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- Rule 51. General requisites of an application.* Applications for patents must be made to the Commissioner of Patents. A complete application comprises:
- (a) A petition or request for a patent, see rule 61.
 - (b) A specification, including a claim or claims, see rules 71 to 77.
 - (c) An oath, see rule 65.
 - (d) Drawings, when necessary, see rules 81 to 88.
 - (e) The prescribed filing fee. (See rule 21 for filing fees.)

The petition, specification, and oath must be in the English language and must be legibly typewritten, written or printed in permanent ink. See Rule 52 and 608.01.

The parts of the application may be included in a single document, and an approved single signature form may be used.

Determination of completeness of an application is covered in 506.

The petition, specification and oath are secured together in a file wrapper bearing appropriate identifying data including the serial number and filing date (717).

NOTE

Reissue patents, 1401.

Design patents, Chapter 1500.

Plant patents, Chapter 1600.

A model, exhibit or specimen is not required as part of the application as filed, although it may be required in the prosecution of the application (Rules 91-93, 608.03).

Rule 59. Papers of complete application not to be returned. The papers in a complete application will not be returned for any purpose whatever. If appli-

cants have not preserved copies of the papers, the Office will furnish copies at the usual cost. See rule 87 for return of drawing.

601 Petition

Rule 61. Petition. The petition must be addressed to the Commissioner of Patents and request the grant of a patent. The residence, and post office address of the petitioner must appear in the petition if not stated elsewhere in the application. The petition need not be separately signed when part of and attached to the specification and oath, otherwise it must be signed by the petitioner.

The power of attorney or authorization of agent may be incorporated in the petition.

Petitioner's or applicant's post office address is discussed in 605.03.

The petition need not be dated.

601.01 Amendment of Petition

Those portions of the petition other than the post office address (see 605.03) may be amended by the attorney. (Extract from Order No. 1994.)

601.02 Power of Attorney or Authorization of Agent

Usually a power of attorney or authorization of agent is incorporated in either the petition or single signature form. See 402 and 605.04 (a).

The attorney's or agent's full post office address should be given in every power of attorney or authority of agent. The prompt delivery of communications will thereby be facilitated. (Extract from Notice of Oct. 8, 1946.)

602 Original Oath

Rule 65. Oath of applicant. (a) The applicant, if the inventor, must make oath or affirmation that he does verily believe himself to be the original and first inventor or discoverer of the process, machine, manufacture, composition of matter, or improvement thereof, for which he solicits a patent; that he does not know and does not believe that the same was ever known or used before his invention or discovery thereof, and shall state of what country he is a citizen and where he resides, and whether he is a sole or joint inventor of the invention claimed in his application. In every original application the applicant must distinctly state under oath that to the best of his knowledge and belief the invention has not been in public use or on sale in the United States for more than one year prior to his application, or patented or described in any printed publication in any country before his invention or more than one year prior to his application, or patented in any foreign country prior to the date of his application on an application filed by himself or his legal repre-

representatives or assigns more than twelve months prior to his application in this country. The oath shall state whether or not any application for patent on the same invention has been filed in any foreign country, either by the applicant or by his legal representatives or assigns

If any such application has been filed, the applicant shall name the country in which the earliest such application was filed, and shall give the day, month, and year of its filing; he shall also identify by country and by day, month, and year of filing, every such foreign application filed more than twelve months before the filing of the application in this country. This oath must be subscribed to by the affiant.

See rule 153 for oath in design cases and rule 162 for oath in plant patent applications.

(b) If the application is made as provided in rules 42, 43, or 47, the oath shall state the relationship of the affiant to the inventor and, upon information and belief, the facts which the inventor is required by this rule to make oath to.

(c) An additional oath may be required if the application has not been filed in the Patent Office within a reasonable time after the execution of the original oath.

Rule 65 has been amended with respect to the recitation of prior foreign applications. The applicant must state that no foreign applications have been filed, if such is the case. If all foreign applications have been filed within twelve months of the U. S. filing date, he is required only to recite the first such foreign application, and it should be clear that the foreign application referred to is the first filed foreign application. The applicant is required to recite all foreign applications filed more than twelve months prior to the U. S. filing. It should be noted that an oath in the form proper before January 1, 1953 is still acceptable.

The single signature form mentioned in 605.04 (a) includes the oath.

An oath which refers to applicant as "the petitioner" need not contain applicant's name in the body thereof.

In the oath, the jurat must be filled out, and the word "sole" or "only" must appear if there is but one inventor, and "joint" if two or more inventors.

When joint inventors execute separate oaths, each oath should make reference to the fact that the affiant is a joint inventor together with each of the other inventors indicating them by name. This may be done by stating that he does verily believe himself to be the original, first and joint inventor together with "A or A & B, etc." as the facts may be.

The oath usually bears an impressed seal of the administering official but such seal may not always be required. See Rule 66, and 604.

If a claim is presented for matter not originally claimed or embraced in the original statement of invention in the specification a supplemental oath is required. Rule 67, 603.

602.01 Oath Cannot Be Amended

The wording of an oath cannot be amended. If the wording is not correct or if all of the required affirmations have not been made or if it has not been properly subscribed to, a new oath must be required. However, in some cases a deficiency in the oath can be corrected by a supplemental paper and a new oath is not necessary.

For example, if the oath does not set forth evidence that the notary was acting within his jurisdiction at the time he administered the oath a certificate of the notary that the oath was taken within his jurisdiction will correct the deficiency. See 604.02.

602.02 New Oath or Substitute for Original

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 filing.

Where neither the original oath, nor the substitute oath is complete in itself, but the two taken together give all the required data, no further oath is needed.

602.03 Defective Oath Must Not Be Waived by the Examiner

The fact that the courts would probably not invalidate a patent because of a defective oath does not relieve the Examiner of the duty of requiring the appropriate remedy for any such defect.

602.04 Foreign Oath

An oath executed in a foreign country must be properly authenticated, 604, Rule 66.

602.04 (a) Foreign Oath Is Ribboned to Other Application Papers

Extract from Rule 66. (b) When the oath is taken before an officer in a country foreign to the United States, all the application papers, except the drawings, must be attached together and a ribbon passed one or

more times through all the sheets of the application, except the drawings, and the ends of said ribbon brought together under the seal before the latter is affixed and impressed, or each sheet must be impressed with the official seal of the officer before whom the oath is taken. If the papers as filed are not properly ribboned or each sheet impressed with the seal, the case will be accepted for examination but before it is allowed, duplicate papers, prepared in compliance with the foregoing sentence, must be filed.

602.05 Oath Too Old at Time of Filing

The time elapsed between the date of execution of oath and the filing date of the application should be checked for compliance with Rule 65 (c). If an unreasonable time has elapsed, the Examiner should call for a new oath. What constitutes a reasonable time is a question of judgment to be determined by all the circumstances in the particular case. (Five weeks plus time of transmission in the mails was considered reasonable under the circumstances of *ex parte Heinze*, 1919 C. D. 67; 265 O. G. 145). Note 602.05 (a).

602.05 (a) Oath in Division and Continuation Cases

Where the date of filing the application is not the date that determines the statutory twelve months' period, as in divisional and continuation cases, it is immaterial, so far as concerns the acceptability of the oath, how long a time intervenes between the execution of the oath and the filing of the application.

When a divisional application is identical with the original application as filed, signing and execution of the oath in the divisional case may be omitted. (See Rule 147, 201.06.)

603 Supplemental Oath

Rule 67. Supplemental oath for matter not originally claimed. (a) When an applicant presents a claim for matter originally shown or described but not substantially embraced in the statement of invention or claim originally presented, he shall file a supplemental oath to the effect that the subject matter of the proposed amendment was part of his invention; that he does not know and does not believe that the same was ever known or used before his invention or discovery thereof, or patented or described in any printed publication in any country before his invention or discovery thereof, or more than one year before his application, or in public use or on sale in the United States for more than one year before the date of his application, that said invention has not been patented in any foreign country prior to the

date of his application in this country on an application filed by himself or his legal representatives or assigns more than twelve months prior to his application in the United States, and has not been abandoned. Such supplemental oath should accompany and properly identify the proposed amendment, otherwise the proposed amendment may be refused consideration.

(b) In proper cases the oath here required may be made on information and belief by an applicant other than inventor.

Rule 67 requires in the supplemental oath substantially all the data called for in Rule 65 for the original oath. As to the purpose to be served by the supplemental oath, the Examiner should bear in mind that it cannot be availed of to introduce new matter into an application. It applies only to matter originally shown or described but not embraced in the statement of invention or claims as originally presented.

603.01 Supplemental Oath Filed After Allowance

Since the decision in *Cutter Co. v. Metropolitan Electric Mfg. Co.*, 275 Fed. 158, many supplemental oaths covering the claims in the case have been filed after the case is allowed. Such oaths may be filed as a matter of right and when received they will be placed in the file by the Issue Branch, but their receipt will not be acknowledged to the party filing them. They should not be filed or considered as amendments under Rule 312, since they make no change in the wording of the papers on file. (Order No. 2798.) See 714.16.

