

MANUAL OF PATENT EXAMINING PROCEDURE

U.S. DEPARTMENT of COMMERCE
Patent and Trademark Office



U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

MANUAL OF PATENT EXAMINING PROCEDURE
Fourth Edition

The attached pages comprise a complete copy of the Manual of Patent Examining Procedure, fourth edition.

Periodic revisions will be issued in the future in order to maintain the information current.

The major changes included in the fourth edition are as follows:

<u>Section</u>	<u>Change</u>
101	Paragraph added to indicate that information received from public searchers is confidential.
110	New section on confidential nature of international applications.
201.08	New paragraph added on when a determination should be made as to whether the requirements of 35 U.S.C. 120 have been met.
201.13(b)	New section on priority based on an international application.
310	New section on Government contractor license rights.
506	Includes procedure permitting cancelation of claims to lower filing fee.
605.04	Includes practice on granting filing date based on facsimile papers.
711.03(c)	Includes consideration of petition for withdrawal of a notice of abandonment with allegation that an Office action was not received.
721.01	Includes revised fraud allegation handling practice.
803	Includes revised restriction practice for Markush-type claims.
823	New section on Unity of Invention under the PCT.

- 901.05 Includes material on national foreign patent documents prepared by P.V. Federico.
 - 1101.02 Includes practice for notifying patentees twice concerning copying of claims.
 - 1401.08
 - 1401.09
 - 1401.09(a) Include additional guidelines for reissue applications.
- Chapter 1800 New chapter relating to procedures under the Patent Cooperation Treaty.

Louis O. Maassel, Editor
Manual of Patent Examining
Procedure

Rev. 2, April 1980









U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office
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MANUAL OF PATENT EXAMINING PROCEDURE
Fourth Edition

Instructions Regarding Revision No. 2

The attached revised pages are replacements for those in the Manual having corresponding numbers.

Arrows are printed in the margin of pages to indicate material changed, deleted, or added by this revision. Where insertion of new material results in shifting of unchanged material onto following pages, no arrows appear on such pages but the revision number is cited at the bottom of each page.

	or		Line on which change begins.
	or		Line on which change ends.
	or		Line on which change both begins and ends.
	or		Opposite a blank space, indicates deletion of material.

The notation "[R-2]" in the attached pages appears at the title of a section that has been revised.

Louis O. Maassel, Editor
Manual of Patent Examining
Procedure

Rev. 2, April 1980

Particular attention is called to the following sections:

<u>Section</u>	<u>Change</u>
202.02, 202.03	Procedure added for examiner verifying prior application information printed on file wrapper label.
608.02(a)	The requirement that formal drawings be received prior to examination has been deleted.
708, 708.01	Indication added that reissue applications in which litigation has been stayed should be given top priority for examination.
721, 721.01	The material from these sections has been incorporated in new Chapter 2000.
1446	Section clarified as to handling of reissue applications without changes but with issue of fraud or violation of duty of disclosure.
1901.07(a)	Revised to include procedure for adding protestor's address to file wrapper where he has right to receive all correspondence.
Chapter 2000	Entirely new Chapter added on duty of disclosure, fraud, lack of candor and good faith, violation of duty of disclosure, and striking of applications.

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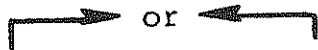
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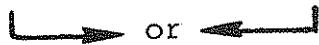
Instructions Regarding Revision No. 3

The attached revised pages are replacements for those in the Manual having corresponding numbers.

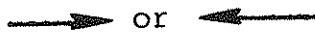
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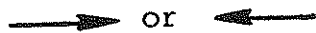
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Opposite a blank space, indicates deletion of material.

The notation "[R-3]" in the attached pages appears at the title of a section that has been revised.

Louis O. Maassel, Editor
Manual of Patent Examining
Procedure

Particular attention is called to the following sections.

<u>Section</u>	<u>Change</u>
201.13(b) and 1828	Revised PCT Rule 17 added relating to submission of priority documents in international applications.
802	Revised PCT Rule 13 added relative to unity of invention in international applications
1805	Revised PCT Rules 18.5 and 19.2 added relating to listing of applicants in international applications.
1807	Revised PCT Rule 90.3 and Administrative Instruction 106 added relating to general powers of attorney in international applications during international processing only.
1812	Revised PCT Rule 10 added relating to metric terms in international applications.
1815	Revised PCT Rule 11.1(d) and 11.10(d) and 11.13(j) added relating to using sheets sideways in international applications.
1820.05	The list of PCT member States has been updated.
1823.01	New section on reference to deposited microorganism in international applications.
1827.01	New section on new procedure under PCT Rule 16 bis in which the International Bureau will advance money for unpaid fees.
1845.04	New section on changes of certain indications on the PCT Request form.
1885	Revised PCT Rule 47.1(c) added which requires each designated Office to be informed of a communication under PCT Article 20 and that such notice shall be accepted as conclusive evidence of communication on the date specified in the notice.

