to elsewhere. The organization composed mainly of examining patent offices (ICIREPAT, Paris Union Committee for International Cooperation in Information Retrieval among Patent Offices) has developed a numerical code relating to the bibliographic information on the copies and most countries use this code by placing the number, enclosed in a circle or between brackets adjacent to the corresponding item, even before it had yet reached its final accepted form. The major items of interest are listed to indicate the nature of the information which may appear. These code numbers are listed in >MPEP< § 901.04.

Some foreign countries list the references cited during the prosecution, following the practice started in the U.S. These, especially if they are U.S. patents, may be helpful, either as references of interest to the examiner or to suggest an overlooked field of search.

See >MPEP< § 901.05(a) for additional items.

g. Citation Dates. The information to be given in citing a foreign patent or specification is specified in >MPEP< § 707.05(e). The date used for citation purposes may be the effective date, or one of the effective dates, but in the case of some countries it may not correspond to the precise effective date of the reference. Details regarding dates, for a number of countries, are given in Part F.

The examiner has the duty of determining in the first instance that the effective date (or one of them) of the foreign patent or specification to be used as a reference is at least earlier than the filing date of the application being considered. This is no problem when the reference is at least several years older, in which case the citation date used may serve merely to show this fact and as part of the identification. Also, for most countries the necessary information is contained on the face of the publication. Certain countries with special problems are treated in detail in Part F.

A foreign patent may have two different effective dates as a reference, one the effective date as a patent and the other the effective date as a printed publication. This distinction is of importance only when the specification is printed *for the first time after* the patent is granted, and then only if the printed publication date is too late to be used at all, or too close to the filing date of the application being considered that the possibility of being overcome by an affidavit under 37 CFR 1.131 may exist. Except for these situations, it is simplest to regard the foreign printed specification, whether of a patent or of an application, merely as a printed publication and nothing more. With this view nearly all of the information in the present group of sections becomes merely background information indicating how these printed publications came into being, perhaps interesting and educational, but otherwise of no concern.

h. Corresponding Specifications. Since a separate patent must be obtained in each country in which patent rights are desired (except for the European Patent Convention and a group of African countries which have a common patent), there may be a number of patents of different countries for the same invention. The large increase in the total number of patents issued each year has been due in greatest part to the increase in the number of international filings; probably over half of the printed specifications issued each year are duplicates of others.

All of the countries listed in Part F are parties to the Paris Convention for the Protection of Industrial Property and provide for the right of priority. If an application is filed in one of the countries, an application for the same invention thereafter filed in a second country, within one year of the filing of the first application, will be entitled to the benefit of the filing date of the first application on fulfilling various conditions. (This subject is treated in *MPEP* § 201.13) The second country is required to specify that priority is claimed and to give the country, date, and the number of the first application, on the patent or specification which it issues. This data serves the purpose, among others, of enabling a patent issued on the first application to be located. There may be any number of these second applications, in different countries, and the group as a whole is usually referred to as a family of patents.

In general the specification of the second application is identical in substance to the specification of the first; in many instances the second, if in another language, is simply a translation of the first with perhaps some variation in purely formal parts. But in a minority of cases the two may not be identical. It is permissible to combine two or more first applications for different subject matter into one second application; also the second application could be filed for only part of the disclosure of the first. It is also permissible for the second application to have the relationship to the first which we refer to as continuation-in-part; the second application may occasionally include additional subject matter, such as a further example discovered after the first was filed. In some instances the second application could have its disclosure diminished or increased, to meet the requirements or practices of the second country.

The various ones of a family of patents will normally have different effective dates. In discarding duplicate specifications (*MPEP* § 903.03) a note should be written on the one retained giving the data relating to the one discarded, if the one retained

is not the one with the earliest effective date or dates, or both may be retained for a time.

The examiner may have occasion to specifically attempt to locate a foreign specification corresponding to a reference he or she may have on hand. This may be either for language purposes or for purposes of dates. The *Scientific and Technical Information Center (STIC)* will assist in or conduct the search for the duplicate version.

Duplicate or substantially duplicate versions of a foreign language specification, in English or some other language known to the Examiner, can sometimes be found. It is possible to cite a foreign language specification as the reference used, while at the same time citing an English language version of later date as a convenient translation if the latter is in fact a translation; any disputes in such cases must be settled by the language of the one which is used as the reference.

If a U.S. patent being considered as a reference claims the priority of a prior filed foreign application, it may sometimes be desirable to determine if the foreign application has issued or has been published, to see if there is an earlier date. A little experience will show when this would be fruitless and when some result is probable. The following situation actually occurred. The claims were rejected on the basis of a U.S. patent and the applicant filed affidavits to overcome the filing date of the reference; the affidavits were controversial and the case went to appeal, with extensive briefs and *examiner's answers* being filed. After all this work, somebody noticed that the U.S. patent reference claimed the priority of a foreign application filed in a country in which patents were issued fairly soon, checked the foreign application, and discovered that the foreign patent had not only been issued but also published in printed form more than one year prior to the filing date of the application on appeal.

If a foreign patent or specification claims the priority of a U.S. application, it can be determined whether the latter is abandoned, still pending, or patented. Even if the U.S. case is or becomes patented, the foreign documents may still be useful as supplying an earlier printed publication date.

If a foreign patent or specification claims the priority of an application in another foreign country, it may sometimes be desirable to check the latter to determine if an earlier date is possible. An example so obvious as to be trite and which does not occur very often is the following; if a British specification being considered as a reference claims the priority of an application filed in Belgium, it is known at once that a considerably earlier effective date can be established, if needed. If the application referred to was filed in one of the countries which publish applications in printed form a specified period after filing, after such system was instituted, this publication may give an earlier date. These remarks obviously also apply to a U.S. patent claiming a foreign priority.

The determination if a foreign patent corresponding to known priority data has been issued or the application published, is a comparatively simple matter for some countries, but for some it is quite laborious and time consuming and may not even be possible from *Scientific and Technical Information Center* sources. The greatest facility for locating correspond-

ing patents from unofficial sources exists in the chemical field. Chemical Abstracts publishes abstracts of patents of a large number of countries. Only one is abstracted in full and if a corresponding patent turns up there is a cross-reference to the other. The annual indexes include lists of patent numbers, and also include patentee's and inventor's names in the alphabetical author index. A concordance of corresponding patents appearing during five year periods has also been published.

When an application is filed outside the convention year from an earlier application, a patent issuing on the later one is sometimes possible, but it will not refer to the first application. It is hence possible that there may be duplicate specifications without any indication revealing the fact. These are caught only by chance when the two copies come together in the same subclass.

i. Proof of Dates. The examiner is not required to prove either the date or the occurrence of events specified on specifications of patents or applications, or in official journals, of foreign patent offices which the Patent and Trademark Office has in its possession. In a court action certified copies of the Patent and Trademark Office copies of these documents constitute prima facie evidence, in view of 28 U.S.C. 1745, which reads as follows:

"Copies of the specifications and drawings of foreign letters patent, or applications for foreign letters patent, and copies of excerpts of the official journals and other official publications of foreign patent offices belonging to the United States Patent Office, certified in the manner provided by section 1744 of this title are prima facie evidence of their contents and of the dates indicated on their face."

An applicant is entitled to show the contrary by competent evidence, but this question seldom arises.

The date of receipt of copies by the Office, as shown by office records or stamped on the copies, need only to be stated by the examiner, when necessary.

E. $\text{35 U.S.C.} < 102(d)$

$\text{35 U.S.C.} < 102(d)$ **provides that a patent cannot be obtained in the United States if:

"(d) the invention was first patented or caused to be patented by the applicant or his or her legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States."

This section specifies four conditions which, if all are present, establish a bar to a patent in this country. These conditions are:

- (1) The foreign application must have been filed more than twelve months before the filing in the United States;
- (2) The foreign application must have been filed by the same applicant as in the United States or by his or her legal representatives or assigns;
- (3) The invention was patented in the foreign country on the basis of the foreign application concerned before the filing in the U.S.;
- (4) The same invention is involved.

If such a foreign patent is discovered by the examiner, a rejection is made as being barred by 35 U.S.C. 102(d).

If the invention is patented after the date of filing in the United States, the foreign patent is of no concern. The law was different prior to the coming into force of the Patent Act of 1952. The effect of R.S. 4887, first paragraph, the precursor of $\text{35 U.S.C.} < 102(d)$ was that a person was barred from a U.S. patent if the invention was patented in the foreign country before the U.S. patent was granted. The situation was, the other conditions listed above being present, that if the U.S. patent issued first, there was no bar whereas if the invention was patented in the foreign country first, either before the U.S. case was filed or while the U.S. case was pending, a U.S. patent was barred. The change in the law rendered immaterial the patenting in the foreign country while the U.S. application was pending.

Under the old law it was the routine practice to have the Scientific Library make a search to ascertain if any so-recited foreign application had become patented. After the law was changed, this practice was found to be normally fruitless and was abandoned. As stated in $\text{MPEP} < \text{706.13}(s)$, the probability of the foreign patent having issued after the date of execution of the original oath and before the U.S. filing date is so slight as to make such a search ordinarily unproductive.

With respect to the first requirement, the U.S. application is in time to prevent the bar from arising if it is filed on the one year anniversary date of the filing date of the foreign application. If this day is a Saturday, Sunday or Federal holiday, the year would be extended to the following business day, see *Ex parte Olah et al.*, 131 USPQ 41 (**>Bd. App. < 1960). No questions appear to have arisen in recent times in connection with the second requirements, as ordinarily the foreign application is recited in the oath or declaration of the U.S. application, nor in connection with the fourth requirement.

Cases in which the bar of $\text{35 U.S.C.} < 102(d)$ might be applicable do not arise very often since all that an applicant needs to do to avoid it is to file in the U.S. before the invention is patented in the foreign country. Recent cases have been concerned with the German Gebrauchsmuster (*American Infra-Red Radiant Co., Inc., et al. v. Lambert Industries, Inc., et al.*, 149 USPQ 722, 360 F.2d 977 (**>8th Cir., 1966), the date of patenting in certain countries, and with special problems in design cases.

The statute does not refer to the "granting" or "issuing" of a patent in the foreign country but uses the expression "the invention was... patented... in a foreign country..." A period of secrecy after granting the patent before the specification becomes available to the public, as in Belgium and Italy, has been held to have no effect in connection with $\text{35 U.S.C.} < 102(d)$. *Granme Electrical Co. v. Arnoux and Hochhausen Electric Co. et al.*, 17 Fed 838, 1883 CD 418, involved a predecessor of 102(d); *Ex parte Weiss*, 159 USPQ 122 (**>Bd. App. < 1967), and *In re Talbot*, 170 USPQ 281 (CCPA* 1971) involved U.S. design applications in which the foreign design registrations were secret. A secret foreign patent of the type in which the patentee was forbidden to apply for patents in other countries or to disclose the invention, and no infringement suits could be brought with respect to infringements committed

before the secrecy was removed, was disregarded in *Ex parte Rackham*, 1923 CD 4 (**>Comm'r Pat. 1922<).

In design cases the period is six months instead of one year, 35 U.S.C.172. Foreign design registrations and applications for such registrations are considered equivalent to U.S. design patents and applications for the purpose of 35 U.S.C. 102(d) and 119. *Ex parte Weiss*, *In re Talbott*, supra.

F. NOTES ON INDIVIDUAL COUNTRIES

The following *>notes< give some data concerning the published patent material of a number of countries to assist in their use and citation as references. In some instances a small amount of information concerning the patent system of the country is included; this is done in order to give some idea of the variety of systems and also with the view that the significance of the different dates may become clearer. In general, citation data and the appearance of different dates on the printed copies refer only to the current or a recent period and might not apply to earlier forms of publications.

1. AUSTRALIA. Australia was the first country to adopt a system of publishing, but only in the sense of opening to public inspection, pending applications a specified time after filing. At present the time is 18 months after the filing of the complete specification, or earlier if the applicant requests. There is an announcement in the official journal and anyone may inspect or obtain copies of the application, but the specification is not issued in printed form at this time. This does not constitute a printed publication. *Ex parte Haller*, 103 USPQ 332>(Bd. App. 1953)<. At the same time that the application is published in this sense, printed abstracts are issued. The abstracts published since 1969 are stored in the *>Scientific and Technical Information Center< and can be used as printed publications for whatever they actually disclose. Australian patents are now provided in the form of microfilm, *In re Wyer*, 210 USPQ 790 (CCPA 1981).

Applications are examined with a limited search of the prior art (except as noted below) and after being found allowable by the examiner, the term "Accepted" is used. *A notice of the acceptances is published in the official journal. There is a 3-month period for oppositions to be filed. The specifications of the allowed applications are issued in printed form a short but variable time after publication of the notice of the acceptance. The date of this printing does not appear anywhere; it has no significance in Australia. (A date which may appear in a footnote type line at the bottom of the first page is not the date of the printed publication.) The patent is granted (sealed) after the opposition period is over or after any opposition is terminated in favor of the applicant. The sealing date is normally about six months after the Accepted date but would be later if there was an opposition; this date can be ascertained from the official journal in the *>Scientific and Technical Information Center<.

Printed copies of the specifications carry the filing date (application "lodged"), the date the application was opened to inspection (after the word "Published", or the phrase "Complete Specification Published"), and the date of acceptance (after the word "Accepted" or the phrase "Complete Specification Ac-

cepted"). The word "Published" on the copies refers to the 18-month opening for inspection referred to in the first paragraph.

When dates are fairly close the examiner must ascertain when the printed copy was received in the *>Scientific and Technical Information Center<, or when the patent was sealed and cite this date, with an explanation. When the Australian specification is so old that questions of its availability as a reference, or of swearing back of it, would not be apt to arise, the "Accepted" date can be used for citation purposes but denominating it as such.

The examination system was modified in 1970 by a new law. Under the new system when an application is reached for examination in its regular turn, the applicant is sent a letter which notifies him that he must request examination, and pay a special examination fee within six months (which time can be extended in certain cases). If the examination is not requested within the time limit, the application becomes abandoned (the word "lapsed" is used). In any event the examination must be requested within five years from the filing of the complete specification, otherwise the application becomes abandoned. The examination is the same as before except that in certain cases a modified examination, by paying a lesser fee, can be requested. If the application is based on a prior U.S. or British application and the prior application is patented, the applicant can amend the Australian specification to make it the same as the patented one and ask for a modified examination; the examiner then, to a certain extent, accepts the findings of the U.S. or British examiner.

The number appearing on the printed copies is assigned at the time of acceptance; under the new system, the series was jumped to 400,001 as the number of the first one. Also under the new system, the publication of the specifications of >applications< which became abandoned (lapsed) after they were opened to inspection, has begun. These carry only the application number.

2. AUSTRIA. Printed copies of Austrian patents carry the expression "Ausgegeben am . . ." followed by a date. This is the date the patent specification was issued in printed form and is used for citation purposes as well. It now appears beneath the line in large type giving the patent number, and formerly appeared in the upper right hand corner.

Applications are examined and laid open for opposition if found allowable; the opposition period is four months. The patent stands granted by operation of law 30 days after the expiration of the opposition period if there was no opposition or after the date of a favorable final decision if there was an opposition; no specific action is taken by anyone. The date of grant is published in the official journal about six weeks before the printing date.

The term of the Austrian patent is 18 years from the date of the laying open for opposition, which date is identifiable as the date following the expression "Beginn der Patentdauer": (beginning of the term of the patent) which appears on the printed copies.

3. BELGIUM. Belgian patents are normally granted within a month from filing, after a minimum formal inspection; in some cases the granting is delayed until six months after filing.

The granting of the patent consists in the making up and signing of a "ministerial decree" or departmental order, which remains in the file; in due time the applicant (now patentee) is sent what amounts to a certified copy, with an attached copy of the specification. In the normal case the specification of the patent is kept secret for a period of three months after the patent is granted, by a specific provision in the statute, after which it becomes available to the public. Such a period of secrecy is tacked onto the granting date and the date of a Belgian patent as a patent to be considered in using it as a reference under 35 U.S.C. 102(a) and (b) is taken as the date when the specification became open to public inspection, *In re Ekenstam*, 1958 C.D. 402; 118 U.S.P.Q. 349 >(CCPA 1958)<. (A period of secrecy occurring after grant has not been taken into account in connection with 35 U.S.C. 102(d). There is no period of secrecy after granting in the delayed issue cases and the effective date as a patent for these cases is the actual date the patent was granted.

The specifications are not issued in printed form until about two or three years after the patents are granted. The printed copies received since No. 620,001 (granted January 10, 1963, available to the public January 10, 1963, printed February 2, 1965) consist in a reproduction of the granting Order as the top page, together with a reproduction of the specification and drawing. The filing date appears in the preamble of the Order; the patentee's name and the title of the invention, and any claim for priority, appear in Article 1; and the granting date is at the end above the official's signature. The date on which the specification became available to the public appears in the upper right hand corner in the lower part of a rectangular frame, below the expression "Brevet mis au lecture" in the French language copies. This is the date to be used for citation purposes and as the effective date as a patent. The date on which the printed copies were issued as such does not appear on the copies, but can sometimes be ascertained from the title page of the bound volumes. The copies are received in groups of 50 already sewn together for binding, with a title page giving the date on which they were printed and published.