604 Administration or Execution of Oath

Extract From Rule 66. Officers authorized to administer oaths. (a) The oath or affirmation may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by a certificate of a diplomatic or consular officer of the United States, the oath being attested in all cases in this and other countries, by the proper official seal of the officer before whom the oath or affirmation is made. Such oath or affirmation shall be valid as to execution if it complies with the laws of the state or country where made. When the person before whom the oath or affirmation is made in this country is not provided with a seal, his official character shall be established by competent evidence, as by a certifi-

cate from a clerk of a court of record or other proper officer having a seal.

NOTE: Seals, 604.01.

When unnecessary, 604.01.

In foreign case, 602.04 (a).

604.01 Seal

When the person before whom the oath or affirmation is made in this country is not provided with a seal, his official character shall be established by competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal, except as noted in 604.03 (a), in which situations no seal is necessary.

The seal must be a physical impression such as produced with a die upon the paper or upon a substance adherent to the paper. See also 602.04 (a) on foreign executed oath and seal.

604.02 Venue

That portion of an oath or affidavit indicating where the oath is taken is known as the venue. Where the county and state in the venue agree with the county and state in the seal, no problem arises. If the venue and seal do not correspond in county and state, the jurisdiction of the notary must be determined from statements by the notary appearing on oath, or from the listing at 604.03. Venue and notary jurisdiction must correspond or the oath is improper. The oath should show on its face that it was taken within the jurisdiction of the certifying officer or notary. This may be given as the caption of the oath, or in the body of the jurat. Otherwise, a new oath, or a certificate of the notary that the oath was taken within his jurisdiction, must be required. Ex parte Delavoye, 1906 C. D. 320; 124 O. G. 626; Ex parte Irwin, 1928 C. D. 13, 367 O. G. 701.

604.03 Notaries and Extent of Jurisdiction

The extent of the jurisdiction of the notaries in the various states is given below.

STATEWIDE

Alaska	Illinois
Arkansas	Indiana
Canal Zone	Louisiana
Colorado	Maine
Connecticut	Maryland
Delaware	Massachusetts
District of Columbia	Michigan
Florida	Minnesota
Georgia	Montana
Idaho	Nevada

New Hampshire
New Jersey
New Mexico
New York (c)
North Carolina
North Dakota
Oklahoma
Oregon
Pennsylvania

Puerto Rico
Rhode Island
South Carolina
South Dakota
Utah
Vermont
Washington
Wisconsin
Wyoming

COUNTY ONLY

Alabama
Arizona
~~California~~
Kansas

Mississippi
Tennessee
Texas
West Virginia

VARIABLE JURISDICTION

(See explanatory paragraphs (a-f) below)

Hawaii (e)	Nebraska (b)
Iowa (a)	Ohio (f)
Kentucky (a)	Virginia (d)
Missouri (a)	

(a) In Iowa, Kentucky, and Missouri a notary, by filing a proper certificate in counties adjoining that for which he is appointed, may have authority to administer oaths in such counties also.

(b) In Nebraska a notary with a county commission can act only in that county; but he may have a general commission and may then act in any county on filing proper papers.

(c) In New York an attorney-at-law may be commissioned to act as a notary public but shall not employ the words "notary public" in connection with his official acts or duties.

(d) In Virginia, a notary may be appointed for one or more counties and cities, or for the commonwealth at large.

(e) In the Territory of Hawaii it is generally limited to the judicial circuit.

(f) In Ohio the law, as amended in 1941, gives notaries who are attorneys-at-law statewide jurisdiction and other notaries jurisdiction in the county of appointment. The extent of jurisdiction is stated on the seal or near the notary's signature.

The notary does not have to state when his commission expires but if he does so state, the oath should be inspected to determine whether or not the notary's commission had expired at the date of execution of the oath.

604.03 (a) Notarial Powers of Some Military Officers

Public Law 506 (81st Congress, Second Session) Article 136: (a) The following persons

California

on active duty in the armed forces . . . shall have the general powers of a notary public and of a consul of the United States, in the performance of all notarial acts to be executed by members of any of the armed forces, wherever they may be, and by other persons subject to this code [Uniform Code of Military Justice] outside the continental limits of the United States:

- (1) All judge advocates of the Army and Air Force;
 - (2) All law specialists;
 - (3) All summary courts-martial;
 - (4) All adjutants, assistant adjutants, acting adjutants, and personnel adjutants;
 - (5) All commanding officers of the Navy and Coast Guard;
 - (6) All staff judge advocates and legal officers, and acting or assistant staff judge advocates and legal officers; and
 - (7) All other persons designated by regulations of the armed forces or by statute.
- (d) The signature without seal of any such person acting as notary, together with the title of his office, shall be prima facie evidence of his authority.

604.04 Consul

When the oath is made in a foreign country, the authority of any officer other than a diplomatic or consular officer of the United States authorized to administer oaths must be proved by certificate of a diplomatic or consular officer of the United States. Rule 66, 604.

604.04 (a) Consul-Omission of Certificate

If the consular certificate is omitted, in cases in which the oath is taken before a notary abroad (or other foreign official), steps must be taken to have an appropriate consular officer authenticate the oath. This can be done only by arranging to send the oath to the consular officer.

604.05 Consular Fee Stamp

Up to June 28, 1955, the statute (22 U. S. C. 1196) required consular officers to affix a fee stamp to papers in connection with which they had performed consular or notarial acts. The act performed was not legally valid in the United States unless this stamp had been affixed. Such stamps were not required of embassies and legations under the Notice of Aug. 4, 1914.

The above mentioned statute was repealed by an Act of Congress effective June 28, 1955, and the use of consular fee stamps has been discontinued.

Rev. 2, June 1956

Hence all papers executed on or after that date that formerly required the consular fee stamp, are acceptable without such stamp. (Notice of Jan. 25, 1956, Revised.)

604.05 (a) Omission of Consular Fee Stamp

In applications executed abroad prior to June 28, 1955 before a consular officer and in which a consular fee stamp is required but from which the required stamp is lacking, the Examiner should not require a consular fee stamp to be furnished. The applicant should be informed that the oath or authentication, as the case may be, does not carry the required consular fee stamp and that the applicant should obtain a statement from the consular officer that a fee stamp had been affixed when the paper was executed.

604.06 By Attorney in Case

The language of Rule 66 and 35 U. S. C. 115 is such that an attorney in the case is no longer barred from administering the oath as notary. If such practice is permissible under the law of the jurisdiction where the oath is administered, then the oath is a valid oath.

The law of the District of Columbia prohibits the administering of oaths by the attorney in the case and hence the old bar still applies in the case of oaths administered in the District of Columbia. If the oath is known to be void because of being administered by the attorney in a jurisdiction where the law holds this to be invalid, the proper action for the Office to take is to strike the application since there is in effect no proper application before the Office and the Examiner will refer the file to the Solicitor's Office to initiate such action. (*Riegger v. Beierl*, 1910 C. D. 12; 150 O. G. 826.) Rule 66, 604.

605 Applicant

Rule 41. Applicant for patent. A patent must be applied for and the application papers must be signed and the necessary oath executed by the actual inventor in all cases, except as provided by rules 42, 43, and 47. See rule 147.

Unless the contrary is indicated, the word "applicant" when used in these rules refers to the inventor, joint inventors who have applied for a patent, or to the person mentioned in rules 42, 43, or 47 who has applied for a patent in place of the inventor.

Extract from Rule 45. Joint inventors. (a) Joint inventors must apply for a patent jointly and each must sign the application papers and make the required oath; neither of them alone, nor less than the

entire number, can apply for a patent for an invention invented by them jointly, except as provided in rule 47.

For convertibility from a joint to sole or sole to joint application see 201.03.

Rule 46. Assigned inventions and patents. In case the whole or a part interest in the invention or in the patent to be issued is assigned, the application must still be made by the inventor or one of the persons mentioned in rules 42, 43, or 47. However, the patent may be issued to the assignee or jointly to the inventor and the assignee as provided in rule 334.

This section concerns filing by the actual inventor. If filed by other, see 409.03.

NOTE

Disposition of application by inventor, 301.
Inventor dead or insane, 409.

Nationals of Germany or Japan may not apply for or obtain patents for any invention made, or upon which an application was filed by any such national, before January 1, 1946, in Germany or Japan or in the territory of any other of the Axis Powers or in any territory occupied by the Axis forces. Public Law 380, Sec. 3, 602 O. G. 675-6.

605.01 Applicant's Citizenship

The statute (35 U. S. C. 115) requires an applicant to state his citizenship. Where an applicant is not a citizen of any country, a statement to this effect is accepted as satisfying the statutory requirement; but a statement as to citizenship applied for or first papers taken out looking to future citizenship in this (or any other) country does not meet the requirement.

605.02 Applicant's Residence

The rules of practice require that the applicant state his place of residence. In the case of an applicant who is in the U. S. Army or U. S. Navy, a statement to that effect is sufficient as to residence. For change of residence see 717.02 (b).

605.03 Applicant's Post Office Address

Applicant's post office address means under Rule 61 that address at which he customarily receives his mail.

