

MANUAL OF
PATENT
EXAMINING
PROCEDURE



PROPERTY OF THE UNITED STATES GOVERNMENT

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EXAMINING
PROCEDURE**

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Foreword

This Manual is published to provide examiners in the Patent Office with a reference work on the practice and procedure within the Office as it relates to their duties and operations. It contains instructions to examiners, as well as other material in the nature of information and interpretation, and generally outlines the current procedure which the examiners are required or authorized to follow in appropriate cases in the normal examination of applications.

Examiners will continue to be governed as in the past by the applicable statutes, the Rules of Practice, decisions, and orders and instructions issued by the Commissioner, the Executive Examiner or the Supervisory Examiners. Orders and Notices still in force which relate to the subject matter included in this Manual are incorporated and identified as such. Some Orders and Notices have been revised to coordinate them with changes in the patent laws and in the Rules of Practice, and are included in their revised form. Orders and Notices, or portions thereof, relating to the examiners' duties and functions included in this Manual which have been omitted or not incorporated in the text may be considered obsolete.

Subsequent changes in practice and other revisions will be incorporated in the form of substitute or additional pages for the Manual.

ROBERT C. WATSON,
Commissioner.

NOVEMBER 30, 1953.

Acknowledgments

Preparation of the text of the Second Edition of the Manual was directed by E. A. Faller, Secretary, Committee on Practice and Procedure, under the supervision of the Executive Examiner.

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Suggestions for improving the form and content of the Manual are always welcome. They should be addressed to:

Commissioner of Patents,
Washington 25, D. C.,

and marked for the attention of the Committee on Practice and Procedure.

Numbering System

The system of numbering used in this Manual was selected to indicate to the reader topical indentations in the tables of contents. It may be understood by considering specific examples. Thus, the symbol "1100" refers to Chapter 1100 as a whole; the symbol "1101" refers to a subdivision indented under 1100; the symbol "1101.01" refers to a further subdivision indented under 1101; and "1101.01 (a)" refers to a still further indentation under 1101.01. Thus Chapter 1100 is numbered as follows:

Chapter 1100 Interference

- 1101 Preliminaries to an Interference
 - 1101.01 Between Applications
 - 1101.01 (a) In Different Divisions
 - 1101.01 (b) Common Ownership
 - 1101.01 (c) The Interference Search
 - 1101.01 (d) Correspondence Under Rule 202
 - 1101.01 (e) How Conducted

Indentations beyond the third indentation are ignored in the assignment of a symbol. Fourth and further indentations are given the same type of symbol as a third indentation. Thus in the above example the section entitled "How Conducted" has the same type of symbol as the section entitled "Correspondence Under Rule 202." Because a fourth indent in the table of contents does not show up in the numbering system, those sections which are a fourth indent in the table of contents are given a title in the text which includes the title of the section under which they are indented. Thus, in the text, the heading for Sec. 1101.01 (e) reads: "Correspondence Under Rule 202, How Conducted."

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Introduction

Constitutional Basis

The Constitution of the United States provides:

"ART. 1, SEC. 8. The Congress shall have power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

Statutes

Pursuant to the foregoing provision of the Constitution, Congress has passed a number of statutes under which the Patent Office is organized and our patent system is established. The provisions of the statutes can in no way be changed or waived by the Patent Office. Prior to January 1, 1953, the law relating to patents consisted of various sections of the Revised Statutes of 1874, derived from the Patent Act of 1870 and numerous amendatory and additional acts. These statutes, as well as old Title 35 of the United States Code, were compiled and reprinted several times prior to January 1, 1953, in a pamphlet entitled "Patent Laws".

By an Act of Congress approved July 19, 1952, which came into effect on January 1, 1953, the patent laws were revised and codified. With certain exceptions applying to applications filed and patents issued before January 1, 1953, this law governs all cases in the Patent Office. The patent law is Title 35 of the United States Code, which contains 95 sections numbered from 1 to 293, with gaps in the numbering between various chapters of the title. In referring to a particular section of the new patent code the citation is given, for example, as, 35 U. S. C. 31. The current edition of the pamphlet "Patent Laws" reprints the patent code and some additional statutes; following each section of the patent code, the citation of the old statute corresponding to that section is given in parentheses, and the pamphlet also contains tables of the old section numbers with the corresponding new sections.

Rules of Practice

One of the sections of the patent statute, namely, 35 U. S. C. 6, authorizes the Commis-

sioner of Patents, subject to the approval of the Secretary of Commerce, to establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office. These regulations are set forth in a Patent Office booklet entitled "Rules of Practice of the United States Patent Office in Patent Cases". The Rules of Practice have a long history, going back to pamphlets of general information to the public, first issued in 1836. The content has been determined by history, tradition and other factors. Primarily the function of the Rules of Practice is to advise the public of the regulations which have been established in accordance with the statutes and which must be followed before the Office. But the Patent Office Rules of Practice have always additionally included, as numbered rules, informational material, copies of sections of the patent statutes, purely internal procedure, and the like. It goes without saying that the Rules of Practice govern the Examiners, as well as applicants and their attorneys.

Commissioner's Orders and Notices

From time to time, the Commissioner of Patents has issued Orders and Notices relating to various specific situations that have arisen in operating the Patent Office. Notices and circulars of information or instructions have also been issued by the Supervisory Examiners under authority of the Commissioner. Orders and Notices have served various purposes including directions to the examiners giving them instructions, information, interpretations and the like. Some may be for the information of the public, advising what the Office will do under specified circumstances.

Decisions

In addition to the statutory regulations, the actions taken by the Examiner in the examination of applications for patents are to a great extent governed by decisions on prior cases. Those dissatisfied with an Examiner's action may have it reviewed. In general, it may be stated that from that portion of the Examiner's action pertaining to objections on formal matters, a petition for review may be taken to the

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Commissioner of Patents (1002) and from that portion of the Examiner's action pertaining to the rejection of claims on the merits, an appeal may be taken to the Board of Appeals (1201). The distinction is set forth in Rules 181 and 191. The decision of the Commissioner on for-

mal matters is final but the decision of the Board of Appeals on questions passed on by it may be carried to the courts. See 1216. In citing decisions as authority for his actions, the Examiner should cite the decision in the manner set forth in 707.06.