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Section 3. EXAMINATION OF PATENT APPLICATIONS

10-1-1. Examination of Patent Applications

The applicant's disclosure of the invention is sufficient for the purpose of detecting, in the absence of any art in the field, any obviousness, or obviousness, that; such detection and a rejection of such claims come within the province of the Examiner's work. Rejection of such objections, however, is necessary only; the primary purpose of the examination is to determine through understanding of the applicant's invention, and thus enable the Examiner to make an intelligent examination of its merits or novelty.

The conditions precedent to the grant of a patent to an inventor are set forth in Sec. 4996, R.S.;

any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereof, or who has invented or discovered and usefully reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not previously described in any printed publication in this or any foreign country, or before his invention or discovery thereof or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless he can prove that he has been a resident, or was doing business, or had acquired an actual domicile, in this country at the time of his invention or discovery thereof.

The applicant must, before filing a patent application, have a right of ownership in the invention.

The applicant must also, before filing a patent application, have a right of ownership in the invention. It is required that the applicant must have a right of ownership in the invention at the time of the filing of the application.

10-1-1. Residence and Domicile

It is required that the applicant (Sec. 4996, R.S.) must have a residence or domicile in this country at the time of the filing of the application.

and process of making, constructing, compounding, and using it, in such full, clear, and concise, and exact terms as to enable any person skilled in the art or science to which it pertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in the case of a machine he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions.

As this forms the consideration on the part of the inventor in return for which he receives protection, the Examiner should be careful to see that the description is full, clear, and concise, and call upon the applicant for all necessary amplifications or amendments. Such amendatory matter, however, must fall within the confines of the original disclosure; otherwise, it is not admissible to the case. While amendments to the specification and claims involving new matter are entered, such matter is required to be cancelled from the specification, and the claims affected are rejected. A "new matter" amendment of the drawing is not entered.

10-1-2. Original Claim May be Basis For Disclosure

In establishing a disclosure applicant may rely not only on the specification and drawing as filed but also on the original claims if their content justifies it.

10-1-3. Claims Necessary

Sec. 4893 R.S. also requires that the applicant shall particularly point out and distinctly claim the part, improvement, or combination which he regards as his invention or discovery. The portion of the application in which he does this is the claim or claims. This is the most important part of the application, as it is the definition of that for which protection is granted.

There is no set form for a claim, but in every particular in which the claim fails to define correctly applicant's invention, it should be challenged and the fault definitely pointed out.

Having obtained thorough understanding of the subject matter disclosed and claimed in the application, the Examiner 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".

10-1-4.

Breadth of a Claim

The breadth of a claim should always be carefully noted; that is, the Examiner should be fully aware of what the claim does not call for, as well as what it does require. For, there is always danger of slipping into the claim limitations imported from the specification or drawing. In the case of a machine, if a claim is broadly stated, it is well to draw an elemental sketch of the subject matter, to better visualize the breadth of the claim; and this should be kept in mind while searching the case.

While the picture of the patent or publication that most nearly resembles that of the application will of course most readily respond to the structural recitations of the claims, the matter of function or use must not be overlooked in the selection of a reference. Ordinarily, the basic reference should be from the same art as the application; at any rate it should have the same basic function. That is, a tea mixer may be reference for a concrete mixer; a brick-cutting machine for a biscuit-cutting machine; for in each instance the ultimate function of the two devices is the same.

10-1-5. Publications Available to Examiner

There are some publications kept in every division and each assistant Examiner should ascertain what they are in his division and whether or not any of them is likely to bear on the class assigned to him. There is a Scientific Library in the Office, with which the assistant Examiner in the Patent Office should acquaint himself sufficiently to know when it is likely to afford him assistance in his examination of an application. The Library contains copies of foreign patents to which the Examiner may have recourse when he is unable to find in his own office those whose number and title he needs.

10-1-6.

Ordering Soft Copies

Soft copies may be ordered on Form 57 by the Examiner or his assistant. These copies should be ordered from the Patent Copy Sales Branch. No one other than those assigned to this branch have access to the files of printed copies of patents. In emergency cases, requests should be taken to the Chief of the Branch whose approval, if given, will insure instead of filling of such orders.

Copies of patents cost only twenty-five cents each (less a patent of ten cents each), an economy should be exercised in their use. It is advisable to place in the application file soft copies of those patents cited from other classes. This will avoid a duplicate order when the application is amended to re-examine, or if amended it is re-examined.

10-1-7. Classification of a Granted Patent

To find out the classification of a domestic patent whose classification does not appear on the copy at hand, the Classification Division should be consulted.

10-1-8. Prints of Foreign Patents

Prints of foreign patents classified in arts in other divisions can be had by an Examiner if he thinks the patents would be of frequent use in his own class. Otherwise, he can borrow from the other division the patent needed for a particular case.

10-1-9. Translation of Foreign Patents

In foreign patents, as in domestic, the Examiner should refer to the specification for every feature in the drawing he does not thoroughly understand. A translator in the Scientific Library is available to assist the Examiner with the specifications in any language with which he is not familiar. Typed translations can be had if necessary.

10-1-10. Patented Files

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

Patented files may be obtained in the Record Room by filling out slips (Form No. 126 or PO-124, according to whether or not the files are to be taken from the room), found there, with the necessary data and giving these slips to the clerk in charge. The patented files are drawn from the shelves and distributed, the slips being retained by the clerk as a check. The patented file should be promptly returned when the Examiner has finished with it.

10-1-11. Files of Abandoned Applications

Files of abandoned applications may be obtained in the same way.

10-1-12. Search to be Noted

The search having been completed, the Examiner will make an endorsement in ink, on the left hand page of the open file wrapper, stating the classes and sub-classes of domestic and foreign patents and the publications in which search for references has been made, together with the date of the search and the Examiner's initials. In subsequent

actions, if further search is made, notation of the additional field searches should also be entered on the file wrapper.

10-1-14. "General Information Concerning Patents"
Sent Instead of "Rules of Practice"

Whenever in the examination of an application the Examiner deems it advisable to send a copy of the Rules of Practice to the applicant for his guidance, the small pamphlet entitled "General Information Concerning Patents" should be sent instead unless there is some particular reason for sending the copy of the rules.

10-1-15. Examiner Must Not Cast Shadow on Patent

Everything of a doubtful nature must be avoided and also must everything which would cast a shadow on the patent if granted, as for example, a statement that "every doubt has been resolved in favor of the applicant in granting him the claims allowed".

10-1-16. Discourtesy of Attorney

Rule 1.3 Business to be Conducted With Decorum and Courtesy. Applicants and their attorneys or agents are required to conduct their business with the Patent Office with decorum and courtesy. Reports or statements in violation of this requirement will be submitted to the Commissioner and will be returned by his direct order. Complaints against Examiners and other employees must be made in communications separate from other papers.

If the attorney is discourteous in the receipt or return of his papers, the papers in question should be returned to the Patent Office and the Commissioner will advise to him being returned.

10-1-17. Signatures for Retention of Records

(See Section 10-1-17)

10-1-18. Initials in Correspondence
and in Applications

In each Examiner's letter, the word "Examiner", without a number, of the Division, should be printed in the margin of the letter. In applications, the initials of the Examiner should be printed in the margin of the application.

A carbon copy of the letter is also made. Both copies, together with the rough draft, if there be one, and the file are put on the Assistant Examiner's desk, who will compare the copy with the rough draft, paying particular attention to the date of the references. If any corrections are to be made, he will note them in lead pencil and return the papers to the stenographer for correction. When the corrections have been properly made, or when there are no corrections required, the Assistant Examiner will initial the original copy and place the file with the two copies of the letter on the desk of the primary Examiner for his inspection and for his signature to the original copy. Carbon copies should not be signed by the assistant or primary.

10-2-3. Unsigned Amendment

An unsigned amendment or one not properly signed by a person having authority to prosecute the case is not entered. This applies where the amendment is signed by one only of two inventors.

10-2-4. Unsigned Amendment, Disposal of

When an unsigned amendment or an improperly signed amendment is received, and there is not sufficient time for the return of the paper for signature before the expiration of the time allowed by law within which to take proper action, the Examiner will enter the amendment on the file wrapper and notify the applicant of the status of the case.

The present practice requires the Examiner in carrying out the provisions of above paragraph to give applicant a specified time (15 to 30 days) to furnish a duplicate amendment properly signed, or to ratify the amendment already filed.

Informal amendments which are to be returned will be forwarded to the Executive Officer with a memorandum giving the name and address of the attorney, the date of the last office action in the case and a statement as to why the paper is to be returned. The Executive Officer will cancel the impression of the receiving stamp and conduct the correspondence incident to the return of the papers.

Before taking action as prescribed in the preceding paragraph, the Examiner should call in the local representative of the firm, if there be one, as he may have authority to sign the amendment.

10-2-5.

Telegraph Amendment

When a telegraph amendment is received it is placed in the file, but not entered. If ratification of this amendment does not follow in due time, the applicant is notified that proper ratification is required; otherwise, the telegraph will not be accepted in any way. A return is sent to the letter office to this effect. If the ratification is promptly received, the amendment is entered. (See *Ex Parte Wherry*, 17 O.G. 134; 115 O.D. 253).

The same test as to consistency of substance applies to an amendment sent by telegraph as to one sent by mail.

10-2-6.

Signed by Attorney Not of Record

Where an amendment signed by an attorney whose power is not of record is filed, both the attorney and applicant are notified that the amendment cannot be entered.

When the Examiner's letter is of such character that the statutory period for amendment runs from the date of a previous action, a statement to that effect should be made at the end of the letter and the date from which the statutory period runs given.

10-2-7.

Amendment Signed by Applicant
Not by Attorney of Record

If an amendment signed by the applicant is received in an application in which there is a duly appointed attorney, the amendment should be entered and acted upon. Attention should be called to Rule 6.5 and a copy of the letter should be mailed to the applicant, as well as to the attorney.

10-2-8.

Power of Attorney by a Firm

Where a power of attorney is given to a firm stated to consist of certain members, an amendment should be signed with the firm name; or if the firm name is stated or typewritten, the signature of one of the members of the firm should appear beneath the firm name.

Where the power is given to several individuals by name, and they are stated to constitute a firm whose title is given, an amendment signed with the name of any one of the individuals or with the firm name is regarded as properly signed.

Where the firm name is stated or typewritten and the name of a member of the firm is not signed beneath, it is not a proper signature.

An amendment in which the name of the attorney or firm, stamped, typed or written is followed by the word "per" and the initials or signature of a stranger to the record is not properly signed.

10-2-9. Assistant to Attorney
Signs Amendment After Attorney Dies

An amendment signed by an assistant in the office of the attorney, the latter having died, may, with the approval of the Commissioner, be admitted, subject to future ratification.

10-3. Actions Which Require the Personal
Attention of the Primary Examiner

The Primary Examiner, though responsible for all of the actions and decisions made in the conduct of the work of his division, must, in view of the amount of that work, delegate to the experienced and reliable Assistant Examiners of his division authority to pass on many of the questions to be decided in the prosecution of cases. There are some questions, however, which existing rules or orders require the Primary Examiner personally to decide. The following actions fall in this category:

1. Third action in any case. (See third following paragraph)
2. Action in a case pending for more than one year. (See third following paragraph)
3. Final Rejection.
4. Withdrawal of Final Rejection.
5. Decision on Reissue Oath.
6. Decision on Affidavit under Rule 18.1.
7. Sealing of Rule 18.1 Affidavit prior to interference.
8. Setting up an interference.
9. Disposition of an amendment in a case in interference looking to the formation of another interference involving that application.
10. Decisions on Interference Actions under Rule 25.2 to 25.5; also, actions taken under Rule 25.7.
11. Rejection of a previously allowed claim.
12. Proposed rejection of a pending patent claim.
13. Objection of a claim.
14. Hold in abeyance of an insufficient response.
15. Suspension of an application (Rule 16.3).
16. Treatment of newly filed application which obviously fails to comply with Section 4000 R.S. 595 O.G. 141. (See following paragraph)
17. Treatment of newly filed application where amendments are admitted but filing date only. (See second following paragraph)

Whenever in an examination of an application the Primary Examiner finds that a prior filed application has previously failed to disclose an invention with the clarity required by Sec. 1025 R.S., or whenever immediately after such an examination attention is directed to such an application, attention is directed to Rule 12.4 to hold an application in abeyance. Office action, which should be taken immediately, should be issued which is revised to conform with the practice prevailing before this Office. A shortened statutory period may be set for compliance with this requirement, the duration of such shortened period, if set, being determined by the Primary Examiner in accordance with the complexity of the case, the revision of the specification necessary, and time necessary for communication with the applicant. These actions, in all cases, regardless of whether a shortened statutory period is set, should be submitted to the Supervisory Examiners for review 12.115, C.G. 145.

In some instances drawings accompanying new applications are of such quality that they may not be suitable for examination because of defective execution or other reasons. Nevertheless, to accept the application of securing a patent, the Chief Draftsman in each case should be advised "As per filing date only." When such drawings are received by the Primary Examiner, he should immediately write a letter in the case notifying the applicant that the drawings do not comply with the requirements of filing the application. Filing date is to be taken within ninety days he must file a set of drawings meeting the requirements of Rule 12.4 and conforming with the drawings on file. The letter should additionally state that failure to furnish such drawings within the time stated will be taken as sufficient basis for holding the application abandoned. This letter of the Primary Examiner will not be entered in the action and the file should be kept closed. If drawings are not received within the ninety-day period, an action should be taken in the case as abandoned.

12-3 ()

Case Law for Third
Action and Five-Year Cases

The Principal Examiner should advise their assistants with the fact that the shortened period to the final decision of an application or finally the best references on the file should be carefully examined.

The Principal Examiner are expected to especially examine every application which is a third official action with a view of finally concluding its prosecution.

Any case that has been pending five years should be carefully studied by the Principal Examiner and every effort made to terminate its prosecution. In order to accomplish this result, the case is to be considered "special" by the Examiner.

10-4. Dual Prosecution

10-4-1. Definition

Where a case contains, in addition to the claims which control its classification, other claims which, though not divisible from the controlling claims, are per se classifiable in art in another examining division, as in the case of old combination claims and claims to an element or subcombination therein, the Examiner to whom the case is assigned may require the Examiner who has the claim to which the second group of claims pertains to make an action thereon which will be mailed by the Examiner to whom the case is assigned along with his action on his group of claims.

This practice is known as "Dual Prosecution" (D.P.).

More than one other division may be involved.

10-4-2. Purpose

Dual prosecution is based on the proposition that when plural, indivisible inventions are claimed, in many instances either less time is required for examination, or the results are of better quality, when specialists on each character of claimed invention treat the claims directed to their speciality. A saving of the total time that is required to give a thorough examination of an application is of primary importance.

10-4-3. Jurisdiction and Responsibilities of Division to Which Case is Assigned

The application will be considered as regularly assigned to the division having the governing claim, and will be entered on the official register of that division. Such division will assume general jurisdiction of the application for formal matters, will receive and enter all amendments, and will mail all actions including the notice of allowance.

The actions taken by the several Examiners in a Dual prosecution case must be consistent with one another. Where divergent or conflicting views on substantive or procedural issues are held by the Examiners, and it is found impossible to harmonize these views, it will then be necessary for the Examiner to whom the case is assigned to

transferring the entire prosecution. The maintenance of
control in the responsibility of the Examiner to whom the
case is referred. In view of this responsibility Dual
Prosecution may be required to be done by the Examiner to
whom the case is referred.

The Examiner in the division to which the case is
referred should complete a copy of the report at which an
action is taken in his claim which may include any
which may be pertinent to claim formation in another
division. Where necessary for a thorough action on his
own claim, it may be necessary for him to search other
divisions, including divisions having jurisdiction of
other claims in the case. He is primarily responsible for
the correct presentation of the case.

10-4-4. Jurisdiction and Responsibility of Divisions to which Case is Forwarded

The Examiner to whom the case is forwarded,
having no jurisdiction of the claim claim -
filed in his unit, will normally retain that jurisdiction
until the claim is finally disposed of. If a request
is made for his report or record is received, he will
prepare a letter to that effect to be filed in the case and
a copy hereof to be sent to applicant along with the
communication from the Examiner having charge of the
case, and this irrespective of whether that communication
be a letter or notice of allowance.

It will also be required to refer in his own divi-
sion and any further referral, if necessary, in other
divisions.

10-4-5. Time of Initiation, in Each Division of File

Dual prosecution, when possible, is normally instituted
with the first unit. The jurisdiction remains in the
division which has jurisdiction until the case is
disposed of in that division or referred to another
division.

10-4-6. Time of Examination in Division to which Forwarded

Cases under Dual Prosecution have a "second
action" in the division to which forwarded. The order
of examination of such cases, under rule 14.1 is deter-
mined by the status in the division which has jurisdic-
tion. The division to which is referred to for
action is normally the division which has jurisdiction.
The division to which is referred to for action is the division
of that division.

10-4-7. Sequence of Examination Between Divisions

Ordinarily, the Examiner to whom the case is forwarded will search his claims, file his action, and return the file with the typed copies of the action to the Examiner having general jurisdiction before any other search is made.

Other sequences of examination and letter writing may be worked out between the Examiners to fit a particular case.

If an agreement cannot be reached, the Examiner having jurisdiction of the case must make the first search and, without necessarily writing a letter, send the references to the other Examiner who will make his search and write his action.

The Examiner having jurisdiction of the case and being primarily responsible determines the sequence of examination amongst the various other divisions to insure a proper disposal of the case.

10-4-8. Requirement of Division

As a general rule division is not required when a case is under Dual Prosecution. However, if division does develop, the Examiner having general jurisdiction, makes the requirement for division. On the other hand, when claims forwarded to another Examiner under Dual Prosecution are found to be divisible between themselves, the latter Examiner may require division between his several claims.

10-4-9. When Case Is Transferred

When all claims being acted on by the division having general jurisdiction are cancelled the case should be transferred to the other division, even though the case may be ready for allowance at that time. This is an exception to the practice outlined in section 15-2-10.

10-4-10. When Dual Prosecution is Not Proper

In many instances a single Examiner can give a complete examination of an invention on all claims (including those claims divisible in another division) and in less total examiner time than would be consumed by Dual Prosecution. Dual Prosecution is not obligatory and should be sought only where it will save total examiner time or will result in improved quality of action due to specialized knowledge. Exemplary situations are as follows:

(1) Where claims are directed to the same character of invention but differ in scope only, Dual Prosecution is never proper.

(1) Where an invention is related to a manufacturing process and a machine defined by the process of manufacture, the Examiner's jurisdiction of the process can usually give a complete, adequate examination in law and fact and there is no need for Dual Prosecution.

(2) Similarly, where the claims are related to a product and a process which involves such product but a process which is in character of a machine, the Examiner's jurisdiction of the process can usually give a complete and adequate examination.

(3) Where the claims are related to a combination distinguished solely by the characteristics of a subcombination and such subcombination per se, the examination can usually be complete and adequate by the Examiner having jurisdiction of the subcombination.

10-4-11.

Disputes

Disputes between Examiners as to classification of claims, sequence of examination, propriety of initiating Dual Prosecution, and the like should be submitted to the original Examiner of UK jurisdiction for determination.

10-4-12.

Supervision by Primary

With a view to reducing Dual Prosecution actions to only those situations where it is really needed, the Primary Examiner should carefully supervise the administration of Dual Prosecution practice in their respective divisions to limit requests or actions to those instances where total examiner time will be saved, or quality of action is improved, due to a combined knowledge of another Examiner.

10-4-13.

Change of Office Action in Response

Any division which initiates under Dual Prosecution other than the one with jurisdiction shall indicate in which division number, room number or floor number at the top of the letter form. However, no letter will be received in office, if this is the claim:

This is an action under Dual Prosecution by Division _____ of this jurisdiction in Division _____.

If an action follows one or more communications by applicant, the division to which the Examiner's action is directed shall be numbered as:

This division which has jurisdiction should head its action as follows:

This is an action by Division _____ of this jurisdiction in Division _____ of this jurisdiction under Dual Prosecution by Division _____ of this jurisdiction.

Also, the division having general jurisdiction of the application, when dating and mailing the composite action in one envelope, will give all the parts of the composite action its own division and room numbers and the same paper number. Its own action will have only the paper number, while the actions by the other divisions will have the paper number plus a letter. Thus assuming that the action had three sections and was to be assigned a paper number 7, the number 7 on the back of the file would be followed by "a" and "b", i.e.-- "7, a,b." The division mailing the composite action will also apply the appropriate paper number plus letter to the upper right hand corner of the actions by the other divisions i.e. ---"7a" and "7b".

The applicant should make only one reference to a composite action, which should be directed to the division having jurisdiction. It is permissable and helpful if applicant divides his response into sections corresponding to the composite action.