The object of requiring applicant's post office address is to enable the Office to communicate directly with the applicant if desired; hence, the address of the attorney with instructions to send communications to applicant in care of the attorney is not sufficient. (Extract from Order No. 1994.)

If the post office address is entirely omitted it must be supplied by a letter over the applicant's own signature. Where, however, having given complete data as to his residence, the applicant identifies his post office address only by street and number, it is assumed and so accepted, that the city and state of his residence are the city and state of his post office address.

Any amendment of the post office address requires the signature of the applicant himself.

605.04 Applicant's Signature and Name

Rule 57. Signature. The application must be signed by the applicant in person. The signature to the oath will be accepted as the signature to the application provided the oath is attached to and refers to the petition, specification and claim to which it applies. Full names must be given, including the full first name without abbreviation, and the middle initial or name if any.

Rule 76. Signature to the specification. The specification need not be signed when followed by the oath and constituting part of the original application papers, otherwise it must be signed by the applicant in person. See rule 57.

The signing and execution by the applicant of certain Divisional applications may be omitted. Rule 147, Section 201.06.

NOTE: Signature to response 714.01 (a) to (e).

605.04 (a) Single Signature Form

The single signature form should be executed only when attached to a complete application as the last page thereof. Such a form is shown as No. 16 in the List of Forms on pages 106 and 107 of Rules of Practice of January 1, 1953.

605.04 (b) Full First Name Required

Rule 57 requires "full names". The full *first* name must appear somewhere in the papers as filed, and there must be consistency in the names and signatures. Otherwise, appropriate amendment is required.

All applications which disclose the full first and last names with middle initial or name, if any, of the applicant at any place in the application papers will be received and considered as a sufficient compliance with Rules 57 and 76 of the Rules of Practice.

When the *full first name* of the applicant does not appear either in the signature or elsewhere in the papers the Examiner will, in the first official action, require an amendment over applicant's signature supplying the omission, and he will not pass the application to issue until the omission has been supplied unless a statement be filed over the applicant's

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own signature setting forth that his full first name is as signed or what is in fact his full first name.

No affidavit should be required.

The requirement should be made only when for the first name in the signature a mere initial appears or what can be only an abbreviation of a name. (Order No. 3140 Revised.)

In an application where the name is type written with a *middle name or initial*, but the signature is without such middle name or initial, action should be taken as follows:

In the first Office letter, call attention to the lack of uniformity and request information over the applicant's signature as to the correct form of his name, together with any necessary amendment.

If applicant, in reply, gives the name without the middle name or initial unaccompanied by any instructions to amend the typewritten name, the reply may be interpreted as a direction to cancel the middle name or initial from the preamble; though such amendment is not material, since the preamble is no longer printed in the patent. It is necessary however, that such surplus portion of the name, if it appears printed on the drawing, should be removed therefrom. This can be done by the Office draftsman.

If applicant gives the name with the middle name or initial, interpret the reply as a direction that the middle name or initial is to be used in the name on the printed patent. As the printer takes the name from the signature of the application, the addition of the middle name or initial must be indicated in red ink adjacent the signature.

If applicant fails to answer the request and the case is otherwise ready for issue, correct the name on the drawing by Examiner's amendment to correspond to the signatures, send copy to attorney, and pass the case to issue. This cannot be done if there are inconsistencies in the signatures.

There should be uniformity notwithstanding that lack of it is not sufficient to affect the validity of the patent.

When the name on the file is corrected, the file should be sent to the Application Branch for correction of its records.

605.04 (c) Applicant Changes Name

In cases where an applicant's name has been changed after his application has been filed and the applicant desires that the patent when issued carry an endorsement as to the change in his name, it will be sufficient for the applicant to make a request in writing accompanied by an oath signed with both

names and setting forth the procedure whereby the change of his name was effected. When such papers are received the application will be forwarded to the Assignment Branch and the oath pertaining to the change of name will be recorded in the assignment records. The Assignment Branch will then forward the application to the Application Branch for a change in their records. (Order No. 5106, Revised.)

No change is made on the face of the file by the Docket Clerk of the examining division, a suitable endorsement being made by the Assignment Branch. When ready for allowance, the case should be sent to the Drafting Branch for the addition of the new name to the drawing.

Where the change of name is merely by amendment, such as the addition of a full first name or a middle initial and no oath is required, the file is sent to the Application Branch for a change in their records and if the application is assigned it will be forwarded by the Application Branch to the Assignment Branch for a change in assignment record.

605.04 (d) Applicant Unable To Write

If the applicant is unable to write, his mark as affixed to the application must be attested to by a witness. In the case of the oath, the notary's signature to the jurat is sufficient to authenticate the mark.

605.04 (e) May Use Title With Signature

It is permissible for an applicant to use a title of nobility or other title, such as "Dr.," in connection with his signature. The title will not appear in the printed patent.

605.04 (f) Signature on Joint Applications—Order of Names

It is not essential that the names appear in the same order in the signatures to the petition, specification, oath, and drawing.

In joint applications, where the single signature form is used, the signatures thereto should be in the same order as the typewritten names. Where the single signature form is not used, the signatures to the application should be in the same order as the typewritten names in the body of the papers. The order of names of joint patentees in the heading of the patent is taken from the order in which the typewritten names first appear in the application papers. Care should be exercised in selecting the order of typewritten names before filing, as requests for subsequent shifting of the names would entail

changing numerous records in the Office. Since the particular order in which the names appear is of no consequence insofar as the legal rights of the joint applicants are concerned, no changes will be made except by permission of the Commissioner. It is suggested, at the time of filing, that the names of joint applicants appear in alphabetical order for facilitating filing and record keeping in the Office. (Notice of April 4, 1952, Revised.)

605.04 (g) When Name Is Corrected, Send to Application Branch

When the name is corrected by amendment, the file should be sent to the Application Branch for correction of the name in its record. When the name is changed, see 605.04 (c).

605.04 (h) Signature to Drawing

Rule 82. Signature to drawing. Signatures are not required on the drawing if it accompanies and is referred to in the other papers of the application, otherwise the drawing must be signed. The drawing may be signed by the applicant in person or have the name of the applicant placed thereon followed by the signature of the attorney or agent as such.

Extract from Rule 81, Drawings. (h) *Location of signature and names.* The signature of the applicant, or the name of the applicant and signature of the attorney or agent, may be placed in the lower right-hand corner of each sheet within the marginal line, or may be placed below the lower marginal line.

The Rules now permit (a) the drawing to be signed as in the past, (b) to be signed as in the past but below the lower marginal line, or (c) no signature on the drawing provided it accompanies and is referred to in the other papers of a new application.

The signature when placed on the drawing should never cross the marginal line. The full first name of the inventor is not required on the drawing. Drawings filed without the inventor's name thereon, will have the name applied in pencil by the Mail Branch.

The drawing is not signed by both applicant and attorney. When the drawing is signed by the inventor in person the name of the attorney is not permitted to appear thereon.

The drawing may be signed by the applicant, attorney, or agent in person after the drawing has been filed. The signature need not be dated. Prohibition against changing name of the attorney on drawing is discussed at 608.02 (u). For return of drawing to applicant for signature see 608.02 (y).

The name or signature of the inventor must be identified as such by an appropriate legend.

Each sheet must be signed when the signature is necessary. The printed name of the inventor without a signature is also acceptable and may appear only on the first sheet.

605.05 Administrator, Executor, or Other Legal Representative

In an application filed by a legal representative of the inventor, the specification should not be written in the first person. Instead of the usual "I have found," the wording should be "it was found."

For prosecution by administrator or executor, see 409.01 (a).

For prosecution by heirs, see 409.01 (a) and 409.01 (d).

For prosecution by representative of legally incapacitated inventor, see 409.02.

For prosecution by other than inventor, see 409.03.

605.05 (a) Signature of Legal Representative

If the drawing is signed by the legal representative it must follow this form:

John A. Jones, deceased,
by Mary A. Jones, Administratrix.

The other signatures must either be in the above form or:

Mary A. Jones
Administratrix of Estate of
John A. Jones, deceased.

If the drawing is signed by the attorney, this form must be used:

John A. Jones, deceased,
by Mary A. Jones, Administratrix,
by William A. Smith, Atty.

If the specification bears the *signature* of the administrator or executor but omits the matter, "administrator of the Estate of John Jones, deceased," the matter can be added by amendment. The Examiner may make the amendment if the case is otherwise ready for issue.

605.06 Filing by Other Than Inventor

See 409.03.

606 Title of Invention

Rule 72. Title of the invention. The title of the invention, which should be as short and specific as possible, should appear as a heading on the first page of the specification, if it does not otherwise appear in the beginning of the application.

Despite the statement in the Rule, the Examiner should not require that the title be placed at this particular location.

The title of the invention should be in the singular as this is the way it will appear on the face of the file and in the patent. Even though applicant should use a plural title, this Office will employ the title in the singular.

606.01 Examiner May Require Change in Title

Where the title is not descriptive of the invention claimed, the Examiner should require the substitution of a new title that is clearly indicative of the invention to which the claims are directed. This may result in slightly longer titles, but the loss in brevity of title will be more than offset by the gain in its informative value in indexing, classifying, searching, etc. If a satisfactory title is not supplied by the applicant, the Examiner may change the title by Examiner's Amendment on or after allowance. (Extract Notice of July 1, 1946.)