Belgian specifications were not issued in printed form until 1950, beginning with No. 493,079 and these continued up to No. 573,100 (filed November 18, 1958, granted December 15, 1958, available to the public March 16, 1959, printed September 21, 1982) when printing ceased for three years until resumed in the format first described. There is hence a gap of 46,900 patents for which printed specifications have not been received. The printed copies of the 1950-1958 period carry the date they were issued in printed form in a line at the bottom of the first page, "Edite et imprime le — — —," on the copies printed in French. For the first year only, 1950, they show the date the specification was available to the public, after the word "Public," which in this instance does not refer to printed publication. The granting date is specified on all, after the word "octroye" on the French language copies. Further details on Belgian patents with a more particular description of the older printed copies and the method of determining the effective date as a patent when not given, are in the Memorandum of March 2, 1959, published at 41 J.P.O.S. 440-443, June 1959.

Belgian chemical patents are abstracted in various publica-

tions and these published abstracts can be used as printed publications for what they disclose. If the examiner needs the full text of a Belgian specification which has not yet been printed, the *Scientific and Technical Information Center* can be requested to obtain a certified manuscript copy.

4. CANADA. Patents have been issued in printed form since January 1948. The date of issue of the patent appears on the copies following the word "Issued", or the words "Emis le" on those printed in French. Prior to 1948, mounted clippings from the official journal were placed in the search files. Recent copies are coded, the issue date being item 45.

5. CZECHOSLOVAKIA. The Czech patent specifications carry the date the application was laid open to public inspection for opposition, following the word "Vyloženo" or "Vyložene", and the later date of publication of the specification in printed form, following the word "Vydano" or "Vydane". The publication date is the date to be cited.

6. DENMARK, FINLAND, NORWAY, SWEDEN. A new patent law came into effect in each of these countries on January 1, 1968. Most of the provisions of these laws are practically identical**.

Applications are examined and when found allowable published for opposition. Under the new laws the practice of issuing the specifications in printed form at this time has begun. This publication is a reproduction of the manuscript specification with added heading material; those for Denmark and Norway are on different shades of blue paper and those from Finland carry the data identification code numbers. They have been given a new number in the patent number series of each country, and carry three dates. The first date is adjacent the application number and is the filing date; the second date is referred to below; and the third date, the latest in time, is the date used for citation. There will be a second printing after, and if, a patent is granted.

Under the new laws, applications are opened to public inspection 18 months after the filing date, or priority date if one is claimed. There is no printed publication at this time. The date of this laying open for inspection is the second of the three dates which appear on the subsequently printed specifications and has no effect in the U.S.

Prior to this new system there was only one printing, of the patent. The printed specifications of the patents carry the following information:

DENMARK: The date the patent was granted follows the expression "Patent udstedt den...". The date, later in time, the specification was published, follows the expression "Beskrivelse offentliggjort den...".

FINLAND: The upper right hand corner gives the date the patent specification was published, following the expressions "Julkaistu/Publicerad". The date the patent was granted, which is earlier, follows the expressions "Patenti myönnettiin — Patent beviljades den". These expressions are in two languages, first Finnish then Swedish.

NORWAY: The date the patent specification was published appears in the heading following an expression beginning with the word "Offentliggjort".

SWEDEN: The upper right hand corner bears three dates;

first the date the patent was granted, after the expression "Beviljat den", and third the date, later in time, the patent specification was published, after the expression "Publicerat den"; the middle date is stated as the date the patent term starts, which is the date of publication (not printed) for opposition.

The publication date is the date to be used for citation of these old law patents; the occasion for resorting to the earlier granting date seldom if ever arises.

7. EAST GERMANY. The patents of East Germany (German Democratic Republic) can only be used as printed publications. The date of this publication follows the word "Ausgabetag", and is the date to be cited. Patents are granted after a formal examination and the specification issued in printed form on yellow paper. An examination as to novelty may be requested later by the patentee and the patent office will confirm the patent or annul it in whole or in part. If confirmed (or only annulled in part) the specification is printed again, on white paper. This second printing carries its own publication date (Ausgabetag); the date of the earlier publication is the date following the expression "In Kraft getren," as indicated by a footnote at the bottom of the first page.

>East Germany ceased to exist at midnight on October 2, 1990. As of October 3, 1990, only one German state, the Federal Republic of Germany, exists, comprising both East and West Germany.<

8. FINLAND. See under "Denmark, Finland, Norway, Sweden".

9a. FRANCE: LAW OF 1844-1968. In view of a change in the French system caused by a new patent law which came into effect January 2, 1969, French patents are considered in two sections. The present section deals primarily with the old law cases but present tense is mainly used, for convenience.

Prior to the new law patents were granted after an examination as to formal matters only, but an application for subject matter we would call outside the statutory classes of invention could be rejected. The granting of the patent consisted in the execution of a paper called an "arrete ministeriel" which term is literally translatable as "ministerial decree", but "departmental order" is also used. This decree or order remains in the file; the applicant is notified and some time later he is sent what amounts to a certified copy, with an attached copy of the specification. About five weeks or so after the granting of the patent announcement appears in the Official Bulletin which, in recent years, also publishes an abstract at the same time the specification of the patent is issued in printed form about four or five months later.

The specifications and drawings of French patents have been regularly published, in separate printed leaflets since 1902. Prior to this time only selected ones were published in book form with the specifications and drawings in separate volumes, and mounted copies of the drawings were placed in the search files.

From 1902 up to a date in 1960, the printed specifications of French patents regularly carried three dates in the heading. For example French patent 1234900, the last one to do so, has the following in the heading:

(1) "Demande le 28 juillet 1959, a 14h 48m a Paris." [Filed July 28, 1959 at 2:48 P.M. in Paris.]

(2) "Delivre le 23 mai 1960." [Granted May 23, 1960.]

"Publie le 19 octobre 1960." [Published October 13, 1960.]

The first date, the "Demande" date, is the date the application was filed; the hour of the day is given since there are no interferences and the patent of the applicant who filed his or her application first would be the valid one; the city is given since applications may be filed in various local government offices throughout the country. The second date, preceded by the word "Delivre", is the date the patent was granted; the French verb "delivrer" when used with reference to patents means "to grant." The third date, preceded by the word "publie", is the date on which the specification was issued in printed form.

Beginning with Patent No. 1234901 (granted May 23, 1960) the *publie* date has been omitted from the printed specification. It is hence not possible to tell from the printed copies when they were issued in such form. This information, however, can be found in the Official Bulletin which contained periodical lists of the numbers of the specifications which have been printed giving the dates when the printed copies were available to the public. Later, the identification of the Official Bulletin in which the patent was announced was added to the heading, at first without the date. Currently, and recently, the heading gives the filing date, the granting date, and the date and number of the Official Bulletin. The most recent format has a coded cover page; item 46 gives the date of the Official Bulletin.

In 1957 there was a change in the practice in the French Patent Office, which required a change in the practice of the U.S. Patent and Trademark Office. The specifications of granted patents were made inaccessible to the public from the date the granting order was executed, until the date, of the appearance of the Official Bulletin announcing it, and it is only on the later date that members of the public could inspect and obtain copies of the specifications of patents. This change in practice is indicated by a notice in the Official Bulletin which first appeared in the issue for July 11, 1957, and is taken as beginning with patent No. 1,148,401, the first one announced on that date. It is hence necessary to apply *In re Ekenstam*, 1958 C.D. 402, 118 USPQ 349 >(CCPA 1958)<, to these patents and consider the date of the Bulletin as the effective date as a patent.

Summary, old law patents: There are numbered below 2,000,000. The effective date as a patent is the granting (*delivre*) date up to No. 1,148,400, and is taken as the date of the Official Bulletin from No. 1,148,401. The effective date as a printed publication is about four or five months later, when printed copies are issued. For citation purposes, the *PUBLIE* date is used when this appears; the *delivre* date, or the date of the Official Bulletin if it appears, is used when the *Publie* date does not appear.

Patents of Addition: These are referred to as "certificates of addition" and were numbered in a separate series and when one of these is cited it must be identified as an addition.

Special Medical Patents: Beginning in 1958, patents for medicaments were issued under the heading "Brevet special de medicament", abbreviated as B.S.M., in a separate numbering series, with the letter "M" after the number. These were granted only after a search was made and a search report filed.

The separate numbering of patents (certificates) of addition and of patents for medicaments has been discontinued under the

new law.

Application Numbers: Patent applications can be filed in France in a local government office in each Department. Each local office maintains a register and has its own series of serial numbers, for applications filed there. The applicant is given, as a receipt, a copy of the memorandum or record entered in the register which is known as a "proces verbal." The local office then promptly forwards the papers to the patent office in Paris. The application number, when given, appears on the printed specifications following the abbreviation "P.V." While there are thus many different series of numbers, the ranges covered in a given year apparently do not overlap and the city of filing is ordinarily dropped. Under the new law, the numbering system has been changed.

9b. FRANCE: LAW OF 1969. The new law which came into effect January 2, 1969 did not apply to applications already on file and the remarks made in the preceding **>note<* apply for an overlapping period after this date.

Under the new law patents are divided into two classes: "patents for invention" and "certificates of utility." The term of the patent is 20 years from the filing date and of the certificate of utility 6 years from the filing date. Except for the fact that medicaments can be patented, there is no other difference between the two in subject matter, the conditions for patentability, or in the rights granted.

The certificate of utility is issued in due course without any search of the prior art, as all patents except those for medicaments were issued under the prior law.

An application for patent is subjected to a novelty search and report, a special fee being paid. Except in the case of medicaments, the applicant may request postponement of the novelty search up to two years. If the search is not requested by that time, the application is automatically converted to one for a certificate of utility. Also the applicant himself may convert the application to one for a certificate of utility during this period.

The novelty search was conducted by the former International Patent Institute at The Hague, >Netherlands, now part of the European Patent Office,< and an initial novelty report **>was<* issued. The applicant **>could<* file arguments and amendments and a second report **>was<* issued. This report and the file are open to the public and third parties may file references and statements, with the applicant having an opportunity to file arguments and amendments. A final novelty report **>was<* then issued. There is no actual rejection or refusal of a patent, but the patent **>was<* granted with the record of the report.

The system of novelty searches commenced in January 1969 with respect to certain classes only, and has since been extended to additional classes. For the remaining classes patents are granted substantially according to the old system, without novelty search, but an action for infringement cannot be brought unless a novelty report is made. Patents granted under the old law likewise cannot be sued on unless the patentee supplies a novelty report. Patentees could order novelty searches and reports directly from the International Patent Institute which is now a part of the European Patent Office.

Patents (both kinds) under the new law have claims instead

of the old "resume."

Under the new law all applications are open to public inspection 18 months after the filing date, or the priority date if one is claimed, unless the application has been abandoned (withdrawn). The specifications are also issued in printed form a short time thereafter. This publication may occur earlier on request of the applicant. If the patent is granted early enough, the publication of the application as application does not occur.

The system of application numbers has been changed. When received by the central office all applications are renumbered in a single series; the first two digits of the new number are the last two digits of the year of filing. The new number replaces the P.V. number and is referred to on the printed copies as the "national registration number".

When the specification is published the first time, either as application or as patent if there was no preceding application publication, the case is assigned a publication number. These numbers begin with 2,000,001 and are retained thereafter, being or becoming the patent numbers. The separate numbering of medical patents has been dropped and they are now numbered in the same series. Likewise the separate numbering of patents of addition has been dropped and these are also numbered in the same series. There may be a certificate of addition to a certificate of utility, but identification as such is not essential.

The printed specifications of pending applications are reproductions of the original papers, with a cover page from set type giving certain information, issued on light green paper.

The specifications of patents are printed from set type, with a new format cover page, on white paper. If it is the initial publication, the words "Premiere et Unique Publication" (first and only publication) appear in a box beneath the heading. If it is the second publication the words "Deuxieme Publication de l'Invention" appear.

In both forms the cover page is coded: application number, item 21; filing date, item 22; applicant, item 71; publication of patent number, item 11. There have been some changes in the coding, however, and some confusion may remain.

The printed specifications of applications give the date the application was open to public inspection, uncoded or item 41, but do not give the date they were published in printed form, which date is of no concern in France. For the time being the date copies were received in the **>Scientific and Technical Information Center<* is the date to be used as the effective date; if a more precise date is needed, the **>Scientific and Technical Information Center staff<* will attempt to obtain further information from the French Patent Office.

The printed specifications of patents give the date of the publication of the notice that the patent was granted in the uncoded line reading "Publication de la delivrance." For the time being the date appearing in this line is taken as the effective date as a patent.

It appears that publication of lists of numbers of the specifications available in printed form, with the dates they were so available, has been discontinued.

10a. GERMANY. The first patent law of united Germany came into effect in 1877 and printed copies of specifications of patents have been received from number 1 of 1877. Applica-

tions were examined with a search of the prior art. When found allowable by the examiner, the application was published for opposition and within three months anyone could oppose the granting of a patent. The procedure is outlined in *Ex parte Gruschwitz et al.*, 1963 C.D. 859, 138 USPQ 505 >(Bd. App. 1961)<, with further details in *Ex parte Beik **>et al.<*, 161 USPQ 795 >(Bd. App. 1968)<.

For patents with numbers below 1,000,000, the printed specifications carry a date in the upper right hand corner which is preceded by the words "ausgegeben am". This is the date on which the specification was issued in printed form and is used for citation. (It was also used for the date the patent was granted, which does not appear on the copies, but this is no longer of any concern to examiners.) These are printed on white paper.

Prior to September 1955 the only printing of the specification was after the patent was granted. From September 1955 through December 1956, the specifications of allowed applications published for opposition were issued in printed form in a format similar to patent specifications. These are headed "Patentanmeldung" and carry the application number. These are printed on white paper.

Beginning in January 1957, allowed applications published for opposition were renumbered and issued in printed form on green paper. These are headed "Auslegeschrift". The numbers begin with 1,000,001. When and if the patent is granted the specification is printed again as a "Patentschrift", on white paper, and carries the same number. Shortly after this system began, the placing of printed copies of the specifications of patents in the search files was discontinued since *>there< was a printed publication of earlier date. The numbers had not reached 1,300,000 when a new law came into effect.

On October 1, 1968, the German Patent Office shifted into a new examination schedule similar to the deferred examination procedure followed in the Netherlands since 1964, but with a few differences. When an application is filed it is not up for action on the merits but just remains a pending application until there is a request for examination, with an examination fee. If there is no request within seven years from the filing date the application is no longer pending, and the application may also lapse for nonpayment of annual maintenance fees which are due for the third and following years from the filing date. The applicant may ask for a search and citation of references only, paying one third the fee, and the examination may be requested later (with the balance of the fee) but still within the seven years. (Anyone else may pay the fee and request the examination, but he does not become a party to the proceedings.) There is no change in the actual examination procedure, which still follows that outlined in *Ex parte Gruschwitz et al.* The only difference is in the timing, with some cases having a separate search report in the record before the first action on the merits, but some cases will never be examined at all.

Under the new law every application is open to the public and the specification and drawings are published in printed form, 18 months after the filing date or 18 months after the priority date if one is claimed, if then still pending, but a preceding notice must appear in the official journal.

Applications filed before October 1, 1968 and still pending on that date were brought under the new law with the exception

of those which had reached a certain stage in their prosecution. Publication of these prior applications is being spread over a period of several years.

After the application is published, the applicant has certain provisional rights, not full patent rights, which can be exercised against infringers, but which are unenforceable if the application becomes abandoned.

The new publications are photo-offset reproductions of the manuscript specification, and drawings if any, with a top page printed from set type. They are printed on yellow paper. The top page serves as a heading and gives a certain amount of coded information. The German word "Offenlegungsschrift" appears in large letters in the heading; this is the word specially coined to designate these printed specifications (in the German plural "en" is added to the word). They are numbered with a seven digit number greater than 1,400,000. The number corresponds to a new system of numbering applications referred to below. The items appearing on the first page are coded and following is the significance of some of them.

21. Aktenzeichen. The application number; the old number, if there was one, is in parentheses.

22. Anmeldetag. The filing date.

30-33. Data with respect to a priority application.

43. Offenlegungstag. The publication date. This is the date to be used for citation purposes and as the effective date as a printed publication.

71. Applicant, who need not be the inventor.

72. Inventor. The system of numbering applications has been changed. According to the old system the application number consisted of the initial letter (or first two or three letters) of the applicant's name, followed by a serial number, with a different series of numbers for each initial letter; the examining group and classification followed the number but these were not used for identification purposes. According to the new system, the first case filed in October, 1968, is numbered 1,800,001 and the numbers increase to the end of the year; the first case filed in 1969 is numbered 1,900,001 and the first case in 1970 is numbered 2,000,001, and so on. The first two digits of the number are 50 less than the last two digits of the year. The prior applications which were brought under the new law were renumbered to fit into the new system, beginning with 1,400,001, but here, however, the correspondence with the year of filing does not regularly exist. As applications, the numbers also have an additional decimal number following the seven digit number, but this has only internal significance to the German Office and is dropped; the letter P may also appear before the number, this refers to "patent" and distinguishes from Gm referring to Gebrauchsmuster. The published specification will carry the same number as the application (dropping the letter P and the decimal part); if the application is allowed and published for opposition, it will be printed again on green paper with the same number; and if a patent is issued the specification will be printed again on white paper, with the same number.

