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8. PARTS, FORM AND CONTENT OF APPLICATION

Rule 8.1 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 8.9.
- (b) A specification and claim, see rule 10.
- (c) An oath, see rule 9.1.
- (d) Drawings, when necessary, see rule 12.
- (e) A filing fee of \$30, and \$1 for each claim in excess of 20.

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.

Typed, mimeographed, or multigraphed papers are acceptable. Carbon copies must be replaced by acceptably prepared papers before allowance.

The petition and oath may be included in a single document, the approved single signature form.

Determination of completeness of an application is covered at 7-1-9.

The petition, specification and oath are secured together in a file wrapper bearing appropriate identifying data including the Serial Number and filing date (10-17).

Note:

- reissue patents Sec. 16-1.
- design patents Sec. 17.
- plant patents Sec. 18.

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 13.1 - 13.3, (8-9-48).

Rule 8.8 Papers of Complete Application Not to be Returned. The papers in a complete application will not be returned for any purpose whatever. If applicants have not preserved copies of the papers, the Office

will furnish copies at the usual cost. See Rule 12.7 for return of drawing.

8.1.

Petition

Rule 8.9 Petition. The petition must be addressed to the Commissioner of Patents and must state the name, residence, and post office address of the petitioner requesting the grant of a patent; designate by title the invention sought to be patented; contain a reference to the specification for a full disclosure of such invention; and must be signed by the applicant in person.

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

In the single signature form, the statements above required for a separate petition do not all appear in the petition paragraph and are differently arranged.

See forms for separate petition.

See Rule 8.7 and forms for statements of the petition as embodied in single signature form.

The petition need not be dated.

8-1-1.

Amendment of Petition

Those portions of the petition, other than the post office address, may be amended by the attorney.

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

If the post office address is entirely omitted, it must be supplied by a letter over the applicant's own signature.

Applicant's post office address means that address (other than in case of the attorney in the case) at which he customarily receives his mail. 8-5.

8-1-2.

Power of Attorney

Usually a power of attorney or authorization of agent is incorporated in either the petition or single signature form. Note 6-1, 6-2, and 8-6 for details.

The attorney's full post-office address should be given in every power of attorney. The prompt delivery of communications will thereby be facilitated.

Original Oath

Rule 9.1 Oath of Applicant. The applicant, if the inventor, must make oath or affirmation that he does verily believe himself to be the original and first inventor or discover of the art, machine, manufacture, composition, or improvement, or of the variety of plant, 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 on an application filed by himself or his legal representatives or assigns more than twelve months prior to his application in this country. If any application for patent has been filed in any foreign country by the applicant in this country, or by his legal representatives or assigns, prior to his application in this country, he shall state the country or countries in which such application has been filed, giving the date of such application, and shall also state that no application has been filed in any other country or countries than those mentioned, and if no application for patent has been filed in any foreign country, he shall so state. This oath must be subscribed to by the affiant.

If the application be made by an executor or administrator of a deceased person or the guardian, conservator, or representative of an insane person, the oath shall allege 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.

An additional oath may be required in the cases where the applications have not been filed in the Patent Office within a

reasonable time after the execution of the original oath.

The single signature form, rule 8.7 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, the word "sole" or "only" must appear if there is but one inventor, and "joint" if two or more inventors.

The oath usually bears an impressed seal of the administering official but such seal may not always be required. Rule 9.2, See 8-2-11, 8-2-18, 8-2-19.

If a claim is presented for matter not originally claimed or embraced in the statement of invention in the specification a supplemental oath is required. Rule 9.3, See 8-2-9.

8-2-1. Oath Cannot be Amended

The oath cannot be amended. If it is deficient for any reason a new oath must be required.

The oath must furnish evidence that the notary was acting within his jurisdiction at the time he administered the oath. 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.

If the consular certificate is omitted, in cases in which the oath is taken before a notary abroad, the examiner should require an acceptable new oath, or a consular certificate for the original oath.

8-2-2. Lack of Oath

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

Note lack of supplemental oath 8-2-9.

8-2-4.

Foreign Oath

An oath executed in a foreign country must be properly authorized, 8-2-11, Rule 9.2.

8-2-5.

Foreign Oath is Ribbioned
to Other Application Papers

Rule 9.2. 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 drawing, 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 ribbioned 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.

A rubber stamped imprint upon an adhesive wafer under which the ribbons were brought together has been accepted as a proper seal in a foreign application.

8-2-6.

To Old at Time of Filing

Note time between date of oath and filing of application. Five weeks plus time required for transmission in the mails is allowed (ex parte Heinze 1919 C.D. 67; 265 O.G. 145.

Note: residence 8-4
name 8-6

8-2-7.

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.

8-2-8.

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.

8-2-9.

Supplemental Oath

Rule 9.3. Supplemental Oath for Matter not Originally Claimed. 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 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 be attached to and properly identify the proposed amendment, otherwise the proposed amendment may be refused consideration.

In proper cases the oath here required may be made on information and belief by an executor or administrator of a deceased person or a guardian, conservator, or representative of an insane person.

Rule 9.3 requires in the supplemental oath substantially all the data called for in Rule 9.1 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.

The occasions for the use of a supplemental oath are

rare, as the general statement of invention usually contains some all-inclusive statement embracing the entire disclosure as comprehended within the applicant's invention. Further, where a claim asserted after the case has been examined is for a different and divisible invention from that originally claimed, it would be subject to rejection on the ground of prior election; and the question of its coming within the general statement of invention would be a moot one at best.

It has been held that the failure to file a supplemental oath, even where under the terms of the Rule such oath is required, in no way affects the validity of the patent. *Heller Bros. Co. v. Crucible Steel Co. of America*, 1925 C.D. 322; 330 O.G. 3.

8-2-10.

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 34.2, since they make no change in the wording of the papers on file.

8-2-11.

Administration or Execution of Oath

Rule 9.2. Officers Authorized to Administer Oaths. The oath or affirmation may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, charge d'affaires, consul, or commercial agent holding commission under the Government of the United States, or before any notary public, judge, or magistrate 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 except that no oath or affirmation may be administered by any attorney or agent appearing in the case. When the person before whom the oath or affirmation is

made in this country is not provided with 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.

Note: Seals 8-2-19
when unnecessary 8-2-20
in foreign case 8-2-5

8-2-12. Notaries and Extent of Jurisdiction

The extent of the jurisdiction of the notaries in the various states is given below. The listing of states is based on John's "American Notaries," 5th edition, 1942 (copy in Law Library).