When any Examiner to whom a case has been forwarded takes an action which he considers is in condition to be made final, he shall indicate this fact by stating, "An issue has been reached as to claims 2, 3, 4, etc.," but he shall not use the word "final" in a rejection. The Examiner completing the action when the case is in condition for final rejection shall enumerate all the claims in the case, specifying those allowed and those rejected and shall state "This action is FINAL."

10-4-14.

Details of Handling

The clerical procedure for handling Dual Prosecution is fully treated in the Clerk's Manual.

When a case is sent out for Dual Prosecution a print of the drawing is ordered for the second division. Each division clerk keeps a card recording the date on the case. The Examiner in each division gets credit for each action he makes. When a case is finally the case of the first division a print in the second division is destroyed.

When a case that is sent D.P. prosecution is allowed for issue, notification of this fact will be necessary given by the division having jurisdiction of the case to the other division or divisions that are interested in the prosecution. The Examiner of each such "other" division will make notation of date of allowance on the print of his file of claims.

The first division will be notified the other division of the subsequent disposition made of the case, i.e., withdrawn from issue, patented, rejected, etc. If the other division receives no such notification within six

months from the date of filing, the Examiner will check with the Patent Division with a view to placing his files of our country prints.

18-10-11. Definition of Examination,
Section 6303

10-10-11. Definition and List

Applications filed in the Patent Office are classified according to their rights, and are taken up for examination in regular order of filing, those in the same class of invention being examined and disposed of, so far as practicable, in the order in which the respective applications have been completed.

The following cases have preference over all other cases, in every period of their examination in order enumerated:

- (1) Applications wherein the inventions are deemed of peculiar importance to our branch of the public service, or in which there are non-likelihood of some important discovery being made by the Government, or which require immediate action on the Commissioner's part; but in this case it shall be the duty of the head of that department to cause reference to be made to the Commissioner in order to prevent the invention from being a secret.
- (2) Applications for re-examination.
- (3) Applications for which a preliminary report has been made, and which are of a character of such importance in our national affairs, or which are of such a character as to require immediate action on the Commissioner's part.
- (4) Applications filed in order to interfere with the rights of others, provided that the same are filed before the expiration of the term of the patent, or before the expiration of the term of the patent, or before the expiration of the term of the patent, or before the expiration of the term of the patent.
- (5) Applications for which the Commissioner has issued a preliminary report, and which are of a character of such importance in our national affairs, or which are of such a character as to require immediate action on the Commissioner's part.

interference, if such should result, may be declared as promptly as possible.

When a proposed amendment to an application involved in interference contains claims copied from a patent which claims the Examiner does not believe to be allowable in said application, he obtains jurisdiction, enters the amendment, acts upon the claims at once and sets a time limit for response. The case is then special until this question is finally adjudicated. An exception to this procedure is made where the application at the time of forming the interference was closed to further *Ex Parte* prosecution and the disclosure of the application will, *prima facie*, not support the patent claims copied. A further exception is made where the prosecution of the application is closed before the Primary Examiner and the copied patent claims relate to an invention distinct from that claimed in the application; *Ex Parte Shohan* 1941 C.D. 1, 522 O.G. 501.

- (f) Any case that has been pending five years should be carefully studied by the Principal Examiner and every effort made to terminate its prosecution. In order to accomplish this result, the case is to be considered "special" by the Examiner.
- (g) One of the best ways to expedite our work is to take such action as will conclude the prosecution of an application as speedily as possible, for once the prosecution is closed, that case is "water over the dam."

It has been the uniform practice of this Office for years to allow an application forthwith when it is known to be in condition for issue. This is good business, and should be followed in every application where, from the record, which of course should be complete as to the applicant's reasons for allowance, or from the Examiner's knowledge of the case, he has reached the conclusion that the case should be either allowed or finally rejected. In other words, if an Examiner has a case which he is satisfied is in condition for allowance, or which he is satisfied will have to be finally rejected, he should give such action forthwith instead of making the case wait its turn.

This will not only expedite business but will avoid the necessity, at a later date, of again reviewing the case or having it studied *de novo* by a new assistant in the event that the assistant who formerly had the case has left the Office.

This practice should be followed in every case where it is possible.

- (h) Where the first action by the Examiner upon an application is limited by a requirement for division, the application will thereafter be given preference in the order of examination over other applications previously acted upon until it has received due action upon the merits, provided the applicant does prompt response to the Examiner's requirement for division.

10-5-2.

Petition to Make Special

Applications will not be advanced for examination excepting upon order of the Commissioner either to expedite the business of the Office or upon a verified showing which in the opinion of the Commissioner will justify so advancing it.

A petition to make special an original application or any other application requiring a search is sent to the examining division to which the case is assigned for report of approximate date when the case will be reached for action in its regular course. The petition is not entered in the file; but the Examiner should note on his calendar at the date reported the serial number of the application with a definite memorandum that the case will not be overlooked in the event that this report date forms a factor in the Commissioner's decision on the petition. The Examiner forwards the petition together with his report to the Law Examiner for submission to the Commissioner or the Assistant Commissioner who decides the petition to make special.

When a petition to make an application special is filed, such petition shall not be entered in the application file.

A petition to make special a division, continuation or continuation-in-part of an original application will be referred to a supplementary Examiner where the petition has not been referred to the division examining only claims which have been withdrawn in the original application. In the original application, a claim differing from such a withdrawn claim only in matters of form or by immaterial amendments, may be Examiner's claim which a report stating whether the allegation in the petition is correct and meritorious. If the claim is not meritorious over which the claims were withdrawn, unless the references have been filed in the application, if, in the opinion of the Examiner, the applicant cannot show that he can justify the special status of the claim, but is unable to

determine from inspection that the application is allowable in matters of substance or that the claims are otherwise such as would by reason of the previous prosecution be clearly subject to immediate final action he should report that fact.

All other petitions and requests to make an application special should be forwarded with the file to the Law Examiner accompanied by a report indicating when the case will be reached for action in its regular course.

(The petition to make special if, and when, granted becomes a part of the file record. Otherwise it is placed in the miscellaneous correspondence file.)

10-5-3. Prompt Attention to "Printer Writing" Cases

All "Printer Writing" applications should receive immediate attention. No such application should be kept on the desk for more than three office hours, except in cases where the rule obviously can not be applied.

The printing and delivery of a entire issue may be retarded by delay in a single instance.

10-5-4. Examiner Tenders His Resignation

Whenever an examiner tenders his resignation, the Principal should see that the assistant spends his remaining time as far as possible in winding up his old complicated cases or more with involved records and getting as many of his pending cases as possible ready for final disposition.

10-6. Suspension of Action

One suspension of action by the office for a "reasonable time," under Rule 1413 may be granted by the Examiner; but any further suspension requires the approval of the Commissioner. In no instance should such extension go beyond the statutory period dating from the last Office action. If so, the case would become abandoned. See *Ex Parte Herzog et al.*, 1905 C.D. 216, 116 O.G. 2009.

It is to be noted that suspensions under this Rule are granted with respect to impending Office actions, -not actions by applicants. That is, if the case is awaiting action by applicant he has the statutory or set shortened period within which to respond. While the shortened period may be extended within the limits of the statutory period, no suspension can operate to extend the statutory period.

Suspension under rule 14.3 which is at the instance of the applicant, is to be distinguished from suspensions originating with the examiner, or, where an applicant has two applications whose claims are directed to overlapping subject matter and one of them becomes involved in an interference, action on the other application is, under the McCormick (1904 C.D. 575) practice, sometimes suspended pending the termination of the interference. No suspension, however, is necessary where the subject matter claimed in the said "other" application is patentably distinct from the disclosure of the opposing party to the interference.

10-6-1. Overlapping Applications by Same Applicant or Owned by Same Assignee

Examiners should not consider ex parte, when raised by an applicant, questions which are pending before the Office in inter partes proceedings involving the same applicant or party of interest. (See ex parte Jones, 1924 C.D. 59; 327 O.G. 681).

Where one of several applications of the same inventor or assignee which contain overlapping claims gets into an interference it was formerly the practice to suspend action by the Office on the other applications. Now, partly in view of in re Seebach, 1937 C.D. 495; 484 O.G. 503 the prosecution of all the cases not in the interference is required to be carried as far as possible, by treating as prior art not only the counts of the interference, but also the disclosures of all the adverse parties and by rejections forcing the drawing of proper lines of division. In some instances, suspension of action by the Office can not be avoided.

10-6-2. Actions following Correspondence Under Rule 23-2

Where the junior party, as now required by Rule 23-2, states under oath a date of an act which if proven would establish that he had conceived the claimed invention prior to the filing date of the senior applicant, the law examiner then approves the examiner's proposal to suggest claims.

Where the junior party fails thus to overcome the senior party's filing date, the proposed interference is disapproved by the law examiner, in which event, the junior applicant is advised by the primary examiner, that action on his case is suspended for a period not exceeding six months, while the application of the senior party, if in allowable condition, is sent to issue.

10-7.

Atomic Energy Act

Not all new and useful inventions are patentable under the law. The invention must be within the "statutory classes". See 10-8-2. In the case of plant patents, see 18-1.

A further limitation on what can be patented is imposed by the Atomic Energy Act, Public Law 585, 590 O.G. 195:

(1) No patent shall hereafter be granted for any invention or discovery which is useful solely in the production of fissionable material or in the utilization of fissionable material or atomic energy for a military weapon. Any patent granted for any such invention or discovery is hereby revoked, and just compensation shall be made therefor.

(2) No patent hereafter granted shall confer any rights with respect to any invention or discovery to the extent that such invention or discovery is used in the production of fissionable material or in the utilization of fissionable material or atomic energy for a military weapon. Any rights conferred by any patent heretofore granted for any invention or discovery are hereby revoked to the extent that such invention or discovery is so used, and just compensation shall be made therefor. Sec. 11, (a).

Sec. 5 (a) (1) defines "fissionable material" as follows:

"As used in this act, the term 'fissionable material' means plutonium, uranium enriched in the isotope 235, any other material which the Commission determines to be capable of releasing substantial quantities of energy through nuclear chain reaction of the material, or any material artificially enriched by any of the foregoing; but does not include source materials, as defined in Section 5 (b) (1)."

See: Notice, September 9, 1946 ATOMIC ENERGY ACT OF 1946.

Rejection of Application under Public Law 585.

Whenever an application is considered by the Patent Office Atomic Energy Committee to be barred from issuance as a patent by the Atomic Energy Act, Public Law 585, 79th Congress, jurisdiction of such application will be vested in a Supervisory Examiner member

of said Committee for rejection under the Act. Jan. 31, 1947. (Order 5199).

The actual rejection is prepared and mailed in the Supervisory Examiner's Office. Such cases are listed by the Examiner in the examining division, and the list sent to the Commissioner's Office. Periodically, the applications on the list are turned over to the Patent Office Atomic Energy Committee, for consideration.

Thus an inventor in this particular field is precluded from obtaining a patent, even though he has something "new", "useful" and otherwise patentable.

10-2. Rejection of Claims

Section 4886 of the Revised Statutes (3-2)

Rule 14.6. Rejection of Claims. If the invention is not considered patentable, or not considered patentable as claimed, the claims, or any of them are rejected, the refusal of a patent or the refusal in the form requested being expressed by the rejection of claims.

Section 4886 of the Revised Statutes enumerates certain conditions to be fulfilled before the inventor may secure a patent. A shortcoming in respect to any one of them will result in a rejection.

10-8-1. Contrasted With Objection

Rule 14.6 indicates that the refusal to grant claims is called a "rejection" and this term must be used in the Examiner's letter. If the form of a claim is improper and not its substance, an "objection" is made. The practical difference between a rejection and an objection is that a rejection, being a matter of the merits may be taken to the Board of Appeals for review while an objection, if persisted in, may be taken to the Commissioner by way of petition.

Example of objection: A series of dependent claims not in immediate consecutive order. 3-9-14.

The requirements of Section 4886 that the claimed matter be "new", "useful", not in "public use for more than a year before the date of filing," etc., may be likened to a series of obstacles in a steeplechase.

The applicant must at least hurdle all of these prior to obtaining his patent.

10-8-2. Statutory Classes

The categories of "Art, machine, manufacture, composition of matter" in Section 4886 are referred to as the "Statutory Classes" of invention. See 3-4 to 3-10. Judicial decisions have determined the limits of these classes.

10-8-2.1. For example, a mere arrangement of printed matter, though seemingly a "manufacture", is rejected as not being within the statutory classes.

10-8-2.2. Similarly, a thing occurring in nature, which is substantially unaltered, is not a "manufacture". A shrimp with the head and digestive tract removed is an example.

10-8-2.3. Though seemingly within the category of an "art" or method, the law is settled that a method of doing business can be rejected as not being within the statutory classes.

10-8-2.4. A scientific principle, divorced from any tangible structure, such as the effect of ether when used in operations, can be rejected as not within the statutory classes.

10-8-3. Rejections on prior art

By far the most frequent ground of rejection is on the ground of unpatentability in view of the prior art, that is, that the claimed matter is not "new" and patentable. The reference relied upon is identified and the claim is accordingly rejected either because it is fully met therein or unpatentable thereover, if there is a difference between the requirements of the claim and the showing of this prior art.

In the event that there is no invention involved in combining several elements of two or more prior structures, the rejection is made on the combination of the several references. See 10-9-8.

10-8-4. Rejections not based on Prior Art

Although they constitute a small percentage of all rejections made, mention must be made of a number of rejections which may be appropriate despite the fact

that no pertinent prior art is discovered in the search. The examiner's function is not to scrutinize each claim with the idea of rejecting it on some far-fetched technical ground. Nevertheless, claims which are vague, functional, incomplete or unduly multiplied should be recognized as such and rejected. The rejectability of the claim may be apparent from the claim itself, may arise from its relation to other claims, or to the disclosure, or may be based upon a prior act of the inventor.

Dividing into these four categories:

<u>Claim by itself</u>	Sub Section
not in statutory class	2
Functional	5
Vague and indefinite	6
Incomplete	7
Prolix	8
Aggregative	9
 <u>Relation to other claims</u>	
Dependent directly on more than one	11
Unpatentable over other claims	12
Multiplicity	13
Disjoinder (before election)	14
 <u>Relation to disclosure</u>	
Inaccurate	15
How matter	16
Lacking utility	17
Obvious method of Making; or Using;	18
Mere function of machine	19
 <u>Prior act of inventor</u>	
Statutory bar	20
Abandonment	21
Disjoinder (after election)	22
Earlier assigned application	23
Interference or public use	24
Proceeding	24
Estoppel	25

10-8-5.

Functional

Claims which are rejected as functional are so broad in scope that it is considered to be against public policy to allow them, even though they do not read upon any prior art. A so-called "single means" claim, such as:

"In a device of the class described, means for transferring clothes-carrying rods from one position and depositing them on a suitable support."

covers every possible means for accomplishing the desired result.

Ex parte Bullock, 197 O.G. 93; 127 O.G. 1580. As is suggested in Heiderick v. Ickesson, 1924 O.D. 407; 320 O.G. 227, a claim which defines a method only by its result may be properly rejected as functional. Holland v. Perkins Glue, 1928 O.D. 266; 372 O.G. 517, applies the doctrine of functionality to product claims and holds them to be invalid if the product is defined only by its desirable properties. This rejection is not based on the prior art and is to be distinguished from a rejection as differing from the prior art only a functional statement. G.E. v. Babash, 1938 O.D. 813; 421 O.G. 468. Obviously this last-mentioned rejection requires that the Examiner find in the prior art everything called for by the claim with the exception of a functional limitation. The rejection as functional is sometimes confused with a rejection of a claim as being the mere function of the machine. See 10-8-19.

10-8-6.

Indefinite, Herzer Barkush

The rejection of a claim as indefinite would appear to present no difficulties. On occasion, however, a great deal of effort is required to explain just what is wrong with the claim when writing the Examiner's letter. Although cooperation with the attorney is to be commended, undue time should not be spent trying to figure out what the attorney was trying to say in the claim. Sometimes, a rejection as indefinite plus the statement that line 4 is meaningless is sufficient. Inclusion of a negative limitation, such as a "metal, excepting nickel", may make a claim indefinite. Expressions such as: "anhydrous", "colorless" and "non-poisonous" have been permitted

because they are definite and by far the least cumbersome way to express the limitation.

Alternative expression such as "brake or locking device" may make a claim indefinite if the limitation covers two different elements. If two equivalent parts are referred to such as "rods or wires", the alternative expression may be considered proper. Markush type claims (Ex parte Markush, 1925 C.D. 126; 340 O.G. 839), although alternative in form, may be allowed if they come within the special circumstances upon which the decision was based; namely, such a paucity of language that a term, commensurate with the chemical field which applicant is entitled to cover, does not exist. If this is not the case, the claim is rejected as containing an improper Markush grouping.

Still another way in which a claim can be indefinite is where a non-sequitur occurs. For example, a claim is inferential and therefore indefinite when it recites "said lever" and there was no earlier reference in the claim to lever. An indirect limitation also affords a ground of rejection as indefinite. If "a lever" is set forth and, later in the claim, "said non-ferrous lever" is recited, the claim is rejected as indefinite.

10-8-7.

Incomplete

A claim can be rejected as incomplete. For example, a claim to a bicycle "consisting" of a frame and a front wheel is obviously faulty. It should be kept in mind, however, that the term "comprising" is synonymous with "including" and need not be followed by a recital of all the parts of the device.

10-8-8.

Prolix

Outrageously long claims can be rejected as prolix. Ex parte Iagan 1911 C.D. 10; 162 O.G. 538 expresses the thought that very long, detailed claims set forth so many elements that invention cannot possibly reside in the combination recited.

10-8-9.

Aggregation

Rejections on the ground of aggregation should be based upon a lack of cooperation between the elements of the claim. No prior art should be

relied upon in this rejection. Many decisions and some legal writers extend the term to include old and exhausted combination (10-8-10). The last-mentioned rejections, however, involve the state of the art, and cooperation is present. Confusion as to what is meant can be avoided by treating all claims which include more than one element as combinations (patentable or unpatentable) if there is actual cooperation between the elements, and as aggregations if there is no cooperation.

Claim	Co-op.	Prior Art	Ground of Rejection	Section
A B	NO	Ignore	Aggregation	10-8-9
A B	YES	A B	No invention to combine A and B	10-8-3
A B'	Same as in	A B	Old combination, if B' has separate status	10-8-10

Example of aggregation: A washing machine combined with a dial telephone.

Example of old combination: An improved carburetor claimed in combination with a gasoline engine.

A claim is not necessarily aggregative because the various elements do not function simultaneously. A typewriter, for example, is a good combination.

10-8-10. Old Combination

The rejection on the ground of old combination (synonymous with "exhausted combination") requires the citation of a reference, but is treated here because of its relation to aggregation. The reference is cited, not to anticipate the claim, as in 10-8-3 but to anticipate the broad combination set forth in the claim. Moreover, in the reference, the cooperation between the elements must be the same as it is in the claim. Finally, the specific element, or sub-combination which is claimed must have separate status in the art.

Example: An improved (specifically recited) carburetor claimed in combination with a gasoline engine. A reference is cited which shows a carburetor combined with a gasoline engine. This shows the broad combination to be old. Both in the reference and in the claimed

combination, the cooperation between the carbureter and engine is the same. The claimed combination is an improvement over the prior art only because of the improved carbureter. The carbureter has separate status, since an entire subclass is devoted to carbureters, claimed as such.

10-8-11. Directly dependent on more than one other Claim

In the second category of rejections not based on the prior art where the relation of the claim to other claims is the basis for the rejection, is included the case of a claim directly dependent on more than one other claim.

Cases prepared abroad sometimes contain claims of this type:

Claim 6, Machine as in claims 1-5, in which, etc.

10-8-12. Double Patenting

Inasmuch as a patent is supposed to be limited to only one invention or, at most, several closely related indivisible inventions, limiting an application to a single claim, or a single claim to each of the related inventions might appear to be logical as well as convenient. However, court decisions have confirmed applicant's right to restate (i.e. by plural claiming) his invention in a reasonable number of ways. Indeed, a mere difference in scope between claims has been held to be enough.

Nevertheless, when two claims are duplicates, or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper to reject claim 2, for example, as unpatentable over allowed claim 1.

This rejection may also be given where applicant has similar claims in each of two different applications. It may then be expressed as a rejection to avoid possible double patenting. See Sec. 9. It is clearly improper to grant more than one patent to an applicant for a single invention, even though the several applications were to issue on the same day. To do so would result in double patenting. Two patents issuing on different dates would extend the monopoly for more than the statutory term of seventeen years. The rejection is also made in the case

of applications, filed by different inventors but owned by the same assignee.

In making the rejection, the other application (or patent, if it has matured into one) must be identified and the specific claim referred to therein. The fact that the subject matter now claimed was disclosed in the other case does not, by itself, justify a rejection. See 9-9.