The published specifications constitute references as printed publications, effective on their publication date. They may be cited and referred to as German Specifications, with the usual citation data. This term may also be used for the published (printed) specifications of allowed German applications.

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For convenience of distinction, following is a list of the four types of German publications of specifications in printed form.

A. Patent specifications (Patentschrift). White paper. If numbered below 1,00,000 there will not have been any earlier printed publication except in cases of the group of paragraph B. If numbered above 1,000,000 and below 1,400,000 there will have been an earlier printed publication (see paragraph C) and if numbered above 1,400,000 there may have been two earlier printed publications. The patent specifications with numbers above 1,000,000 have not been placed in the search files since 1957.

B. Specifications of allowed applications published for opposition (Patentanmeldung). White paper. The specifications of allowed applications published for opposition were issued in printed form beginning September, 1955 and through December, 1956 in a format similar to patent specifications. These carried the application number and the heading "Patentanmeldung."

C. Specifications of allowed applications published for opposition (Auslegeschrift). Green paper. These began January 1937 and are numbered above 1,000,000. If numbered above 1,400,000 there will have been an earlier printed publication (see paragraph D) except for those which were allowed before 18 months from filing. Those numbered above 1,400,000 have a new format coded cover page; the date of printed publication is given opposite item 44 and of the earlier printing, if any, opposite item 43.

D. Specifications of applications, unexamined or in process of examination (Offenlegungsschrift). Yellow paper. Described above; this printing is skipped when the Auslegeschrift is published first. These documents are printed publications but should not be considered to be patents, *Ex parte Links*, 184 USPQ 429 (Pat. Off. Bd. Apps. 1974).

10b. GERMANY: Gebrauchsmuster (Utility Models). The German law, in addition to the regular patent law, provides for short term patent rights in new and useful articles of manufacture (processes and compositions of matter being excluded) which might be (but not necessarily) of a lower order of inventive merit than required for the longer term patent. These go by the name of "Gebrauchsmuster" which word is customarily translated as "utility model" and might also be translated as "useful article". The term "petty patent" is also sometimes used. They are registered without search and the specifications and drawings, while available to the public, are not issued in printed form. The term is three years, counted from the filing date, and they are renewable for another three year period. Copies of course are not placed in the search files except for a few which have come to the examiner's attention.

Right of priority. An application for a Gebrauchsmuster is considered to be an application for a patent in a foreign country, and consequently the right of priority of 35 U.S.C. 119 can be based upon such an application. A small proportion of applications for patent filed in the United States by German residents claim the priority of a previously filed application for a Gebrauchsmuster. When endorsing the number of the foreign application on the face of the U.S. file the examiner should be careful in noting the nature of the foreign application as a "utility

model" by using the abbreviation "Gm".

Not a printed publication. When a German utility model is registered a notice thereof is published in the official journal, the Patentblatt, and the specification is then available to the public. The regular publication of abstracts of the specifications (with a figure of the drawing) of registered Gebrauchsmuster began in July, 1964, with number 1,895,601, in a new periodical "Auszüge aus den Gebrauchsmustern" which is in the *Scientific and Technical Information Center*. These abstracts may be used, for their content, as printed publications. The effective date would be the date the periodical was published. See *Bendix v. Balax*, 164 USPQ 485 (7th Cir. 1970).

Inasmuch as the full specifications are not issued in printed form, they cannot be used as printed publications, in conformity with decisions of the courts and of the Office that manuscript specifications of issued patents, and of applications laid open for public inspection, are not printed publications.

Prior patents. The examiners may use a Gebrauchsmuster which has come to his or her attention as a prior patent, effective as of the date of registration, in the same manner as they would use a Belgian or Italian patent for the period of several years after it is granted and before the specification is issued in printed form. See Part C.

The registration of a Gebrauchsmuster also constitutes the patenting of the invention in a foreign country for the purpose of Section 102 (d) of the statute.

If the examiner needs the full text of a Gebrauchsmuster specification and drawings, the librarian will obtain a copy direct from the German Patent Office. A file of copies which have been obtained in the past is maintained in the *Scientific and Technical Information Center*. Copies received from Germany may have a clipping from the official journal pasted near the top of the first sheet and close to it a stamped date which is the registration date.

Minor patents of other countries. Some other countries, including Italy, Japan, Poland, Spain, Brazil, Portugal, Philippines, also have a system of minor patents. In the Philippine and Italian laws they are called "patents for utility models." In Japan they are searched and examined, and the specifications are printed, but these have not been placed in the search files.

11. Great Britain (United Kingdom). British specifications published in printed form go back to the 17th century. From the standpoint of the numbering system used they are divided into three groups.

1. 1617-1852 (part). Patents are numbered in a single series from No. 1 of 1617 to No. 14359 of 1852. The year is necessary in citing one, to avoid confusion with later series. The numbering and printing was done after 1852.

2. 1852 (part)-1915. Each year has its own numbering series and hence the year, which appears on the specification in large type next to the number is an indispensable part of the identification number, and no further date need be given. The number and year also appear on the drawings but occasionally an exponent appears on the number, giving the corrected year.

3. From 1916. Beginning in 1916, a new number was assigned when the application was allowed (accepted), starting

with No. 100,001, and this is the current series.

The second group includes at various times the specifications of applications which became abandoned, and at one time after 1916 the specifications of certain abandoned applications were also published in printed form. The word abandoned is not used but "became void" is used instead.

An application may be filed "accompanied by" either a "provisional specification" or a "complete specification".

The provisional specification need only describe the nature of the invention; it does not need to have an enabling disclosure and neither drawing nor claims are required. Its purpose is to establish a priority date. The complete specification must be filed within 12 months, with three months extension possible; if not filed, the application becomes void. ** The subject matter of several provisionals may be joined in one complete.

Applications are examined, on the basis of the complete specification, but the examination is partial. In general only prior British specifications are searched (specifications over 50 years old, of any country, are not references in any event), and the question of obviousness cannot be raised by the examiner. When the application is allowed, the British use the words "accepted" and "acceptance" where the U.S. Office would use "allowed" and "allowance". It is published for opposition and the opposer can cite any applicable references and raise all questions of patentability.

At the time of allowance and publication for opposition, the specification is assigned a number and published in printed form; these are the copies which are placed in the search files. The copies for some time have carried the expression "complete specification published", with a date; this is the date to be cited and used as the effective date as a printed publication, see *In re Monks*, 200 USPQ 129 (CCPA 1978). Older copies have the expression "complete specification accepted", with a date, which is used for citation. Recent copies are coded, but the number 45 is used, instead of the apparently more appropriate number 44, for the date the specification was issued in printed form.

After the opposition period is over, or after a favorable decision if there was an opposition, the patent is "sealed" (there is a sealing fee). This term is used to signify the granting of the patent involving the making up of the "letters patent" with the signing and affixing of a seal, and comes from the time when the last act in granting a patent was affixing the Great Seal of England, which was quite a formal occasion. Lists of sealing dates are published in the Official Journal. There is no second printing of the specification when or after the patent is granted. Amendments if any may be printed on slips for attachment, but we do not use them. A British patent can be amended similar in extent to a non-broadened or narrowed reissue in the U.S. but in a simpler manner, and an "amended specification" is sometimes published.

12. HUNGARY. The date of the printed publication of the specification of the patent is given at the top, following the word "Megjelent," in the order year, month, day.

13. ITALY. Separately printed copies of the specifications of Italian patents have been received since 1925. The date the

application was filed is given in the heading opposite the words "data di deposito" and the date the patent was granted is given opposite the words "data di concessione". Prior to No. 500,001, granted in 1954, different words or abbreviations were used in referring to filing (Dpd., Domandato) and to the granting (Dcs., Rilasciato, Concesso).

Copies of the specifications are not issued in printed form until some time after the patent is granted, generally two or three years. Prior to about the middle of 1957 (year of grant) a printer's colophon on the last page indicated the month and year of printing. This has been dropped and it has not been possible since then to ascertain from any information in our Office when the specifications were published in printed form. The date they were received in the *Scientific and Technical Information Center< here gives a limiting date.

Since Italian patents are granted some time before there is a printed publication, they are used as patents when the printed publication date is not early enough. However the date the patent was actually granted is not used as the effective date as a patent since the specification is kept secret by law for a period after the granting and the date the specification became available to the public must be used instead, *In re Ekenstam*, >45 CCPA 1022, 256 F.2d 321, 1958 CD 402, 734 OG 290, 118 USPQ 349 (CCPA 1958)<. The period is normally three months except that in a small proportion of cases the period of secrecy is extended to six months. The official journal of the Italian Patent Office, the "Bollettino", indicates if there was a six months period of secrecy, but only through the year 1962.

The Memorandum of October 26, 1960, 42 J.P.O.S. 795-8 gives some further details.

The granting date is used for citation purposes. However, the applicant should be advised of the effective date as being three months or six months later when this information may be useful to him. A dilemma is created if the filing date of the application being examined is between 3 and 6 months after the granting date of a prospective Italian patent reference. The *Scientific and Technical Information Center< will write to the Italian Patent Office to attempt to ascertain the date the specification became available to the public. In the meantime the patent could be cited for the applicant's information, pending determination of its availability.

14. JAPAN. Japan enacted a new law in 1970, effective January 1, 1971, which introduced a form of deferred examination procedure.

Referring to cases under the old law, the specifications of allowed applications are published in printed form at the time of publication for opposition. This date appears on the printed copies in Arabic numerals, in the order year, month, and day. The year is given by the regnal year of the present Emperor**. The date appears in the upper right hand corner, beneath the number. The number is assigned at the time of publication and the first two digits, spaced from the remainder, are the regnal year. >To convert the Japanese year of the Emperor to the Western calendar year, for years prior to 1989, add 1925 to the JAPANESE YEAR. For example: 40.3.6 = March 6, 1965. For years after 1988, add 1988 to the JAPANESE YEAR.<

Recent published specifications use the date information

code and give the calendar year, as well as the regnal year, of publication.

15. **NETHERLANDS.** The Netherlands inaugurated the deferred examination system on January 1, 1964. Applications when filed are not examined, except to determine if they are formally in order. At any time within seven years after filing, the applicant may request a search report, paying a fee for the same. After the search report is received, the applicant may request the examination of the application leading to granting of the patent, paying another fee; this likewise must be done within the seven years except that there is an extension of up to four months from receipt of the search report if the search request was made near the end of the seven years. If there is no search request within the seven years, or if there was one but no examination request within the allowed time, the application becomes abandoned. After the second year, an annual fee is due to keep the application pending.

As part of the system applications are open to public inspection 18 months after filing, or after the priority date if one is claimed, and the specifications are published in printed form unless the application has already been abandoned. Certain provisional rights begin with this publication.

The published specifications are reproductions of the originals with a cover page or heading, printed on light green paper. The number appears in the upper right hand corner of the cover page (Octrooiaanvraag No.); this is a seven digit number the first two digits of which are the last two digits of the year of filing. The date of publication is next to the phrase "Datum van ter inzagelegging;" and the applicant's name is next to the word "Aanvrager".

The Netherlands examination is particularly severe. When found allowable, the application is laid open for opposition and the specification is at that time also issued in printed form (making a second printing since 1964). If the patent is granted, the specification is again issued in printed form (making a third printing, since 1964), an earlier printed publication, the specifications of granted patents are no longer placed in the examiner's search files. Copies of allowed applications published for opposition were never received by the U.S. Patent and Trademark Office.

16. **NORWAY.** See under "Denmark, Finland, Norway, Sweden".

17. **POLAND.** The date the specification of the patent was published appears in the upper right hand corner following the word "Opublikowano".

18. **SWEDEN.** See under "Denmark, Finland, Norway, Sweden".

19. **SWITZERLAND.** Two different systems are in operation in Switzerland. The majority of patents are issued without search and examination in the light of references, but after a rigorous examination as to form. The date used for these is the publication (veroeffentlich, publie, pubblicato) date; this is the date the specification was issued in printed form.

In two fields, inventions relating to timekeeping, and inventions relating to the nonmechanical treatment of textiles and fibers, applications are searched and examined in the light of the prior art and the procedure differs from that followed in the other

cases; it follows, in general, the procedure in Germany as described in *Ex parte Gruschwitz et al.*, 1963 C.D. 859, 138 USPQ 505 >(Bd. App. 1961)<. Patents which have been issued under the examination system can be recognized from information given in the heading which refers to the publication of the application (in the French and German language applications, Demande publiee and Gesuch bekanntgemacht, respectively) for opposition. As in the German practice, when a case is found allowable by the examiner the application is published for opposition and the specification is issued in printed form (called Auslegeschrift on the German language copies and Memorie expose on the French). These printed copies have not been received by the U.S. Patent and Trademark Office. The printed copies of the patent specifications which we do receive carry the publication date which is used if sufficiently early. They indicate the date of the earlier printed version and if it becomes necessary in connection with a Swiss patent issued under the examination system to establish an earlier date, the *>Scientific and Technical Information Center< can obtain a copy of the earlier printed specification from the Swiss Patent Office.

The effective dates of Swiss patents are discussed in *Ex parte Reuge*, 115 USPQ 51 and in *Ex parte Appeal No 194-** >38<, 1966 C.D. 31, 152 USPQ 70 >(Bd. App. 1965)<.

20. **USSR.** A general description of the Soviet law on inventions and discoveries can be found at 43 J.P.O.S. 1-55, January 1961. There have been a few changes since that date.

With certain exceptions, an inventor may apply for either an inventor's certificate (also called an author's certificate) or a patent. In the former case the invention is presented to the state and any establishment in the country can use it; the inventor is entitled to compensation ordinarily measured on the basis of a percentage of the savings from one year's use of the invention, not to exceed 20,000 rubles, and to certain perquisites. In the case of a patent, the right to exclude others is granted. Nationals do not seek patents. Less than about 3% of issues are patents, all except one or two now and then being granted to foreigners, and foreigners apply for very few inventor's certificates.

Applications are examined with a search of the prior art, including foreign patent material. When granted, the specifications are issued in printed form. Except for the appearance of identifying words in the heading, the specifications of author's certificates and patents are not distinguishable.

Since the author's certificates are not patents, they can only be used as references as printed publications, and the effective date would be the date the specification was issued in printed form. The *>Scientific and Technical Information Center< has received printed copies since 1958. For the earlier ones received the date of receipt by the *>Scientific and Technical Information Center<, stamped on the copies, is the date to use. Issues since 1964 show three successive dates in the heading in successive lines: the first is the filing date; the second (but the priority date if any would precede this) is the date of publication in the official journal, the Bulletin, the number of which is also given; and the third, which is in the last line preceding the horizontal ruling, is stated to be the date of publication of the description. This last date is the date to be cited.

901.05(a) Citation Data

Foreign patent publications that use Arabic and Roman numerals in lieu of names to indicate the date, show in order the day, month, and year. Roman numerals always refer to the month.

Japanese patent application publications show the date in Arabic numerals, by indicating in order the year of the reign of the Emperor, the month, and the day. To convert the Japanese year of the Emperor to the Western calendar year, >for years prior to 1989,< add 1925 to the JAPANESE YEAR. For example: 40.3.6 = March 6, 1965. >For years after 1988, add 1988 to the JAPANESE YEAR.<

Foreign language, alphabetical lists of the names of the months, and of the names and abbreviations for the United States of America are shown on the following page. The lists set forth only selected, commonly encountered foreign language names, and do not include those which are similar to the English language names and thus easily translatable.

In using the lists, identification of the foreign language (except for Russian), is not necessary. The translation into English is ascertained by alphabetically locating the foreign language name on the list.

The list of the foreign language names and abbreviations for the United States is useful in determining whether a foreign language patent publication indicates the filing of a similar application in the United States.

Alphabetical List of Selected Foreign Language Names of Months

agosto	August
gošt	August
august	August
avril	April
brezen	March
cervna	June
cervenca	July
czerwca	June
decembre	December
dicembre	December
dubna	April
elokuu	August
februaio	February
Feber	February
februari	February
fevrier	February
gennaio	January
giugno	June
grudnia	December
heinakuu	July
helmikuu	February
huhতিকু	April
Janner	January
janvier	January
joulukuu	December

juillet
juin
kesakuu
kvetna
kwietnia
leden
lipca
listopad
listopada
lokakuu
luglio
lutego
maaliskuu
maart
maggio
Mai
Maj
maja
maraskuu
marca
mars
Marts
Marz
marzo
mei
ottobre
października
prosina
rijna
settembre
sierpnia
srpena
stycznia
syyskuu
tammikuu
toukokuu
unora
wrzesnia
zari

RUSSIAN

август
апрель
декабрь
июль
июнь
май
март
ноябрь
октябрь
сентябрь
февраль
январь

July
June
June
May
April
January
July
November
November
October
July
February
March
March
May
May
May
May
November
March
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August
January
September
January
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February
September
September

August
April
December
July
June
May
March
November
October
September
February
January

*** List of Selected Foreign Language Names and Abbreviations for the United States of America**

Amerikas Forenta Stater	Stati Uniti d' America
De Forenete Stater av Amerika	S.U.
EE.UU.	S.U.A.
E.U.	S.Z.A.
E.U.A.	V.St.A.
E.U. d'Am.	V.St.v.A.
Etats-Unis d' Amerique	Ver.St.V.Am(erika)
Sp.St.A.	Vereenigde Staten Van Amerika
	Vereenigde Staten Van Noord-Amerika
Spoj. St. Am.	Vereinigten Staaten Von Amerika
Spojene Staty Americke	Voreneede Stater i Amerika
Stany Zjednoczone Ameryke	

901.05(b) Other Significant Data [R-14]

Occasionally, the exact date of foreign patenting becomes material. In the case of Australia, Austria, East Germany, India, Ireland, United Kingdom and U.S.S.R., it does not appear on the printed copies of the patents. If necessary, this information can be secured from the Scientific and Technical Information Center.