Statewide

Arkansas	New Mexico
Connecticut	New York (d)(e)
Florida	North Carolina
Idaho	North Dakota
Illinois	Oklahoma
Indiana	Oregon
Maine	Pennsylvania
Massachusetts	Rhode Island
Michigan	South Carolina
Minnesota	South Dakota
Montana	Vermont
Nevada	Wisconsin
New Hampshire	Wyoming
New Jersey	

County Only

Alabama	Maryland
Arizona	Mississippi
California	Tennessee
Colorado	Texas
Delaware	Utah
Georgia	Washington
Kansas	West Virginia
Louisiana (Parish)	

8-2-13. Variable Jurisdiction

(See Explanatory paragraphs (a-h) below.)

Iowa (a)	Ohio (h)
Kentucky (a)	Virginia (f)
Missouri (a)	Puerto Rico (g)
Nebraska (b)	Alaska (g)
New Jersey (d)	Hawaiian Is. (g)

(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 other counties also.

(c) 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.

(d) In New Jersey and New York any attorney-at-law may administer oaths.

(e) In New York the jurisdiction of the notary is, by law effective Sept. 1, 1946, "co-extensive with the boundaries of the state, irrespective of (his) place of residence within the state."

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

(g) The jurisdiction of the notary public in Puerto Rico is unlimited. In Alaska and the Hawaiian Islands it appears to be limited to the judicial district.

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

Any naval officer serving beyond the continental limits of the U.S. has notarial jurisdiction but has no seal. (Act of April 25, 1935.)

All army officers on duty with the Judge Advocate General's Department, and all adjutants, assistant adjutants or personnel adjutants of any command, among other designated army officers, have notarial powers (Act of Dec. 14, 1942.)

During existence of war or declared national emergency and six months thereafter, any officer of the Navy, Marine Corps or Coast Guard designated by the Secretary of the Navy (or by the Secretary of the Treasury in the case of Coast Guard if under the jurisdiction of the Secretary of the Treasury) has notarial powers. No seal is required (Act of April 9, 1943).

8-2-14.

Consul

The authority of any officer, not a U. S. minister, charge d'affairs, consul, or commercial agent, administering an oath to an applicant residing abroad must be proved by certificate of a U. S. diplomatic consular officer.
Rule 9.2.

8-2-15.

Consul-Omission of Certificate

If the consular certificate is omitted, in cases in which the oath is taken before a notary abroad, the examiner should require an acceptable new oath, or a consular certificate for the original oath.

8-2-16.

Consular Fee Stamp

Sec. 10, Act approved April 5, 1906; "Whenever a consular officer is required or finds it necessary to perform any consular or notarial act he shall prepare and deliver to the party or parties at whose instance such act is performed a suitable and appropriate document as prescribed in the consular regulations and affix thereto and duly cancel an adhesive stamp in the denomination or denominations equivalent to the fee prescribed for such consular or notarial act, and no such act shall be legally valid within the jurisdiction of the Government of the United States unless such stamp or stamps is or are affixed and cancelled."

8-2-17.

Omission of Consular Fee Stamp

In all applications executed abroad before a consular officer, from which the required consular fee stamp has been omitted, the first action in the case will include the requirement that the necessary stamp be forwarded to the Patent Office to be affixed to the affidavit and canceled by the Head of the Application Branch.

This applies only to affidavits taken before consular officers.

8-2-18.

Embassies and Legations
Stamp not Required

Embassies and legations are not supplied with fee stamps, and are not required to attach any such stamps to papers executed by them.

8-2-19.

Seal

An oath under Rule 9.1 administered by a civilian official must be attested by a competent seal, as required

by Rule 9.2.

The seal must be a physical impression such as produced with a die upon the paper or a substance adherent to the paper. See also 8-2-5.

8-2-20. Seal, When Not Required

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 8-2-13 following paragraph (h).

8-2-21. Venue

Venue and Seal should agree.

That portion of the caption or heading of an oath or affidavit indicating where the oath is taken is known as the venue. The venue is generally regarded as a material fact in oaths and affidavits. 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 the oath, or from the listing at 8-2-12. Venue and notary jurisdiction must correspond or the oath is invalid. The oath should show on its face that it was taken within the jurisdiction of the certifying officer or notary.

8-2-22. Oath by Attorney in Case, Invalid

The oath may not be executed by a notary who has power of attorney in the case. If such an oath is offered as one of the original paper, the application is not accepted as "complete," since an oath so executed is invalid and without legal effect. (Riegger v. Beierl, 1910 C.D. 12; 150 O.G. 826) Rule 9.2.

8-3. Applicants

Rule 7.1 Only Inventor may Apply for Patent. Only the actual inventor may apply for a patent and the application papers must be signed and the necessary oath executed by the inventor, unless the inventor is dead or insane.

Rule 7.5 Joint Inventors. 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.

Independent inventors of distinct and independent improvements in the same machine can not obtain a joint patent. The fact that one person furnishes the capital and another makes the invention does not entitle them to make an application as joint inventors; but the patent may be issued to them as joint owners under the conditions prescribed in Rule 36.4.

If an application for patent has been made inadvertently or by mistake and without fraudulent intention by two or more persons as joint inventors when they were not in fact joint inventors, the application may be amended to remove the name of those not inventors upon filing a statement of the facts verified by all of the original applicants, and an oath required by Rule 9.1 by the applicant who is the actual inventor, provided the amendment is diligently made. An application can not be amended to add the name of a joint inventor who was omitted, but a new application must be filed.

Rule 7.6 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 as indicated in Rules 7.1 and 7.5 or by one of the persons mentioned in Rules 7.2 and 7.3. However, the patent may be issued to the assignee or jointly to the inventor and the assignee as provided in Rule 36.4.

Rule 7.7 Applicant. Unless the contrary is indicated, the word "applicant" when used in these rules refers to the inventor (Rule 7.1), joint inventors who have applied for a patent (Rule 7.5), or to the person mentioned in Rule 7.2 or 7.3 who has applied for a patent in place of the inventor.

Note: Disposition of application by inventor 5-1.

Inventor dead or insane; 8-6-9, Rules 7.2, 7.4.

8-3-1.

Citizenship

The statute (Sec. 4892, R.S.) requires an applicant to state his citizenship, the reason for this being found in Sec. 4887, R.S. 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.

8-4.

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.

8-5.

Applicant's Post Office Address

Applicant's post office address means under Rule 8.9 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.

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.

8-6.

Signature and Name

Rule 8.6 Signatures. The petition, the specification and claims, and the oath, must be signed by the applicant in person. Full names must be given, including the full first name without abbreviation, and the middle initial or name if any. Names must be legibly written.

Rule 10.5 Signature to the Specification. The specification and claim must be signed by the applicant in person. See rule 8.6.