10-8-13. Multiplicity

An unreasonable number of claims; that is, unreasonable in view of the complexity of applicant's invention and the state of the art, afford a basis for a rejection on the ground of multiplicity. The Examiner may, in his letter, indicate the number of claims which, in his opinion, would be adequate. See Rule 10.4.

10-8-14. Misjoinder

When division is required, it is advisable to reject all the claims on the ground of misjoinder. This is consistent with the philosophy of Steinmetz v. Allen, 1904 C.D. 703, 109 O.G. 549, which first held a requirement for division to be an appealable matter. Compare 10-8-22.

10-8-15, Inaccurate

The third category of rejections not based on the prior art is based upon the relation of the rejected claim to the disclosure. The clearest case is where the claim does not even read on applicant's own disclosure in which event a rejection as inaccurate or unwarranted is made. Where the individual members of a Markush group are of broad scope, each such member should ordinarily be supported by a disclosure of at least one specific example. Each member of the Markush group should be regarded as if it constituted the entire claim and requires the same support as would such claim. It must be kept in mind that an original claim is part of the disclosure and, in the case of something very simple, might adequately set forth subject matter which is completely absent from the specification. In such a case, the rejection is not given. Applicant is required to add the subject matter to the specification. If subject matter capable of illustration is claimed and it is not shown in the drawing, applicant is required to add it to the drawing.

10-8-16.

New Matter

In amended cases, subject matter not disclosed in the original application is sometimes added and a claim directed thereto. Such a claim is rejected on the ground that it is drawn to new matter. New matter includes not only the addition of wholly unsupported subject matter, but also, adding specific percentages or compounds after a broader original disclosure, or even the omission of a step from a method. Doubts as to new matter are resolved against applicant.

10-8-17.

No Utility

A rejection on the ground of lack of utility includes the more specific grounds of inoperativeness, involving perpetual motion, frivolous, fraudulent and against public policy. In connection with the last-named, see 10-8-4.

10-8-18.

Obvious Method

An applicant may invent a new and useful article of manufacture. Once the article is thought of, anyone skilled in the art would at once be aware of a method of making it. If applicant asserts both article and method claims, the article claims are allowed but the method claims are rejected as being drawn to the obvious method of making the article. Similarly, method claims to the obvious method of using a new device may be rejected.

10-8-19.

Mere Function

Judicial decisions on mere function of the machine, like those on aggregation, cannot be fitted into a single pattern. There is logic, as well as precedent, in limiting such rejections to the following cases: First, method claims only should be rejected. Compare 10-8-5. Second, applicant's disclosed machine is considered. Third, the method must be such that it cannot be carried out by hand, nor by a machine which differs materially from applicant's. The rejection, which is rarely availed of, appears to be based upon the theory that, in such cases, claims to the machine alone suffice. Of course, if applicant's machine is not new, the method claims are more readily handled by rejecting them as being unpatentable in view of the ordinary operation of the prior machine.

10-8-20.

Statutory Bar

The fourth category of rejections not based on the prior art finds a basis in some prior act of applicant, as a result of which the claim is denied him.

Section 4887 of the Revised Statutes deprives an inventor of the right to obtain a patent if, for example, he has "patented or caused to be patented" the same invention in a foreign country on an application filed more than twelve months prior to his United States filing date. If such a foreign patent is discovered by the Examiner, the rejection is made on the ground of a statutory bar. An applicant who permits his invention to go into public use in the United States more than twelve months before his filing date is similarly rejected.

10-8-21.

abandonment

An applicant who expressly abandons his invention (See 10-12) and subsequently asserts claims thereto may be rejected on the ground of abandonment or dedication.

10-8-22.

Non-Elected Group

After a requirement for division has been made and complied with, claims to the non-elected group are rejected on the ground of misjoinder. Claims to non-elected species are rejected as not readable on the elected species. Just when and in what manner applicant made the election should be pointed out. Compare 10-8-14.

10-8-23.

Assigned Application

Assignment of an application conveys title, not only to the subject matter originally claimed, but to any patentable subject matter in the case. As a consequence, if there are two applications, one assigned and one unassigned, any claim in the letter which reads upon the disclosure of the assigned application is rejected for that reason. The equities involved are brought out in Ex parte MacLaughlin 1891 C.D. 67; 55 O.G. 863 and citation of this decision in the Office letter is advisable. See 5-9.

10-8-24.

Interference

Following an interference, the losing party is informed that the claims corresponding to the counts stand finally rejected in view of the adverse termination of the interference, the latter being identified by its number. Claims which are considered unpatentable over the issue of the interference are rejected for that reason. The outcome of public use proceedings may also be the basis of a rejection. If there has been a disclaimer, a concession of priority or an abandonment of the contest, no rejection is necessary. These acts are construed as a direction to cancel the claims involved. Rule 28.2.

10-8-25.

Estoppel

The losing party to an interference may have claims in his case which could have been added to the interference by appropriate motion but which were not. This failure to act results in a rejection of such claims on the ground of estoppel. This is perhaps the simplest example of an estoppel, but the principle involved underlies all of the numerous situations in which the rejection is made: that is, an applicant is precluded or "estopped" from urging the rejected claims because of some prior action he took or failed to take. The rejections discussed in Sections 10-8-20, 10-8-21, and 10-8-23 are all based on estoppel but, in view of the application of the term "estoppel" to other branches of the law, and in equity jurisprudence, the more specific reasons for the rejections should be given in those cases.

10-8-26.

Defective Reissue Oath

A defective reissue oath affords a ground for rejecting all the claims in the reissue application.

10-8-41.

Statement of Rejection

Section 10-9 discusses the general content and arrangement of the Examiner's letter. In rejecting claims on any of the technical grounds treated above, use of the underlined words, such as indefinite, inaccurate, etc. gives applicant at once an indication of the Examiner's position, and a brief pointing out of where the indefiniteness or inaccuracy occurs enables him to fully understand the Examiner's position. Numerous citations of decisions are not required, and, should an unusually extensive philosophical

discussion be required to explain a "technical" rejection, it is doubtful that such rejection is appropriate.

If a change in the claim, which can be briefly explained to applicant, would obviate the rejection, it is best to suggest the change. "Blanket rejections" such as those in which a large number of claims are grouped together, rejected on the same grounds, and a very sketchy explanation given create an impression of slipshod work on the part of the Examiner. In the event that the stated grounds do not apply equally well to each of the claims in the group, such rejections should not be made.

10-8-42. Rejection of Previously Allowed Claim

A claim noted as allowable shall thereafter be rejected only after the proposed rejection has been submitted to the Primary Examiner or, in his absence, to the Assistant Chief, for consideration of all the facts and approval of the proposed action.

Great care should be exercised in authorizing such a rejection. (order 3157).

10-8-43. Rejection after Allowance of Application

If a reference is found for an allowed claim in an application that is in issue, or for a claim allowed by a higher tribunal, the Primary Examiner in a letter addressed to the Commissioner requests, if the case is in issue, that the application be withdrawn from issue for the purpose of applying the new reference. This letter should cite the reference, and, if need be, briefly state its application. Upon approval of this request by the Commissioner, the letter is taken to the Issue and Gazette Branch and the allowed application is stamped "Withdrawn" over the allowance signature of the Primary Examiner. It is then returned to the division from which it came; the clerk enters the withdrawal from issue on her register, and the application is thus restored to its former status as a pending application awaiting action of the Examiner. The Examiner at once writes a letter in the case citing the new reference or references against the claim or claims believed to be met thereby and rejecting such claims.

If the Examiner's proposed action is not approved, the letter requesting jurisdiction should not be placed in the file.

For rejection of claims in an allowed case which has failed to make the date of a senior application in correspondence under Rule 23.2, see Sec. 13.

10-8-44.

Rejection of Claims
Copied from patent

Where copied patent claims are, in the opinion of the Examiner, unpatentable to the applicant on any ground not also applicable to the patentee, as, insufficient disclosure or a reference whose date is junior to that of the patentee, the rejection of the claims on such ground should be made by the Examiner without referring the case to the Commissioner. But where the ground of rejection is equally applicable to the patent, permission to make such rejection must be obtained from the Commissioner.

10-8-45.

Final Rejection

Rule 15.3. Final rejection or action.

On the first or any subsequent re-examination or reconsideration, the rejection or other action may be made final, whereupon applicant's response is limited to appeal in the case of rejection of any claim (Rule 32.1), or to amendment as specified in Rule 16.2. Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim (Rule 31.1).

In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the case, clearly stating the reasons therefor.

Before final rejection is in order a clear issue should be developed between Examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in response to this action the applicant should amend with a view to avoiding the references in a patentable way while still conserving his rights to as broad protection as the state of the prior art admits. Switching from one subject matter to another

in the claims presented by applicant in successive amendments or from one set of references to another by the Examiner in rejecting in successive actions claims of substantially the same subject matter will alike defeat attaining the goal of reaching a clearly defined issue for an early termination; i.e., either an allowance of the case or a final rejection.

While Rule 15.3 no longer gives to an applicant the right to "amend as often as the Examiner presents new references or reasons for rejection", present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his invention in claims that will give him the patent protection to which he is justly entitled should receive the cooperation of the Examiner to that end, and not be prematurely cut off in the prosecution of his case. But the applicant who dallies in the prosecution of his case, resorting to technical or other obvious subterfuges in order to keep the application pending before the Primary Examiner, can no longer find a refuge in Rule 15.3 to ward off a final rejection.

However, the Examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and Examiner should be developed if possible, before appeal is prosecuted. The point emphasized is that after a properly entered final rejection is made in a case, it should definitely mean that whatever further prosecution the case may have before the Primary Examiner must be had within the ensuing six months. It is to the interest of the applicants as a class as well as to that of the public that prosecution of a case be confined to as few actions as is consistent with a thorough consideration of its merits.

Ex parte Hoogendam 1939 C.D. 3; 499 O.G. 3, states the attitude of the Office on the matter of final rejections. The position therein taken holds that neither the Statutes nor the Rules of Practice confer any right on an applicant to a more extended prosecution of his application than is comprised in an "examination" and a "re-examination" thereof. It is recognized, however, that the equities in a given case may justify a larger number of Office actions than the two specified in the Statute.

For form paragraphs to be used in final actions, see Section 10-9-14.

For amendments filed after final rejection, see Section 10-16-14.

10-8-46.

Final Rejection, when proper

Due to the change in practice as affecting final rejections, decisions that were rendered prior to the amendment of old rule 68 (new rule 15.3) on questions of prematurity of final rejection or admission of subsequent amendments do not necessarily reflect present practice. Where a claimed subject matter has been held unpatentable over a reference or combination of references, finality of rejection cannot be avoided by presenting that subject matter anew in a re-worded claim, especially if the state of prosecution of the case is beyond the second Office action; nor can final action be forestalled by adding to the claim limitations clearly disclosed in the reference patent.

It may therefore be proper to make the rejection final, even though the references are applied and combined in a manner different from that employed in the prior Office actions.

In the consideration of claims in an amended case where no attempt is made to point out the patentable novelty, the Examiner should be on guard not to allow such claims. See 10-16-2. The claims, however, may be finally rejected if, in the opinion of the Examiner, they are clearly open to rejection on grounds of record.

10-8-47. Final Rejection when proper on first action

In certain instances, the claims of a new application may be rejected on the first action. This may be done when the claims of the new application are similar to those of an earlier application filed by the same applicant, and if the claims of the earlier application were rejected on grounds which are also applicable against the claims of the new application. Such procedure is quite consistent with the provisions of rule 15.3, since the action on the claims in the new application is, in effect, a "re-examination" or a "reconsideration" of claims which had been treated previously in the earlier application.

10-8-48.

Final rejection, premature

The Examiner should guard against premature final rejections. A premature final rejection may result from failure to permit a full development of clear-cut issues, especially in cases involving complex machines or processes. Or, again, if the Examiner waits until the final rejection before giving an adequate explanation of the application of the references against the claims, such final rejection may be premature. This

would hold even if the references and reasons relied on in the final rejection are the same as those advanced in a prior Office action.

Any question as to prematurity of a final rejection should be raised, if at all, while the case is still pending before the primary examiner. This is purely a question of practice, wholly distinct from the tenability of the rejection. It may therefore not be advanced as a ground for appeal, or made the basis of complaint before the Board of Appeals.

10-8-49. Final Rejection, Withdrawal of Premature

If no request by applicant for reconsideration, the examiner finds the final rejection to have been premature, he should withdraw the final rejection.

Once a final rejection that is not premature has been entered in a case, however, it should not be withdrawn except on the showing required by Rule 16.2. This does not mean that no further amendment or argument will be considered. Any amendment that will place the case either in condition for allowance or in better form for appeal will, as a matter of course, be admitted.

10-8-50. Withdrawal of Final Rejection

The Examiner may withdraw the rejection of finally rejected claims whenever he deems the conditions appropriate for such action. If, for example, new facts or reasons are presented to convince the Examiner that the previously rejected claims are in fact allowable, then the final rejection should be withdrawn. Note: 18-8-49.

10-9 Examiner's Letter of Action

10-9 (a) Sufficiency of Disclosure Must First Be Determined

To be entitled to an examination, the specification must so describe the alleged invention "as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make, construct, compound, and use the same." (Rule 10.1). Before any search is undertaken the Examiner must have a thorough understanding of applicant's invention and he must be satisfied that the above requirements are met. If it is found that the application obviously fails to disclose an invention with the clarity required by Sec. 4888 Revised Statutes, the Examiner in his first action, should call attention to The Statute

and require that the application be properly revised. A shortened statutory period may be set for compliance with this requirement, the duration of such shortened period, if set, being determined by the Primary Examiner in accordance with the complexity of the case, the revision of the specification necessary, and the time necessary for communication with the applicant. These actions, in all cases, regardless of whether a shortened statutory period is set, should be submitted to the Supervisory Examiner for approval. It should be noted that the action outlined above should be taken as soon as possible and preferably immediately after the case reaches the division. A proposed form to carry out the above is given below:

A preliminary examination of this application discloses that it fails to comply with Sec. 4888 R. S. in that the invention is not presented with sufficient clarity to make possible an intelligent examination on the merits in a reasonable time.

FORM

In accordance with Rule 67, it is required that this application be revised to conform with the practice before this Office within the shortened statutory period hereinafter set to avoid any question of abandonment.

THE SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE _____.

If the disclosure is satisfactory it should be determined whether full action on the merits is to be given or the condition of the case is such as to necessitate a requirement of division and/or election of species. The action to be taken determines the extent of the search. If the Examiner discovers that the application belongs in another division, he should transfer the application. See 7-2.

10-9 (b).

Primary Indicates Action
For New Assistant

After the search has been completed, action is taken in the light of the references found. Where the assistant examiner has been but a short time in the Office, it is the duty of the Primary Examiner to go into the case thoroughly. The usual procedure is for the Assistant Examiner to explain the invention and discuss the references which he regards as most pertinent. The Primary Examiner may indicate the action to be taken, whether division or election of species is

to be required, or whether the claims are to be considered on their merits. If action on the merits is to be given, he will indicate how the references are to be applied, in cases where the claim is to be rejected, or authorize allowance if it is not met in the references and no further field of search is known.

Until a new assistant becomes familiar with Patent Office phraseology, his letters will generally be dictated to him by the Primary Examiner. Later, the wording of the Office action is usually left to the assistant, the character of the action being supervised by the Primary.

10-9 (c)

Sample of Conventional
"First Action" Letter

A conventional "First Action" letter is herewith presented:

21435-190

ADDRESS ONLY
THE COMMISSIONER OF PATENTS
WASHINGTON 25, D. C.

DEPARTMENT OF COMMERCE
UNITED STATES PATENT OFFICE
WASHINGTON

PAPER NO.

All communications respecting
this application should give the
serial number, date of filing,
and name of the applicant.

Please find below a communication from the EXAMINER
in charge of this application.

Lawrence S. Kingsland
Commissioner of Patents

[Redacted]

GPO 16 27315 7

Division: 47-1000-1000
Applicant: JAMES J. ROY
Ser. No. 78-307
Filed Sept. 1, 1929
For 21435-190

The following communication is from the examiner:

The following is the communication:

Copy of the communication is filed in the file of the application.
Date: Jan. 1, 1930

Reference is made to the communication of the examiner of the application.
July 1, 1929

A communication from the examiner is hereby notified of record
and a copy of the communication is filed in the file of the application.
The following communication is from the examiner of the application,
dated July 1, 1929.

The following communication is from the examiner of the application:

The following communication is from the examiner of the application:

The following communication is from the examiner of the application:

The following communication is from the examiner of the application:

EXAMINER

10-9-1.

Initial Intent

The initial intent of each letter should indicate the nature of the communication. The following has been examined. If it is the first letter, it should say, "This is in response to amendment filed on [date]" if not, it should say, "This is in response to amendment filed on [date] in case [number]."

Each letter should be clearly headed to acknowledge the filing of the amendment and filed (date) has been received. The initial sentence should state the nature of the initial sentence. It should state the date in cases in which claims in general are being amended according to the filing for amendment. The initial official action is two ways, either a withdrawal of claims originally presented and applicant's withdrawal accordingly.

In sections under "Best Presentation" the division other than the one having jurisdiction of the application should send the letter as follows:

This is an notice in re "Best Presentation" by Div. on claims General jurisdiction of this application is in Div.

The division having jurisdiction of the application should send the letter as follows:

This is an notice in re "Best Presentation" by Division (assigned Div.) which has been filed by Div. and not forth in letter (in re) General jurisdiction of this application is in Division (assigned Div.) for full description of the invention see 10-9-1.

10-9-2.

Division of Labor

The citation of the agreement and the first time in the prosecution of the case should be made.

Rule 14.7 Intent to Amend
If a notice is given to the applicant, dated, the name of the inventor, and the claims of the invention, the applicant should file a statement of intent to amend, and a copy of the amendment should be furnished to the division of labor. The applicant should be advised that the division of labor will be responsible for the prosecution of the application and that the division of labor will be responsible for the prosecution of the application and that the division of labor will be responsible for the prosecution of the application.

patent be involved, the particular pages and sheets containing the parts relied upon must be identified. If printed publications be cited, the author (if any), title, date, pages or plates, and place of publication, or place where a copy can be found, shall be given. When a rejection is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

10-9-3. Grouped at Beginning of Letter

In citing references for the first time, the identifying data of the citation should be placed immediately following the initial introductory sentence (10-9-1), or acknowledgment of preliminary amendment (if any).

10-9-4. References Applied

The references selected as needed for treating the claims should be preceded by a heading such as: "References applied".

10-9-5. References Pertinent

Any references selected to cover subject matter disclosed but not claimed should be separately listed under a heading such as "References further showing the state of the art", or some similar expression.

10-9-5.1 References Cited in Subsequent Actions

When references are cited in a subsequent action the heading should be "Additional references made of record", or "Additional references relied upon".

When an applicant in an amendatory paper refers to a reference which is subsequently relied upon by the Examiner, such reference should be cited by the Examiner in the letter in which he relies upon the reference for the first time. The citation should be in the usual manner (15-2-15).

Whenever a reference has been incorrectly cited in any official paper forming part of an application file, and such citation has been correctly given in an ensuing office action, the Examiner should correct the error, in ink, in the paper in which the error appears, and place his initials on the margin of such paper, together with a notation of the paper number of the action in which the citation has been correctly given.

In any case, otherwise ready for issue, in which the erroneous citation has not been formerly corrected in an official paper, the Examiner should correct the citation by way of an Examiner's Amendment.

10-9-6. (a) Data

The data in citing references should be fully given, as set forth in Rule 14.7. Care must be taken to cite a reissue or design patent as such, since each has its own separate series of numbers.

Official cross-references should be cited thus,
Class------(X.R.)

and unofficial cross-references thus,
Class------(u.X.R.)

Patents prior to July 4, 1836, have no official numbers. Some are numbered with an "A" following the number, but this number should not be cited. The rest of the required data must serve to identify all patents prior to July 4, 1836.

Some patents of 1861 have two numbers thereon. The larger number is the one to be cited.

From 1838 to 1861, iterative patents covering an inventor's improvements on his own device bore serial numbers independent of the current numbering of patents and were labeled A.I. (Additional improvement). Such patents should be cited as A.I., otherwise the citation is altogether misleading.

For the correct identification of British patents bearing exponential numbers, see 11-1-5

The citation of all foreign patents should include notation of the number of pages of specification and the number of sheets of drawing, and designation of the sheet or sheets which constitute the reference.

If the drawing of such foreign patent as issued comprises a single sheet, the words one sheet should be added to the identifying data.

10-9-6 (b) effective Dates of
Declassified Printed Matter

A large amount of printed matter prepared for use during the war and classified as secret, confidential, or restricted, has been declassified and is now available to the public at large. In using this material as references there are usually two pertinent dates to be considered, namely, the printing date and the publication date. The printing date in some instances will appear on the material and may be considered as that date when the material was prepared for limited distribution. The publication date is the date of release when the material was made available to the public. If the date of release does not appear on the material, this date may be determined by reference to the Office of Technical Services, Commerce Department.