For the effective dates of Belgian patents, see the Memorandum of March 2, 1959, which has been reproduced in 41 J.P.O.S. at page 440.

For the effective dates of Italian patents, see the Memorandum of October 25, 1960 distributed to all examiners and published in 42 J.P.O.S. 795-8.

Comments concerning German, French and Belgian procedure in granting patents are found in *Ex parte Gruschwitz et al.*, 138 USPQ 505. This case did not involve anticipation but the bar of foreign patenting under 35 U.S.C. 102(d). **>The Board of Appeals has held that "patenting", within the meaning of 35 U.S.C. 102(d), does not occur upon laying open of a Japanese utility model application, which is the first publication of the application, *Ex parte Fujishiro et al.*, 199 USPQ 36 (Bd. App. 1977)<.

A German Offenlegungsschriften publication is not considered to be a patent under 35 U.S.C. 102(d), *Ex parte Links*, 184 USPQ 429 (Bd. **>App.< 1974). However, a German Auslegeschrift publication is considered to provide the legal effect of a patent under 35 U.S.C. 102(d), *Ex parte Beik >et al<*, 161 USPQ 795 (Bd. App. 1968).

>In Great Britain, rights of patentee date back to time completed specification was filed, patentee's rights do not become fixed and settled until patent is sealed, specifications may be sufficient and approved but if patent is not sealed patentee receives no certificate that patent has been granted and no rights accrue to him as patentee. "Patented" as used in 1952 Patent Act refers to time when patentee's right to patent is fixed and determined and this in Great Britain would be the date when it is sealed, *In re Monks*, 200 USPQ 129 (CCPA 1978).<

Some countries issue patents of addition and they should be identified as such and, when separately numbered as in France, the number of the addition patent should be cited. "Patents of addition" generally cover improvements of a patented parent invention and can be obtained by the proprietor of the parent invention. Inventiveness in relation to the parent invention need not be demonstrated and the term is governed by the term of the parent patent.

For citation of the number of pages of drawing and specification, see >MPEP< § 707.05(e). Some foreign countries list the references cited during the prosecution. These, especially if they are U.S. patents, may be helpful, either as references of interest to the examiner or to suggest an overlooked field of search.

FEDERAL REPUBLIC OF GERMANY

German allowed applications have been issued in printed form beginning September 1, 1955. Those printed from this date up to December 31, 1956, are captioned "Patentanmeldung." They should be cited as "German printed applications" and identified by the name of the applicant, the serial number of the application, and the date of publication. They are printed on white paper. The applications printed after January 1, 1957, are printed on green paper and are captioned "Auslegeschrift" and have an additional number which is larger than 1,000,000 and which will be the number of the patent, if issued. This new number should be used instead of the original serial number. When and if the patent is granted, the specification is printed again on white paper with the same number.

On October 1, 1968, the West German Patent Office shifted to a deferred examination procedure. Under this procedure all pending applications are printed on yellow paper at 18 months after the filing or claimed priority date as "Offenlegungsschriften". The numbering system is larger than 1,400,000.

German Utility Models (Gebrauchsmuster) may be used as references as prior patents, but not as prior printed publications since the full specifications are not printed effective as of their registration date. When necessary, the **>Scientific and Technical Information Center staff< will obtain the complete text of the specification from the German Patent Office. A file of such copies is maintained in the Scientific and Technical Information Center.<

NETHERLANDS

Netherlands applications, unless withdrawn, are printed beginning January 1, 1964. They are captioned "Octroolaanvraag". They should be cited as Netherlands applications giving the number, date of publication, "Datum van ter inzageelling", name of applicant, "Aanvrager" and data customarily given in citing foreign patents.

UNITED KINGDOM

Certain United Kingdom applications had become void and hence lack a date of acceptance. Nevertheless, they were given

a number in the patent series. The date of publication (year only) is given following the statement "Printed for His Majesty's Stationery Office," and this should be cited.

British specifications prior to 1916 have printed in large heavy type at the head of the first page of the specification a number and year, as 1451 A.D. 1912. This, together with the name, as required by the rules, is always the proper citation of the patent. The year given at the head of the specification is either the year of filing or the year of acceptance, but in either case it is the official designation of the patent.

The year printed on the drawing is not always the year for correct designation of the patent. Where it is not, the correct year is shown by a small superior number or exponent placed to the right and above the serial number of the patent, as —

1910 — No. 499¹¹

1912 — No. 19421¹¹ In instances of this kind the patent should be cited as No. 499 of 1911 or No. 19421 of 1913.

FRANCE

The date of recent French patents to be taken as the effective date as a patent for reference purposes is the date of the Official Bulletin of the French Patent Office (Bulletin Officiel de la Propriété Industrielle) in which the granting of the patent was announced. This date does not appear on the printed copies of the specifications of the patents. The printed copies give the date the patent was granted (*delivre*) and the number of the particular issue of the Official bulletin in which the granting of the patent was announced. The date of the issue of the bulletin, if needed, may be obtained from the Bulletin itself in the "Scientific and Technical Information Center" and would be about five or six weeks later than the granting date. The granting date may be used for citation purposes but if the precise date is critical the effective date should also be given.

The date used as the effective date when the patent is used as a patent (rather than as a printed publication which date is later) has been the date on which the patent was granted, indicated on the printed copies by the word "*delivre*", as was established by decisions of the courts, the Commissioner, and the Board of Appeals. Owing to a change in the practice in the French Patent Office whereby the specifications of granted patents are now not available to the public until the date of the Official Bulletin, it is necessary to apply *In re Ekenstam*, **256 F.2d 321, 1958 CD 402, 734 OG 290, 118 USPQ 349 (CCPA 1958); and used the date on which the specification became available to the public as the effective date as a reference. This practice will apply to recent French patents, going back to number 1,148,401 announced in the Official Bulletin of July 11, 1957 and back to patent of addition number 67,251. No change in practice is indicated with respect to French patents prior to these numbers. See also *Ex parte Appeal No. 242-47*, 196 USPQ 828 (Bd. App. 1976).

SWITZERLAND

The effective dates of Swiss patents are discussed in *Ex parte Reuge*, 115 USPQ 51 (Bd. App. 1957) and in *Ex parte*

Appeal No. 194-38, 1966 CD 31, 152 USPQ 70 (Bd. App. 1965). It should be noted that two different systems are in operation in Switzerland. The majority of patents are issued without search and examination in the light of references, and the date used for these is the publication (*veroeffentlicht*, public, *publicato*) date. In two fields, inventions relating to time-keeping, and inventions relating to the non-mechanical treatment of textiles and fibers, applications are searched and examined in the light of the prior art and the procedure differs from that followed in the other cases; it follows, in general, the procedure in the Federal Republic of Germany as described in *Ex parte Gruschwitz et al.*, 1963 C.D. 859, 138 USPQ 505 (Bd. App. 1961). Patents which have been issued under the examination system can be recognized from information given in the heading which refers to the publication of the application (the French and German language applications, *Demande publiee* and *Gesuch bekanntgemacht*, respectively). As in the German practice, when a case is found allowable by the examiner the application is published for opposition and the specification is issued in printed form (also referred to as *Auslegeschrift*, German and *Memoire expose*, French). These printed copies have not been received by the Office. If it becomes necessary in connection with a Swiss patent issued under the examination system to establish a date earlier than the date the patent was granted, the "Scientific and Technical Information Center" can obtain a copy of the earlier printed application from the Swiss Patent Office.

901.05(c) Obtaining Copies [R-14]

Photocopies of foreign patents can be ordered by an examiner for placement in the shoes of a class in which he or she examines, if the patents would be of frequent use in that class (MPEP § 905.01 and § 903.03).

901.05(d) Translation [R-14]

Examiners may consult the translators in the Translation Branch of the Scientific and Technical Information Center (STIC) for oral assistance in translating foreign patents or literature that are possible references for an application being examined. Examiners may also request written translations of pertinent portions of references being considered for citation or already cited in applications. (See MPEP § 901.06(a), Translations*, and MPEP § 903.03, Classification of Foreign Patents.) Written translations can be made from virtually all foreign languages into English.

Equivalent versions of foreign language specifications, in English or other languages known to the examiner, can also commonly be found. Equivalency searches are an alternative to getting a translation and can be requested from the Foreign Patents Branch of STIC. (See MPEP § 901.06(a), STIC Services - Foreign Patent Services.)

901.06 Non-Patent Publications [R-14]

All printed publications may be used as references, the date

901.06(a)

MANUAL OF PATENT EXAMINING PROCEDURE

to be cited being the publication date. Recognized abbreviations of names of periodicals may be used in their citation (>MPEP< § 707.05(e)).

There are some publications kept or circulated in every group and each assistant examiner should ascertain which are available in his >or her< group and whether or not any of them is likely to bear on any >assigned< class**.

Where a non-patent literature reference with a document identification number is cited, the identification number and the class and subclass should be included on form PTO-892.

The citation should be as follows: (S00840001) Winslow, C.E.A. *Fresh Air and Ventilation* N.Y., E.P. Dutton, 1926, p. 97-112, TH 7653. W5, 315-22.

901.06(a) >Scientific and Technical Information Center [Formerly known as the Scientific Library] [R-14]

The Scientific and Technical Information Center is located at CP34, Room 2C01c

35 U.S.C. 8. Library.

The Commissioner shall maintain a library of scientific and other works and periodicals, both foreign and domestic, in the Patent and Trademark Office to aid the officers in the discharge of their duties.

**>Technical literature, foreign patent documents, reference and online search services available in the Scientific and Technical Information Center (STIC) are all important resources for the patent examiner to utilize. These resources provide material which must be known or searched to determine whether claims of applications are directly anticipated and therefore unpatentable under the provisions of 35 U.S.C. 102. STIC handbooks, textbooks, periodicals, reports and other materials assist examiners in deciding the question of patentable invention in cases which the primary search indicates that there is some novelty as compared to any single reference in the art (35 U.S.C. 103). These resources enable the examiner to determine whether the features novel in the particular combination searched would be obvious to a person skilled in the art from the general state of knowledge as reflected in the technical literature.

STIC COLLECTIONS

1. Books

The Scientific and Technical Information Center carefully selects and purchases primarily English-language publications in all fields of applied technology. There is a modest collection in French and German, mostly in the field of chemistry. Collections of books and trade catalogs are also purchased by STIC for permanent location in specific examining groups. For instance, the Design Patent Group has a great many manufacturer's catalogs. Books may be ordered by examiners for location in the groups by addressing a memorandum to the Manager of STIC via the group director. The locations of all acquired publications

are recorded in STIC so that users will know where to look for a particular publication, be it in the Information Center or in an examining group. All publications, regardless of location, are processed in STIC's Technical Services Branch.

Reference works including encyclopedias, dictionaries, handbooks, and abstracting and indexing services are also available in the Information Center to assist examiners in finding information pertinent to the subject matter of a patent application. STIC does not circulate reference materials. Books in the reference collection are so labeled.

The staff of the Scientific and Technical Information Center makes every effort to obtain current, useful publications. However, all suggestions for additional purchases that come in from the Examining Corps are welcomed.

2. Periodicals

Approximately 1,300 technical periodical titles are received in STIC, including publications of many important scientific and technical societies. Incorporated into the collection are a number of titles pertinent to the examination of design patent applications and titles of interest to non-examining areas of the PTO. Many of the periodical holdings in STIC are in microfilm format.

Requests for the purchase of new subscription titles are accepted at any time throughout the year, with subsequent purchase dependent on demonstrated need and availability of funds. STIC staff is alert to new periodical titles and often acquires sample copies which are sent to appropriate examining groups for review and recommendation.

A number of periodicals are routed to specific examining groups. Once each year, STIC notifies each group of titles currently routed to them and invites them to suggest changes to this list.

Current issues of periodicals are arranged alphabetically and located on shelves near the reference collection. Bound periodicals are interfiled with the book collection by their library classification numbers. Periodicals on microfilm are housed in microfilm cabinets. A list of periodicals on microfilm is available in STIC.

3. Foreign Patent Documents

The United States Patent and Trademark Office receives foreign patent documents through exchange agreements with almost all countries that print their patent documents. This makes STIC's collection of foreign patent documents the most comprehensive in the United States. The collection is located in the Foreign Patents Branch. In many cases, two copies of the patent documents are received: one for the examiners' search files and one for the numerical set in the Scientific and Technical Information Center. Since July 1969, the numerical set for most industrial countries has been obtained on 16-mm microfilm reels. Foreign patents are date-stamped on receipt in STIC.

Most foreign countries issue official patent and trademark journals corresponding to the *Official Gazette of the United States Patent and Trademark Office*. These journals are shelved under country name together with the bound paper numerical

sets of patent documents for those countries which print their patents. Most countries issue name indexes; some also issue classified indexes. Indexes are shelved with the journals.

The Foreign Patents Branch acquires English language abstracts of foreign patent documents for selected countries published by Derwent. Holdings are in 16mm format from 1972 to date. Earlier holdings are in paper. The Branch also has unexamined Japanese patent applications abstracted by the Japanese Patent Office from 1977 to date in paper.

4. Special Collections

Biotechnology/Chemical

With the formulation of a new biotechnology examining group in 1988 came a mandate to improve STIC resources in this area. The former Chemical Library, located with the biotechnology and chemical examining groups, was renovated and renamed the Biotech/Chemical Library. In addition, a separate biotechnology collection has been identified and is being developed to include a microfilm backfile of biotechnology journal titles added to the collection in 1988.

Government Publications

In 1986, the Scientific and Technical Information Center was designated a Federal Depository Library which means that it now receives a selected number of documents published by various U.S. government agencies. Many of these publications are on microfiche. The primary search aids are the *Monthly Catalog of U.S. Government Publications* and the *List of Classes*. A few series and monographs have been cataloged, but most government publications are shelved by the Superintendent of Documents classification system assigned by the Government Printing Office, and housed together in a special area in STIC.

Project XL Materials

This collection of books, games, puzzles, and manipulatives relate to the teaching of thinking skills whether they are classified as creative thinking, critical thinking, decision making, innovation and invention or problem solving skills. The collection is primarily aimed at, but not limited to, elementary education and is a result of a PTO initiative in the mid-1980's to emphasize the importance of encouraging creativity in America's youth. Access to the collection is through STIC's online catalog. All Project XL materials are available for loan.

HOW TO LOCATE MATERIALS IN STIC

LS/2000

The primary vehicle for locating books and other materials is STIC's online catalog which is part of the automated library system known as LS/2000. The online catalog contains a record of all book titles acquired from 1977 to date. Older materials are being added to the system on an as-needed basis. Other

materials such as periodicals and government publications have also been added. Dedicated LS/2000 terminals are located in STIC. Examiners have remote access to LS/2000 via personal computers located throughout the Corps. The LS/2000 system includes an electronic mail function that will allow users to communicate with the Information Center. Examiners may use this capability to submit interlibrary loan requests to STIC electronically. Instructions for use of the system are included in a brochure entitled *Online Catalog Users Guide: Scientific Library* (former name of STIC). Brochures are available in the groups and in STIC. In addition, STIC staff are always available to assist in the use of the system.

Access to materials acquired prior to 1977 is through the card catalog located in STIC. This catalog merges authors, titles and subjects into one alphabetical listing. It will be phased out in the future as older titles are weeded from the collection.

All materials are cataloged using the Library of Congress (LC) classification system, a system employing a combination of letters and numbers. Periodicals as well as books are cataloged according to the LC system, and interfiled together once the periodicals have been bound. A copy of the LC classification schedule is located in the STIC for those interested in a better understanding of the system.

Both the online and card catalogs include the number of copies of a particular publication as part of the official record, as well as the location of each copy. This enables STIC to account for the location of any item at any particular time.

LOAN POLICY

All STIC materials except non-circulating items may be charged out at the Circulation Desk. (Non-circulating material includes reference publications, foreign patent documents, and microfilm.) Books circulate for a period of four weeks and can be renewed on request. Extended loan periods are available on request. Examiners may use the Department of Commerce Libraries as well as other Federal Government libraries in the area. STIC's Scientific Reference Branch can answer questions regarding the accessibility and lending practices of other libraries. If books are needed from another library for official use, the request should go through the Scientific and Technical Information Center by means of an interlibrary loan request. (See "Interlibrary Loan" under STIC SERVICES.)