If a change in title is the only change being made by the Examiner at the time of allowance a separate Examiner's Amendment need not be prepared. The change in title will be incorporated in the Notice of Allowance. This will be accomplished by adding the typewritten notation in capital letters "AS AMENDED BY EXAMINER" following the heading "Title of Invention or Improvement" and entering thereunder the title as changed by the examiner.

The Primary Examiner or the assistant examiner making the change must initial any Notice of Allowance containing a change in the title of invention.

The Notice of Allowance containing a change of title will be authority for the clerk to make the change indicated.

However, if an Examiner's Amendment must be prepared for other reasons any change in title will be incorporated therein. (Notice of May 23, 1950.)

607 Filing Fee

While a filing fee, except in certain applications in which the Government has an interest, is a *sine qua non* part of the complete application, it seldom presents any question requiring the attention of the Examiner. The requisite fee must be paid before the application is given a filing date, and hence before it is sent to the examining division, Rule 22. Fees are listed in Rule 21.

No additional filing fee is receivable after the filing date. If claims in excess of the number corresponding to the filing fee are presented before the first official action, see 714.10.

607.01 Fee Exempt

There are two types of Fee Exempt applications: (a) those filed under 35 U. S. C. 266

and (b) those filed under a ruling of the Comptroller General's Opinion B-111, 648:

FILED UNDER U. S. C. 266

35 U. S. C. 266. *Issue of patents without fees to Government employees.* The Commissioner may grant, subject to the provisions of this title, to any officer, enlisted man, or employee of the Government, except officers and employees of the Patent Office, a patent without the payment of fees, when the head of a department or agency certifies the invention is used or likely to be used in the public interest and the applicant in his application states that the invention described therein, if patented, may be manufactured and used by or for the Government for governmental purposes without the payment to him of any royalty thereon; which stipulation shall be included in the patent. (Based on Act Mar. 3, 1883, amended Apr. 30, 1928.)

In revising such applications for issue, the specification should be checked to assure the presence of the substance of the following statement therein:

"The invention described herein may be manufactured and used by or for the Government for governmental purposes without the payment of any royalty thereon."

If the substance of such a statement does not appear in the specification, but is present elsewhere in the record, the same should be entered, by Examiner's Amendment, as the first paragraph of the specification.

If the substance of this statement is not present at any point in the record of the application, an action should be made requiring such statement, signed by the applicant, and an amendment directing insertion of same as the first paragraph of the specification. A shortened statutory period for response should be set and the application withheld from issue until such response has been made. (Notice of June 6, 1949, Revised.)

FILED UNDER COMPTROLLER GENERAL'S OPINION

For these applications to be fee exempt, the inventor does not have to be a Government employee but there must be an assignment giving the Government the entire right, title and interest in the application without any reversionary clause and/or condition which is less than the entire ownership for the full term of the patent.

If an application is received in the Examining Division that is filed under Comptroller General's Opinion B-111,648 but does not have the assignment to the Government endorsed thereon, it should not be examined until the application is so assigned.

607.01 (a) Inventor Leaves Service of United States

An opinion of the Attorney General, dated January 14, 1936, rules that an application filed under the Act of 1883, as amended, now 35 U. S. C. 266, which meets the requirements of this statute as to the status of the inventor at the time of filing, is sufficient warrant for the issuance of a patent to the inventor if the invention claimed therein is found patentable, whether or not he is in the service of the United States at the time the patent issues.

607.01 (b) Fee Exempt Changed to Fee Filed

Where an application is filed under 35 U. S. C. 266, the regular filing fee can be subsequently paid and proper amendment made by the inventor, concurred in by the Head of the Department concerned, cancelling the offer of dedication, the fee being entered on the file and the original date of the application retained.

607.01 (c) Fee Filed Changed to Fee Exempt

An application for which a filing fee has been paid may issue under 35 U. S. C. 266 if the applicant qualifies under this section, and files the required dedication by amendment signed by the inventor and certified by the Head of the Department. In such case the docket clerk of the division will forward the application to the Application Branch for appropriate amendment of the file wrapper and of the record in the Application Branch. (Notice of August 10, 1938, Revised.)

607.02 Returnability of Fees

All questions pertaining to the return of fees will be referred to the Financial Division. Examiners and Chiefs of other divisions will express no opinion to attorneys or applicants as to whether or not fees are returnable in particular cases. (Notice of Oct. 11, 1937.)

608 Disclosure

In return for a patent, the inventor gives as consideration a complete revelation or disclosure of the invention for which he seeks protection. All amendments or claims must find basis in the original disclosure, or they involve new matter. Applicant may rely for disclosure upon the specification with original claims and drawings, all as filed complete. See Rule 118, 608.04.

608.01 Specification

Rule 71. Detailed description and specification of the invention. (a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms 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 and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode devised by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

Certain cross notes to other related applications may be made. Rule 78, 202.01.

Rule 52. Language, paper, writing, margins. (a) The petition, specification, and oath must be in the English language. All papers which are to become a part of the permanent records of the Patent Office must be legibly written or printed in permanent ink.

(b) The specification and claims, and also papers subsequently filed, must be plainly written on but one side of the paper. A wide margin must be reserved on the left-hand side and on the top of each page and the lines must not be crowded too closely together. Legal paper, 8 to 8½ by 12½ to 13 inches, typewritten and double spaced with margins of one and one-half inches on the left-hand side and top is deemed preferable. Typewritten or printed papers suitable for use by the Office may be required if the papers originally filed are not correctly, legibly and clearly written.

(c) Any interlineation, erasure or cancelation or other alteration made before the application was signed and sworn to should be clearly referred to in a marginal note or footnote on the same sheet of paper, and initialed or signed and dated by the applicant to indicate such fact. (See Rule 56.)

In order that specifications may be expeditiously handled by the Office, page numbers should be placed at the center of the bottom of each page. A top margin of at least 1½ inches should be reserved on each page to prevent possible mutilation

of text when the papers are punched for insertion in a file jacket. (Notice of March 8, 1950.)

Typed, mimeographed, or multigraphed papers are acceptable. A good carbon copy is acceptable.

As stated in Rule 52 the specification as well as petition and oath must be in the English language.

The specification is sometimes in such faulty English that a new specification is necessary, but new specifications encumber the record and require additional reading, and hence should not be required or accepted except in extreme cases.

The requirement that the specification must be in the English language is not satisfied by the filing of a signed specification in a foreign language together with a sworn translation thereof. In re Incomplete Application 659 O. G. 917.

The specification does not require a date.

If a newly filed application obviously fails to disclose an invention with the clarity required by 35 U. S. C. 112, revision of the application should immediately be required. See 702.01.

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 requests insertions, cancellations, or alterations, giving the page and the line.

608.01 (a) Parts of Specification

Rule 77. Arrangement of specification. The following order of arrangement should be observed in framing the specification:

- (a) Title of the invention; or a preamble stating the name, citizenship and residence of the applicant and the title of the invention may be used.
- (b) Brief summary of the invention.
- (c) Brief description of the several views of the drawing, if there are drawings.
- (d) Detailed description.
- (e) Claim or claims.
- (f) Signature (see rule 76).

The term specification as used herein includes the descriptive portion of the application and the claims. "Specification" is sometimes used to denote the descriptive portion without the claims.

NOTE

Design patent specification, 1503.01.
Plant patent specification, 1601.5.
Reissue patent specification, 1401.06.

608.01 (b) Preamble

The preamble of the specification is simply the introductory portion stating applicant's name, citizenship, residence, and the title of the invention.

608.01 (c) Preamble May Be Omitted

Since the preamble is not printed in the patent, its omission by applicant from the specification is permissible. The oath or single signature form supplies the data as to name, citizenship, etc., of which a specification preamble is composed.

608.01 (d) Brief Summary of Invention

Rule 73. Summary of the invention. A brief summary of the invention indicating its nature and substance, which may include a statement of the object of the invention, should precede the detailed description. Such summary should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed.

Since the purpose of the brief summary of invention is to apprise the public, and more especially those interested in the particular art to which the invention relates, of the nature of the invention, the summary should be directed to the specific invention being claimed, in contradistinction to mere generalities which would be equally applicable to numerous preceding patents. That is, the subject matter of the invention should be described in one or more clear, concise sentences or paragraphs. Stereotyped general statements that would fit one case as well as another serve no useful purpose and may well be required to be canceled as surplusage, and, in the absence of any illuminating statement, replaced by statements that are directly in point as applicable exclusively to the case in hand.

The brief summary, if properly written to set out the exact nature, operation and purpose of the invention will be of material assistance in aiding ready understanding of the patent in future searches. See 905.04. The brief summary should be more than a mere statement of the objects of the invention, which statement is also permissible under Rule 73.

The brief summary of invention should be consistent with the subject matter of the claims. Note final review of application and preparation for issue, 1302.