Rule 8.7 Single Signature Form. The petition, oath, specification and claims, and power of attorney may be included in a single document and may be executed by a single signature of the applicant if an approved single signature form supplied by the Office or approved by the Office is used.

If the oath and one of the other component parts of the application are properly signed by the applicant, his failure to sign the other parts will not of itself defeat acceptance as a complete application.

The single signature form (Rule 8.7) should be executed only when attached to a complete application as the last page thereof.

Full First Name Required

It is hereby directed that all applications which disclose the full name of the applicant (at any place in the application papers) will be received and considered as a sufficient compliance with Rules 8.6 and 10.5 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 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 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 3140)

Rule 8.6 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.

In an application where the name is typewritten 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 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 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 to indicate, in red ink, the middle name or initial in the signature so that the latter will be properly printed in the patent.

If applicant fails to answer the request and the case is otherwise ready for issue, correct the drawing by Examiner's amendment, sending copy to applicant and pass the case to issue.

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

8-6-1. Applicant Changes Name

Sometimes the name of an applicant is changed in the period between filing of the applicant and the issue of the patent, as by court order or by marriage. This fact can, if desired by applicant, be indicated by appropriate notation under the signature to the specification and drawing (or printed name on the drawing where signed by the attorney). However, proof of the change of name, as by certificate of court order, must first be recorded in the Assignment Branch.

8-6-2. Applicant Unable to Write

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

8-6-3. May Use Title With Signature

It is permissible for an applicant to use a Title of Nobility in connection with his signature. The Title will not be in the printed patent.

8-6-4. On Joint Applications

In case of a joint application, the order of the names on the file wrapper is that in which they appear in the preamble. It is not essential that the names appear in the same order in the signatures to the petition, specification, oath, and drawing.

8-6-5. 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.

8-6-6. Unsigned Specification

An unsigned specification is not returned to the applicant, but the applicant may come in and sign such specification in the Patent Office. Otherwise, a properly signed permanent copy of the specification as originally filed is required.

8-6-7. Unsigned Original Specification
and Signed Duplicate

Whenever an application is filed in which the original specification is not signed by the applicant, a requirement should be made in the first action that the specification be signed by the applicant or that a properly signed duplicate specification be filed. If the duplicate specification be filed with the first amendment, said amendment should be entered in the signed duplicate specification and the original or unsigned specification canceled; but if the first amendment be filed before the signed duplicate specification is filed, the amendment should be entered in the original specification, and the signed specification marked "Duplicate of Original Specification" and placed in the file, in which case a marginal notation should be made at the end of the unsigned specification to print the signature as found at the end of the duplicate specification.

8-6-8. Signature to Drawing

Rule 12.2 Signature to Drawing. The drawing must either 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.

Erasing the names of attorneys or writing upon the drawings the names of attorneys subsequently appointed, so as to make it appear that their names were present when the

drawings were originally filed, is prohibited.

This prohibition applies also where a drawing is transferred from one case to another having a different attorney. (Order 480)

8-6-9. Administrator or Executor

Rule 7.2 When the Inventor is Dead.
In case of the death of the inventor, the executor or administrator of the deceased inventor may sign the application papers and make the necessary oath, and apply for and obtain the patent. Where the inventor dies during the time intervening between the filing of his application and the granting of a patent thereon, the letters patent will issue to the executor or administrator upon proper intervention by him.

Rule 7.3 When the Inventor is Insane.
In case an inventor becomes insane, the legally appointed guardian, conservator, or representative of the insane inventor may sign the application papers and make the necessary oath, and apply for and obtain the patent.

Rule 7.4 Proof of Authority. In the cases mentioned in Rules 7.2 and 7.3, proof of the power or authority of the executor or administrator, or of the guardian, conservator, or representative, must be recorded in the Patent Office.

When an inventor dies after filing an application the executor or administrator should intervene, but the allowance of the application, will not be withheld nor the application withdrawn from the issue if the executor or administrator does not intervene. (Order 2076)

In an application filed by an administrator or executor, the specification should not be written in the first person. Instead of the usual "I have found," the wording should be "it was found."

8-6-10. Signature of Executor or Administrator

The signature to the petition, specification, and oath may be in either of the two following forms:

- (a) Hanna Edlund,
Administratrix of Estate of
Claus A. Edlund, deceased.

(b) Claus A. Edlund, deceased,
by Hanna Edlund,
Administratrix.

The signature to the drawing, however, must follow the (b) form, the name of the inventor appearing first. If the drawing is signed by the attorney, the following form should be observed:

Claus A. Edlund, deceased,
by Hanna Edlund, administratrix,
by S. V. Lauderly, 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.

8-6-11. Heirs As Such Cannot Sign Application

If the application is by the heirs of a deceased inventor, see 6-2-3.

8-7. Title of Invention

The title of the invention in each application should be as specific as possible. General titles do not serve to throw any helpful light on the nature of the invention.

8-7-1. Change By Examiner's Amendment

Where the title is not specific to 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.

8-8. Filing Fee

While a filing fee, except as provided in the Act of March 3, 1883, as amended April 30, 1928, is a sine qua non part of the complete application for a patent, it seldom, if ever, 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. Where the number of the claims exceeds twenty, and only the minimum fee of \$30 is paid, a filing date for the complete application is

withheld pending receipt of the required balance of one dollar for each claim in excess of twenty or a cancellation of each such claim. See 8-9-10 and Rules 4.1 and 4.2.

Sometimes before a case is examined, an amendment is filed increasing the claims to a number in excess of twenty. As no additional fee is receivable after the filing date, the amendment is not entered.

8-8-1. Fee Exempt

The Act of April 30, 1928, amending the Act of 1883, states the law governing the granting of patents without payment of fees, and is as follows:

The Commissioner of Patents is authorized to grant, subject to existing law, to any officer, enlisted man, or employee of the Government, except officers and employees of the Patent Office, a patent for any invention of the classes mentioned in section 4886 of the Revised Statutes, without the payment of any fee when the head of the department or independent bureau certifies such invention is used or liable to be used in the public interest: Provided, that the applicant in his application shall state 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.

8-8-2. Inventor Leaves Service of United States

In view of the ruling in the opinion of the Attorney General, dated January 14, 1936, that an application filed under the Act of 1883, as amended, 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, a letter asking for the status of the inventor will no longer be required.

8-8-3. Changed to Fee Filed

Where an application is filed under the Act of March 3, 1883, as amended April 30, 1928, the regular filing fee can be subsequently paid and proper amendment made by the inventor and 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.

8-8-4. Fee Filed Changed to Fee Exempt

An application for which a filing fee has been paid may issue under the Act of March 3, 1883, as amended April 30, 1928, if the applicant or applicants qualify under said Act, and file the required petition. 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.