STIC SERVICES

1. Reference Services

The staff of the Scientific Reference Branch and the Biotechnology Information Branch assist examiners in the use of the resources of STIC. Upon request, they will provide bibliographies on given subjects. If any problems are encountered in locating materials, using the catalogs or indexing services, or finding answers to informational needs, please check with the staff. They are ready and willing to assist. Queries may be made in person or by telephone.

2. Online Searching

Online computer data base searching is provided by the Scientific Reference Branch and the Biotechnology Information Branch. Both branches have access via remote terminals to a number of vendors' commercial data base search systems. These vendors' data bases extensively cover the field of knowledge; provide printouts of bibliographies, abstracts or in some cases full-text data, and chemical structures; and provide a valuable initial screen of the non-patent literature for the examiner intending to make a search of the secondary sources of his/her area of interest.

Vendors accessed by STIC staff include DIALOG, ORBIT, DOE/RECON, Chemical Abstracts Services (STN), INPADOC, Newsnet, Tulsa, Questel, DTIC/DROLS, IntelliGenetics, and the Mead Data Central data bases. When they are identified as meeting the needs and requirements of the Office, new data base vendors are added. A list of the data bases offered by each vendor is available in the vendors' manuals located in STIC. Examiners may request a computer search by submitting a request form to the appropriate branch. Searches are usually completed and ready for pick-up within 1-2 days.

Examiners are allowed to conduct searches of online commercial data bases independently of STIC staff. Training is provided through the Patent Academy. To assist examiners in the use of online data base systems, a manual was developed entitled *The Manual of Online Searching*. This publication includes search aids and helpful hints on how to use most of the vendors' databases subscribed to by STIC. Copies are available from the Patent Academy.

Online searching of nucleic and amino acid sequences is conducted by the staff of the Biotechnology Information Branch through the use of an in-house computer network developed for this purpose. Examiners can also access the SUN biotechnology sequence search system or CD-ROM products by using one of several computers located in Group 180. For information on biotechnology sequence search/analysis training, contact the staff of the Biotechnology Information Branch.

3. Foreign Patent Services

Patent online search services, performed on the Derwent and INPADOC patent data bases, are provided for patent examiners by the Foreign Patents Branch. Alternatively, examiners may choose to perform their own patent searches after receiving appropriate training through the Patent Academy.

The services provided by the Foreign Patents Branch include: identification of English language or preferred language equivalents; determination of priority dates and publication dates; searches by inventor name or abstract number; and other patent family and bibliographic searches. The systems overlap in coverage and have other similarities, but also have differences in format, kinds of searches that can be performed, and patent document and country coverage. In comparing the two systems, Derwent maintains superior coverage of chemical patent documents, while INPADOC includes earlier documents and more countries, and has more extensive coverage of me-

chanical and electrical patent documents. Manual searching of foreign patent journals (Official Gazettes), patent concordances and/or indexes is performed when necessary to supplement the online searching effort.

The staff of the Foreign Patents Branch is available to assist with any problem or informational need regarding foreign patent searching or foreign patent documents.

SPECIAL NOTE: Members of the public can order copies of foreign patent documents. Procedures are outlined in a brochure entitled "Foreign Patent Document Copy Orders" available in STIC.

4. Translations

Examiners may consult the translators in the Translations Branch of STIC for oral assistance in translating foreign language patents and other literary sources that are possible references for applications being examined. Oral translations are performed in the major European languages and in Japanese. Examiners may also request written translations of pertinent portions of references being considered for citation or already cited in applications. Full translations are also made upon request. Written translations can be made from virtually all foreign languages into English.

There is a computerized data base located in the Translations Branch listing all translations which have been made by the Branch, and a few others gathered from miscellaneous sources. This data base lists over 30,000 translations of foreign patents and articles, all of which are all located in the Translations Branch. Patent translations are indexed by country and patent number; articles are indexed by language and author or title. Any copies of translations coming to examiners from outside the Office should be furnished to the Translations Branch so that it may make copies for its files. In this case the source is indicated on the translation so that it will not be certified as an official translation of the Patent and Trademark Office.

5. Interlibrary Loans

When needed for official business purposes, STIC will borrow materials not available in-house from other libraries. Requests are initially submitted to the Scientific Reference Branch via LS/2000 or in person. Those that can be filled by libraries in the metropolitan area are handled by staff who go out on a daily basis to retrieve requested materials. Those that must be filled by libraries elsewhere in the country are handled by the Scientific Reference Branch. Law books cannot be borrowed by STIC for use by examiners in connection with law courses.

When a book or periodical is borrowed from another library, and cited in an Office action, a photocopy of the portion cited should be placed in an appropriate class and subclass. This class and subclass should be cited in the Office action.

STIC also loans its materials to other libraries in the Washington, D.C. metropolitan area so that occasionally an examiner may find that the item he/she desires is unavailable. Materials which are out on interlibrary loan may be recalled for the examiner if required for immediate use.

Copies of foreign patents are usually kept in shoes separate from and immediately following the U.S. patents.

All foreign patent documents (patents and published applications) involved in a reclassification project issued after January 1, 1974 are filed by ****>a computer-generated sequence number<** within each subclass. Each such foreign patent document has the year of publication indicated in the upper right-hand corner of the front page. It is anticipated that eventually all the classified foreign patent document search files will be arranged in this manner. This filing arrangement aids the examiner in updating his search as well as the ****>Search & Information Resources Administration<** in the maintenance of the integrity of the search files.

Non-patent publications or photocopies thereof containing disclosures for particular subclasses, if numerous, should be filed in shoes following the foreign patents, otherwise at the bottom of the last shoe of foreign patents.

in the search file.<

C	PATENT NUMBER	NO. OF COPIES 1
	USE A SEPARATE FORM FOR ORDERING EACH MISSING COPY	
EXAMINER'S NAME		DATE OF ORDER
TO REPLACE MISSING COPY IN		
<div style="display: flex; justify-content: space-around;"> → CLASS → SUBCLASS OR DIGEST </div>		
CHECK ONE BOX ONLY		
<input type="checkbox"/> OR <input type="checkbox"/> XR <input type="checkbox"/> UNKNOWN		
<small>PTO-14C (REV. 5-76) U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE</small>		

EXAMINER'S ORDER FOR REPLACEMENT COPY

901.08 Borrowing References

The search files in each examining group should at all times be complete. Where they are incomplete, the examiners using such files and relying upon their completeness may miss valuable references. References removed from the files whether for use in the group or otherwise should, of course, be promptly returned.

901.09 Missing Copies — Replacement [R-14]

When the original or cross-reference hard copy of a **<referenced>** patent is missing from the **<examiner's>** search files, a **<replacement>** copy may be ordered **<using buff-colored form PTO-14C, Examiner's Order for Replacement Copy. Only one patent number may be ordered per form. To order a replacement copy, the examiner should complete the "Patent Number," "Examiner's Name," "Art Unit," and "Date of Order" boxes, should identify the class and subclass or digest from which the copy is missing, and should check only one of the three boxes labeled "OR," "XR," and "Unknown.">**

To expedite the handling of requests for **<replacement>** copies and thereby **<ensure>** the quickest response, the following routing procedures should be adhered to:

(1) Use designated collection drops **<within each group>** for copy orders.

(2) Group clerical personnel should hand-carry or mail the **<PTO-14C orders>** at least daily to the **<Search File Improvement Division, currently located in "Crystal Mall Building 2, Room 967.>**

The attorneys' drop slot at the **<Public Service Window>** should not be used nor should the forms be mailed to **<Copy Fulfillment Services>** as consequent rerouting to **<Office of Classification Support>** for processing will result in unnecessary delay.

<All replacement copies ordered through the PTO-14C program are returned to the requesting examiner as notification of order fulfillment. The examiner should then place the copies in the designated file drop location for filing by the contractor

902 **<Search Tools and Classification Information>** [R-14]

902.01 Manual of Classification [R-14]

<The Manual of Classification is the key to the U.S. Patent Classification system. It is published in full as the Basic Manual every two years. Basic Manuals reflect current classifications as of December of even-numbered years. Revisions to the Basic Manual occur at six-month intervals. Pages of the Manual Revisions are inserted as replacements to update the previous versions.

There are over 400 classes in the U.S. Patent Classification system, each having a title descriptive of its subject matter and each being identified by a class number. Each class is subdivided into a number of subclasses. Each subclass bears a descriptive title and is identified by a subclass number. The subclass number may be an integral number or may contain a decimal portion and/or alpha characters. A complete identification of a subclass requires both the class and subclass number and any alpha or decimal designations, e.g., 417/161.1A identifies Class 417, Subclass 161.1A.

The Manual of Classification contains ordered arrangements of the class and subclass titles, referred to as class schedules. These titles are necessarily brief, although they are intended to be as suggestive as possible of subject matter included. Therefore, it is best not to depend exclusively upon titles to delineate the subject matter defined by a class or subclass. Reference to respective definitions and notes is essential. If a search is to be expeditious, accurate and complete, the Manual of Classification should be used only as a key to the class or subclass definition and appended notes.

The Manual of Classification has the following parts:

Current Pages - A tabulation showing the classes appearing in the current version and the date each class was created.

Classes Arranged by Related Subject - A theoretical organization of most classes into three major groups, which attempts within each group to list classes in a hierarchy representing a relationship for all applied sciences. This tabulation is for the purpose of assisting the user in finding the class pertinent to his search.

Organic Compounds Index - A table showing the hierarchical arrangement of the synthetic resin and organic compound classes.

Group Personnel Directory - A listing which shows for each examining group, the Director, the Supervisory Patent Examiners, and the Group Post Classifier with room locations and telephone numbers.

Classes Arranged by Art Unit

Classes Arranged Numerically with Art Unit and Search Room Locations

Classes Arranged in Alphabetical Order by Title

Class Schedules - The arrangements of subclass titles under each class title. The plant class appears first, followed by the utility classes in numeric sequence, followed by the design classes in numeric sequence.<

902.01(a) Index to the U.S. Patent Classification [R-14]

The Index to Classification is an alphabetic listing of technical and common terms referring to specific classes and subclasses of the >U.S. Patent< Classification system. It is intended as an initial entry into the **>system and should not be considered exhaustive. The definition and associated notes of the identified classifications must also be reviewed, even when the citation found in the Index appears to be restricted to a specific subject matter area.

The Index is published every year reflecting classification as of December of the year. Suggestions or changes to the Index are encouraged and should be directed to the Classification Groups.<

902.02 >Class and Subclass< Definitions [R-14]

All of the utility classes (i.e., classes devoted to technology) **>and the plant< class have definitions. **>The design classes do not have< definitions.

*Definitions state the subject matter** >of the classes and subclasses< much more explicitly than it is possible to state in short class and subclass titles. **> A study of the definitions is

essential to determine the proper classification of subject matter within the U.S. Patent Classification system.

Definitions are available as full sets on microfiche. The microfiche is revised every six months, with full (basic) sets being issued on an irregular basis. Each examining group has at least one set of definitions on microfiche and a microfiche reader. There are several sets of microfiche and a paper set of definitions in the Public Search Room.

Definitions of individual classes in paper form are available from the Office of Classification Support. It is noted that classification orders frequently affect existing definitions. Personal sets of definitions used by examiners should be periodically revised to reflect these changes.<

902.02(a) *>Definition< Notes [R-14]

**>Many of the definitions have accompanying notes. These notes are of two types: notes that supplement definitions by explaining terms or giving examples, and notes referring to related disclosures located in other classes or subclasses.

These latter notes are termed search notes and are helpful in explaining the limits of a class or subclass. They generally state the relationship to, and difference from, other identified subject matter collections. It is intended that each note should guide a user to the extent necessary to reach a decision either to include or exclude an area containing relevant subject matter.<

*Search notes are not exhaustive and should be regarded as suggestive of additional fields of search, but not as limiting the search. >Additionally, since a search note which applies to a particular subclass is rarely repeated for subclasses indented thereunder, it is advisable to review the search notes of all parent subclasses.<

902.02(b) Search Cards [R-14]

**>Many older subclasses have "search cards" in the first< shoe of each defined subclass in both the examining group and the Public Search Room **.

902.03 **Classification >Information< [R-14]

**>Current classification information for U.S. patents is available from the sources indicated below.<

902.03(a) Master Classification File (MCF) on Microfilm

A patent number index of domestic patents giving their current original and cross-reference classification is available on microfilm in the Public Search Room. Patent numbers are arranged in both numeric and classified array. The microfilm is updated semi-annually, in June and December.

902.03(b)

902.03(b) Patent Index [R-14]

Original and cross reference classification information for individual patents can be obtained by use of computer terminals located in the Public Search Room or by calling the Patent Index telephone service, 557-43951. This data is updated bimonthly with new issues and reclassifications.

902.03(c) Subclass Lists [R-14]

Computer print-out listings of patents contained in subclasses, either separately or merged, may be obtained by request from the Office of Classification Support. Listings can be inclusive or limited by use of a cut-off date or patent number. This data is updated bimonthly with new issues and reclassifications.

902.03(d) Classification and Search Support Information System (CASSIS) [R-14]

CASSIS provides access to search tools and classification information through terminals located throughout the PTO on CD-ROM (Compact Disc-Read Only Memory).

The following are available on CASSIS in both on-line and CD-ROM:

- ° Lists of all classifications of a patent
- ° List of all patents in a classification
- ° Display and word search of class schedules of the Manual of Classification

CASSIS/CD-ROM allows word searching and display of patent titles and assignees for patents granted after 1969 and word searching and display of recent abstracts.

>902.03 (e) Automated Patent System (APS) [R-14]

APS is the PTO on-line system which allows access to the full text of U.S. patents granted since 1970. In addition, APS provides access to current classification information for all U.S. patents.

902.04 Classification Orders [R-14]

Classification Orders issue once a month, each Order detailing the changes resulting from a classification project effected that month.

Since classification projects issue monthly throughout the year, orders are used to bridge the gap between the time a project issues and the time the other search tools (Manual, Index, Definitions) are updated.

The order includes the following:

1. Either the new class schedules or changes to existing class schedules necessitated by the project.

2. The changes to the definitions necessary to support the changes in 1, above.

3. Source and disposition lists showing how the old art has been distributed into the newly established subclasses.

4. A revised concordance showing the relationship between the newly established subclasses and their International Patent Classification (IPC) counterparts.

Classification Orders are distributed to classifiers and examiners associated with the reclassification project of the order, to Patent Depository Libraries and to the Public Search Room. Copies can be obtained through the Group Post Classifier or from the Office of Classification Support.

>902.04 (a) Reclassification Alert Report [R-14]

The Reclassification Alert Report is distributed to examiners, classifiers and technicians each quarter. It lists numerically the classes and subclasses affected by classification orders which issued during the quarter, indicating if the classifications were established, abolished, or had definition changes.

Copies of definitions of newly established subclasses, definition changes to existing subclasses, or entire classification orders are available from the Office of Classification Support.

903 Classification

903.01 Statutory Authority

The statutory authority for establishing and maintaining a classification is given in the following statute, which states:

35 U.S.C. 9. Classification of patents.

The Commissioner may revise and maintain the classification by subject matter of United States letters patent, and such other patents and printed publications as may be necessary or practicable, for the purpose of determining with readiness and accuracy the novelty of inventions for which applications for patent are filed.

903.02 Basis and Principles of Classification

The basis of classification used in the U.S. Patent and Trademark Office, the principles followed, and the reasons why such principles were adopted are set forth in the booklet *Development and Use of Patent Classification Systems*, which is available in each art unit. Since classification is the basic tool of every examiner, this booklet, particularly as it relates to the present classification system, should be carefully studied.

903.02(a) New and Revised Classes [R-14]

The establishment of new classes or subclasses and the revision of old classes are done under the supervision of a patent classifier.

The classifier performing the reclassification secures a set of patent copies of the present classification. With these copies, by study and successive groupings, he or she develops an arrange-

ment of the patents which is satisfactory for searching. >Usually expert examiner opinion is sought.<

The definition of the new class or revised class is written or modified, the lines between the class and other classes are drawn up and the subclass definitions are established.

The Index to the U.S. Classification and the Classification computer files are also updated.

Notification of the new class or subclass is published in a Classification Order, and Supplementary sheets necessary to correct the loose leaf Manual of Classification are published.

Definitions of all revised classes and subclasses are included in Classification Orders.

903.02(b) Scope of a Class

In using any classification system, it is necessary to analyze the organization of the class or classes to be included in the search.

The initial analysis should determine which one or ones of the several types of subject matter (manufacture, art, apparatus or stock material) are contained in the class being considered.

Further, relative to each type of subject matter, it is necessary to consider each of the various combinations and subcombinations set out below:

Feature Combined with Basic Subject Matter for Some Added Purpose. The added purpose is in excess of the scope of the subject matter for the class, as defined in the class definition, e.g., adding a sifter to a stone crusher which gives the added function of separating the crushed stone.

Feature Combined to Perfect the Basic Subject Matter. Features may be added to the basic subject matter which do not change the character thereof, but do perfect it for its intended purpose, e.g., an overload release means tends to perfect a stone crusher by providing means to stop it on overload and thus prevent ruining the machine. However, this perfecting combined feature adds nothing to the basic character of the machine.