608.01 (e) Reservation Clauses Not Permitted

Rule 79. Reservation clauses not permitted. A reservation for a future application of subject matter disclosed but not claimed in a pending application will not be permitted in the pending application, but an application disclosing unclaimed subject matter may contain a reference to a later filed application of the same applicant or owned by a common assignee disclosing and claiming that subject matter.

608.01 (f) Brief Description of Drawings

Rule 74. Reference to drawings. When there are drawings, there shall be a brief description of the several views of the drawings and the detailed description of the invention shall refer to the different views by specifying the numbers of the figures, and to the different parts by use of reference letters or numerals (preferably the latter).

The Examiner should see to it that the figures are correctly described in the brief description of the drawing, that all section lines used are referred to, and that all needed section lines are used.

608.01 (g) Detailed Description of Invention

A detailed description of the invention and drawings follows the general statement of invention and brief description of the drawings. This detailed description, required by Rule 71, 608.01, must be in such particularity as to enable any person skilled in the pertinent art or science to make and use the invention without involving extensive experimentation. An applicant is ordinarily permitted to use his own terminology, as long as it can be understood. Necessary grammatical corrections, however, should be required by the Examiner, but it must be remembered that an examination is not made for the purpose of securing grammatical perfection.

The reference characters must be properly applied, no single reference character being used for two different parts or for a given part and a modification of such part. In the latter case, the reference character, applied to the "given part," with a prime affixed may advantageously be applied to the modification. Every feature specified in the claims must be illustrated, but there should be no superfluous illustrations.

The description is a dictionary for the claims and should provide clear support or antecedent

basis for all terms used in the claims. See Rule 75 in 608.01 (i), 608.01 (o), and 1302.01.

NOTE.—Completeness 608.01 (p).

608.01 (h) Mode of Operation of Invention

The best mode devised by the inventor of carrying out his invention must be set forth in the description. Current practice is to accept an operative example as sufficient to meet this requirement.

In chemical cases, complete data necessary for the preparation and use of at least one example of the invention should be presented.

NOTE.—Completeness 608.01 (p).

608.01 (i) Claims

Rule 75. Claim. (a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

(b) More than one claim may be presented, provided they differ substantially from each other and are not unduly multiplied.

(c) When more than one claim is presented, they may be placed in dependent form in which a claim may refer back to and further restrict a single preceding claim.

(d) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.

See rules 141 to 147 as to claiming different inventions in one application.

NOTE

Numbering of Claims, 608.01 (j).

Form of Claims, 608.01 (m).

Dependent claims, 608.01 (n).

Examination of claims, 706.

Claims in excess of fee, 714.10.

608.01 (j) Numbering of Claims

Rule 126. Numbering of claims. The original numbering of the claims must be preserved throughout the prosecution. When claims are cancelled, the remaining claims must not be renumbered. When claims are added by amendment or substituted for canceled claims, they must be numbered by the applicant consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not). When the application is ready for allowance, the examiner, if necessary, will renumber the claims consecutively in the order in

which they appear or in such order as may have been requested by applicant.

608.01 (k) Statutory Requirement of Claims

Sec. 35 U. S. C. 112 requires that the applicant shall particularly point out and distinctly claim the subject matter which he regards as his invention. The portion of the application in which he does this forms the claim or claims. This is an important part of the application, as it is the definition of that for which protection is granted.

608.01 (l) Original Claims

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.

Where subject matter not shown in the drawing or described in the specification is claimed in the case as filed, and such original claim itself constitutes a clear disclosure of this subject matter, then the claim should be treated on its merits, and requirement made to amend the drawing and specification to show this subject matter. The claim should not be attacked either by objection or rejection because this subject matter is lacking in the drawing and specification. It is the drawing and specification that are defective; not the claim.

It is of course to be understood that this disclosure in the claim must be sufficiently specific and detailed to support the necessary amendment of the drawing and specification.

608.01 (m) Form of Claims

While there is no set statutory form for claims, the present Office practice is to insist that each claim must be the object of a sentence starting with "I (or we) claim" whether or not the words "I (or we) claim" are stated. The claim begins with a capital letter and ends with a period. Periods may not be used elsewhere in the claim except for abbreviations.

See Rejections not based on Prior Art 706.03.

608.01 (n) Dependent Claims

Rule 75 (c), permitting dependent claims, reads as follows:

When more than one claim is presented, they may be placed in dependent form in which a claim may refer back to and further restrict a single preceding claim.

For example, claim 2, a dependent claim, could read as follows:

2. The product of claim 1 in which . . .

A dependent claim cannot directly refer back to two or more preceding claims. For example, a claim reading as follows:

7. A machine as specified in claims 5 or 6 (or, 5 and 6) in which . . .

is not permitted. Such a claim disguises the true number of claims, since it is in reality two claims. It is also alternative.

However, a dependent claim may refer to a preceding claim, which in turn refers to another preceding claim, thus a series of dependent claims as follows:

2. The machine of claim 1 in which . . .

3. The machine of claim 2 in which . . .

etc.

is permitted.

There may be several series of dependent claims in a single application. All the claims in each series of dependent claims (i. e., those in addition to the base or independent claim) must either be in immediate consecutive order or as close thereto as is physically possible. In other words, it is permissible to have dependent claims which are dependent on the same dependent claim and are separated therefrom only by each other. (Notice of December 9, 1946, and Memorandum of July 16, 1951, revised.)

A dependent claim, which is otherwise allowable, should not be rejected merely because the basic claim is rejected. See 707.07 (j).

When renumbering of the claims is necessary, in compliance with Rule 126, particular attention should be given to dependent claims to see that each dependent claim correctly identifies the claim upon which it is built.

608.01 (o) Basis for Claim Terminology in Description

The meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import, and in mechanical cases it should be identified in the descriptive portion of the specification by reference to the drawing, designating the part or parts therein to which the term applies. A term used in the claims may be given a special meaning in the description. No term may be given a meaning repugnant to the usual meaning of the term.

Usually the terminology of the original claims follows the nomenclature of the specification, but sometimes in amending the claims or in adding new claims, new terms are introduced that do not appear in the specification. The use of a confusing variety of terms for the same thing should not be permitted.

New claims and amendments to the claims already in the case should be scrutinized not only for new matter but also for new terminology. While an applicant is not limited to the nomenclature used in the application as filed, yet whenever by amendment of his claims, he departs therefrom, he should make appropriate amendment of his specification so as to have therein clear support or antecedent basis for the new terms appearing in the claims. This is necessary in order to insure certainty in construing the claims in the light of the specification. *Ex parte Kotler* 1901 C. D. 62; 95 O. G. 2684. See Rule 75, 608.01 (i) and 1302.01.

608.01 (p) Completeness

Newly filed applications obviously failing to disclose an invention with the clarity required are discussed in 702.01.

A disclosure in an application, to be complete, must contain such description and details as to enable any person skilled in the art or science to which the invention pertains to make and use the invention.

While the prior art setting may be mentioned in general terms, the essential novelty, the essence of the invention, must be described in such details, including proportions and techniques where necessary, as to enable those persons skilled in the art to make and utilize the invention.

Specific operative embodiments or examples of the invention must be set forth. Examples and description should be of sufficient scope as to justify the scope of the claims. Markush claims must be provided with support in the disclosure for each member of the Markush group. Where the constitution and formula of a chemical compound is stated only as a probability or speculation, the disclosure is not sufficient to support claims identifying the compound by such composition or formula.

A complete disclosure should include a statement of utility. This usually presents no problem in mechanical cases. In chemical cases, varying degrees of specificity are required.

A disclosure involving a new chemical compound or composition must teach persons skilled in the art how to make the compound or composition. Incomplete teachings may not be completed by reference to subsequently filed applications. If the starting material is old but difficult to locate in the literature, the literature citation should be incorporated into the specification. This may be done by amendment. In the application as filed, preparation of a new chemical starting material may be

described generally along with reference to a concurrently or previously filed application by the same inventor wherein the detailed preparation is given. If a concurrently or previously filed application of the same inventor adequately discloses the preparation of the starting material, amendments to include reference to such application by serial number and a general method of preparation are proper.

Reliance upon a copending application by a different inventor may not be made for the purpose of completing the disclosure.

All essential features of an invention must be fully disclosed in the application without depending upon a reference to a copending application for completing the disclosure.

Since a disclosure must be complete as of the filing date, subsequent publications or subsequently filed applications cannot be relied upon to establish a constructive reduction to practice.

NOTE.—Trade-marks and trade names 608.01 (v).

608.01 (q) Substitute or Rewritten Specification

Rule 125. Substitute specification. If the number or nature of the amendments shall render it difficult to consider the case, or to arrange the papers for printing or copying, the examiner may require the entire specification or claims, or any part thereof, to be rewritten. A substitute specification will ordinarily not be accepted unless it has been required by the examiner.

The specification is sometimes in such faulty English that a new specification is necessary, but new specifications cumber the record and require additional reading, and hence should not be required or accepted except in extreme cases.

A substitute specification that has not been required, and is not needed, is not entered. See 714.20.

New matter in amendment, see 608.04.

Application prepared for issue, see 1302.02.