In the use of any of the above noted material as an anticipatory publication, the date of release following declassification is the effective date of publication within the meaning of the statutes.

For the purpose of anticipation predicated upon prior knowledge under Section 4886 R. S. the above noted declassified material may be taken as prima facie evidence of such prior knowledge as of its printing date even though such material was classified at that time. When so used the material does not constitute a statutory bar and its printing date may be antedated by an affidavit under Rule 75.

Whenever in citing references in applications and in Form 480 the titles of periodicals are abbreviated, the abbreviations of titles used in Chemical Abstracts and printed in the List of periodicals abstracted by Chemical Abstracts should be adopted with the following exceptions: (1) the abbreviation for the *berichte der deutschen chemischen Gesellschaft* should be Ber. Deut. Chem. rather than Ber., and (2) where a country or city of origin is a necessary part of a complete identification, the country or city of origin should be added in parentheses, e.g., J. Soc. Chem. Ind. (London)

10-9-7. Citation of Decisions,
Orders and Notices

In citing published decisions the tribunal rendering the decision should be identified and wherever possible the C.D. citation should be given. Attention is also

called to Commissioner's Order 3357 relating to date citation of court decisions in appealed cases. This requirement may well be complied with in all Office actions and complete citation given whenever the decision is first referred to. (Order 1370).

It is directed that hereafter when Examiners cite manuscript decisions they shall quote the salient portions of such decisions or give the substance of them.

When a Commissioner's Order, Notice or Memorandum is cited in any official action, the date of the order, notice, or memorandum or the Official Gazette in which the same may be found should also be given.

10-9-8. Completeness and Clarity

Rule 14.5. Completeness of Examiner's action. The Examiner's action will ordinarily be complete as to all matters, but matters of form need not be raised until a claim is found allowable. In appropriate circumstances, such as misjoinder of invention, undue multiplicity of claims, fundamental defects in the application, and the like, the action of the Examiner may be limited to such matters before further action is made.

10-9-8 (a) Deferment of Action on Formal Matters

When, upon examination, the specification and claims are such that the invention may be readily understood, Examiners ordinarily should make no requirements on matters of form in the specification until some claim is found to be allowable. In every such case the first letter should say in substance:

"On allowance of any claim revision as to form may be required. (Rule 14.5)"

In every instance requirements to correct informalities noted on Form 281 (pink slip) by the Chief of the Application Division and Draftsman's criticisms of the drawings should be made in the first letter.

Every action on the merits should be complete and thorough as to merits and, whenever any claim is allowed, also complete as to form.

When an application is in condition for allowance, except as to matters of form, the case will be considered special and prompt action taken to require correction of formal matters. Such action should include a statement that prosecution on the merits is closed in accordance with the decision in ex parte Mayle, 1935 C.D. 11; 453 O.G. 213, and should conclude with the setting of a shortened statutory period for response.

10-9-8 (b) Requiring New Oath

In requiring a new oath the Examiner should always give the reason for the requirement and call attention to the fact that the application of which it is to form a part must be properly identified in the body of the new oath, preferably by giving the serial number and the date of the filing.

10-9-8 (c) Draftsman's Requirement

The Examiner should embody the Draftsman's statement with regard to the drawing in his first letter to the applicant, and in so doing he should be careful to state distinctly that a new drawing will not be admitted or that a new drawing will be required, if the case is found to contain patentable matter, in accordance with the Draftsman's directions.

When the condition of the case is such that the correction of the drawing is required, the Examiner should secure the estimate for the correction from the Draftsman and inform the applicant of the charge.

10-9-8 (d) Language to be Used in Rejecting Claims

When a claim is refused for any reason relating to the merits thereof it should be "rejected", and the ground of rejection fully and clearly stated, and the word "reject" must be used. If the claim is rejected as too broad, the reason for so holding should be given; if rejected as indefinite the Examiner should point out wherein the indefiniteness resides; or if rejected as incomplete, the element or elements lacking should be specified, or the applicant be otherwise advised as to what the claim requires to render it complete.

In general the most usual ground of rejection is based on a prior patent or patents and the rejection should generally be set forth as follows:

(1) If the claim reads element for element on the references, the claim should be rejected as

- (a) obviously fully met, or
- (b) clearly readable, or
- (c) fully anticipated, (or other equivalent expression)

on the reference.

While ordinarily additional comment is unnecessary where any of these phrasings is applicable, it may in some cases be helpful to point out one or more elements of the reference where their identity is not clear from a brief inspection of said reference.

In no instance should any of the above phrasings be used unless the claim reads as well on the patent as it does on the application.

(2) If the claim is met in substance in the reference, but has immaterial variations thereover or involves mechanical equivalents, the claim should be rejected as

- (a) substantially met by, or
- (b) lacking invention over, or
- (c) unpatentable over, or
- (d) finding its full equivalent in, (or other equivalent expression)

the reference. Such rejection should always be accompanied by a brief statement taking note of that feature or those features of the claim which are not fully met in the reference and pointing out why said feature or features do not render the claim patentable.

(3) If the claim is rejected on A in view of B, such rejection should always be accompanied by a statement that

- (a) there is no invention in substituting for the element X of A the element X as shown (or taught, or disclosed) in B; or
- (b) it would require only mechanical skill to substitute in A for his element X the equivalent element X' as shown in B.

It is not sufficient in a rejection based on A in view of B merely to state that B teaches (or shows) the element defined in the claim. This is not conclusive that

the claim should be rejected; for even if B does disclose the element as claimed, it might require invention to incorporate this element in the A organization. In some cases, in addition to the above general statement as set forth in (a) or (b), it may be advisable to point out specifically how the substitution can be made. The pertinency of each reference should be fully set forth.

Everything of a personal nature must be avoided. Whatever may be the Examiner's view as to the utter lack of patentable merit in the disclosure of the application examined, he should not cast a shadow on the patent, if granted, by expressing in the record the opinion that the application is, or appears to be, devoid of patentable subject matter. Nor should he express doubts as to the allowability of allowed claims or state that every doubt has been resolved in favor of the applicant in granting him the claims allowed.

A constructive suggestion by the Examiner as to how some specific rejection or objection may be avoided often saves considerable time and is generally welcomed by the attorney or applicant. The Examiner should reject each claim on all valid grounds rather than on that ground which he considers best at the moment.

An omnibus rejection of the claims "on the references and for the reasons of record" is stereotyped and usually not informative and should therefore be avoided. This is especially true where certain claims have been rejected on one ground and other claims on another ground.

A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group.

10-9-9.

Formal Requirements

When a claim is found allowable, or for other reasons it is deemed best to take up matters of form, the Examiner should note all of his objections, and clearly point them out. In all cases, whether or not a claim is indicated as allowable, informalities as to the drawing, oath, or signatures should be noted. See above Section as to criticism of oath and drawing.

10-9-10

Note All Outstanding Requirements

In taking up an amended case for action the Examiner should note in every letter all the requirements outstanding against the case. Every point in the prior action of an Examiner not answered by the applicant must be repeated or withdrawn to prevent the implied waiver of the objection.

10-9-11. Answer All Material Traversed

Where requirements are traversed, or suspension thereof requested, the Examiner should make proper reference thereto in his action on the amendment.

Where the applicant traverses any rejection, the Examiner should, if he repeats the rejection, take note of the applicant's argument and answer every material point therein.

If a rejection of record is to be applied to a new or amended claim, specific identification of that ground of rejection, as by citation of the paragraph in the former Office letter in which the rejection was originally stated should be given.

10-9-12. Piecemeal Prosecution

In general, piecemeal actions should be avoided when a technical rejection is made, by treating the claim also, whenever possible, on the basis of prior art.

10-9-13. Notify of Inaccuracies in Amendment

Where the directions for the entry of an amendment are defective, as, inaccuracy in the line designated, or lack of precision where the word to which the amendment is directed occurs more than once in the specified line, and it is clear from the context what is the correct place of entry, the amendatory paper will be properly amended in the examining division, and notation thereof initialed by the Examiner will be made on the margin of the amendatory paper. In the next Office action the applicant should be duly informed of this alteration in his amendatory paper and the entry of the amendment as thus amended; as he will also be informed of the non-entry of an amendment where defective directions and context leave doubt as to the intent of applicant.

10-9-14. Each Claim to be Mentioned in Each Letter

In every letter each claim should be mentioned by number, and its treatment or status given. Since a claim retains its original numeral throughout the prosecution of the case, its history through successive actions is thus easily traceable.

Also where claims for non-elected divisible subject matter are retained under Rules 11.2 and 11.7, their presence in the case should be noted in each succeeding Office letter. Each action should conclude with a summary of rejected, allowed and canceled claims and claims retained under Rule 11.2.

10-9-15. State When Claims are Allowable
except as to Form

When the Examiner finds that a claim is allowable except as to form, this fact should be stated.

10-9-15.1 Specific Actions

Specific actions such as requirement of division, election of species, D.P. prosecution, Examiner's Statement, etc., are treated separately under the corresponding topic. As to requirement of division and election of species see Section 9; D. P. prosecution 10-4, and Examiner's Statement 14-1-14.

10-9-15.1 (a) It should be noted however that in an Office action in which election of species is required the following concluding paragraph is recommended:

FORM

Since there is no allowable generic claim present, election of one species is required. Applicant is advised that his response to be complete must include an election of species or a statement that in his opinion all claims are in fact readable on a designated species which must be identified. Such statement will be construed as an election.

10-9-15.1 (b) The following statement should be added at the end of all regular Office actions when it appears that the next action taken by the Examiner may be final:

FORM

This application should be prepared for final action. No further amendments that do not place the case in condition for allowance or better form for appeal will be entered after final action unless accompanied by a proper showing of good and sufficient reasons why they were not earlier presented. Rule 16.2.

10-9-15.1 (c) Attention is particularly called to the requirement (rule 15.3) that in the letter making a rejection final "the Examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the case, clearly stating the reasons therefor". The letter should conclude with the following statement:

No further amendments that do not place this application in condition for allowance or better form for appeal will be entered unless accompanied by a proper showing of good and sufficient reasons why they were not earlier presented.
rule 16.2.

To insure against applicant's failure to note that the rejection as stated in the body of the letter was made final, it is advisable for the Examiner to conclude such letter with the paragraph, "The above rejection is made FINAL," or "This action is FINAL."

It is also suggested that at the top of such letter, or as the last line of such letter the words FINAL REJECTION be placed in capital letters.

In D.P. prosecution, when the Examiner to whom a case has been forwarded takes an action which he considers is in condition to be made final, he should indicate this fact by stating, "An issue has been reached as to claims 2, 3, 4, etc." but he shall not use the word "final" in a rejection. The Examiner completing the action when the case is in condition for a final rejection shall enumerate all the claims in the case, specifying those allowed and those rejected and shall state "This action is FINAL."

10-9-16. Numbering Paragraphs

Paragraphs may be successively numbered on each page of the letter to facilitate identification in the future prosecution of the case.

10-9-17. Office Letters to have One Inch Margin,
Left Side of Page

All communications sent from this Office will provide for ample margin (at least one inch), on the left side of the page. Rule 10.9 requires from applicants that "a wide margin must always be reserved upon the left hand side of the page." The reason for this rule is also applicable to communications originating in the Office.

10-9-18.

Typing of Letter

The typist copies the Examiner's letter on Form FOL 90 inserting in the proper place the address of applicant, or of his attorney, and the necessary identification data of the application.

10-9-19.

Review by Assistant Examiner

A carbon copy of the letter is also made. Both copies, together with the rough draft, if there be one, and the file are then put on the Assistant Examiner's desk, who will compare the copy with the rough draft, paying particular attention to the data of the references. If any corrections are to be made, he will note them in lead pencil and return the papers to the typist for correction. When the corrections have been properly made, or when there are no corrections required, the Assistant Examiner will initial the original copy and place the file with the several copies of the letter on the desk of the Primary Examiner for his inspection and signature to the original copy. Carbon copies should not be signed by the Assistant or Primary.

In each Examiner's letter, the word "Examiner", without the number of the division should appear at the end on both the original and carbon copy, the original only, as heretofore, being signed. The words "Acting Examiner" should be used whenever that official signs the letter.

10-9-20.

Entry

After the original copy has been signed by the Primary Examiner, the typist places it in the file wrapper on the right hand side, and enters in black on the outside of the wrapper, under "Contents," the character of the action. If any claim has been rejected, the word "Rejection" is entered on the file, or if the rejection has taken the form of a requirement for division, the entry will so indicate; otherwise, the word "Letter" is used. Errors will be avoided if the Assistant Examiner enters the character of the action on the file in lead pencil before giving the file to the typist.

The papers are numbered consecutively, the application being No. 1, the print of the drawing, if there is one, being No. 2, and the next paper, usually the first Office letter, being No. 3, etc.

The file is next given to the clerk, who enters the character of the action, and the date thereof, in the "Register of Pending Applications," after which the file is returned to the file case along with other applications awaiting action by the applicants. Such applications are arranged in the file case in the numerical order of their serial numbers, so that they may be readily available.

10-9-21. Date

Since the six months statutory period begins to run from the date of mailing of the Examiner's action, the date should not be typed when the letter is written, but should be stamped on both copies of the letter after it has been signed by the Examiner and the carbon copy is about to be mailed.

10-9-22. Mailing

The typist mails the carbon copy to the proper address. As to details of the actual mailing attention is called to 7-4.

10-9-23 Number of Copies Mailed

Ordinarily one copy (carbon) of the letter is mailed to the applicant. However, two carbon copies are mailed to the Alien Property Custodian and, this is also the practice followed with applications handled by the U.S. Army and Navy.

10-9-24. Returned Office Action

For treatment of returned letters, see 7-4-3.

10-10. Examiner's Amendment

10-10 (a) Amendments that May be Made by Examiner

Except by formal amendment duly signed or as hereinafter provided, no corrections, erasures, or interlineations be made in the body of written portions of the specification or any other paper filed in the application for patent.

Correction of the following obvious errors only may be made with pen by the Examiner of the case who will then initial the sheet margin and assume full responsibility for the change:

1. Misspelled words.
2. Disagreement of a noun with its verb.
3. Inconsistent "case" of a pronoun.
4. Disagreement between a reference character as used in the description and on the drawing. The character may be corrected in the description but only when the examiner is certain of the propriety of the change.

Other obvious informalities in the application may be corrected by the Examiner, but such corrections must be in the form of an amendment, approved and signed by the Principal Examiner, placed in the file, and made a part of the record. A copy of the amendment is sent to the applicant. The changes specified in the amendment are entered by the clerk in the regular way (Order 4009).

where an application is ready for issue except for a slight defect in the drawing not involving change in structure, the Examiner will note in pencil on the drawing the addition or alteration to be made. He will also prepare an Examiner's Amendment indicating the changes made and send the drawing to the Draftsman for the required correction.

The following corrections are illustrative of those that may be made:

1. Adding two or three reference characters or exponents.
2. Changing one or two numerals or figure ordinals.
3. removing superfluous matter, e.g., figure and ordinal where all but one figure have been canceled.
4. Adding or reversing directional arrows.
5. Changing Roman numerals to Arabic numerals to agree with specification.
6. Adding section lines, or brackets, where easily executed.
7. Making simple changes in inventor's name (not his signature).
8. Changing lead lines.
9. Correcting misspelled legends.

It is directed that no other changes be made by any person in any record of this office without the written approval of the Commissioner of Patents.

In reading the application over all errors should be carefully noted. It is not a matter of importance whether the language is the best that could be chosen, it is, however, essential that it

be clear in meaning, and free from errors in syntax.

In the printing of the specification and claims of applications, the punctuation as made by the applicant must be strictly followed and not departed from.

However, in revising the application, and in subsequent revision and proof reading in the Issue and Gazette Division and in the Printing Office, minor informalities and obvious errors are sometimes found which require correction. Such correction is made by Examiner's Amendment, and a copy is sent to the applicant. Where the correction is made in an application already in the printer's hands, a copy may be sent to the applicant, if the changes made are of sufficient importance.

10-10 (b) Title of Invention

Where the title of the invention is not specific to the invention as claimed, the Examiner may change the title by Examiner's Amendment on or after allowance. See Sec. 15-2-1.

10-10 (c) Cancellation of Non-Statutory Claim

When a case is otherwise in condition for allowance the Examiner may cancel an obviously non-statutory claim. Applicant should be notified of the cancellation of the claim by an Examiner's Amendment.

10-10 (d) Data of Copending Application Referred to Should be Brought Up To Date

Where a copending application is referred to in the specification the Examiner should ascertain whether said copending application has matured into a patent or has become abandoned and if so, insert by Examiner's Amendment the number and date of the patent or the fact that the case has become abandoned.

This procedure is also followed when an application is referred to the Examiner by the Issue and Gazette Branch in which application there appears a reference to another application by serial number without any statement as to whether the application referred to is patented or abandoned. If it is determined by the Examiner that such case is patented or abandoned he will indicate this fact in the specification by appropriate Examiner's Amendment.

10-10 (e) Numbering of Claims Used
In Examiner's Amendment

In entering an Examiner's Amendment in a claim, the original number, as well as the number of the claim in the patent, should be referred to.

10-11. Period for Response

See also 14-1-5, 14-3, 14-4-1.1 and 14-4-2.1.

10-11-1. Statutory

Rule 19.1. Abandonment for Failure to Respond in Time Limit. If an applicant neglects to prosecute his application for six months or such shorter time as may be fixed (Rule 19.2) after the date when the last official notice of any action by the Office was mailed to him, the application will become abandoned.

The portion of Rule 19.1 quoted above sets forth the provisions of Sec. 4894 Rev. St. with reference to the prosecution of an application by an applicant. The normal statutory period for response to an Office action is six months.

10-11-2. How Computed

The period is computed from the day of the mailing of the Office action to the date of receipt by the Office of applicant's response. No cognizance is taken of fractions of a day and applicant's action is due on the corresponding day six months after the Office action.

Response to an Office action dated on August 30 is due on the following February 28 (or 29 if it is a leap year) and, likewise, a response to an Office action dated on February 28 is due on August 28 and not on the last day of August.

10-11-3. Shortened Statutory Period
and Time Limit Actions

Time Less Than Six Months

Rule 19.2 (Sec. 4894 Rev. St.) provides that applicant need not necessarily always have six months within which to respond to an Office action. He may be required to respond in a shorter period, not less

than 30 days, whenever it is deemed "necessary or expedient." Some conditions deemed "necessary or expedient" are listed in Section 10-11-5.

In setting a shortened statutory time for response to an Office action, the date on which the shortened period ends must be specified thus:

FORM A SHORTENED STATUTORY PERIOD FOR RE-
 SPONSE TO THIS ACTION IS SET TO EXPIRE
 (Date).

(This should be in capital letters)

In addition to the statutory provisions of shortened periods for response the Examiner may also, in some cases, require the applicant to make response within a specified limited time. These are known as time limit actions.

Where an Office action is such as to require the setting of a time limit for response thereto, the Examiner should note at the end of the letter the date when the time limit period ends. The time limit requirement should also be typed in capital letters.

Furthermore, the legend "SHORTENED TIME FOR REPLY" is placed on the first page of every action in which a shortened time for reply has been set, and is applied on the first page of the action in one or more places, and preferably across the date stamp just under the date, so prominently that a person looking merely for the mailing date of the action and not reading the action as a whole cannot reasonably avoid seeing the legend.

10-11-4. Approval of Time Set

Before being mailed, a letter setting a shortened statutory period for response must be approved by the Commissioner, but this approval is obtained from the Supervisory Examiner, to whom the Commissioner has delegated this authority.

10-11-5. Situations in Which Used:

10-11-6. Shortened Statutory Period

From time to time the Commissioner through the Supervisory Examiners adds to or removes from the list of types of actions calling for a shortened statutory period. In general where the prosecution has obviously

been dilatory, or where the circumstances are such that the public interest requires the prosecution to be promptly closed, a shortened statutory period may be set.

Some specific cases are:

a) When an application is in condition for allowance, except as to matters of form, such as correction of drawings or specification, a new oath, etc., the case will be considered special and prompt action taken to require correction of formal matters. Such action should include a statement that prosecution on the merits is closed in accordance with the decision in ex parte Mayle, 1935 C.D. 11; 453 O.G. 213, and should conclude with the setting of a shortened statutory period for response.

b) When a prompt issue as a patent is desired to avoid futile interference proceedings, as where the junior party fails to overcome the senior party's filing date under Rule 232.

c) Where, after the termination of an interference proceeding, the application of the winning party contains an unanswered office action, final rejection or any other action, the Primary Examiner notifies the applicant of this fact. In this case response to the Office action is required within a shortened statutory period (40 days) running from the date of such notice. See Ex parte Peterson, 525 O.G. 3, 1941 C.D. 8.

d) When a case has been pending for five years, in order to expedite termination of the prosecution. This also applies to any case which by relation to a prior application has an effective filing date of more than five years.