Note: 4-1-13 to 4-1-17 on fee and fee-exempt applications.

8-8-5. 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.

8-9. 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 disclosure, or they involve new matter. Applicant may rely for disclosure upon the specification with original claims and drawings, all as filed complete.

8-9-1. Specification

Rule 10.1 Detailed Description and Specification of the Invention. The specification must include a written description of the invention or discovery and of the manner and process of making, constructing, compounding, 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, construct, compound, and use the same.

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, followed

by an explanation of the mode of operation or principle whenever applicable. The best mode devised by the inventor of carrying out his invention must be set forth.

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 must be explicit language distinguish between what is new and what is old; 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.

Cross references to other related applications may be made when appropriate, Rule 10.7 and 4-3.

Rule 10.9 Paper, Margin, Legible Writing. The specification and claims must be plainly written on but one side of the paper. (See Rule 8.1). 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 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 filled are not correctly, legibly and clearly written.

Any interlineation, erasure or cancellation or other alteration must be clearly referred to in a marginal or footnote on the same sheet of paper, initialed or signed by the applicant to indicate that it was made before the application was signed and sworn to. (See Rule 8.5)

As stated in Rule 8.1 the specification must be in the English language.

The specification is sometimes in so 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 specification does not require a date.

If a newly filed application obviously fails to disclose an invention with the clarity required by Sec. 4888 R. S., revision of the application should immediately be required (10-3).

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, erasures, or alterations, giving the page and the line.

8-9-2. Parts of Specification

Rule 10.6 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 and statement of the nature 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.

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

Note: Design patent specification.
Plant patent specification.
Reissue patent specification.

8-9-3. Preamble

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

8-9-4. Preamble Not Printed in Patent

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.

8-9-5.

General Statement of Invention

Rule 10.2 Summary of the Invention. A brief summary and statement of the nature of the invention, which may include a statement of the object of the invention, should precede the detailed description. Such summary and statement should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed.

Rule 10.8 Reservation Clauses not Permitted. A reservation of subject matter disclosed but not claimed in a pending application will not be permitted in the pending application.

Note: Filing of application claiming matter disclosed but not claimed in patent, 8-9-23.

Since the purpose of the general statement 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 statement should be directed to the specific invention claimed, in contradistinction to mere generalities which would be equally applicable to numerous preceding patents. That is, the subject matter of the claims taken as a unit should be paraphrased in a few clear, concise sentences or paragraphs, according to the extent and nature of the invention. 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.

8-9-6.

General Statement of Invention-Coextensive with Claims

The general statement of invention should be coextensive with the claims. Note final review of application 15-1-1.

Some latitude is permitted chemical cases.

8-9-7.

Brief Description of Drawings

Rule 10.3 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 figures and to the different parts by letters or numerals (preferably the latter). Reference characters should be so selected that the first occurrence in the specification will be in sequence.

The Examiner should see to it that the figures are correctly described in the brief description of the specification and the reference characters 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" may (with a prime affixed) advantageously be applied to the modification. Every feature covered by the claims must be illustrated, but there should be no superfluous illustrations.

8-9-8. 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 10.1, must be in such particularity as to enable any person skilled in the pertinent art or science to construct, prepare and use the invention without involving extensive experimentation.

The description is a dictionary for the claims and should provide a basis for all terms used in the claims.

Note: Completeness 8-9-12.

8-9-9. Mode of Operation

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 the invention should be presented.

Note: Completeness 8-9-19.

8-9-10. Claims

Rule 10.4 Claim. The specification must conclude with a specific and distinct claim of the part, improvement, or combination which the applicant regards as his invention.

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

When more than one claim is presented, they may be placed in dependent form (see form).

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 with certainty by reference to the description.

In cases in which claims in excess of the number corresponding to the filing fee are presented before the first official action on the case, the clerk places the amendment in the file and enters it on the file wrapper but action is deferred on the claims presented in the amendment. In his first action the Examiner acts on the claims originally presented and for which the appropriate fee was paid. If, after the official action is made, the applicant believes that any of the claims presented by the amendment are patentable, he can have them entered and considered in the next action only if he specifically points out wherein the claims presented in the amendment are patentable over the references cited by the Examiner.

Note examination of claims, 10-8; numbering of claims 8-9-11, 8-9-15.

8-9-11.

Numbering of Claims

Rule 17.6 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 cancelled 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.

8-9-12.

Index of Claims

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

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

As any claim is canceled a line should be drawn through its number. Claims retained under Rule 11.2 but not canceled should be enclosed by a ring in pencil with the notation "R 11.2". This is an aid in mentioning all of the claims by number in each action in which reference to claims retained but not acted on should be made, preferably at the end of the letter.

The Office action must include a summary of rejected and allowed claims and claims retained under Rule 11.2.

8-9-13.

Statutory Requirement of Claims

Sec. 4888 R. S. requires that the applicant shall particularly point out and distinctly claim the part, improvement, or combination which he regards as his invention or discovery. The portion of the application in which he does this forms the claim or claims. This is the most important part of the application, as it is the definition of that for which protection is granted.

8-9-14.

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 so complete as to support the necessary amendment of the drawing and specification.

Where the descriptive portion of the specification indicates that certain conditions are necessary to obtain an improvement or advantage over the prior art, original claims omitting some of the conditions cannot be relied upon as an explicit disclosure that all of the conditions are not essential. Ex parte Brown and Davis, 65 U.S.P.Q.

8-9-15.

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 claim" whether or not the words "I 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.

In every particular in which the claim fails to define correctly applicant's invention, it should be challenged and the fault definitely pointed out.

An article that cannot be described in any other manner, may be claimed by a process of making it. In re Moeller 1941 C. D. 316, 527 O. G. 559.

Restricted to chemical cases, under special conditions, a Markush type of claim may be presented. Ex parte Markush 1925 C. D. 126, 340 O. G. 839; Ex parte Spafford 66 U.S.P.Q. 361; In re Thompson et al 1946 C. D. 280; 588 O. G. 353. A Markush type claim is generally not proper in the same case with a true genus claim. Markush groups of diminishing scope are improper no matter how few the number of claims. Formula type claims, as used in chemical cases must meet the same requirements as Markush claims.

8-9-16.

Dependent Claims

A dependent claim which depends from and covers the combination of only a single other independent claim may be presented without regard to the numerical order of presentation.