608.01 (r) Derogatory Remarks About Prior Art in Specification

The applicant may refer to the general state of the art and the advance thereover made by his invention, but he is not permitted to make derogatory remarks concerning the inventions of others, or to designate them by name unless to state that he desires to improve on the disclosure in a prior patent or in an application of common ownership or that he makes no claim to the disclosure in a certain application of common ownership.

608.01 (s) Restoration of Canceled Matter

Canceled text in the specification or a canceled claim can be restored only by filing a duplicate thereof. See Rule 124, 714.24.

608.01 (t) Use of Disclosure in Subsequent Application

A reservation for a future application of subject matter disclosed but not claimed in a pending application will not be permitted in the pending application. Rule 79, 608.01 (e).

While a specification cannot be transferred to another application, drawings may be transferred from a prior application to a later case by the same inventor, note 608.02 (i) to 608.02 (l).

608.01 (u) Use of Formerly Filed Incomplete Application

Parts of an incomplete application may be used as part of a complete application if the missing parts are later supplied. See 506 and 506.01.

608.01 (v) Trade-Marks and Names Used in Trade

The expressions "trade-marks" and "names used in trade" as used below have the following meanings:

Trade-Mark: a word, letter, symbol or device adopted by one manufacturer or merchant and used to identify and distinguish his product from those of others. It is a proprietary word pointing distinctly to the product of one producer.

Names Used in Trade: a nonproprietary name by which an article or product is known and called among traders or workers in the art, although it may not be so known by the public generally. Names used in trade do not point to the product of one producer, but they identify a single article or product irrespective of producer.

Names used in trade are permissible in patent applications if:

- (1) Their meanings are established by an accompanying definition which is sufficiently precise and definite to be made a part of a claim, or
- (2) In this country, their meanings are well known and satisfactorily defined in the literature.

Condition (1) or (2) must be met at the time of filing of the complete application.

The relationship between a trade-mark and the product it identifies is sometimes indefinite, uncertain and arbitrary. The formula or characteristics of the product may change from time to time and yet it may continue to be sold under the same trade-mark. In patent specifications, every element or ingredient of the product should be set forth in positive, exact, intelligible language, so that there will be no uncertainty as to what is meant. Arbitrary trade-marks which are liable to mean different things at the pleasure of manufacturers do not constitute such language.

However, if the product to which the trade-mark refers is otherwise set forth in such language that its identity is clear the Examiners are authorized to permit the use of the trade-mark if it is distinguished from common descriptive nouns, as by capitalization and/or quotation marks. If the trade-mark has a fixed and definite meaning it constitutes sufficient identification unless some physical or chemical characteristic of the article or material is involved in the invention. In that event as also in those cases where the trade-mark has no fixed and definite meaning, identification by scientific or other explanatory language is necessary.

Where the identification of a trade-mark is introduced by amendment it must be restricted to the characteristics of the product known at the time the application was filed to avoid any question of new matter. (Notice of November 18, 1947.)

If proper identification of the product sold under a trade-mark, or of a product referred to only by a name used in trade, is omitted from the specification and such identification is deemed necessary under the principles set forth above, the Examiner should hold the disclosure insufficient and reject on the ground of insufficient disclosure any claims based on the identification of the product merely by trade-mark or by the name used in trade. If the product cannot be otherwise defined, an amendment defining the process of its manufacture may be permitted. Such amendments must be supported by satisfactory showings establishing that the specific nature or process of manufacture of the product as set forth in the amendment was known at the time of filing of the application.

Although the use of trade-marks having definite meanings is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trade-marks. The Examiner should not permit the use of language such as "the product X (a descriptive name) commonly known as Y (Trade Mark)" since such language does not bring out the fact that the latter is a trade-mark. Language such as "the product X (a descriptive name) sold under the trade-mark Y" is permissible.

608.02 Drawing

Rule 81. Drawings required. The applicant for patent is required by statute to furnish a drawing of his invention whenever the nature of the case admits of it; this drawing must be filed with the application. Illustrations facilitating an understanding of the invention (for example, flow sheets in cases of processes, and diagrammatic views) may also be furnished in the same manner as drawings, and may be required by the Office when considered necessary or desirable.

Rule 86. Draftsman to make drawings. Applicants are advised to employ competent draftsmen to make their drawings.

The Office may furnish the drawings at the applicant's expense as promptly as its draftsmen can make them, for applicants who can not otherwise conveniently procure them. (See rule 21.)

NOTE

Standards for drawings, Rule 84.

A booklet "Guide for Patent Draftsmen" is available from the Superintendent of Documents, U. S. Government Printing Office, Washington 25, D. C., Price 15 cents.

Design patent drawings, Rule 152, 1503.02.

Plant patent drawings, Rule 165.

Reissue application drawings, 608.02 (k).

Signature to drawing, 605.04 (h).

The back of each sheet of drawing must bear the stamp of the draftsman before the application is allowed.

The Patent Copy Sales Branch, Reproduction Section has charge of the drawings in patented cases. Canceled sheets, however, are not retained with the patented drawings but are filed with the abandoned files and drawings in the Abandoned Files Unit.

See: Correction of drawings, 608.02 (p). Prints, preparation and distribution, 508, 608.02 (m). Prints, Return of drawing, 608.02 (y).

608.02 (a) New Drawing—When Required

The Chief Draftsman is the judge of drawings, as to the execution of the same, and the arrangement of the views thereon, while the Examiner is the judge as to the sufficiency of the showing. The drawings, upon receipt of an application, are sent from the Application Branch to be inspected by the Chief Draftsman. If satisfactory, he stamps on the back of each sheet "Approved, Draftsman, U. S. Patent Office" together with the date.

If the drawings are informal, but may be admitted for examination purposes the Draftsman writes in lead pencil in the margin of the

drawing "Inf. A. F. E." (admit for examination) together with his criticism and if the drawings can be corrected he adds the words "can be corrected." On all informal drawings that cannot be freed from objection he notes the words "New drawings required." The drawings are then returned to the Application Branch.

If the drawing is endorsed "Inf. A. F. E." it is accepted as satisfying the requirement of Rule 51.

The Examiners are directed to advise the applicants in the first Office action of the conditions which render the drawing informal, and when indicated, that such drawings can be corrected so as to be acceptable, but will not, in any case, require new drawings because of their execution unless the necessity therefor shall have been indicated by the Chief of the Drafting Branch. (Extract from Order No. 1764.) See 707.07 (c).

The Examiner may require additional drawings for the purpose of illustrating the disclosure.

When a necessary additional illustration is small and may be added to the drawings on file, an additional sheet of drawing should not be required, but the Examiner will ask that the proposed illustration be shown in a sketch, which showing will be transferred to one of the sheets of the drawings (Extract from Order No. 1862).

For the handling of additional, duplicate, or substitute drawings, see 608.02 (h).

608.02 (b) Informal Drawings

Rule 85. Informal drawings. The requirements of Rule 84 relating to drawings will be strictly enforced. A drawing not executed in conformity thereto may be admitted for purpose of examination, but in such case the drawing must be corrected or a new one furnished, as required. The necessary corrections will be made by the Office upon applicant's request and at his expense. (See Rule 21.)

If the drawing is such that the prosecution of the application can be properly carried on without the corrections being made, the Examiner should inform the applicant that the corrections need not be made until patentable subject matter is found in the application. Even where appeal is taken, if no claim has been allowed, correction of the drawing will not be insisted on.

608.02 (c) Drawings or Print Always Kept in Examining Division

The photographic copies of the drawings must always be kept on top of the papers on the right of

the file wrapper so as to be visible upon opening the wrapper and easily detached.

Whenever the original drawing is taken from the examining division, the photographic copy must be taken from the application file and placed in the cabinet of drawings in lieu of the original drawing. When the original drawing is returned to the examining division and placed in the cabinet, the photographic copy must be replaced in the file.

This procedure is to make certain that either the original drawing or the photographic copy (print) is always available for interference searches.

Immediately upon the receipt of the hard copies of patents issued by the examining division, the docket clerk should have the prints pulled, marked in the upper left hand corner with the patent number and sent to the Issue and Gazette Branch.

If there is no copy of the drawing in the file, a dummy must be placed in the cabinet of drawings in lieu of the original drawing whenever the latter is removed from the examining division.

No application should be sent to issue or to abandoned files unless the original drawing is checked up and found in the division. (Order No. 3104, Revised, and Memorandum of Sept. 23, 1952.)

608.02 (d) Complete Illustration in Drawings

Rule 83. Content of drawing. The drawing must show every feature of the invention specified in the claims. When the invention consists of an improvement on an old machine the drawing must when possible exhibit, in one or more views, the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

Likewise, any structural detail that is of sufficient importance to be described should be shown in the drawing. (Ex parte Good, 1911 C. D. 43; 164 O. G. 739.)

608.02 (e) Examiner Determines Completeness of Drawings

The Examiner should see to it that the figures are correctly described in the brief description of the specification and that the reference characters are properly applied, no single reference character being used for two different parts or for a given part and a modification of such part. Every feature covered by the claims must be illustrated, but there should be no superfluous illustrations.