Whenever the Primary Examiner finds that a newly filed application obviously fails to disclose an invention with the clarity required by Sec. 4888 R.S., or whenever his attention is directed to such an application, he should call attention to Rule 14.5 (second sentence) and require in the first Office action, which should be taken immediately, that the application be revised to conform with the practice prevailing before this Office. A shortened statutory period may be set for compliance with this requirement, the duration of such shortened period, if set, being determined by the Primary Examiner in accordance with the complexity of

the case, the revision of the specification necessary, and the time necessary for communication with the applicant. These actions, regardless whether a shortened statutory period be set or not, should be submitted to the Supervisory Director for approval.

10-11-7. Shortened Non-Statutory Time-Limit

Under certain conditions it is deemed more desirable to set non-statutory shortened time-limits for response, such as:

a) Rule 23.3 provides that in suggesting claims for interference:

The parties to whom the claims are suggested will be required to make these claims (i.e., present the suggested claims in their applications by amendment) within a specified time, not less than 20 days.

b) Rule 23.6 provides:

Where claims are copied from a patent and the Examiner is of the opinion that none of the claims can be made, he should state in his action why the applicant can not make the claims and set a time limit, not less than twenty days, for reply, and similarly if, after response by the applicant, the rejection is made final, a similar time limit should be set for appeal.

c) When applicant's action is not fully responsive to the Office action, the Examiner may give applicant a limited time, usually 20 days to complete his response. See last paragraph of rule 19.1 which reads as follows:

When action by the applicant is a bona fide attempt to advance the case to final action, and is substantially a complete response to the Examiner's action, but consideration of new matter or compliance with some requirement has been inadvertently omitted, opportunity to explain and supply the omission may be given before the question of abandonment is considered.

10-11-8. Difference Between Shortened Statutory and Time-Limit Periods

The distinction between a limited time for reply and a shortened statutory period under Rule 19.2 should not be lost sight of. The first is set by the primary Examiner, while the second requires the approval of the Commissioner. The penalty attaching to failure to

reply within the time limit is less of the subject matter involved on the doctrine of disclaimer, and is, therefore, appealable matter; while failure to respond within the set statutory period is not appealable but petitionable only and may result in abandonment of the entire application. Further, where applicant responds a day or two after the time limit, this may be excused by the Examiner if satisfactorily explained; but a response one day late carrying a shortened statutory period under the Rule 19.2, no matter what the excuse, results in abandonment; however, if asked for in advance extension of the period may be granted by the Examiner, provided, the extension does not go beyond the six months' period of the Office action.

10-11-0.

extension of Time

Rule 19.2...... The time for reply, when a time less than six months has been set, will be extended only for good and sufficient cause, and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the applicant is due, but in no case will the mere filing of the request effect any extension. In case involving a shortened statutory period for response only one extension may be granted by the Primary Examiner in his discretion; any further extension must be approved by the Commissioner. In no case can any extension be granted which will carry the date on which response to an action is due beyond six months from the date of the action.

It should be very carefully noted that neither the Primary Examiner nor the Commissioner has authority to extend the shortened statutory period unless request for the extension is filed on or before the day on which applicant's action is due. While the shortened period may be extended within the limits of the statutory six months period, no extension can operate to extend the time beyond the time. Ex parte Barzoz et al 1905 C.D. 216; 116 C.G. 2009.

In this relation attention is called to Rule 14.3.

Rule 14.3. Suspension of Action.

Suspension of action by the Office will be granted at the request of the applicant for good and sufficient cause and for a reasonable time specified. Only one suspension may be granted by the Primary Examiner; any further suspension must be approved by the Commissioner.

If action on an application is suspended when not requested by the applicant, the applicant shall be notified of the reasons therefor.

It is to be noted that suspensions under this Rule are granted with respect to impending Office actions, -- not actions by applicants. That is, if the case is awaiting action by applicant he has the statutory or set shortened period within which to respond. While as explained before, the shortened period may be extended within the limits of the statutory period, no suspension can operate to extend the statutory period.

10-11-10.

Three Year Period,
Government Owned Cases

Three Year Statutory Period

A government-owned case is under Sec. 4894, R.S., entitled to a three year period for response to an Office action, provided there has been filed in the application a request to that effect by the head of the department concerned. Such request holds for only one three year period in such case, but it holds for that entire period irrespective of the number of actions that may be taken either by the Office or by the applicant during the period. However, the status of the application as coming within the three year provision of the statute may be continued for another three year period by a request from the department head for reapplication of the statute. A letter from the head of the department requesting such reapplication of the statute must be reasonably filed.

Where an application is placed under the three year statutory provision, it is required that the Office notify the head of the department within 90 days and not less than 30 days before the expiration of the three year period of the approaching end of said period.

10-11-11.

Two Periods Running

There sometimes arises a situation where two different periods for response are running against an application, the one limited by the regular statutory period, the other by the limited period set in a subsequent Office action. The running of the first period is not suspended nor affected by an ex parte limited time action or even by an appeal therefrom.

10-11-12.

Copying Patent Claims

Where in an application in which there is an unanswered rejection of record, claims are copied from a patent and all these claims are rejected (Rule 23.6; Sec. 10-11-7), there results a situation where two different periods for response are running against the application. One period, the first, is the regular statutory period of the unanswered rejection of record, the other period is the limited period set for response to the rejection (either first or final) established under Rules 23.3 and 23.6. The date of the last unanswered office action on the claims other than the copied patent claims is the controlling date of the statutory period (Ex parte Milton, 164 Ms 1, 63 USPQ 132 and Ex parte Nelson, 164 Ms 361, 26 J.I. O.S. 564).

10-11-13.

Factors Affecting Or
Determining Dates

10-11-14.

Date of Receipt of
Applicant's Action

When a paper reaches the Office it is stamped as of that day and this stamp date is the controlling date, not the stamped date applied in the examining division.

10-11-15.

Period Ending on Sunday or Holiday

Rule 1.8. Times for Taking Action
Expiring on Sunday or Holiday. When the day, or the last day, fixed by statute or by or under these rules for taking any action or paying any fee falls on Sunday, or on a holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding day which is not a Sunday or a holiday.

Note: The holidays in the District of Columbia are: New Year's Day, January 1; Washington's Birthday, February 22; Memorial Day, May 30; Independence Day, July 4; Labor Day (first Monday in September); Armistice Day, November 11; Thanksgiving Day (fourth Thursday in November); Christmas Day, December 25; Inauguration Day (January 20, every four years).

An amendment received on such succeeding secular or business day which was due on the Sunday or holiday is endorsed with both dates. The period allowed by statute is six calendar months.

10-11-16.

Miscellaneous Factors
Determining Date

When applicant writes the Office pointing out an incorrect citation of a reference, the period of six months running against the application begins anew on the date of the Office responds giving the correct citation.

Remailing

Where for any reason it becomes necessary to re-mail any action, (7-4-3) the action should be correspondingly redated, as it is the re-mailing date that establishes the beginning of the six months' period. (Ex parte Courtoff, 1924 C.D. 151, 329 O.G. 536).

Supplemental Action

A supplementary action after a rejection explaining the references more explicitly or giving the reasons more fully, even though no further references are cited, establishes a new date from which the statutory period runs.

Defective Office Action

If for any other reason an Office action is defective in some matter necessary for a proper response applicant's time to respond begins with the date of correction of such defect.

10-11-17.

Actions on Appeals

Appeal to the Board must be made within 6 months from the final Office action.

10-11-18.

Board's Decisions

The six months' time allowed for amendment after decision on appeal where the Board has given new reasons for rejection dates from the date of the Board's decision. (See ex parte King, 1928 C.D. 1; 366 O.G. 3.)

A decision by the Board of Appeals which is in any way adverse to the appellant is an "action" in the case marking the beginning a new statutory period.

A complete reversal of the Examiner's rejection brings the case up for action by the Examiner; whereas, if the Examiner was sustained either in whole or in part, the next action must be taken by the applicant, either by way of further appeal or suit in equity or by cancellation of the rejected claims if there be an allowed claim in the case.

Where the Board of Appeals rejects claims on new grounds applicant has six months from the date of the Board's decision to respond to the rejection in that decision.

10-11-19.

Dismissal

Where the appeal is withdrawn or dismissed, see 14-3.

10-11-20.

Citing New Reference in
Examiner's Statement, "Mevey"

If the Examiner in his statement or in a supplemental statement cites a new reference as a basis of rejection, thus bringing the case within the doctrine of Ex parte Mevey, 1891 C.D. 115, 56 O.G. 805, a new date for the statutory period running against the application is thereby established. New Rule 32.4 sets forth this practice.

10-11-21.

Court Decisions

See 14-4-1.1 and 14-4-2.1.

10-11-22.

Actions in Interferences

10-11-23.

Preliminary

a) Correspondence under Rule 23 is not an action on the case and, hence, cannot serve to extend the statutory period if the case is awaiting action

by the applicant.

b) Claims suggested under Rule 23.3 must be made before the date set or the delay must be satisfactorily explained.

c) Response to the rejection of all claims copied from a patent must be made within limited time (either as a request for reconsideration or an appeal from the rejection).

10-11-24.

Decision by Board of
Interference Examiners

The date when the decision of the Board of Interference Examiners becomes final does not mark the beginning of the statutory period for response to any unanswered action by the Office.

10-11-25.

Termination of Interference

Upon termination of interference, appropriate action in each case should be promptly taken by the Examiner. For details see Sec. 13-7.

If the losing party's case was under final rejection or ready for issue when the interference was formed, his right to reopen the prosecution is restricted as explained in Sec. 13.

For shortened statutory periods in actions following termination of interference, see 10-11-6 (c).

10-11-26.

Petitions

A petition filed near the end of the statutory period, even if not reached for decision during that period, does not operate to extend the period. However, if the petition is granted, the case is not abandoned, provided otherwise full response to the last Office action had been made within the statutory six months. For example, if the petition is to vacate a final rejection as premature, and within the statutory period there is filed an amendment traversing the rejection, or amending the finally rejected claims, supported by argument, but yet not rendering the claims patentable in the opinion of the Examiner, then the granting of the petition even at a date outside the six months' period saves the case from a holding of abandonment; while if the petition is denied, the case is abandoned, since under the decision applicant had not made a proper response to the final rejection within the statutory period.

10-12.

Abandonment, Forfeiture

Time for Response by Applicant,
Abandonment of Application

Rule 19.1. Abandonment for Failure to Respond in Time Limit. If an applicant neglects to prosecute his application for six months or such shorter time as may be fixed (Rule 19.2) after the date when the last official notice of any action by the Office was mailed to him, the application will become abandoned.

Prosecution of an application to save it from abandonment must include such complete and proper action as the condition of the case may require. The admission of an amendment not responsive to the last official action, or refusal to admit the same, and any proceedings relative thereto, shall not operate to save the application from abandonment.

When action by the applicant is a bona fide attempt to advance the case to final action, and is substantially a complete response to the Examiner's action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, opportunity to explain and supply the omission may be given before the question of abandonment is considered.

Rule 19.4. Express Abandonment. An application may be expressly abandoned by filing in the Patent Office a written declaration of abandonment, signed by the applicant himself and the assignee of record, if any, and identifying the application.

Abandonment may be either of the invention or of an application. An invention is abandoned when the inventor dedicates it to the public. Dedication may take different forms.

This discussion is primarily concerned with abandonment of the application for patent. See 4-2-4.

An abandoned application is one which is removed from the Office docket of pending cases through

1. formal abandonment by the applicant (acquiesced in by the assignee if there be one)

or through

2. failure of applicant to take appropriate action within a specified time at some stage in the prosecution of the case.

Applications expressly abandoned (Rule 19.4) present no particular problem. It should be borne in mind, however, that formal abandonment must have the signature of the assignee, if any, as well as of the inventor. For this reason, an amendment signed by the attorney in which all the claims are cancelled and none substituted is not entered since such action would amount to an abandonment of the application.

Rule 34.6. Forfeited Application.

A forfeited application is one upon which a patent has been withheld for failure to pay the final fee within the prescribed time. (See rule 34.4)

A forfeited application is not considered as pending, and, if the final fee is not subsequently paid and accepted as provided in rule 34.7, the application is abandoned, as of the date it became forfeited.

It is seen that a forfeited application is one which had the status of an allowed case for six months and on which the final fee was not paid. (Rule 34.6) Its legal status during the year dating from its forfeiture makes possible its being issued as a patent on petition to the Commissioner, the petition being supported by a verified statement and accompanied by the final fee and the petition fee (\$10). (Rule 34.7)

When the six months' period within which the final fee might have been paid has expired, the file is returned by the Issue and Gazette Division to the examining division. The clerk of the examining division takes out the drawing, stamps it "Forfeited," stamps the file likewise, makes the proper entry in the register, and forwards the file and drawing to the proper section of the Record and Attorneys' Room which is under the supervision of the Librarian. The application is recorded as forfeited and filed away in the abandoned files section. If not patented within eighteen months after the date of allowance, the forfeited case becomes abandoned; and such abandoned application cannot be revived. In this respect an abandoned application that has passed through the twelve months period of forfeiture differs in status from an application that has become abandoned under the provisions of

Rules 19.1 and 19.2 and can be revived under the provisions of Rule 19.3. See also Rule 14.8.

10-12 (a) Abandoned and Forfeited Applications
Not Cited.

Abandoned and forfeited applications will not be cited as references.

10-12-1. Abandonment by Non-Statutory Disclaimer
(For Statutory Disclaimer, See 16-3)

Abandonment of invention may be brought about by what is often referred to as a disclaimer. This results when an applicant by an act of his loses his right to patent protection. Some examples among others are:

a) Failure of applicant to make claims suggested by the Patent Office under Rule 23.3;

If claims are suggested in an application near the end of the statutory period running against the case, and the time limit for making the claims extends beyond the end of the period, such claims will be admitted if filed within the time limit even though outside the six months' period and even though no amendment was made responsive to the Office action outstanding against the case at the time of suggesting the claims. However, if the suggested claims are not thus made within the specified time, the case becomes abandoned in the absence of a responsive amendment filed within the six months' period. (Ex parte Kohn, 1932 C.D. 9; 421 O.G. 853.)

b) Disclaimer filed under Rule 28.2.

c) A statement of record in the file that a given part of the disclosure is old in the art.

It should be noted here that when a sole application is substituted for a joint application, or the joint application amended to a sole application, a proper disclaimer by the surrendering joint applicant and oath by sole inventor should be filed. In re Roberts, 1920 C.D. 158; 273 O.G. 410.

10-12-2. Failure to Take Required Action
During Time Period

Rule 19.1 specifies that an application becomes abandoned if applicant "neglects to prosecute" his application within the fixed statutory period. This neglect may result either from

1. entire failure to respond, or
2. insufficiency of response, i.e., failure to take "complete and proper action as the condition of the case may require."
(Rule 19.1)

Abandonment by entire failure to respond presents no problems.

Nor is there any particular difficulty when an amendment reaches the Office (not the division) after the expiration of the statutory period. The case is abandoned and the remedy is to revive it.

10-12-2 (a) Disposal of Amendment Filed After Case is Abandoned

When an application is not prosecuted within six months from the date of the last Office action therein and thereafter an amendment is filed, such amendment shall be endorsed on the file wrapper of the application, but not formally entered and the Examiner shall immediately notify the applicant that the amendment was not filed within the statutory period and therefore cannot be entered.

10-12-2 (b) Special Cases Involving Abandonment

Difficulty may arise when there is disagreement as to the date from which the statutory period begins to run. Some examples are:

a) Copying claims from a patent when not suggested by the Patent Office does not constitute a response to the last Office action and will not save the case from abandonment, unless the last Office action relied solely on the patent for the rejection of all the claims rejected in that action.

b) A case may become abandoned through withdrawal of appeal to the Board of Appeals, no properly responsive amendment having been seasonably filed (Ex parte Coverstone, 1929 C.D. 16; 381 O.G. 483).

c) Likewise it may become abandoned through dismissal of appeal to C. C. P. A. or suit in equity, where there was not filed prior to such dismissal or within six months from the Board's decision an amendment putting the case in condition for issue or fully responsive to the Board's decision.

d) Also, abandonment may result from failure to issue within the twelve months' period of forfeiture.

e) Where applicant withdraws his appeal and subsequently files an amendment more than six months from the final rejection; or if it be an ex parte Mevey (1891 C.D. 115; 56 O.G. 805) situation and the amendment is submitted more than six months after the Examiner's Statement (Ex parte Coverstone 1929 C.D. 16; 381 O.G. 483, the case is abandoned, and this irrespective of the nature of the proffered amendment.

To pass on questions of abandonment of the above character, it is essential that the Examiner know the dates that determine the beginning of the statutory period under varying situations. The ex parte prosecution before the Examiner presents few departures from the ordinary type in which the applicant's response must reach the Office within six months from the mailing date of the Office letter, or not later than the date set as ending the shortened period for reply. The date determination is treated above in Sec. 10-11-13.

Insufficiency of Response

A frequent case of abandonment is where a response is made by the applicant within the statutory time but, in the opinion of the Examiner, is not fully responsive to the Office action.

10-12-3. Reconsideration of Holding of: Revival

When advised of the abandonment of his application applicant may wither ask for reconsideration of such holding, if he disagrees with it; or petition for revival, if he acquiesces with the holding.

10-12-4. Holding Based on Insufficiency of Response

Applicant may deny that his response was incomplete.

While the Examiner has no authority to act upon an application in which no action was taken during the statutory or shortened period, he may reverse his judgment as to whether or not an amendment received during such period was responsive and act on a case of such character which he has previously held abandoned. This is not a revival of an abandoned application but merely a holding that the case was never abandoned.

Where the bona fide response to the Examiner's action is filed before the expiration of the six months allowed by law (or set shortened period), but through an apparent oversight or inadvertence some point necessary to a complete response has been omitted, --such as an amendment or argument as to one or two of several claims involved or signature to the amendment, --the Examiner, so soon as he notes the omission, should require the applicant to complete his response within a specified time limit (as 20 days), if the period has already expired or not sufficient time is left to take action before the expiration of the period. If this be done the application should not be held abandoned even if the six months (or set shortened period) has then expired. See Rule 19.1.

If there is sufficient time left for completion of the response, applicant is notified in what respect his response is insufficient and the time within which it must be made fully responsive.

10-12-5.

Holding based on failure to
Respond within period

When an amendment reaches the Patent Office (not the division) after the expiration of the statutory period and there is no dispute as to the dates involved, no question of reconsideration is presented.

However, the Examiner and the applicant may disagree as to the date from which the statutory period commenced to run. In this situation, as in the situation involving sufficiency of response, the applicant may take issue with the Examiner and point out to him that his holding was erroneous.

In some instances drawings accompanying new applications are of such quality that they may not be admitted for examination because of defective execution or other reason but nevertheless are acceptable for purposes of securing a filing date. The Chief Draftsman in such cases marks the drawings "ad. for filing date only." When drawings so marked are received by the Primary Examiner he will immediately write a letter in the case notifying applicant that the drawings have been admitted for the purpose of giving the application a filing date but that within ninety days he must file formal drawings meeting the requirements of Rule 12.4 and conforming with the drawings on file. The letter should additionally state that failure to furnish such drawings within the time

stated will be taken as sufficient basis for holding the application abandoned. This letter of the Primary Examiner will not be counted as an action and the file should be appropriately marked as a new case and placed with the new cases awaiting action. If formal drawings are not filed within the ninety-day period, an action should be taken holding the case abandoned. The ninety-day period may be extended by the Primary Examiner upon request.

10-12-6.

Petitions Relating to Abandonment

Rule 19.3. Revival of abandoned application. An application abandoned for failure to prosecute may be revived as a pending application if it is shown to the satisfaction of the Commissioner that the delay was unavoidable. A petition to revive an abandoned application must be accompanied by a verified showing of the causes of the delay, by the proposed response unless the same has been previously filed, and by the petition fee.

Rule 31.1 (Reproduced and discussed in 12 and the Sections thereunder), is of general nature and provides remedy from the action of the Examiner in holding a case abandoned for insufficient response or as being too late and with which holding the applicant disagrees.

Determination of these petitions may be delegated by the Commissioner to the Supervisory Examiners or to the Solicitor or Law Examiners, but any such action may be reviewed by the Commissioner.

A petition to revive an abandoned application should not be confused with a petition from an Examiner's holding of abandonment. As stated above abandonment may result not only from insufficiency of response but also from entire failure to respond, within the statutory period following an Office action.

Where the holding of abandonment is predicated on the insufficiency of the response, or disagreement as to controlling dates the petition from such holding comes under Rule 31.1 and does not require a fee.