Basic Subject Matter. The combination of features necessary and essential to the fundamental character of the subject matter treated, e.g., a stone crusher requires a minimum number of features as essential before it can function as such.

Subcombinations Specialized to Basic Subject Matter. Each type of basic subject matter may have subcombinations specialized to use therewith, e.g., the crushing element of a stone crusher.

Subcombinations of General Utility. Each type of basic subject matter may have subcombinations which have utility with other and different types of subject matter, e.g., the machine elements of a stone crusher. Subcombinations of this character usually are provided for in some general class so that the examiner should determine in each instance where they are classified.

903.02(c) Establishing Subclasses and Cross Reference Art Collections [R-14]

When an examiner finds it desirable to create a new subclass or cross reference art collection>,< the appropriate post classi-

fier should be consulted. The post classifier will assist the examiner in establishing any new subclass or cross reference art collection by providing appropriate instructions on how to mark patents to be transferred from an existing subclass to a new subclass, obtaining any additional cross-reference copies that might be needed, determining the title of the newly established subclass or cross reference art collection and assigning the numeric designation to be placed on the new subclass or cross reference art collection.

All newly created subclasses will be made official so as to be a part of the defined classification system and will thus appear in both the examiners' and Public Search Room files. The intent is to accomplish this with a minimum amount of disruption to the examiners. Any examiner having the group director's approval to create new subclasses should contact the group post classifier for his >or her< group. The classifier will cooperate with the examiner on the arrangement of the subclasses he or she wishes to establish and the definitions thereof. Then, the examiner will physically establish the subclasses or provide a marked up computer printout of the patents in the subclass or subclasses being affected. On a time available basis, the examiner may be aided in this task by classification personnel.

At this point, the Office of *>Classification Support< will withdraw the corresponding Search Room copies, and using data gathered from the examiners' newly created subclasses or computer printout, conduct the final processing of the Search Room patents. After this is complete (i.e. the Search Room copies are arranged by the new classification), the examiners' copies will be withdrawn for a short period to go through final clerical processing into numeric subclasses and then returned to the examiners.

The above procedures will not only be beneficial to the Search Room file but will also provide the examiners with defined subclasses.

903.03 Classification of Foreign Patents [R-14]

Usually>,< newly received foreign patent documents are distributed by the **>Foreign Documents Processing Division, Office of Classification Support<, to the Classification Groups. Classification personnel will classify these documents and return them to the **>Foreign Documents Processing Division< for further processing. All documents will be labeled and routed to the examining group for inclusion in the examiner search file. >Certain examining groups are currently filing a portion of their foreign patent documents by the International Patent Classification system.<

In a few cases, newly received foreign patent documents will be routed to the examining groups with forms attached. When such documents are received>,< the examiner should indicate the proper classification for the foreign patent on the form.

If the foreign patent is not properly classifiable in his or her group, the examiner should indicate on the form a Group Art Unit and Class in which he or she *>considers< it to be classifiable, if possible, and return it with the patent to the **>Foreign Documents Processing Division<. Any indication

of class made by the **Foreign Documents Processing Division** is advisory only, and the final decision as to where the patent is to be placed is made by the classifier or the examiner in whose art it is classifiable.

All subclasses in which a copy of the foreign patent is desired should be indicated on the form. **Foreign Documents Processing Division** will supply any necessary additional copies and label them with the classifications indicated on the form.

All foreign patents should be classified and returned with the forms to the **Foreign Documents Processing Division** within two weeks of receipt.

If the examiner desires to update the classification of a foreign patent by changing, canceling or adding copies, he or she should forward the patent to his or her post classifier with the desired transaction attached.

The **Scientific and Technical Information Center** retains copies of foreign patents (See **MPEP** § 901.06(a)), so that foreign patents, known by country, number, and publication date, can be inspected in the **Scientific and Technical Information Center** or photocopies ordered.

Examiners confronted with language problems in classifying foreign-language patents may call upon the Translation Branch of the **Scientific and Technical Information Center** for assistance, see **MPEP** § 901.06(a).

Time spent in classifying foreign patents is allowed in computing an examiner's output. The method used in classifying foreign patents and the assignment of such work among the examiners of the group are left to the supervisory primary examiners. The hours spent by each examiner on this work are noted on the individual examiner's record of "Other" time (PTO-690E).

903.05 Transfer of U.S. Patents

The transfer of official copies of U.S. patents, either original or cross-reference, from one class or subclass to another requires the approval of a classifier.

Examiners must submit to the appropriate classification group all questions of transfer of patents.

When an examiner desires to transfer official copies of domestic patents to a different class or subclass, he or she should have a memorandum list prepared for signature of the primary examiner of the numbers of all patents which are to be transferred indicating only the class and subclass into which each is to be placed. Both originals and properly identified official cross-references may be included in the same list and these may involve transfers to or from any number of different classes or subclasses. Additional cross-reference copies of any listed patent may also be requested by merely indicating where the cross reference copies should be placed. This list with the examiner's copies of the patents is routed through any other group involved for its prompt approval or comment and is forwarded to the appropriate classification group.

In those instances where a transfer is approved by a patent classifier, the class and subclass designations on both the examiner and Public Search Room copies of the patents are

changed and the classification data files are altered to agree with the new classification. When the transfer is not approved, the copies of the patents will be returned with a notification thereof.

Unauthorized transfers render the subclasses in the Public Search Room no longer duplicates of those in the examiners' rooms, and also render incorrect the classification data files.

When it becomes necessary in the course of a transfer to remove copies from the files in the Public Search Room or Examiner Search Room, a notice indicating the patents withdrawn and the classifications to which they are transferred is placed in the search file.

The procedure for transferring an entire class or subclass from one group to another is given in the Manual of Clerical Operations.

903.06 Practice To Be Followed in Ordering Official Cross-References [R-14]

Patents which are useful as references may be found either in the course of a search or from inspection of the *Official Gazette* each week. All patent copies in official subclasses, cross reference art collections and digests are now recorded on the Master Classification File (MCF). In order that the search file be complete as to patent copies and to insure the accuracy of the MCF, it is necessary that each patent copy subsequently added to the search file be recorded.

The informal placement of cross references as "Unofficial Patents" into the examiner's search file is prohibited. All patent copies now placed in the examiner's search file are official cross references. Requests for additional cross references will be utilized by the Search and Information Resources Administration to generate and classify patent documents and to ensure the placement of labeled copies in the examiner's search file and the Public Search Room.

To order new or additional cross-references, the examiner should submit a pink-colored form PTO-14B, completed as follows:

(1) Enter the "PATENT NUMBER," "GR. ART UNIT," "DATE OF ORDER," and "EXAMINER'S NAME" in the appropriate boxes.

(2) Enter the "CLASS" and "SUBCLASS/DIGEST" information for each location where a copy of the requested patent should be placed.

(3) Enter the number of "TOTAL COPIES" requested. This number is determined by multiplying the total number of unique classifications listed times two. This ensures a sufficient number of copies will be obtained to place a labeled copy in both the Examiner Search File and the Public Search Room.

To expedite the handling of requests for additional cross references and thereby ensure the quickest response, the following routing procedures should be adhered to:

(1) Designated collection drops within each group for copy orders should be used.

(2) Group clerical personnel should hand-carry or mail the PTO-14B orders at least daily to the Search File Improvement Division, currently located in Crystal Mall Building 2, Room 967.

The attorneys' drop slot at the Public Service Window should not be used, nor should the forms be mailed to Copy Fulfillment Services as consequent rerouting to the Office of Classification Support for processing will result in unnecessary delay.<

903.07 Classifying and Cross-Referencing at Allowance [R-14]

It is the duty of each primary examiner to personally review the >original< classification and cross-referencing made by his or her assistants of every application passed for issue and to print his or her full name on the blue issue classification slip to show that this review has been made.

Both the blue issue classification slip (PTO-270) and the file wrapper provide spaces for the full names of the "Assistant Examiner" and "Primary Examiner."

An examiner with full signatory authority who acts >personally< on an application* and sends it to issue should print his or her full name on the blue issue slip and stamp and initial the file wrapper ONLY in the "Primary Examiner" space. A line should be drawn through the "Assistant Examiner" spaces on both the blue issue slip and the file wrapper to make it clear that the absence of an initial or signature in the box was not an oversight.

The initial classification of pending applications and the drawings thereof will have been indicated in pencil by the supervisory primary examiner. See >MPEP< § 903.08(b).

However, an application, properly classified at the start of examination, may be improperly classified when it is ready for allowance. The allowed claims should be reviewed, in order to determine the subject matter covered thereby. It is the disclosed subject matter covered by the allowed claims that determines the original classification of U.S. patents.

>The procedure for determining the classification of an issuing application is as follows: every claim, whether independent or dependent, must be considered separately for classification. A separate mandatory classification is required for each claim which is classifiable in a different class or subclass. After all mandatory classifications have been determined, the classification to be designated as the original (OR) is determined. If the mandatory classifications are in different classes, the original class is that in which the most comprehensive claim is classified (if the most comprehensive claim cannot be determined, the superiority of statutory categories of inventions applies, as discussed in section 711 of "Development and Use of the U.S. Patent Classification System"). Within the original class, the mandatory classification that appears first (highest) in the schedule controls original classification. All remaining mandatory classifications are designated as cross-references, as are any additional discretionary classifications that the examiner wishes to apply to the patent.<

Only the correct *>original< classification should be left on the file and drawing of each application when passed for issue.

The examiner *>must legibly fill< out a blue issue classification slip (PTO-270) or a salmon slip (PTO-328) in the case of designs to indicate the class and subclass in which the patent should be classified >as an original< and also the classifications

in which it should appear as a cross-reference. The examiner should be certain that all subclasses into which cross-references are placed are still valid. The examiner attaches the blue issue classification slip to the inside of the left fold of the file wrapper to be forwarded to the Patent Issue Division.

The examiner also enters the final *>original< classification appearing on the issue classification slip in the space provided on the front of the file and in the space provided in the stamping at the top margin of the drawing. Care should be exercised to see that all three entries of the classification are correct and in agreement, particularly after any alteration of one entry, for otherwise the patent will be printed with an erroneous classification or improperly positioned in the *Official Gazette*.

All examiners are requested to fill in the >original< class and subclass on the drawings in large numerals using as much of the space provided as feasible. In this way the filing of drawings and subsequent retrieval by the Patent Issue Division will be greatly aided. See also >MPEP< § 1302.10.

All examiners must include unofficial subclass designators on the blue issue slips (PTO-270) at the time of issue when appropriate. This applies to both the original classification and the cross-reference classification. Any time that a patent is being issued in or cross-referenced to a subclass containing unofficial subclasses, the alpha designation for the proper unofficial subclass must be included on the blue issue slip. No other designation is permissible. Inclusion of only the numeric designation of an official subclass which includes unofficial subclasses is an incomplete and improper entry on a blue issue slip. All official subclasses which have unofficial subclasses are now designated with an "R" (denoting residual) and if the patent does not fit an indented unofficial subclass, the blue slip should include the "R" designation. It is permissible to place multiple copies of a patent into a single set of unofficial subclasses.

When the original patent is classified in an unofficial subclass (including the "R" subclass), the front of the file wrapper and the drawing should also include the alpha designation.

Digests and cross reference art collections should also be included on the blue issue slip, but the original classification must never be a digest or cross reference art collection. The indication for a copy of a patent in a digest or cross reference art collection must be in the cross-reference area of the blue issue slip. A digest must be identified by class number, alpha characters DIG and appropriate digest number.

RESUBMISSION

The original classification assignment of an application may have involved a "borderline" situation. The file wrapper of such an application will be stamped, "RESUBMIT TO CLASSIFICATION GROUP — — — — , etc.", the stamp appearing **>above the Index of Claims<. A "Special" tag should be attached to the file when resubmitted. Note that there should be no resubmission if there is, at the time of allowance, no longer any doubt or dispute about the proper classification.

Where an official Classification Order affects an application already passed to issue, the classification group makes the necessary changes on the file wrapper, blue slip, and drawing, if any. **

Applications which already have been sent to the printer will be classified by the classification group at the time the patent issues.

903.07(a) Cross-Referencing — Keep Systematic Notes During Prosecution [R-14]

Throughout the examination of the case, systematic notes should be kept as to cross-references needed either due to claimed or unclaimed disclosure. Examiners handling related subject matter should be consulted during prosecution (whether they handle larger unclaimed combinations or claimed or unclaimed, but disclosed, subcombinations), and asked if cross-references are needed.

>Each consultation involving a question of the propriety of the classification of subject matter and/or the need for a cross reference must be recorded in the SEARCH NOTES box on the file wrapper and must include: the name of each examiner consulted, the date that the consultation took place and the results of the consultation including the consulted examiners' or examiner's indication of where claimed subject matter is properly classified and where subject matter disclosed but unclaimed is properly classified and whether or not a cross-reference is needed.<

A cross-reference MUST be provided for all CLAIMED disclosure where possible and inserted on the blue issue classification slip at time of issue.

903.07(b) Issuing in Another Examining Group Without Transfer

When an examiner issues a prospective patent in another examining group, he or she notes in the space provided on the blue issue classification slip, *in red ink*, the class and subclass of the other group, and in parentheses the number of said other group. (The initials of said other primary examiner must appear in the block to the right of the original classification.) In the lower left corner, the examiner writes his or her own group number in black ink. (When the patent issues, the classification group will, as a matter of routine, send the necessary notices to the group involved.)

The sending of cases to issue from one group and assigning them to classes in another group is restricted to those situations where both examiners concur in the proposed classification of the patent, which must be shown by the concurring examiner initialing the issue classification slip, or where there has been a ruling by a patent classifier, who must initial the slip.

903.08 Applications: Assignment and Transfer [R-14]

>The titles "supervisory patent examiner", "supervisory primary examiner", and "primary examiner", as used in this Chapter 900, include in their definition any person designated by them to act on their behalf. It is recognized that authority to accept or refuse the transfer of an application may be delegated

when such authority is deserved.<

The examining group to which an application is assigned is responsible for its examination until such time as the application is officially transferred to another group by the classification group.

The primary examiners have full authority to accept any application submitted to them that they believe is properly classifiable in a class in their art unit.

Applicants may be advised of expected application transfers by using Form Paragraph 5.03.

§ 5.03 Notification of Art and Application Transfer to Another Group

Applicant is advised that this application and the art to which this application pertains has been transferred to another group. All further papers submitted in this application should carry the following items:

1. Serial Number (checked for accuracy).
2. Group Art Unit [1].
3. Name of Examiner now in charge of this application [2].
4. Filing date.
5. Title of invention.

903.08(a) New Applications [R-14]

New applications are assigned to the various examining groups in the first instance by the Application Division.

Upon receiving an application from Application Division, the clerk in charge of processing new applications should >wand the application on the PALM to the art unit to which it has been assigned and < date stamp the file wrapper ** on the day the file is to be delivered to the supervisory primary examiner. The complete application (file >and< drawing**) are then given to the appropriate supervisory primary examiner. The clerks should not permit these cases to remain overnight before distributing.

If the supervisory primary examiner decides that the application properly belongs in his or her art unit, it is processed as a new receipt. See >MPEP< § 903.08(b).

When a new application is received which, in the opinion of the primary examiner, does not belong to his or her group, he or she may request transfer to another group. See >MPEP< § 903.08(d).

Form PTO-447, "Transfer Request" consists of *>two< copies and is used as a transmittal** and notification form.

If the search in connection with the first action develops art showing proper classification elsewhere, the transfer is initiated after a response is received from applicant.

BORDERLINE CLASSIFICATION

The classification assignment of an application to the proper examining group, especially when there is submission to and assignment by the classification groups, often involves a borderline situation. Post classifiers in the classification groups, when assigning such borderline cases, will stamp the file wrapper directly below the interference search box when it is their considered opinion that the classification of such an application should be reconsidered on allowance. The stamp will indicate which classification group will reconsider the case on a "Spe-

cial" basis. Note "Resubmission" portion of >MPEP< § 903.07.

903.08(b) Classification and Assignment to Examiner

Every application, new or amended and including the drawings, if any, when first assigned to a group must be classified and assigned to an examiner for examination.

The supervisory primary examiner normally assigns them, noting in lead pencil in the space provided in the face of the file and in the upper left hand corner of the first sheet of the "colored" paper prints the class and subclass to which the case pertains, and also the name or initials of the examiner or the assigned docket designation. The application file is then turned over to the clerk for processing.

If an examiner other than the supervisory primary examiner is given the responsibility of assigning applications, time so spent may, at the group director's discretion, be charged to "Assisting SPE".

903.08(c) Immediate Inspection of Amendments [R-14]

Upon the receipt of an amendment which makes a transfer proper, steps should be taken promptly in accordance with the transfer procedure outlined in >MPEP< § 903.08(d).

903.08(d) Transfer Procedure [R-14]

TRANSFER BETWEEN ART UNITS WITHIN THE SAME GROUP

All "within the group" transfers must be called to the attention of the group clerk so that the **> PALM file may be updated< to correctly indicate the assignment of the application. **

Where there is a difference of opinion among the supervisory primary examiners as to assignment within the same group, the matter is submitted to the post classifier assigned to that group for resolution. Note >MPEP< § 903.10.

