



## MEMORANDUM

DATE: October 4, 2023

TO: All Patent Examiners

FROM: Jeanne Clark  
Editor, Manual of Patent Examining Procedure

SUBJECT: **Advance Notice of Change to MPEP § 2205 – Correction on supplying copies of cited prior art patents and publications in 35 U.S.C. 301 submissions**

This memorandum is to provide advance notice of a change that will be made to correct an error in the Manual of Patent Examining Procedure (MPEP) § 2205. In the Ninth Edition (March 2014), MPEP § 2205 was revised to add guidance for submitting written statements by a patent owner under 35 U.S.C. 301. As part of this revision, guidance on requiring copies of the written statements by patent owners was combined with submitting copies of cited patents and printed publications, which resulted in requiring copies of cited patents and printed publications. There was no intention to revise the policy to require copies of cited patents and printed publications in a submission under 35 U.S.C. 301. Accordingly, the guidance in MPEP § 2205 will be revised to indicate that it is preferred that copies of cited patents and printed publications be submitted and that copies of written statements by patent owners must be submitted.

The current text of the third paragraph in MPEP § 2205 recites:

Copies of all the submitted prior art patents, printed publications or section 301 written statements and any necessary English translation must be included so that the value of the information may be readily determined by persons inspecting the patent files and by the examiner during any subsequent reissue, reexamination proceeding, or other post patent proceeding.

The paragraph will be revised to read:

It is preferred that copies of all the cited prior art patents or printed publications and any necessary English translation be included so that the value of the citations may be readily determined by persons inspecting the patent files and by the Office during any subsequent reissue, reexamination, or other post patent proceeding. Copies of section 301 written statements must be submitted so that the value of the information may be readily determined by persons inspecting the patent files and so that the Office may determine

the proper meaning of a patent claim after an *ex parte* reexamination, *inter partes* review, or post grant review has been ordered or instituted. See 35 U.S.C. 301(d).

This advance notice does not change the requirement of 37 CFR 1.510(b)(3) to submit copies of cited prior art patents and printed publications and any necessary English translations as part of a request for *ex parte* reexamination submitted under 35 U.S.C. 302.

MPEP § 2205 will be corrected in the next revision of the MPEP. This change is effective on issuance of this memorandum.