Claims are independent or dependent. An independent claim is complete in itself without reference to another claim. A dependent claim refers to and modifies another

claim, for example, claim 4 a dependent claim could read as follows:

4. The product of claim 3 wherein

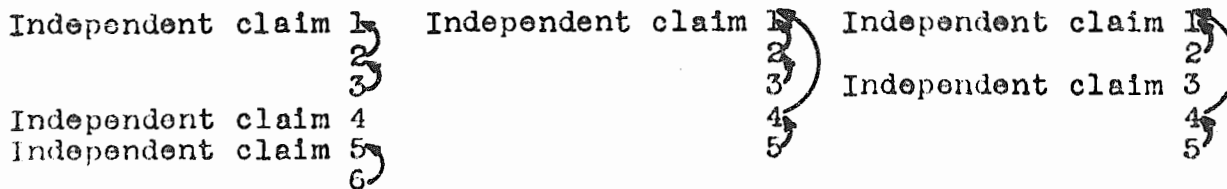
If claim 3 is an independent claim there is no objection. If claim 3 is in turn a dependent claim referring to claim 2 or 1, the following direction applies:

A dependent claim may depend from a preceding dependent claim providing that the claims of any series of dependent claims shall appear in the application in immediate consecutive order, and no dependent claim shall contain direct reference to more than one preceding claim.

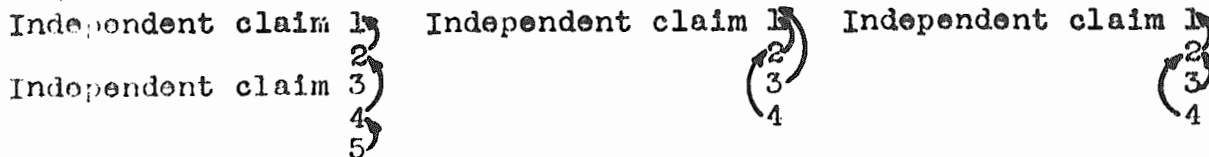
A series of dependent claims consists of dependent claims, at least two in number. A series cannot consist of a single claim. The parent, basic or independent claim is not considered to be one of the "series of dependent claims" because it is not a dependent claim. There may be several series of dependent claims in a single application, provided that the claims in each series of dependent claims are in immediate consecutive order.

Examples of accepted and prohibited series of dependent claims are illustrated in the following table:

Accepted



Prohibited



2,4,5 are a series of dependent claims and not in immediate consecutive order.

2,4 are a series. 3 is not in that series. Series 2,4 are not in immediate consecutive order.

2,3 are a series. 2,4 are a series not in immediate consecutive order.

When renumbering of the claims is necessary, in compliance with Rule 17.6, particular attention should be given to dependent claims to see that each dependent claim correctly identifies the claim upon which it is built.

8-9-17.

Basis for Claim
Terminology in Description

Every term used in any of the claims should find antecedent basis in the descriptive portion of the specification with clear disclosure as to its import, and in mechanical cases it should be identified by reference to the drawing, designating the part or parts therein to which the term applies. Terms used in the claims may be given a special meaning in the description providing it is not repugnant to the usual meaning of the terms.

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.

8-9-18.

Claims Added by Amendment

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 verbal 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.

8-9-19.

Completeness

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, construct, compound 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 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 ordinarily be provided

with support in the disclosure of at least one specific example 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. General statements of utility are not acceptable where closely related materials are not known to have specific use within the general statement. Broad indication of use as an insecticide, therapeutic, resin, or preservative, without greater specificity, such as examples and mode of application, is insufficient or of dubious value.

A disclosure involving a new chemical compound or composition must teach persons skilled in the art how to make the compound or composition. Obviously, the starting materials and methods of making the starting materials must also be available to the expert, as of the filing date of the application, incomplete teachings may not be completed by reference to subsequently filed application. If the starting material is old but obscure 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 co-filed or previously filed application by the same applicant wherein the detailed preparation is given. If a co-filed or previously filed application of the same applicant adequately discloses the preparation of the starting material amendments to include reference to such application by serial number and a general method of preparation have been accepted.

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, nunc pro tunc.

Note: trade-marks and trade names 8-9-27
period for response, 10-11 failure to
take required action during time
period, 10-12-2.

8-9-20, Substitute or Rewritten Specification

Rule 17.5 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 not ordinarily be accepted unless it has been required by the Examiner.

The specification is sometimes in so 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.

An amendment presenting an uncalled-for and unnecessary substitute specification along with other amendatory matter, as, amendments to claims or new claims, should be entered in part, rather than refused entry in toto. The substitute specification should be denied entry and so marked, while the rest of the amendatory paper should be entered.

It may be noted in this connection, however, that the fact that a substitute specification, in the opinion of the Examiner, contains new matter is not a proper reason for refusing entry thereof.

Before passing applications to issue, all papers should be inspected to see that they are in such shape and condition as to avoid all possibility of error by the printers. Whenever interlineations or erasures have been made in the specification or amendments which would lead to confusion and mistake, the Examiners should require the entire specification to be rewritten before passing the case to issue. (Order 525)

8-9-21.

Formulae in Specification

Printer's proofs of applications about to issue as patent specifications containing chemical or other formulae are sent with the application file to the Examiner who promptly indicates on the proof any corrections he may find necessary in the formulae and immediately returns the file and proof to the Issue and Gazette Branch.

8-9-22.

Foreign Language

As stated in the Rules, the specification must be in the English language.

8-9-23. Derogatory Remarks About Prior Art

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 application of common ownership or that he makes no claim to the disclosure in a certain application, also of the same ownership.

8-9-24. Restoration of Canceled Matter

Canceled text in the specification or canceled claim can be restored only by filing a duplicate thereof.

Note: Applicant's directions for entry of amendment, 10-16-36.

8-9-25. Use of Disclosure
in Subsequent Application

When after obtaining a patent, the patentee files an application claiming subject matter disclosed but not claimed in his patent, he is required to place a notice in the file of the patent, as soon as the application has received a Serial Number, to the effect that such an application has been filed and to identify the application in the notice by its Serial Number and filing date. He is also required to identify in his application the patent in which the subject matter now claimed is disclosed.
(Order 5200)

Reservation of subject matter disclosed but not claimed in a pending application is not permitted. Rule 10.8.

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 8-9-39.

8-9-26. 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 7-1-9 and 7-1-12.

8-9-27. Trade Marks and
Trade Names in Disclosure

The expressions "trade-mark" and "trade-name" as used below have the following meanings:

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 at the time the application was filed to avoid any question of new matter. Such characteristics must have been known at the time of the filing date.

If the trade-mark or trade name which is not well known or satisfactorily defined in the literature at the time of filing of the application appears in the specification as originally filed and is not accompanied by a proper definition, the claims are rejected as based upon an insufficient disclosure if the material referred to by the trade-mark or trade name is necessary to practice the invention.