TRANSFERS BETWEEN DIFFERENT GROUPS

**>Where a supervisory primary examiner believes an application, either new or amended, does not belong in his or her art unit, he or she may request transfer from his or her art unit (the "originating" art unit) to another art unit (the "receiving" art unit) using form PTO-447. The supervisory primary examiner of the originating art unit dates and completes Section I of the PTO-447 giving a full explanation of the reasons for classification in the other art unit.

In the space provided on the form at least one of the following must be included:

(1) Identification of the controlling claim examinable in another group.

(2) Identification of any existing informal transfer agreement.

(3) Other reasons - with full explanation.

In all cases when transfer is initiated the application must be sent to another art unit. It cannot be sent directly to a classification group. Even if the application is informal, confusing or contains unfamiliar subject matter the examiner must make his or her best judgment as to where the application should be classified and attempt to transfer it there.

Where an application's claims include a combination of limitations for plural disciplines (chemical, electrical or mechanical) a primary examiner may request transfer to another discipline, notwithstanding the fact that the controlling claims are properly classified in his or her art unit, on the ground that the application is "best examinable" in the other discipline. In this instance, the examiner requesting transfer should cite art showing the limitations classifiable in his or her discipline. For discussion of the situations in which assignment of an application on a "best examinable" basis may be proper, see MPEP § 903.08(e).

PROCESS FOR TRANSFER

When the supervisory primary examiner or primary examiner determines that transfer is proper, he or she staples the form PTO-447 to the front of the file and gives it to the docket clerk for forwarding.

If the receiving examiner agrees to accept the application, he or she classifies and assigns the application and initials the form PTO-447 and the face of the file wrapper. The transfer is effected by the clerk in the group which accepts the application for transfer.

If the receiving art unit refuses to accept the application, the reasons for refusal, the date and the examiner's name are placed on the form PTO-447 in Section II "DISPOSITION BY RECEIVING ART UNIT". Where an application is refused by the receiving art unit based upon the classification of any claim it may be submitted to the classification group associated with the originating art unit for decision. Where an application is refused by the receiving art unit solely for reasons within the purview of the examining corps, e.g., propriety of a restriction requirement, timeliness of transfer, etc., and there is no dispute as to the classification of any claim, the application should be returned directly to the originating art unit using the appropriate line in Section II of the PTO-447.

If an application contains both classification issues and examining corps issues, e.g., a dispute both as to the classification of claims and the propriety of restriction, etc., it should be sent to the appropriate classification group. If the originating art unit receives an application as having only examining corps issues but believes there is a classification issue present, the originating art unit may submit the application to their classification group. For the procedure in the classification groups for applications which contain examining corps issues see >MPEP< § 903.08(e)13.

The time limits for requesting or refusing transfer are as

follows. In a new application transfer must be requested within two calendar weeks of the group receipt date of the application. In an amended application transfer must be requested within two calendar weeks of the group receipt date of the amendment upon which the request for transfer is based. The time limit for refusal of a transfer request is two calendar weeks from the receipt of the transfer request in the receiving art unit.

Exceptions to these time limits are:

1. All new applications (docketed and undocketed) transferred to Group 220 purely for security reasons.
2. New reissue application should be retained in the group indicated by the notice of filing in the *Official Gazette* for two months following the notice before transfer.
3. PCT applications and other special applications for which a different time limit is set by competent authority.

Failure to fill in the date on the form by either the originating examiner or the receiving examiner may result in the assignment of the application to his or her art unit.

If a request for transfer is not made or refused within the two week time limit, the art unit having physical possession of the application must keep it for purposes of examination. However, if the group directors having authority over the art units involved agree that strict adherence to the two week time limit would not provide the best examination for the application, they may waive the requirement.

The question of need for a restriction requirement does not enter the determination of transfer.

The regular messenger service may be used to effect the transfer of applications, with the exception that applications filed under the Patent Cooperation Treaty and such other special applications designated by competent authority must be hand carried throughout the transfer process. If an application is hand carried at any stage of the transfer process, care must be taken that it is wanded in or out on the PALM system as appropriate so that the PALM system will always have an accurate record of the location of the application.

CLASSIFICATION AND ASSIGNMENT OF APPLICATIONS FILED UNDER THE PATENT COOPERATION TREATY (PCT)

Applications filed under the PCT are treated as any other application submitted to a classification group for classification except for the following.

- 1) they are to be hand carried throughout the transfer and classification process;
- 2) classified on the basis of the first claimed invention; and
- 3) classified and returned within three working days of receipt in a classification group.

PROCEDURE IN THE CLASSIFICATION GROUP

The post classifier will consider the statements and evidence of both the originating and forwarding art units and will assign the application to the art unit which has jurisdiction over the art in which the controlling claims of the application are properly classified. This may be the originating, forwarding, or another art unit as appropriate. The post classifier writes the assigned class and art unit number and his or her initials on the face of the file wrapper and on form PTO-447, briefly giving reasons for assignment of the application in the space on the form.

Where the change results in assignment of an application to an art area under the jurisdiction of another post classifier, the post classifier having jurisdiction of the originating group art unit obtains the concurrence and signature on form PTO-447 of the other post classifier who also states on form PTO-447 his or her reasons for accepting the application.

Where there is an issue raised within the purview of the examining corps as well as a dispute as to the classification of any claim the application is treated as set forth in MPEP § 903.08(e), paragraph 13.

Under certain circumstances a post classifier may, contrary to controlling classification rules, assign an application to a class or group which in his or her judgment is better equipped to examine the application. This is fully described in paragraphs 6 and 9 of MPEP § 903.08(e); see also the last paragraph of MPEP § 903.08(e). Assignment by the post classifier becomes final, and no transfer should be accepted without the post classifier's initials on the face of the file wrapper.

RECONSIDERATIONS

The primary examiner of the group art unit to which an application is assigned by the classification group may request reconsideration if he or she believes the post classifier's assignment is in error, by stating the reason on a new form PTO-447, checking the "Request for Reconsideration" box, and sending it with the application to his or her classification group. All previous PTO-447 forms must remain with the application. In each application only one such request for reconsideration will be entertained from any art unit. Reconsideration should not be requested as a matter of routine, but should be requested only in those unusual cases when it is believed that further evidence will cause a reassignment of the application. The post classifier having jurisdiction of the area to which the application is assigned considers the matter and writes his or her decision on the PTO-447 form with the advice and consent of his or her supervisory patent classifier. Reconsideration must be requested within two calendar weeks of the receipt in an art unit of a decision by a classification group. On those rare occasions when an examining group director becomes involved in or shows an interest in the outcome of a reconsideration, the appropriate classification group director(s), in collaboration with appropriate examining group director(s) will come to a final classification decision within one calendar week.

In the assignment of applications it must be realized that every application, no matter how peculiar or confusing, must be

assigned somewhere for examination. Thus, in contesting the assignment of an application it may be more successful to point out another class that is thought to be a better place to classify the application at hand than merely arguing why the application does not fit the examiner's class.<

903.08(e) General Regulations Governing the Assignment of Applications for Examination [R-14]

The fact should be borne in mind that the following regulations are only general guides, and exceptions frequently arise because of some unusual condition. The fact should also be kept in view that the post classifiers as well as the patent examiners are confronted with an already existing classification, made up of newly revised classes, those revised years ago and which have somewhat outgrown their definitions and limits, and still others made a generation ago and never changed. Also, these classes are based on different theories and plans, some on art, some on structure, some on functions, some on the material worked upon, and some apparently, on no theory or plan at all. The post classifiers cannot change this existing condition as each application comes up for assignment but must seek to dovetail the cases into the patchwork and try to get the applications where they will be best handled. To do this may violate the post classifier's views as to what constitutes a really proper classification.

1. The assignment of applications follows, as far as possible, the rules or principles governing the classification of patents.

2. The most comprehensive claim, that is the claim to the most extensive combination, governs between classes, and this is true whether there is only one such claim and a large number of other claims, or whether the sets of claims are more evenly divided. It is regarded as just as vital that one complex claim be searched and adjudicated by an examiner skilled in the art as that a group of such claims be so searched and adjudicated.

3. The claims and statement of invention are generally taken as they read, however, claims must be read in light of the disclosure (claimed disclosure). Any attempt of a post classifier to go behind the record and decide the case upon what is deemed the "real invention" would, it is believed, introduce more errors than such action would cure. The post classifiers cannot possess the specific knowledge of the state of the art in all the classes that the patent examiners collectively possess. Further, such questions are matters of merit for the examiners to determine and are often open to argument and are subject for appeal.

4. Within a class, the first coordinate subclass that will take any claim controls classification.

5. The location of the United States patents constituting the prior art is generally controlling over all else. (Note: Where time permits, obvious misplacements of the patents constituting the prior art are corrected, but to straighten all lines as the cases come up for assignment would require the time of several *>people< and would often involve a reclassification of an entire class.)

6. Ordinarily an application cannot be assigned to a class

which includes one element or part only of several claimed in combination. The claim is treated in its entirety. The question of aggregation is not reviewed by the post classifiers.

7. The post classifiers are authorized in all cases, where they evaluate the facts as warranting it, to assign applications for examination to the group best able to examine the same. Since assignment for examination on this basis will at times be contrary to classification of patents containing the same character of claims, the post classifiers will indicate the proper classification of the patent, if such claims are allowed.

Thus in cases where there is a claim drawn to hybrid or mixed subject matter and the supervisory primary examiner in one discipline feels that the application requires consideration by, or may be best examined by, a group in one of the other technical disciplines, chemical, electrical, or mechanical, he >or she< may submit the application to his or her post classifier who may assign the application on a "best examinable" basis, in accordance with this subsection.

Some examples of applications which may be thus submitted include:

(1) An application containing a hybrid claim wherein, for instance, a product is defined merely in terms of the process for producing it. See >MPEP< § 705.01(e)(1).

(2) Where an application properly assigned to a mechanical or electrical class contains at least one claim to mixed subject matter, a part of which is chemical, the application may be assigned to the appropriate chemical art unit for examination; or where the application is properly assigned to a mechanical class and a claim therein contains electrical subject matter, the application may be assigned to the appropriate electrical art unit for examination.

As indicated earlier, when an application which had been assigned for examination in accordance with this subsection ultimately is allowed, it will be classified according to the controlling claim. In effect, assignment for examination may be on a "best examinable" basis, but the patent will issue and be classified according to the rules of superiority in classification; thus, the search file will have a constant set of rules governing placement of patents therein.

Where an application is being reassigned from one examining discipline to another, under the provisions of this subsection, the post classifiers are authorized to require the first examiner to cite references pertinent to the claimed features falling under the jurisdiction of the art within his discipline. In those cases wherein the application of the reference(s) is not evident or clear, the first examiner should include a brief statement explaining the relation and possible application of the reference(s) to the claim(s); in case of dispute as to the necessity of this procedure, the post classifier has power to require the statement.

8. A patent application filed subsequent to the filing of a PCT application will normally be assigned for examination purposes to the examiner who searched >and/or prepared the preliminary examination report for< the PCT application.

9. When an application has been taken up by an examiner for action and a requirement to restrict is found necessary, a part of the claims being directed to matter classifiable in the group where the case is being examined, an action requiring restriction

should be made without seeking a transfer of the case to another group. The action of the applicant in response to the requirement for restriction may result in making a transfer of the application unnecessary.

10. Ordinarily where all the claims of an application are for an article made of a specific composition or alloy with no other structure of the article recited, the application will be assigned to the composition or alloy class.

11. A class of cases exists in which either no art or a divided art is found and in which no rule or principle is involved. (Such cases are placed where, in the judgment of the post classifiers they will be best searched and adjudicated.) It is often impossible to so explain a decision in this class of cases as to satisfy, or in any way aid, the examiners interested. Indeed, the reasons for or against sending such cases one place or another may be so evenly balanced that no reason of any value can be given.

12. An examiner seeking the transfer of a case may make a search, both of his or her own class and the class to which he or she thinks the case should be transferred, and the examiner in charge of the art unit should exhibit the result of such search to the appropriate classification group. This is the way the expert knowledge of the examiners involved is utilized.

13. When an application is received in a classification group in which there is a matter under dispute which is not related to the classification of a claim but which is in the purview of the examining corps, e.g., propriety of a restriction requirement, timeliness of submission for transfer, etc., as well as a dispute over the classification of claims the application will be treated as follows.

The classifier will check the appropriate box on the PTO-447 indicating that the application is being returned (not assigned) to the originating group to resolve the non-classifying issues involved. The classifier will indicate on the PTO-447 the proper classification of any claims under dispute. If any claims under dispute are outside the jurisdiction of the classifier associated with the originating group, that classifier will obtain concurrence of the classifier having jurisdiction of the claims in question who will sign the PTO-447 as the concurring classifier. Multiple concurrences may be required for application with claims classifiable in different art areas.

It is important that newly received applications be immediately screened for these situations so that the applications may be promptly returned to the originating group.

If after resolution of the non-classifying issues there is still a dispute as to which group should examine the application, the originating group may return the application to classification for assignment.

903.08(f) Post Classifier's Decision [R-14]

A post classifier in a classification group decides the question of the proper classification of the application, and either (1) returns the application to the group which submitted it if he or she denied the transfer request, or (2) forwards the application to the group to which it is transferred. See also MPEP § 903.10.

903.08(g) Transfer to Another Examining Group After Decision [R-14]

If the application is to remain in the group which submitted it for classification, no further procedure is necessary. If assigned to another group, the classification group processes the case as described in the Manual of Clerical Procedures.

If the case is one which has been taken up for action by an examiner according to its effective filing date, it should be treated as special by any examiner, art unit, or group to which it is transferred. See MPEP § 708.01.

903.09 International Classification of Patents for Inventions [R-14]

In accordance with the Strasbourg Agreement Concerning the International Patent Classification, the United States is required to indicate on its issuing documents the classification symbols of the International Patent Classification 1989 (Fifth Edition), hereinafter referred to as "Int. Cl. 5".

The complete Int. Cl. 5 symbols must be placed in the indicated space on the Issue Classification Slip (form PTO-270) when an application is issued.

The layout of the Int. Cl. 5 is explained below with reference to the sample page.

Section

The Classification represents the whole body of knowledge which may be regarded as proper to the field of patents for invention, divided into eight sections.

(a) *Section Symbol* — Each section is designated by one of the capital letters A through H.

(b) *Section Title* — The section title is to be considered as a very broad indication of the contents of the section. The eight sections are entitled as follows:

- A Human Necessities
- B Performing Operations; Transporting
- C Chemistry; Metallurgy
- D Textiles; Paper
- E Fixed Constructions
- F Mechanical Engineering; Lighting; Heating; Weapons; Blasting
- G Physics
- H Electricity

(c) *Contents of Section* — Each section title is followed by a summary of the titles of its main subdivisions.

(d) *Subsection* — Within sections, informative headings form subsections, which are titles without classification symbols.

Example: Agriculture

Class

Each section is subdivided into classes.

(a) *Class Symbol* — Each class symbol consists of the section symbol followed by a two digit number.

Example: A 01

(b) *Class Title* — The class title gives an indication of the content of the class.

Example:

A 01 Agriculture; Forestry; Animal Husbandry; Hunting; Trapping; Fishing

Subclass Each class comprises one or more subclasses.

(a) **Subclass Symbol** — Each subclass symbol consists of the class symbol followed by a capital letter.

Example: A 01 B

(b) **Subclass Title** — The subclass title indicates as precisely as possible the content of the subclass.

Example:

A 01 B Soil Working in Agriculture or Forestry; Parts, Details, or Accessories of Agricultural Machines or Implements, in General

(c) **Subclass Index** — Some subclasses have an index which is merely an informative summary giving a broad survey of the content of the subclass.

Group Each subclass is broken down into subdivisions referred to as "groups", which are either main groups or subgroups.

(a) **Group Symbol** — Each group symbol consists of the subclass symbol followed by two numbers separated by an oblique stroke.

(b) **Main Group Symbol** — Each main group symbol consists of the subclass symbol followed by a one to three digit number, the oblique stroke and the number 00.

Example: A 01 B 1/00

(c) **Main Group Title** — The main group title defines a field of subject matter considered to be useful in searching for inventions.

Example: A 01 B 1/00 Hand tools

(d) **Subgroup Symbol** — Subgroups form subdivisions under the main groups. Each subgroup symbol consists of the subclass symbol followed by the one to three digit number of its main group, the oblique stroke and a number of at least two digits other than 00.

Example: A 01 B 1/02

Any third or fourth digit after the oblique stroke is to be read as a decimal subdivision of the second or third digit, respectively, e.g. 3/426 is to be read as "three slash forty two point six", not "three slash four hundred and twenty six" and is to be found after 3/42 and before 3/43, and 5/1185 is to be read as "five slash eleven point eight five", and is to be found after 5/118 and before 5/119.