The mere filing of a petition will not stay the period for replying to an Examiner's action which may be running against the application nor act as a stay of other proceedings. A petition filed near the

end of the statutory period, even if not reached for decision during that period, does not operate to extend the period. However, if the petition is granted, the case is not abandoned, provided otherwise full response to the last Office action had been made within the statutory six months. For example, if the petition is to vacate a final rejection as premature, and within the statutory period there is filed an amendment traversing the rejection, or amending the finally rejected claims, supported by argument, but yet not rendering the claims patentable in the opinion of the examiner, then the granting of the petition even at a date outside the six months' period saves the case from a holding or abandonment; while if the petition is denied, the case is abandoned, since under the decision applicant had not made a proper response to the final rejection within the statutory period.

Where the applicant acquiesces in the holding or abandonment, or where the petition from such holding is denied, applicant's only recourse, so far as concerns the particular case involved, is by petition to revive. Such petition must be accompanied by a fee of \$10.00, a proposed amendment to the preceding Office action, if no such amendment had been previously filed, and a verified satisfactory showing that the delay in prosecution was unavoidable. Rule 19.3

10-12-7. Examiner's Statement on Petition

On Petition to set aside Examiner's Holding

Rule 31.1 states that the Examiner "may be directed by the Commissioner to furnish a written statement within a specified time setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner". Often, however, the Supervisory Examiner passes upon the question without requesting such statement from the examiners, if the issue raised is clear from the record.

On Petition to Revive

In answering a petition to revive an abandoned application the Examiner should state the date when the application became abandoned, whether the amendment, if any, is responsive and if not, in what respect it is defective, and whether it puts the application in condition for allowance. If no amendment is filed or if the petition is not verified the answer should so state.

Attention should be directed to the history of the case, so far as pertinent to the question of revival, but no recommendation should be made. A copy of the answer should be sent the petitioner.

10-12-8. Disposal of Abandoned Files

Rule 3.4.
Abandoned applications may be destroyed after twenty years from their filing date, except those to which particular attention has been called and which have been marked for preservation. Abandoned applications will not be returned.

10-12-9. Pulling, Counting, Listing

At the expiration of each quarter an examination is made of the files in each division to list which applications have become abandoned during such quarter.

Similarly at the end of each quarter when the forfeited cases are returned to the division by the Issue Division for entering the notation "Forfeited" on the register opposite the entry of each case, a list should be prepared of these cases, arranged according to serial numbers and forwarded to the Application Division for entry on the records there. This list should give the name of the inventor opposite the serial number. See Clerk's Manual for details.

10-12-10. Destruction of Abandoned Files

See 10-12-8.

10-12-11. Ordering Abandoned Files

Abandoned files may be obtained from the Abandoned Files Section by filling out form 602 with the necessary data and leaving these forms with the clerk in charge. The name of the Examiner ordering the file should appear on the form. The file should be promptly returned when the Examiner has finished with it.

10-12-12. Where Office Action is Returned as Undeliverable.

See Sec. 7-4-3.

An application in which an Office letter was returned by the Post Office and in which the Office was

unsuccessful in remailing such letter, is filed away (together with the returned envelopes) and eventually sent to the Abandoned Files storage room. See 7-4-3.

10-12-12 (a) Letter of Abandonment Received
After Application is Allowed

A letter of abandonment received after an application is allowed is answered by the Issue and Gazette Branch, the letter being signed by the Executive Officer.

Swearing Back of Reference
Affidavit under Rule 18.1

Rule 18.1 Affidavit of prior invention to overcome cited patent or publication. When an application is rejected on reference to a domestic patent which substantially shows or describes but does not claim the rejected invention, or on reference to a foreign patent or to a printed publication, and the applicant shall make oath to facts showing a completion of the invention in this country before the filing date of the application on which the domestic patent issued, or before the date of the foreign patent, or before the date of the printed publication, and shall also make oath that he has never abandoned the invention, then the patent or publication cited shall not bar the grant of a patent to the applicant, unless the date of such patent or printed publication be more than one year prior to the date on which the application was filed in this country.

The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception prior to the effective date of the reference coupled with due diligence to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photographic or photostatic copies thereof, must accompany and form part of the affidavit or their absence satisfactorily explained, and proof may be required.

Any printed publication dated prior to an applicant's effective filing date, or any patent of prior filing date, that is in its disclosure pertinent to the claimed invention, is available for use by the examiner as a reference, either basic or auxiliary, in the rejection of the claims of the application.

Such a reference may be overcome, in certain instances noted below, by applicant's filing of an affidavit under Rule 18.1 known as "swearing back" of the reference.

Affidavits under Rule 18.1 apply:

- (A) Where reference date is less than one year prior to applicant's filing date.

- (B) Where reference shows but does not claim the invention.
- (C) Where patent is to another inventor, despite common assignment of patent and application rejected. In re Beck, 1946 C.D. 398; 590 O.G. 357.
- (D) In connection with the use of "copending patents" as references, it is to be noted that it is proper to use such a patent either as a basic or an auxiliary reference, or both the basic and auxiliary references may be "copending patents". Minn. Mining & Mfg. Co. v. Coe, 1938 C.D. 100; 497 O.G. 766.
- (E) After appeal to the Board of Appeals, but is not admissible unless accompanied by an acceptable affidavit under Rule 16.2 explaining the delay in filing the Rule 18.1 affidavit. Ex parte Bowyer 1939 C.D. 5; 505 O.G. 759. See also 14-1-11.

Affidavit under Rule 18.1 not proper:

- A. Where reference date is more than one year back of applicant's filing date. "Statutory Bar", Sec. 4886, R.3.
- B. Where the reference patent claims the invention, Rule 23.1 Interference.
- C. Where reference is a foreign patent to applicant or his legal representatives issued on an application filed more than twelve months prior to the filing date of the domestic application.
- D. Where the effective filing date of applicant's parent application or an International Convention proved filing date is prior to the effective date of the reference.
- E. Where the reference is a prior U.S. Patent to the same party, claiming the same invention, the question involved is one of "double patenting"

10-13a. Reference Patent Entitled
 To Foreign Filing Date

In overcoming, under Rule 18.1, a domestic patent where the patentee has an earlier foreign filing date to which he would be entitled in establishing priority to the invention claimed in the patent, it is NOT necessary for the applicant to carry his date back of the patentee's FOREIGN filing date. (Commissioner's decision in Inter-

ference No. 68,916, involving Viviani application, now patent 2,022,260, 161 Va. 173.)

Should it be established that the portion of the patent disclosure relied on as the reference was introduced into the patent application by amendment and as such was new matter, the date to be overcome by the affidavit is the date of the amendment. In re William et al, 1935 C.D. 229; 454 O.G. 535.

10-13b. General Rule (Genus and Species)

In mechanical cases, where a patent contains generic claims and discloses but does not claim a species, an applicant, by affidavit under Rule 18.1 may antedate patent by showing the reduction to practice of a single species prior to the effective date of the patent.

10-13c. Exceptions and Practice
Relative to Chemical Cases

A patent showing a species was used against an application having generic claims. The affidavit showed a reduction to practice of a different species. It was held that this affidavit did not overcome the reference. A second affidavit showed a reduction to practice, of the same species as the patent, prior to the effective date of the patent and said second affidavit was held to overcome the reference. Ex parte Fryling, 1947 C.D. 5; 604 O.G. 5.

"The principle is well established in chemical cases, and in cases involving compositions of matter, that the disclosure of a species in a cited reference is sufficient to prevent a later applicant from obtaining generic claims, although the disclosure in an application of a species may not be sufficient basis for a generic claim." In re Steenbock, 1936 C.D. 594; 473 O.G. 495.

A further case along this line is In re Kyrides, 1947 C.D. 254; 600 O.G. 501, wherein Kyrides had previously been in interference with Anderson. Anderson was the senior party and both parties had generic disclosures. Kyrides was awarded priority by the court as to the generic claims on the basis that he had an earlier co-pending application which disclosed a single species. The interference having terminated and ex parte prosecution resumed the examiner rejected the generic claims in Kyrides' application on the Anderson application on the ground that while the court had awarded Kyrides priority in the generic invention it did not necessarily follow that Kyrides was entitled to the allowance of claims for such generic invention. The court upheld the examiner,

stating:

"We have heretofore stated that the awarding of priority to an applicant in an interference proceeding does not insure or even suggest, that he is necessarily entitled to his claim in a patent."

Kyrides by affidavit under former Rule 75 attempted to overcome the Anderson application by Kyrides earlier application. The affidavit was held to establish no more than that one species had been reduced to practice as of that date. A showing of one species alone by either a Rule 18.1 affidavit or an earlier application lacking a generic disclosure does not overcome an intervening reference whose effective date is prior to the filing date of the application in which the generic claim is asserted.

The quantum of showing in an affidavit under Rule 18.1 necessary to overcome a rejection of generic chemical claims on disclosed but unclaimed species varies with the circumstances.

In accordance with the trend of present practice, it cannot now be stated that any arbitrary number of species will be regarded as sufficient in all cases, but the showing in the particular case should be representative at least of the class covered by the rejected generic claim.

"Markush" Type Genus Claim:

Where a claim reciting a Markush group is rejected on a reference disclosing but not claiming a specific member of the group, the reference cannot be avoided by an affidavit under Rule 18.1 showing a different member of the group.

The affidavit must actually show the species of the reference or at least a species which would be clearly suggestive thereof. In re Faase et al., 1944 C.D. 271; 563 O.G. 582 did not involve an affidavit under Rule 18.1 but appears to support this doctrine.

10-13-1.

Who May Make Affidavit

- A. The Inventor (applicant).
- B. One of two joint inventors is accepted where suitable excuse is given for failure of the other applicant to sign. Carlson et al, 1936 C.D. 95; 462 O.G. 479.

- C. The Assignee or other party in interest when it is not possible to produce the affidavit of the inventor. Ex parte Foster, 1903 C.D. 213; 195 O.G. 261.

10-13-2. Patent Claiming Same Invention

When the reference in question is a patent whose issue date is less than one year prior to the filing date of the application being examined, applicant's remedy, if any, must be by way of Rule 25.4 instead of Rule 18.1. The Examiner should therefore take note whether the status of the patent as a reference is that of a PATENT or a PUBLICATION. If the patent is claiming the same invention as the application, this fact should be noted in the Office letter together with citation of one or more of the patent claims in support of this holding. The reference patent can then be overcome only by way of interference.

10-13-2a. Affidavit Under Rule 18.1 Must Be Removed Before Interference

Where an application in which an affidavit under Rule 18.1 has been filed is to be involved in an interference, the affidavit must be sealed in an envelope properly labeled before forwarding the application to the interference division.

The same practice obtains with respect to a Rule 18.1 affidavit in the file of an application made the subject of a motion under Rule 25.4 or 25.5.

Under the practice established in Ferris v. Tuttle, 1940 C.D. 5, 521 O.G. 523, the Rule 18.1 affidavit is thrown open to the opposing party or parties to the interference at the time the preliminary statements are opened.

10-13-3. Facts And Documentary Evidence

The essential thing to be shown under Rule 18.1 is priority of invention and this may be done by any satisfactory evidence of the fact.

Where the applicant acknowledges in his oath a FIRST filed foreign application less than twelve months prior to his U.S. filing date, and antedating

the reference, such foreign application will void the reference if a certified copy of the foreign application is filed, together with a sworn translation, if the copy be not in English. Ex parte Mattlet, 1926 C.D. 62; 347 O.G. 1047.

FACTS, not conclusions:

- (A) As shown in attached sketches.
- (B) As shown in attached blueprints.
- (C) As indicated by accompanying model.
- (D) As shown in attached photographs.
- (E) If verbal disclosures were made instead of the above, supporting statements by the witness will be acceptable.
- (F) If the dates of the exhibits have been removed or blacked off, the matter of dates can be taken care of in the body of the oath.

The dates in the oath may be the actual dates or, if the applicant does not desire to disclose his actual dates, he may merely allege that the date referred to occurred prior to the effective date of the reference.

A general allegation that the invention was completed prior to applicant's filing date is not sufficient. Ex parte Saunders, 1883 C.D. 23; 23 O.G. 1224. It must include:

"If the applicant made sketches he should so state, and produce and describe them; if the sketches were made and lost, and their contents remembered, they should be reproduced and furnished in place of the originals. The same course should be pursued if the disclosure was by means of models. If neither sketches nor models are relied upon, but it is claimed that verbal disclosures, sufficiently clear to indicate definite conception of the invention, were made the witness should state as nearly as possible the language used in imparting knowledge of the invention to others." Ex parte Geneva, 1890 C.D. 109; 52 O.G. 300.

The affidavit must state "I" and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention **IN THIS COUNTRY**, the conception at least being at a date prior to the filing date of the patent. Where there has not been reduction to practice in this country prior to the date of the reference, the applicant must show diligence in the completion of his invention from time just prior to that date continuously up to the date of filing,

which constitutes a constructive reduction to practice. In this connection, note the following:

"A conception of an invention, evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor and has no effect on a subsequently granted patent to another, UNLESS HE FOLLOWS UP WITH REASONABLE DILIGENCE BY SOME OTHER ACT, such as an actual reduction to practice or filing an application for a patent." Automatic Weighing Mach. Co. v. Pneumatic Scales Corp., Limited. 1909 C.D. 498; 139 O.G. 991.

Where conception occurs prior to the date of the reference, but reduction to practice is afterward it is not enough merely to allege that applicant had been diligent. Ex parte Hunter, 1880 C.D. 218; 49 O.G. 733.

The facts to be established under Rule 18.1 are similar to those to be proved in interference. Under Rule 18.1 applicant may show conception in this country prior to the date of the reference, coupled with diligence up to the time of reduction to practice, which may be actual or constructive.

Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In Mergenthaler v. Scudder, 1897 C.D. 724 81 O.G. 1417 it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also.

10-13-3a.

Diligence

What is meant by diligence is brought out in Christie v. Seybold, 1895 C.D. 515 64 O.G. 1650. In patent law, an inventor is either diligent at a given time or he is not diligent; there are no degrees of diligence. A man may be diligent within the meaning of the patent law when he is doing nothing, if his lack of activity is excused.

10-13-b.

Reduction to Practice

Reduction to practice is defined in Corona v. Davan, 1928 C.D. 254, 370 O.G. 1011 wherein the making of a brief examination of test slabs of rubber constituted a valid reduction to practice of an invention even though a commercial form of the invention had not been made nor tested. A test is unnecessary if the device be so simple that making it suffices to show that it would work.

Mason v. Hepburn, 1898 C.D. 510; 84 O.G. 147. If various related chemicals are tried out in sequence, their chemical behavior may be so predictable that compounding a substance may be a valid reduction to practice without a test, but if such prediction is not obvious, the date of testing is the date of actual reduction to practice.

10-13-3c. Interference Statements and Testimony Sometimes Used

A preliminary statement in interference may be accepted in some cases as equivalent to an affidavit.

In place of an affidavit the testimony of the applicant in an interference may be used to antedate a reference.

The part of the testimony to form the basis of priority over the reference should be pointed out. Ex parte Bowyer, 1930 C.D. 5; 505 O.G. 759.

10-13-d. Acts Relied Upon Must Have Been Carried Out in This Country

The affidavit must contain an allegation that the acts relied upon to establish the date prior to the reference were carried out in this country. See Public Law 506, Section 9.

10-13-4. Exhibits May Be Submitted In The Form Of:

- A. Sketches
- B. Blueprints
- C. Models
- D. Photographs
- E. Statements of witness

Note: Dates on the exhibits may be blocked out if taken care of in the body of the oath.

Exhibits filed as part of an affidavit under Rule 18.1 that are too bulky to be placed in the application file are retained in the Examining Division until the case is finally disposed of. When the case goes to issue (or abandonment) the exhibits are sent to the Model Room, notation to this effect being made on the margin of the affidavit.

10-13-5 Passed Upon By Primary Examiner

The question of sufficiency of affidavits under Rule

18.1 should be reviewed and decided by the Examiner in charge of the division. (Order 8712)

10-14. Affidavits Traversing or Supporting References

Rule 18.2

Note (10 - 8 - 11)

New Rule 18.2 affidavits traversing grounds of rejection.

When an application is rejected on reference to a domestic patent which substantially shows or describes but does not claim the invention, or on reference to a foreign patent, or to a printed publication, or to facts within the personal knowledge of an employee of the Office, or when rejected upon a mode or capability of operation attributed to a reference, or because the alleged invention is held to be inoperative or lacking in utility, or frivolous or injurious to public health or morals, affidavits traversing these references or objections may be received.

Applicants sometimes during the prosecution of their applications file affidavits attempting to overcome rejections. Such affidavits should be directed to an issue raised in the case, *ex parte Robinson*, 1905 O.D. 123; 115 O.G. 1584, and should recite facts instead of conclusions and opinions, *ex parte Korunder*, 1910 O.D. 121; 157 O.G. 200.

Affidavits swearing back of a reference have been treated under 10-13.

Rule 18.2 enumerates various grounds of rejection where affidavits seeking to remove these respective grounds may be received.

As to *ex parte* cases in which the operability of a patent is attacked, the principle is followed:

A patent has the benefit of presumptive validity; and one who will attack its operableness, according *ex parte* numerous precedents, burden of proof. For this reason, and also since the Office has no laboratory means of checking the tests made by applicant, and since the patentee has no opportunity to defend the operableness of his claimed invention, the affidavit should not be given the usual status of an affidavit in its binding effect as to factual statements therein made, but should be accorded merely the status of an expression of opinion of an expert in the art. With its status thus construed,

the affidavit will be admitted and considered by the Examiner.

Affidavits relating to the following subject matter have sometimes been given weight.

The statements and conclusions set forth in affidavits, however, have no binding effect upon the consideration of an application by the Examiner.

10-15.

Interviews

10-15-1. General Policy, Now Conducted

The personal appearance of an applicant or his agent before the Examiner, presenting matters for his consideration is considered an interview. In its more limited sense, however, an interview generally relates to a consideration by the Examiner and the attorney or applicant of an issue existing in a pending application.

The conditions under which interviews with the Examiner (i.e., the primary Examiner or, in his absence, the Assistant Primary Examiner) may be had is governed by Rule 10.5 the first paragraph of which states:

"Interviews with Examiners concerning applications and other matters pending before the Office must be had in the Examiners' rooms at such times, within office hours, as the respective Examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Commissioner. Interviews for the discussion of the patentability of pending applications will not be had prior to the first official action thereon. Interviews should be arranged for in advance."

The Primary Examiner ordinarily conducts the interview, with the Examiner in charge of the application usually present. However, the Primary Examiner may, in his discretion, authorize the Examiner in charge of the application to do so. Applicants and attorneys should not interview other Examiners except by express permission of the Primary Examiner.

An interview should normally be arranged for in advance, as by letter, telegram or phone call, in order to insure that the Primary Examiner and/or the Examiner in charge of the application will be present in the Office. The unexpected appearance of an attorney or applicant requesting an interview without any previous notice to the Examiner may well justify his refusal of the interview at that time, this particularly in an involved case. The right to an interview lies wholly within the discretion of the Primary Examiner.

An interview should be had only when the nature of the application admits of such and solely to develop and clarify specific issues and to reach a mutual

understanding between the Examiner and the applicant, and, if the application is not under final rejection, to close the prosecution thereof. Thus the attorney when presenting himself for an interview should be fully prepared to discuss the issues raised in the Office action. When it is obvious that the attorney is not so prepared or does not understand the issues involved an interview should not be permitted.

The Examiner should not hesitate to state, if such be the case, that claims presented for consideration at the interview require further search and study and that the status of the application does not warrant an interview at this time. Nor should the Examiner hesitate to conclude an interview when it appears that no common ground has been reached, it being apparent that the application requires further amendment or an additional action by the Examiner.

In no case should an interview be allowed to become protracted with the expenditure of an unreasonable amount of the Examiner's time. It is the duty of the Primary Examiner to see that an interview is not extended beyond a reasonable period even when he does not personally participate in the interview. Matters irrelevant to the subject matter should not be discussed.

Where there is an attorney of record in the application, an interview with the applicant alone, with or without previous notice, should normally be refused where it is apparent that the applicant is not familiar with patent practice and where his presence indicates only a desire to explain his invention or its commercial possibilities, or to argue that the rejection is not proper, or references are not pertinent. In this respect attention is directed to the proviso in Rule 1.6 that the "Office cannot act as expounder of the patent law, nor as counsellor for individuals."

During an interview in which the applicant is prosecuting his own case and is not familiar with Office procedure the Examiner may make suggestions that will advance the prosecution of the case; this lies wholly within his discretion. Too much time, however, should not be allowed for such interviews.

10-15-1a.

No Interview Permitted
Prior to First Official Action

No interview is permitted on an application prior to the first official action thereon. And it obviously follows that no interview can be held in advance of the filing of an application. In this regard it is the practice of many attorneys, searchers and inventors to consult the Examiner as to the field of search or whether

he knows of any art, domestic or foreign, not covered by a search already made. Ordinary courtesy to those doing business with the Office has countenanced this practice. However, the Examiner when confronted by such a request may in his discretion comply with such request, but in no case should he permit a detailed explanation of the invention with attendant discussion thereof as to the field of search, detailing the expenditure of an unreasonable amount of time. Here again attention is directed to the above mentioned proviso of Rule 120 that the "Office cannot act as an expounder of the patent law, nor as counsellor for individuals." Nor should the Examiner permit searching in the division without the consent of the Primary Examiner.