The original disclosure may sometimes be suitably amended to define the product to which the trade-mark or trade name is applied; or if the product referred to by the trade-mark or trade name cannot be otherwise satisfactorily defined, by an amendment defining the process of its manufacture. Such an amendment must be supported by a satisfactory showing establishing; if a trade-mark, the specific nature or process of manufacture as known to those skilled in the art at the time of filing of the application; or, if a trade name, that such definition of the meaning thereof or its method of making were known to those skilled in the art at the time of filing of the application.

8-9-28.

Interlineations or
Erasures Made Prior to Filing

Rule 10.9 Any interlineation, erasure or cancellation or other alteration must be clearly referred to in a marginal or footnote on the same sheet of paper, initialed or signed by the applicant to indicate that it was made before the application was signed and sworn to. (See Rule 8.5).

8-9-29.

Drawing

Rule 12.1 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

Trade-mark; a proprietary word, letter, device or symbol, used in connection with merchandise and pointing distinctly to the origin or ownership of the article to which it is applied.

Trade name; a non-proprietary name by which an article is called among traders or workers in the art, and which is not indicative of the origin or ownership of the article to which it is applied.

The use of trade names in patent applications is permissible 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 as of the filing date 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. Trade-marks, suitably defined, may be used in the descriptive portion of the specification and, when necessary, in drawings such as flow sheets.

Trade-Marks are Never Permitted in Claims

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

this fact. On the return of the drawing to the Office, the file should be inspected to ascertain the status of the case. It may be ready for issue.

See correction of drawings 8-9-17.

The name of the inventor may be placed on the drawing by the attorney, but when the drawing is signed by the inventor in person the name of the attorney is not permitted to appear thereon.

Note: correction of drawing 8-9-17.

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

Reference of "Issue Case" Drawings to Draftsman

When the drawings are to be referred to the draftsman in the final revision of allowable applications (under Order 2438) fasten thereto the draftsman's slip Form 249, inscribed "Issue Case." Place these drawings in the draftsman's box. The draftsman's messenger will transport them to and from the Drafting Branch.

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.

8-9-30.

Drawing - When Required

The Chief of the Drafting Branch when vizing drawings filed in pending applications, is hereby directed to mark as informal all such drawings as do not conform to the established standards, and to note the words "can be corrected" upon such informal drawings as it is possible to free from objection. On such informal drawings as cannot be freed from objection he will note the words "New drawings required."

The Examiners are directed to advise the applicants 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 unless the necessity therefor shall have been indicated by the Chief of the Drafting Branch. (Order 1764)

Note: Additional, duplicate, or substitute drawings
8-9-30.

views) may also be furnished in the same manner as drawings, and may be required by the Office when considered necessary or desirable.

Rule 12.6 Draftsman to Make Drawings. Applicants are advised to employ competent draftsmen to make their drawings.

The Office may furnish the drawings at cost (with a minimum charge) as promptly as its draftsmen can make them, for applicants who can not otherwise conveniently procure them.

Rule 12.8 Signature to Drawing. The drawing must either 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.

Rule 12.7 Return of Drawings. The drawing of an accepted application will not be returned to the applicant except for signature.

Note: Standards for drawings, Rule 12.4.
Design patent drawings, Rule 20.2.
Plant patent drawings, Rule 20.5.
Reissue application drawings, 8-9-41.

Government Department applications may have their drawings corrected by Government attorneys.

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

The print is given a paper number and corresponding entry on the file jacket is made.

The print being thus an official paper in the record, it 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.

The drawing may be signed by the applicant in person, after the drawing has been filed. No date is at present required.

When a drawing is being returned for the applicant's signature, the Examiner writes a letter stating

Examiners should not require substitute drawings in any case unless the Chief Draftsman has first indicated that the original drawings cannot be made serviceable. Where the cancellation of some of the figures from one sheet of the drawings has left the remaining figures with an inartistic arrangement, the Chief Draftsman should be consulted as to whether the said remaining figures should be transferred to other sheets already in the drawings; and conversely, when the necessary additional illustration is but fragmentary 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.

8-9-31.

Informal Drawings

Rule 12.4 gives extensive and detailed standards for drawings.

Rule 12.5 Informal Drawings. The requirements of the foregoing Rule 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.

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.

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

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

8-9-32. Draftsman Determines
Informality of Drawings

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 the Drafting Branch to be inspected by the Chief Draftsman. If satisfactory, he stamps "Draftsman, Patent Office" and the date on the back of each sheet.

If the drawings are informal, but may be admitted for examination purposes the Draftsman writes in lead pencil on the face of the drawing "Inf. A.F.E." (admit for examination). The drawings are then returned to the Application Branch.

If the drawing is endorsed "Inf. A.F.E." it is accepted as satisfying the requirements of Rule 8.1 in the matter of a drawing as a necessary part of a complete application; and in the receipt which the Application Branch mails the applicant, there is embodied the draftsman's criticism of the drawing with notation as to whether the drawing is susceptible of correction or a new one required.

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

8-9-33. Drawings Kept in Examining Division

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

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.

When sending for the original drawing upon payment of the final fee, the Issue and Gazette Branch, after stamping the patent date upon the photographic copy, will send the latter to the Examining division, and such photographic copy must be placed in the cabinet in lieu of the original drawing.

Each examining division will, each week, select the photographic copies bearing the date of that week's issue and return them to the Issue and Gazette Branch by Wednesday morning of that week in order that the latter may replace them in the proper application (now patent) files.

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. (Order 3104)

No application should be sent to issue or to abandoned files unless the original drawing is checked up and found in the division.

8-9-34. Complete Illustration in Drawings

Rule 12.3 Content of Drawing. The drawing must show every feature of the invention covered by the claims, and the figures should be consecutively numbered if possible. 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.

8-9-35. 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 the reference characters 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.

8-9-36. Modifications in Drawings

Modifications may not be shown in broken lines on figures which show in solid lines another form of the invention.

All modifications described must be illustrated, or the text canceled. (Ex parte Peck, 1901 C.D. 136; 96 O. G. 2409.) 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.) This requirement does not apply to a mere reference to well-known and conventional parts.

Note: correction of drawing 8-9-49.

8-9-37. New Matter in Drawings

An amendment of the drawing which would introduce "new matter" is not entered. See 8-9-2.

8-9-38. Additional,
Duplicate or Substitute Drawings

When an amendment is filed stating that at the same time substitute or additional sheets of drawings are filed such drawings have not been transmitted to the examining division, inquiry should be made of the Application Branch before the applicant is notified that the drawings have not been received.