- 1901.07(c) New section on filing of multiple papers relating to the same issues in protests.
- 2100 New chapter on patentability which will be expanded upon in future revisions.
- 2105 New section relating to patentable subject matter in view of the Chakrabarty decision.
- 2120-2129 New sections on the statutory bars of "Public Use" and "On Sale" under 35 U.S.C. 102(b).

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*Added page

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U.S. DEPARTMENT OF COMMERCE

PATENT AND TRADEMARK OFFICE

Rev. 3, July 1980

The Patent and Trademark Office does not handle the sale of the Manual, distribution of notices and revisions or change of address of those on the subscription list.

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Superintendent of Documents
Mail List Section
Washington, D.C. 20402

Inquiries relating to subscriptions should be directed to:

Mr. C. A. LaBarre (personal attention)
Superintendent of Documents
United States Government Printing Office
Washington, D.C. 20402

Orders for reproduced copies of individual replacement pages not amounting to a complete revision of the Manual should be sent to the following address:

Commissioner of Patents and Trademarks
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Washington, D.C. 20231

The cost per page will be 30¢ (see 37 CFR 1.13(a), 1.21(b) and 1.21(t)).

Charges may be made to deposit accounts if the requester is an account holder in good standing at the time the request is received. Checks or money orders should be made payable to the Commissioner of Patents and Trademarks. Requests must identify the specific pages required and the number of copies of each page.

Employees of the Patent and Trademark Office should direct their requests for the Manual, replacement pages, notices, and revisions to the Scientific Library.

First Edition, November 1949

Revision 1, November 1950

Revision 2, December 1951

Revision 3, May 1952

Second Edition, November 1953

Revision 1, April 1955

Revision 2, June 1956

Revision 3, June 1957

Revision 4, July 1958

Third Edition, November 1961

Revision 1, January 1964

Revision 2, November 1964

Revision 3, January 1965

Revision 4, April 1965

Revision 5, July 1965

Revision 6, October 1965

Revision 7, January 1966

Revision 8, April 1966

Revision 9, July 1966

Revision 10, October 1966

Revision 11, January 1967

Revision 12, April 1967

Revision 13, July 1967

Revision 14, October 1967

Revision 15, January 1968

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Revision 18, October 1968

Revision 19, January 1969

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Revision 53, July 1977

Revision 54, October 1977

Revision 55, January 1978

Revision 56, July 1978

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Revision 2, April 1980

Revision 3, July 1980

Foreword

This Manual is published to provide Patent and Trademark Office patent examiners, applicants, attorneys, agents, and representatives of applicants with a reference work on the practices and procedures relative to the prosecution of patent applications before the Patent and Trademark Office. It contains instructions to examiners, as well as other material in the nature of information and interpretation, and outlines the current procedures which the examiners are required or authorized to follow in appropriate cases in the normal examination of a patent application.

A separate manual entitled "Trademark Manual of Examining Procedure" is published by the Patent and Trademark Office as a reference work for trademark cases.

Examiners will be governed by the applicable statutes, the Rules of Practice, decisions, and orders and instructions issued by the Commissioner and the Assistant Commissioners. Orders and Notices still in force which relate to the subject matter included in this Manual are incorporated in the text. Orders and Notices, or portions thereof, relating to the examiners' duties and functions which have been omitted or not incorporated in the text may be considered obsolete. Interference procedure not directly involving the Primary Examiner is not included in this Manual and, therefore, Orders and Notices relating thereto remain in force.

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

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

Commissioner of Patents and Trademarks,
Editor, M.P.E.P.
Washington, D.C. 20231

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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 provision of the Constitution, Congress has over the years passed a number of statutes under which the Patent and Trademark 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 and Trademark 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.

By an Act of Congress approved July 19, 1952, which came into effect on January 1, 1953, the patent laws were revised and codified into substantially its present form. With certain exceptions applying to applications filed and patents issued before January 1, 1953, this law governs all cases in the Patent and Trademark Office. The patent law is Title 35 of the United States Code, which contains 110 sections numbered from 1 to 376, with gaps in the numbering between various chapters of the title. In referring to a particular section of the patent code the citation is given, for example, as, 35 U.S.C. 31. The pamphlet "Patent Laws" (available from the Superintendent of Documents) reprints the patent code and some additional statutes.

35 U.S.C. 1 Establishment. The Patent and Trademark Office shall continue as an office in the Department of Commerce, where records, books, drawings, specifications, and other papers and things pertaining to patents and to trademark registrations shall be kept and preserved, except as otherwise provided by law.

Rules of Practice

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

sioner of Patents and Trademarks, subject to the approval of the Secretary of Commerce, to establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office.

37 CFR 1.351. Amendments to rules will be published. All amendments in this part will be published in the Official Gazette and in the Federal Register.