608.02 (f) Modifications in Drawings

Modifications may not be shown in broken

lines on figures which show in solid lines another form of the invention. (Ex parte Badger, 1901 C. D. 195; 97 O. G. 1596.)

All modifications described must be illustrated, or the text canceled. (Ex parte Peck, 1901 C. D. 136; 96 O. G. 2409.) This requirement does not apply to a mere reference to minor variations nor to well-known and conventional parts.

608.02 (g) Illustration of Prior Art

Figures showing the prior art are usually unnecessary and should be canceled. Ex parte Elliott 1904 C. D. 103; 109 O. G. 1337. However, where needed to understand applicant's invention, they may be retained if designated by a legend such as "Prior Art."

608.02 (h) Additional, Duplicate or Substitute Drawings

When an amendment is filed stating that at the same time substitute or additional sheets of drawings are filed and such drawings have not been transmitted to the examining division, the docket clerk in the examining division should call the Application Branch before entering the amendment to ascertain if the drawing was not received. In the next communication of the Examiner the applicant is notified if the drawings have not been received. (Notice of March 24, 1919, Revised.)

To avoid accumulation of canceled sheets of drawings, the Examiners will not admit an additional or substitute drawing, unless the necessities of the case so require. If the Examiner considers an additional or substitute sheet of drawing necessary it must be submitted to the Chief Draftsman before entering it in the case.

If an additional sheet of drawing is considered unnecessary and the original drawing requires alterations which are taken care of in the proffered additional sheet, the latter may be used in lieu of the usual sketch required in making the correction of the original drawing.

For return of drawing, see 608.02 (y).

608.02 (i) Transfer of Drawings From Prior Applications

Rule 88. Use of old drawings. If the drawings of a new application are to be identical with the drawings of a previous application of the applicant on file in the Office, or with part of such drawings, the old drawings or any sheets thereof may be used if the prior application is, or is about to be, abandoned, or if the sheets to be used are cancelled in the prior applica-

tion. The new application must be accompanied by a letter requesting the transfer of the drawings, which should be completely identified.

Formal transfer of drawings from one application to another is made only by the Application Branch. The name of the attorney on the drawing being transferred is not changed, 608.02 (u).

When an application becomes a patent, any canceled sheet of drawing then in the case is sent to the abandoned files. Such canceled sheet is available for applicant's use in another application directed to its subject matter.

608.02 (j) Transfer of Canceled Sheets of Drawings to Divisional Application

In the case of a divisional application, if the drawing and descriptive matter pertaining thereto have been canceled from the parent case, the canceled sheet or sheets of drawing may be withdrawn and used as the original drawing of the divisional case.

608.02 (k) Transfer of Drawings to Reissue

Extract from Rule 174. The drawings upon which the original patent was issued may be used in reissue applications if no changes whatsoever are to be made in the drawings. In such cases, when the reissue application is filed, the applicant must submit a temporary drawing which may consist of a copy of the printed drawings of the patent or a photoprint of the original drawings securely mounted by pasting on sheets of drawing board of the size required for original drawing, or an order for the same.

In a reissue application, the prints of the original or patented drawing may be used for examination purposes, and the formal transfer of the original drawing to the reissue application made when the reissue application is ready for issue, *provided* no change whatever, even so much as the priming of a reference character, or correction of an obvious error, is made in the drawing. If there is to be any change whatsoever in the drawing, a new drawing for the reissue must be filed.

If there is more than one sheet of original drawing, a required change on any sheet will preclude the use of the original drawings which must be kept in the condition existing at the time of issue of the original patent. See 1401.05.

Transfer of the drawing is made by the Application Branch, notation thereof being entered on the file wrapper of the original application.

608.02 (l) Transfer of Drawings to Continuation or Substitute

When a substitute, continuation or continuation-in-part application is filed, the drawing in the parent case may be transferred and used as the original drawing in the later case subject to the provisions of Rule 88. The Application Branch will not effect the transfer until the later case is otherwise in condition to receive a filing date. A letter including the following statement should be written:

"In view of the transfer on _____ of the drawings from this application to application Serial No. _____ pursuant to applicant's request and his stated intention therein to abandon the instant application, this application is considered abandoned as of said date and is being forwarded to the Abandoned Files Unit." (Extract from Notice of May 16, 1955.)

608.02 (m) Prints

Preparation and distribution of prints is discussed in 508.

Photographic prints are made of the drawings of an acceptable application. Prints of the drawings as filed are entered in the application, given a paper number and kept on top of the papers on the right side of the file wrapper, see 717.01 (b).

All prints and inked sketches subsequently filed to be part of the record are endorsed with the date of their receipt in the office and given their appropriate paper number.

The print being thus an official paper in the record should not be marked or in any way altered. Where, as in an electrical wiring case, it is desirable, to identify the various circuits by different colors, or in any more or less complex case, it is advantageous to apply legends, arrows or other indicia, an additional print for such use should be ordered by the Examiner and placed unofficially in the file.

Prints remain in the file at all times except as provided in 608.02 (c).

608.02 (n) Duplicate Prints in Patentability Report Cases

In Patentability Report cases having drawings, the Examiner to whom the case is assigned will obtain a duplicate set of prints of the drawing for filing in the division to which the case is referred.

When a case that has had Patentability Report prosecution is passed for issue or becomes abandoned, notification of this fact will at once be given by the division having jurisdiction of the case to each division that submitted a P. R. The Examiner

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of each such reporting division will note the date of allowance or abandonment on his duplicate set of prints. At such time as these prints become of no value to the reporting division, they may be destroyed. (Extract of Notice of November 10, 1948.)

608.02 (o) Dates Entered on Drawing

Dates are entered by the Office upon the back of each sheet of drawing.

The earliest date is that of the Mail Branch, regardless of whether or not the drawing was submitted by mail.

If and when the drawing is approved by the Draftsman, and before the case is passed to issue, each uncanceled sheet of drawing must bear a date of the Draftsman.

The Examining Division receipt date is applied by the clerk of the Examining Division.

Dates of correction of the drawing are stamped and noted by the Draftsman upon the back of the drawing.

608.02 (p) Correction of Drawings

Rule 123. Amendments to the drawing. (a) No change in the drawing may be made except by permission of the Office. Permissible changes in the construction shown in any drawing may be made only by the Office. A sketch in permanent ink showing proposed changes, to become part of the record, must be filed. The paper requesting amendments to the drawing should be separate from other papers. The drawing may not be withdrawn from the Office except for signature.

(b) Substitute drawings will not ordinarily be admitted in any case unless required by the Office.

NOTE.—Correction is deferrable, see 608.02 (b), correction at allowance and issue, see 608.02 (w) and 1302.05.

608.02 (q) Conditions Precedent to Amendment of Drawing

Correction and alterations in the disclosure of the drawings of a pending application may be made only under the supervision of, or by the Chief Draftsman.

No alterations as above indicated will be permitted unless required by an Examiner's letter in each case, or proposed in writing by applicant or his attorney. In either case the alterations or corrections as indicated in the sketches filed after the requirement by the Examiner, or with the request of the applicant or his attorney receive the written approval of the Examiner before the case is sent to the Chief Draftsman. (Extract from Order No. 1958, Revised.)

NOTE.—Disposition of Orders for Amendment of Drawing, 608.02 (x).

608.02 (r) Separate Letter to Draftsman

Any request by the applicant for amendment of the drawing to cure defects must be embodied in a *separate* letter for the Chief Draftsman. Otherwise the case, unless in other respects ready for issue, will not be forwarded by the Examiner to the Drafting Branch, and applicant will be so advised in the next action by the Examiner. (Extract from Order No. 4009.)

NOTE.—Changes which may require sketches, 608.02 (v).

608.02 (s) Estimating Cost of Correcting Drawings

Files and drawings sent from the Examining Division to the Draftsman for estimating the cost of correcting the drawing or of making new drawings will be retained by the Draftsman only long enough to estimate the cost of the work.

If the Examiner approves of a proposed correction of a drawing for which an estimate is requested he will note his approval on the order for the estimate, attach the order to the outside of the file and have the Docket Clerk of the Division forward the file and drawing to the Draftsman. The Draftsman will note the estimate on the order and also on the drawing. If the application is not up for action the Draftsman sends the estimate to the Applicant. If the application is up for action the Draftsman does not send an estimate, but the Examiner should include the estimate in the next action.

After stating the estimate the following paragraph should be added in the Examiner's letter:

When corrections are made, prints of the corrected sheets should be ordered to ascertain whether the changes made are correct. (Notice of July 13, 1906, Revised.)

When giving an estimate in a case where no allowable subject matter has been found the Examiner should inform the applicant that no correction will be made until a claim is found to be allowable. If specifically requested by the applicant, the drawing will be corrected whether or not a claim is allowable. (Extract from Notice of February 1, 1932.)

If an application is ready for allowance except for a correction required by the Official Draftsman, such as in a case where the lines are rough and blurred, the Examiner will obtain an estimate of the cost of this work from the Draftsman even though applicant has not requested such an estimate. Including the estimate in the final requirement for correction of the drawing may avoid prolonging the prosecution.