(e) **Subgroup Title** — The subgroup title defines a field of subject matter within the scope of its main group considered to be useful in searching for inventions. The title is preceded by one or more dots indicating the hierarchical position of the subgroup, i.e. indicating that each subgroup forms a subdivision of the nearest group above it having one dot less. The subgroup title is often a complete expression, in which case it begins with a capital letter. A subgroup title begins with a lower case letter if it reads as a continuation of the title of the next higher, less-indented group, i.e. having one dot less. In all cases, the subgroup title must be read as being dependent upon, and restricted by, the title of the group under which it is indented.

Examples

A 01 B 1/00 Hand tools
1/24 for treating meadows or lawns
(The title of 1/24 is to be read as: Hand tools for treating meadows or lawns.)

A 01 B 1/00 Hand tools
1/16 Tools for uprooting weeds
(The title of 1/16 is a complete expression, but owing to its hierarchical position, the tools for uprooting weeds are restricted to hand tools.)

Complete Classification Symbol A complete classification symbol comprises the combined symbols representing the section, class, subclass and main group or subgroup.

Example:

A	01	B	1/00	Main group
Section	Class		or 1/16	Subgroup
		Subclass		Group

Guide Headings

The main groups in each subclass are arranged in a sequence intended to assist the user. It has not however, been found practicable to standardize the sequence. Where several successive main groups relate to common subject matter, it is usual to provide before the first of such main groups a "guide heading" which is underlined, indicating this subject matter (see, for example, the guide heading "Ploughs" before group A 01 B 3/00). The series of groups covered by such a heading extends to the next guide heading or to a line in heavy type extending across the column, which is used when the following group or groups relate to different subject matter for which no guide heading is provided (see, for example, the line after A 01 B 75/00).

CLASSIFYING IN THE INT. CL.³ SYSTEM**A. Selecting subclasses (Corresponding to U.S. Classes)**

The effective scope of a subclass is defined by the following, taken together:

(a) The subclass title which describes, as precisely as is possible in a small number of words, the main characteristic of a portion of the whole body of knowledge covered by the Classification, this portion being the field of the subclass to which all its groups relate;

(b) Any references which follows the subclass title or the hierarchically higher class title. These references often indicate certain parts of the field described by the title which are covered by other subclasses and are therefore excluded. These parts may constitute a substantial part of the field described by the title and, thus, the references are in some respects as important as the title itself. For example, in subclass A 47 D — FURNITURE SPECIALLY ADAPTED FOR CHILDREN — a considerable part, namely school benches or desks, of the subject matter covered by the title is excluded in view of a reference to particular groups of subclass A 47 B, thus considerably altering the scope of subclass A 47 D;

1/02; B07B 7/083; C08F 110/04; and C08F 267/00. >Examiners should assure that the IPC notations used are from the current edition.<

903.10 Duties of the Post Classifier [R-14]

Post classifiers were established to improve liaison between the classification groups and the examining groups. Examiners should contact their post classifier on all classification problems.

Each post classifier is assigned one examining group as his >or her< responsibility. *>Each post classifier< is charged with all classification duties relative to this one examining group, except for major reclassification projects.

A post classifier is responsible for:

(1) The technical accuracy, adequacy and completeness of all search systems in his >or her< group including the monitoring of any need for major and minor reclassification projects including mechanized systems.

(2) The full range of classification administration functions including the resolution of classification disputes on pending applications, guidance on classification matters to both examiners and the public, which includes outlining fields of search and answering examiner's requests for advice as to the proper classification of allowed applications.

(3) The inspection of issuing applications to determine the accuracy and adequacy of original and cross-reference classification by working closely with the supervisory primary examiners and group directors to insure feedback to correct problem areas.

(4) Determination of the training needs of the personnel in his >or her< assigned group relative to principles of classification and supplying this training through formal and informal channels.

Generally, the post classifiers are to aid the examiners in the use, maintenance, and perfection of the classification system.

904 How to Search [R-14]

The examiner, after having obtained a thorough understanding of the invention disclosed and claimed in the application, then searches the prior art as disclosed in patents and other printed documents. Any such document used in the rejection of a claim is called a "reference."

In all continuing applications, the parent applications should be reviewed by the examiner for pertinent prior art. Where the cited prior art of a parent application has been reviewed, this fact should be made of record in accordance with the procedure set forth at B.S. of >MPEP< § 717.05.

The first search should be such that the examiner need not ordinarily make a second search of the prior art, unless necessitated by amendments to the claims by the applicant in the first response, except to check to determine whether any reference which would appear to be substantially more pertinent than the prior art cited in the first Office action has become available subsequent to the initial prior art search. It should cover the invention as described and claimed, including the inventive

concepts toward which the claims appear to be directed. It should not be extended merely to add immaterial variants.

904.01 Analysis of Claims

The breadth of the claims in the application should always be carefully noted; that is, the examiner should be fully aware of what the claims do *not* call for, as well as what they do require. There is always danger of reading into the claim limitations imported from the specification or drawing.

904.01(a) Variant Embodiments Within Scope of Claim

Substantially every claim includes within its breadth or scope of definition one or more variant embodiments not disclosed by applicant, which would anticipate the terms of the definition. The claim must be so analyzed and understood that any such variant encountered during the search will be recognized and selected.

In each type of subject matter capable of such treatment (e.g., a machine or other apparatus), the subject matter as defined by the claim may be sketched in order to clearly delineate the limitations of the claim. Two or more sketches, each of which is as divergent from the particular disclosure as is permitted by claim recitation, will assist the examiner in determining the claim's actual breadth or scope. However, an applicant will not be required to submit such sketches of claim structure (*In re Application filed November 16, 1945*, 1951 C.D. 1, 646 O.G. 5).

904.01(b) Equivalents

All subject matter that is the patentable equivalent of the subject matter as defined in the claim, even though specifically different from the definition in the claim, must be considered.

904.01(c) Analogous Arts

Not only must the art be searched with which the invention claimed is classifiable, but also all analogous arts regardless of where classified.

The determination of when arts are analogous is at times difficult. It depends upon the necessary essential function or utility of the subject matter covered by the claims, and not upon what it is called.

For example, a tea mixer and a concrete mixer are for the same art, namely the mixing art, this being the necessary function of each. Similarly a brick cutting machine and a biscuit cutting machine have the same necessary function.

904.01(d) Outlining Field of Search [R-14]

>A proper field of search includes the subclass in which the claimed subject matter of an application would be properly classified. The proper field of search shall not include those

areas in which it could reasonably have been determined that there was a low probability of finding the best reference(s).<

In outlining a field of search the examiner should note every class and subclass >under the U.S. Patent Classification system and other organized systems of literature,< that may have material pertinent to the subject matter as claimed. Every subclass, digest and cross reference art collection pertinent to each type of invention claimed should be listed, from the largest combination through the various subcombinations to the most elementary part. The search should extend to all probable areas relevant to the claimed subject matter and should cover the disclosed features which might reasonably be expected to be claimed.

>Strategies should be developed by the examiner for locating prior art utilizing both manual and machine search tools.

The areas to be searched should be prioritized so that the most likely areas are searched first.

The examiner should plan a search that not only covers the claimed subject matter, but one that also covers the disclosed features that might reasonably be expected to be claimed. The examiner should consult with other examiners and/or supervisory primary examiners, especially with regard to applications covering subject matter unfamiliar to the examiner.<

The following should be kept in mind: (a) that a combination reference is necessary to reject a claim drawn to a ** combination, (b) that a combination reference is valuable as a basic reference where elements thereof may be varied by substituting equivalent elements of a secondary reference, (c) that a convincing aid to a rejection on the ground of old combination is the citation of references showing the subcombinations to have been already recognized as having practical and more general utility, (d) that combination claims can be shown unpatentable by combining separately classified subcombinational elements where reasons can be given for holding obviousness in forming the combination, and (e) that in the rejection of a claim on the ground of aggregation, the citation of references showing the individual utility of the elements may better prove that the aggregative structure is no more than the sum of the features shown by the several elemental patents.

An examiner, in each first action upon an application, makes an initial endorsement in ink in the space provided on the left-hand page of the open file wrapper, stating the classes and subclasses of domestic and foreign patents, abstract collections and the publications in which search for references was made and also the date of the search. Note >MPEP< § 717.05.

In subsequent actions, if further search is made, notation of the additional field covered is also endorsed and initialed on the file wrapper.

904.02 Conducting the Search

It is a prerequisite to a speedy and just determination of the issues involved in the examination of an application that a careful and comprehensive search, commensurate with the limitations appearing in the most detailed claims in the case, be made in preparing the first action on the merits so that the second action on the merits can be made final or the application allowed

with no further searching other than to update the original search. It is normally not enough that references be selected to meet only the terms of the claims alone, especially if only broad claims are presented; but the search should, insofar as possible, also cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant's amendment. A complete search should result if applicants included, at the time of filing, claims varying from the broadest to which they believe they are entitled to the most detailed that they would be willing to accept.

It thus results that the examiner finds references that, while not needed for treating the claims would be useful for forestalling the possible presentation of claims to other subject matter regarded by applicant as his or her invention, and claimable with the subject matter being currently claimed, but shown to be old by these references.

In selecting the references to be cited the examiner should carefully compare the references with one another and with the applicant's *disclosure* to avoid the citation of an unnecessary number. The examiner is not called upon to cite *all* references that may be available, but only the "best." (37 CFR 1.106.) Multiplying references, any one of which is as good as, but no better than, the others, adds to the burden and cost of prosecution, and should therefore be avoided. However, if doubt exists as to the inclusion of a reference, it is better to err in citing too much art rather than too little.

The best reference should always be the one used. Sometimes the best reference will have a publication date less than a year prior to the application filing date, hence it will be open to being overcome under 37 CFR 1.131. In these cases, if a second reference exists which cannot be so overcome and which, though inferior, is an adequate basis for rejection, the claims should be *additionally* rejected thereon.

In all references considered, including non-patent, foreign patents and domestic patents, the examiner should study the specification or description sufficiently to determine the full value of the reference disclosure relative to the claimed or claimable subject matter.

905 Miscellaneous

905.01 Photocopy Orders

Patents and/or applications received from Germany, Federal Republic of, since October 1, 1968 and from Japan, France and U.S.S.R. since July 1, 1969 are not in numerical sequence. Inasmuch as the Patent and Trademark Office supplies orders for copies of these foreign documents from master microfilm reels made up on weekly or other periodic publishing sequences, all orders must include the country, patent or application number, and the publication date (if known) of the ordered document. Reference should be made to >MPEP< § 901.05(a) to assist in determining the publication date of the commonly encountered foreign patents and applications.

All orders for photocopies on PTO-250 originating in the examining groups must be authorized by an examiner having

full or partial signatory authority in the box headed "PRIMARY EXAMINER (Signature)". The stamped name of the authorizing examiner will be indication of authority for Reproduction Section. Handwritten signatures should not be used.

905.02 Soft Copy Orders [R-14]

**>Soft copies of U.S. patents for the examiner's personal use may be ordered by the examiner on blue-colored order form PTO-14A. These copies are not to be placed in the official search file. To complete the form PTO-14A, the examiner should indicate the number of copies desired in the box marked "NO. OF COPIES" and should also complete the "PATENT NUMBER," "EXAMINER'S NAME," "ART UNIT," and "DATE OF ORDER" boxes.

To expedite the handling of requests for personal copies and thereby ensure the quickest response, the following routing procedures should be adhered to:

(1) Designated collection drops within each group for copy orders should be used.

(2) Group clerical personnel should hand-carry or mail the PTO-14A orders at least daily to the Search File Improvement Division, currently located in Crystal Mall Building 2, Room 967.

The attorneys' drop slot at the Public Service Window should not be used nor should the forms be mailed to Copy Fulfillment Services as consequent rerouting to the Office of Classification Support for processing will result in unnecessary delay.

Copies provided for personal use will be stamped "DONOT PLACE IN SEARCH FILE;" any such copy found in the search file will be removed by refiling personnel. Because of the cost of printing copies of patents, economy should be exercised in their use. Personal use soft copies no longer desired by examiners should be destroyed.

In view of the high cost of printing patents with color drawings, orders by examiners for plant patents and other patents with color drawings for personal use will normally not be filled.<

A	PATENT NUMBER	2,345,678	NO. OF COPIES	1
	USE A SEPARATE ORDER FORM FOR EACH PATENT NUMBER			
EXAMINER'S NAME		ART UNIT	DATE OF ORDER	
HENRY GREEN		352	10-15-78	
EXAMINER'S NOTES				
PTO-14A REV. 5 '78 U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE				
PATENT ORDER FOR EXAMINER'S USE ONLY				

B	DATE OF ORDER	1-5-83	PATENT NUMBER	3,456,789
	USE A SEPARATE ORDER FORM FOR EACH PATENT NUMBER			
EXAMINER'S NAME AND ART UNIT		EXAMINER'S USE THIS SPACE IN ORDER TO COPY FOR EACH CLASSIFICATION	TOTAL COPIES	
Joseph M. Thesz Art Unit 233			6	
EXAMINER'S NOTES		ONLY ONE CLASSIFICATION PER LINE		
		CLASS	SUBCLASS/DIGEST	
		1 364	200	
		2 377	1	
		3 377	14	
		4		
		5		
PTO-14A REV. 5 '78 U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE				
EXAMINER'S ORDER - CROSS REFERENCES FOR SEARCH FILES				

905.03 Ordering of Patented and Abandoned Files

In the examination of an application it is sometimes necessary to inspect the application papers of some previously abandoned application or granted patent. This is always true in the case of a reissue application and reexamination proceeding.

Patented and abandoned files are stored at the Files Repository located near the other PTO buildings in Crystal City. Older files are housed in a warehouse located in Suitland, Maryland.

Patented and abandoned files are ordered by means of a PALM video display transaction. To place such an order, the examiner is required to input his/her PALM location code, employee number, and patent number(s) and/or serial number(s) of the file(s) that are needed. After transmission of the request transaction by the examiner, a "response" screen appears on the video display terminal which informs him/her of the status of the request for each file. The examiner is informed that the request (1) is accepted; (2) is accepted, but for which the file is located at the Suitland warehouse (in which case delivery time is increased); or that the request is not accepted since (3) the file is not located at the repository or warehouse; (4) a previous request for the file has not yet been filled; or (5) the patent or serial number inputted is not valid.

Periodically each day, personnel at the Files Repository perform a PALM print transaction which produces a list of all accepted requests in patent number order and, for requests for abandoned files, in serial number order. The printed record of each request is detached from the list when its associated file is found. It is then stapled to it. Throughout the day, periodic deliveries of files are made directly to the offices of their requesters by Files Repository personnel. Upon delivery of files at the various locations, files that are ready to be returned to the repository are picked up.

With the exception of certain older files, the drawings of patented and abandoned files, if any, are now stored within their respective application file jackets. Since it is desired not to separate one from the other, both the file and its drawings are delivered when a file is ordered.

905.04 Marking Examiners' Copies of Patents

When the examiners' copies of patents are sent to their respective art units to be filed, they should be routed across the appropriate examiners' desks prior to placement in the shoes. The assistant examiners who examined the application should mark in ink on the face of the drawings, or the specifications where there are no drawings, such features as may be deemed advantageous in aiding understanding of the patents in future searches.

905.05 Application File Location

All files should be returned promptly to their proper location.

Whenever an application file is moved from one PALM location to another, e.g., removed from a group's central files or moved from one examiner to another, the PALM record should be updated with its current location. The appropriate bar code transaction should be performed. For example, if the examiner to whom the application is docketed obtains it, he/she should perform PALM transaction 1023 by pressing the "TOEXR" key on the bar code reader and scanning the bar code label of the file with the light pen of the BCR. If an examiner other than the one to whom the application is docketed obtains the file, he/she should perform transaction 1036 which requires the input of his/her group number and his/her employee number before the label is scanned. All files should be returned promptly to their proper location.

>905.06 Family of Patent Information [R-14]

Patent family information is available at the United States Patent and Trademark Office primarily through commercial databases. Examiners have access to this information either directly or through the search services of the Scientific and Technical Information Center (STIC).

Available Databases

Derwent's World Patents Index in (WPI) and International Patent Documentation Center (INPADOC), are the two databases used for retrieving foreign patent information.

INPADOC is the first choice for quick searches for publication dates or patent families because of its ease of use and low cost. The Office enjoys cost effective rates for INPADOC due to an agreement between the Office and the International Patent Documentation Center (now part of the European Patent Office) negotiated several years ago. The agreement applies only to INPADOC as accessed directly on the INPADOC computer in Austria, not to INPADOC as available on other commercial database systems such as ORBIT, DIALOG or STN.

WPI is used whenever abstracts are needed or when searches in addition to publication date or Patent family are required, such as searches on inventor name or IPC (International Patent Classification).

Access to Foreign Patent Information

Patent examiners who have received training and access codes may directly search INPADOC or WPI or both. Examiners who have been trained on searching the ORBIT, DIALOG or Questel systems may also search WPI, with or without specific training on WPI, since WPI is one of the databases available on these systems.

Examiners may also request foreign patent searches through the Scientific and Technical Information Center (STIC). Trained searchers in both the Reference and Foreign Patents sections of STIC perform patent family searches on demand, with a short turnaround time. The Foreign Patents section can also help examiners get copies of foreign patents found through online searching.<



MANUAL OF PATENT EXAMINING PROCEDURE