37 CFR 1.352. Publication of notice of proposed amendments. (a) Whenever required by law, and in other cases whenever practicable, notice of proposed amendments in this part will be published in the Official Gazette and in the Federal Register. If not published with the notice, copies of the text will be furnished to any person requesting the same. All comments, suggestions, and briefs received within a time specified in the notice will be considered before adoption of the proposed amendments which may be modified in the light thereof.

(b) Oral hearings may be held at the discretion of the Commissioner.

These rules and amendments thereto are published in the Federal Register and in the Official Gazette. In the Federal Register and in the Code of Federal Regulations these rules are Part 1 of Title 37, Patents, Trademarks and Copyrights, and the individual rules, called sections, are numbered with the Part number and a decimal point prefixed to the rule number. A booklet entitled "37 Code of Federal Regulations," published by the Office of the Federal Register, contains all of the patent rules and forms, as well as trademark rules and forms and copyright rules. Persons desiring a copy of the patent rules should order a copy of "Title 37, Code of Federal Regulations" from the Superintendent of Documents.

The primary 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. 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 and Trademarks has issued Orders and Notices relating to various specific situations that have arisen in operating the Patent and Trademark Office. Notices and circulars of information or instructions have also been issued

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by other Office Officials under authority of the Commissioner. Orders and Notices have served various purposes including directions to the examiners giving them instruction, 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. Applicants dissatisfied with an examiner's action may have it reviewed. In general, that portion of the examiner's action pertaining to objections on formal matters may be reviewed by petition to the Commissioner of Patents and Trademarks (see § 1002) and that portion of the examiner's action pertaining to the rejection of claims on the merits, may be reviewed by appeal to the Board of Appeals (see § 1201). The distinction is set forth in 37 CFR 1.181 and 1.191. In citing decisions as authority for his actions, the examiner should cite the decision in the manner set forth in § 707.06.

Publications Available from Superintendent of Documents

Orders should be addressed and remittances made payable to Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

Patent Official Gazette. The official journal of the Patent and Trademark Office relating to patents. Issued each Tuesday, simultaneously with the weekly issuance of patents, it contains a selected figure of the drawings and a claim of each patent granted, indexes of patents, list of patents available for license or sale, and general information such as orders, notices, changes in rules, and changes in classification.

Annual Indexes. An index of the patents issued each year is published in two volumes, one an alphabetical index of patentees and the other an index by subject matter of inventions. The two parts are sold separately. Price varies from year to year, depending upon size of the publication. An annual Index of Trademarks contains an alphabetical index of trademark registrants, registration numbers, dates published, classification of goods for which registered, and decisions published during the calendar year. Price varies from year to year, depending upon size of the publication.

Guide for Patent Draftsmen. Patent and Trademark Office requirements for patent drawings with illustrations.

Manual of Classification. A loose-leaf volume listing the numbers and descriptive titles of the more than 300 classes and 95,000 subclasses used in the subject classification of patents, with an index to the classifications. Substitute and additional pages, which are included in the subscription service, are issued from time to time.

Manual of Patent Examining Procedure. A loose-leaf manual which serves primarily as a detailed reference work on patent examining practice and procedure for the Patent and Trademark Office's Examining Corps. Subscription service includes basic manual, quarterly revisions, and change notices.

Patents and Inventions—An Information Aid to Inventors. The purpose of this publication is to aid inventors in deciding whether to apply for patents, in obtaining patent protection, and in promoting their inventions.

Patents: Spur to American Progress. Focuses on the functioning of the patent system, outlining its purpose and practices and charting the "how-to" path to patents. It illustrates how the system nurtures discovery of data and devices on which the American partnership of inventor, industry, and the public builds prosperity. This publication is one of the U.S. Department of Commerce's "Know Your Economic ABC's" series.

The Story of the United States Patent and Trademark Office. Cites important events in the development of the United States patent system and lists chronologically inventions having important effects on the economy.

Patent Laws. Compilation of patent laws in force.
Patent Attorneys and Agents Registered to Practice Before The U.S. Patent and Trademark Office. An alphabetically and a geographically arranged listing of patent attorneys and agents registered to practice before the U.S. Patent and Trademark Office.

Title 37—Patents, Trademarks and Copyrights. Compilation rules of practice before the U.S. Patent and Trademark Office.

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Q & A About Patents. Brief, non-technical answers to questions most frequently asked about patents. Free.

Q & A About Plant Patents. Same as above for plant patents. Free.

General Information Concerning Patents. Contains a vast amount of general information concerning the application for and granting of patents, expressed in non-technical language for the layman. Single copy free. Multiple copies available from Superintendent of Documents.

Patents. Copies of the specification and drawings of all patents are available at 50 cents each, except design patents. Design patents are 20 cents each. When ordering, identify the patent by the patent number, or give full name of the inventor and approximate date of issuance of the patent.

Classification Definitions. Contain the changes in classification of patents as well as definitions of new and revised classes and sub-classes. Price is based upon size of publication, minimum price 10 cents.

Weekly Class Sheets. Lists showing classification of each patent in the weekly issue of the *Patent Official Gazette*.

Patent Cooperation Treaty. Free.