10-15-1b. Interview for "Sounding Out"
Examiner Not Permitted

Interviews that are solely for the purpose of "sounding out" the Examiner as by a local attorney acting for an out of town attorney should not be permitted when it is apparent that any agreement that would be reached is conditional on being satisfactory to the principal attorney. Such practice nullifies the real purpose of interviews and is a waste of the Examiner's time in the event the agreement is not satisfactory.

10-15-1c. Substance of Interview
Must be Made of Record

The substance of an interview must always be made of record in the application, particularly where agreement between attorney and the Examiner is made. Rule 18.3 specifically requires that:

"In every instance where reconsideration is requested in view of an interview with an Examiner, a complete written statement of the reasons presented at the interview warranting favorable action must be filed."

An interview does not remove the necessity for response to Office actions.

After an interview the case may be considered "Special" at the discretion of the Primary Examiner.

10-15-1d. No Interview with Disbarred Attorney

Patent office employees are forbidden to hold either oral or written communication with a disbarred attorney.

regarding an application unless it be one in which said attorney is the applicant. Power to inspect given a disbarred attorney will not be accepted by the Examiner.

10-15-1e.

No Inter parte questions
Discussed Ex Parte

After an interference is declared the Examiner may not discuss inter parte questions ex parte with any of the interested parties. See 1-8-1.

10-15-2

Exposure of other Cases

Prior to an interview the Examiner should arrange his desk such that files, drawings and other papers are placed out of view except those necessary in the interview. See 2-1.

10-15-3

Demonstration, Exhibits, Models

The invention in question may be exhibited or demonstrated during the interview by a model thereof which may be sent to the Office prior to the interview where it is received in the model room and forwarded to the division. A model is not to be received by the Examiner directly from the applicant or his attorney.

All models received in this Office, whether forming part of an application, or filed upon request from the Examiner, must be received from the model room and not from the applicant or his agent. It is necessary that all models should be taken to the Model Room for proper recording in order that they may be located under subsequent inquiry and for final disposition. The Examiners should, therefore, refuse to accept models from inventors or attorneys. Models properly received and entered upon the books of the Model Clerk will be delivered by a representative of the Property Clerk's Office.

Oftentimes a model or exhibit is not given into the custody of the Office but is brought directly into the division by the attorney solely for inspection or demonstration during the course of the interview. This is permissible. Demonstrations or apparatus or exhibits too large to be brought into the Office may be viewed by the Examiner outside of the Office, (in Washington) with the approval of the Primary Examiner. It is presumed that the witnessing of a demonstration or the viewing of an exhibit is actually essential in the developing and clarifying of the issues involved in the application.

10-15-4

Finally Rejected Applications

If the case is under final rejection, the Examiner may give an interview even though no proposed amendment has been filed. The grace extended an applicant after final rejection will be determined in part by the length of prosecution prior to final rejection, and the possible patentable subject matter in the case. Interviews on finally rejected cases can be justified only on the ground that the applicant was not fully understood the position of the Examiner or that the Examiner had not fully appreciated the limitations in the claims over the prior art, or that the Examiner may be able to offer some constructive aid in accepting finally rejected claims or in formulating a new claim which would distinguish over the prior art where the case contains patentable subject matter not fully protected by any allowed claims.

10-15-5

Interview preceding Filing Amendment,
Rule 4.2

After a case is close to issue, it is technically no longer under the jurisdiction of the Primary Examiner, Rule 4.2. An interview with an Examiner that would involve a detailed consideration of claims sought to be entered and perhaps submitting a discussion of the prior art for determining whether or not the claims are allowable should not be given. Obviously an applicant is not entitled to a greater degree of consideration in an amendment presented informally than is given an applicant in the consideration of an amendment when formally presented, particularly since consideration of an amendment filed under Rule 4.2 cannot be demanded as a matter of right. However, it is entirely proper should the Examiner be confronted with a request to state whether a claim or a proposed amendment under Rule 4.2 is allowable, to peruse the same and inform the attorney either, (1) that the claim is patentable or (2) that it is not obvious that the proposed claim is patentable. A suggestion by the Examiner of an amendment that would render the claim allowable is always in order.

10-16-1.

Must be Fully Resolved

References to requirements to divide are treated in Sec 9.

Rule 15.3. Reply by Applicant. After the Office action, if adverse in any respect, the applicant, in his correspondence in his application for a patent, must reply in writing and may request re-examination or reconsideration, with or without amendment.

An applicant is entitled to re-examination or reconsideration. The applicant must make request therefor in writing, and must distinctly and specifically point out the supposed errors in the examiner's action; the applicant must respond to every ground of objection and rejection of the prior Office action (except that request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until a claim is allowed), and the applicant's action must appear throughout to be a bona fide attempt to advance the case to final action. The mere allegation that the examiner has erred will not be received as a proper reason for such re-examination or reconsideration.

In amending an application in response to a rejection, the applicant must clearly point out all the patentable novelty which he thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He must also show how the amendments avoid such references or objections.

A response in regard to the correction of formal matters may be deferred by applicant until a claim is indicated to be allowable or appeal is taken.

Formal matters generally include drawing corrections, correction of the specification and the presentation of a new oath. However, the line between formal matters and substance is not clear, and the determination of the merits of a case may sometimes require that drawing corrections, corrections of the specifications and the presentation of a new oath be insisted on.

Rule 16.5 . . . "In presenting new or amended claims, the applicant must point out how they avoid any reference or ground of rejection of record which may be pertinent, and in adding claims which increase the total number in the case the applicant should and may be required to show how they substantially differ from each other and from the other claims."

The prompt development of a clear issue for final rejection or definite reasons for allowance of the claims requires that the responses of the applicant be intelligent and meet the objections and rejections of the examiner.

Amendments Not Fully Responsive
Action to be Taken

If there is sufficient time remaining in the six months Statutory period or set shortened period when applicant's amendment is found to be not fully responsive to the last Office action, a letter should at once be sent applicant pointing out wherein his amendment fails to fully respond, coupled with a warning that the response must be completed within the time period in order to avoid abandonment. See 10-12-2.

Where a bona fide response to an examiner's action is filed before the expiration of the permissible period, but through an apparent oversight or inadvertence some point necessary to a complete response has been omitted, -- such as an amendment or argument as to one or two of several claims involved or signature to the amendment, -- the examiner, as soon as he notes the omission, should require the applicant to complete his response within a specified time limit (usually 20 days). If this is done the application should not be held abandoned even though the prescribed period has expired.

Rule 15.1 requires that the applicant's action "must appear throughout to be a bona fide attempt to advance the case to final action." Thus, in deciding the question whether a slightly defective amendment is such as saves the case from abandonment, the good faith of the applicant in making the response must be considered. The examiner tests out this good faith by setting a time limit for supplying the inadvertently omitted matter. Whether the applicant does or does not supply such missing matter within the time limit will enable the examiner

the better to judge the good faith of the applicant as to his intent to have made a fully responsive action.

The examiner must exercise discretion in applying this practice to safeguard against abuses thereof.

The practice outlined above does not apply where there has been a deliberate omission of some necessary part of a complete response. For example, if an election of species has been required and applicant does not make election because he holds the requirement to be wrong, the amendment on its face is not a "bona fide attempt to advance the case by final action" (Rule 15.11), and the examiner is without authority to postpone decision as to abandonment (10-13).

If there be ample time for applicant's reply to be filed within the time period, no reference is made to the time limit other than to note in the letter that the response must be completed within the statutory period dating from the last Office action.

10-16-2. Claims Presented in Amendment with no Attempt to Point Out Patentable Novelty

In the consideration of claims in an amended case where no attempt is made to point out the patentable novelty, the claims should not be allowed.

See ex parte Peterson, 1928 C.D. 31, 376 O.G. 3, sustaining the holding of abandonment for a nonresponsive amendment, wherein it was held that Order 2801 was intended merely to emphasize the necessity of enforcement of old Rule 68 as to the presentation of proper arguments, reasons or showing as to patentability.

10-16-3 to 8. Examiner should immediately inspect

Actions by applicants, especially those filed near the end of the statutory period, should be inspected immediately upon filing to determine whether they are completely responsive to the preceding Office action so as to prevent abandonment of the application. If found inadequate, and sufficient time remains, applicant should be notified of the deficiencies and warned to complete the response within the statutory period. (Order No. 2215 $\frac{1}{2}$).

All amended cases when put on the examiner's desk should be inspected by him at once to determine:

If the amendment is properly signed.
If the amendment has been filed within the statutory period, set shortened period or time limit.
If the amendment is fully responsive
If the changes made by the amendment warrant transfer.
If the case is special.
If claims are copied for interference and to ascertain the probability of an interference with any pending application.

10-16-3. Immediate Inspection of Amendment for Signature

The amendment must be inspected to determine if it is signed by the inventor or someone who has power to sign for the inventor. See 10-2 Signatures to Actions and Responses.

10-16-4. Immediate Inspection of Amendment to Determine if Within Time Period for Response

The amendment must be inspected, as to its date of filing in the Office and as to the previous Office action to see if a shortened period had been set, an extension granted, or the six months statutory period applies, to determine if the amendment has been filed within the period for response. See 10-12-2.

10-16-5. Immediate Inspection of Amendment to Determine if Fully Responsive

The amendment together with the last Office action should be inspected immediately to determine if the amendment is completely responsive.

10-16-6. Immediate Inspection of Amendment to Determine if Changes Made Warrant Transfer

Applications should be inspected to determine if the cancellation of claims in the case or amendments made in the claims change the classification of the case to another division. Cases in which division is required or which are under Dual Prosecution should be especially noted as the classification of such cases is frequently changed by an amendment and the transfer of the case should not be delayed.

10-16-7. Immediate Inspection of Amendment to Determine if It is Special

Amendments and the Office actions should be inspected to determine if the case should be acted on out of its regular turn. See 10-5 for Definition and List of Special Cases.

10-16-8. Immediate Inspection of Amendment to Determine if Claims Are Copied for Interference

Amendments should be inspected to determine if claims are presented that are copied from a patent for interference. An amendment merely presenting unsuggested claims from a patent asking for an interference does not stay the running of the statutory period dating from an unanswered Office action. See Sec. 13.

10-16-9. Amendments Sent to Wrong Division

See 7-1-14.

10-16-10. Amendments Not in Permanent Ink

If an amendment in other than permanent ink is filed, it is entered, but a permanent copy is required to be filed. A good carbon copy is acceptable.

10-16-11. Telegraphic Amendment

When a telegram amendment is received it is placed in the file, but not entered. If ratification of this amendment does not follow in due time, the applicant is notified that proper ratification is required; otherwise, the telegram will not be accepted as a response to the former Office action. If he does ratify promptly, the amendment is entered. (See ex parte Wheary, 1913 C.D. 253; 197 O.G. 534.)

The same test as to completeness of response applies to an amendment sent by telegraph as to one sent by mail.

10-16-12. Amendments Before First Office Action

See 8-8-52.

As an applicant has the right to amend before action on his case provided the number of claims is kept within the limit imposed by his filing fee, an amendment

is sometimes filed along with the filing of the application. Such amendment does not enjoy the status as part of the original disclosure. It is entered in the case and acted on in the first Office action. In regard to the introduction of new matter by such an amendment, see § 9-52.

10-10-13. Claims added in Excess of Filing Fee

In cases in which claims in excess of the number corresponding to the filing fee are presented before the first official action on the case, the examiner will place the amendment in the file and enter it on the file wrapper but will defer action on the claims presented in the amendment. In his first action the examiner should act on the claims originally presented and for which the appropriate fee was paid. In this first action the examiner also should inform the applicant that if he believes that any of the claims presented by the amendment are patentable, he can have them entered and considered in the next action but only by specifically pointing out wherein the claims presented in the amendment are patentable over the references cited by the examiner.

10-15-14. Amendments After Final Rejection or Allowance

Rule 16.2 Amendments after Final Rejection. After final rejection or action (Rule 15.3) amendments may be made concerning claims or complying with any requirement of form which has been made, and amendments presenting rejected claims in better form for consideration on appeal may be admitted; but the admission of any such amendment or its refusal and any proceedings relative thereto shall not operate to relieve the application from its condition as subject to appeal or to save it from abandonment under Rule 19.1.

If amendments touching the merits of the application be presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon a showing of good and sufficient reasons why they are necessary and were not earlier presented.

No amendment can be made as a matter of right in appealed cases between the filing of the examiner's statement of the reasons of his decision (Rule 52.2) and his decision.

of the appellate tribunal except as provided by Rule 32.4. After decision on appeal, amendments can only be made as provided in Rule 32.9, or to carry into effect a recommendation under Rule 32.7.

Once a final rejection that is not premature has been entered in a case it should not be withdrawn except on the showing required by Rule 16.2 and the approval of the Supervisory Examiner. This does not mean that no further amendment or argument will be considered. Any amendment that will place the case either in condition for allowance or in better form for appeal will be entered.

In every case where an amendment is filed after final rejection, such amendment will be considered by the examiner at least to the extent of determining whether the re-argued or amended claims could be allowed without further search. An amendment with appeal which presents additional claims without cancelling corresponding finally rejected claims would not ordinarily be considered as placing the application in better condition for appeal, *Ex parte Wirt*, 1905 C.D. 247, 117 O.G. 599.

Amendments After Final Rejection or Allowance Action Taken

If possible or expedient applicant should be notified within the statutory six months period following final rejection of the disposition of any amendment filed after final rejection.

Where the amendment places the case in condition for allowance the notice of allowance of course is sufficient.

Where an amendment filed after final rejection, within the statutory period, not accompanied by the filing of an appeal, does not place the case in condition for allowance, applicant is informed that the amendment has not been entered as it is not considered to be a proper response to the final rejection. When such an amendment is also presented for purposes of appeal and is considered by the examiner to place the case in better condition for appeal, applicant also is informed that the amendment will be entered for appeal on the filing of the appeal.

Failure of applicant to properly respond to a final rejection within the statutory period results in a holding of abandonment of the case. For an exception see 10-16-32 (3).

10-16-15.

Amendment Mailed Before, but
Received in Examining Division,
After Allowance

Where an amendment, even though prepared and filed prior to allowance, does not reach the office until after the notice of allowance has been mailed, such amendment has the status of one filed under Rule 34.2. Its entry is a matter of grace. For discussion of amendments filed under Rule 34.2, see 10-16-17.

If, however, the amendment is filed in the Office, but is not received by the examiner prior to the mailing out of the notice of allowance, it has the same standing in the case as though the notice had not been mailed. Where the case has not been closed to further prosecution, as by final rejection of one or more claims, or by an action allowing all of the claims applicant is entitled to have such amendment entered even though it may be necessary to withdraw the application from issue. Such withdrawal, however, is unnecessary if the amendatory matter is such as the examiner would recommend for entry under Rule 34.2.

As above implied, the case will not be withdrawn from issue for the entry of an amendment that would reopen the prosecution if the Office action next preceding the notice of allowance closed the case to further amendment, i.e., by indicating the patentability of all of the claims, or by allowing some and finally rejecting the remainder.

After an applicant has been notified that the claims are all allowable, further prosecution of the merits of the case is a matter of grace and not of right (ex parte Quayle, 1935 C.D. 11; 453 O.G. 213). To this extent the practice affecting the status of an amendment received in the Office on the date of mailing the notice of allowance, as set forth in ex parte Miller, 1922 C.D. 36; 305 O.G. 419, is modified.

10-16-16. Practice Where Copied Patent Claims Are
Filed in a Case in Issue

The procedure below is to be followed when an amendment is received after notice of allowance, which includes one or more claims copied or substantially copied from a patent.

Where the examiner, after consideration of the proposed amendment, finds one or more of the copied claims patentable to the applicant and an interference

unavoidable, he or she prepares a letter requesting that the application be withdrawn from issue for the purpose of interference. This letter, which should designate the claims to be involved, should be forwarded, together with the file and the proposed amendment, to the Commissioner.

If, however, the applicant refuses to withdraw the application, he or she should receive an adverse report (see report of date 10-16-24.) stating briefly the basic reasons for refusing the interference, e.g., not readable on the prior art, or, if readable, no sound on the disclosure, or, disclosure to alicant over the prior art, etc. The Examiner should also prepare an internal memorandum setting forth in detail his reasons for refusing the requested interference. This memorandum is for use in the Commissioner's Office and will not become a part of the record. These papers with the file on the case should be forwarded to the previous office.

Where an Amendment is Filed With a Motion Under Rule 34.2 Applying to a Case in Issue

Where an amendment is filed with a motion under Rule 34.2 applying to a case in issue, the case is not immediately withdrawn from issue if the date set for hearing the motion comes well within the prescribed period of allowance. Otherwise, the case is withdrawn, but the amendment is not entered unless and until the motion has been granted.

10-16-17.

Amendment after Allowance Under Rule 34.2

Rule 34.2, Amendments After Allowance.
Amendment after the notice of allowance of an application may not be permitted as a matter of right, except as hereinafter provided, if the applicant has not previously begun, on the recommendation of the Primary Examiner, approved by the Commissioner, without withdrawing the case from issue

After a case is allowed to issue, it is technically no longer under the jurisdiction of the Primary Examiner. However, the Examiner has the right and authority to permit amendments, in whole or in part, as provided in the Rules, and also to allow amendments under Rule 34.2 which are permitted as a matter of form in applications or claims, and to the amendments in claims of claims.

Amendments in claims of claims under Rule 34.2 may be allowed as a matter of right, even, if a claim or claim in a claim is not amended, in a reverse

reasons and as to its admission on this score is made by the Examiner. New issues may not be raised for determination once a case has been allowed. Rule 34.3 was not intended to provide a way for the continued prosecution of an application after it has been passed for issue.

For the reason just stated, an advertisement issued by the Examiner as to an admission of an applicant under Rule 34.3 should not be accompanied by a detailed statement of reasons in support of such recommendation. The single statement that "it is not obvious that the proposed claim is patentable" is usually adequate. Of course where it can be made, a suggestion of an amendment that would, in the opinion of the Examiner, render the claim allowable is always in order.

The regulations of Rule 15.1 (see 10-16-11) with respect to continuing the patentable novelty of any claim sought to be added, apply in the case of amendments under Rule 34.2, as in ordinary amendments.

Rule 34.2 does not contemplate the admission of an amendment after the specification has been printed.

Sometimes a supplemental oath is filed after the application has gone to issue. Such oath is not treated as an amendment under Rule 34.2, but is merely placed in the file by the Issue and Gazette Branch. No acknowledgment of its receipt is made. Order 2793, January 2, 1923. (8-2-10)

10-16-20.

Amendment Under
Rule 34.2 Cancelling Claims

Amendments submitted after the notice of allowance of an application which merely the correction of formal matters in the specification, or formal changes in a claim without changing the scope thereof, or the cancellation of claims from the application, shall be acted upon by the Primary Examiner and not forwarded to the Commissioner for approval.

(Similar practice obtains in the matter of amendment of the drawing.)

Any amendment affecting the disclosure of the specification, or adding claims, or changing the scope of any claim, shall be referred, and referred only, to the Commissioner for approval in accordance with the provisions of Rule 34.2. (Order 311)

Form No. 101.09 is required for amendments to applications under Rule 34.2 which fall within Order No. 311.

10-16-21.

Amendments Under Rule 34.2
Copied Patent Claims

If the amendment which the applicant seeks to have entered under Rule 34.2 presents copied patent claims, and the Examiner is of the opinion that one or more of them are patentable to the applicant, action by the Examiner should be taken under the provisions of Rule 34.3, not under Rule 34.2; that is, the Examiner should request withdrawal of the case from issue.

Where the Examiner finds basis for refusing the interference on any ground, action is taken under Rule 34.2 as pointed out in 10-16-16.

10-16-22.

Under Rule 34.2
Excess Number of Claims

When an amendment under Rule 34.2 adds claims which increase the total number in the case above twenty, the Examiner's clerk in preparing the forms will see that the notice bears the statement "The final fee in this case will now be \$_____." filled in according to the number of claims that stand allowed in the case after the entry of the amendment.

Rule 34.7 is sometimes taken advantage of where, after payment of the final fee at the end of the six months period, it is sought to add claims under Rule 34.2 which would increase the number of claims in the case beyond that covered by the final fee. Acceptance of such additional final fee is of course contingent on the applicant's making a satisfactory showing as to why the additional claims were not earlier presented, whether printing has begun and the approval of the Commissioner.

10-16-24. Amendments Under Rule 34.2, Handling.

Order No. 2698 October 12, 1921

Rule 34.2 Procedure. Petitions to amend under Rule 34.2 will be sent by the Mail Room to the Issue and Gazette Branch.