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. Such proffered drawing will be returned to applicant, a print thereof being first made, "unless it be a duplicate", and placed in the record. If the original drawing requires alterations, and these are taken care of in the proffered substitute drawing, the latter will be used in lieu of the usual sketch in making the correction of the original drawing.

Examiners should not require substitute drawings in any case unless the Chief Draftsman has first indicated that the original drawings cannot be made serviceable. See 8-9-30 and 8-9-49.

8-9-39.

Transfer of Drawings
From Prior Applications

Rule 12.8 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. The new application must be accompanied by a letter requesting the transfer of the drawings, which should be completely identified.

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

Formal transfer of drawings from one application to another is made only by the Application Branch. See also 8-9-49 (e).

8-9-40.

Transfer of Cancelled 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.

When an application is patented, 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.

8-9-41.

Transfer of
Drawings Patent to Reissue

Rule 12.9 Drawings in Reissue Applications. 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 consisting 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, 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 entire set of the original drawings intact and in the condition existing at the time of issue of the original patent.

As in 8-9-3a, transfer of the drawing is made by the Application Branch, notation thereof being entered on the file wrapper of the original application.

8-9-42.

Transfer of Drawings
to Continuation or Substitute

Where a continuation is filed, prints are accepted in lieu of formal drawings to establish a filing date, the original drawings being transferred after abandonment of the parent case either by operation of law or by properly executed letter of abandonment.

Prints submitted in lieu of drawings are given a date on the back by the Register, Correspondence and Mail Branch of the Administrative Services Division. These prints are mounted upon Bristol board by the Application Branch and the back of the board upon which the prints are mounted bears a date stamped by the Application Branch to correspond with the now covered date of the Mail Branch.

8-9-43.

Blueprints

Blueprints which are submitted for the purpose of guiding the draftsman in adding reference letters or indicating the line of section will not be placed in the file but will be returned after the corrections have been made. Note: Blueprints used in correction of drawing, Order 1958, 8-9-49.

8-9-44.

Prints

The Application Branch has permanent prints made of the drawings of all complete applications and secures the prints in the file wrappers. The drawings and files are then assembled and forwarded to the proper examining divisions.

In the exceptional case where an application without a drawing is given a filing date and the Examiner subsequently requires a drawing, or where for any other reason a new sheet of drawing is added by amendment, a print of such drawing is made and forwarded to the division to be placed in the file as an official paper.

Prints may be accepted in lieu of drawings 8-9-42.

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.

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.

Prints remain in the file at all times except as provided in 8-9-33.

Note: Prints in file wrapper 10-17-4.

8-9-45.

Prints Kept
in Examining Division

The print or original drawing must always be kept in the Examining Division until the application is patented or abandoned. See Order 3104, at 8-9-33.

Note: Prints in dual prosecution (D.P.) cases
8-9-46.

8-9-46.

Prints in Dual Prosecution

In dual prosecution (D.P.) 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.

Final Disposal of Prints

When a D. P. application is passed to issue, notification of this fact will at once be given by the division having general jurisdiction of the case to the other division or divisions that participated in the prosecution. The Examiner of each such "other" division will make notation of date of allowance on the print of his file of drawings.

The division having general jurisdiction will also notify the other division of the subsequent disposition

made of the case, as, withdrawal from issue, patented, forfeited, etc. If the other division receives no such notification within six months from the date of allowance, the Examiner will check with the division of general jurisdiction with a view to ridding his files of the print if no longer of any prospective use.

8-9-47.

Data on Prints

The photoprints in an application contains, besides a print of the drawing the following information:

On the front of the print-

Serial number of the application Stamp by the Application Branch "Print of drawing as originally filed."

OR

"This is an additional sheet of drawing and must be submitted to the Chief Draftsman before enter."
(This latter is stamped on the additional drawing and reproduced therewith)

Paper number, usually #2.

Marginal notation of informalities-

by the Draftsman on the margin of the original drawing.

OR

"O. K." if there are no Draftsman notations.

Class and subclass of the application on the back of the print-

Stamp of the Application Branch and date of receipt of the print from the photoprinting establishment. Sometimes a stamp of the Examining Division receipt date.

Additional prints prepared for the Examiner or the Board of Appeals bear on the front such information as is on the drawing as of the copying date:

Serial number of the application
Sometimes the reproduced stamping.

"This is an additional sheet of drawing and must be submitted to the Chief Draftsman before enter."

Marginal stamp of "O. G. figure, Class and Sub-Class" reproduced from the stamp on the drawing.

On the back, additional prints bear a stamp stating "Photographs for Examiner" and the date the additional prints were made. See also 8-9-33.

8-9-48. Date 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 when photoprints are made for the Examiner are stamped as "Photographs for Examiner."

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

Note: informal drawings and "Application filed complete" date 8-9-31.

8-9-49. Correction of Drawings

Rule 17.3 Amendments to the Drawing.
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.

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

8-9-49(a).

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, and no such corrections or alterations will be permitted in any case until after approved photographic copies of the drawings have been filed. A black line photographic or lithographic print is an approved copy.

Blue prints will not be accepted as complying with the requirements of the Office and will not be entered in the application files. Blueprints submitted for the purpose of guiding the draftsman in adding reference letters or indicating the line of section will not be placed in the file but will be returned after the corrections have been made.

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 will receive the written approval of the Examiner before the case is sent to the Chief Draftsman. (Order 1958)

Note: Prints in file wrapper 10-17-4.

8-9-49(b).

Slight Corrections to Drawing

The Examiner will in his first action on every case carefully scrutinize the drawing (and of course also the specification), and make appropriate requirements looking to the corrections of noted defects.

Any request by the applicant for amendment of the drawing to cure these or other 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 division, and applicant will be so advised in the next action by the Examiner.

In the event that the alteration requested in the separate letter is so slight as, in the opinion of the draftsman, not to necessitate a charge, the letter, after the correction of the drawing, will be stamped, No Charge, and placed in the file.

8-9-49(c).

Estimating Cost
of Correcting Drawings

Files and drawings taken from Examining Divisions by the Draftsman for correcting or making new drawings, will be retained by the draftsman only long enough to estimate the cost of the work.

An order for the work will be attached to the drawing in each case, and the file and drawing returned to the Examiner. The order slip will be detached only by the draftsman upon completion of the work.

8-9-49(d).

Cancellation of Drawings

In the cancellation of figures to be canceled will be surrounded by a line in red ink and the word "canceled" with proper date of cancellation will be written in red ink within each line. No portion of the figure itself, however, will be crossed by the red lines. When the entire drawing is to be canceled a red line will be drawn entirely around the same (but immediately within the marginal line), date of cancellation within the said surrounding red line. But no lines shall be drawn in any case across the figures themselves. (Order 25)

8-9-49(e).