608.02 (t) Cancellation of Figures

Cancellation of one or more figures which do not occupy entire sheets of the drawings is done by the docket clerk of the examining division who encloses a figure and its legend with a red ink line. No portion of the figure itself should be crossed by the red line. The words "Canceled Per" and the letter identifying the amendment directing the cancellation should be written in red ink within the red line.

Cancellation of an entire sheet of drawings is done by stamping the words "Canceled Per" in the 1¼" x 8" area at the top of the drawing within the marginal line in the space reserved for the heading.

When the cancellation of some of the figures from one sheet of drawings has left the remaining figures with an inartistic arrangement, the Chief Draftsman should be consulted as to whether the remaining figures should be transferred to other sheets already in the case or shown in additional drawings. (Extract from Order No. 1862.)

608.02 (u) Changing Name of Attorney on Drawing Forbidden

Erasing the name of a first attorney or writing upon the drawing the name of an attorney subsequently appointed so as to make it appear that the latter name was present when the drawing was originally filed is prohibited.

This prohibition applies also where a drawing is transferred from one case to another having a different attorney. (Order No. 480, Revised.)

608.02 (v) Drawing Changes Which May Require Sketches

When changes are to be made in the drawing itself, other than mere changes in reference characters, designations of figures, or inking over lines pale and rough, a print or pen-and-ink sketch showing such changes must be filed. Ordinarily, broken lines may be changed to full without a sketch.

Sketches filed by an applicant and used by the draftsman for correction of the drawing will not be returned. All such sketches must be in ink or permanent prints. (Extract from Order No. 4009.)

A pencil sketch that is otherwise acceptable or a blueprint with the changes indicated in pencil, may be inked in by the Office Draftsman at applicant's request and at his expense.

608.02 (w) Drawing Changes Which May Be Made by Examiner's Amendment Without a Sketch

Where an application is ready for issue except for a slight defect in the drawing not involving change

in structure, the Examiner will prepare an Examiner's Amendment indicating the change made and note in pencil on the drawing the addition or alteration to be made and send the drawing by the file clerk to the Draftsman for the required correction.

As a guide to the Examiner the following corrections are illustrative of those that may thus be made:

1. Adding two or three reference characters or exponents.
2. Changing one or two numerals or figure ordinals (Quality of paper being a factor).
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. (Extract from Order No. 4009.)

608.02 (x) Disposition of Orders for Amendment of Drawing

Where the ordered correction of the drawing in a case up for action by the Examiner is approved, the application and drawing are forwarded to the draftsman provided there is an allowable claim or there has been a specific request by applicant that the drawing be corrected regardless of whether or not a claim has been allowed (608.02 (s)). Applicant's letter to the draftsman is attached to the outside of the file and the Examiner writes on said letter "approved", with the date of approval and his initials, attaching, if appropriate, the tag (PO-369) "Special This Case Is Ready For Allowance", signed by the Primary Examiner. After the drawing has been corrected, the draftsman stamps the letter to the draftsman and the back of the drawing CORRECTED and returns the case to the examiner. In cases where the office draftsman has been requested to prepare a new drawing, the letter to the draftsman is stamped with a Drawing Ordered stamp showing the date the drawing was ordered. Upon completion of the drawing, the date the drawing is mailed to the attorney for approval is stamped on the draftsman letter and the case is returned to the examiner. The approved drawing is forwarded directly to the examiner when it is returned to the office after the necessary office print has been made by the Application Branch.

Where the correction is not approved, for example, because the proposed changes are erroneous, or involve new matter or (although otherwise proper) do not include all necessary corrections, the case and request for correction of drawing are not sent to the draftsman. The Examiner's reasons for not approving the corrections to the drawing should be set forth in the Office action. (Extract from Notice of February 1, 1932, Revised.)

608.02 (y) Return of Drawing

Rule 87. Return of drawings. The drawings of an accepted application will not be returned to the applicant except for signature.

A photographic print is made of the drawing of an accepted application.

If there is an accepted drawing in the case, other drawings (except those originally filed) that have been finally denied admission will be returned to the applicant.

The Examiner states in his letter that the drawing is being returned under separate cover, giving the reason therefor; e. g., unentered because of new matter, paper poor, or returned at applicant's request.

Such a request must be filed within a reasonable time; otherwise the drawing may be disposed of at the discretion of the Commissioner.

When a drawing is to be returned, the file, letter and drawing are taken to the Drafting Branch where the letter will be stamped and the drawing returned. The letter stating that the drawing is returned is mailed by the Examining Division.

Drawings will not be returned until prints have been made and put in the application file. (Extracts from Orders 1783 and 4009.)

608.03 Models, Exhibits, Specimens

Rule 91. Models not generally required as part of application or patent. Models were once required in all cases admitting a model, as a part of the application, and these models became a part of the record of the patent. Such models are no longer generally required (the description of the invention in the specification, and the drawings, must be sufficiently full and complete, and capable of being understood, to disclose the invention without the aid of a model), and will not be admitted unless specifically called for.

Rule 92. Model or exhibit may be required. A model, working model, or other physical exhibit, may be required if deemed necessary for any purpose on examination of the application.

With the exception of cases involving perpetual motion, a model is not ordinarily required by the Office to demonstrate the operativeness of a device. If operativeness of a device is ques-

tioned, the applicant must establish it to the satisfaction of the Examiner, but he may choose his own way of so doing.

A physical exhibit, not to be part of the case, is generally not refused except when bulky or dangerous.

Rule 93. Specimens. When the invention relates to a composition of matter, the applicant may be required to furnish specimens of the composition, or of its ingredients or intermediates, for the purpose of inspection or experiment.

608.03 (a) Handling of Models, Exhibits and Specimens

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 and Receiving 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 (Notice of Nov. 26, 1921).

When a model has been received in compliance with the official requirement, the date of its filing shall be entered on the file wrapper of the application.

When an exhibit or model is received, it will be forwarded from the Model Room to the examining division together with Form PO-244a. A label showing attorney's name and address should be attached to the model or exhibit so that it can be returned after prosecution of case. If exhibit is too large to be kept in the division during prosecution of case, it may be sent to the Model Room together with Form PO-244a properly checked to indicate whether exhibit is to be held or returned to sender.

Rule 94. Return of models, exhibits or specimens. Models, exhibits, or specimens in applications which have become abandoned, and also in other application on conclusion of the prosecution, may be returned to the applicant upon demand and at his expense, unless it be deemed necessary that they be preserved in the Office. Such physical exhibits in contested cases may be returned to the parties at their expense. If not claimed within a reasonable time, they may be disposed of at the discretion of the Commissioner.

When a model is to be returned a letter should be written to applicant by the Examining Division stating that it is being returned under sep-

arate cover and the model room should be properly notified to return the model.

NOTE.—Disposition of exhibits which are part of the record, 715.07 (d).

Models, exhibits and specimens may be presented to the Office for purposes of interview and taken away by the attorney at the end of the interview. See 713.08.

NOTE.—Plant specimens, 1607, Rule 166.

Rule 95. Copies of exhibits. Copies of models or other physical exhibits will not ordinarily be furnished by the Office, and any model or exhibit in an application or patent shall not be taken from the Office except in the custody of an employee of the Office specially authorized by the Commissioner.

608.04 New Matter

Rule 118. Amendment of disclosure. In original applications, all amendments of the drawings or specifications, and all additions thereto, must conform to at least one of them as it was at the time of the filing of the application. Matter not found in either, involving a departure from or an addition to the original disclosure, cannot be added to the application even though supported by a supplemental oath, and can be shown or claimed only in a separate application.

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. Note 608.01 (1).

While amendments to the specification and claims involving new matter are ordinarily entered, such matter is required to be canceled from the descriptive portion of the specification, and the claims affected are rejected.

A "new matter" amendment of the drawing is not entered.

The Examiner's holding of new matter may be petitionable or appealable, 608.04 (c).

NOTE.—New matter in reissue application, 1401.07. New matter in substitute specification, 714.20.

608.04 (a) Matter Not in Original Specification, Claims or Drawings

Matter not in the original specification, claims or drawings is usually new matter. Characteristics inherent in the disclosure such as chemical or physical properties, or mode of operation, may be amplified if such inherency was initially present in the case as filed. New uses or additional limitations not imposed by the initial disclosure may be new matter. For rejection of claim involving new matter see 706.03 (o).

NOTE.—Completeness of disclosure, 608.01 (p); Trade-marks and trade names, 608.01 (v).

608.04 (b) New Matter by Preliminary Amendment

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. Its test as to involving new matter is the same as though filed on a subsequent date. *Ex parte Leishman*, 137 Ms. 366, Pat. No. 1,581,937, and *Ex parte Adams*, Pat. No. 1,789,921.

608.04 (c) Review of Examiner's Holding of New Matter

Where the new matter is confined to amendments to the specification, review of the Examiner's requirement for cancellation is by way of petition. But where the alleged new matter is introduced into or affects the claims, thus necessitating their rejection on this ground, the question becomes an appealable one, and should not be considered on petition even though that new matter has been introduced into the specification also. Rules 181 and 191 afford the explanation of this seemingly inconsistent practice as affecting new matter in the specification.