The Issue and Gazette Branch will send the petition with the file to the division which allowed the case.

The Examiner's clerk will send it the case to the Examiner for his recommendation, which must be promptly made. When the recommendation is favorable (to be indicated by applying on the amendment the stamp reading:

"Entry recommended under Rule 79" (34.2), the Examiner's clerk will enter the amendment and prepare a letter, in duplicate, (Form No. 10-104) to the applicant, notifying him that the amendment has been entered. This letter should be placed in the file, entered on the file wrapper and in the Examiner's register. The file, together with the usual application, should be sent back to the Issue and Control Branch which will forward it to the Commissioner.

If the Examiner's recommendation is adverse to the entry of the amendment, a letter (Form 10-104) should be prepared in duplicate, to the applicant, advising him, and consulting the Examiner's report. This letter should be placed in the file and entered on the file wrapper and in the Examiner's register. The unfiled duplicate, together with the file, should be forwarded to the Commissioner as above.

After the Commissioner has acted on the petition, the file will be forwarded to the Issue and Control Branch, which will mail the communication prepared by the Examiner. See 10-104, 10-105, and Rule 34.2.

The physical entry of the amendment by the clerk in the use of Forms 261 and 10-105 does not signify that the amendment has been admitted; nor, though physically entered, it is not constructively admitted unless and until approved by the Commissioner.

10-10-25. Amendments by or Rule 34.2
Handling Entry in Part

The general rule that an amendment should be entered in part and refused in part, will not be applied, but when, under Rule 34.2, an amendment is proposed containing a plurality of claims, some of which may be admitted and some not, the several claims should be entered, in the case and if necessary they should be recommended to be non-conformable with the claims already in the case.

The Examiner should then submit a report in Form 10-104, recommending the entry of the admitted portion of the amendment and the non-entry of the non-admitted portion together with his reasons therefor. The entry of admitted should be indicated by number in this report.

In some Form 10-104's, Examiner should give the Form by which it is entered, i.e., "Admitted" and by which it is refused, i.e., "Not Admitted".

"The entry of the amendment proposed under Rule 34.2 has been made in part. A copy of the Examiner's report appears below."

10-16-27. Amendment Filed After the Period for Response has Expired.

When an application is not prosecuted within six months from the date of the last Office action therein, within a set shortened statutory period or a set time limit and thereafter an amendment is filed, such amendment shall be endorsed on the file wrapper of the application, but not formally entered, and the Examiner shall immediately notify the applicant that the amendment was not filed within the time period and therefore cannot be entered. (Order 1154) See 10-2, and 10-11.

10-16-30. Entry of Amendments

When the amendments reach the Application Branch, they are assorted according to the Divisions to which they belong, and are therein these amendments, together with such new applications as have been received, are collected and sent to the respective divisions. There the amendments are put in the files to which they pertain, and the files with the unentered amendments placed on the primary's desk for inspection and such penciled comments as he may wish to note on the margin of the amendatory paper.

The files and amendments are then turned over to the clerk, whose duty it is to enter the amendments. The clerk stamps the amendment with the date of its receipt in the division. It is important to observe the distinction which exists between the stamp which shows the date of receipt of the amendment in the division, and the stamp bearing the date of receipt of the amendment by the Office. The latter date, placed in the left-hand corner, should always be referred to in writing to the applicant with regard to his amendment.

The amendment or letter is placed in the file, given its number as a paper in the application, and its character endorsed on the file wrapper in red ink.

When several amendments are made in an application on the same day no particular order as to the order of the receipt or the mailing of the amendments can be assumed, but consideration of the case must be given as far as possible as though all the papers filed were a composite single paper.

When the name or residence of applicant or title of invention is changed by amendment, it must be changed on the face of the file in red ink by the clerk of the division.

When the name is corrected by amendment, the file should be sent to the Application Branch for correction of the name in its record.

After entry of the amendment the application is "up for action," and it is very important that it should be kept separate from those applications which await action by the applicant. It is placed on the Examiner's desk, and he is responsible for its proper disposal. The Examiner should immediately inspect the amendment and set forth in 10-10-3 to 5. After inspecting the application as filed in the amended case files to await re-examination in regular order.

Amendments or other papers filed in a case before the Law Examiner should be promptly forwarded to him.

10-10-11.

Amendment Entry Denied

Amendment Presenting Subject Matter Claim After Time Limit Is Not Entered Without Commissioner's Approval

Where the Examiner suggests that an applicant copy a claim or claims from a patent for the purpose of establishing an interference, a time limit should be set within which an amendment containing the claim or claims should be presented, and upon failure of the applicant to present such amendment within the time limit, or any reasonable extension thereof which the Examiner has granted, the amendment will not be entered without the approval of the Commissioner.

List of Amendments, Entry Denied.

- (1) an amendment presenting an unpatentable claim, or a claim requiring a new search or otherwise raising a new issue in a case where prosecution before the Primary Examiner has been closed, as where
 - (a) All claims have been allowed.
 - (b) All claims have been finally rejected,
 - (c) Some claims allowed and remainder finally rejected. See 10-16-14.
- (2) Substitute specification that has not been required and is not needed. See 10-10-2.
- (3) A patent claim suggested by the Examiner and not presented within the time limit, or a reasonable extension thereof, unless entry is authorized by the Commissioner. See Section 14.
- (4) While copied patent claims are generally admitted even though the case is under final disposition or on appeal, yet where, *prima facie*, the applicant has no

basis in his disclosure for the copied patent claim or its essence, or where the patent claim is for another, even though not divisible different, invention than that claimed by the application (patent file No. 1, 27, 066), the claim may be refused admission if the application falls in class (a), (B), or (c) of category, (1) supra, and especially if the application is an old one. (See section 13).

(5) An unsigned amendment or one not properly signed by a person having authority to prosecute the case. This applies where the amendment is signed by one only of two inventors. See 6-1-11; 10-2; 10-16-11.

(6) An amendment filed in the Patent Office after the expiration of the statutory period or set time limit.

(7) An amendment so worded that it cannot be entered with certain accuracy. See 10-16-30.

(8) An amendment cancelling all of the claims and presenting no substitute claim or claims. See 10-12.

(9) An amendment in a case no longer within the Examiner's jurisdiction with certain exceptions in applications in issue (Order 3511) 10-16-20, except on approval of the Commissioner.

(10) An amendment filed before the first action increasing the number of claims in excess of the filing fee. See 10-16-13.

(11) Amendments to the drawing held by the Examiner to contain new matter are not entered until the question of new matter is settled. This practice of non-entry because of alleged new matter, however, does not apply in the case of amendments to the specification and claims.

(12) An amendatory paper containing objectionable remarks that, in the opinion of the Examiner, brings it within the contemplation of Rule 1.3, will be submitted to the Commissioner with a view to its being returned to applicant.

While amendments falling within any of the foregoing categories should not be entered by the Examiner at the time of filing, a subsequent showing by applicant may lead to entry of the amendment. See 10-16-33.

10-16-32. List of amendments Entered in Part

To avoid confusion of the record the general rule prevails that an amendment should not be entered in part. As in the case of most other rules, the strict observance of its letter may sometimes work more harm than would result from its infraction, especially if the amendment in question is received at or near the end of the statutory period. Thus,

(1) An amendment presenting an uncalled-for and

(4) In an amendment accompanying a motion granted only in part, only so much of the amendment as is covered in the grant is entered.

10-16-35. Amendments Inadvertently Entered No Legal Effect

If the clerk inadvertently enters an amendment when it should not have been entered, such entry is of no legal effect, and the same action is taken as if the changes had not been actually made, inasmuch as they have not been legally made. Unless such unauthorized entry is deleted, suitable notation should be made on the margin of the amendatory paper, as, "Not Officially Entered".

An amendatory paper, even though not entered, should be given a paper number, and appropriately endorsed on the file jacket, as by "Not Entered".

10-16-35. Entry of Amendments, Directions For Note 1-10-37

As the specification is never returned to applicant under any circumstance, he should retain a line for-line copy thereof. In amending, the attorney or the applicant is required by Rule 17.1 to specify the exact word or words to be stricken out or inserted in the application and to indicate the precise point as by page and line where the deletion or insertion is to be made.

10-16-36. Entry of Amendments, Directions For Defective

Where the directions for the entry of an amendment are defective, as, inaccuracy in the line designated, or lack of precision where the word to which the amendment is directed occurs more than once in the specified line, and it is clear from the context what is the correct place of entry, the amendatory paper will be properly amended in the examining division, and notation thereof, initials by the Examiner, will be made on the margin of the amendatory paper. The applicant will be duly informed of this alteration in his amendatory paper and the entry of the amendment is thus amended; as he will also be informed of the non-entry of an amendment where defective directions and context leave doubt as to the intent of applicant.

10-16-36a. Amendment of Amendments

Rule 17.4 When an amendatory clause is to be amended, it should be wholly rewritten and the original insertion cancelled, so that no interlineations or deletions shall appear in the clause as finally presented. **Matter**

cancelled or amended, or a copy for which
applied by a third person, and which, containing
the cancelled matter, is not in the file.

10-17-1. Application of Order 2799

It has frequently happened that, in a case in which
a petition for reconsideration of the decision of the
Examiner has been filed, and the petition is allowed,
which it related, and allowed to stand, the applica-
tion was reached for examination in the original order.
In view of this fact, the Director is directed to
carefully inspect each case in connection with the appli-
cant or an attorney, before deciding in an application
file, to determine whether such case and petition should be
called to the immediate attention of either the Commissioner
or the Examiner.

Every case and petition in which a petition has been filed
at the above-mentioned date, shall be initiated on Jan-
10-17-1.

10-17 File Wrapper

10-17-1. Papers in File Wrapper

Every paper entered on the "Contents" of a file
should be entered in ink and not in pencil. If the paper
is not to be allowed entry in the case, that fact may be
noted in ink at the time the entry on the "Contents" is
made. If subsequently the paper is allowed entry in the
case a line may be drawn through the "not entered" note.
No paper entered on the "Contents" of the file should ever
be withdrawn or returned to the applicant without special
authority of the Commissioner. (Order 2799)

It is directed that entries shall not be made on
the back of a file wrapper, containing the application
papers for a patent, or papers or petitions which do not
become a permanent part of the contents of the file.
(Order 767)

10-17-2 Numbering of Papers
in File Wrapper

On the back of the file wrapper is printed the
"Contents" column, numbered 1 to 50.

The papers when placed in the file are numbered
and noted in the contents column, the application papers
being No. 1, the print of the drawing, if there is one,
being No. 2, and the next paper, usually the first Office
letter being No. 3, etc.

The papers are noted in the contents column according to their character. If it is an Office action rejecting any claim, the word "Rejection" is entered on the file, or if the rejection has taken the form of a requirement for division, the entry will so indicate, otherwise the word "Letter" is used. Papers from the applicant amending the case are designated "Amendment", "Letter to Craftsman", "Sub Attorney", etc.

Correspondence from the applicant is entered in the contents column in red ink and Office correspondence is entered in black ink.

After the notation of the character of the papers, the mailing date is entered in regard to Office correspondence and the filing date in regard to correspondence from the applicant. See Clerk's Manual Part I, Sec. 4.

10-17-3. Arrangement of Papers in File Wrapper

All papers in applications must be arranged and marked uniformly in the following manner.

The specifications and all amendments that are to be printed must be kept separate from office letters, appeals and miscellaneous correspondence. The specification and amendments must be fastened to the second or middle page of the jacket with the original specification and claims on the bottom and the last amendment on the top. The print of the drawing, the Office letters and other papers not needed by the printer must be fastened to the third page of the jacket, the print of the drawing being always kept uppermost. A communication containing amendments and explanations should ordinarily not be divided. If the amendments and explanatory matter be presented in the same paper, it should be treated as an amendment and placed on the amendment side or second page of the jacket, care being taken to mark and enclose the parts to be printed by red ink that the printer can readily distinguish the amendment from the explanatory matter. All the papers in the case will be marked serially as heretofore.

Amendments will be lettered serially in the order of their receipt, all the amendments of the same date bearing the same serial letter. If the amendment is short it should be transcribed in red ink at the proper place, and the notation per "A", per "B", etc. should be written in red ink on the margin. Amendments that are transcribed should never be marked A¹, A², B¹, B². Amendments that are too long to be transcribed should be marked A¹, A², B¹, B², etc. on the margin. The first amendment of this character in amendment sheet "A" shall be A¹, the second A², etc. At the

margin point at which the amendment is to be inserted should be written "Insert A¹", "A²" etc. as the case may be, and the same letters placed in the angle of a caret at the proper point of insertion, so that when several insertions are placed in the same line these different insertions may be readily distinguished.

All insertions and substitutions should be marked on the original application, if practicable. For instance, if Amendment A provides that claims 1 to 5 should be canceled and new claims substituted, a red line should be drawn transversely across claims 1 to 5 and in the margin should be written "Sub. A¹." If at a later date the claims contained in Amendment A¹ are canceled and a series of claims contained in Amendment B¹ are submitted, the claims in Amendment A¹ should be canceled and the proper notation made in the margin, and in addition the notation "Sub A¹" on the original paper should be canceled and in its place should be written "Sub B¹". The last requirement is very important, as the work of the printer is needlessly delayed and complicated if he is compelled to search from paper to paper for the proper insertion.

Where amendments are submitted in duplicate, the carbon copy is destroyed except where the duplicate is received within the time period for response and the original is late. In this latter situation both copies are placed in the file.

If the attorney wishes a receipt for any paper filed, this may be had by enclosing with the paper a self-addressed postal card identifying the paper. The mail-room receiving-stamp will be placed on the card, and the card dropped in the outgoing mail. (Order 1733)

10-17-4.

Prints

The Principal Examiners are directed to instruct their clerks to hereafter enter as Paper No. 2 the prints of the drawings fastened inside the file wrapper by the Application Branch. Such entry, of course, requires endorsement on the file wrapper and on each print of the appropriate date of receipt and paper number.

This does not countermand the order requiring these prints to be always kept on top of the papers on the right of the file wrapper.

All prints and inked sketches subsequently filed to be part of the record (blueprints do not become part of the record, see 8-9-4b) should be endorsed with the date of their receipt in the office and given their appropriate paper number. (Order 3340)

10-17-5. Data Entered on File Wrapper
(See also 10-9-19 and 15-2-5)

10-17-5a. Statutory Period ends
on Sunday or Holiday

The following data is typed or written on the face of the wrapper:-

1. The serial number given the application in the Application Branch. See 7-1-4

2. The number of the examining Division to which the case is assigned by the application Branch.

3. The name of the applicant. See 8-6

4. The residence of the applicant.

5. The title of the invention.

6. The date of receipt of the various parts of the application. See 7-1-8

7. The date when it is considered a complete application. If the parts of the application have been received at different dates, the date of receipt of the last part is the date of the complete application, or filing date. See 7-1-4

8. The name and address of the attorney or representative. See 6

9. The name and address of the assignee if there be one. (This entry is made by the Assignment Branch.) See 5-2

10. The filing date and name of country of earliest foreign application, if any, and also of each additional foreign application filed outside the 12-months period, if any.

If any error is made in entering the above data on the file wrapper and is subsequently discovered in the examining division, the correction of such error must be made by the Application Branch except for 9, which the Assignment Branch corrects.

Also where a case for which the filing fee was paid is brought under the Act of 1883, entry on the file wrapper is made by the Application Branch. Assignments are entered by the assignment Branch.

All of the above entries are either typed or made in black ink. Such changes by amendment as change of address or of attorney are entered in red ink by the Examiner's clerk, the original entry being canceled but not erased.

Where an amendment is filed or a fee paid a day or two later than the expiration of the period fixed by statute care should be taken to ascertain whether the last day of that period was Sunday or a holiday in the District of Columbia, and if so whether the amendment was filed or the fee paid on the next succeeding day.

When an amendment is filed on the first secular day succeeding Sunday or a holiday, which was the last day of the period for filing amendments, the clerk should endorse on the file wrapper, following the date on which the amendment was filed, that the last day was Sunday, or holiday. Thus, where the time period for response expired on June 5, 1927, and an amendment was filed on June 6th, the endorsement should be, "Amendment--June 6, 1927 (June 5th, Sunday)." Papers received at the Post Office before 5 P.M. on week days, excepting holidays, and papers filed with the watchman should be stamped as at present provided in Rule 1.7. (Order 5017)

10-17-5b.

Name or Residence of Inventor
or Title Changed

When the name or residence of applicant or title of invention is changed by amendment it must be changed on the face of the file in red ink by the clerk of the division.

10-17-15.

Classification during Examination

When a new case is received in a division the primary Examiner notes in pencil in the upper left-hand corner of the face of the file wrapper the classification of the case and indicates the assistant Examiner who will examine it.

In the upper right hand corner on the face of the file wrapper is noted (EXR'S BOOK) where the case is recorded in the Examiner's Register. (See Clerk's Manual.)

The file of an application which is subject to dual prosecution will be so distinguished by noting in red ink in the upper left hand corner of the file directly below "Div.----" the following: Div.----

10-17-16. Index of Claims

Constant reference is made to the "Index of Claims" found in the inside of the file wrapper of all applications. It should be kept up to date by the Examiner so as to be a reliable index of all claims pending in a case, and of the amendment in which the claims are to be found.

A line in ink should be drawn below the last number of the group of original claims. Thereafter a line in ink should be drawn below the last number of each successive group of claims added by amendment, and on the left side of the first claim of each amendment should be placed the letter designating the amendment.

As any claim is canceled a line should be drawn through its number. Claims retained under Rule 11.2 but not canceled should be enclosed by a ring in pencil with the notation "R11.2". This is an aid in mentioning all of the claims by number in each action since claims retained under Rule 11.2 are rejected as not readable on the elected species.

10-17-17. Field of Search

Hereafter in each action by an Examiner upon an application he shall make an (initialed) indorsement (in ink) on the left-hand page of the open file wrapper, stating the classes and sub-classes of domestic and foreign patents, and the publications in which search for references was made and also the date of the search.

In the above order "initialed indorsement" means the Examiner's initials should be noted. Also, the date of search in the Scientific Library for foreign patents issued to the applicant when sending an application to issue which was not filed within 6 months of his earliest foreign application (Order 2140) should be noted in the file wrapper. (See 10-17-16.)

10-17-18. Foreign Filing Dates

The Examiners are directed on passing to issue any application in which an earlier foreign application, or applications, for the same invention has been filed, to enter (if entry has not been made) at the bottom of the face of the file wrapper the earliest date of filing in any foreign country and the name of such country, as in the

event that more than one foreign application has been filed outside the twelve-months period (six months for designs), the filing date and name of country of each such application will also be thus entered. (Order 3233)

The applicant is required by rule 9.1 to state the foreign countries in which he has filed prior to his application in the United States in his oath. Therefore, the Examiner should inspect the oath in following out the requirements of the above order.

10-17-19. Related Applications

The file wrapper should identify earlier filed related applications. See 4-2-2.

Where there is filed a division, a continuation, or a substitute of a prior application which has been assigned, the assignment of the parent case applies to the latter filed case. Where the later case is a continuation-in-part, the assignment does not carry over from the earlier case.

10-17-20. Allowed Case Data
(Note 10-17-18, 10-17-19; 4-1-13)

Particular care should be exercised by the Examiners in indicating upon the file wrapper and drawing the correct classification of any case sent to issue. No classification data should remain or appear upon either paper that is inconsistent with the designation finally approved. (Order 2291)

When an application is passed to issue the Examiner fills out the form at the bottom of the face of the file wrapper. See 15-2-8.

The Primary Examiner signs and dates the face of the file wrapper after the case is revised by the clerk.

When the notice of allowance is mailed its date is also endorsed on the face of the file wrapper.

In the case of a reissue application, it is permissible to use the drawing of the patented application if no alteration is to be made and the entire drawing is to be used. Otherwise, a new drawing is required. When the patented drawing is used it is not transferred until the case is ready for issue. Such transfer is made by the Application Branch, notation thereof being entered on the file wrapper of the original application. See 8-9-39

10-17-21.

Patented File

Rule 22.9 Notice of reissue application.
When an application for a reissue is filed, there will be placed in the file of the original patent a notice stating that an application for reissue has been filed, giving its serial number and filing date. When the reissue is granted or the reissue application is otherwise terminated, the fact will be added to the notice in the file of the original patent.

A notice of the filing of a reissue application will be published in the Official Gazette. Reissue applications are not preserved in secrecy in the same manner as original applications, and access may be granted on request in writing and for sufficient reasons.

The notice referred to in Rule 22.9 which is required to be placed in the file of an original patent for which an application for reissue has been filed, will be on Form No. 22-76, which is inserted by the Application Branch.

All such notices will be entered on the file wrappers and in the Examiner's registers.

If an application becomes a patent, the patent number and issue date are recorded on the face of the file wrapper.