Changing Name of
Attorney on Drawing Forbidden

Where a drawing is transferred from one case to another having a different attorney, erasing the name of the first attorney or writing upon the drawing the name of the 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. See 8-9-50.

8-9-49(f). 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. Broken lines may be changed to full without a sketch.

Only those sketches which are made in ink will be accepted by the Office for correction of a drawing. Such sketches become a part of the file record and therefore will not be returned. The applicant may obtain from the Office a print of a sketch by ordering and paying for the same.

Where an application is ready for issue barring a slight defect in the drawing not involving change in structure, the Examiner will note in pencil on the drawing the addition or alteration to be made and send the drawing to the draftsman for the required correction. In such cases no charge will be made.

As a guide to the Examiner the following corrections are illustrative of those that may be free of charge by the Office Draftsman:

1. Adding two or three reference characters or exponents.
2. Changing one of 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.

If it is necessary to return a drawing for applicant's signature charge will be made for packaging and registering in the mail.

Sketches filed by an applicant and used by the draftsman for correction of structural features of the drawing will not be returned. All such sketches must be in ink or permanent prints.

Sketches in pencil will be inked in by the Office draftsman at the expense of applicant.

Where a drawing is filed that is finally denied admission to the case it will be returned to applicant on his request but at his expense. Such request must be filed within a reasonable time; otherwise the drawing may be disposed of at the discretion of the Commissioner. (Order 4009)

Note: Additional duplicate or substitute drawings
8-9-38.

Where requested a pencil sketch that is otherwise acceptable is inked in by the draftsman at the expense of the applicant.

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. Such proffered drawing will be returned to applicant, a print thereof being first made, "unless it be a duplicate," and placed in the record. If the original drawing requires alterations and these are taken care of in the proffered substitute drawing, the latter will be used in lieu of the usual sketch in making the correction of the original drawing.

When the drawing is defective in a case found to contain allowable subject matter, the Examiner should state fully the correction that is needed and require the applicant to furnish a sketch in permanent ink of such correction, along with an authorization for the Office draftsman to make the required amendment. If applicant complies with this requirement, the sketch is submitted to the Examiner for his written approval, and if given the correction is made by the draftsman, the file and drawings being forwarded to him.

8-9-49(g).

Disposition of Orders
for Amendment of Drawing

Where the correction of a drawing is ordered and the correction when made will put the case in condition for allowance, the Examiner writes "Approved" and initials the notation on the order for correction, attaches the order for correction and a "Special this case is ready for allowance" tag to the outside of the file wrapper and sends the file, drawing, letter for correction of drawing, and special tag to the draftsman by the file clerk. The tag is signed by the Primary Examiner, or, in his absence by the assistant chief. These cases must be so marked if the draftsman is expected to make the correction "special."

Where the ordered correction of the drawing in a case up for action by the Examiner will NOT put the case in condition for issue, if the correction is approved and when the case contains an allowable claim, the Examiner forwards to the draftsman the case with drawing and order for correction indicating such corrections as are approved. The order for correction is attached to the outside of the file wrapper. Where the correction is not approved (or where the case contains no allowable claim) the case and request for correction of drawing, are not sent to the draftsman, but are retained in the division.

When an estimate for correction is requested (in a case where no allowable subject matter has been found), the Examiner at his next action will secure the estimate from the draftsman and inform the applicant of the charge and also that no correction will be made until a claim is found to be allowable.

The correction of a drawing, except in the case of applying a few reference characters or making some other minor alteration, is at the expense of the applicant.

8-9-49(h). Return of Drawing

When a drawing is to be returned for correction the Examiner will transmit the same to the Chief of the Drafting Branch, who will promptly prepare such drawings for shipment.

Drawings will not be returned except for the correction or addition of the signature thereto and no drawing will be returned unless a photographic copy of the same has been filed and accepted as part of the application.

Permissible changes in the construction in any drawing may be made only within this Office, and not until after an approved photographic copy has been filed and the proposed changes authorized by the Examiner. But signatures to the drawing may be within this Office and Office and reference characters may be changed by this Office, without filing a photographic copy, if the requirement for such correction and changes appears in the Examiner's letter. (Order 1783)

8-9-50. Models, Exhibits, Specimens

Rule 13.1 Models Not 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 13.2 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.

Rule 13.3 Specimens. When the invention is a composition of matter, the applicant may be required to furnish specimens of the composition, and of its ingredients or intermediates, sufficient in quantity for the purpose of experiment.

Rule 13.4 Return of Models, Exhibits or Specimens. Models, exhibits, or specimens in applications which have become abandoned, and also in other applications 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.

Rule 13.5 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.

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 questioned, the applicant is required to establish it to the satisfaction of the Examiner, but he may choose his own way of so doing.

Models are generally not refused except when bulky or dangerous.

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 10-15

A model is not to be received by the Examiner directly from the applicant or his agent.

8-9-51,

Model Room

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.

Note: Plant specimens Sec. 18-5, Rule 21.6.

8-9-52.

New Matter

Rule 16.4 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.

While amendments to the specification and claims involving new matter are 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.

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 verbal 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.

8-9-53.

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 constitute new matter.

Note: Completeness of disclosure 8-9-19.
Trade-marks and trade names 8-9-27.

8-9-54. 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 that of the original disclosure. Its test as to involve new matter is the same as though filed on a subsequent date.

Note: New matter in subsequent amendments 8-9-56.

8-9-55. New Matter in Substitute Specification

The fact that a substitute specification, in the opinion of the Examiner, contains new matter is not a proper reason for refusing entry thereof. So far as the subject matter itself is concerned, an applicant has the right to a hearing on any amendment he may see fit to present. Whether that amendment be presented in the form of a substitute specification or a series of alterations of the original specification is an administrative matter for the Office to determine.

8-9-56. New Matter in Amendment

In the re-examination of an application following amendment thereof, the Examiner must be on the alert to detect new matter. An applicant is not allowed to introduce into the application any matter by amendment not disclosed in the application as originally filed, and if this is attempted by amendment, he must be required to cancel such matter. The Examiner should note that this applies likewise to what are called preliminary amendments; that is, amendments filed prior to an Office action on the case, even if such amendment be filed on the same day the application is filed. See 8-9-54.

8-9-57. Review of
Examiner's Holding of New Matter

Where the new matter is confined to amendments to the specification, review, if any, of the Examiner's requirement for cancellation is had by way of petition. But where the alleged new matter is introduced into 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 31.1 and 32.1 afford the explanation of this seemingly inconsistent practice as affecting new matter in the specification.

Note: Petition Sec. 12
Appeal Sec. 14